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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

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

**Fourteenth Session
Geneva, February 5 to 7, 2007**

**PCT INTERNATIONAL SEARCH AND PRELIMINARY
EXAMINATION GUIDELINES: PROPOSED MODIFICATIONS**

Proposals by the United States Patent and Trademark Office

SUMMARY

1. The PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) require revision due to a number of issues and developments. Annex I to this document contains a third draft of proposed revisions to the Guidelines necessitated primarily by recently adopted changes to the PCT Regulations which either have already become effective or which will become effective on April 1, 2007. The Meeting is invited to consider and comment on the proposals.

BACKGROUND

2. At the 12th session of the Meeting, held in Geneva from December 12 to 16, 2005, it was agreed that the Guidelines should be reviewed and revised as necessary to accommodate changes to the PCT Regulations which have come into effect since the Guidelines were published in 2004. It was also agreed that the opportunity should be taken to consider further revisions of the Guidelines with respect to the divergent practices set forth in the appendices to certain chapters of the Guidelines.

3. At the 13th session of the Meeting, held in Geneva from May 3 to 5, 2006, proposed changes to the Guidelines were presented for consideration by the Authorities. Document PCT/MIA/13/2, prepared by the International Bureau, set forth proposed changes necessitated primarily by amendments of the PCT Regulation which had become effective subsequent to the last revision of the Guidelines. Document PCT/MIA/13/2 Add.1, containing proposals by

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the United States Patent and Trademark Office, set forth proposed changes necessitated primarily by amendments of the PCT Regulation which will enter into force on April 1, 2007.

4. At that session, and subsequent thereto, comments were received from Authorities on the proposed changes. Some Authorities also made suggestions for additional changes. It was agreed that the United States Patent and Trademark Office should draft a revised proposal, taking into account the comments and suggestions of the Authorities, that Authorities should submit any comments on the revised proposal by November 1, 2006, and that, if possible, a final version of the revisions would be drafted by January 1, 2007.

5. On September 1, 2006, the United States Patent and Trademark Office submitted to the Authorities, via the PCT/MIA electronic forum, a further proposal for revision of the Guidelines which combined the proposals from documents PCT/MIA/13/2 and PCT/MIA/13/2 Add.1, and which also took into account comments and suggestions submitted by Authorities. Subsequently, comments were submitted by the Austrian Patent Office, the Canadian Intellectual Property Office, the European Patent Office and the National Board of Patents and Registration of Finland.

FURTHER REVISED PROPOSALS

6. Upon review of the submitted comments it was clear that the positions of the Authorities were too divergent on several key issues to arrive at an agreed revision by January 1, 2007. After consultation with the International Bureau, it was decided that the best course of action, at this time, would be to submit of a further draft of proposed modifications of the Guidelines for discussion at the present session of the Meeting.

7. The resulting delay in the establishment of a final draft may prevent publication of the revised Guidelines by the International Bureau in the PCT Gazette prior to April 1, 2007. However, if agreement can be reached by the Meeting at the present session, there should still be sufficient time for the revised Guidelines to be published electronically and made available to Authorities, Offices, and users on the WIPO website prior to that date. Publication in the PCT Gazette would then follow as soon as possible thereafter.

8. Annex I to this document accordingly contains a third draft of proposed modifications of the Guidelines. Added text is indicated by underlining (blue text, in the electronic version) and deleted text by striking through (red text). Changes which were proposed previously, either in documents considered by the 13th session of the Meeting or in the proposal submitted via the PCT/MIA electronic forum on September 1, 2006, appear without further highlighting, whereas those proposed changes which appear for the first time in this document are highlighted by (yellow) shading.

9. Annex II contains a compilation of the comments received in response to the September 1, 2006, proposal, together with the United States Patent and Trademark Office's responses explaining why additional modifications were or were not made in response to particular comments.

10. The Meeting is invited to review and comment on the proposed modifications of the Guidelines contained in Annex I of this document.

[Annexes follow]

ANNEX I

PROPOSED MODIFICATIONS OF THE PCT INTERNATIONAL
SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

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Chapter 1 Introduction

1.01 These Guidelines give instructions as to the practice to be followed by Authorities during the international search and examination procedures. ~~The Guidelines have been revised to incorporate the changes resulting from the amendments to the Regulations under the Patent Cooperation Treaty (PCT) adopted by the Assembly in September 2002, the main change relating to the procedure before the International Searching and Preliminary Examining Authorities being that the establishment of an examiner's written opinion is incorporated into the international search procedure.~~

1.02 [No change]

1.03 These Guidelines are common rules of international search and examination that provide instructions regarding international search and examination and assist in the application of the provisions of the PCT, PCT Regulations and PCT Administrative Instructions relating to international search and examination. They are intended to cover typical occurrences. They should therefore be considered only as general directives; examiners will have to go beyond the instructions in exceptional cases. Nevertheless, applicants can expect the International Searching and Examining Authorities to act, as a general rule, in accordance with the Guidelines until such time as they are revised. In addition, at various points throughout these Guidelines, the examiner is directed to interpret a claim in a particular fashion. This has been done to enable the designated and/or elected Offices to understand the examiner's conclusion as to novelty, inventive step (non-obviousness) and industrial application, and in no way binds the designated and/or elected Offices to adopt a similar interpretation. The Guidelines ~~also~~ set forth standards for quality for the International Searching Authorities and the International Preliminary Examining Authorities to follow so as to minimize differences in the results of the search and examination process among the various Authorities.

1.04–1.08 [No change]

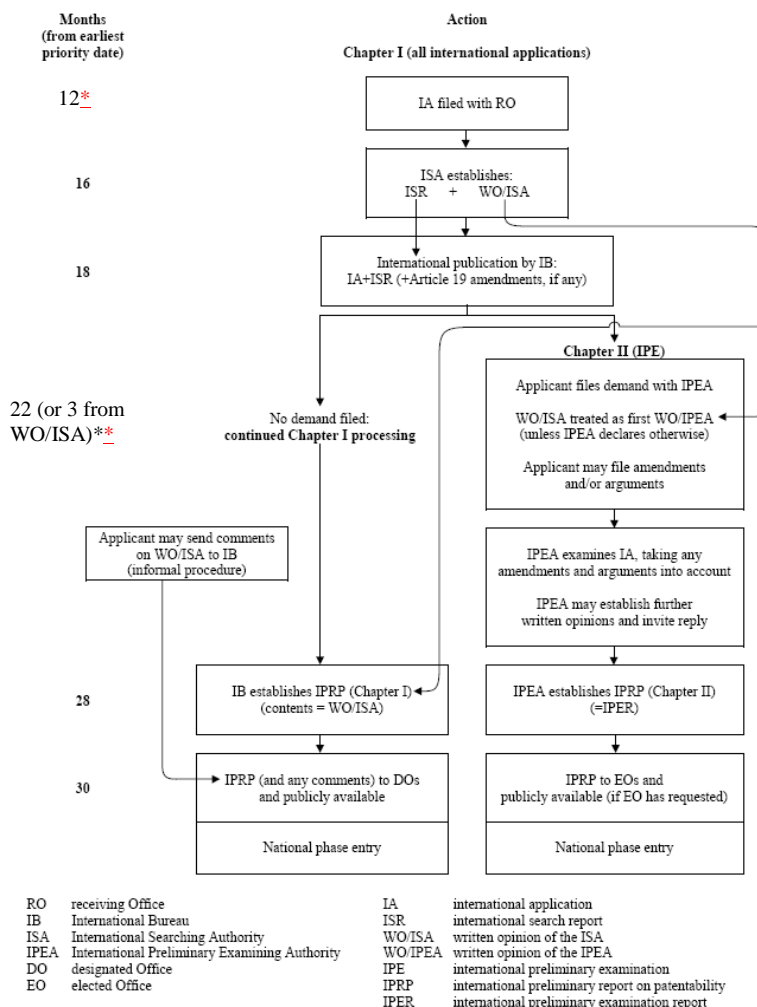
1.09 The procedure through which an international patent application under the Patent Cooperation Treaty proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two main stages, commonly referred to as the “international phase” and the “national phase” (or “regional phase” when an international application comes before a regional body rather than a national one). ~~As indicated in paragraph 1.01, a major change to processing international applications is that the International Searching Authority rather than the International Preliminary Examining Authority establishes a first written opinion (under PCT Rule 43bis), thus combining the international search and international preliminary procedures to a much greater extent than before.~~ The following paragraphs 1.10, 1.11 and the flowchart of typical international application processing that has been provided at the end of this chapter provide a brief overview of the international phase, with a complete explanation provided in Parts ~~II~~² through ~~VIII~~⁸ of the Guidelines.

1.10–1.15 [No change]

The flowchart at the end of Chapter 1 is to be modified as follows:

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Flowchart of Typical International Application Processing



* If IA is filed later than 12 months from the priority date but within two months from the expiration of the priority period, the right of priority may be restored.

** In practice, demand must be filed by 19 months for Article 22 transitional reservation countries.

Chapter 2 Overview of the International Search Stage

2.01–2.02 [No change]

2.03 At the same time as establishing the international search report, the search examiner establishes a written opinion ~~as to whether the claimed invention appears to be novel, involve an inventive step, be industrially applicable and meet with the other requirements of the Treaty which are checked by the International Searching Authority.~~ The written opinion has the primary objective of formulating a preliminary and non-binding opinion on the questions of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. A secondary objective is to identify whether there appear to be any defects in the form or contents of the international application, for example with regard to the clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description.

2.04–2.09 [No change]

2.10 The role of the International Searching Authority is as follows, the details being considered in subsequent chapters referred to below:

(a) to (d) [No change]

Rule 13ter

(e) to determine whether to invite the applicant to provide a listing if the international application contains disclosure of one or more nucleotide and/or amino acid sequences but does not include a sequence listing in compliance with the ~~paper form or computer readable sequence listing~~ standards for sequence listings in paper or electronic form provided for in the Administrative Instructions (see paragraphs 15.11 and 15.12);

(f) to (i) [No change]

2.11–2.20 [No change]

Chapter 3 Overview of the International Preliminary Examination Stage

3.01 [No change]

3.02 International preliminary examination is an optional part of the processing of an international application, performed if the applicant files a “demand.” It shares the objectives of, and builds on the process of, the written opinion of the International Searching Authority, allowing the applicant to respond to the International Preliminary Examining Authority, with arguments as to why the opinion was incorrect, or with amendments to attempt to overcome objections. ~~It has the primary objective of formulating a preliminary and non-binding opinion on the questions of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. A secondary objective is to identify whether there appear to be any defects in the form or contents of the international application, for example with regard to the clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description.~~ The results of the international preliminary examination are recorded in the international preliminary examination report (entitled “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)”), copies of which are then sent to the applicant and the International Bureau. The International Bureau communicates the report to each elected Office (that is, usually, the Offices of all Contracting States).

3.03–3.06 [No change]

Article 31(6); Rule 54bis

3.07 The applicant should file the demand with the competent International Preliminary Examining Authority before the expiration of the later of the following time limits:

(a) three months from the date of transmittal to the applicant of the international search report or the declaration referred to in Article 17(2)(a), and written opinion established under Rule 43bis.1, ~~or of the declaration referred to in Article 17(2)(a)~~; or

(b) 22 months from the priority date of the international application.

3.08–3.12 [No change]

3.13 The International Preliminary Examining Authority normally starts the international preliminary examination (see Chapter 19) when:

(a) it is in possession of:

(i) the demand;

(ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2; ~~and~~

(iii) if the applicant is required to furnish a translation under Rule 55.2, that translation; and

(iv) either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, and the written opinion established under Rule 43bis.1 ~~or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established~~;

and

(b) the time limit within which the applicant was permitted to file the demand (see paragraph 3.07) has expired, or earlier if the applicant has expressly requested an earlier start.

