

WIPO



PCT/TCO/VII/8

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DATE: September 5, 1977

WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

Seventh Session

Geneva, October 12 to 18, 1977

ADDENDUM TO DOCUMENT PCT/TCO/VII/6

Final comments on the Draft Guidelines for International
Preliminary Examination to be Carried Out under the
Patent Cooperation Treaty (PCT)

1. This document contains, in its annexes, the final comments of the members of the Working Group on Guidelines for International Search and for International Preliminary Examination on the Draft Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT) (see document PCT/TCO/VII/6, paragraph 3, fifth sentence, and paragraph 4).

2. The said annexes, containing the said final comments (in order of receipt), are as follows:

- Annex A: comments received from the Patent Office of the United Kingdom;
- Annex B: comments received from the Patent Office of Sweden;
- Annex C: comments received from the International Patent Institute (IIB);
- Annex D: comments received from the Council of European Industrial Federations (CEIF);
- Annex E: comments received from the Patent Office of the Netherlands.

[Annex A follows]



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Mr E M Haddrick
Lead PCT Division
World Intellectual Property Organisation
12 Chemin des Colombettes
CH-1211 Geneva 20
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Your reference

Our reference IPCD 40113

Date 29 July 1977

Dear Mr Haddrick

Guidelines for International Preliminary Examination

In accordance with the procedure agreed at the June meeting of the Working Group on the above guidelines, I am forwarding to you the comments of the UK delegation on the Annex to circular No 2877. They are as follows:-

- Chapter I para 1.6 . - The first "the" in line 1 should be deleted.
- Chapter I para 4.3 .. The words "with which the preliminary examination report is primarily concerned" have been omitted from the end of this paragraph. This vital qualification was agreed in the draft report.
- Chapter II para 5.1 - The marginal reference to Rule 7 is inappropriate.
- Chapter III para 3.2 . - The word "only" on line 11 should be deleted.
- Chapter III para 3.3 - Line 13 on page 11 should have the reference "(4)" inserted before the word "where".
- Chapter III para 6.5 - The words "states in vague terms that other means" have been omitted after the word "merely" on line 12.

- Chapter VI para 4.12 - Reference should be made to Article 17(2) (a) (ii).
- Chapter VI para 5.18 - The reference to Rule 66.8 (a) is incorrect (see para 7.2).
- Chapter VI para 8.2 - The words "by the examiner" at the end of the paragraph should be deleted. Certain parts of the form may not be completed by the Examiner.

Yours sincerely

M F Vivian

(Principal Examiner, Patents II)

PCT/TCO/VII/8
ANNEX A



August 8, 1977

Mr. E.M. Haddrick
Head, PCT Division
WIPO
32, chemin des Colombettes
1211 Genève 20
Schweiz

In reply to WIPO circular 2877 regarding comments on draft Guidelines, the Swedish delegation wants to draw your attention to the following points:

Chapter II par. 4.11 (page 6 of the doc.): The insufficiencies here mentioned are not of a nature to be rectified but rather inherent in the invention as such. The point would be better clarified if first sentence of the corresponding par. in the EPO guidelines were also included (see Part C page 12 of the EPO guidelines).

Chapter III par. 3.2 (page 10), last sentence: It appears that the original wording of the EPO guidelines has been somewhat jumbled. The present sentence says the same thing in both its parts. It should be positively mentioned in the first part that the examiner should draw attention to unnecessary proliferation of claims (suggested change: delete the word "only").

Chapter III par. 3.3 point (3) of the last sentence (page 11): The latter part of this sentence is not separated by a special digit from the former, although two entirely different cases are intended. We have further some hesitation about the example of a "known substance for a number of distinct medical uses". There may be a theoretical controversy involved in that some may argue that medicines as products should not be characterized by particular uses. There are other examples in the EPO guidelines better suited for the PCT.

[Annex C follows]

- 2 -

Chapter V par. 1.1, last sentence (page 27): The wording of this sentence is not quite clear. It is suggested that the words "relevant dates of prior art" are exchanged for "the state of the art relevant" (cf EPO guidelines part C page 107 third sentence).

Chapter V par. 2.4 (page 28): The statement about broadening of claims appears too sweeping. In our opinion a widening of the scope of the invention must have clear justification in the disclosure at the priority date, e.g. the broadening of the invention should be obvious to the person skilled in the art and not require further invention.

