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PCT/TCO/VII/5

STEPS IN THE PROCEDURE BEFORE THE
INTERNATIONAL SEARCHING AUTHORITY
IN CONNECTION WITH THE USE OF THE PCT FORMS

prepared by the International Bureau

SUMMARY

This document contains a draft outline of the steps in the procedure before the International Searching Authority in connection with the use of the PCT Forms; it lists the tasks of the International Searching Authority under general headings, briefly indicates steps under each task, and illustrates--in flow diagrams--such tasks and steps. The PCT Forms to be used in connection with the tasks and steps are specified in both the outline of the tasks and steps and the flow diagrams.

Background and purpose of this document

1. The PCT Interim Committee for Technical Cooperation, at its sixth session held in Geneva from November 3 to 8, 1976, placed on its program for 1977 a study of the steps in the procedure before the International Searching Authority in connection with the use of the PCT Forms (see the report of the said session, document PCT/TCO/VI/16, paragraph 89(iv)).
2. The primary purpose of this document is to provide reference material for the International Searching Authority in relation to its processing of international applications under the PCT. This reference material may be regarded as complementary to the Guidelines for International Search to be Carried Out under the Patent Cooperation Treaty (PCT) (see document PCT/TCO/VII/2), since it indicates to the International Searching Authority the PCT Form that is appropriate in particular situations dealt with in those Guidelines. Having regard to the fact that a consideration of procedural matters involving the use of the PCT Forms is also of interest to the Interim Advisory Committee for Administrative Questions, consideration of the present document has been placed on the agendas of both that Committee and the Interim Committee for Technical Cooperation (the two Committees are hereinafter referred to as "the Interim Committees") for their consideration in a joint meeting.
3. To facilitate the presentation of the said reference material, the processing of international applications by the International Searching Authority has been arranged according to "procedural tasks" each comprising a number of "procedural steps." The sequence of tasks and steps set forth in this document has also only been used for reasons of presentation and should not be taken as suggesting that it is necessary to complete any particular task or step before undertaking another task or step.

The Annex to this document

4. The Annex deals with the processing of international applications by the International Searching Authority ("ISA"). The Annex is subdivided into three parts: the first (Part A) indicating the procedural tasks; the second (Part B) describing the various steps under each task; and the third (Part C) consisting of flow diagrams illustrating the tasks, the steps and the PCT Forms to be used.

The procedural tasks

5. The procedural tasks referred to in Parts A, B and C are indicated by the symbol of the Authority ("ISA"), an oblique stroke and a number. For example, "ISA/4" means task number 4 of the International Searching Authority.

The processing steps

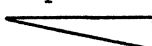
6. The processing steps are described and annotated with references to the relevant provisions of the Articles of the PCT and the Rules and Administrative Instructions thereunder and, where applicable, with references to the PCT Forms. These steps are indicated by the symbol of the Authority followed by an oblique stroke, the number of the task and, after a decimal point, by the number of the step. For example: "ISA/4.3" means step number 3 of the task number 4 of the International Searching Authority.

The flow diagrams

7. The flow diagrams are contained in charts. Each chart has a double line running along the right-hand side of the page. This double line traces the normal flow of the processing of an international application. The procedural tasks indicated along this "normal flow line" are, whenever possible, set forth in chronological sequence. Questions presented in the flow of processing are represented by the figure  in which key words are included.

8. The arrangement of the normal processing flow is such that, for the vast majority of international applications, vis-à-vis the questions presented along the normal flow line under any particular procedural task, the answer will be negative (indicated by the letter "N" (for "no")) and the processing proceeds down the normal flow line rather than encounter the abnormal processing occurring when an affirmative answer (indicated by the letter "Y" (for "yes")) diverts the processing temporarily, or, in some situations, permanently, from continuing down the normal flow line.

9. Processing steps to be taken are represented by the figure  in which the key words are included and, as the purpose of this document is to explain the use of the PCT Forms, any communication arising from any given processing step and requiring the use of any given Form is indicated by the figure

 - - - - and above that figure, the symbol of the Form to be used (for example: PCT/ISA/212). The contents of the Form to be used can be readily ascertained by reference to document PCT/INT/2, Annex F, containing the Forms under the PCT Administrative Instructions.

10. The Forms are identified in the manner used in document PCT/INT/2. Such identification consists of the symbol PCT, an oblique stroke, the symbol of the International Searching Authority, an oblique stroke, and the number of the Form (for example: "PCT/ISA/212").

11. The Interim Committees are invited to consider the annexed outline of procedural tasks, processing steps and flow diagrams with particular reference to the use of the PCT Forms and to provide their advice to the International Bureau.

[Annex follows]

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[Part A follows]

PART A INTERNATIONAL SEARCHING AUTHORITY: PROCEDURAL TASKS

TASK SYMBOL	TASK
ISA/1	RECEIPT OF THE SEARCH COPY UNDER RULE 25
ISA/2	RULE 29.3 CHECK (CALLING ATTENTION TO NON-COMPLIANCE WITH ARTICLE 11(1) REQUIREMENTS)
ISA/3	ARTICLE 17(2) CHECK (SEARCH REQUIRED AND POSSIBLE)
ISA/4	ARTICLE 17(3) CHECK (LACK OF COMPLIANCE WITH REQUIREMENT OF UNITY OF INVENTION)
ISA/5	RULE 37 CHECK (MISSING OR DEFECTIVE TITLE)
ISA/6	RULE 38 CHECK (MISSING OR DEFECTIVE ABSTRACT)
ISA/7	RULE 28 CHECK (CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION)
ISA/8	RULE 9 CHECK (EXPRESSIONS, ETC., NOT TO BE USED)
ISA/9	RULE 91 CHECK (RECTIFICATION OF OBVIOUS ERRORS OF TRANSCRIPTION)
ISA/10	RULE 83 REQUEST FOR PROOF OF RIGHT TO PRACTICE
ISA/11	RULES 16.3 AND 41 REFUND (USE OF INTERNATIONAL OR INTERNATIONAL-TYPE SEARCH REPORT)
ISA/12	ARTICLE 18 ESTABLISHMENT OF INTERNATIONAL SEARCH REPORT
ISA/13	RULE 44.1 TRANSMITTAL OF INTERNATIONAL SEARCH REPORT
ISA/14	RULE 44.3 PREPARATION AND TRANSMITTAL OF COPIES OF CITED DOCUMENTS
ISA/15	RULE 48.3(b) TRANSLATION OF INTERNATIONAL APPLICATION
ISA/16	RULE 92 NEED FOR SIGNATURE WITH REGARD TO CORRESPONDENCE
ISA/17	RULE 93.3 KEEPING OF RECORDS AND FILES

