

C. PCT 1669

May 17, 2024

Madam,
Sir,

Alternative Practices in the International Search and Preliminary Examination Guidelines

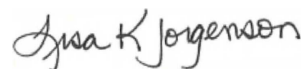
This Circular is addressed to your Office in its capacity as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT).

At the thirteenth informal session of the Quality Subgroup held on October 30 and 31, 2023, the Subgroup discussed the proposal by the Canadian Intellectual Property Office (CIPO) to identify and record the different approaches selected by Authorities where the PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) offer options. The Subgroup recommended that the International Bureau of the World Intellectual Property Organization (WIPO) should, with the assistance of CIPO, provide details of the alternatives chosen by each International Authority for the various issues where differences in practice are recognized by the Guidelines, as well as indicating any other areas where differences may have been identified to exist that are not so recognized (paragraphs 13 and 14 of Annex II to document PCT/MIA/30/10).

./ The Annex to this Circular includes tables listing the alternative practices in the Guidelines. Your Office is invited to complete the tables with details of your respective practices using the template of this Annex in Word format available on the electronic forum of the Quality Subgroup. Details on how to join the forum can be requested by email to pct.mia@wipo.int.

Your Office is invited to submit its response by June 14, 2024, preferably by uploading it directly to the appropriate page of the electronic forum of the Quality Subgroup, or alternatively, by sending it by e-mail to pct.mia@wipo.int.

Yours sincerely,



Lisa Jorgenson
Deputy Director General
Patents and Technology Sector

Enclosure: Annex: Alternative Practices in the International Search and Preliminary Examination Guidelines

ALTERNATIVE PRACTICES IN THE INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

Responding International Authority:

Name of contact person:

Position:

E-mail address:

Please complete the following tables and respond to the questions below.

In the first table, please indicate the alternative practice in the International Search and Preliminary Examination Guidelines your Office follows and any relevant references to Office manuals relating to practice under the PCT or similar provisions under national and regional patent law.

Subject	Paragraph	Alternative followed (tick box [1] or [2])		Reference Material with Links	Comments
		[1]	[2]		
Background Art	A4.05				
Multiple Dependent Claims	A5.16				
Interpretation of Claims	A5.20				
Product by Process Claims	A5.26				
Conciseness	A5.42				
Excluded Subject Matter Regarding Schemes, Rules or Methods of Doing Business etc.	A9.07				

Subject	Paragraph	Alternative followed (tick box [1] or [2])		Reference Material with Links	Comments
		[1]	[2]		
Excluded Subject Matter Pertaining to Programs for Computers	A9.15				
Extrinsic Knowledge in Determining if Prior Art Defeats Novelty	A12.02				
Utility or Industrial Applicability	A14.01				
New Matter	A.20.21				

In the second table below, please indicate whether your Office follows certain approaches or methodologies from the International Search and Preliminary Examination Guidelines, by stating Yes or No in the relevant column. Again, please provide any relevant references to Office manuals relating to practice under the PCT or similar provisions under national and regional patent law and any comments providing information on your Office's alternative practice, if applicable.

Subject	Paragraph	Particular method or approach followed (Yes or No)	Reference Material with Links	Comments
"Use Claims"	A5.21			
Informal Clarification	9.34 and 9.35			
"Minimum Reasoning" Methodology	10.04A			
Problem-Solution Approach	A13.08.1			
Examples in which a single document calls into question the inventive step	A13.13			

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Subject	Paragraph	Particular method or approach followed (Yes or No)	Reference Material with Links	Comments
Provision of Partial International Search (Annex to PCT/ISA/206)	10.61			
Cases where a further written opinion (IPEA/408) may be established	19.24			

In the third table below, please indicate your level of use for two Boxes of Form PCT/ISA/237, corresponding to paragraphs 17.49, 17.50 of the International Search and Preliminary Examination Guidelines, by ticking the box “Do not use”, “Use for only major issues”, “Use for only minor issues” or “Use for all issues found” any relevant references to Office manuals relating to practice under the PCT or similar provisions under national and regional patent law.

Subject	Paragraph	Level of Use				Reference Material with Links	Comments
		Do not use	Use for only major issues	Use for only minor issues	Use for all issues found		
Box No. VII of ISA/237	17.49						
Box No. VIII of ISA/237	17.50						

[End of Annex and of Circular]