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INTERIM COMMITTEE FOR TECHNICAL COOPERATION

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QUESTIONS RELATING TO
INTERNATIONAL PRELIMINARY EXAMINATION

Memorandum from the International Bureau

1. The Working Group on Guidelines for International Search and for International Preliminary Examination (hereinafter referred to as "the Working Group"), established by the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee") at its sixth session held in Geneva from November 3 to 8, 1976, asked, in the course of the Working Group's second (June 1977) session, that the International Bureau consider certain questions relating to international preliminary examination (see the report of the said second session, document PCT/WG/GSE/II/5, paragraph 15).

2. The said questions are set out in this memorandum within quotation marks and in the same form as they appeared in the report of the said session of the Working Group, i.e., in relation to specified paragraphs of the Guidelines for International Preliminary Examination to be Carried out under the Patent Cooperation Treaty (PCT) (referred to in the said report and in this memorandum as "the PCT Guidelines"). The conclusions of the International Bureau are set out after each question which it was asked to consider.

"(1) Chapter V, paragraph 3.3 and Chapter VI, paragraph 4.9:

The furnishing of a certified copy of the priority document to the International Preliminary Examining Authority under the procedure provided by PCT Rule 66.7(a) with appropriate advice to applicants in the part of the Guidelines for Applicants filing under the PCT relating to Chapter II."

3. The procedure under Rule 66.7 provides for the International Preliminary Examining Authority to be furnished with a copy of a priority document referred to in the international application either by the International Bureau or, where the request is made before the International Bureau has received the priority document under Rule 17.1(a), by the applicant. In the latter case, the applicant is also required to furnish such copy to the International Bureau. Any copy of a priority document furnished to the International Bureau under Rule 17.1(a) must be "certified by the authority with which it was filed." The copy with which the International Preliminary Examining Authority will be furnished by the International Bureau under Rule 66.7(a) must clearly be a copy of the certified copy of the priority document furnished by the applicant under Rule 17.1(a). The copy furnished by the applicant to the International Bureau, in response to the invitation of the International Preliminary Examining Authority under Rule 66.7, would need to be a certified copy having regard to the requirements of Rule 17.1(a).

4. It is to be noted that Section VI, paragraph 4.9 of the PCT Guidelines provides for the applicant to be invited to furnish the International Preliminary Examining Authority with a certified copy of the priority document. The relevant form under the Administrative Instructions (Form PCT/IPEA/414) does not, however, specify a certified copy. It would seem neither practical nor necessary that the applicant be required to furnish two certified copies, one for the International Bureau and one for the International Preliminary Examining Authority, provided that the copy furnished by the applicant to the International Preliminary Examining Authority is a copy of the certified copy which he must, in any event, furnish to the International Bureau. Where the International Preliminary Examining Authority has doubt whether the copy furnished by the applicant is a true copy, it could always ask the International Bureau to provide a copy for the purposes of verification.

5. Should the Interim Committee agree with the views expressed in paragraph 4, Section VI, paragraph 4.9 of the PCT Guidelines should be amended accordingly. Appropriate information can be included in the Chapter relating to Chapter II of the PCT which is to be added to the Guidelines for Applicants taking into account the decision of the Interim Committee on this question.

"(2) Chapter VI, paragraph 4.2:

The provision to the International Preliminary Examining Authorities of copies of documents cited in international search reports, taking into account the provisions of PCT Rule 44.3."

6. Article 20(3) places on the International Searching Authority the obligation of sending to designated Offices and applicants, upon request, copies of documents cited in international search reports. Rule 44.3 specifies particulars as to the making of such requests, charges for preparing and making copies and the mode of sending the copies. There is no comparable obligation under the Treaty and Regulations as regards the sending of copies of cited documents to International Preliminary Examining Authorities. However, since the obligation in relation to designated Offices and applicants is one for which, in any event, a charge may be made to cover costs, there would not seem to be any objection in principle to establishing a comparable arrangement for the International Preliminary Examining Authorities.

7. The International Preliminary Examining Authorities will have at their disposal, however, at least the minimum documentation referred to in Rule 34 and, thus, will be able to make for themselves copies of most cited documents. Any provision for the supply of copies to them on a regular basis rather than only occasionally according to specific need would therefore be one dictated by general economy of effort or convenience rather than by actual necessity. The attitude to what is required may vary from Authority to Authority.