Chapter V par. 3.2 (page 29): It is noted that in the PCT there is nowhere a definition that clearly places a patent granted by the European Patent Office and not involving so called Community patents, under the term "regional patent". Thus, if an applicant has filed applications for national European patents say in Austria and Sweden through the EPO, it is not clear that this case is also intended to fall under this par.

Chapter VI par. 7.11, last sentence (page 40): We are rather hesitant about allowing adding particular details, such as in the case of the helical springs not specifically mentioned in the original disclosure. It could place the examiner into delicate positions of judgments and could, if this judgment is not absolutely selfevident, mislead designated offices. If, in fact, the detailing is selfevident it seems that a specific mention thereof would be superfluous. Anyway, if protection would cover these "selfevident" additions would clearly be a question for national law and should not be prejudiced by a PCT opinion.

Chapter VI par. 8.10 (b): The meaning is not quite evident. Should further reasoning really be necessary if the judgment is a positive one? If there is a miswriting and "positive" stands for "negative" it seems that (b) is superfluous in view of what is covered already by (a).

Sincerely yours,

Saul Lewin
Saul Lewin
Deputy Director General

PCT/TCO/VI/8
ANNEX B



PCT/TCO/VII/8

ANNEX C

INSTITUT INTERNATIONAL DES BREVETS

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ADRESSE TÉLÉGRAPHIQUE:

BREVPATENT

TÉLEX No. 31.651

ADRESSE:

PATENTLAAN 2. RIJSWIJK (Z.H.)

(PAYS-BAS)

Mr. M. HADDRICK,

Head PCT Section,

WIPO,

32, Chemin des Colombettes,

1211-GENEVE 20-SUISSE.

JVV/MB.

RIJSWIJK (Z.H.), le August 16, 1977.

Dear Mr. Haddrick,

With regard to the Draft Guidelines for International Preliminary Examination, we have to offer the following comments :

Page 14, § 6.5. : In the penultimate line of this paragraph after the word "merely" the following words should be inserted: "states in vague terms that other means".

Page 19, § 5.2 In the fifth line "of" should read "or".

Page 33, § 4.5. At the end of § 4.5 should be added:
"The translation must contain a signed statement by the applicant, that the translation is, to the best of the applicant's knowledge, complete and faithful."

Page 33, § 4.6. Lines 4 to 9 should be replaced by the following wording :
"(appli)cation and/or the signed statement within one month of the date of the invitation. The International Preliminary Examining Authority must determine whether the translation and the signed statement have been filed within this time limit and, if not, notify".

Page 39, § 7.7. In the 2nd. line "and" should read "any".

Yours sincerely

J.A.H. Van Voorthuizen.
Dep. Technical Director.

[Annex D follows]

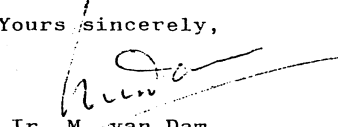
15-08-1977

Mr. E.M. Haddrick
Head, PCT Division
World Intellectual Property Organisation
32, Chemin des Colombettes
1211 Genève 20
Suisse

Dear Sir,

Referring to your letter dated July 18, 1977
concerning Draft Guidelines for International Preliminary
Examination (Annex to Circular No. 2877) I send you on be-
half of the Council of European Industrial Federations
./. (CEIF) the enclosed comments on said Annex.

Yours sincerely,


Ir. M. van Dam

COMMENTS, MADE ON BEHALF OF CEIF, ON THE DRAFT
GUIDELINES FOR INTERNATIONAL PRELIMINARY EXAMINATION
(ANNEX TO CIRCULAR NO. 2877).

1.) Chapter II, paragraph 4.6. (page 5).

It is suggested to replace the words "any particular
product or process" in the 12th line of this paragraph
by "any product or process of any particular person other
than the applicant". This is the exact wording of Rule
9.1. (iii); the applicant can not be forbidden to disparage
his own product or process.

2.) Chapter II, paragraph 6.1. (page 8).

The reference in the third line to Chapter IV, Section
2 seems meaning less since that Section does not relate
to "Expressions, etc, not to be used", but to "subject
matter not to be examined", (Rule 67).

