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المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ  
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The International Bureau of the World Intellectual Property Organization  
./ (WIPO) presents its compliments and has the honor to transmit herewith the  
report (document PCT/MIA/9/6) of the ninth session of the Meeting of  
International Authorities under the PCT, which was held in Geneva from  
July 21 to 25, 2003.

As the working language of the session was English, the report is available  
only in English.

Both the report and the working documents are available on WIPO's Web  
site (see <http://www.wipo.int/pct/en/meetings>).

July 28, 2003

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# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PCT**

**Ninth Session  
Geneva, July 21 to 25, 2003**

REPORT

*adopted by the Meeting*

## INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its ninth session in Geneva from July 21 to 23, 2003.
2. All of the eleven International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Canadian Intellectual Property Office, the European Patent Office, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the Russian Agency for Patents and Trademarks, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in the Annex to this document.

## OPENING OF THE SESSION

4. Mr. Jay Erstling, Director, Office of the PCT, on behalf of the Director General, opened the session and welcomed the participants.

## ELECTION OF A CHAIR

5. The meeting unanimously elected Mr. Philip Thomas (WIPO) as Chair.

## ADOPTION OF THE AGENDA

6. The Meeting adopted for its agenda the draft contained in document PCT/MIA/9/1, subject to the addition of a further item, "Future Work," after item 6 in that document.

## CONTENTS OF THIS REPORT

7. The Meeting agreed that this report would contain the principal conclusions reached at the session rather than a record of the discussion in its entirety.

## REVISED DRAFT PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES<sup>1</sup>

8. Discussions were based on documents PCT/MIA/9/2, 2 Add.1, 2 Add.2 and 2 Add.3.
9. The Meeting thanked the United States Patent and Trademark Office for the work done by it in preparing the further revised draft PCT International Search and Preliminary Examination Guidelines ("the Guidelines") as a whole, and the European Patent Office for the work done by it on sections dealing with clerical and administrative procedures.
10. The Meeting agreed on the text of the revised draft Guidelines as set out in document PCT/MIA/9/2 subject to the comments made in the following paragraphs.

### *General*

11. A number of paragraphs included unnecessary opening words (originally inserted as suggested headings) which should be deleted.
12. The entire text should be reviewed to replace references to the term "specification" by references, as appropriate, to the "description" or to the "description and claims."

### *Chapter 1*

13. *Paragraph 1.01:* In line 4, the word "that" should be inserted after "being."
14. *Paragraph 1.10(c):* The square brackets should be replaced with parentheses.
15. *Annex 1, page 10:* The International Bureau agreed that it would revise the format of the flowsheet in the course of its editorial review of the next (near final) draft (see paragraph 111, below).

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<sup>1</sup> 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"). References to "Forms" are to those set out in Annex A of the Administrative Instructions under the PCT. "IPC" denotes International Patent Classification. "IPDL" denotes Industrial Property Digital Library.

*Chapter 2*

16. *Paragraph 1.01*: “1.01” should be replaced by “2.01.”

*Chapter 3*

17. *Paragraph 3.19*: The last line should be deleted and replaced with “set forth in Chapter 10 at paragraphs 10.27 *et. seq.*”

*Chapter 4*

18. *Paragraph 4.14*: In lines 6 and 7, the square brackets should be deleted. Occurrences of “[The Search Guidance IPDL]” in other paragraphs and Chapters should be similarly revised to remove the square brackets. A URL for the IPDL should be established by the International Bureau and a reference to it included in the final version of the Guidelines.

19. *Paragraph 4.24*: The words from “For example” at line 8 to the end of the paragraph should be deleted.

20. *Paragraph 4.28*: The words “under the practice in the United States of America” should be replaced by “under the practice of some Authorities.”

21. *Paragraph 4.31*: This paragraph should be amended to read as follows:

“4.31 The examiner should, in general, exclude from the international search subject matter for which no searches are to be carried out or no meaningful search can be made; this may result, for example, from the fact that certain subject matter may be excluded from the search under Rule 39 [XR], or from exceptional situations where no search at all is possible for a particular claim(s) (see paragraph 4.10.05 [XR] and Chapter 20 [XR]). The examiner should indicate in either Box No. II of Form PCT/ISA/210 (International Search Report) or Form PCT/ISA/203 (Declaration of Non-Establishment of International Search Report), as appropriate, the reasons for which no international search is established in respect of the relevant claims (see paragraphs 12.09, 12.30, and 12.31 [XR]). In Box No. III of Form PCT/ISA/237 (Written Opinion of the International Searching Authority), it will then usually be sufficient to indicate that no international search report has been established for the relevant claims as the reason for not establishing an opinion on novelty, inventive step and industrial applicability and refer to the international search report or declaration for further details.”

22. *Paragraph 4.33*: A new sentence should be added at line 5 before “If applicant”:  
“Note that any such correction must not introduce new matter (see Chapter 22).” The word “the” should also be inserted between “If” and “applicant.”

