



C. PCT 1426

October 2, 2014

Madam,  
Sir,

*Standardized Clauses in PCT International Search and Preliminary Examination Reports*

This Circular is addressed to your Office in its capacity as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT).

This Circular communicates a finalized set of standardized clauses for use in international search and preliminary examination reports. It also discusses the implementation by those Authorities interested in using the clauses in their reports.

At the fourth informal meeting of the Quality Subgroup of the Meeting of International Authorities under the PCT (PCT/MIA Quality Subgroup), held in Tel Aviv on February 9 and 10, 2014, the Quality Subgroup discussed a paper (Paper No. 6) that reported on progress in the pilot group tasked with preparing a set of standardized clauses for use in international search and preliminary examination reports. This work had begun following a proposal by the Canadian Intellectual Property Office at the eighteenth session of the PCT/MIA in 2011 (document PCT/MIA/18/8) and an invitation to Authorities, by means of Circular C. PCT 1328, dated December 13, 2011, to submit standardized clauses used in their reports.

The discussions of standardized clauses at the fourth informal meeting of the Quality Subgroup are summarized in paragraphs 13 to 16 of Annex II to document PCT/MIA/21/22. Paragraph 16 sets out the follow-up agreed by the Subgroup:

/...

“16. The Subgroup recommended that:

(a) Authorities should submit any further comments on the wording of the draft set of standardized clauses to the International Bureau via the Subgroup’s e-forum before the end of April 2014;

(b) the International Bureau should then finalize the clauses, taking into account any comments received, and formally communicate the final wording of those clauses to all Authorities by way of a Circular; the date of actual first use of those clauses in reports should then be left to each Authority, depending on its specific implementation needs.”

In line with the recommendation by the Subgroup, the International Bureau invited comments on an updated set of standardized clauses posted on the Subgroup’s electronic forum on March 11, 2014. Three Authorities posted further remarks on these clauses.

./. The Annex to this Circular contains a finalized set of standardized clauses. In addition to taking into account the remarks made in the final discussion round, this includes changes to some clauses to cover reference to claims in both their singular and plural. A set of clauses showing changes from the text posted in the final discussion round has been posted on the PCT Quality Subgroup forum at <https://www3.wipo.int/confluence/display/pctqualitysubgroup/Standardized+Clauses>.

Any International Authority interested in using the standardized clauses in their reports is invited to inform the International Bureau of the date it proposes to begin use of the clauses and share any experiences with their implementation that could be of interest to other Authorities. The clauses have so far been established only in English. Any Authority that intends to use the clauses in any other language of publication is invited to contact the International Bureau, which will then prepare the necessary translation of the clauses into any such language.

Information on plans to implement the clauses by International Authorities and any other comments on this Circular should be addressed to PCT Business Development Division, email [pctbdd@wipo.int](mailto:pctbdd@wipo.int). Comments of a general nature may also be shared with other International Authorities on the Quality Subgroup forum. Any comments received by November 24, 2014 will be taken into account in preparing a paper for the fifth informal session of the Quality Subgroup, envisaged to take place in early 2015.

Yours sincerely,



James Pooley  
Deputy Director General

Enclosure:      Annex      Final Standardized Clauses

**FINAL STANDARDIZED CLAUSES**

## GENERAL PRINCIPLES

- a) Clauses should refer to relevant provisions under the PCT where possible and shall not contain any reference to national laws and practices.
- b) Clauses should be concise using short sentences and avoiding unnecessarily complex language, thereby facilitating eventual translation into other PCT languages.
- c) Clauses should use vocabulary closely aligned to the relevant provisions in the PCT and shall not contain alternative wording with equivalent meaning used in national laws.
- d) Clauses should be limited in number and cover common situations encountered when producing a written opinion or international preliminary examination report on an international application. The use of alternative options for conveying the same message or rarely-used clauses covering unusual cases or practices not common to all International Authorities should be avoided wherever possible.
- e) The clauses should include text that could be used by a number of International Authorities. However, the use of standardized paragraphs should never be mandatory, given the need for flexibility for the examiner to address all relevant issues in a manner which he or she deems appropriate in the given case.