3.14 The exceptions to the above are as follows:

[Rule 69.1\(c\)](#)

[\(a\) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account \(Rule 53.9\(a\)\(i\)\), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned.](#)

[Rule 69.1\(e\)](#)

[\(b\) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand \(Rule 53.9\(c\)\) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1\(g\) \(see paragraph 18.04\) has expired, whichever occurs first.](#)

[Rule 69.1\(b\) and \(d\)](#)

[\(ac\) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes, start at the same time as the international search \(subject to the possible need to invite the applicant to provide copies of amendments under Article 34, as noted in paragraph \(b\), above\), provided that the applicant has not indicated \(under Rule 53.9\(b\)\) in the statement of amendments that examination is ~~not~~ to be postponed until after the expiry of the time limit for filing amendments under Article 19 \(such amendments only being permitted after the international search report has been received\).](#) ~~according to the statement concerning amendments (see paragraphs (c) and (d) below).~~

~~[\(b\) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account \(Rule 53.9\(a\)\(i\)\), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned.](#)~~

~~[\(e\) Where the statement concerning amendments contains such an indication that the start of the international preliminary examination is to be postponed \(Rule 53.9\(b\)\), the International Preliminary Examining Authority does not start the international preliminary examination before whichever of the following occurs first:](#)~~

~~[\(i\) until it has received a copy of any amendments made under Article 19;](#)~~

~~[\(ii\) it has received or a subsequent notice from the applicant that he does not wish to make amendments under Article 19; or the time limit under Rule 46.1 for filing Article 19 amendments has expired, whichever occurs first.](#)~~

~~[\(iii\) the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search will be established; or the expiration of 22 months from the priority date.](#)~~

~~(d) — Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) (see paragraph 18.04) has expired, whichever occurs first. These examination procedures before the International Preliminary Examining Authority are set out in detail in chapter 19.~~

3.15–3.29 [No change]

Chapter 4 Content of the International Application (Other Than the Claims)

4.01–4.04 [No change]

Rules 5.1(a)(ii), 6.3(b)(i)

4.05 [No change to body of paragraph]

4.06–4.14 [No change]

Rules 5.2, 13ter.1(a), (c) and (e); Sections 208, 801; AI Annex C

4.15 Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description should contain a separate sequence listing part complying with the standard provided for in Annex C of the Administrative Instructions. ~~The sequence listing may be in written form and computer readable form, both forms complying with the standard provided for in Annex C. Instead of in written form, the sequence listing may be filed on an electronic medium under the provisions of Section 801 of the Administrative Instructions, where the receiving Office in which the international application was filed accepts sequence listings filed on an electronic medium. The International Searching Authority carries out the international search on the basis of those forms of the listing.~~ Where the receiving Office accepts sequence listings filed on an electronic medium in accordance with Part 8 of the Administrative Instructions, the applicant may choose to file the sequence listing part of the description and/or any table related to the sequence listing either in paper form, in electronic form, or both. Either form must comply with the standard provided for in Annexes C and C-bis. However, where the listing is not available to the International Searching Authority (or International Preliminary Examining Authority) in electronic form, or the listing does not comply with the relevant standard, the International Searching Authority may invite the applicant to furnish a further copy of the listing in the appropriate format for the purposes of international search. For handling of the nucleotide and/or amino acid sequence listings, refer to paragraphs 15.11 and 15.12 (search stage) and paragraphs 18.17 to 18.18 (examination stage).

4.16–4.26 [No change]

4.27 A reference in the description to an unpublished, previously filed application (that is, not published before the international filing date) should not be regarded as being part of the disclosure, unless the application referred to is made available to the public on or before the publication date of the international application. The reference to such an application made available to the public on or before the publication date of the international application may be replaced by the actual text referred to and may be taken into account by the examiner. Similarly, references to textbooks and periodicals are allowable under the same conditions if it can be proved that the content thereof was fixed prior to the international filing date. In the case of any document made available to the public later than the publication date of the international application or not to be published at all (for example, an application withdrawn before publication), the examiner should not take into account the reference to that document for the purposes of international preliminary examination. It should be noted, however, that this practice relates only to the international phase and does not preclude any designated or elected Office applying the relevant national law as far as it relates to the contents of the disclosure of the international application as filed.

4.28–A4.05[2] [No change]

Chapter 5
[No change]

Chapter 6 Priority

6.01 An international application is accorded as its international filing date the date on which it satisfies the requirements of Article 11. This date remains unchanged except in the special circumstances of later-filed drawings and/or parts of the description or claims that were missing upon filing of the international application, and sheets as provided in Article 14(2) and Rule ~~20.5(c)20-2~~. The international filing date may be the only effective date of the international application. It will be of importance for fixing the expiration of certain time limits and for determining the state of the art relevant for the purposes of the international search and examination.

6.02 [No change]

Article 8(1); Rules 2.4, 4.10, 26bis.2, and 64.1

6.03 For a valid claim to priority, several conditions must be satisfied. ~~the~~ The earlier application whose priority is claimed must have been made by the applicant or his predecessor in title; and it must ~~have been filed not more than 12 months before the filing date of the international application; and~~ have been “filed in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention.” The words “in or for” any country or Member mean that the earlier application the priority of which is claimed may be an earlier national, regional or international application. Furthermore, the international application must have been filed within the period of 12 months from the filing date of the earlier application (the “priority period”). However, in accordance with Rule 26bis.2(c)(iii), the claim to priority shall not be considered invalid only because the international application has a filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date. In such a situation, applicant may request that the right to claim priority be restored by the receiving Office in accordance with Rule 26bis.3, or by the designated office in accordance with Rule 49ter.2. The earlier application may be for a patent or for the registration of a utility model or for an inventor’s certificate. So long as the contents of the earlier application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the final disposition of the application may later be; for example, it may subsequently be withdrawn or held withdrawn. Other conditions to be satisfied for a valid claim of priority are mentioned in paragraphs 6.04 and 6.11 to 6.17.

6.04 [No change]

Article 8(1)

6.05 An international application may claim rights of priority based on more than one earlier application (“multiple priorities”), even if they originate in different countries. ~~The earliest application must have been filed not more than 12 months before the date of filing of the international application.~~ An element of an international application will be accorded the priority date of the earliest priority application which discloses it. If, for instance, the international 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 international application; embodiment A will have the French priority date and embodiment B the German priority date. If an international 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 international application

itself. In other words, it is not permitted to make a mosaic of the priority documents. An exception might arise where one priority document contains a reference to the other and explicitly states that features from the two documents may be combined in a particular manner.

6.06 As a general rule, the examiner, in preparing a written opinion or an international preliminary examination report, should not make any investigation as to the validity of a right to priority ([in which case, Box No. II \(“Priority”\) of the opinion or report would not normally be included; see paragraph 17.25](#)). However, the priority right assumes importance if subject matter relevant with regard to the determination of novelty or inventive step (non-obviousness) of the claimed invention:

- (i) has been published within the meaning of Rule 64.1 on or after the priority date claimed and before the international filing date;
- (ii) forms part of the content of a non-written disclosure within the meaning of Rule 64.2, that is, a non-written disclosure which occurred before the priority date and which was indicated in a written disclosure ~~in the period between, and including, on or after~~ the priority date ~~and the international filing date~~; or
- (iii) forms part of the content of an application or patent within the meaning of Rule 64.3, that is, an application or patent which was published on or after that date but was filed earlier than the international filing date or claimed the priority of an earlier application which was filed prior to the international filing date.

In such cases (that is, cases where the art in question would be relevant if of earlier date), the examiner must satisfy himself that the priority date(s) claimed may be accorded to the appropriate parts of the international application he is examining and, where appropriate, will also consider the validity of any priority date claimed for the application or patent within the meaning of Rule 64.3 (see also Rule 70.10, last sentence).

6.07–6.12 [No change]

6.13 The examiner should keep in mind that the form of the declaration (see paragraph 6.11) claiming the priority of one or more earlier applications under Article 8(1) is prescribed under Rule 4.10(a). The prescribed form of declaration includes the giving of the following indications:

- (i) the date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date;
- (ii) the number of the earlier application;
- (iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;
- (iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;
- (v) where the earlier application is an international application, the receiving Office with which it was filed.

6.14–6.16 [No change]

Rules 66.7(a) and (b), 17.1(c) and (d)

6.17 If the examiner needs a copy of the priority document (see paragraph 6.06), the copy is supplied on request by the International Bureau, unless the International Bureau has not yet received the priority document (see paragraph 6.12), ~~in which event the examiner may invite the applicant himself to furnish such a copy.~~ If the priority document is not in the language, or one of the languages (if more than one) of the relevant Authority, the examiner may invite the applicant to furnish a translation of the priority document within two months of the invitation. In the meantime, any written opinion established while there is still time to furnish the priority document or translation thereof may proceed as if the priority had been validly claimed (see also paragraphs 11.05, 17.26 and 18.16); however, if the necessary priority document or its translation is not timely furnished, any further written opinion or the international preliminary examination report may be established as if the priority had not been claimed. No designated Office may disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances. Furthermore, no designated Office may disregard the priority claim if the priority document is available to it from a digital library in accordance with the Administrative Instructions.

Chapter 7
[No change]

Chapter 8 Rule 91 – Obvious ~~Errors~~ Mistakes in Documents

Rule 91.1(a), (c), (d) and (e)

8.01 ~~Errors~~ Mistakes which are due to the fact that something other than that which was obviously intended ~~that~~ were written in the contents of the international application or in a later submitted paper (for example, linguistic errors, spelling errors) may usually be rectified if a request for rectification is submitted within 26 months from the priority date. The ~~error~~ mistake must be “obvious” in the sense that it is ~~immediately apparent~~ obvious to the competent authority:

(i) that ~~an error~~ a mistake has occurred (i.e., something else was intended than what appears in the document concerned); and

(ii) ~~that anyone would immediately recognize~~ that nothing else could have been intended other than the offered rectification.

8.02 The competent authority makes the determination if a mistake is rectifiable. No special attributes should be ascribed to the person in the competent authority making the finding whether an alleged mistake is obvious and thus rectifiable.

Rule 91.1(d)

~~8.03~~ Examples of obvious ~~errors~~ mistakes that are rectifiable include linguistic errors, spelling errors and grammatical errors so long as the meaning of the disclosure does not change upon entry of the rectification. An obvious mistake is not solely limited to such mistakes, but for the correction to the description, claims, or drawings, the finding by the competent authority whether an alleged mistake is obvious would have to be made only on the basis of the description, claims, and drawings, without any possible reliance on extrinsic documents. The contents of priority documents should not be taken into account for the purposes of considering whether mistakes in the description, claims or drawings were obvious and thus rectifiable. ~~Errors~~ Mistakes in chemical or mathematical formulae would not generally be rectifiable unless the correct formulae would be common knowledge ~~to anyone~~.

Rule 91.1(c)

~~8.04~~ If a correction is not of this character (for example, if it involves cancellation of claims, omission of passages in the description or omission of certain drawings), it would ~~be treated not be authorized~~ by the competent authority ~~as an amendment and dealt with on that basis~~. It is noted that Rules 20.5 to 20.8 allow an applicant to request that the receiving Office replace a missing element or part of an application if the request included an incorporation by reference statement under Rule 4.18 and applicant makes such a request in compliance with Rules 20.5 and/or 20.6 within the time limits set forth in Rule 20.7.

Rule 91.1(e)

8.05 In the case of a mistake:

(i) in the request part of the international application or a correction thereof; or

(ii) in a document other than the description, claims or drawings, any correction thereof, or any amendment thereto under Article 19 or 34;

the finding of the competent authority shall only take into account the contents of the international application itself and, where applicable, the correction concerned, or the content of said document, together with any other document submitted with the request, correction or document, as the case may be, any priority document in respect of the international

application that is available to the authority in accordance with the Administrative Instructions, and any other document contained in the authority's international application file at the applicable date under paragraph 8.06, below. Extrinsic evidence filed with the request for rectification, other than the priority document, is not permitted to be used.

Rule 91.1(f)

8.06 The applicable date to be used in determining the approval of a rectification of a mistake shall be:

(i) the international filing date where the alleged mistake is in a part of the international application as filed;

(ii) the date on which a document containing the alleged mistake was submitted where the alleged mistake is in the document other than the international application as filed, including a mistake in a correction or an amendment of the international application.