3.) Chapter II, paragraph 6.4. (page 8).

In the second line the word "failing" should be
"falling".

4.) Chapter IV, paragraph 2.4. (d). (page 18).

In the reference in the margin: (v) should be (iv).

5.) Chapter IV, paragraph 2.6. (page 19).

In the first line Article 34(a)(i) should be
34 (4) (a) (i).

6.) Chapter IV, paragraph 6.3. (page 20).

This paragraph relates to the case of copending inter-
national applications of the same date. However there may
also be situations where an international application is
copending with a national application or patent of the
same date. The observations made in this paragraph 6.3.

Encl.: ./.

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are also applicable to those situations. It might be considered usefull to amend paragraph 6.3. in such a way that those situations are also taken into account.

7.) Chapter VI, paragraph 2.2. (page 31).

This paragraph is incomplete in so far as not all actions of the International Bureau by which the confidentiality is lifted are mentioned. Following improved wording is suggested:

PCT Art. 18	2.2. The international preliminary examination report is not published and is confidential; however the International Bureau communicates that report together with a translation
PCT Art. 36(3)(a)	if necessary, to each elected Office. The very fact that international preliminary examination has been demanded remains also Confidential, however the International Bureau
PCT Art. 31 (7)	notifies each elected Office of its election. Possible withdrawal of the demand or of any or all elections are confidential too, however the International Bureau notifies each
PCT Art. 37(3)(b)	elected Office concerned of the withdrawal of its election".

8.) Chapter VI, paragraphs 4.5 and 4.6. (page 33).

The requirement that the translation must contain a signed statement by the applicant, now referred to in the second sentence of paragraph 4.6., could better be placed at the end of paragraph 4.5. It is namely possible that applicant timely submitted a translation under paragraph 4.5, but did not make therein a statement about its completeness and faithfulness. In that case the International Preliminary Examining Authority should not invite the applicant

(paragraph 4.6.) to submit the translation, but it should invite the applicant to provide the translation already submitted with the required statement. Therefore the following amendments are suggested:

- a) At the end of paragraph 4.5 a sentence is added:
"The translation submitted by the applicant must contain a signed statement by the applicant that the translation is, to the best of the applicant's knowledge, complete and faithful".
- b) That sentence should be accompanied by a reference in the margin to PCT Rule 55.2 (c).
- c) In paragraph 4.6. the lines 4-7 are replaced by:
"cation or to provide the translation with the required signed statement, within one month of the date of the invitation. The International Preliminary Examining Authority must determine.....".
- d) The reference to PCT Rule 55.2 (c) in the margin along the present paragraph 4.6. can be deleted.

9.) Chapter VI, paragraph 7.1. (page 39).

The second sentence of this paragraph requires that any amendment to the international application shall be made in the same language as the said application. Reference is made to Rule 12.2., from which it is clear that the language of the application as filed is meant. However, where the International Preliminary Examining Authority requires under Rule 55.2.(a) a translation of the international application into one of its working languages, the examination will de facto be carried out on this translation. The dialogue between the examining Authority and the applicant will certainly be in the language of that translation. When during this dialogue the examining Authority suggests amendments or the applicant submits amendments, this will of course be done in the language of the translation required by the examining Authority under Rule 55.2. (a) and not in the language referred to in the second sentence of paragraph 7.1.

This anomaly is not remedied by paragraphs 7.2 and 7.5. Paragraph 7.2 provides that amendments must be made by filing replacement sheets accompanied by a letter. According to paragraph 7.5 (and Rule 92.2 (c)) this letter (but not the accompanying amendments) must be in the language of the translation required under Rule 55.2 (a).

In order to make it possible to file amendments in the language in which the preliminary examination is carried out, it is suggested to delete the second sentence of paragraph 7.1 and to interpret paragraph 7.5 in such a way that it does not only apply to "letters" but to all papers submitted by the applicant to the examining Authority.

(End of the comments).