[Part B follows]

PART B INTERNATIONAL SEARCHING AUTHORITY: ANNOTATED DESCRIPTION OF THE
PROCESSING STEPS UNDER THE PROCEDURAL TASKS

ISA/1 RECEIPT OF THE SEARCH COPY UNDER RULE 25

ISA/1.0 The International Searching Authority notifies (Form PCT/ISA/202) the applicant, receiving Office (if the latter is not identical with the International Searching Authority) and the International Bureau of the fact and date of receipt of the search copy (Rule 25.1).

ISA/2 RULE 29.3 CHECK (CALLING ATTENTION TO NON-COMPLIANCE WITH ARTICLE 11(1) REQUIREMENTS)

ISA/2.0 The International Searching Authority timely notes (6 months from the international filing date) that the international application lacks compliance with Article 11(1) (Rules 29.3 and 30.1).

ISA/2.1 The International Searching Authority notifies (Form PCT/ISA/209) the receiving Office that the international application fails to comply with Article 11(1) and that it considers that the receiving Office should make a finding under Article 14(4) (Rule 29.3).

ISA/3 ARTICLE 17(2) CHECK (SEARCH REQUIRED AND POSSIBLE)

ISA/3.0 The International Searching Authority finds that Article 17(2) (a) or 17(2) (b) applies to the international application.

ISA/3.1 The International Searching Authority checks whether all, or only some of the claims of the international application are affected.

ISA/3.2 The International Searching Authority declares that no international search will be carried out and notifies (Forms PCT/ISA/203, PCT/ISA/220, and PCT/ISA/219) the applicant and the International Bureau that no international search report will be established (Article 17(2) (a)).

ISA/3.3 The International Searching Authority indicates in the international search report (item IV of Form PCT/ISA/210) that Article 17(2) (a) applies to certain of the claims only of the international application for which no international search report will be established and proceeds with the search of the other claims (Article 17(2) (b)).

ISA/4 ARTICLE 17(3) CHECK (LACK OF COMPLIANCE WITH REQUIREMENT OF UNITY OF INVENTION)

ISA/4.0 The International Searching Authority finds that the international application lacks compliance with the requirement of unity of invention.

ISA/4.1 The International Searching Authority proceeds to establish the international search report (item V of Form PCT/ISA/210) on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") (Article 17(3) (a)).

ISA/4.2 The International Searching Authority invites (Form PCT/ISA/206) applicant to timely pay additional fees (Article 17(3) (a), Rules 40.1, 40.2(a) and (b) and 40.3).

ISA/4.3 The International Searching Authority finds that applicant has not timely paid additional fees (Article 17(3) (a), Rule 40.3).

ISA/4.4 The International Searching Authority limits the international search to the main invention (Article 17(3) (a)).

ISA/4.5 The International Searching Authority finds that applicant made payment of additional fees under protest (Rule 40.2(c)).

- ISA/4.6 The International Searching Authority (by means of a three-member board or other special instance of that Authority), or any competent higher authority, examines the protest, decides on its justification and notifies (Form PCT/ISA/212) the applicant accordingly (Rule 40.2(c), Section 502 of the Administrative Instructions).
- ISA/4.7 The International Searching Authority registers the notice of protest and the decision thereon and, if requested by the applicant to notify the text of both the protest and the decision thereon to the designated Offices, forwards (Form PCT/ISA/219) them together with the international search report (Form PCT/ISA/210) to the International Bureau (Rule 40.2(c)).
- ISA/4.8 The International Searching Authority searches also those parts of the international application for which additional fees have been paid (Article 17(3)(a)).
- ISA/5 RULE 37 CHECK (MISSING OR DEFECTIVE TITLE)
- ISA/5.0 The International Searching Authority finds that the title of the invention is not contained in the international application.
- ISA/5.1 The International Searching Authority finds that it has received a notification (Form PCT/RO/106) from the receiving Office indicating that the applicant has been invited to furnish the missing title (Rule 37.1).
- ISA/5.2 The International Searching Authority finds that the title is defective in that it fails to comply with Rule 4.3.
- ISA/5.3 The International Searching Authority establishes or corrects the title, the text of which will accompany the international search report (Form PCT/ISA/210) (Rules 37.2 and 44.2(a)).
- ISA/6 RULE 38 CHECK (MISSING OR DEFECTIVE ABSTRACT)
- ISA/6.0 The International Searching Authority finds that the international application does not contain an abstract.
- ISA/6.1 The International Searching Authority finds that it receives a notification (Form PCT/RO/106) from the receiving Office indicating that the applicant has been invited to furnish the missing abstract (Rule 38.1).
- ISA/6.2 The International Searching Authority finds that the abstract fails to comply with Rule 8.
- ISA/6.3 The International Searching Authority establishes an abstract and, only in the case where the abstract was established on the basis of an abstract which was not missing but was defective, invites (Form PCT/ISA/204) applicant to comment thereon (Rule 38.2(a)).
- ISA/6.4 The International Searching Authority upon consideration of any timely comments (one month from the date of the invitation) submitted by the applicant determines the definitive contents of the abstract which is to accompany the international search report (Form PCT/ISA/210) (Rules 38.2(b) and 44.2(a)).
- ISA/6.5 The International Searching Authority notifies (Form PCT/ISA/205) the applicant and the International Bureau of the abstract approved or established (time limit for applicant's response expired) (Rule 44.2(c)).
- ISA/7 RULE 28 CHECK (CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION)
- ISA/7.0 The International Searching Authority finds defects in the international application referred to in Article 14(1)(a)(i), (ii) or (v) (Rule 28.1(a)).
- ISA/7.1 The International Searching Authority notifies (Form PCT/ISA/215) the receiving Office that the international application contains defects referred to in Article 14(1)(a)(i), (ii) or (v) (Rule 28.1(a)).