Where the alleged mistake is a part of the international application as filed, the rectification two part test discussed in the paragraph 8.01 must be met on the international filing date. Knowledge that came into being after the international filing date may not be used to rectify such a mistake. Where the alleged mistake is in another document, the rectification two-part test must be met on the date the paper was filed. Knowledge that came into being after the deposit date of the document may not be used to rectify such a mistake.

Mistakes that Cannot be Rectified Under Rule 91

8.07 Under Rule 91.1(g), a mistake shall not be rectified if:

Rule 66.5 and 91.1(g)(i)

(i) the mistake lies in the omission of one or more entire elements of the international application referred to in Article 3(2) (request, description, claims, drawings, or abstract) or one or more entire sheets of the international application;

Rule 91.1(g)(ii)

(ii) the mistake is in the abstract;

Rule 91.1(g)(iii)

(iii) the mistake is in an amendment under Article 19, unless the International Preliminary Examining Authority is competent to authorize the rectification because a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examination shall start in accordance with Rule 69.1 has passed; or

Rules 26bis.2(e) and 91.1(g)(iv)

(iv) the mistake is in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the earliest priority date.

However, it is noted that provisions for providing a missing element or sheet to the receiving Office are provided in Rules 20.5 to 20.8. An applicant may, under Rule 38.3, propose modifications to the abstract established by the International Searching Authority. Changes to the priority claim, other than a change in the priority date, may be made under either Rule 91 or Rule 26bis.1(a).

Correction of Priority Claims

8.08 Corrections or additions of the priority claim that would affect the priority date may only be corrected in accordance with Rule 26bis. However, where the applicant wishes to correct or add a priority claim but the time limit under Rule 26bis.1 has expired, the applicant may request the International Bureau to publish information concerning the matter. Any such request must be made prior to the expiration of 30 months from the priority date and is subject to the payment of a special fee.

Transmittal to Another Authority of a Request for Rectification

Rule 91.1(b~~e~~)

8.09~~04~~ The following authorities are competent to authorize rectifications in the international application and associated papers:

(i) the receiving Office if the ~~error~~ mistake is in the request part of the international application or in a correction thereof,

(ii) the International Searching Authority if the ~~error~~ mistake is in the description, claims or drawings or in a correction thereof, unless the International Preliminary Examining Authority is competent under item (iii) any part of the international application other than the request or in any paper submitted to that Authority,

(iii) the International Preliminary Examining Authority if the ~~error~~ mistake is in the description, claims, drawings or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which the international preliminary examination shall start in accordance with Rule 69.1 has passed any part of the international application other than the request or in any paper submitted to that Authority,

(iv) in the case of a ~~the International Bureau if the error~~ mistake is in a document not referred to in items (i) to (iii) submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, other than a mistake in the abstract or in an amendment under Article 19 – by that Office, Authority or Bureau as the case may be any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

8.10~~05~~ If an International Authority receives a request for rectification of an obvious ~~error~~ mistake in the request or a paper for which it is not the authority competent to authorize the rectification, it transmits that request together with any proposed replacement sheet to the appropriate authority, as listed above, and informs the applicant accordingly. It may, instead of transmitting the request, inform the applicant that the request should be sent to the authority competent to rectify the ~~error~~ mistake. For the language(s) in which such request for rectification must be submitted, see Rule 12.2(b).

Invitation to the Applicant to Request Rectification

Rule 91.1(h)

8.11~~06~~ If the International Searching Authority or the International Preliminary Examining Authority discovers what appears to be an obvious ~~error~~ mistake in the international application or any other paper submitted by the applicant, it may invite (optionally using Form PCT/ISA/216 by the ISA or PCT/IPEA/411 by the IPEA) the applicant to submit a request for rectification to the Authority competent to authorize the rectification

(Rule 91.1(~~bd~~) and (~~he~~)). Although Rule 91.1(~~hd~~) allows the International Searching Authority and the International Preliminary Examining Authority to invite rectifications, it is not expected that such invitations will be issued since any ~~error mistake~~ which can be rectified under Rule 91 will not be an impediment to establishing the search report and should not affect the substance of any written opinion or international preliminary examination report.

Submission and Processing of a Request for Rectification Submitted to the International Searching Authority

Rule 91.2

8.12 A request for rectification shall be submitted to the competent authority within 26 months from the priority date. A request for rectification shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation.

Rule 91.34; Section 511

~~8.1307~~ Where a request for rectification is submitted to the International Searching Authority and the International Searching Authority is competent to authorize the rectification ~~in respect of any document other than the request Form is sought~~, the International Searching Authority considers whether the ~~error mistake~~ is rectifiable under Rule 91.1, marks the documents in accordance with Section 511 and completes Form PCT/ISA/217. The International Searching Authority forwards the request for rectification and the PCT/ISA/217 to the receiving Office, the International Bureau and the applicant.

Rule 91.1(b), (g)(i), (g-bis), (g-ter) and (g-quat)

~~8.08 Authorization of rectifications is determined solely by Rule 91.1(b) and (e) (see paragraphs 8.01 to 8.03) while Rule 91.1(g)(i), (g-bis), (g-ter) and (g-quat), determines if they are of effect (in general, where the notification of the authorization for rectification reaches the International Bureau before the completion of the technical preparations for international publication). Whether such rectifications can be effective is not a consideration in authorizing and thus of no concern to the search examiner. No authorization will be approved once publication has occurred.~~

Request for Rectification Submitted to the International Preliminary Examining Authority

Rules 66.5, 91.1(b)

~~8.1409~~ During the time of international preliminary examination ~~Subject to authorization (see paragraph 8.10),~~ a request for rectification of obvious ~~errors mistakes~~ in the international application can be made ~~at the request of~~ by the applicant of his own volition. In addition, the examiner, upon study of the international application (other than the request) and any other papers submitted by the applicant, might also note obvious ~~errors mistakes~~. ~~Although Rule 91 allows the International Preliminary Examining Authority to invite applicants to submit a request for rectification (optionally using Form PCT/IPEA/411), it is not foreseen that such invitations will be issued since any error which can be rectified under Rule 91 will not be an impediment to establishing the international preliminary examination report.~~

Rule 91.31(e), (f) and (g)(ii); Section 607

~~8.1510~~ Rectification of an obvious error cannot be made before the International Preliminary Examining Authority without the express authorization of that Authority. The Authority is permitted to authorize rectification of such errors in a part of the international application other than the request or in any papers submitted to it. The examiner may only authorize rectification of obvious errors up to the time the international preliminary examination report is established. The time within which requests for rectification can be made to that Authority

~~is limited accordingly. Any~~ The International Preliminary Examining-Authority which authorizes or refuses any rectification promptly notifies the applicant of the authorization or refusal using Form PCT/IPEA/412 and, in the case of refusal, of the reasons therefor. The International Preliminary Examining Authority marks the request as set forth in Section 607 and sends a copy of the request for rectification and the Form PCT/IPEA/412 to the International Bureau.

Authorization and Effect of Rectifications

Rule 43.6bis(a)

8.16 An authorized rectification of an obvious mistake under Rule 91.1 shall, subject to paragraph 8.17, be taken into account by the International Searching Authority for the purpose of the international search. The international search report shall indicate that the rectification has been taken into account, subject to paragraph 8.17.

Rule 43.6bis(b)

8.17 The international search report shall, if possible, indicate whether the rectification of an obvious mistake has been taken into account in the situation where the processing or examination of the international application has already started prior to the date on which that Office is notified under Rule 91.3(a) of the authorization of the rectification by the competent authority. If the report fails to indicate whether the rectification of an obvious mistake was taken into account, the International Searching Authority shall notify the International Bureau accordingly, and the International Bureau shall proceed as provided for in the Administrative Instructions.

Rule 91.3(d)

8.18 Upon applicant's request, if the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall publish the request for rectification, the reasons for the refusal by the authority and any further brief comments that may be submitted by the applicant, if possible, together with the international application. Such a request must be submitted within 2 months from the date of the refusal and is subject to the payment of a special fee.

Rule 48.2(a)(vii)

8.19 If authorization of rectification of an obvious mistake was received by the International Bureau before the completion of the technical preparations for international publication, the international publication shall include the rectification.

Rule 48.2(i)

8.20 If authorization of rectification of an obvious mistake in an international application referred to in Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for the international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2. Additionally, the front page shall be republished.

Rule 48.2(k)

8.21 If the request for the publication under Rule 91.3(d) was received by the International Bureau after completion of technical preparations for the international publication, the request for rectification of obvious mistake, any reasons and any comments shall be promptly published after the receipt of such request for publication. Additionally, the front page shall be republished.

Effective date of Rectification

Rule 91.3 (c)

8.22 Where the rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application as filed, from the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which the document was submitted.

A rectification of an obvious mistake in the international application as filed is effective from the international filing date rather than from the date the rectification is proposed. A rectification of a mistake in another document is effective from the date on which the document was submitted rather than from the date the rectification is proposed.

Chapter 9
Exclusions from, and Limitations of, International Search and International Preliminary Examination

9.01–9.38 [No change]

Rule 13ter.1(a) and (b)(e) and (e); Section 208; AI Annex C

9.39 Another situation where a meaningful search or preliminary examination is not possible may arise where the international application contains disclosure of one or more nucleotide and/or amino acid sequences but the ~~applicant does not furnish a listing of the sequence in a written form, and/or a computer readable~~ International Searching Authority does not have available to it a copy of the sequence listing in electronic form, complying with the standard provided for in Annex C of the Administrative Instructions. The International Searching Authority requests the provision of such a sequence listing as soon as possible, before the search report and written opinion are established (see paragraphs 15.11 and 15.12 and paragraph 4.15). However if the listing is not provided or is not provided in the form required by the ~~S~~standard, the Authority makes a meaningful search or preliminary examination to the extent that this is possible. For example, if a named protein is claimed, such a protein could be searched by its name rather than by its sequence. The same may occasionally apply also where a sequence listing is provided in paper form which does not comply with the standard provided for in Annex C of the Administrative Instructions and the International Searching Authority requires such a paper format for the purposes of the international search.

9.40–A9.15[2] [No change]

Chapter 10 Unity of Invention

10.01 [No change]

Rule 13.2; AI Annex B, ~~Part I~~ [paragraph \(b\)](#)

10.02 [No change to body of paragraph]

10.03 Lack of unity of invention may be directly evident “*a priori*,” that is, before considering the claims in relation to any prior art, or may only become apparent “*a posteriori*,” that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. However, if it can be established that A is known or obvious, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

10.04–10.05 [No change]

AI Annex B, ~~Part I~~ [paragraph \(c\)](#)

10.06 [No change to body of paragraph]

10.07–10.10 [No change]

Illustrations of Particular Situations

AI Annex B, ~~Part I~~ [paragraph \(d\)](#)

10.11 [No change to body of paragraph]

Combinations of Different Categories of Claims

AI Annex B, ~~Part I~~ [paragraph \(e\)](#)

10.12 [No change to body of paragraph]

10.13–10.16 [No change]

“*Markush Practice*”

AI Annex B, ~~Part I~~ [paragraph \(f\)](#)

10.17 [No change to body of paragraph]

Intermediate and Final Products

AI Annex B, ~~Part I~~ [paragraph \(g\)](#)

10.18 [No change to body of paragraph]

AI Annex B, ~~Part I~~ [paragraph \(h\)](#)

10.19 [No change to body of paragraph]

10.20–10.59 [No change]

Invitation to Pay Additional Fees

Article 17(3)(a); Rules 16, [40.1](#), [40.2](#), ~~40.3~~, [42](#)

10.60 After deciding that lack of unity exists, except in the circumstances described in paragraphs 10.64 and 10.65, the International Searching Authority informs the applicant of

the lack of unity of invention by a communication, preceding (but see paragraph 10.61, below) the issuance of the international search report and written opinion of the International Searching Authority, which contains an invitation to pay additional fees (Form PCT/ISA/206). This invitation specifies the reasons (see paragraph 10.63) for which the international application is not considered as complying with the requirement of unity of invention, identifies the separate inventions and indicates the number of additional search fees and the amount to be paid. The International Searching Authority cannot consider the application withdrawn for lack of unity of invention, nor invite the applicant to amend the claims, but informs the applicant that, if the international search report is to be drawn up in respect of those inventions present other than the first mentioned, then the additional fees must be paid within ~~a stipulated period~~ one month from the date of the invitation. If the applicant wishes to pay the additional fees under protest and a protest fee is payable (see paragraphs 10.66 to 10.70), the International Searching Authority also invites the applicant to pay any such fee within one month from the date of the invitation.

