



C. PCT 1157

December 19, 2008

Madam,  
Sir,

*Proposed modifications of the PCT Receiving Office Guidelines*

This Circular is addressed to your Office in its capacity as receiving Office (RO) for the purpose of consultation on proposed modifications to the PCT Receiving Office Guidelines (ROGLs). It is also addressed to certain non-governmental organizations representing users of the PCT system.

The proposed modifications are consequential to amendments of the Regulations under the PCT adopted by the PCT Assembly at its thirty-sixth session (see document PCT/A/36/13) and which will enter into force on January 1, 2009. It is recalled that these amendments concern, in particular, the establishment of a PCT Supplementary International Search (SIS) procedure wherein an International Searching Authority (ISA) states its preparedness in the applicable WIPO/ISA agreement to carry out SIS, and the applicant is provided the option of requesting a SIS during the international phase.

The occasion of this Circular is also used to propose certain modifications to the ROGLs to address several issues which were raised at the first session of the PCT Working Group on May 26 to 30, 2008 (see document PCT/WG/1/16) and which are not consequential to the 2009 Rule changes. Specifically, the Working Group agreed that the ROGLs should be modified to further clarify the procedures to be followed under PCT Rules 4.18 and 20.6 with respect to the incorporation of missing elements and parts, particularly for applications where an incorrect set of descriptions, claims and/or drawings had initially been filed (see document PCT/WG/1/16, paragraphs 125 to 127). The Working Group also agreed to modify the ROGLs to further clarify how the receiving Office should deal with additional matter (for example, annexes and appendices) submitted by the applicant at the time of filing of the international application

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(see document PCT/WG/1/16, paragraphs 140 to 143). Furthermore, while the Working Group is itself considering making amendments to the physical requirements of the international application specified in PCT Rule 11, it also invited the International Bureau to clarify in the ROGL the extent to which current systems and procedures meant that it was necessary to enforce the existing requirements of Rule 11 “for the purpose of reasonably uniform international publication” or “for the purpose of satisfactory reproduction”, as appropriate, as required by PCT Rule 26.3 (see document PCT/WG/1/16, paragraphs 65 to 71).

In addition, the proposed text of the ROGLs contains certain other clarifications and simplifications which are not consequential to the entry into force of the amended Regulations on January 1, 2009.

./. The paragraphs of the ROGLs which are proposed to be modified are set out in the Annex to this Circular.

*Comments on the proposed modifications to ROGLs*

Noting that the modified ROGLs should be promulgated as soon as possible after January 1, 2009, and that further consultation may be required after consideration of the comments received in response to this Circular, you are invited to provide comments, if any, to the International Bureau by January 26, 2009, preferably by fax to (+41 22) 910 00 30 or by email to: [pct.legal@wipo.int](mailto:pct.legal@wipo.int).

Yours sincerely,



Francis Gurry  
Director General

Enclosure: Annex – Proposed modified paragraphs of the ROGLs.

[...]

### General

55. Pursuant to Article 3(4)(i), the international application (that is, all elements of the international application: request, description (other than any sequence listing part thereof), claims, abstract, any text matter of the drawings) must be in “a prescribed language.” This requirement means that description (other than any sequence listing part thereof), claims, abstract and any text matter of the drawings must be in the language, or one of the languages, which the receiving Office, pursuant to Rule 12.1(a), accepts for the filing of international applications, and that the request must be in any language of publication which the receiving Office accepts for the filing of requests (Rule 12.1(c)). The languages of publication for international applications are Arabic, Chinese, English, French, German, Japanese, [Korean, Portuguese](#), Russian and Spanish (Rule 48.3(a)).

[...]