[Annex E follows]

ANNEX A

uw brief van	uw nummer	ons nummer	bijlagen
18-7-1977	C.2877/PCT 081.31	S 77/368	-2-

datum 18 augustus 1977

onderwerp

WIPO
Mr. E.M. Haddrick
Head PCT Division
32, chemin des Colombettes
1211 Genève 20
Switzerland

Dear Mr. Haddrick,

In reply to your letter of July 18, 1977 (circular no. 2877) we herewith send you our remarks regarding the Draft Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT) as annexed to circular no. 2877 and our remarks regarding the report of the June meeting of the Working Group (document PCT/WG/GSE/II/5).

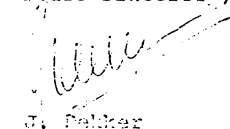
Our remarks are contained in two annexes to this letter, Annex A and Annex B.

Annex A contains our remarks regarding the Draft Guidelines. Each remark is accompanied by an indication of the paragraph to which it relates; if such paragraph also was mentioned in document PCT/WG/GSE/II/5 the relevant item number used in that document is indicated too. Most of the remarks deal with relatively small amendments. However in our opinion the remarks concerning the following paragraphs are of a more substantial nature:

- . Chapter VI, paragraphs 5.7 and 5.8
- . Chapter VI, paragraph 5.13
- . Chapter VI, paragraph 7.24.

Annex B contains our remarks regarding the items 1-16 of document PCT/WG/GSE/II/5, i.e. the items reflecting the general discussion of the Working Group at the June meeting.

Yours sincerely,



J. Fekker

Remarks regarding the annex to circular no. 2877:

"Draft Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT)"

Table of Contents

In several instances there is a difference between the wording used in the Table of Contents and the wording of the corresponding heading in the Guidelines. We have noticed the following ones:

. Chapter III, Section 7, third sub-heading:

"Unity of invention in relation to international search".

We prefer the title preceeding Chapter III, paragraph 7.8.

. Chapter IV, Section 2, second sub-heading:

"Plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes".

In view of PCT Rule 67.1 (ii) we prefer the wording used in Chapter IV, paragraph 2.4, item (b).

. Chapter VI, Section 8, third and fifth sub-headings:

"Basis of the report" and

"Non-written disclosures and certain published documents".

We prefer the titles preceeding Chapter VI, paragraphs 8.4 and 8.12.

Chapter I, paragraphs 1.3, line 2, and 1.4, line 1, (item 17) and Chapter VI, paragraph 1.1, line 6 (item 98).

In order to avoid possible confusion we propose to add in these paragraphs after the words "Chapter II" the words "of the Treaty"

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ANNEX A

cf Chapter I, paragraph 1.1. Such an addition will make it clear that "Chapter II" in the paragraphs mentioned does not refer to Chapter II of the Guidelines.

Chapter I, paragraph 1.5 (item 17).

In our opinion PCT Art. 40(1) is the relevant Article here and not PCT Art. 39(1). Furthermore we would like to express somewhat more clearly under which circumstances PCT Art. 40(1) is applicable. Therefore we propose the following amendments:

. On line 1 - Insert between "that" and "the":

" , provided the election of a Contracting State of the PCT has been effected prior to the expiration of the 19th month after the priority date,".

. On line 4 - Insert between "date" and "when":

"(PCT Article 40(1))".

. On lines 5 and 6 - Delete "(PCT Article 39(1))".

Chapter II, paragraph 2.2, line 4, (item 19) and

Chapter II, paragraph 3.2, line 6, (item 20).

In our opinion there should be a (second) bracket after the expression "(PCT)", since this expression is part of a sentence placed between brackets.

Chapter II, Section 3.

In title of Section delete the words "of the international application".

Chapter II, paragraph 4.13 (item 29).

On the second line of this paragraph in our opinion PCT Rule 5.1(a) should be mentioned instead of PCT Rule 5.1(b): "The manner of presentation should be that specified in PCT Rule 5.1(a) unless ... ". The marginal reference to PCT Rule 5.1(b)

of course is correct.

Chapter II, paragraph 4.17 (item 33).

The third sentence is difficult to comprehend, and we suggest to replace lines 9-11 of this sentence by the following more simple wording:

"In the latter case the reference to such document, supplemented or replaced by an indication of such background".

Chapter II, paragraph 6.1 (item 35).

In our opinion the reference to Chapter IV, Section 2, should be deleted, since this Section does not deal with "expressions not to be used".

Chapter II, paragraph 6.4 (item 36).