ISA/8 RULE 9 CHECK (EXPRESSIONS, ETC., NOT TO BE USED)

ISA/8.0 The International Searching Authority notes lack of compliance with Rule 9.1 (Rule 9.2).

ISA/8.1 The International Searching Authority suggests to applicant that he voluntarily correct lack of compliance with Rule 9.1 and notifies the receiving Office and the International Bureau of lack of compliance (Form PCT/ISA/218) (Rule 9.2).

ISA/8.2 The International Searching Authority enters corrections received from the applicant into the international application and transmits (Form PCT/ISA/224) copies of such corrections to the receiving Office and the International Bureau (Section 501 of the Administrative Instructions).

ISA/9 RULE 91 CHECK (RECTIFICATION OF OBVIOUS ERRORS OF TRANSCRIPTION)

ISA/9.0 The International Searching Authority notes obvious errors of transcription (Rule 91.1(d)).

ISA/9.1 The International Searching Authority invites (Form PCT/ISA/216) the applicant to submit a request for rectification of obvious errors of transcription (Rule 91.1(d)).

ISA/9.2 The International Searching Authority finds, where it is presented with a request for rectification by the applicant, that the rectification requested is of an obvious error (Rule 91.1(b) and (c)) and that the request for rectification was timely filed, i.e., filed within a time permitting timely authorization of the rectification by the International Searching Authority.

ISA/9.3 The International Searching Authority timely authorizes (until establishment of the international search report or a declaration under Article 17(2)(a)) (Rule 91.1(g)(ii)) rectification (Rule 91.1(e)(ii)) and records the date of authorization for rectification (Rule 91.1(f)).

ISA/9.4 The International Searching Authority notifies (Form PCT/ISA/217) the applicant and the International Bureau of the authorization for rectification or, where the authorization for rectification was denied, notifies only the applicant (Rule 91.1(h), Section 109 of the Administrative Instructions).

ISA/10 RULE 83 REQUEST FOR PROOF OF RIGHT TO PRACTICE

ISA/10.0 The International Searching Authority decides that, with respect to any particular international application, proof that the interested person is entitled to practice under Article 49 is needed (Rule 83.1).

ISA/10.1 The International Searching Authority requests (Form PCT/ISA/214) the receiving Office to produce proof of the right to practice (Rule 83.2(a)).

ISA/11 RULES 16.3 AND 41 REFUND (USE OF INTERNATIONAL OR INTERNATIONAL-TYPE SEARCH REPORT)

ISA/11.0 The International Searching Authority finds a reference in the request (Rule 4.11) to an earlier international search carried out by itself or to an international-type search carried out by any International Searching Authority (Form PCT/ISA/210 or 201) which is to be utilized.

ISA/11.1 The International Searching Authority refunds (Form PCT/ISA/213) to applicant the search fee to the extent that results of the earlier international or international-type search can be partly or fully utilized (Rules 16.3 and 41.1).

ISA/12 ARTICLE 18 ESTABLISHMENT OF INTERNATIONAL SEARCH REPORT

ISA/12.0 The International Searching Authority establishes the international search report (Form PCT/ISA/210) (Rule 43).

ISA/13 RULE 44.1 TRANSMITTAL OF INTERNATIONAL SEARCH REPORT

ISA/13.0 The International Searching Authority on the same day transmits copies of the international search report (Form PCT/ISA/210) to the applicant (Form PCT/ISA/220) and to the International Bureau (Form PCT/ISA/219) (Rule 44.1).

ISA/14 RULE 44.3 PREPARATION AND TRANSMITTAL OF COPIES OF CITED DOCUMENTS

ISA/14.0 The International Searching Authority receives a timely request (within seven years from the international filing date) from the applicant and/or the designated Offices for copies of the documents cited in the international search report (Article 20(3), Rule 44.3(a)).

ISA/14.1 The International Searching Authority opts for the International Bureau to furnish copies of the documents cited in search reports (Rule 44.3(c)).

ISA/14.2 The International Searching Authority forwards (Form PCT/ISA/219) copies of cited documents to the International Bureau for transmittal (Rule 44.3(c)).

ISA/14.3 The International Searching Authority, subject to reimbursement of cost (Form PCT/ISA/221), transmits (Form PCT/ISA/211) copies of cited documents to the applicant and to the designated Offices (Rule 44.3(b)).

ISA/15 RULE 48.3(b) TRANSLATION OF INTERNATIONAL APPLICATION

ISA/15.0 The International Searching Authority finds that the international application was filed under Rule 12 in a language other than English, French, German, Japanese, or Russian (Rule 48.3(b)).

ISA/15.1 The International Searching Authority prepares a draft translation of the international application, subject to reimbursement of cost by the applicant (Form PCT/ISA/222), within the prescribed time limit(s) referred to in Rule 47.1(b) (Rule 48.3(b)).

ISA/15.2 The International Searching Authority invites (Form PCT/ISA/207) the applicant to comment on the draft translation within the prescribed time limit (time limit considered reasonable under the circumstances of the case and fixed by the International Searching Authority) (Rule 48.3(b)).

ISA/15.3 The International Searching Authority finds that the applicant has not timely submitted comments.

ISA/15.4 The International Searching Authority may desist from considering the comments in establishing the translation (Rule 48.3(b)) and notifies (Form PCT/ISA/208) the applicant accordingly.

ISA/15.5 The International Searching Authority notifies (Form PCT/ISA/208) the applicant as to the consideration given the comments in establishing the translation (Rule 48.3(b), Section 506(a) and (b) of the Administrative Instructions) and transmits the translation to the International Bureau (Form PCT/ISA/219) (Rule 48.3(b)).

ISA/16 RULE 92 NEED FOR SIGNATURE WITH REGARD TO CORRESPONDENCE

ISA/16.0 The International Searching Authority finds that in the case of papers in the form of a letter received from the applicant or papers accompanied by a letter identifying the international application, the papers and/or letter were unsigned (Rule 92.1(a)).