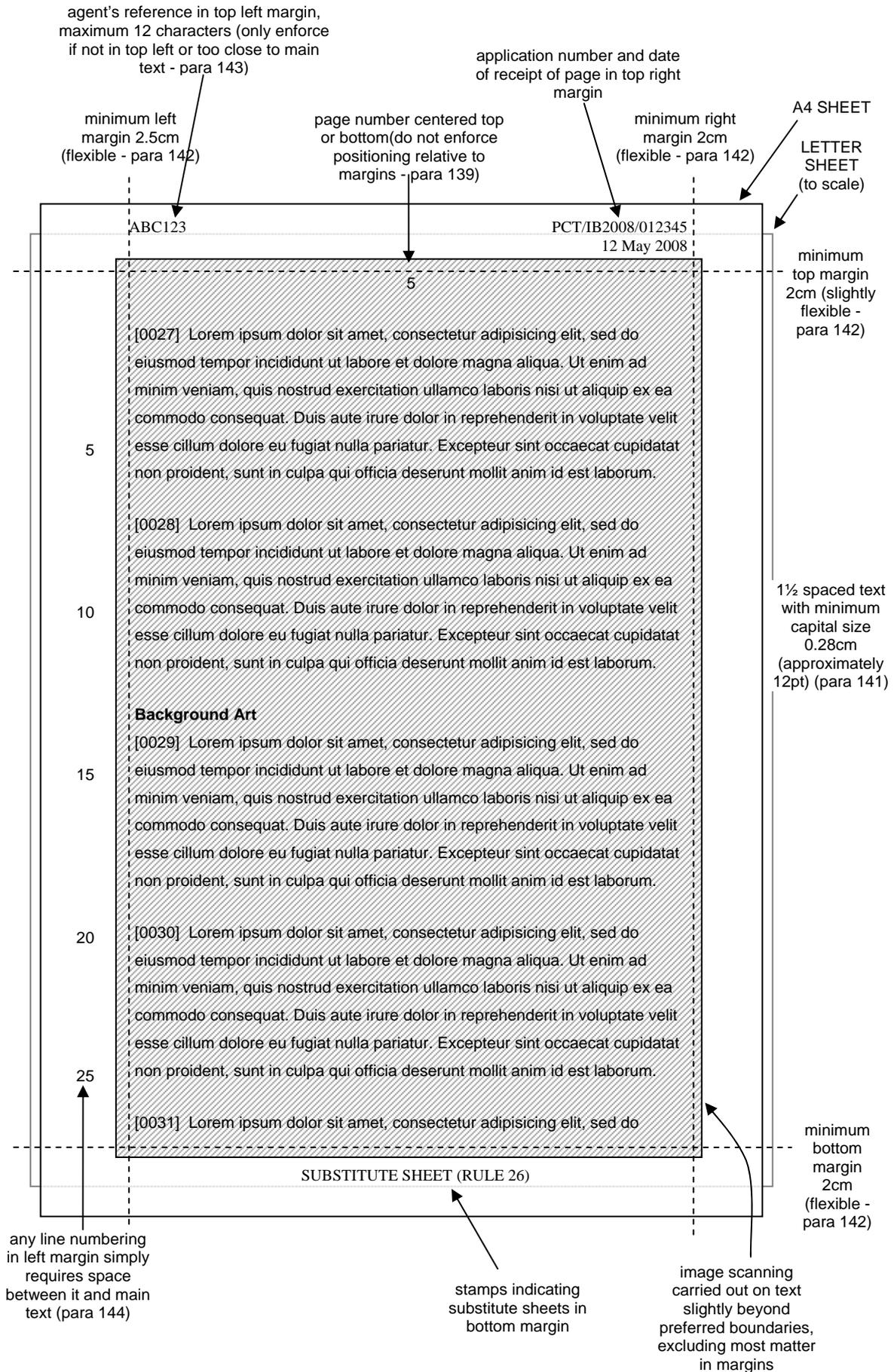
133. Where the international application is filed in a language of publication (Rule 48.3(a) and paragraph 55), the receiving Office checks whether the application complies with physical requirements to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication (Rule 26.3(a)(i)), [including image scanning and optical character recognition \(OCR\) by the International Bureau](#), as outlined in paragraphs 139 to 146.

[...]

135. Where the international application is filed in a language which is not a language of publication, in which case not the original text but a translation furnished by the applicant under Rule 12.3 or 12.4 will be published, the receiving Office checks that original text of 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 purposes of satisfactory reproduction (Rule 26.3(b)(i) and paragraph 134). The translation and the drawings [in the language of publication](#) are checked for compliance with the physical requirements referred to in Rule 11 to the extent that compliance is necessary for the purpose of reasonably uniform international publication (Rule 26.3(b)(ii)), [including image scanning and OCR by the International Bureau](#). This also applies where the applicant has furnished a translation of the abstract or drawings containing the translation of text matter into the language in which the international application is to be published (Rule 26.3ter(a)).

[...]