On the second line the word "failing" should be replaced by "falling" (cf the corresponding paragraph in document PCT/WG/GSE/II/2).

Chapter III, paragraph 3.1 (item 42).

On line 1 there should be a quotation mark after "categories" (cf the corresponding paragraph in document PCT/WG/GSE/II/2) and a comma after "apparatus" (cf PCT Rule 13.3).

Chapter III, paragraph 3.3, page 11 (item 44).

Since the last sentence of this paragraph describes four examples, we propose the following amendment:

. on the fifth line from the bottom - insert "(4)" between "and" and "where".

Chapter III, paragraph 4.1 (item 48).

In our opinion twice the word "to" has been omitted in this paragraph. We propose the following amendments:

- . Line 2 - Insert "to" between "also" and "the" (cf the corresponding paragraph in document PCT/WG/GSE/II/2).
- . Line 4 - Insert "to" between "and" and "he".

Chapter III, paragraph 5.1.

Regarding independent claims in the same category a reference to Chapter III, paragraph 3.3 in our opinion is more relevant than the present reference to Chapter III, paragraph 3.4.

Chapter III, paragraph 6.5 (item 57).

A part of the last sentence seems to have been erroneously omitted. Therefore we propose to amend the last sentence as follows:

Insert between "merely" and "may" the words: "states in vague terms that other means".

Chapter III, paragraph 7.6 (item 60).

We would like to make two remarks regarding this paragraph.

- 1) In view of PCT Art. 33(6) we propose to add the following words at the end of the second sentence of this paragraph: "or, in accordance with PCT Art. 33(6), by any additional document considered to be relevant". A similar amendment has been made by the Working Group in Chapter III, paragraph 2.2 and in Chapter III, paragraph 7.10.
- 2) Furthermore we want to notice a small drafting point. On line 5 the comma between "matter" and "of" should be deleted (cf the corresponding paragraph in document PCT/WG/GSE/II/2).

Chapter IV, paragraph 2.4, page 18 (item 68).

In item (d) of this paragraph the reference in the margin should be to PCT Rule 67.1 (iv). In the same item on the third

line "carrv" should be replaced by "carry".

In item (f) of this paragraph on line 9 we propose to insert the words "as well" between "excluded" and "as".

Chapter IV, paragraph 5.2 (item 75).

On line 5 one should read "the use or dissemination of such knowledge" (cf the corresponding paragraph in document PCT/WG/GSE/II/3).

Chapter IV, paragraph 5.4 (item 77).

We see no reason for inclusion of a reference to PCT Art. 2(xi) in the margin of this paragraph. For the purpose of computing time limits the priority date means the filing date of only the earliest application whose priority is claimed, regardless whether this priority has been validly claimed or not. For the purpose of prior art however each claimed priority date will be a relevant date as is explained in this paragraph 5.4, if the priority concerned has been validly claimed; in case not one priority has been validly claimed the filing date is the only relevant date.

Therefore the situation with regard to prior art (PCT Rule 64.1) is quite different from the situation with regard to computing time limits (PCT Art. 2 (xi)). In our opinion the reference made in this paragraph to PCT Art. 2 (xi) should be deleted.

Chapter IV, paragraph 6.1 (item 78) and

Chapter V, paragraph 2.1 (item 92).

In view of the discussion of the Working Group with regard to PCT Rules 64.2 and 64.3 (see item 15 of document PCT/WG/GSE/II/5), the amendment accented by the Working Group with respect to Chapter VI, paragraph 8.12, and the wording of Chapter IV,

paragraph 5.3, we propose to amend Chapter IV, paragraph 6.1, as follows: on line 3 - insert the words "on or" between "published" and "after".

For the same reason we propose to insert the words "on or" between "published" and "after" on line 11 of Chapter V, paragraph 2.1.

Chapter IV, paragraph 8.1.

We do not quite understand the last sentence of this paragraph, especially the part starting with "but also whether". A solution may be to replace the last sentence of paragraph 8.1 by the last sentence of PCT Rule 65.1, (however starting with "He" instead of "It"), which would be in conformity with the wording of Chapter IV, paragraph 8.7.

Chapter IV, paragraph 8.3 (item 83).

In connection with prior art the expression "relevant date" in our opinion is a much better one than "priority date" (see PCT Rule 64.1). Therefore we propose to replace the word "priority" on the lines 2 and 12 by "relevant".

