

Patent Cooperation Treaty (PCT) Working Group

Sixteenth Session
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FORMALITIES CHECKING IN THE PCT

Document prepared by the International Bureau

[This revised document contains corrections to a number of cross-references in the Annex at the points highlighted and adds a reference to Rule 29, explained by a new sentence at the end of paragraph 9.]

SUMMARY

1. The fifteenth session of the PCT Working Group considered a proposal for the centralization of formalities checking at the International Bureau. Although merits were seen in the principle, some States considered that national Offices were in a better position to provide the necessary level of service to their applicants. This document proposes an arrangement where receiving Offices may conduct formalities examination to the extent that they consider appropriate if they consider that this adds value for their applicants. However, Offices would be free to leave formalities checking solely to the International Bureau. Either way, where defects relevant to reasonably uniform international publication remain, the International Bureau would take these up directly with the applicant, rather than requesting the receiving Office to do so.
2. Clarifying the definition of what is “necessary for the purpose of reasonably uniform international publication” will continue as a separate exercise.

BACKGROUND

REQUIREMENTS OF FORMALITIES CHECKING

3. PCT Article 11 requires the receiving Office to check that a purported international application fulfils the minimum requirements to be given an international filing date. Article 14 then sets out a further set of checks on defects that should be corrected before the application proceeds to international publication. Specifically, Article 14(1) states:

(1)(a) The receiving Office shall check whether the international application contains any of the following defects, that is to say:

- (i) it is not signed as provided in the Regulations;
- (ii) it does not contain the prescribed indications concerning the applicant;
- (iii) it does not contain a title;
- (iv) it does not contain an abstract;
- (v) it does not comply to the extent provided in the Regulations with the prescribed physical requirements.

(b) If the receiving Office finds any of the said defects, it shall invite the applicant to correct the international application within the prescribed time limit, failing which that application shall be considered withdrawn and the receiving Office shall so declare.

4. The requirement of Article 14(1)(a)(v) is implemented by Rule 11 (which contains the actual physical requirements) and Rule 26.3. Rule 26.3(a) includes the following requirements (with similar requirements in paragraph (b) dealing with documents not filed in a language of publication and corresponding translations):

26.3 Checking of Physical Requirements under Article 14(1)(a)(v)

(a) Where the international application is filed in a language of publication, the receiving Office shall check:

- (i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;
- (ii) any translation furnished under Rule 12.3 for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.

DISCUSSIONS IN THE FIFTEENTH SESSION OF THE WORKING GROUP

5. The fifteenth session of the Working Group discussed a proposal to centralize checking of the physical requirements of the international application at the International Bureau (see document PCT/WG/15/6). Paragraphs 40 to 46 of the Summary by the Chair of the session (document PCT/WG/15/19) summarize these discussions, as follows:

“40. Discussions were based on document PCT/WG/15/6.

“41. Some delegations supported the proposal for the International Bureau to take on the primary role for formalities examination since it was in the best position to judge the requirements for the international publication for which it was responsible and to deliver a consistent result.

“42. Some other delegations doubted the benefits. Issues included that the receiving Office was able to perform a more timely check and remained responsible for other correspondence with the applicant, so introducing a second body might cause confusion. In countries where many applications were filed on paper, correspondence with the International Bureau could add considerable time and expense for applicants. There were also concerns over the consistency of the proposal with Article 14(1). Several of these delegations suggested that it was more appropriate to build on the existing system, but improving the communications between the receiving Office and International Bureau.

“43. Some delegations, while recognizing the difficulty of the task, noted that the International Bureau should attempt to define “reasonably uniform publication”, so that Offices and applicants alike could understand the requirements necessary in the filing and processing of international applications.

“44. A variety of drafting issues were raised, including concerns of consistency, possible duplication of duties and the need to include additional details concerning timing, changes to PCT Forms and procedures. Several Offices considered it undesirable for the International Authorities to play any role in correction of formalities defects other than through rectification of obvious mistakes or amendments as part of international preliminary examination. Further consideration was needed of the scope of issues related to “informal drawings”.