10.61 If preferred, the said invitation may be already accompanied by a notification of the result of a partial international search drawn up for those parts of the international application which relate to what is to be considered as the “first” invention. The result of the partial international search will be very useful for the applicant in deciding whether additional search fees should be paid so that further parts of the international application would be subjected to the international search. The invention(s) or group(s) of inventions, other than the one first mentioned in the claims, will be searched, subject to paragraphs 10.64 and 10.65, only if the applicant pays the additional fees. Thus, whether the lack of unity of invention is directly evident *a priori* or becomes apparent *a posteriori*, the examiner, may proceed in one of two ways: he may immediately inform the applicant of his finding and invite him to pay additional search fees and any protest fee (with Form PCT/ISA/206) and search or continue to search the invention first mentioned in the claims (“main invention”); or alternatively, he may carry out the search on the “main invention” and draw up a partial international search report which will be sent together with the invitation to pay additional search fees and any protest fee (with Form PCT/ISA/206).

10.62 Since ~~these payments must take place within a period to be set by the International Searching Authority so as to enable the observation of the time limit for establishing the international search report set by Rule 42,~~ the applicant is given one month to make these payments before any further search will be made, the International Searching Authority should endeavor to ensure that international searches be made as early as possible after the receipt of the search copy so as to enable the observation of the time limit for establishing the international search report set by Rule 42. The International Searching Authority finally draws up the international search report and written opinion on those parts of the international application which relate to inventions in respect of which the search fee and any additional search fee have been paid. The international search report (see paragraph 16.29) and written opinion (see paragraphs 17.36 and 17.37) identify the separate inventions or groups of inventions forming unity and indicate those parts of the international application for which a search has been made. If no additional search fee has been paid, the international search report and written opinion contain only the references relating to the invention first mentioned in the claims.

10.63–10.65 [No change]

Rule 40.2(c) and (e)

10.66 The applicant may protest the allegation of lack of unity of invention, or that the number of required additional fees is excessive and request a refund of the additional fee(s)

paid. If, and to the extent that, the International Searching Authority finds the protest justified, the fee(s) are refunded. (The additional search fees must be paid for any protest to be considered.) The International Searching Authority may require a protest fee to be paid in order for the protest to be considered (see paragraph 10.69).

10.67 [No change]

Rule 40.2(c) and (d)

10.68 The protest is examined by a ~~three-member board or other special instance of the International Searching Authority or any competent higher authority~~ review body constituted in the framework of the International Searching Authority, and a decision taken on it. The form of the examination process is determined by each International Searching Authority, although the review body must not be limited to the person who made the decision which is the subject of the protest. Some Authorities may review the protest in two stages, with a formal board being convened only if a preliminary review of the protest considers that the protest is not entirely justified. To the extent that the applicant's protest is found to be justified, the additional fee is totally or partly reimbursed. At the request of the applicant, the texts of both the protest and the decision on it are notified to the designated Offices by the International Bureau together with the international search report (see paragraph 10.70).

Rule 40.2(c) ~~to~~ and (e)

10.69 ~~Where the applicant has paid an additional fee under protest, the International Searching Authority may require the applicant also to pay a fee for the examination of the protest ("protest fee").~~ Details of the protest fee, if any, charged by the International Searching Authorities appear in Annex D of the *PCT Applicant's Guide*, Volume I – Introduction to the International Phase. ~~If a protest fee is chargeable by the International Searching Authority, it is only required in a particular case after a prior review of the justification for the invitation to pay additional search fees. The review should not be made by the examiner who made the finding alone. If the invitation to pay additional fees is maintained, the applicant is invited to pay the protest fee within one month from the date of the notification to the applicant of the result of the review. The notification of the result of the review, if negative, gives a technical reasoning of that result. If the protest fee is not paid within one month from the date of the invitation to pay additional fees, the protest is considered withdrawn not to have been made. The protest fee is only refunded to the applicant under Rule 40.2(e) where the ~~three-member board, special instance or higher authority~~ review body finds that the protest was entirely justified. ~~The applicant may, on the payment of the protest fee, supplement the reasoned statement which accompanied the protest, taking into consideration the result of the review.~~~~

Rule 40.2(c); Section 502

10.70 Where the applicant paid additional search fee(s) under protest, he is informed promptly (using Form PCT/ISA/212 ~~may be used for that purpose~~) of any decision about the compliance with the requirement of unity of invention. At the same time the International Searching Authority transmits to the International Bureau a copy of the protest and of the decision thereon as well as any request by the applicant to forward the texts of both the protest and the decision thereon to the designated Offices.

Process at the International Preliminary Examination Stage

Article 34(3)(a) to (c); Rule 68

10.71 The procedure before the International Preliminary Examining Authority regarding lack of unity of invention is governed by Article 34(3)(a) to (c) and Rule 68 (see also Rule 70.13). This procedure is more fully explained in paragraphs 10.74 to 10.7682. It

should be noted that in most instances lack of unity of invention will have been noted and reported upon by the International Searching Authority, which will have drawn up an international search report and written opinion based on those parts of the international application relating to the invention, or unified linked group of inventions, first mentioned in the claims (“main invention”), unless the applicant has paid additional fees.

10.72–10.73 [No change]

Rule 68.2, 68.3

10.74 Where the examiner finds a lack of unity of invention, a communication may, at the option of the examiner (see paragraph 10.76), be sent to the applicant, using Form PCT/IPEA/405, informing him why there is a lack of unity of invention and inviting him, within ~~a period stated in the invitation (the period may be between one and two months from the date of the invitation)~~, either to restrict the claims or to pay an additional fee for each additional invention claimed. Where such a communication is sent, at least one possible restriction, which would avoid the objection of lack of unity of invention, is indicated by the examiner. In the invitation to pay additional fees, the examiner sets out a logically presented, technical reasoning containing the basic considerations behind the finding of lack of unity in accordance with these Guidelines. Where a protest fee is payable if the applicant wishes to pay the additional fees under protest (see paragraphs 10.78 to 10.82), the International Preliminary Examining Authority also invites the applicant to pay any such fee within one month from the date of the invitation.

10.75 [No change]

Rule 68.1, 68.3(e) to (e); Section 603

10.76 However, there are cases of lack of unity of invention where, compared with the procedure of inviting the applicant to restrict the claims or to pay additional fees (Rule 68.2), no or little additional effort is involved in establishing the international preliminary examination report for the entire international application. Then, reasons of economy may make it advisable for the examiner to avail himself of the option referred to in Rule 68.1 by choosing not to invite the applicant to restrict the claims or to pay additional fees. In this situation, he carries out his preliminary examination and establishes the international preliminary examination report on the entire international application, but indicates, when establishing the report, his opinion that the requirement of unity of invention is not fulfilled and the reasons therefore.

10.77 [No change]

Protest Procedure

~~10.78 Where the applicant has paid an additional fee under protest, the International Preliminary Examining Authority may require the applicant also to pay a fee for the examination of the protest (“protest fee”). Details of the protest fee, if any, charged by the International Preliminary Examining Authorities appear in Annex E of the PCT Applicant’s Guide, Volume I—Introduction to the International Phase. If a protest fee is chargeable by the International Preliminary Examining Authority, it is only required in a particular case after a prior review of the justification for the invitation to pay additional fees. The review should not be made by the examiner who made the finding alone. If the invitation to pay additional fees is maintained, the applicant is invited to pay the protest fee within one month from the date of the notification to the applicant of the result of the review. The notification of the result of the review, if negative, gives a technical reasoning of that result. If the protest fee is not paid, the protest is considered withdrawn. The protest fee is refunded to the applicant~~

~~under Rule 68.3(e) where the three member board, special instance or higher authority finds that the protest was entirely justified. The applicant may, on the payment of the protest fee, supplement the reasoned statement which accompanied the protest, taking into consideration the result of the review.~~

Rule 68.3(c)

10.78 The applicant may protest the allegation of lack of unity of invention or that the number of required additional fees is excessive and request a refund of the additional fees paid. If, and to the extent that, the International Preliminary Examining Authority finds the protest justified, the fees are refunded. (The additional examination fees must be paid for any protest to be considered.) The International Preliminary Examining Authority may require a protest fee to be paid in order for the protest to be considered (see paragraph 10.81).

Rule 68.3(c)

10.79 Protest of allegation of lack of unity is in the form of a reasoned statement accompanying payment of the additional fee, explaining why the applicant believes that the requirements of unity of invention are fulfilled and fully taking into account the reasons indicated in the invitation to pay additional fees issued by the International Preliminary Examining Authority.

Rule 68.3(c) and (d)

10.80 The protest is examined by a review body constituted in the framework of the International Preliminary Examining Authority, and a decision taken on it. The form of the examination process is determined by each International Preliminary Examining Authority, although the review body must not be limited to the person who made the decision which is the subject of the protest. Some Authorities may review the protest in two stages, with a formal board being convened only if a preliminary review of the protest considers that the protest is not entirely justified. To the extent that the applicant's protest is found to be justified, the additional fee is totally or partly reimbursed. At the request of the applicant, the texts of both the protest and the decision on it are notified to the elected Offices by the International Bureau as an annex to the international preliminary examination report (see paragraph 10.82).

Rule 68.3(e)

10.81 Details of the protest fee, if any, charged by the International Preliminary Examining Authorities appear in Annex E of the PCT Applicant's Guide, Volume I – Introduction to the International Phase. If the protest fee is not paid within one month from the date of the invitation to pay, the protest is considered not to have been made. The protest fee is only refunded to the applicant under Rule 68.3(e) where the review body finds that the protest was entirely justified.

Rule 68.3(c); Section 603

10.82 Where the applicant paid additional examination fees under protest, he is informed promptly (using Form PCT/IPEA/420) of any decision about the compliance with the requirement of unity of invention. At the same time the International Preliminary Examining Authority transmits to the International Bureau a copy of the protest and of the decision thereon as well as any request by the applicant to forward the texts of both the protest and the decision thereon to the elected Offices.

Chapter 11 Prior Art

11.01 [No change]

Rules 2.4, 33.1, 43bis.1, and 64.1

11.02 It should be noted that the definition of relevant prior art for purposes of international search report is different from the definition of relevant prior art for other purposes, including the written opinion established by the International Searching Authority because “relevant date” is defined differently for international search report purposes and for written opinion and international preliminary examination purposes.

11.03 [No change]

11.04 For the purposes of the written opinion and international preliminary examination, Rule 64.1 defines the relevant date as:

(i) subject to items (ii) and (iii), the international filing date of the international application under international preliminary examination (or, in conjunction with Rule 43bis.1(b), for which a written opinion is being established by the International Searching Authority); ~~or~~

(ii) where the international application claims the priority of an earlier application and has an international filing date which is within the priority period (12 months from the filing date), the filing date of such earlier application, unless the International Authority considers that the priority claim is not valid; ~~where that international application validly claims the priority of an earlier application, the filing date of such earlier application.~~

(iii) where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

11.05–11.26 [No change]

Chapter 12
[No change]

Chapter 13
[No change]

Chapter 14
[No change]

Chapter 15 The International Search

15.01–15.09 [No change]

Article 19; Rules 5.2, 13ter, 91.1; Section 208, AI Part 8, AI Annex C

15.10 There is no right to amend the application until after the international search has been established, consequently the international search must be carried out on the basis of the search copy of the application as transmitted to the International Searching Authority by the receiving Office, except that obvious ~~errors~~ mistakes may be corrected (see chapter 8).