ISA/16.1 The International Searching Authority finds that, in respect of lack of compliance of the applicant to properly sign the papers, the papers are considered not to have been submitted (Rule 92.1(b)).

ISA/16.2 The International Searching Authority notifies (Form PCT/ISA/223) the applicant of his lack of signature by returning the papers for his signature and resubmission.

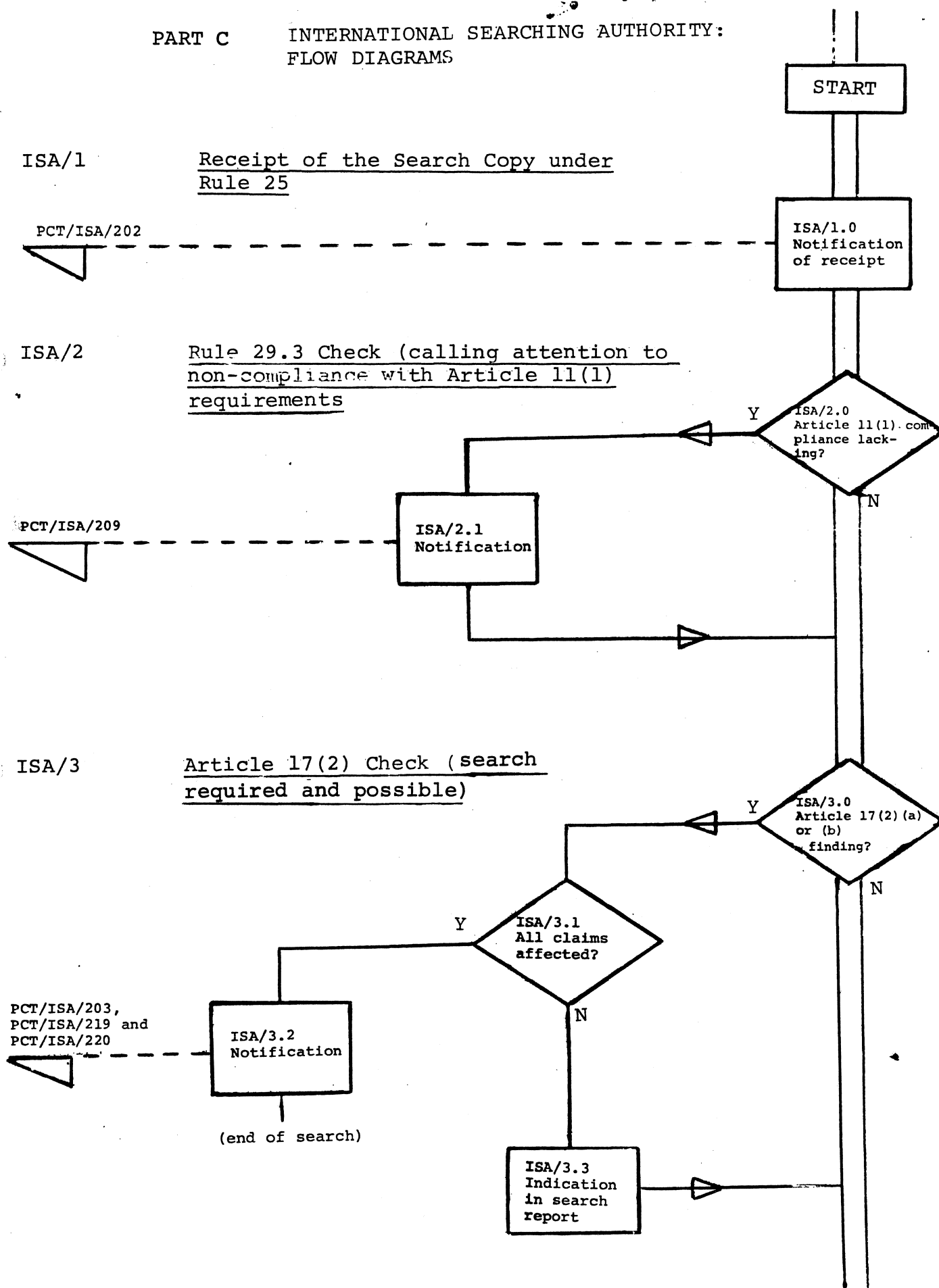
ISA/16.3 The International Searching Authority finds that the applicant has returned the papers properly signed.