*Diagram of Page Showing Main Layout Requirements*



139. **Arrangement of Elements and Numbering of Sheets.** The elements of the international application must be placed in the following order: the request, the description (other than any sequence listing part thereof), the claim(s), the abstract, the drawings (if any), and, where applicable, the sequence listing part of the description. All sheets constituting the international application must be numbered in consecutive Arabic numerals with the following separate series of numbering: the first applying to the request only and commencing with the first sheet of the request; the second series commencing with the first sheet of the description (except any sequence listing part thereof) and continuing through the claims until the last sheet of the abstract; if applicable, a third series applying to the sheets of the drawings only; and, if applicable, preferably, a further series applying to the sequence listing part of the description commencing with the first sheet of that part. ~~The numbers must be centered at the top or bottom of the sheet, but not placed in the margin.~~ The number of each sheet of the drawings must consist of two sets of Arabic numerals separated by a slant, the first set being the sheet number and the second set being the total number of sheets of drawings (for example, 1/3, 2/3, 3/3); see Rule 11.7 and Section 207. While Rule 11.7(b) indicates that the numbers must be centered at the top or bottom of the sheet, but not placed in the margin, objections to non-compliance with this specific limitation is unnecessary where the numbers appear in the top or bottom margins but do not interfere with the areas where the receiving Office stamps the sheets with the international application number, date of receipt and any indications relating to substitute sheets.

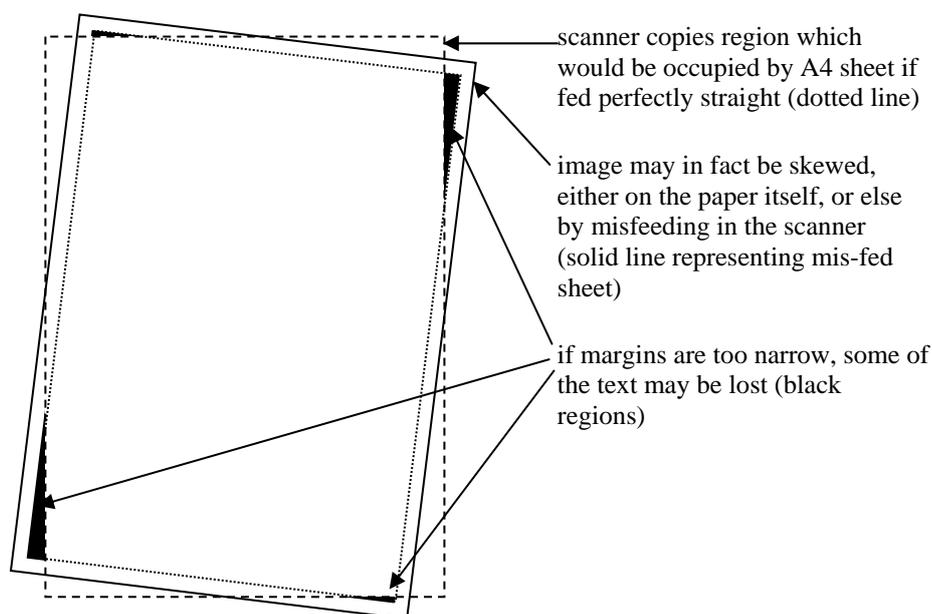
140. Where sheets filed on the international filing date but not numbered as part of the international application are intended to be part of the international application, ~~the pages need renumbering. To that effect the applicant may be invited under Rule 26 to furnish replacement sheets or~~ the receiving Office may renumber the sheets *ex officio* (paragraphs 161 to 165), failing which the International Bureau will do so.

141. **Writing of Text Matter.** The request, the description, the claims, the abstract and any sequence listing part shall be typed or printed in a dark indelible color (Rule 11.9; for the request see also the Notes to the request form). This is very important for the description, claims and abstract because these parts are subject to OCR which does not work effectively on handwriting or light colored text. However, graphic symbols, chemical and mathematical formulae and certain characters in the Chinese or Japanese languages may be hand drawn. The text must be printed in letters the capitals of which are not less than 0.28cm high (Rule 11.9(d)). This equates to approximately 12 point text in Times New Roman font and is important because smaller text is much less reliable for image scanning and OCR. Rule 11.9(c) requires that the typing is 1½ spaced, but this need only be enforced to the extent that the lines of text are clearly separated from one another such that there is a definite vertical gap between the tops of letters and the lower part of letters on the line above. Handwritten ~~Moreover, indications (in particular, the marking of check-boxes) in the request form; that are is, not machine printed; are not considered as a defect under Rule 11.9 should not be objected to if they are legible. Although Since~~ the request is not published as such, details such as applicant/inventor's names and addresses are captured by OCR at the International Bureau for the purposes of international publication, but rather information is extracted from it for publication of the international application on the WIPO website, and therefore Receiving Offices should, in their contacts with applicants, encourage them to respect similar guidelines for text matter in the request as in the description, claims and abstract, but without going as far as objecting to text matter in the request form, provided that it is sufficiently legible so as to allow correct data capture ~~text is required only to be sufficiently legible so as to allow correct data capture.~~