23. The following paragraphs should be inserted after paragraph 4.54:

“When conducting a search on an international application, it may be necessary to make use of the Internet as a search tool. According to Rule 42.1, the international application must be searched within three months of receipt of the search copy by the International Searching Authority (or nine months after the priority if this expires later), and the receiving Office must usually forward the search copy to the International

Searching Authority within one month of the international filing date (Rule 23.1(a)). This means that where the full priority year is claimed, the search will usually have to be performed at the very latest, within 16 months of the priority and consequently before international publication according to Article 21(2)(a). Where the international application has not yet been published at the time of the search, there exists the danger that search terms used in the search on non-secure Internet search engines or in databases available on the Internet may be observed by third parties. This may reveal details of the application before it is published, which is clearly undesirable. It should be stressed that it is common practice for Internet sites to keep records of queries, which result in their retrieval. This is particularly dangerous to the applicant, where the web site retrieved belongs to a competitor.

“All web sites must be treated as non-secure unless the Authority has a commercial arrangement with a service provider in order to maintain confidentiality and the connection to that web site is via a secure connection.

“Consequently, extreme caution must be exercised when using the Internet as a search tool where (as in most cases) the international application has not yet been published. Where a relevant database is accessible via the Internet, but an alternative secure connection to the same database is accessible by the International Searching Authority, the secure connection must be used.

“Where no secure connection to a database on the Internet is available to the International Searching Authority, the search may be conducted on the Internet using generalized search terms representing combinations of features that relate to the claimed invention, which have already been shown to exist in the state of the art.”

24. *Paragraph 4.55:* The first three words should be converted into a heading above the paragraph.

25. *Paragraph 4.56:* The following sentence should be included at the end of the paragraph: “Where the document is an Internet disclosure and doubts exist with regard to its publication date (such that it is not clear if it was published before the relevant date according to Rule 64.1), the examiner should continue the search as though that Internet disclosure had not been retrieved.”

26. *Paragraph 4.57:* In line 3, the phrase “The examiner is also encouraged” should be changed to “Depending on the policy of an ISA, the examiner may find it useful” but the matter should be listed for future consideration by the Meeting (see paragraph 114(i), below). Similar amendments should be made in paragraphs 6.55, 6.56, 6.58, 6.59 and 6.62.

27. *Paragraph 4.65:* In line 4, the phrase “physically inspected” should be changed to “consulted.”

28. *Paragraph 4.71:* In line 3 the word “may” should be replaced by “should.”

## *Chapter 6*

29. *Paragraph 6.02:* At the end of the last sentence, “for illustrating format only” should be added. It was clarified that this was because Authorities should be free to draft reports in

the manner most effective for the particular application and should not feel constrained by the style, content or level of detail contained in the samples.

30. *Paragraph 6.09:* In line 2, a reference should be added to “the extra sheet (if any)” of the international search report.

31. *Paragraph 6.55:* The current text should be deleted with the removal of the square brackets and replaced with the text of paragraph 6.55.5. See also paragraph 26, above.

32. *Paragraph 6.56:* Subsections (a) and (b) should be deleted and replaced with “Where the IPC classification terms were searched, with or without restricting the search by using key words, the examiner should enter the associated IPC symbols.” In line 3, the words “Search Guidance” should be inserted before “IPDL.” See also paragraph 26, above.

33. *Paragraphs 6.58, 6.59 and 6.62:* See paragraph 26, above.

34. *Paragraph 6.100:* The heading above this paragraph should be replaced by “Finalization of the report.”

#### *Chapter 9*

35. As a general approach, the paragraphs of existing Chapter 9 relating to clerical and administrative procedures should be moved to Chapter 24. In particular, certain paragraphs of Chapter 9, as renumbered in document PCT/MIA/9/2, should be moved, subject to the changes specified below (most of which were as set out in relation to the corresponding paragraphs in document PCT/MIA/9/2 Add.1).

36. *Paragraph 9.01:* Move to be the first paragraph in Chapter 24.

37. *Paragraph 9.02:* Move to follow paragraph 24.15.

38. *Paragraph 9.03:* Move to follow paragraph 24.16.

39. *Paragraph 9.04:* Move (together with its heading) to follow paragraph 24.23.

40. *Paragraph 9.09:* In the third sentence, delete “is.” Add the following sentence at the end: “However, any International Preliminary Examining Authority can waive the sending by mail (Form PCT/IB/337) of the information that no Article 19 amendments were received by the International Bureau, but may opt to receive such information in electronic form.” It was noted in this connection that a corresponding modification of the Administrative Instructions might also be desirable.

41. *Paragraph 9.14:* After “(see paragraph 10.07),” delete “the request,.” After “Article 19” insert “, unless waived by the Authority.” After “the written opinion of the International Searching Authority;” insert “and, depending on the circumstances, the request and.” Delete “the receiving Office or the International Searching Authority and, depending on the circumstances” and insert “the receiving Office, the International Searching Authority or the International Bureau.”