Rule 13ter.1; Section 513

15.11 If the application contains disclosure of one or more nucleotide and/or amino acid sequences but does not contain a sequence listing complying with the relevant standard (see paragraph 4.15) or contains the sequence listing only in paper form, the International Searching Authority may invite the applicant (with Form PCT/ISA/225) to furnish, within a fixed time limit, a sequence listing in ~~written paper~~ form and/or in ~~computer-readable~~ electronic form complying with the standard for purposes of completion of the international search. The furnishing of a sequence listing in response to an invitation by the International Searching Authority may be subject to the payment of a fee set by the International Searching Authority, which may not exceed 25% of the international filing fee (not taking into account any fee for each sheet of the international application in excess of 30 sheets). If the applicant complies with the invitation, the International Searching Authority proceeds with the completion of the international search, the international search report, and the written opinion on the basis of the ~~written paper~~ and/or ~~computer-readable~~ electronic forms of the sequence listing provided. However, any sequence listing not contained in the international application as filed will not, subject to Article 34, form part of the international application, but will be used as a search tool. The Authority marks the first sheet of any such listing provided in paper form “SUBSEQUENTLY FURNISHED SEQUENCE LISTING” or their equivalent in the language of publication of the international application. If the applicant does not comply with the invitation within the time limit or if the response to the invitation does not comply with the standard, the International Searching Authority is ~~not required to carry out the international search to the extent that such non-compliance has the result that a meaningful search cannot be carried out~~ only be required to search the international application to the extent that a meaningful search can be carried out without the sequence listing.

Rules 5.2(b), 13ter.1(d,f); Section 513; AI Annex C

15.12 Where the sequence listing part of the description contains free text as defined in the standard provided for in Annex C of the Administrative Instructions, but that free text does not also appear in the main part of the description in the language thereof, the International Searching Authority invites the applicant (with Form PCT/ISA/233) to correct the application by adding the free text to the main part of the description. If the applicant complies with the invitation, the International Searching Authority marks the replacement sheet with the words “SUBSTITUTE SHEET (RULE 13ter.1(d,f))” or their equivalent in the language of publication of the international application and the date of receipt, and transmits the substitute sheets containing that free text to the receiving Office and the International Bureau for inclusion of the sheets concerned in the home copy and the record copy, respectively; it keeps a copy of those sheets for inclusion in the search copy. If the applicant does not comply with the invitation, the International Searching Authority nevertheless continues to perform the international search.

15.13–15.18 [No change]

15.19 Since the applicant is not permitted to amend the claims before receiving the international search report, except to rectify obvious ~~errors~~ mistakes or to correct formal matters which are contrary to the PCT and are called to the applicant's attention by the receiving Office, the international search is directed to the claims as filed. See paragraph 15.21.

15.20–15.29 [No change]

Obvious ~~Errors~~ Mistakes and Matter Contrary to Public Order

Rules 9.1, 9.2, 91.1, 33.3(b); Sections 501, 511(a)(v)

15.30 If the examiner notices any obvious ~~error~~ mistake in the international application, the International Searching Authority may invite (optionally using Form PCT/ISA/216, see paragraph 8.06) the applicant to request the rectification of the error.

15.31–15.70 [No change]

Chapter 16 International Search Report

16.01–16.11 [No change]

Filling Out the Notification of Transmittal of the International Search Report or the Declaration, and of the Written Opinion of the International Searching Authority, of the Declaration (Form PCT/ISA/220)

Address for Correspondence

16.12–16.23 [No change]

Nucleotide and/or Amino Acid Sequence Listings and Related Tables

16.24 Where the application discloses any nucleotide and/or amino acid, box 1.b of the first sheet is checked and Box No. I (appearing on “continuation of first sheet (1)”) indicates the form (that is, whether in paper copy or ~~computer-readable~~ electronic form) and status (that is, whether filed with the international application or later, for the purposes of search) of the sequence listing, and any related tables, that the search was carried out on. See paragraphs 4.15 and 15.11 for further details.

16.25–16.47 [No change]

Classification of Subject Matter

16.48 [No change to body of paragraph]

Rule 43.36(a)

16.49 [No change to body of paragraph]

Rule 43.6(a)

16.50–16.65 [No change]

Documents relating to the theory or principle underlying the invention

Section 507(e)

16.66 Where any document cited in the search report is a document whose publication date occurred after the filing date or the priority date of the international application and is not in conflict with the said application, but which may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it is indicated by the letter “T”.

Potentially conflicting patent documents

Section 507(b)

16.67 Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date) but published later than that date and the content of which would constitute prior art relevant to novelty (Article 33(2)) or inventive step (Article 33(3)) is indicated by the letter “E” (see section 507(b) and Rule 33.1(c)). Where the patent document and the application searched have the same date, the patent document is also identified by the letter “E”. An exception is made for patent documents based on the priority under consideration.

16.68–16.80 [No change]

Chapter 17

Content of Written Opinions and the International Preliminary Examination Report

17.01–17.03 [No change]

Different Types of Opinion and Report

Written Opinion of the International Searching Authority

Rule 43bis, 66.1bis

17.04 A written opinion will be issued by the International Searching Authority together with the international search report [or the declaration under Article 17\(2\)\(a\) that no international search report will be established](#). This will normally be treated as the first written opinion of the International Preliminary Examining Authority under Article 34(2) in the event that international preliminary examination is demanded and, as such, the opinion will include an invitation to submit a response, together with a time-limit (see Rules 43bis.1(c) and 54bis.1(a)) for that response, if the applicant wishes to demand international preliminary examination. However International Preliminary Examining Authorities may notify the International Bureau that this will not be the case for written opinions issued by specified International Searching Authorities other than themselves. Such notifications are published by the International Bureau in the Gazette.

17.05–17.09 [No change]

Form of Opinion or Report

17.10 Written opinions are established in a standard format using Form PCT/ISA/237 (for the opinion of an International Searching Authority) or PCT/IPEA/408 (for an opinion of the International Preliminary Examining Authority). International preliminary examination reports (given the title “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)”) are established using Form PCT/IPEA/409. Apart from the cover sheet, containing generally bibliographic details and any notification of action that the applicant may be invited to take, these follow the same format, including whichever of the following parts are appropriate to the particular international application:

- (i) Basis of the opinion or report;
- (ii) Priority;
- (iii) Non-establishment of opinion with regard to novelty, inventive step and industrial applicability;
- (iv) Lack of unity of invention;
- (v) Reasoned statement under Rule 66.2(a)(ii) or Article 35(2) with regard to novelty, inventive step or industrial applicability and citations supporting such statement;
- (vi) Certain documents cited;
- (vii) Certain defects in the international application;
- (viii) Certain observations on the international application.

Sheets which have not been filled in (blank sheets) are to be omitted from the Opinion or Report, and are not to be included in the total number of sheets listed under item 2 of the cover sheet.

17.11–17.14 [No change]

Language Considerations

Rules 23.1 (b), 48.3(b), 55.2 and 55.3

17.15 With regard to the language, item 1 of Box No. I ~~need not be filled if all the elements of the application (originally filed sheets and amended sheets, if any) were available or furnished to the International Authority in the language in which the international application was filed. Otherwise,~~ an appropriate indication must be checked as to whether the elements were available or furnished to the International Authority in the language which is:

(i) the language of a translation furnished for the purposes of international search (under Rule 23.1(b));

(ii) the language of publication of the international application (under Rule 48.3(b));
or

(iii) the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

For further discussions of language, refer to chapter 18.

17.16–17.20 [No change]

– Nucleotide and/or Amino Acid Sequence Listings

17.21 With regard to any nucleotide and/or amino acid sequence listing, one or more of the following indications must be given with respect to the sequence listing, and/or tables related thereto, on which the examination is based, either in item 2 of Box No. I (for the written opinion of the International Searching Authority) or in item 1 of the Supplemental Box Relating to Sequence Listings (in written opinions of the International Preliminary Examining Authority or the international preliminary examination report):

(a) the type of material (sequence listing only or also related tables);

(b) format of material (~~written or computer readable~~ paper or electronic form); and

(c) the time of filing or furnishing (contained in the application as originally filed, filed together with the international application in ~~computer readable~~ electronic form, subsequently furnished for the purposes or search and/or examination, or filed as an amendment).

Where more than one version or copy of a sequence listing and/or table related thereto has been filed, the check box under item 2 (or item 3 of Box No. 1 of the written opinion of the International Searching Authority) is used to indicate whether the required statements were included, that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed. For further discussions of the nucleotide and/or amino acid sequence listings, refer to chapter 18.

17.22–17.24 [No change]

Box No. II: Priority

17.25 This part of the opinion or report is not relevant if the international application does not claim priority. Furthermore, where priority is claimed, but the citations in the international search report were all published before the earliest priority date, it is not necessary to consider whether the priority claim is valid (see chapter 6). In either of these cases, this Box should not normally be included in the opinion or report.

17.26 Where one or more citations of the international search report were published after the earliest priority date, the validity of that earliest priority date requires checking. (See paragraph 6.03 for formal requirements for validity and paragraph 6.05 for substantive requirements for validity.)

(a)–(d) [No change]

17.27 [No change]

17.28 “Additional observations” in item 3 of Box No. II relate to Priority considerations only and not to clarity, descriptive support, defects or any other consideration relevant to Box No. VIII. Such observations might include the reasons for which a priority claim was considered to be invalid[, or else an indication that the priority claim had been checked and was considered to be valid].

Article 17(2)(a)(i); Rules 43bis.1, 67

17.29 This part of the opinion or report explains why an opinion as regards novelty, inventive step and industrial applicability may not have been established for some or all of the subject matter of the international application for any reason other than because the international application lacks unity of invention and the required additional fees have not been paid (this is dealt with in Box No. IV, see paragraphs 17.36 to 17.39). For example, Rules 43bis.1(b) and 67.1 establish that no International Authority shall be required to examine certain subject matter within an international application, such as mathematical theories, plant or animal varieties and methods for treatment of the human or animal body. The agreements between the International Bureau and the International Preliminary Examining Authorities further qualify this by excepting from exclusion any subject matter which is examined under the relevant national grant procedures. See paragraph 17.58 and chapter 9 for details of excluded matter. The first two check boxes of Box No. III are used to indicate the extent to which no opinion has been established.

17.30–17.34 [No change]

Nucleotide and/or Amino Acid Sequence Listings

AI Annexes C, C-bis

17.35 A failure to supply nucleotide and/or amino acid sequence listing information, or have it comply with the Administrative Instructions standards, may preclude any meaningful preliminary examination from being carried out. Refer to chapter 15 (search stage) and chapter 18 (examination stage) for discussion of the nucleotide and/or amino acid sequence listings. A submission in electronic form of tables relating to the sequence listings not in compliance with the Annex C-bis of the Administrative Instructions may also preclude any meaningful preliminary examination from being carried out (see Box No. III, ~~item 3~~). In either case the Authority should make a meaningful search or preliminary examination to the extent that it is possible, but if some or all claims cannot be examined, the reasons are noted

in the final check boxes of Box No. III, and details may be provided in the Supplemental Box if necessary.

17.36 [No change]

Article 34(3); Rule 70.13

17.37 If the applicant has paid additional fees before the International Searching Authority or the International Preliminary Examining Authority, or has restricted the claims before the International Preliminary Examining Authority in response to an invitation to do so, or if the applicant has failed to respond to the invitation to pay additional fees or restrict the claims (see paragraphs 10.74 to 10.78), this is also indicated in the opinion or report. The possible indications (some of which are not relevant to the written opinion of the International Searching Authority) are that:

(i) the claims have been restricted before the International Preliminary Examining Authority;

(ii) additional fees have been paid without protest;

(iii) additional fees have been paid by the applicant under protest and where applicable, the protest fee was paid;

(iv) additional fees have been paid by the applicant under protest but the applicable protest fee was not paid

~~(v)~~ (iv) the applicant has neither restricted the claims nor paid additional fees;

~~(vi)~~ (v) the examiner was of the opinion that the international application did not comply with the requirement of unity of invention but decided not to issue an invitation to restrict the claims or pay additional fees.