ISA/17 RULE 93.3 KEEPING OF RECORDS AND FILES

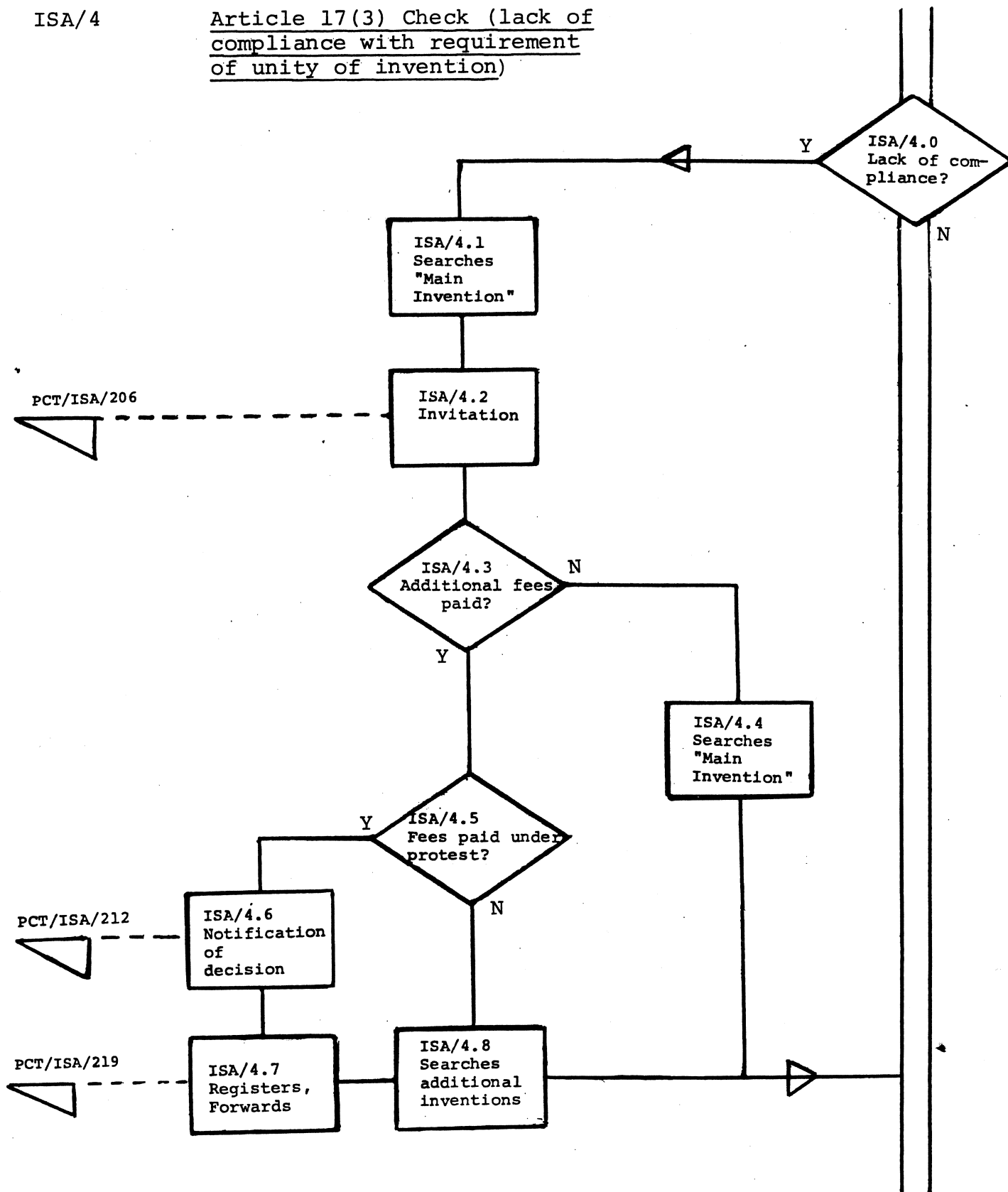
ISA/17.0 The International Searching Authority shall keep the file of each international application for at least ten years from the international filing date (Rule 93.3)

[Part C follows]