42. *Paragraphs 9.16(ix) and 9.20:* Omit from these paragraphs the reference to the possibility of requesting the applicant to furnish a copy of the priority document, but instead

include a paragraph at an appropriate place in the Guidelines (not necessarily in this Chapter) referring to the possibility that the applicant may, for practical reasons, but only in exceptional circumstances and without loss of rights, be asked to furnish a copy of the priority document where it is not otherwise available, even where that applicant had complied with Rule 17.1 in relation to furnishing the priority document to the receiving Office or the International Bureau.

#### *Chapter 10*

43. *Paragraph 10.15:* The words from “the examiner” to “further written opinion” should be replaced by “no further written opinion need be issued before the international preliminary examination report is established.” In the second sentence, the words “, at the discretion of the International Preliminary Examining Authority,” should be inserted before “be issued.”

44. In the heading before paragraph 10.16, “with” should be replaced with “which.”

45. After the heading before paragraph 10.27, the words “See Chapter 11” should be inserted.

46. *Paragraphs 10.27 to 10.31:* Move to Chapter 11 and insert after paragraph 11.04.

47. *Paragraphs 10.32 and 10.34:* Move to Chapter 24.

48. *Paragraph 10.33:* Move to Chapter 11 following paragraph 10.31.

49. *Paragraphs 10.35 and 10.36:* The text of paragraph 10.36 should be added as “iii” in paragraph 10.35. Question marks should be inserted at the end of paragraph 10.35(ii) and the first sentence of new paragraph 10.35(iii).

50. *Paragraph 10.38:* In line 1, “19(1) and/or” should be inserted before “34(2)(b).”

51. *Paragraph 10.39:* A reference to Article 19(2) should be introduced before this paragraph.

52. *Paragraphs 10.35 to 10.46:* Move to Chapter 11, after paragraph 10.33, with the corrections above.

53. *Paragraph 10.58:* In line 1, “examiner” should be replaced with “Authority” and in line 2, “he” should be replaced by “it.”

#### *Chapter 11*

54. *Paragraph 11.01:* At the end of the first sentence, “see paragraph 10.35 [as renumbered]” should be inserted. At the end of the paragraph a new sentence should be added: “Article 19 amendments are considered by the examiner only during the international preliminary examination procedure.”

55. *Paragraph 11.04:* Following this paragraph and before the newly added paragraphs from Chapter 10, the heading “Making amendments – general considerations” should be inserted.

56. *Paragraph 11.05*: In line 1, “19(1) and/or” should be inserted before “34(2)(b)” and the paragraph should be moved to follow paragraph 11.07.

57. *Paragraph 11.06*: In line 7, the spelling of “contradiction” should be corrected. In line 9, the words “this may raise a question of lack of support” should be replaced by “there may be a question of whether the claims provide sufficient disclosure to allow amendment of the description without adding matter that goes beyond the disclosure as filed or to provide full support.”

58. *Paragraph A11.07[02]*: In line 3, after “to” the text should be replaced by “exclude parts of a claim for reasons other than novelty, such as for lack of industrial applicability or insufficient disclosure.”

## *Chapter 12*

59. *Paragraph 12.09*: The words “insofar as checked by that Authority” should be inserted at the end of items (iii) and (v).

60. *Paragraph 12.19*: In line 2, the words “should not be” should be replaced by “are not normally.” At lines 5-6, the period after “replacement sheet” should be replaced by “, but” and the words “In this situation” deleted. In line 7, “shall” should be replaced by “are to.”

61. *Paragraph 12.21*: In line 4, “printed form or electronic medium” should be replaced by “written form or computer readable form.”

62. *Paragraph 12.23*: The words “(see also paragraph 12.19)” should be inserted at the end.

63. *Paragraph 12.26*: As to the furnishing of priority documents, the same comments apply as in paragraph 42, above.

64. *Paragraph 12.26(d)*: At line 9 (only, not at other points), the words “and/or the translation” should be deleted since the Regulations do not yet make any provision for retrieving translations of priority documents from digital libraries.

65. *Paragraph 12.35*: A new sentence should be inserted at the end: “However, in either case the Authority should make a meaningful search or preliminary examination to the extent that it is possible.”

66. *Paragraphs 12.36 and 12.37*: These paragraphs should be revised for consistency.

67. *Paragraph 12.51*: The heading before this paragraph should be replaced by “Finalization of the report.” In line 1, “completing the certification of” should be replaced by “finalizing.” In line 2, “examiner” should be replaced by “Authority.” In line 6, “certification” should be replaced by “report.”

68. *Paragraph 12.54*: This paragraph should be amended to read as follows:

“12.54 If the cited prior art is such as to demonstrate lack of novelty or inventive step in the main claim or claims, and if consequently there is lack of unity of invention between dependent claims, if there is enough time, the applicant may be notified of this

situation by the International Searching Authority and invited to pay additional search fees (see also paragraphs 21.23[XR] *et seq*) prior to the international search report and the first written opinion being established. Subsequently, if a demand for international preliminary examination is filed and if, in the opinion of the International Preliminary Examining Authority, any response of the applicant (see paragraph 10.17[XR]) does not overcome the objection of lack of unity of invention, the Authority thereafter shall adopt the procedure described in paragraphs 21.37[XR] to 21.46[XR].”