Chapter IV, paragraph 8.8, page 25 (item 85).

In our opinion the Working Group with regard to item (C 2) (ii) of this paragraph agreed to replace the words "a small number of" by "particular". Therefore in the first line of item (C 2) (ii) the words "a" and "number of" should be deleted; after this amendment the wording will be the same as in the corresponding paragraph in the European Guidelines.

Chapter V, paragraph 3.2.

On the first line the words "in the International Preliminary Examining Authority" may be deleted. A similar amendment has

been made in many other paragraphs (see also Chapter I, paragraph 2.2).

Chapter V, paragraph 3.3 (item 97).

In our opinion the reference made on line 4 should be to Chapter V, paragraph 3.1.

Chapter VI, paragraph 1.2 (item 99).

In accordance with a decision of the Working Group the expression "Contracting States" on lines 3 and 5 has been replaced by "Receiving Offices"; in our opinion a further amendment of the second sentence is now necessary. We propose to replace the last part of the second sentence, starting on line 7 with "the national Offices of" (including the part in brackets on lines 7 and 8) by "these receiving Offices".

Chapter VI, paragraph 4.1 (item 105) and

Chapter VI, paragraph 4.2 (item 106).

In relation to the fourth item mentioned in paragraph 4.2 in our opinion notifications under PCT Rule 62.2 (b) should be taken into account, since thereafter the examination may start (PCT Rule 69.1 (b) (ii)). Therefore we propose the following additional item to follow the fourth item of paragraph 4.2:

" - A notification to the effect that no amendments have been filed under PCT Article 19 within the prescribed time limit, or that the applicant has declared that he does not wish to make such amendments: by the International Bureau".

Also a reference to PCT Rule 62.2 (b) should then be included in the margin.

For similar reasons we propose the following amendment on line 8 of paragraph 4.1:

After "date;" - insert "a notification that no amendments have been filed or will be filed under PCT Article 19;".

Chapter VI, paragraph 4.4.

In order to bring the wording of this paragraph in line with the wording of Chapter VI, paragraphs 4.1, 4.2 and 4.5, we propose to insert on lines 1 and 2 the word "national" between "same" and "Office".

Chapter VI, paragraph 4.12 (item 115).

On lines 5 and 6 the reference made should be to PCT Article 17(2) (a) (11).

Chapter VI, paragraph 5.4 (item 118).

We do not understand why a reference to Chapter III, paragraph 7.6 has been included. In our opinion a reference to Chapter III, paragraph 7.9 is more appropriate. Therefore we propose to amend the portion between brackets on the last line as follows:

"(see also Chapter III, paragraph 7.9)".

Chapter VI, paragraph 5.7 (item 121) and

Chapter VI, paragraph 5.8 (item 122).

We would like to make three remarks regarding these paragraphs:

- 1) In the present text of paragraph 5.8 the first part of the first line actually introduces no restriction at all, since protests must be accompanied by payment of additional fees. Therefore we suggest the following modification:

Replace the first two lines of paragraph 5.8 by "If the applicant timely complied with the invitation to restrict the claims or to pay additional fees (without filing a protest, see Chapter VI, paragraph 5.7), the examiner will

there - ".

- 2) Since in case of a protest by the applicant a three-member board will decide whether the international application complies with the requirement of unity of invention or not, the examiner in our opinion should not carry out the international preliminary examination until the three-member board has taken its decision. Therefore we propose to amend paragraph 5.7 as follows:

. Line 2 - insert between "case," and "a":

"the preliminary examination is stayed pending examination of the applicant's protest and decision on the justification thereof by".

. Lines 4 and 5 - place a full stop after "protest)" on line 4 and delete the fifth line.

- 3) As already indicated at the June meeting of the Working Group we maintain our opinion that logically the paragraphs 5.7 and 5.8 should be interchanged.

Chapter VI, paragraph 5.13 (item 127).

Now the Working Group has agreed to replace in the second sentence the words "concurrently with the examiner's first written opinion" on line 9 by "in the examiner's first written opinion", in our opinion there should not be a reference to Chapter VI, paragraphs 5.5 to 5.9 in the same sentence. The procedure according to PCT Rule 68, which is described in the paragraphs just mentioned (and for which a separate form PCT/IPEA/405 has been adopted), is quite different from the procedure according to PCT Rule 66.2; f.i. the definitions of the time limits are different and the applicant under PCT Rule 68 has no possibility to submit counter-arguments unless he complies under protest.