“45. The Secretariat indicated that it saw no consensus on the proposal, but noted that, in addition to the above points, it had heard strong interest in a variety of the issues, including the need to define clearly the requirements for physical requirements of the international application, bringing Rule 11 more into line with the requirements of electronic applications. A representative of users emphasized the importance of allowing color drawings as part of such changes. There was interest in the ability to point out certain formalities defects without necessarily requiring them to be corrected, though one Office considered that this would risk confusion and problems in the national phase. Independent of formalities checking, the Secretariat noted interest in expanding the languages for communication between applicants and the International Bureau and agreed to raise this issue separately at a future session of the Working Group.

“46. The Working Group invited the International Bureau to further investigate options for the improvement of formalities examination, taking into account the comments made.”

PROPOSAL

FORMALITIES EXAMINATION BY THE INTERNATIONAL BUREAU

6. Annex I contains a proposal to allow formalities examination by the International Bureau, but continuing to allow formalities examination by receiving Offices.

7. Receiving Offices would conduct the degree of examination of the physical requirements that they consider appropriate. This includes the option of not making any check of the physical requirements except in the exceptional case where the defects of an international application filed on paper are so significant that it is not possible to make a satisfactory record copy to send to the International Bureau.

8. Where the receiving Office does check the physical requirements, it would have the option of indicating any lack of compliance with Rule 11 so that the applicant can be given an opportunity to make corrections. However, as at present, the applicant should only be required to make corrections if the receiving Office considers that the defect is relevant for the purpose of reasonably uniform international publication.

9. The International Bureau would conduct the same formalities examination that it does at present. However, in the case of finding a defect considered relevant for the purpose of reasonably uniform international publication or satisfactory reproduction, the International Bureau would send an invitation for correction directly to the applicant, rather than asking the receiving Office to do so. In the event that no satisfactory response is received and the international application has not been brought into a suitable state for publication, the International Bureau would declare on behalf of the receiving Office that the international application is considered withdrawn. In that case, the International Bureau would take responsibility for informing the applicant, receiving Office and, if the search copy had been sent, the International Searching Authority, that the application was considered withdrawn.

10. Contrary to Rule 26, proposed Rule 28 does not specify the timing for examination by the International Bureau to issue an invitation to the applicant to correct any defects as this is dependent on the actions of the receiving Office. As at present, where the receiving Office issues an invitation to correct, the International Bureau would, where appropriate, defer its review of the international application until the applicant had responded to the receiving Office. Including the timing in Rule 28 would therefore need to cover various scenarios and add to the complexity of Regulations. Nonetheless, the International Bureau would complete the formalities examination as early as possible without interfering with any procedures at the receiving Office in order to avoid delays in international publication.

11. Proposed Rule 28 also differs from the proposal in document PCT/WG/15/6 in that it allows the International Bureau to invite the applicant directly to correct the omission of signatures or of prescribed indications concerning the applicant. Document PCT/WG/15/6 proposed to replace existing Rule 28.1(a) with a provision allowing the International Bureau to invite corrections of defects in the physical requirements, but accidentally deleted any mention of other defects. If the International Bureau is to invite the applicant directly to make corrections concerning the physical requirements, it would appear appropriate to do the same for these other defects, rather than inviting the receiving Office to invite corrections.

12. A proposal to amend Rule 92 to expand the languages of communication for the International Bureau is contained in document PCT/WG/16/2. This would permit the International Bureau to provide the invitations to correct in any of the ten languages of publication.

DEFINITION OF REQUIRED STANDARDS

13. The International Bureau will continue its attempts to define more clearly the requirements for reasonably uniform international publication with a view to updating the guidance in the PCT Receiving Office Guidelines.

14. However, the most important work in this area will be in developments related to *Processing International Applications in Full Text Format* (see document PCT/WG/15/14), including:

(a) Enabling the processing of full color drawings throughout at least the international phase. This will eliminate one of the most common defects - the submission of drawings that do not convert well to black and white image formats.

(b) Replacement of Rule 11 with requirements more relevant to electronic processing. The rule should preferably be reformulated in terms primarily based on what is necessary to process an application in XML format, including in images and other referenced files. It will nevertheless need to retain aspects concerning PDF and paper processing suitable for Offices in both the international and national phases.