142. **Requirements Concerning Margins.** Rule 11.6 prescribes certain minimum requirements for the margins of the sheets containing the description, the claims and the abstract (top, bottom and right sides: 2cm; left side: 2.5cm). These requirements only need to be checked to the extent necessary to ensure that information is not lost in scanning and, in the case of pages of the description, claims and abstracts filed in a language of publication or in the case of translations furnished under Rule 12.4 for

the purposes of international publication, to ensure that image scanning and OCR can be carried out efficiently for the publication of the full text version of the international application. The area normally selected for OCR is based on the “ideal” margins as shown in the diagram above (inserted between paragraphs 138 and 139) in order to separate the text of the description and claims from the administrative text in the margins. However, as long as there is a clear gap between the main text and matter in the margins, it is generally easier for the International Bureau to adjust the original sheets to permit effective scanning than to deal with replacement sheets. Consequently, replacement sheets should only be requested for major defects. In practice, this means that there must be sufficient space to add any necessary stamps to the page (such as the international application number or an indication that a page is a replacement sheet) and still to have at least 0.5cm of blank space around the edge to avoid any information being lost if the page is not perfectly aligned when it is scanned (see diagram below). This means that the top margin is quite important, but that the left, right and (for originally filed sheets) bottom margins do not need to be checked carefully as long as any line numbers in the left margin remain well separated from the main text. ~~Minor non-compliance with the requirements concerning the left margin (provided that the sheets can be stapled without impeding the legibility of the text), right margin and bottom margin may be disregarded but compliance with the requirements concerning the top margin is important.~~ Sheets with letterheads or stamps with names and addresses of applicants or agents may not be used. Text matter originally prepared on a sheet which is reduced by photocopier to meet the A4 paper size requirements is only acceptable if the margins and character size on the A4 copy comply with the provisions of Rules 11.6 and 11.9(d).

*Diagram showing risk of text loss due to paper skew*



143. The indication of the applicant's file reference, if any, on pages of the international application other than the first sheet of the request, which is sometimes more than 12 characters in length, causes no problem so far as international publication is concerned, provided that the reference is placed in the left-hand corner of the top margin, within 1.5 cm from the top of the sheet. During the technical preparations for international publication, the top portion of all sheets of the international application is covered by a mask containing the pre-printed international publication number (for example, WO 2004/123456) (Section 404) and international application number. A reference placed as prescribed will be masked and will therefore not appear in the published international application, nor will it interfere with the OCR process.

144. **Line Numbering Sequence.** Rule 11.8(a) strongly recommends that “every fifth line of each sheet of the description, and of each sheet of claims” be numbered, the numbers appearing in the right half of the left margin, but that is not a mandatory requirement and in fact it is more useful for modern publication and identification of particular passages from databases storing the text rather than images if the paragraphs, rather than the lines, are numbered. If lines are not numbered or are numbered according to a sequence different from that recommended in Rule 11.8(a), there is no basis for objection with regard to the requirements of reasonably uniform international publication (Rule 26.3(a)). The only reason for objection to line numbering is if it appears somewhere other than the left margin or if there is not a clear gap between the numbering and the main text.

145. **Other Physical Requirements Concerning Text.** For reasonably uniform international publication and, in particular, to allow image scanning and OCR, it is important that text matter in the description, ~~and~~ claims and abstract should not be presented in more than one column, ~~and~~ Furthermore, the text should not be askew (however, text askew by not more than 5 mm is generally acceptable since it can be corrected by the International Bureau for image scanning and OCR). The description, claims and abstract may not contain drawings but may contain chemical or mathematical formulae and/or tables to the extent provided under Rule 11.10.

146. **Drawings and Photographs.** Flow sheets and diagrams are considered drawings (Rule 7.1). The Regulations are silent with regard to photographs. Photographs may be filed where it is impossible to represent in a drawing what is to be shown. Where photographs are submitted, they must be presented on sheets of A4 size, respect the minimum margins applicable for drawings (top and left sides: 2.5cm; right side: 1.5cm; bottom: 1cm, but as with text pages, there is some flexibility and the top and left side margins do not need to be enforced strictly as long as there is sufficient room to add the necessary information in the margins such as the international application number) and be black and white; they may be submitted as originals. Regarding the standard to be applied in respect of drawings, including photographs, see Rules 11.10, 11.11, 11.13 and also the PCT Applicant’s Guide, Volume I, Chapter V.

[...]