## CLAUSES

## BOX V

<b>Number</b>	<b>Clause</b>
V.1	Reference is made to the following documents: D1 XX NNNNNNN A1 (COMPANY) date of publication D2 AUTHOR Title of Publication, Year, Volume, No. Pages Etc.
<b>Novelty (N)</b>	
Clauses for Lack of Novelty	
V.2	Claim(s) ... is/are not novel and therefore do(es) not comply with PCT Article 33(2).
	<i>Alternative A - Explanation by document</i>
V.3	Document Dx discloses [insert description]. Therefore claim(s) ... is/are not novel.
	<i>(Repeat clause V.3 for other documents as necessary)</i>
	<i>Alternative B - Identification of closest prior art</i>
V.4.1	Document D1 is considered to be the closest prior art and discloses [insert description]. Therefore claim(s) ... is/are not novel.
V.4.2	Document Dx discloses the additional features [insert description]. Therefore claim(s) ... is/are not novel.

	<i>Alternative C - Separation between independent and dependent claims</i>
V.5.1	Document(s) Dx, Dy ... disclose(s) [insert description]. Therefore claim 1 is not novel.
V.5.2	The features added by dependent claim(s) ... are also disclosed in document Dx, for example [insert description]. [Repeat as necessary for other documents]. Therefore claim(s) ... is/are not novel.
Clauses when Novelty is complied with	
V.6	Claim(s)... is/are novel and therefore complies/comply with PCT Article 33(2).
V.7	Document D1 is considered to represent the closest prior art. Document D1 discloses [insert description]. However, none of the cited documents discloses [insert description]. Claim(s) ... is/are therefore novel.
<b>Inventive Step (IS)</b>	
Clauses for Lack of Inventive Step	
V.8	Claim(s)... do(es) not involve an inventive step and therefore do(es) not comply with PCT Article 33(3).
V.9	Given the above novelty objection, claim(s) [same claim(s) not showing novelty] do(es) not involve an inventive step for the reasons above.
V.10	Document D1 discloses ..... Document D2 discloses ..... [Insert description to explain lack of inventive step]. It would have been obvious to a person skilled in the art to arrive at the matter defined in claim(s) ... by combining the teachings of documents D1 and D2. EITHER: Document(s) ... therefore show(s) that claim(s) ... do(es) not involve an inventive step. OR: Document(s) ... when combined with document(s) ... therefore show(s) that claim(s) ... do(es) not involve an inventive step.
Clauses for when Inventive Step is complied with	
V.11	Claim(s) ... involve(s) an inventive step and therefore complies/comply with PCT Article 33(3).
V.12	[Insert description of feature] is not obvious to a person skilled in the art from the cited documents, when taken individually or in any combination. Claim(s) ... therefore involve(s) an inventive step.

BOX VIII

Number	Clause
<b>Article 5</b>	
VIII.1	The description does not comply with PCT Article 5.
VIII.2	The description does not sufficiently clearly and completely disclose the invention in a manner sufficiently clear and complete to be carried out by a person skilled in the art. [Add explanation]
<b>Article 6</b>	
VIII.3	Claim(s) ... do(es) not comply with PCT Article 6.
<u>Support</u>	
Essential feature of the invention not in the claims	
VIII.4	The description indicates [describe missing essential feature(s)] on page(s) ... to be an essential feature of the invention. This feature is not recited in claim(s) ...
VIII.5	The description indicates on page(s) ... that [describe missing essential feature(s)] materially affects the way the invention works, and is therefore essential. This feature is not recited in claim(s) ....
Element in claim missing from the description	
VIII.6	Claim(s) ... is/are not fully supported by the description. Specifically (describe missing element) is not present in the description.
Operative range of claim outside that of description	
VIII.7	Claim(s) ... describe(s) a range which is out of the operative range disclosed in the description on page(s) ... [Add explanation].
Claim excessively broad without solving problem	
VIII.8	Claim(s) ... include(s) a broad statement that includes all possible means without qualification for solving the problem facing the inventor. This/These claim(s) therefore merely re-state(s) the problem or the desired result.
<u>Clarity and conciseness</u>	
Lack of conciseness	
VIII.9	Claim(s) ... is/are not concise. The number of claims shall be considered reasonable in consideration of the nature of the invention claimed (PCT Rule 6.1(a)).
VIII.10	Claim(s) ... is/are not concise. The claims are identical or are so close in content that these claims address the same subject matter.
Lack of clarity	
VIII.11	Claim(s) ... is/are not clear. The term/expression [describe term/expression] is not clear from the description.

VIII.12	Claim(s) ... is/are not clear. The term/expression [describe term/expression] is used in the claim(s) to mean [enter meaning], which does not have a well-recognized meaning in the art.
VIII.13	Claim(s) ... is/are not clear. The term/expression [describe term/expression] is ambiguous.

[End of Annex]