17.38–17.43 [No change]

Rule 70.7(b), 70.10; Section 507(b)

17.44 The examiner also mentions, as such, any published application or any patent referred to in the report by virtue of Rule 64.3 and provides for each such published application or patent the following indications:

(i) its date of publication;

(ii) its filing date, and its claimed priority date (if any);

~~(iii) placing the letter “E” next to the citation.~~

Rule 70.10~~2(b)~~

17.45 The report may also indicate that, in the opinion of the International Searching Authority or the International Preliminary Examining Authority, the priority date of **the such published application or patent is not valid** ~~international application has not been validly claimed (see also paragraph 17.26).~~

17.46 [No change]

Box No. VII: Certain Defects in the International Application

Rule 70.12, [paragraph 17.09\(iii\)](#)

17.47 If, in the opinion of the examiner, defects exist in the form or contents of the international application ([for example, failure to comply with one or more of the requirements specified in Rules 5 to 11](#)), the examiner includes this opinion in Box No. VII of the written opinion and/or examination report and also indicates the reasons therefore (see also paragraphs 17.09, 17.13 and 17.14).

Box No. VIII: Certain Observations on the International Application

Rule 70.12, [paragraph 17.09\(v\)](#)

17.48 If, in the opinion of the examiner, observations should be made as to the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description ([for example, failure to comply with one or more of the requirements specified in Articles 5 and 6](#)), the examiner includes these observations in the written opinion and/or examination report and also indicates the reasons therefor (see also paragraphs 5.31 to 5.58 and 17.09).

17.49 [No change]

Language of the Written Opinion and the International Preliminary Examination Report

Rules 48.3(a) and (b), 70.17~~(e)~~

17.50 [No change to body of paragraph]

17.51–17.70 [No change]

Chapter 18 Preliminary Procedure on Receipt of the Demand

18.01–18.03 [No change]

Article 34; Rules 60.1(g), 69.1(e); Section 602(a)(i) to (iii) and (b)

18.04 Where the international preliminary examination is to take into account amendments under Article 34, but the applicant failed to submit them with the demand, the International Preliminary Examining Authority invites the applicant (Form PCT/IPEA/431) within a reasonable time limit fixed in the invitation to submit the amendments. Whether the amendments are submitted with the demand or subsequently, they are marked in accordance with Section 602(a)(i) to (iii) and (b) of the Administrative Instructions before the file is **then** forwarded to the examiner.

18.05 [No change]

Article 19; Rules 46.1, 53.9(b), 69.1(d)

18.06 If the International Searching Authority is also to act as International Preliminary Examining Authority and wishes to start the international preliminary examination at the same time as the international search in accordance with Rule 69.1(b), but the demand includes a statement that the start of the international preliminary examination is to be postponed under Rule 53.9(b) ~~because the time limit for filing amendments under Article 19, as provided in Rule 46.1, has not expired~~, the International Preliminary Examining Authority waits until it receives a copy of any amendments made under Article 19 or a notice from the applicant that he does not wish to make amendments under Article 19 before beginning the international preliminary examination. Where neither a copy of the amendments nor a notice has reached the International Preliminary Examining Authority by the expiration of 22 16 months from the priority date or ~~three~~ two months from the date of transmittal of the international search report, whichever expires later (the time limit in accordance with Rule 46.1 for filing amendments under Article 19), examination starts on the basis of the documents in the file.

18.07–18.08 [No change]

Rule 55.2(c), 55.3(b)

18.09 Where the international preliminary examination is to be carried out on the basis of a translation of the international application and/or of amendments, but the applicant failed to submit them with the demand, the International Preliminary Examining Authority invites the applicant (Form PCT/IPEA/443) to submit the missing items within a reasonable time limit fixed in the invitation. Whether the sheets containing the translation and/or amendments are submitted with the demand or subsequently, they are marked in accordance with Section 602(a)(i) to (iii) and (b) of the Administrative Instructions before the file is **then** forwarded to the examiner.

18.10–18.11 [No change]

18.12 In the cases where the international search has been performed by an International Searching Authority which is not part of the same national Office or intergovernmental organization as the International Preliminary Examining Authority, the various elements of the file making up the international application will be supplied to the International Preliminary Examining Authority as follows:

- (i) demand: by the applicant;

Article 31(6)(a)

(ii) request, description, drawings (if any), claims, and sequence listing filed under the provisions of Section 801 (if applicable), as originally filed: by the International Bureau;

Rule 43bis

(iii) the international search report [or declaration under Article 17\(2\)\(a\)](#), and [the written opinion established under Rule 43bis.1](#) ~~or declaration under Article 17(2)(a)~~: by the International Bureau;

Rule 55.2

(iv) where neither the language in which the international application is filed nor the language in which the international application is published is accepted by the International Preliminary Examining Authority, a translation of the international application into a language which is both a language accepted by the International Preliminary Examining Authority and a language of publication: by the applicant (see, however, paragraph 18.11);

Rule 62

(v) amendments and statement under Article 19 (if any): where the applicant has marked the appropriate check box in Box No. IV of the demand (Form PCT/IPEA/401) that amendments under Article 19 are to be taken into account, the International Preliminary Examining Authority indicates on the last sheet of the demand whether a copy of such amendments was actually received with the demand. Where no copy of the amendments under Article 19 was received with the demand, a copy of such amendment will be transmitted by the International Bureau promptly after that Bureau receives the demand. If no amendments under Article 19 have been made at the time when the demand is received by the International Bureau, the International Preliminary Examining Authority is so informed by the International Bureau. If, at the time of filing such amendments, the demand has already been submitted, the applicant should also submit a copy of such amendments to the International Preliminary Examining Authority. In any event, the International Bureau will promptly transmit a copy of any amendments under Article 19 to the International Preliminary Examining Authority;

Rule 13ter.1; Section 208; AI Annex C

(vi) nucleotide and/or amino acid sequence listing in ~~written paper~~ form and/or in ~~computer readable~~ [electronic](#) form, both forms complying with the standard provided for in Annex C of the Administrative Instructions: where the International Searching Authority and the International Preliminary Examining Authority are part of the same national Office or intergovernmental organization, by the International Searching Authority; otherwise, by the applicant;

Rule 66.1

(vii) amendments according to Article 34(2)(b): by the applicant;

(viii) copies of any documents cited in the international search report which are not available from the databases of the International Preliminary Examining Authority: by the International Searching Authority;

Rule 66.7(a)

(ix) priority document: by the International Bureau;

Rule 66.7(b)

(x) translation of the priority document where required: by the applicant (subject to an invitation to furnish the translation having been made, see paragraph 18.16).

18.13 The examiner should keep in mind that the documents making up the international application may contain, instead of an international search report, the a declaration referred to in-according to Article 17(2)(a) ~~instead of an international search report, and written opinion of the International Searching Authority~~, that is, the a declaration of by the International Searching Authority that it considers that the international application relates to a subject matter which it was not required to search and decided not to search, or that the description, the claims, or the drawings failed to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out. In this case, the examiner should appraise the declaration as if it were the international search report.

18.14–18.16 [No change]

Nucleotide and/or Amino Acid Sequence Listings

~~Rule 13ter.1(a), (c) and (e);~~ Section 208; AI Part 8; AI Annex C

18.17 Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences and a corresponding sequence listing in written paper form and in computer readable electronic form (both forms complying with the standard provided for in Annex C of the Administrative Instructions) the International Preliminary Examining Authority carries out the international preliminary examination on the basis of those listings. Instead of a written paper form, the sequence listing may be provided on an electronic medium under the provisions of Section 801 of the Administrative Instructions (see paragraph 4.15).

~~Rules 13ter.1(a), (c) and (e), 13ter.2;~~ Section 208; AI Annex C

18.18 Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences but does not contain a corresponding sequence listing in written paper form and/or in computer readable electronic form complying with the standard provided for in Annex C of the Administrative Instructions, the International Preliminary Examining Authority may invite the applicant (with Form PCT/41PEA/441) to furnish to it, within a time limit fixed in the invitation, a sequence listing in written paper form and/or computer readable electronic form, as the case may be, complying with the standard. The furnishing of a sequence listing in response to an invitation by the International Preliminary Examining Authority may be subject to the payment of a fee set by the International Preliminary Examining Authority, which may not exceed 25% of the international filing fee (not taking into account any fee for each sheet of the international application in excess of 30 sheets). If the applicant complies with the invitation, the procedure outlined in the preceding paragraph applies. If the applicant does not comply with the invitation within the time limit or the response to the invitation is defective, the International Preliminary Examining Authority is not only required to carry out the international preliminary examination to the extent that such non-compliance has the result that a meaningful examination can ~~not~~ be carried out without the sequence listing (see paragraph 9.39).

Chapter 19

Examination Procedure Before The International Preliminary Examining Authority

19.01–19.06 [No change]

Start of Examination

Rule 69.1

~~19.07—The International Preliminary Examining Authority starts the international preliminary examination when it is in possession of the demand; if the applicant is required to furnish a translation under Rule 55.2, that translation; and of either the international search report and the written opinion established under Rule 43bis.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, provided that the International Preliminary Examining Authority does not start the international preliminary examination before the expiration of the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date unless the applicant expressly requests an earlier start, with the exception of the following situations:~~

~~(a)—If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes, start at the same time as the international search, provided that the examination is not to be postponed according to the statement concerning amendments.~~

~~(b)—Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned. These will be transmitted to the International Preliminary Examining Authority by the International Bureau. If a demand for international preliminary examination has already been submitted, the applicant should preferably, at the time he files the Article 19 amendments with the International Bureau, also file a copy of the amendments with the International Preliminary Examining Authority.~~

~~(c)—Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority does not start the international preliminary examination before:~~

~~(i)—it has received a copy of any amendments made under Article 19;~~

~~(ii)—it has received a notice from the applicant that he does not wish to make amendments under Article 19; or~~

~~(iii)—the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date;~~

~~whichever occurs first.~~

~~(d) — Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.~~

Rule 69.1

19.07 The International Preliminary Examining Authority normally starts the international preliminary examination (see Chapter 19) when:

(a) it is in possession of:

(i) the demand;

(ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2;

(iii) if the applicant is required to furnish a translation under Rule 55.2, that translation; and

(iv) either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, and the written opinion established under Rule 43bis.1;

and

(b) the time limit within which the applicant was permitted to file the demand (see paragraph 3.07) has expired, or earlier if the applicant has expressly requested an earlier start.

19.07.1 The exceptions to the above are as follows:

Rule 69.1(c)

(a) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned.

Rule 69.1(e)

(b) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) (see paragraph 18.04) has expired, whichever occurs first.

Rule 69.1(b) and (d)

(c) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes, start at the same time as the international search (subject to the possible need to invite the applicant to provide copies of amendments under Article 34, as noted in paragraph (b), above), provided that the applicant has not indicated (under Rule 53.9(b)) in the statement of amendments that examination is to be postponed until after the

expiry of the time limit for filing amendments under Article 19 (such amendments only being permitted after the international search report has been received). Where the statement concerning amendments contains such an indication that the start of the international preliminary examination is to be postponed, the International Preliminary Examining Authority does not start the international preliminary examination until it has received a copy of any amendments made under Article 19, or a subsequent notice from the applicant that he does not wish to make amendments under Article 19, or the time limit under Rule 46.1 for filing Article 19 amendments has expired, whichever occurs first.

19.08–19.21 [No change]

19.22 Where a response to a written opinion is received in the form of arguments only, the written opinion is reconsidered in the light of those arguments. Where the response includes some amendments, other than rectification of obvious ~~errors~~ mistakes (Rule 66.5), the amended description, drawings, and/or claims are considered as in paragraphs 20.04 to 20.22. In such a case the international preliminary examination report should indicate that the applicant's arguments have been taken in account in establishing the international preliminary examination report. In addition, the examiner should comment on any relevant arguments made by the applicant.

19.23–19.27 [No change]

Rectification of Obvious ~~Errors~~ Mistakes

Rules 66.5, 91.2~~(b)~~

19.28 ~~Errors~~ Mistakes which are due to the fact that something other than that which was obviously intended was written in the contents of the international application (other than the request) or other paper submitted to the International Preliminary Examining Authority (for example, linguistic errors, spelling errors) may ~~usually be rectified at any time during international preliminary examination~~ be rectified if a request for rectification is submitted within 26 months from the priority date. If a correction is not of this character (for example, if it involves cancellation of claims, omission of passages in the description or omission of certain drawings), it ~~is treated by the examiner as an amendment and dealt with on that basis would not be authorized by the Authority~~ (see paragraph 20.09 and chapter 8).

