

WIPO



PCT/WG/1/12

ORIGINAL: English

DATE: May 8, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PATENT COOPERATION TREATY (PCT)
WORKING GROUP

First Session
Geneva, May 26 to 30, 2008

PROPOSALS REGARDING THE TREATMENT OF EXTRANEIOUS MATTER

Document prepared by the United States of America

SUMMARY

1. This document contains proposals for amendment of the Regulations under the PCT relating to the treatment of extraneous matter filed with the International application. Specifically, it is proposed that the PCT Rules¹ be amended to indicate that any extraneous matter filed with the international application will be considered to be an appendix and will not be treated as part of the international application.

BACKGROUND

2. PCT Article 3(2) states:

“An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.”

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be.

3. Further, the Regulations under the PCT only make reference to those parts of the international application, and in that context paragraph 148 of the Receiving Office Guidelines states, “The PCT makes no provision for appendices to the international application.”
4. In spite of the fact that no reference is made to the inclusion of appendices as part of the international application in the Treaty or Regulations, paragraph 148 goes on to require the receiving Office to process appendices by clarifying with the applicant whether or not they are to form part of the application. If applicant indicates that the appendices are to form part of the application, the receiving Office must then, in accordance with Section 207 of the Administrative Instructions and paragraphs 139 and 140 of the Receiving Office Guidelines, either redistribute and renumber the pages in the context of the rest of the application or invite applicant to do so.
5. These requirements of the Administrative Instructions and Receiving Office Guidelines add significant time to the processing of these applications and increase the workload on the receiving Offices, especially in applications where applicants indicate that the appendices are to form part of the application. This workload increase can be significant in situations where the appendix contains copies of prior applications or patents, as is often the case. In such situations, the receiving Offices must divide the different parts of additional applications/patents and renumber not only the page numbers, but the claims and figures, or invite applicants to do so.
6. The procedure set forth in the Receiving Office Guidelines leads to uncertainty as to the status of the subject matter included in the appendix in situations where applicant does not respond to the request for clarification as to whether or not it is to form part of the application.
7. In an effort to address these issues it is proposed that the Rules be amended to provide for the processing of extraneous matter which is filed with the international application. Specifically, it is proposed to provide that any subject matter not presented as a part of the application defined in Article 3(2) will be considered an appendix and automatically deemed to not form part of the international application, and the receiving Office shall notify applicant of such. If applicant desires for the additional subject matter to be treated as part of the international application, applicant must file a request for such treatment within a time limit of one (1) month from the notification. Further, in order to be effective, any such request must be accompanied by: (a) any reformatted and renumbered pages which are necessary to properly incorporate the additional pages into the existing description, claims, drawings, and abstract; (b) any additional fees for excess sheets which are due as a result of inclusion of the additional pages; and (c) any processing fee required by the receiving Office.
8. An additional issue related to the treatment of appendices is the added workload burden on the International Searching and Examining Authorities. In situations where the appendix contains copies of prior applications or patents which have been divided up and redistributed within the description, claims, and drawings of the international application, the presence of these additional descriptions, claims and drawings can have a significant impact on the International Authorities. Specifically, the presence of the additional descriptions, claims and drawings can create confusion for the Authorities as they attempt to determine exactly what constitutes applicant’s invention. Further, the presence of the additional claims needlessly increases the workload on the Authorities as they must search and examine claims which applicant never intended to be searched and examined.

9. In order to address the problem of workload on the Authorities, it is also proposed that the Rules be amended to provide that the claims portion of any prior patent document which was filed as part of an appendix, and which applicant has requested to be considered as part of the International application, is to be incorporated into the application as part of the description.

10. Finally, it is also envisioned that the Administrative Instructions will need to be modified to set forth the types of conditions that would constitute additional subject matter being considered an appendix which is automatically deemed to not form part of the international application. Such conditions could include: pages which have not been paid for; pages which have not been identified as part of the request, description, claims, drawings or abstract in the check list portion of the request form; prior patent documents; and pages or claims which are provided separately and which are not sequentially numbered. Additionally, the Administrative Instructions will need to be modified to set forth the specifics with respect to receiving Office processing of the appendix sheets upon receipt of an effective request that the appendix be included as part of the international application.

PROPOSAL TO AMEND THE RULES

11. Therefore, it is proposed that the rules be amended to indicate that extraneous matter submitted as appendices will be disregarded and will not form part of the international application.

12. The Working Group is invited to consider the proposals contained in the Annex.

[Annex follows]

ANNEX

PROPOSALS REGARDING THE TREATMENT OF EXTRANEOUS MATTER²

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 8bis

Extraneous Matter

8bis.1 Treatment

(a) Extraneous matter, as defined in the Administrative Instructions, not presented as a part of the application defined in Article 3(2) will be considered an appendix and, subject to Rule 8bis.2, will not form part of the international application.

(b) The receiving Office shall promptly notify applicant of the presence of subject matter under (a) and of the possibility to request under Rule 8bis.2 that the subject matter be included as part of the international application.

8bis.2 Request for Inclusion

(a) Subject to paragraph (b), subject matter under Rule 8bis.1 will be considered to form part of the international application upon a request by applicant.

(b) In order to be effective, a request under paragraph (a) must be filed within one month from the date of the notification under Rule 8bis.1(b) and must be accompanied by:

(i) any reformatted and renumbered sheets, claims or drawings which are necessary to properly incorporate the additional pages into the existing description, claims, drawings and abstract;

(ii) any additional international filing fee due;

(iii) any processing fee required by the receiving Office under paragraph (d);

[Rule 8bis.2(b), continued]

(iv) a statement that any reformatted and renumbered sheets, claims or drawings submitted under item (i) do not include any subject matter that is not identical to that as found in the originally filed papers.

(c) The claims portion of any [published] patent document originally filed as part of the appendix, and which applicant has requested form part of the international application under paragraph (a), shall be reformatted and renumbered under paragraph (b)(i) so as to be incorporated into the description part of the international application.

(d) The submission of a request under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a processing fee. The amount of that fee, if any, shall be fixed by the receiving Office.

(e) Upon receipt of an effective request for inclusion, the receiving Office shall proceed as provided in the Administrative Instructions.

[End of Annex and of document]