69. *Paragraph 12.62:* In line 2, “first claimed invention” should be inserted before “main invention” and “main invention” should be replaced by “(main invention).” In line 4, “that” should be deleted. The last sentence should be deleted.

70. *Paragraph 12.64:* In line 4, “first claimed invention” should be inserted before “main invention” and “main invention” should be replaced by “(main invention).” The last sentence should be deleted.

71. *Paragraph 12.66:* In line 7, the text in square brackets should be deleted.

72. *Paragraph 12.68:* The last sentence should be deleted.

### *Chapter 13*

73. *Paragraph 13.36:* In lines 6 to 7, the sentence in square brackets should be deleted. In line 11, the text in square brackets should be deleted.

74. *Paragraph 13.42:* In line 3, the phrase “which render it unduly burdensome to determine the matter for which protection is sought,” should be deleted.

### *Chapter 14*

75. *Paragraph 14.13:* The third and subsequent sentences (“In order to determine...”) should be replaced by the following:

“When citing an Internet disclosure (a web page), problems may arise in establishing the date of publication and whether or not the disclosure has been modified over time. When establishing the publication date of a web page, it is important to distinguish between two types of Internet disclosure, viz:

“(i) *Disclosures made on the web sites of trusted publishers*

“Examples of these are on-line scientific journals (which make available the contents of a paper journal on-line, or may be uniquely on-line publications). The web sites of newspapers, periodicals, television and radio stations will usually fall into this category as well. This type of Internet disclosure gives the publication date of the disclosure which, in the absence of evidence to the contrary, should be taken at face value. The examiner should cite the Internet disclosure in the International search report and use it in the written opinion of the International Searching Authority and in preliminary examination accordingly. The onus is on the applicant to prove otherwise.

“It may happen that the publication date is not sufficiently identified to know if it is published in time to be considered to be state of the art according to Rule 64.1(b) (i.e. it

is not clear if the disclosure occurred before or after the valid priority date). This may happen, for example, where only the month or year of publication is given and this is the same as the month or year of the valid priority of the international application. In these cases, the Authority may need to make enquiries with the owner of the web site in order to establish the publication date to a sufficient degree of accuracy to know if it is relevant state of the art in accordance with Rule 64.1(b) in the same way as it would act in order to establish a more accurate publication date for a paper published document.

*“(ii) Disclosures made on web sites of unknown reliability*

“Examples of such web sites include those belonging to private individuals, private organizations (e.g. clubs), commercial web sites (e.g. advertising) etc. Where such an Internet disclosure is retrieved during the international search and it does not give any explicit indication of the publication date in the text of the disclosure, the Authority may consider using those technical means available to it to attempt to reveal the publication date.

“Such technical means include:

“(a) information relating to the publication date embedded in the Internet disclosure itself (date information is sometimes hidden in the programming used to create the web site, but is not visible in the web page as it appears in the browser),

“(b) indexing dates given to the web page by search engines (these are usually later than the actual publication date of the disclosure since the search engines usually take some time to index a new web site) and

“(c) information available relating to the web site on commercial Internet archiving databases (e.g. Internet Archive Wayback Machine).

“Where the examiner obtains an electronic document which establishes the publication date for the Internet disclosure, he should make a print-out of this document, which must mention both the URL of the relevant Internet disclosure and the date of publication of that relevant Internet disclosure. The examiner must then cite this print-out in the international search report as an “L” document and cite the relevant Internet disclosure according to the relevance of its content (“X”, “Y”, “A”) and according to the date as established (“X”, “Y”, “A”, “P,X”, “P,Y”, “P,A”, “E” etc). Where the examiner is unable to establish the publication date of the relevant Internet disclosure and it is relevant to the inventive step and/or novelty of the claimed invention, he should cite it in the international search report with the category “L” for those claims which it would have affected if it were published in time and giving it the date it was printed out as the publication date (see 6.66.1(ix)(b)).

“Where this type of Internet disclosure does explicitly mention a publication date and this publication date:

“(1) is not contradicted by the information sources mentioned above

“(in this regard it should be noted that the indexing date given by a search engine is usually later than the actual publication date and so where the examiner uncovers an indexing date for an Internet disclosure which is later than the publication date given in

the Internet disclosure itself; this does not necessarily mean that the Internet disclosure was made available later than it claimed, it simply means that it was indexed by that search engine after it was made available)

“(2) and is accurate enough to establish if the document was published early enough to be considered relevant according to Rule 33.1(a) and Rule 64.1(b),

“then the examiner should trust the date given and give this as the publication date in the search report and use this publication date in preliminary examination. The onus is on the applicant to prove otherwise.

“In the absence of evidence to the contrary, the examiner should assume that the content of the Internet disclosure has not changed over time.”