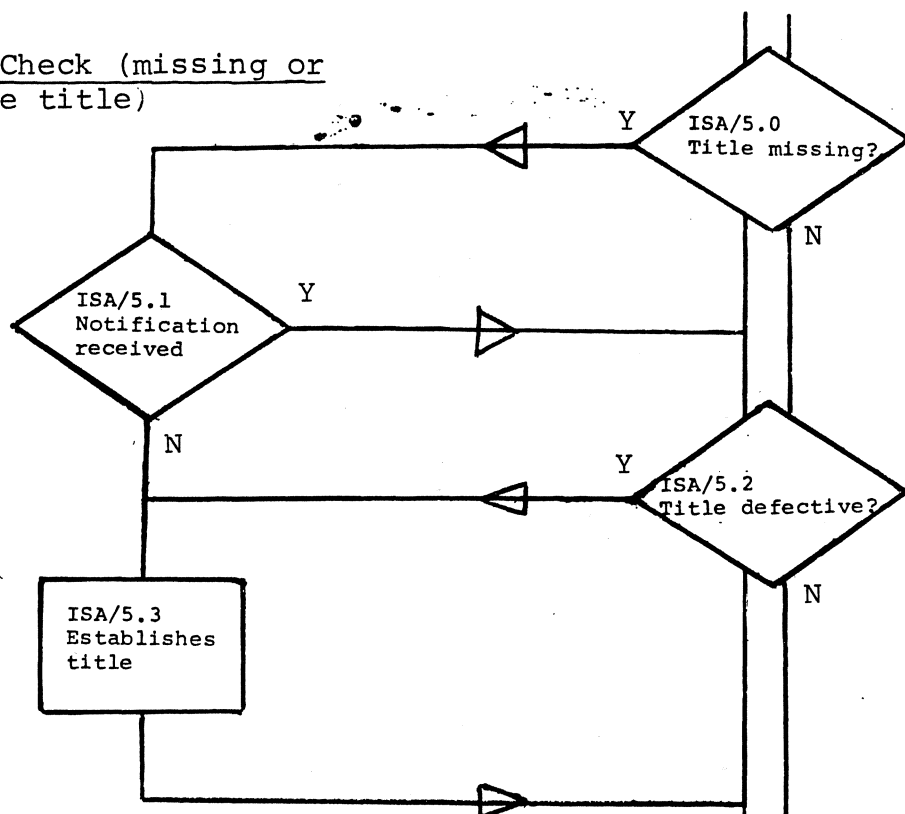
PART C

INTERNATIONAL SEARCHING AUTHORITY:
FLOW DIAGRAMS

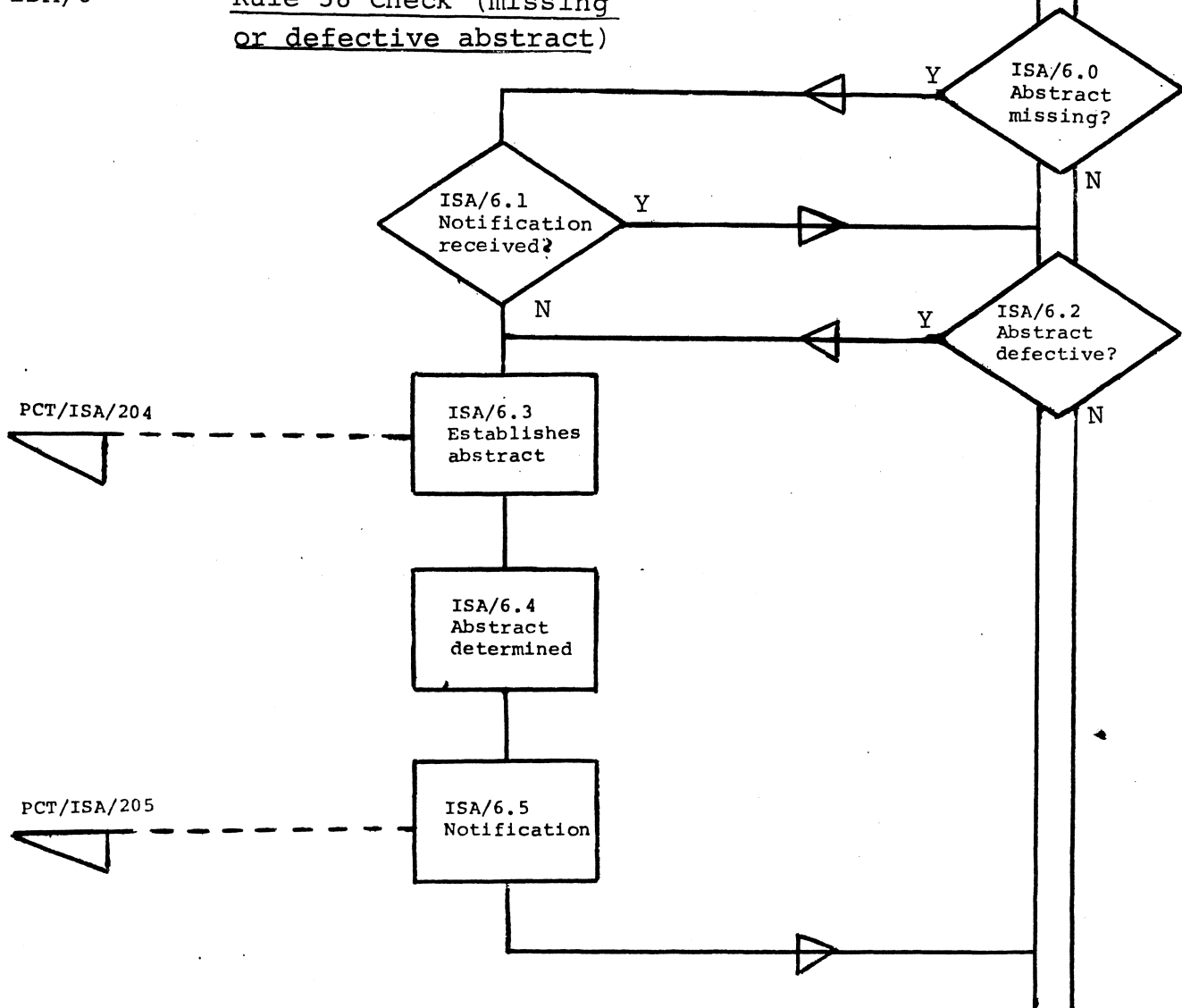
ISA/4

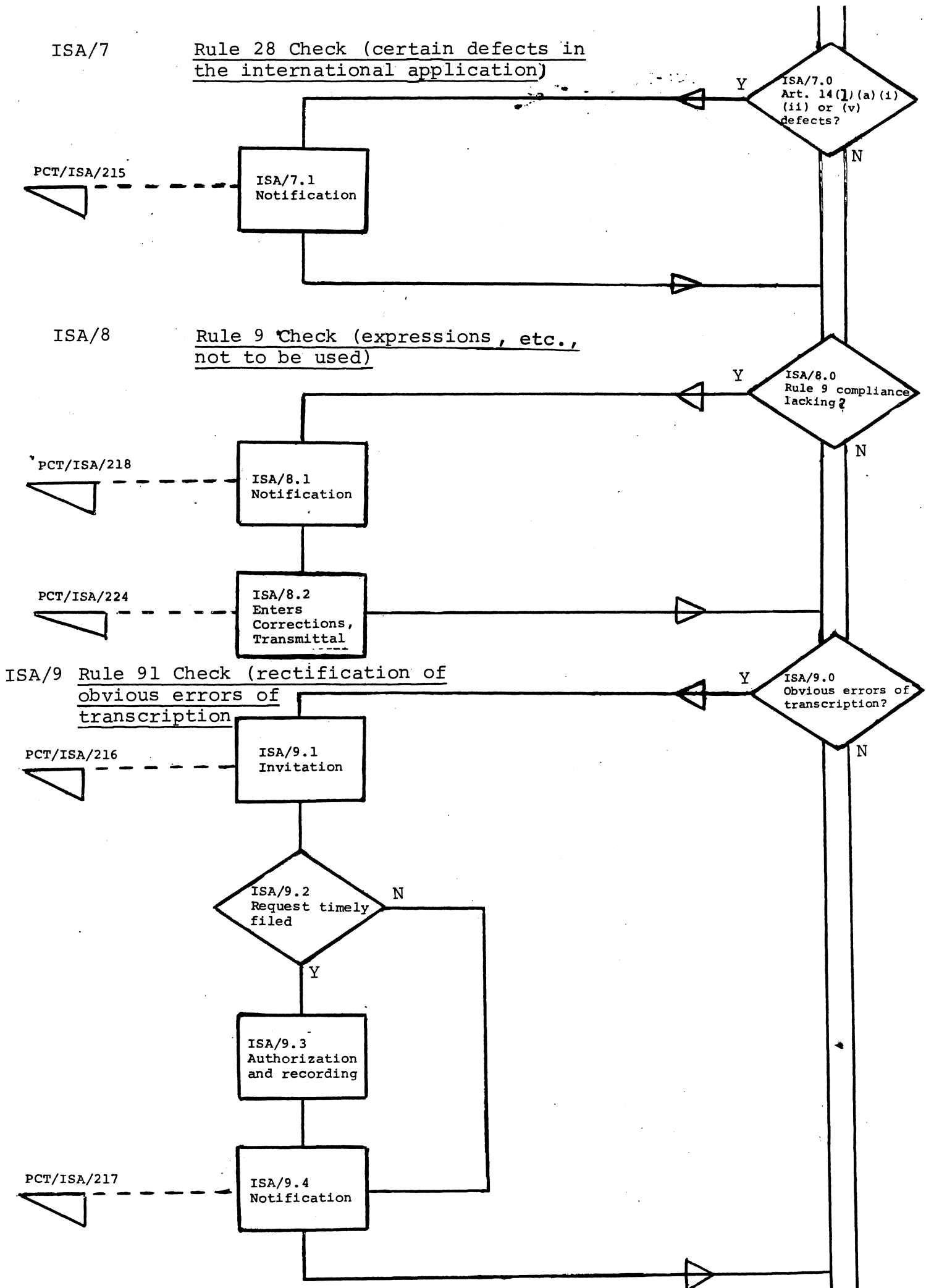
Article 17(3) Check (lack of
compliance with requirement
of unity of invention)

ISA/5

Rule 37 Check (missing or defective title)

ISA/6

Rule 38 Check (missing or defective abstract)



ISA/10

Rule 83 Request of Proof
of Right to PracticeISA/10.0
Proof of right
to practice
needed?