Rule 91.1(a), (b), and (h)~~(d)~~

19.29 Subject to authorization (see paragraph 19.30), rectification of obvious ~~errors~~ mistakes in the international application can be made at the request of the applicant on his own volition. In addition, the examiner, upon study of the international application (other than the request) and any other papers submitted by the applicant, might also note obvious ~~errors~~ mistakes. (See chapter 8). Although Rule 91 allows the International Preliminary Examining Authority to invite the applicant to submit a request for rectifications, it is not foreseen that such invitations will be issued since any ~~error~~ mistake which can be rectified under Rule 91 will not be an impediment to establishing the international preliminary examination report.

Rule 91.1(a) and (b)~~(e), (f) and (g)(ii)~~ and 91.2; Section 607

19.30 Rectification of an obvious ~~error~~ mistake cannot be made before the International Preliminary Examining Authority without the express authorization of that Authority. The Authority is permitted to authorize rectification of such ~~errors~~ mistakes in a part of the international application other than the request or in any papers submitted to it. The Authority may only authorize rectification of obvious errors ~~up to the time the international preliminary examination report is established~~ if a request for rectification is submitted within 26 months from the priority date. See paragraph 8.13~~10~~.

Rule 66.1(d-bis)

19.31 A rectification of an obvious mistake that is authorized under Rule 91.1 shall be taken into account by the International Preliminary Examining Authority for the purposes of the international preliminary examination, subject to paragraph 19.32 below.

Rule 66.4bis

19.32 A rectification of obvious mistakes need not be taken into account by the International Preliminary Examining Authority for purposes of the written opinion or the international preliminary examination report if they are received by, authorized by or notified to that Authority after it has begun to draw up that opinion or report.

Informal Communication with the Applicant

Current paragraphs 19.31–19.38 are to be renumbered 19.33–19.40 respectively.

Article 35(1), 47(1)

19.41³⁹ When it is a matter for the Authority to determine applicable time limits referred to in the PCT, the examiner must consult all the factors relevant to the particular international application under consideration as well as the Regulations under the PCT which govern such time limits. The most important time limits for international preliminary examination so far as International Preliminary Examining Authorities are concerned, have been considered in more detail in the various chapters and paragraphs as follows:

(i) and (ii) [No change]

(iii) rectifications of obvious ~~errors~~ mistakes: see paragraph 19.30 and chapter 8;

(iv) – (vii) [No change]

Current paragraphs 19.40–19.42 are to be renumbered 19.42–19.44 respectively.

Chapter 20

Amendments

20.01–20.03 [No change]

20.04 Any change, other than the rectification of obvious ~~errors~~ mistakes, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings is considered an amendment. Any amendment to the international application must be submitted in the language in which the international preliminary examination is carried out.

20.05–A20.21[2] [No change]

Chapter 21
[No change]

Chapter 22 Clerical and Administrative Procedures

22.01–22.02 [No change]

Rule 59.3(a), (c) and (f)

22.03 The non-competent International Preliminary Examining Authority may, instead, choose to transmit the demand directly to the competent International Preliminary Examining Authority. In such a case, if only one International Preliminary Examining Authority is competent, it transmits the demand to that Authority and notifies the applicant accordingly, using Form PCT/IPEA/436. If two or more International Preliminary Examining Authorities are competent, it must first invite the applicant to indicate, within the time limit applicable under Rule 54bis.1(a), that is, 3 months from the date of transmittal of the international search report ~~and the written opinion under Rule 43bis.1(a)~~, or the declaration referred to in Article 17(2)(a), and the written opinion under Rule 43bis.1(a), or 22 months from the priority date, or 15 days from the date of the invitation, whichever is later, to which one of those Authorities the demand should be transmitted (using Form PCT/IPEA/442). If the applicant responds to the invitation, the non-competent International Preliminary Examining Authority promptly transmits the demand to the competent Authority specified by the applicant and notifies the applicant accordingly. If the applicant does not respond, or responds after the expiration of the time limit, the non-competent International Preliminary Examining Authority declares that the demand is considered as if it had not been submitted and notifies the applicant accordingly, using Form PCT/IPEA/407. If the demand is filed with the receiving Office, International Searching Authority or International Bureau, that body follows the same procedure specified above for the non-competent International Preliminary Examining Authority, except that the forms used are Forms PCT/RO/153, PCT/ISA/234 and PCT/IB/368, respectively.

22.04–22.13 [No change]

Checking Whether Demand Is Timely Filed

Rule 54bis

22.14 The International Preliminary Examining Authority checks to see that the demand is filed within three months from the date of transmittal of the international search report ~~and the written opinion established under Rule 43bis.1~~, or ~~of~~ the declaration referred to in Article 17(2)(a), and the written opinion established under Rule 43bis.1; or 22 months from the priority date, whichever expires later. If the demand is filed later, the International Preliminary Examining Authority considers the demand as having not been submitted and issues a declaration to that effect by sending a copy of Form PCT/IPEA/407 to the applicant and the International Bureau. If the demand is timely filed, the International Preliminary Examining Authority notifies the applicant accordingly (Form PCT/IPEA/402).

22.15–22.36 [No change]

Invitation to Correct Defects in the Demand

Rules 53, 55, 60.1(a), (a-ter) and (b)

22.37 If the International Preliminary Examining Authority finds one or more defects referred to in Rule 60.1(a) ~~and (b)~~, it invites the applicant to correct the defects within a time limit which is reasonable in the circumstances and at least one month from the date of the invitation (Form PCT/IPEA/404). The International Preliminary Examining Authority notifies the International Bureau by sending it a copy of the invitation. Where the defect

consists of the lack of the signature of at least one applicant (see paragraph 22.28), the International Preliminary Examining Authority may include with the invitation to correct, a copy of the last sheet of the demand which the applicant returns after affixing thereto the prescribed signature. Where the defect consists of the lack of the signature on the demand and the demand is filed with an International Preliminary Examining Authority which has waived the requirement for a separate power of attorney, the International Preliminary Examining Authority may include with the invitation to correct, a copy of the last sheet of the demand which the agent returns after signing.

Rule 60.1(b) and (d); Section 602(a)

22.38 Upon receipt of a letter containing a correction or accompanying a replacement sheet of the demand the International Preliminary Examining Authority marks on that letter and any accompanying sheets the date on which they were received. It verifies the identity of the contents of any replacement sheet of the demand with that of the replaced sheet ([see paragraphs 22.40 and 22.41 for the consequences of this check](#)). ~~If the applicant complies with the invitation within the time limit, the demand is considered as if it had been received on the actual filing date provided that the demand as submitted permitted the international application to be identified.~~—The International Preliminary Examining Authority marks in the upper right-hand corner of the replacement sheet, the international application number and the date on which the replacement sheet was received and, in the middle of the bottom margin, the words “~~AMENDED-SUBSTITUTE SHEET~~ [\(RULE 60.1\)](#).” It keeps in its files a copy of any letter and any replacement sheet. It transmits any replacement sheet of the demand and a copy of any letter to the International Bureau. The International Preliminary Examining Authority undertakes the actions referred to in this paragraph not only where the corrections submitted by the applicant are timely received and satisfactory, but also where they are not and, consequently, the demand is considered as if it had not been submitted.

22.39 [No change]

Rule 60.1(a) and (b)

22.40 The International Preliminary Examining Authority checks whether the defects referred to in Rule 60.1(a) have or have not been timely corrected. [If the applicant complies with the invitation within the time limit, the demand is considered as if it had been received on the actual filing date provided that the demand as submitted permitted the international application to be identified.](#) The ~~one-month~~ time limit for correction may be extended. If a correction of a defect is received after the expiration of the time limit for correction but before a decision is taken, the time limit for correction should be extended *ex officio* so that the said correction is considered as having been timely received.

Rule 60.1(b) and (c)

22.41 If the International Preliminary Examining Authority finds that any of the defects referred to in Rule 60.1(a), ~~with the exception of those also referred to in Rule 60.1(d)~~, have not been corrected or have not been timely corrected (see the preceding paragraph), it declares that the demand is considered as if it had not been submitted and notifies the applicant and the International Bureau (Form PCT/IPEA/407). If the date of receipt of the demand is changed, the International Preliminary Examining Authority notifies the applicant and the International Bureau (Form PCT/IPEA/402).

Rule 60.1(d)

22.42 ~~[Deleted] If the International Preliminary Examining Authority finds that any of the defects referred to in Rule 60.1(d) have not been corrected or have not been timely corrected, it notifies the applicant and the International Bureau (Form PCT/IPEA/439).~~

22.43–22.60 [Renumbered as 22.42–22.59 respectively. No change to the body of each paragraph.]

[Annex II follows]

ANNEX II

COMMENTS MADE BY AUTHORITIES TO THE SEPTEMBER 1, 2006, PROPOSED
CHANGES TO THE GUIDELINES AND RESPONSES BY THE UNITED STATES
PATENT AND TRADEMARK OFFICE (USPTO)

COMMENTS BY THE AUSTRIAN PATENT OFFICE

Paragraph 17.29

We share the concerns of the EPO that in the form PCT/IPEA/409 the Box IV in its present form does not allow to indicate that, because of lack of unity and the non payment of additional fees for a number of claims, no search report was established for these claims. In addition, Box IV only refers to Rule 68.1 PCT. This also seems to indicate that this box deals exclusively with Chapter II proceedings.

Therefore, it seems to us that the Box III of the present form PCT/IPEA/409 offers the only place to indicate that during Chapter I no international search report has been established for a certain number of claims.

However, certain claims may also not have been searched because of Article 17 PCT. Although the result for both cases would be the same within the international phase, we think that for the national phase it would be useful to differentiate between the two cases.

Therefore we think that the form PCT/IPEA/409 should be amended in such a way that also in its Box IV a similar provision as in the present Box III is inserted.

USPTO Response

Upon further consideration, and in response to the additional comments by Austria and Canada in this regard, we can agree to amend the paragraph as suggested by the EPO. While it is still our position that this information is already, albeit indirectly, contained in the indications in Box No. IV, and to include such in Box No. III would be redundant, if it would aid applicants and offices we see no harm in including the information both boxes. However, we would propose that the IB modify Box No. III to include an additional check box in the portion of the box which follows the word "because:" which states:

applicant did not, within the applicable time limit, pay the additional fees for the invention(s) to which claim(s) _____ are related. (See Box No. IV)

Additionally, until such time as the forms are officially amended as proposed, we would urge that the Authorities include a specific reference to Box No. IV in any such indication in Box No. III.

Suggestions with respect to new Rule 20.6 (missing parts and elements)

We also have a preference for the option (b), because option (a) seems to be too strict and option(c) while being the most advantageous option for the applicant would result in problems for the clerical staff in the various receiving Offices.

However, we also think that the Receiving Office Guidelines shall have exact and detailed instruction for the receiving Office. In our view, this is underlined by the suggestion of the EPO that in complex cases the receiving Office will, where possible, ask an examiner to give its opinion.

USPTO Response

Agreed. However, as stated in our previous comments, any proposal to modify to the Search and Examination Guidelines would be premature pending a review of any proposed revision of the language of the RO Guidelines.

COMMENTS BY THE CANADIAN INTELLECTUAL PROPERTY OFFICE (CIPO)

Paragraph 8.02

CIPO does not agree with the EPO. CIPO believe that there should be no requirements that the person would be an examiner acquainted with the relevant technical field.

USPTO Response

We agree with the comment by CIPO. See additional discussion below in conjunction with the comments from the EPO.

Paragraph 16.67

It appears to us that the suggestion made by the USPTO may be beneficial to the national/regional offices. We have difficulty understanding the EPO's concerns about adding the proposed change. As this issue appears to be broader than just text in the Search and Examination Guidelines, we would propose to have a more substantive discussion at the next MIA.

USPTO Response

We agree with the comment by CIPO. See additional discussion below in conjunction with the comments from the EPO.

Paragraph 17.29

CIPO shares the concerns of the EPO concerning Box III of form PCT/IPEA/409. CIPO supports the suggestion from the EPO to change the wording so as to indicate that Box III is to be crossed also in the case where non-unity was established and not all the fees paid.