### *Chapter 16*

76. The subject matter of paragraph VI-8.10 of the existing International Search Guidelines should be incorporated into this Chapter at an appropriate location.

### *Chapter 17*

77. *Annex:* The Annex to Chapter 17 should include an outline of the practice of the Russian Agency for Patents and Trademarks, to be provided by it, expressed in a similar style to the content of other such Annexes.

### *Chapter 18*

78. *Paragraph 18.17:* As to the furnishing of priority documents, the same comments apply as in paragraph 42, above.

### *Chapter 20*

79. *Paragraph 20.04:* This paragraph should be revised to make it expressly clear that paragraphs (b) and (d) were not affected by such different practices related to “practical application” or “technical character.”

80. *Paragraph 20.04(c):* The reference to the proposed Directive by the European Commission should be deleted and the matter reconsidered as necessary when a final Directive is issued.

81. *Paragraph 20.04(e)(2):* The square brackets surrounding examples 1 and 2 and the introductory text thereto should be deleted. In example 2, claim 2 (together with the corresponding analysis) should be deleted, and claim 3 renumbered as claim 2.

82. *Paragraph 20.04(f):* The existing text should be replaced by the following:

*[Text to appear in the main body of the Guidelines:]*

“(f) *Programs for computers, to the extent that the Authority is not equipped to carry out search or preliminary examination on such programs.* It should be noted at the outset that programs for computers can be expressed in many forms. Normally, claims

which merely recite program code are excluded subject matter. However, to the extent that a natural language description of any computer-executable program, or a self-documented code, is included in the description and the claims, the Authority should be considered “equipped” to carry out a search and preliminary examination based on such a description subject to the following guidelines regarding the conditions as to exclusion. The Authorities have diverging practices with respect to determinations of exclusions as to computer programs. Specific guidance where divergent practices exist is set forth in Annex A20.04(f).”

*[Text to appear in the Annex to Chapter 20:]*

“A20.04(f)

“The ISA/IPEAs have diverging practices with regard to the exclusion for programs for computers. Either of the alternative guidelines below may be relied upon by an ISA/IPEA as appropriate.

“A20.04(f)[1]

“The basic considerations here are exactly the same as for the other exclusions listed in Rule 67, that is, whether the program claimed has a practical application providing a useful, concrete and tangible result. A mere program listing that describes an executable code that is not tangibly embodied as a record on a computer-readable carrier would be excluded subject matter and thereby not subject of international search and examination. Similarly, an executable program producing only an expression of an idea (such as a mathematical theory) even if tangibly embodied would also fall within this exclusion. However, a program containing executable code tangibly embodied on a computer-readable carrier which when executed has a practical application would not be excluded and should be searched and examined. In addition, a data-processing operation can be implemented either by means of a computer program or by means of special circuits, and the choice may have nothing to do with the inventive concept but be determined purely by factors of economy or practicality. The technology involved in executing the data-processing operation should not be dispositive as to the exclusion determination. With this point in mind, search and preliminary examination in this area should be performed on any computer program tangibly embodied in a computer-readable carrier providing a practical application (e.g., a computer program product claim). International search and preliminary examination should not be denied merely on the grounds that a program is involved in its implementation. This means, for example, that program-controlled machines and program-controlled manufacturing and control processes should normally be regarded as subject matter on which an international search and preliminary examination can be carried out. It follows also that where the claimed subject matter is concerned only with the program-controlled internal working of a known computer, the subject matter could be searched and examined if it provides a practical application. As an example, consider the case of a known data-processing system with a small, fast-working memory and a larger, but slower, further memory. Suppose that the two memories are organized under program control in such a way that a process which needs more address space than the capacity of the fast-working memory can be executed at substantially the same speed as if the process data were loaded entirely in that fast memory. The effect of the program in virtually extending the working memory provides a practical application and would, therefore, require search and preliminary examination. Where search and preliminary

examination on such claims is carried out, then, generally speaking, product, process and use claims should also be searched and examined. See, however, in this context, Chapter 13, paragraphs 13.13 and 13.31 [XR].

“A20.04(f)[2]

“The basic considerations here are exactly the same as for the other exclusions listed in Rule 67, that is, whether the program claimed has technical character. A program producing only an expression of an idea (such as a mathematical theory) would fall within this exclusion. On the other hand, a data-processing operation can be implemented either by means of a computer program or by means of special circuits, and the choice may have nothing to do with the inventive concept but be determined purely by factors of economy or practicality. The technology involved in executing the data-processing operation should not be the determining factor for exclusion. With this point in mind, search and preliminary examination in this area should be performed on any computer program having technical character. International search and preliminary examination should not be denied merely on the grounds that a program is involved in the implementation. This means, for example, that program-controlled machines and program-controlled manufacturing and control processes should normally be regarded as subject matter on which an international search and preliminary examination can be carried out. It follows also that where the claimed subject matter is concerned only with the program-controlled internal working of a known computer, the subject matter could be searched and examined if it provides a technical effect which goes beyond the normal interaction between a program and a computer. As an example, consider the case of a known data-processing system with a small, fast-working memory and a larger, but slower, further memory. Suppose that the two memories are organized under program control in such a way that a process which needs more address space than the capacity of the fast-working memory can be executed at substantially the same speed as if the process data were loaded entirely in that fast memory. The effect of the program in virtually extending the working memory provides a technical character and would, therefore, require search and preliminary examination of a claim relating to the program involved whatever is the form in which it is presented, e.g. product, computer program product, process and use claims. See, however, in this context, Chapter 13, paragraphs 13.13 and 13.31[XR].”