Y

N

PCT/ISA/214

ISA/10.1
Requests
proof

ISA/11

Rules 16.3 and 41 Refund (use
of international or international-
type search report)ISA/11.0
International
or international
type search
report?

Y

N

PCT/ISA/213

ISA/11.1
Refund
determination

ISA/12

Article 18 Establishment of
International Search ReportISA/12.0
Search
Report
established

ISA/13

Rule 44.1 Transmittal of
International Search ReportPCT/ISA/210,
PCT/ISA/219 and
PCT/ISA/220ISA/13.0
Transmits
copies

ISA/14

Rule 44.3 Preparation and
Transmittal of Copies of Cited DocumentsISA/14.0
Request for
copies ?

Y

N

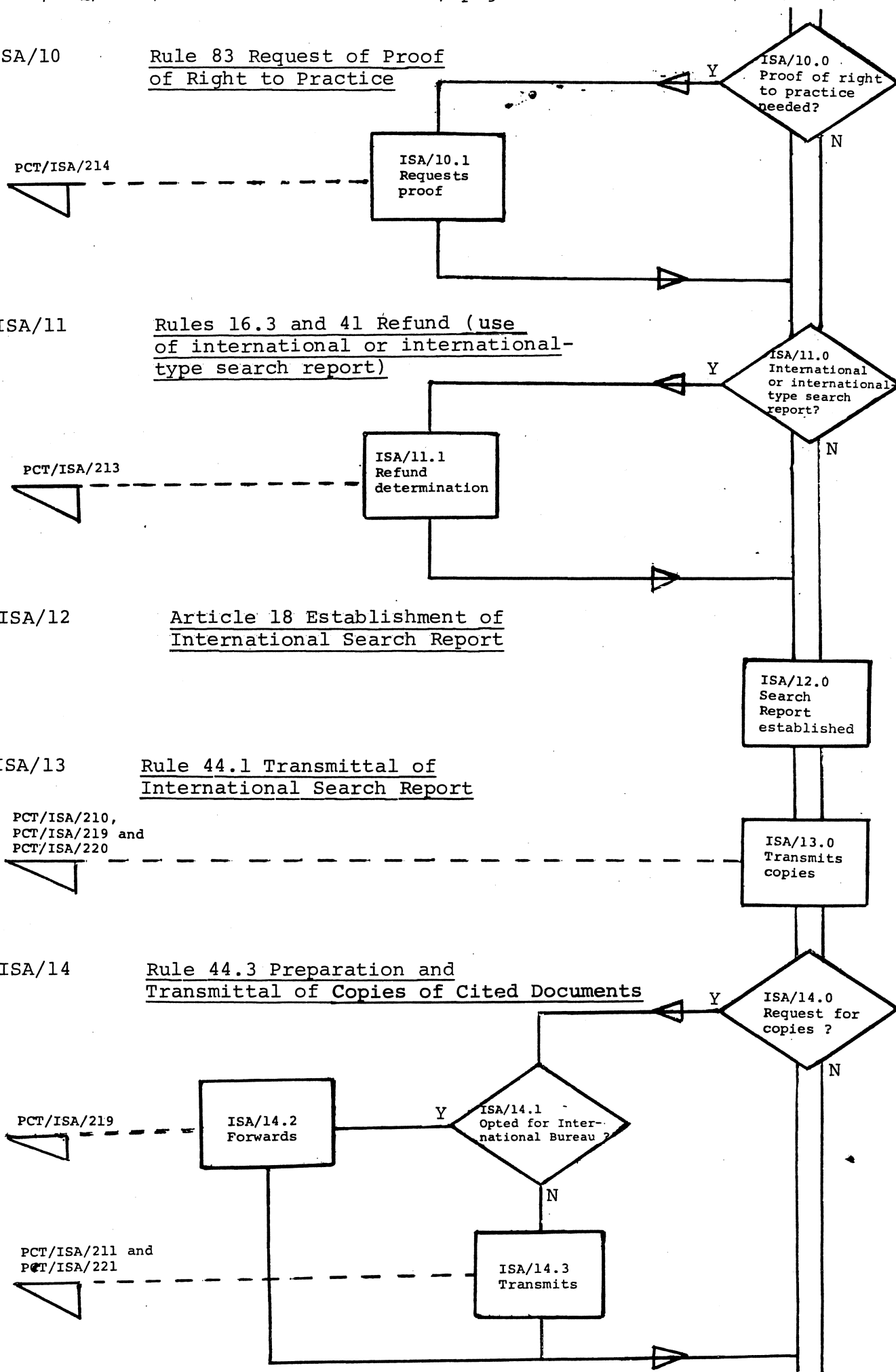
PCT/ISA/219

ISA/14.2
Forwards

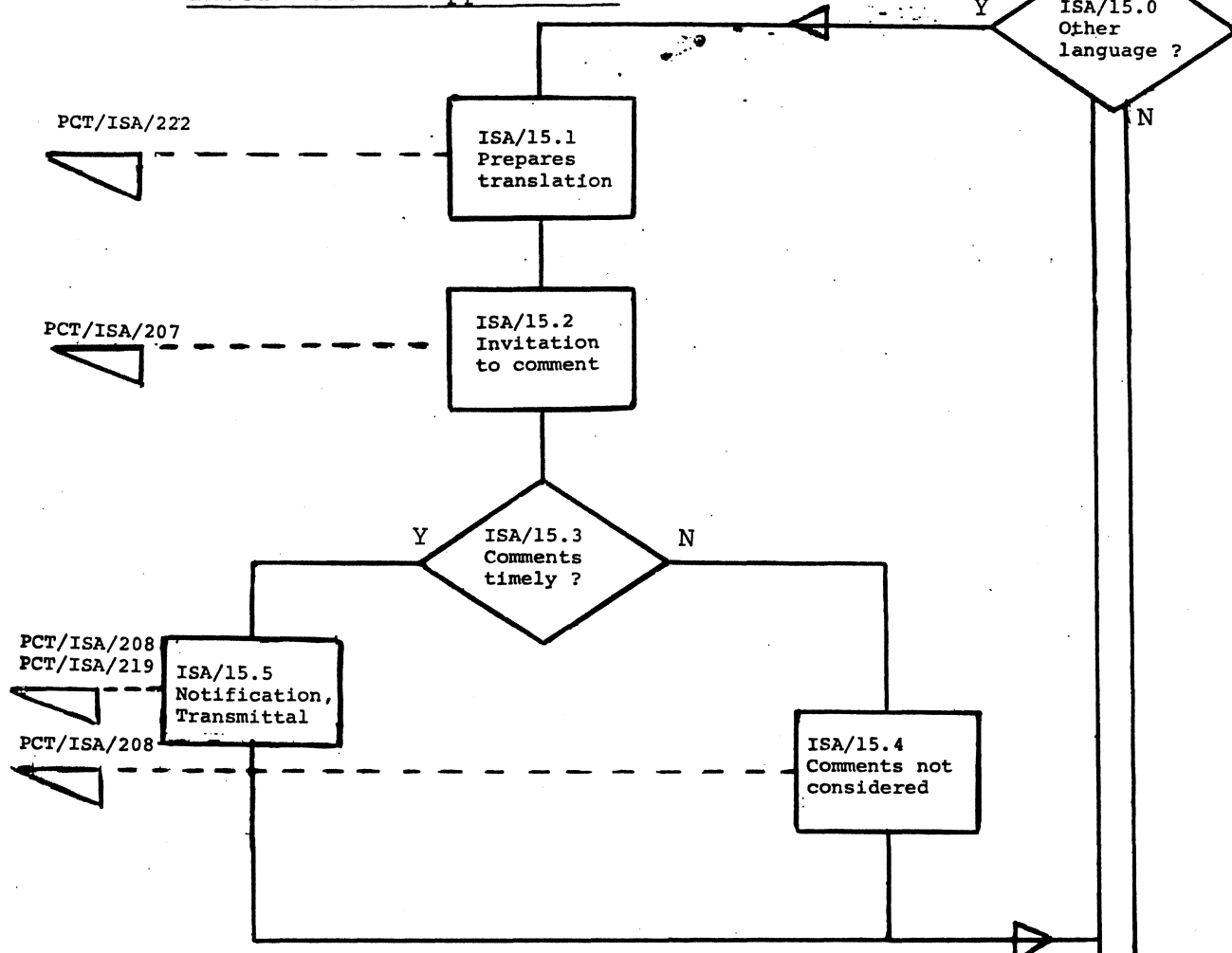
Y

ISA/14.1
Opted for Inter-
national Bureau ?

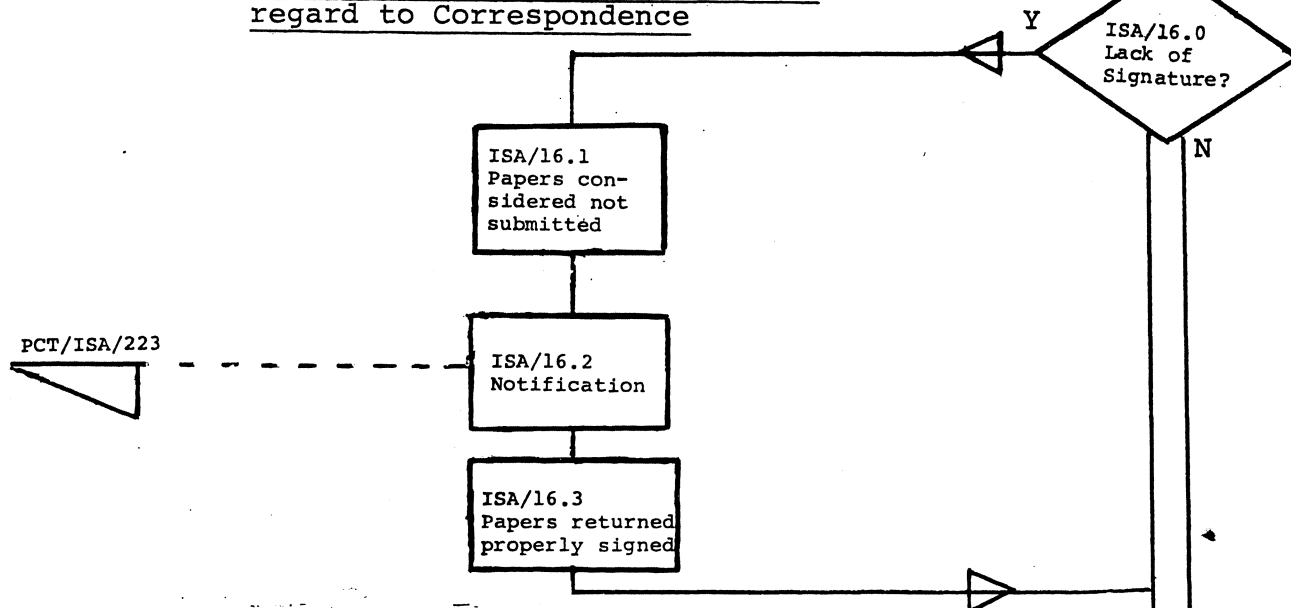
N

PCT/ISA/211 and
PCT/ISA/221ISA/14.3
Transmits

ISA/15

Rule 48.3(b) Translation of
International Application

ISA/16

Rule 92 Need for Signature with
regard to Correspondence

ISA/17

Rule 93.3 Keeping of Records and Files