Therefore we propose to delete from the second sentence the reference to Chapter VI, paragraphs 5.5 to 5.9 and to insert the following sentence between the second and third sentence: "If in the opinion of the examiner the response of the applicant (see Chapter VI, paragraph 6.1) does not take away the objection of lack of unity of invention, the examiner thereafter shall adopt the procedure described in Chapter VI, paragraphs 5.5 to 5.9."

Chapter VI, paragraph 5.14 (item 128).

On line 4 we propose to replace the expression "(such)" by the word "The" in accordance with PCT Rule 66.2 (d).

Chapter VI, paragraph 6.1.

In view of the wording of PCT Rule 66.4 (b) we propose to replace on the last line the words "additional or more" by "or more additional".

Chapter VI, Section 7.

The first sub-heading in this Section should be brought into conformity with the wording used in the Table of Contents by deleting the word "the".

Chapter VI, paragraph 7.5 (item 136).

We would like to make two remarks regarding this paragraph.

- 1) If our recollection is correct the last sentence from the corresponding paragraph in document PCT/WG/GSE/II/3 has not been deleted by the Working Group. We would like to have this sentence restored.
- 2) On line 4 the reference made to PCT Rule 2 could be made more clear by amending the wording between brackets as

follows: "(as defined in PCT Rule 2.1)".

Chapter VI, paragraph 7.7 (item 137).

On line 2 the word "and" should be replaced by "any".

Chapter VI, paragraph 7.20 (item 146).

Since the Working Group decided to replace on the first line the word "defect" by "objection", in our opinion the same change should be made in the second line.

Chapter VI, paragraph 7.24 (item 149).

Since the additional documents mentioned are not known to the applicant, it may be advisable to send the applicant copies of these documents. Therefore we propose to add to this paragraph the following sentence which, if our recollection is correct, is in agreement with the discussion of the Working Group regarding this paragraph:

"If such an additional document is mentioned by the examiner in a written opinion, a copy of the document will be submitted to the applicant, if the agreement between the International Preliminary Examining Authority and the International Bureau so provides (Chapter VI, paragraph 1.2)".

Chapter VI, paragraph 8.1 (item 150).

After the amendments agreed upon by the Working Group the reference in the margin to PCT Rule 70.6 (b) in our opinion is no longer relevant.

Chapter VI, paragraph 8.3 (item 151).

We would like to make more clear why a reference has been made to Chapter V of the Search Guidelines. Also there should be on line 19 another bracket after "PCT" because the expression

"(PCT)" itself is part of a sentence placed between brackets. Furthermore the quotation mark before "Guidelines" on line 18 should be deleted, cf Chapter II, paragraphs 2.2 and 3.2. Therefore we propose to amend on lines 17-19 the part between brackets as follows: "(see Chapter V, Classification of International Applications, of the Guidelines for International Search to be Carried Out under the Patent Cooperation Treaty (PCT))".

Chapter VI, paragraph 8.8 (item 156).

In view of the last sentence of this paragraph a reference in the margin to PCT Rule 68.1 in our opinion is more appropriate than the present reference to PCT Rule 70.12 (1).

Chapter VI, paragraph 8.15 (item 162).

On line 5 a letter "n" has disappeared from the word "examination".

Chapter VI, paragraph 8.16 (item 163).

We propose to put a full stop after the word "Authority" on line 7 and to delete the rest of the last sentence. The subject matter so deleted already has been covered by the first sentence of this paragraph.

ANNEX B

Remarks regarding the items 1-16 contained in document PCT/WG/GSE/II/5

Item 15, page 4, final block of text.

The present wording is not fully consistent with the wording of PCT Rule 64.2, since it is not the document, but the original non-written disclosure for which the matter of becoming part of the prior art arises. Therefore we suggest the following amendments:

- . line 2, after "whether" at the end of the line insert: "in the case of"
- . line 4, after "date," insert: "the non-written disclosure"
- . line 7, replace "document" by "non-written disclosure".