83. *Paragraph 20.11(I), Example 4(ii)*: In line 3, “that is unduly burdensome to determine the matter for which protection is sought” should be deleted. Also, in line 3, “that it is not in compliance with PCT Article 6 and Rule 6” should be inserted after “extent.”

84. *Paragraph 20.11(II), Example 1*: In the second indented paragraph, the second sentence (“The specification discloses ...”) should be replaced by: “The description does not provide sufficient information about the invention to determine the subject matter to which the claim might reasonably be expected to be directed after it had been amended.” In the final paragraph, the words “for claim 1” should be deleted. The second and third sentences of the first full paragraph on page 176 of Annex I (“In the written opinion ...”) should also be repeated at the end of this example.

85. *Paragraph 20.11(II), Example 2*: This example should be deleted.

86. *Paragraph 20.11(II), Example 3*: The term “specification” (three occurrences) should be replaced by “description.”

87. *Paragraph 20.18:* The square brackets surrounding this paragraph should be removed. In lines 4 and 10, “[so]” should be deleted.

#### *Chapter 21*

88. *Paragraphs 21.02 and A21.02:* The United States Patent and Trademark Office will review the text for consistency with its current practice.

89. *Paragraph 21.19:* Example 17 Revised should be deleted.

90. *Paragraph 21.20:* Examples 17*ter*, 17*quater*, 17(1) and 17(2) should be deleted.

91. *Paragraph 21.21:* In Examples 19 and 20, the last sentence should be deleted and the bracketed text following should be deleted. Examples 24*ter*, 24*quater*, 17*bis* and 24(1) should be deleted.

92. *Paragraph 21.28:* The paragraph should be amended as follows:

“21.28 When the examiner finds lack of unity of invention, normally the applicant will be invited to pay fees for the search of additional inventions. In exceptional circumstances, however, the examiner may be able to establish both an international search and a written opinion covering more than one invention with negligible additional work, in particular, when the inventions are conceptually very close. In those cases, the examiner may decide to complete the international search and written opinion for the additional invention(s) together with that for the invention first mentioned. In considering the amount of work involved, the examiner should take into account the time taken to create the written opinion as well as that needed to perform the search, since even when the analysis involved as regards the search is negligible, the opposite may be the case for the written opinion of the International Searching Authority and therefore justify requesting the additional fees. If it is considered that the total additional work does not justify requesting additional fees, all results would then be included in the international search report without inviting the applicant to pay an additional search fee in respect of the additional inventions searched but stating the finding of lack of unity of invention.”

#### *Chapter 23*

93. *Paragraphs 23.16 and 23.17:* The Meeting noted that these paragraphs, which were as agreed by the Working Group on Reform of the PCT (see document PCT/R/WG/4/14, paragraphs 78 and 80(f)), would give the Meeting the responsibility of preparing an initial report to the Assembly of the PCT Union concerning implementation of the quality management systems generally. The Meeting noted that the reports would be a valuable means for sharing experience and know-how on quality management systems. The Meeting agreed that the annual report by an Authority should be in the nature of an overall evaluation by the Authority of the progress of implementing the quality management system. Such annual reports should be submitted to the Meeting for discussion/information.

*Chapter 24*

94. In addition to the moving of text from Chapter 9 (see paragraphs 35 to 39, above), the changes set out in the following paragraphs should be made.
95. *Paragraph 24.01:* The last sentence should be moved to appear after the third sentence, as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.02.
96. *Paragraph 24.02:* The paragraph should be amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.03.
97. *Paragraph 24.05:* The paragraph should be further amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.06.
98. *Paragraph 24.11:* The paragraph should be further amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.12.
99. *Paragraph 24.19:* The paragraph should be further amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.22.
100. *Paragraph 24.21:* In the *chapeau*, delete “the existence of any of.”
101. *Paragraph 24.21(vii):* The paragraph should be amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.24(g).
102. *Paragraph 24.26:* The paragraph should be amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.29a, with the further change of “may not” to read “cannot.”
103. *Paragraph 24.27:* In the penultimate sentence, insert “or a copy” after “the original.”
104. *Paragraph 24.29:* The paragraph should be amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.32.
105. *Paragraph 24.31:* The paragraph should be amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.34. At the end of the second sentence, add “, or checks with the International Bureau.”
106. *Paragraph 24.41:* The paragraph should be amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.44.
107. *Paragraph 24.47:* The paragraph should be preceded by the heading “Use of facsimile machine, telegraph, teleprinter, etc.” and should be further amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.51.
108. *Paragraph 24.48:* The paragraph should be amended as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 25.52.