USPTO Response

See above response to the comments from Austria.

COMMENTS BY THE EUROPEAN PATENT OFFICE (EPO)

Paragraph 3.02

The EPO agrees with the proposed insertion of the 2nd sentence, ie. “It builds on ... to overcome objections”. However the word “either” in the 4th line should be deleted to make it clear that the applicant may, if he so wishes, submit both amendments and arguments. Furthermore the EPO considers that the text which it is proposed to delete, ie. from “It has the primary objective ... The results of the international preliminary examination” should be reinstated as it is a useful clarification; this would entail the deletion of the half sentence “The results of this more thorough examination”. PCT II is not necessarily more thorough than PCT I rather it serves a different purpose ie cases where the applicant reacts in some way to the IPRP.

USPTO Response

The language in question was originally proposed by the IB in document PCT/MIA/13/Nonpaper 1, and as such the IB has been consulted with respect to the EPO comment. Their response has been summarized below.

- Agree with respect to the deletion of “either.”
- Agree that the examination is not “necessarily” more thorough than that under Chapter I. However, it would seem that reinstatement of the entire text would imply that those objectives went beyond the objectives of the Chapter I opinion.
- Suggest not reinstating the first and second deleted sentences, but to reinstate the 3rd sentence to its original form. Alternatively, if they are considered important, suggest moving the first and second deleted sentences to paragraph 2.03 (in place of the proposed addition there) and in paragraph 3.02 indicate that the objectives are the same as for the WO of the ISA (see paragraph 2.03) and that it builds on the process of the written opinion.

The USPTO also agrees with the deletion of the word “either.” With respect to the reinstatement of the deleted sentences we agree with the IB’s statement concerning the implication of reinstating the deleted sentences. As such, it would seem that the alternative solution proposed by the IB is the best course of action. Therefore, paragraphs 2.03 and 3.02 have been further modified in accordance with the IB’s suggestion.

Paragraph 8.01(ii)

The proposed addition of the half sentence “or that the proposed rectification was the only meaning which could have been intended” is tautologous.

USPTO Response

Agreed. The paragraph has been further amended to no longer include the above language.

Paragraph 8.02

The 2nd sentence beginning “No special attributes should be ascribed” should be deleted as it is potentially misleading. It should be made clear that the person in the competent Authority will be an examiner acquainted with the relevant technical field for the description claims or drawings or the relevant formalities officer for other issues.

USPTO Response

We disagree. The comment to proposed Rule 91.1(c) as presented to, and eventually adopted by, the Seventh Session of the PCT Reform Working Group in document PCT/R/WG/7/6 refers to “paragraphs 8 to 13 in the main body of [the] document.” Concerning the language “obvious to the competent authority,” paragraph 8 of the document states:

“it is proposed...not to ascribe any special attributes to the person in the competent authority making the finding whether an alleged mistake is ‘obvious’ and thus rectifiable...”

A review of the Report from the session reveals that no objections were apparently made to this comment. Additionally, it bears noting that identical language was also presented to the 11th session of the MIA, and similarly no objections are noted in the Report from that session. As such, the language is deemed to be an accurate reflection of the intentions of both the Working Group and the MIA and has been retained.

Paragraph 8.05

The proposed addition of the phrase “other than the priority document” is potentially misleading and does nothing to clarify the text. In the EPO’s view, the text would be clearer with the deletion of the final sentence, i.e. from “Extrinsic evidence ... is not permitted to be used”.

USPTO Response

We disagree. The previous objection from the EPO to this paragraph was that the sentence in question was not correct in that some extrinsic evidence is permitted to be used. Therefore, the proposed sentence has been modified to accurately reflect that the only extrinsic evidence that could be submitted with the request for rectification and which may be considered in determining whether the correction is obvious is a copy of the priority document. As such, it is unclear how the suggested change cannot be considered as clarifying the issue.

Paragraph 8.07(iv)

It should be clarified in the final line that the priority date in question is the “earliest” priority date.

USPTO Response

Agreed. The paragraph has been further modified.

Paragraph 16.67

The EPO still disagrees with the view expressed by the USPTO. Although the amendment suggested by the USPTO could be considered as covered by the wording of Rule 33.1(c) PCT, the fact remains that the amendment concerned gives a new interpretation of this rule. The EPO does not consider that the wording of the present guidelines was due to an “oversight” which has to be corrected, but that this paragraph of the guidelines clearly sets out the agreed interpretation of that rule. If the USPTO is now of the opinion that this agreed interpretation should be changed because it does not tally with the wording of the existing rule, then the EPO position is that we should rather change the rule so that it clearly sets out what has always been the agreed interpretation. On the other hand, the USPTO seems to argue that a change is necessary from a “work sharing perspective”. This means that what is requested by the USPTO is indeed a change in the long standing interpretation because of new parameters in the system itself, ie. “work sharing”. However, if the USPTO wishes to cite such documents in the search report neither the rule itself nor the present guidelines prohibits such citation. The EPO cannot agree to the need for making this particular practice mandatory for all Authorities.

USPTO Response

The United States strongly disagrees with the EPO suggestions that the proposed language “gives a new interpretation of [Rule 33.1(c)]” and that the interpretation as presented in the current language of the Guidelines is both previously agreed to and longstanding. First, it must be noted that the PCT Search Guidelines, as in effect prior to the current revision to accommodate PCT Reform, addressed the matter in Chapter VI – Relevant Prior Art. Specifically, under the heading *Symbol “E”*, paragraph VI-8.24 states:

The symbol “E” is used when the document (published application or patent) was filed before the international filing date and was published after the international filing date. It should always be accompanied by a symbol indicating the relevance of the document (“X”, “Y” or “A”).

By suggesting that the symbol “E” be used in conjunction with the symbol Y (as opposed to only in conjunction with the symbol X) the Guidelines clearly indicate that the Authorities were to cite “E” references with respect to both novelty and inventive step. As such, this would appear to contradict the suggestion that the interpretation supported by the proposed language is “new” as well as the suggestion that the interpretation supported by the current language is “longstanding.”

Regarding the suggestion that the Authorities had previously agreed to the interpretation supported by the current Guideline language, the USPTO can find no support for such a statement. If the Authorities, in the context of their discussions on revision of the Guidelines, had decided to purposefully adopt an interpretation that was contrary to both the language of the Rule and the language of the Guidelines in effect at that time, surely there would have been some discussion on the matter, and such discussion would have been reflected in either the papers introducing the changed language or the reports from those sessions of the MIA (and most likely would have been reflected in both). However, a review of the documents from the MIAs leading up to the adoption of the combined Search and Examination Guidelines, shows no such discussion having apparently taken place. This would seem to support the USPTO position that the current language is the result of an oversight on the part of the Authorities. Further

evidence that the current language is the result of an oversight, as opposed to an agreed upon interpretation of the Rule, is the fact that no proposal was ever put forth to amend the Rule to conform it to the language of the “agreed upon” language of the Guidelines.

Finally, the EPO urges that the United States has proposed the change to the paragraph as a necessity which has been brought about by the “new parameters in the system itself, i.e. ‘work sharing’.” In this regard, it must be pointed out that work sharing is hardly a new parameter of the PCT system. From its very inception, one of the primary goals of the PCT was to establish a system where applicants could file a single application which would result in a single set of search and examination reports that could then be used by all States in the course of their national processing. Therefore, the proposed language cannot be said to have been necessitated by a change in the parameters of the PCT system, but rather is required by the original intent of the PCT system and the language of Rule 33.1(c) (which has remained unchanged since the original adoption of the Treaty).

Paragraph 17.28

The crossing of Box II to merely indicate that the Office did not have the priority document and therefore assumed priority to be valid was opposed by the applicants who stated that the mere crossing of the Box would imply that there is something negative. The EPO therefore had to change its practice and does not anymore cross Box II unless priority is definitely invalid. Thus, the suggestion by the USPTO is likely to again cause protests and confusion amongst applicants who are used to the practice that this box is only crossed in case of priority being invalid, ie. the negative case. If the examiner wishes to insert remarks on checked priority this could also be done in Section VI (where intermediate documents are dealt with) or in box V (by stating that since the priority is valid the intermediate documents are not considered further). However, this does not need to be mentioned in the guidelines.

USPTO Response

The language in question was originally proposed by the IB in document PCT/MIA/13/2, and as such the IB has been consulted with respect to the EPO comment. Their response has been summarized below.

- Paragraph 17.26 indicates that the validity of the earliest priority date requires checking when one or more of the citations is published after the earliest priority date, and it would seem to be necessary to make a comment on the outcome of that check.
- Absent a statement that the earliest priority date is valid (or assumed to be valid in the case provided for in item 1 of the Form 237 version), there is no justification for omitting citations from the WO which appeared in the ISR, or (as the case may be) their relegation to Box No. VI rather than Box No. V.
- Box No V or VI could be considered to be equally valid alternative locations for the information, however it should be noted that the DTDs for XML search reports do not seem to allow for comments of that nature to be written into Box No. VI. This could cause problems in the future as Authorities consider delivering the report information in XML format.

- It is appropriate to state in the Guidelines, either in paragraph 17.28 as proposed or within the section on Box No. V, that a positive comment on the validity of the priority is necessary, especially if that is the reason that a citation listed in the search report is not carried through to the written opinion or appears in Box No VI rather than V.

Current USPTO practice is consistent with that of the EPO, i.e., to only mark Box No. II in situations where the statements concerning the priority claim are negative. Further, in many cases it is not simply a matter of a positive or negative statement concerning the validity of the priority claim. Often the priority claim may be valid for some claims but not for all claims in the application. In such situations U.S. examiners are instructed to discuss the validity of the priority claim in the context of the specific discussion of novelty or inventive step concerning those claims. As such, we would agree with the comments of the EPO. However, in view of the comments from the IB, the language in question has been placed in brackets and it will be left to the MIA to make a final determination on the matter.

Paragraph 17.29

The EPO notes that the US has not proposed any change in this regard. The EPO maintains its original comment.

USPTO Response

See above response to the comments from Austria.

COMMENTS BY THE NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

Paragraph 16.48

The reference at the right-hand corner is erroneous: it should be Rule 43.3(a).

Paragraph 16.48 says that non-obligatory IPC symbols do not need to be applied. It is clear that if something is non-obligatory, it need not be applied. Would it, however, be appropriate to mention that non-obligatory classification/indexing is desirable, as mentioned in paragraph 119 of the IPC Guide.

USPTO Response

Agreed. The reference has been changed.

Paragraph 16.49

The reference at the right-hand corner of paragraph 16.48, namely Rule 43.6(a), belongs apparently to this paragraph.

USPTO Response

Agreed. The reference has been added.

Paragraph 16.56

This paragraph says that if the previous application has not yet been published, the information may be sent to the applicant informally, when the international search report is transmitted. This matter requires clarification because it is not appropriate to reveal the contents of an unpublished application to the applicant of the later application.

USPTO Response

Under the procedure provided in this paragraph (PCT Rule 41), the applicant is the same in both applications. As such, there is no question as to the appropriateness of revealing the contents of the unpublished application. No change is proposed to be made to the Guidelines in this regard.

Paragraph 17.44

Is it appropriate to discuss in Box No. VI the contents of the documents mentioned there? Would it be worth of telling that in paragraph 17.44?

USPTO Response

Box No. VI is merely for the citation of references in accordance with PCT Rule 70.10. No discussion of the references is to be included. No change is proposed to be made to the Guidelines in this regard.

ADDITIONAL PROPOSED CHANGES

Paragraph 17.45

It is proposed to further amend this paragraph so as to amend the phrase “the cited earlier published application...” bridging lines 2 and 3 to “such published application...” for clarity.

Paragraph 15.11

Currently, the software used by the USPTO for electronic processing of International Applications does not allow for such markings in the upper right-hand corner. As such it is proposed to remove the specific location from the proposed language and simply require that the first sheet be marked.

Paragraph 22.43–22.60

It is proposed to renumber these paragraphs consequential to the deletion of paragraph 22.42.

[End of Annex II and of document]