#### Matter not part of the international application **Appendices**

148. Apart from the request form (Rule 4.19), tThe PCT makes no provision for matter which does not appear to be a part of the international application such as appendices or annexes to the international application. Where such matter is submitted together with the international application ~~appendices or annexes are filed on the international filing date~~, the receiving Office invites the applicant to clarify within a reasonable time limit ~~clarifies with the applicant~~ whether these sheets are intended to be part of the international application. If the sheets are intended to be part of the application, they should be renumbered so as to comply with Section 207 under a heading which makes their status clear (paragraphs 139 and 140). If the applicant has not confirmed within the time limit set in the invitation that the sheets concerned should form part of the international application, the sheets concerned should be disregarded and are ~~If the sheets are not intended to be part of the international application, they are~~ not considered part of the record copy and should not be sent to the International Bureau (paragraph 294). As to sheets containing references to deposited biological material and sheets containing nucleotide and/or amino acid sequence listing and/or table(s) relating thereto, see paragraphs 222 to 227.

[...]

**Sheets Submitted under Rule 20.6(a)(i) which contain additional matter**

205E. Where the applicant timely confirms the incorporation by reference of missing elements or parts and furnishes a sheet or sheets containing such missing elements or parts, but such sheets contain additional matter which (1) the applicant does not wish to be incorporated by reference, and/or (2) which are not contained in the earlier application and therefore cannot be incorporated by reference, the receiving Office may invite the applicant to re-submit the sheet(s) from which the said additional matter has been removed. Depending on the case, the receiving Office may alternatively correct such additional matter by deleting ex officio the said additional matter. The general manner of making ex officio corrections by the receiving Office is provided in paragraphs 161 to 163. Where there is more than one possibility of correcting the additional matter, the receiving Office should contact the applicant by telephone and/or in writing to clarify the applicant's intention before making any ex officio correction.

**Incorporation by reference cannot replace elements/parts of the international application originally submitted**

205F. Where the applicant timely confirms incorporation by reference of missing elements or parts, and furnishes sheets under Rule 20.6(a)(i) which contain the description, claims and/or drawings from the earlier application, and requests that they replace the description, claims and/or drawings of the international application, the receiving Office may not perform such substitution; the description, claims or drawings from the earlier application, which are to be incorporated by reference, cannot replace the description, claims or drawings of the international application as filed. In this situation, the parts to be incorporated by reference (Rule 20.5) should be combined with the elements of the international application originally submitted and should also be checked for compliance with the physical requirements referred to in Rule 11 to the extent that compliance is necessary for the purpose of reasonably uniform international publication (Rule 26.3(b)(ii)), including image scanning and OCR by the International Bureau. The receiving Office should invite the applicant to renumber any paragraphs, pages, claim numbers and drawing numbers so that the pages of the combined international application are placed in an order such that the sheets incorporated by reference are placed first sequentially followed by the pages which were originally filed such as in the following example.

Description incorporated from earlier application

Description as originally filed

Claims incorporated from earlier application

Claims as originally filed

Drawings incorporated from earlier application

Drawings as originally filed

The receiving Office should note that the abstract is not covered by incorporation by reference under Rule 20 (see Rule 38.3 for the possibility of the applicant to request modification of the abstract by the International Searching Authority).

[...]

### Items to Be Transmitted to the International Bureau

325. Where the receiving Office receives from the applicant items which should have been filed with the International Bureau, it marks the date of receipt on the items concerned and transmits them promptly to the International Bureau. The receiving Office may inform the applicant about the transmittal. This applies, in particular, to the following items:

(i) references to deposited microorganisms or other biological material filed later than the international application (Rule 13*bis*.3 and paragraphs 228 to 234);

(ii) a request to publish indications relating to a priority claim considered void (Rule 26*bis*.2(d) and paragraphs 171, 172, 175 and 178);

(iii) a request to publish a request for rectification of an obvious mistake where the rectification was refused under Rule 91.3(d) together with substitute sheets that might have been proposed by the applicant (paragraph 306);

(iv) the correction or addition of declarations relating to national requirements under Rule 4.17 (Rule 26*ter* and paragraph 192F);

(v) amendments to the claims filed under Article 19 (Rule 46.1);

(vi) a notice of correction of addition of a declaration under Rule 26*ter*.1 (Section 317)

[\(vii\) a supplementary search request under Rule 45\*bis\*.1.](#)

### Notification about Right to Practice of Agent before Receiving Office

[...]

335. Where the receiving Office receives from the International Bureau, the International Searching Authority, [the Authority specified for supplementary search](#) or the International Preliminary Examining Authority a request for information as to whether a person has the right to practice before the receiving Office, that Office informs that Bureau or Authority in compliance with Rule 83.2. Such information, which is binding for the respective Authority, should be provided on Form PCT/RO/148.

[End of Annex]