109. *Paragraph 24.54 (new)*: Paragraph 10.61 should be moved to appear as paragraph 24.54, with further amendment as set out in the Annex to document PCT/MIA/9/2 Add.1 in relation to paragraph 26.02, except that the words “withdrawal of the international application” should be replaced by “any withdrawal.”

#### *Arrangement of Chapters*

110. The Meeting agreed that the Chapters should be rearranged and renumbered as proposed in Annex II of document PCT/MIA/9/2, but noting that Chapter 24 should form a separate Part and that Chapter and Part titles may need to be amended to reflect the final contents of each section better.

#### *Further Work*

111. The Meeting gratefully accepted the offers of the United States Patent and Trademark Office to prepare a revised draft of the Guidelines as a whole and that of the European Patent Office to prepare a revised text on clerical and administrative procedures for Chapter 24 and corresponding changes in Chapters 9 and 10 for incorporation by the United States Patent and Trademark Office into the main text. The revised draft would take into account the discussion at the present session and would also include sample filled-in Forms, be prepared by the European Patent Office, as appendices. The revised draft would be posted on the MIA electronic forum by the second half of August for comment by Authorities. The International Bureau would at that stage undertake a thorough editorial review of the text including, for example, a review for consistency of terminology, including with that of the modified Forms. A subsequent (“final”) draft of the Guidelines would be posted for comment, with a view to finalization and issuance by the end of October.

112. Any further substantive issues which emerged should be the subject of consultation between the Authorities at the earliest opportunity using the electronic forum.

113. It was noted that the final version of the Guidelines should be made available in electronic format as a series of small files in addition to a single large file.

114. The Meeting noted that it was desirable to work towards increased consistency in practice and agreed that areas of difference should be the subject of further review in the future, including in particular:

- (i) recording of search history (see paragraph 26, above); and
- (ii) unity of invention practice in relation to biotechnological inventions (see paragraphs 89 to 91, above).

#### NEW AND MODIFIED FORMS RELATING TO INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION

#### *Content of Written Opinions and Reports*

115. Discussions were based on document PCT/MIA/9/3 relating to proposed new or modified Forms PCT/ISA/210 and 237 and PCT/IPEA/408 and 409 (“Form 210”, etc.).

116. The Meeting agreed generally with the proposals subject to the comments appearing in the following paragraphs, noting that further editorial changes would need to be made by the International Bureau.

117. *Basis of reports or opinions and sequence listings (Box No. I in each of Forms 210, 237, 408 and 409 and the Supplemental Box Relating to Sequence Listings in Forms 408 and 409):* See document PCT/MIA/9/3, Annex I, page 2, Annex II, page 2, Annex III, page 10 and Annex IV, page 10. The text appearing under sub-item 1(d) in each instance should be de-linked from the introductory phrase of item 1, so as not to give the impression that the international search or preliminary examination would be carried out “on the basis of” the statements concerned. The text should simply indicate that the statements concerned were furnished.

118. *Written Opinion of International Searching Authority (Form 237):* See document PCT/MIA/9/3, Annex II, pages 1 and 5.

(a) *Explanation of possible further action (cover sheet, item 2).* The text appearing in the first paragraph of item 2 should be reviewed so as to omit the term “usually” in the first line and mention, as an exception, cases where the written opinion of the International Searching Authority will not be treated by the Office acting as International Preliminary Examining Authority (which was not acting as International Searching Authority) as a written opinion of the International Preliminary Examining Authority.

(b) *Unity of invention (Box No. IV).* Text similar to that currently appearing under item 2 in Box No. IV of Form 409 (see document PCT/MIA/9/3, Annex IV, page 5) should be inserted in Form 237, as a new item 2 in Box No. IV, so as to provide for an indication that the International Searching Authority has found a lack of unity of invention but has not invited the applicant to pay additional fees. The other items in Box No. IV would be renumbered accordingly.

119. *International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty) (Form 409):* See document PCT/MIA/9/3, Annex IV, pages 1 and 2. The text appearing in the second paragraph under item 2, on the cover sheet, should be reviewed so as to properly characterize those annexes consisting of replacement sheets containing amendments that go beyond the disclosure in the international application as filed. In addition, the location of the phrase “These annexes consist of a total of \_\_\_\_ sheets” should be reviewed, or the wording modified, so as to clearly cover all annexes that the report may be accompanied by. Finally, the text appearing under item 4, in Box No. I, should be expanded to include the possibility for the International Preliminary Examining Authority to specify those pages which are the subject of the item, for example, by including checkboxes and words such as those appearing below the *chapeau* of item 3 of the same Box.

120. *Further consultation on Forms.* The Meeting noted that the International Bureau would, by the middle of August 2003, post on the MIA electronic forum the proposed revised Forms for comments by the Authorities as part of a final round of consultation. Final versions of the Forms would need to be available well in advance of their entry into force, that is, by the end of October, in conjunction with the issuance of the Guidelines (see paragraph 111, above).