8. It is to be expected, moreover, that the majority of the Offices which will act as International Preliminary Examining Authorities will also act as International Searching Authorities. Where this is so and an Office acts in both capacities in respect of the same international application, there will be no need to make provision for the supply of cited documents.

9. Any arrangement for the supply of copies of cited documents would need to be made in the light of the considerations already mentioned and having regard to the stage in the operations of the Authority (International Searching or International Preliminary Examining Authority, as the case may be) at which it would be most beneficial to make, to send or to receive copies of cited documents.

10. It is concluded that, once the identity is known of those Offices which will be the International Searching and International Preliminary Examining Authorities, at least at the commencement of operations under the PCT, a survey could be made by the International Bureau of the requirements of the International Preliminary Examining Authorities and the possibilities of meeting those requirements offered by the International Searching Authorities. In the light of that survey, proposals could be made, where necessary, for arrangements for the provision of copies of cited documents either on a basis comparable to that under Rule 44.3 or, more probably, on a bilateral basis.

"(3) Chapter VI, paragraph 4.6:

The consequences of the failure of the applicant to file, within the appropriate time limit, a translation of the international application when required under PCT Rule 55.2."

11. Rule 55.2 specifies time limits in relation to:

(a) submission of a translation, if a translation is required by the International Preliminary Examining Authority (Rule 55.2(b)); and

(b) compliance by the applicant, at the invitation of the International Preliminary Examining Authority, with the requirement to submit the translation (or the signed statement referred to in Rule 55.2(c)) where he has not done so within the time limit mentioned in (a) above, (Rule 55.2(d)).

12. If the applicant, having been invited to do so, fails to submit the translation (and/or the signed statement) within the time limit of one month from the date of the invitation prescribed in Rule 55.2(d), the demand will be considered as if it had not been submitted. In such a case, international preliminary examination will not be carried out.

"(4) Chapter VI, paragraph 4.7:

The inclusion, in an annex to the PCT Guidelines, of the requirements with respect to the demand."

13. It would be more appropriate to include such an annex, if thought necessary, as an annex to the document relating to Steps in the Procedure before the International Preliminary Examining Authority (see tasks 2, 3, 4 and 5 set out in that document, PCT/TCO/VII/4). Such an annex has, however, not been found necessary and consequently has not been included in the said document since the requirements as to the demand are apparent from the demand form (Form PCT/IPEA/401), to which reference is made in that document, and the notes to the said form.

"(5) Chapter VI, paragraph 5.11:

An amendment of the Regulations under the PCT (possibly PCT Rule 67) so that international preliminary examination need not be carried out to the extent that there is no international search report in respect of the international application."

14. The situations in which there is no international search report in respect of the international application or part thereof will arise by reason of the application of Article 17(2) and (3) and the Rules of the Regulations relating thereto. As regards the procedure under Chapter II of the PCT, the situations in which international preliminary examination may not be carried out must arise by the application of Article 34(3) and (4) and the Rules of the Regulations relating thereto. These two sets of provisions contain parallel but independent regimes in relation to international search and international preliminary examination. Under these regimes, search or examination may not be carried out having regard to three separate criteria:

(a) lack of unity of invention (if additional fees are not paid);

(b) the international application (or part thereof) relating to subject-matter which the Authority is not required to search or examine, as the case may be, and decides not to search or examine;

(c) no meaningful search or examination possible (for precise formulations see Articles 17(2)(a)(ii) and 34(4)(a)(ii)).

15. It is considered that the likelihood of an International Preliminary Examining Authority encountering difficulty is remote in view of the similarity of the criteria under the two regimes. Moreover, the procedure under Chapter II is optional and applicants knowing that no international search report exists and not having the benefit of such a report will hardly be likely to pay the fees for international preliminary examination.

16. Where, however, the applicant has made amendments to his international application in order to meet objections to it, he has a right to have it examined quite independently from any decision not to search taken under a different situation in the search phase. In the opinion of the International Bureau, it is at least doubtful whether, taking into account the separate nature of the two regimes mentioned above, an amendment of the Regulations of the kind suggested for consideration would be legally possible. Rather, it is felt that such an amendment would not be in conformity with the Treaty. In view of the doubts that exist as to the necessity for, and the legal possibility of, the amendment suggested for consideration, no amendment of the Regulations is proposed.

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