15. *The Working Group is invited to consider the amendments in the Annex to document PCT/WG/16/3 Rev.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 26
Checking by, and Correcting before, the Receiving Office
of Certain Elements of the International Application

26.1 to 26.2bis [No change]

26.3 *Checking of Physical Requirements under Article 14(1)(a)(v)*

(a) The receiving Office shall check the international application and any translation furnished under Rules 12.3 or 12.4 for compliance with the physical requirements referred to in Rule 11 at least to the extent necessary to permit the record copy to be transmitted to the International Bureau.

(b) Where the receiving Office finds defects under Rule 11, the invitation to correct provided for in Article 14(1)(b) shall not require the applicant to correct a defect:

(i) in a document to form part of the international publication unless the correction is necessary for the purpose of reasonably uniform international publication, or

(ii) in any other document referred to in paragraph (a) unless the correction is necessary for the purpose of satisfactory reproduction.

(c) Where the receiving Office finds defects under Rule 11 that are not required to be corrected according to paragraph (b), the invitation to correct provided for in Article 14(1)(b) may nevertheless offer the applicant an opportunity to furnish corrections within the time limit under Rule 26.2.

~~(a) Where the international application is filed in a language of publication, the receiving Office shall check:~~

~~(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;~~

~~(ii) any translation furnished under Rule 12.3 for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.~~

~~(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:~~

~~(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction;~~

~~(ii) any translation furnished under Rule 12.3 or 12.4 and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.~~

~~26.3bis Invitation under Article 14(1)(b) to Correct Defects under Rule 11~~

~~The receiving Office shall not be required to issue the invitation under Article 14(1)(b) to correct a defect under Rule 11 where the physical requirements referred to in that Rule are complied with to the extent required under Rule 26.3.~~

26.3ter Invitation to Correct Defects under Article 3(4)(i)

(a) Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office shall, unless

(i) a translation of the international application is required under Rule 12.3(a), or

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published,

invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published. Rules 26.1, 26.2, 26.3, ~~26.3bis~~, 26.5 and 29.1 shall apply *mutatis mutandis*.

(b) to (d) [No change]

26.4 [No change]

26.5 Decision of the Receiving Office

[No change] The receiving Office shall decide whether the applicant has submitted the correction within the applicable time limit under **Rule 26.2**, and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

Rule 28

Checking of Defects **Noted** by the International Bureau

28.1 ~~Note on Certain~~ Checking of Defects by the International Bureau

(a) If, following the checks under Article 14(1)(a) by the receiving Office, the International Bureau considers that the international application contains any of the defects referred to in Article 14(1)(a)(i), (ii) or (v), the International Bureau shall, subject to paragraphs (b) and (c), invite the applicant to correct the defect on behalf of the receiving Office and give the applicant the opportunity to make observations within two months from the date of the invitation. The time limit may be extended by the International Bureau at any time before a decision is taken.

(b) The International Bureau shall not require the applicant to correct a defect under
Rule 11:

(i) in a document to form part of the international publication unless the correction is necessary for the purpose of reasonably uniform international publication, or

(ii) in any other document referred to in paragraph (a) unless the correction is necessary for the purpose of satisfactory reproduction.

(c) Where the International Bureau finds defects under Rule 11 that are not required to be corrected according to paragraph (b), the International Bureau may offer the applicant an opportunity to furnish corrections in an invitation under paragraph (a).

(d) The applicant shall submit any correction to the International Bureau as a replacement sheet embodying the correction. A letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

(e) The International Bureau shall decide whether the applicant has submitted the correction within the applicable time limit under paragraph (a). If no required correction has been timely submitted or if a submitted correction does not remedy the defect to the extent necessary for the purpose of reasonably uniform international publication or satisfactory reproduction, as appropriate, the international application shall be considered withdrawn under **Article 14(1)(b)** and the International Bureau shall so declare on behalf of the receiving Office under Rule 26.5. Rule 29.1 shall apply *mutatis mutandis*.

~~(a) If, in the opinion of the International Bureau, the international application contains any of the defects referred to in Article 14(1)(a)(i), (ii) or (v), the International Bureau shall bring such defects to the attention of the receiving Office.~~

~~(b) The receiving Office shall, unless it disagrees with the said opinion, proceed as provided in Article 14(1)(b) and Rule 26.~~

[End of Annex and of document]