*Format of Written Opinions and Reports*

121. Discussions were based on document PCT/MIA/9/5.

122. The Meeting agreed that the proposed single column “linear” format, as appearing in the Annexes to the document, was satisfactory and that steps should be taken to develop it to the stage where it could be promulgated as an officially approved alternative to the traditional “box-based” format. The text contained in the box-based version of the Forms should, except where unfeasible, be used in the new format of the Forms.

123. The European Patent Office agreed to prepare a draft set of criteria governing the generation of Forms in the proposed single column format, covering as many scenarios as possible. The International Bureau would post those criteria on the MIA electronic forum for comments by Authorities. The International Bureau would consider the possible need for modifications of the Administrative Instructions.

## PCT MINIMUM DOCUMENTATION

124. Discussions were based on document PCT/MIA/9/4.

125. The International Bureau noted that Circular C. PCT 911 issued on March 28, 2003, had invited members of the PCT Committee for Technical Cooperation (PCT/CTC) to evaluate the Non-Exhaustive Inventory of Traditional Knowledge-Related Periodicals and the Non-Exhaustive Inventory of Traditional Knowledge-Related Databases, attached to the Circular, and to suggest a selection of appropriate periodicals and databases with a view to providing improved access to traditional knowledge documentation for search purposes. On the basis of replies received from 20 PCT/CTC members, the International Bureau had compiled ranked lists of periodicals and databases which included only those periodicals and databases that had been proposed by more than one of the PCT/CTC members (see document PCT/MIA/9/4, Annexes I and II).

126. The International Bureau also informed the Meeting of ongoing activities in the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (“the Intergovernmental Committee”) which had, at its fifth session held in July 2003, continued its studies of providing enhanced accessibility to documented traditional knowledge and related genetic resources, including through an Internet portal linked to relevant databases. The Intergovernmental Committee had also considered document WIPO/GRTKF/IC/5/6, summarizing concrete steps taken to date and containing a draft data specification which the Asian Group had put forward to adopt an international data standard for registries and databases of traditional knowledge and folklore. The Intergovernmental Committee had approved the proposal and agreed to submit it to the appropriate body within the framework of the Standing Committee on Information Technologies.

127. The Meeting reiterated the conclusion, reached at its seventh session, that integration of traditional knowledge documentation into searchable prior art could significantly improve the quality of international searches in areas where traditional knowledge documentation represented a rich source of information (see document PCT/MIA/7/5, paragraph 10).

128. The Meeting agreed that the ranked lists prepared by the International Bureau provided a good basis for selection of the most appropriate periodicals and databases. Criteria for

selection of periodicals had been agreed upon by the Meeting at its seventh session (see document PCT/MIA/7/5, paragraph 12). The Meeting noted particularly that selected periodicals and databases would need to contain descriptions of disclosed technical knowledge to a sufficiently practical or technical level to be of relevance when conducting prior art searches. Certain Authorities stated that they were still in the process of studying the inventories in the light of the criteria just mentioned, but indicated (at least preliminary) views during the session as to certain periodicals and databases, which views were noted by the International Bureau.

129. Some Authorities expressed the view that providing examiners with access to databases relating to traditional knowledge, for example through the framework of an IPDL, would in general yield more satisfactory results than consultation of periodicals, although the mandatory use of such databases in the examination process was not envisaged.

130. The Meeting concluded that periodicals and databases mentioned in the lists prepared should be further studied in the light of their accessibility, facilities for electronic searching, and technical and geographical coverage. The Meeting requested the International Bureau to prepare revised ranked lists, taking into account the comments and further suggestions made during the session and making a comprehensive check of their conformity with the established criteria. The International Bureau was invited to post the updated lists on the MIA electronic forum for comment by Authorities with a view to reaching agreement by way of correspondence as to the inclusion of appropriate traditional knowledge-related periodicals in the non-patent literature part of the PCT minimum documentation, and on a list of recommended traditional knowledge-related databases, by the end of 2003.

131. The Meeting noted that PCT/CTC had requested the Meeting to undertake not only a study of the composition of the PCT minimum documentation with regard to traditional knowledge but also a broader review of the non-patent part of the PCT minimum documentation. The Meeting therefore requested the International Bureau to carry out such a review with the aim of proposing more efficient ways to access non-patent literature.

#### FUTURE WORK

132. The Meeting considered that the outstanding work concerning the International Search and Preliminary Examination Guidelines (see paragraphs 111 to 114), new and modified Forms (see paragraphs 120 and 123) and minimum documentation (see paragraphs 130 and 131) could all be most effectively continued for the present by use of the MIA electronic forum, together with discussions between individual Authorities either informally or in other forums. Consequently there was no need to set a date for the next session at this time.

*133. The Meeting unanimously adopted this report on July 23, 2003.*

[Annex follows]

ANNEX

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

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[End of Annex and of document]