

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Eleventh Session (7th Extraordinary)*
Geneva, January 30 to February 3, 1984

PROPOSED AMENDMENT TO RULES 70.16 AND 74
OF THE REGULATIONS UNDER THE PCT
(Chapter 18 of document PCT/A/XI/4 and Chapter 37 of document PCT/A/XI/5)

Proposal by the Delegation of the United Kingdom

1. The United Kingdom delegation approves the intention behind the proposals to amend Rule 70.16 to clarify the content of the annex to the International Preliminary Examination Report which will ensure that only letters which cancel entire sheets of the application are attached as annex (in addition to replacement sheets). This will reduce the amount of translation required. However, the problem which arises is that letters written to the International Preliminary Examining Authority in response to a written opinion may contain several matters, e.g. a statement cancelling entire sheets, an explanation of the differences between replaced sheets and the replacement sheets (when other amendments are made - see Rule 66.8) and perhaps several pages of argument against citations made in the written opinion. The present proposal only provides for the entire letter to be annexed. This may still involve the applicant in wasteful translation of a good deal of matter, which is not only irrelevant but could be confusing since the reader of the annex will not have before him a copy of the written opinion to which the letter is directed. Accordingly, the United Kingdom delegation would like to propose two possible ways of avoiding this.

* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

2. The first is to further amend rules 66.8, 70.16 and 74.1 to indicate that the cancellation of entire sheets should be communicated on a separate sheet of a letter and that only this sheet be annexed to the report. This would correspond somewhat to the treatment of the statement under Art 19 (see rules 46.4). Suggested proposals for these amendments are attached (Version 1). The second method would be to require the IPEA to indicate the cancellation of entire sheets on the front page of the IPE Report. This would correspond to what the IB does (presumably) when entire sheets of claims are cancelled under rule 46.5 - see publication rule 48.2(f). This could be effected either by producing an amended form of PCT/IPEA/409 or by using the present form and in the section headed "Basis of Report" where it says "description (or claim(s), or drawings, Sheet/fig....) as originally filed adding in the space provided "are cancelled in your letter of ..." as illustrated on the attached copy of Form PCT/IPEA/409. No amendment of rule 66.8 would then be needed and rules 70.16 and 74.1 could be amended as indicated in Version 2. An additional Administrative Instruction could make this procedure clear if necessary.
3. The United Kingdom delegation's preference is for the second version.

Version 1

66.8 Form of Amendments

(a) The applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet originally filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter on a separate sheet identified by a heading "Cancellation of sheets" or its equivalent in the language of the amendment.

70.16 Annexes of the Report

If the claims, the description, or the drawings, were amended** before the International Preliminary Examining Authority, each replacement sheet under Rule 66.8(a) shall be annexed to the report. Replacement sheets superseded by later replacement sheets and letters accompanying replacement sheets under the second sentence of Rule 66.8(a) shall not be annexed. If the amendment is communicated in a letter under the last sentence of Rule 66.8(a), a copy of ^{the relevant sheet of} such letter shall ~~not~~ be annexed to the report.

74.1 Contents of Translation and Time Limit for Transmittal Thereof

Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), transmit a translation of any replacement sheet referred to in Rule 70.16, or of ^{the relevant sheet of} any letter referred to in the last sentence of that Rule, which is annexed to the international preliminary examination report. The same time limit shall apply where the furnishing of a translation of the international application to an elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

Version 2

70.11 Mention of Amendments

If, before the International Preliminary Examining Authority, amendments^{*} have been made, this fact shall be indicated in the report. Where any amendment results in the cancellation of an entire sheet, this fact shall also be specified in the report.

70.16 Annexes of the Report

If the claims, the description, or the drawings, were amended** before the International Preliminary Examining Authority, each replacement sheet under Rule 66.8(a) shall be annexed to the report. Replacement sheets superseded by later replacement sheets and letters accompanying replacement sheets under the second sentence of Rule 66.8(a) shall not be annexed. ~~If the amendment is communicated in a letter under the last sentence of Rule 66.8(a),~~ H ✓
~~a copy of such letter shall*** be annexed to the report.~~

74.1 Contents of Translation and Time Limit for Transmittal Thereof

Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), transmit a translation of any replacement sheet referred to in Rule 70.16/ or of any letter referred to in the last sentence of that Rule/ which is annexed to the international preliminary examination report. The same time limit shall apply where the furnishing of a translation of the international application to an elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22. H ✓

**PATENT COOPERATION TREATY
INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

IDENTIFICATION OF THE INTERNATIONAL APPLICATION		Applicant's or Agent's File Reference ²		
International Application No. ¹	International Filing Date ¹			
Receiving Office ¹	Priority Date Claimed			
Applicant (Name) ¹				
BASIS OF REPORT				
<p>1. AMENDMENTS AND/OR CORRECTIONS^{3*} — The amendments and/or corrections made before this International Preliminary Examining Authority in respect of the claims, the description, and/or drawings in the above-identified international application are annexed to this report.</p> <p>a. <input type="checkbox"/> This report has been established on the basis of the following application documents:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> the application documents as filed <input checked="" type="checkbox"/> description, pages <u>9-10</u> description, pages _____ description, pages _____ description, pages _____ <input checked="" type="checkbox"/> claim(s) <u>10-20</u> claim(s) _____ claim(s) _____ claim(s) _____ <input type="checkbox"/> drawings, sheet/fig. _____ <input type="checkbox"/> drawings, sheet/fig. _____ </td> <td style="width: 50%; vertical-align: top; border-left: 1px solid black;"> as originally filed <u>are cancelled in letter of</u> filed with your letter of <u>10.3.83</u> filed with your letter of _____ filed with your letter of _____ as originally filed <u>are cancelled in letter of</u> filed with your letter of <u>10.3.83</u> filed with your letter of _____ filed with your letter of _____ as originally filed _____ filed with your letter of _____ </td> </tr> </table> <p>b. <input type="checkbox"/> This report has been established as if the amendments and/or corrections indicated on the extra sheet have not been made, since, for the reasons indicated, they have been considered to go beyond the disclosure as filed.</p>			<input type="checkbox"/> the application documents as filed <input checked="" type="checkbox"/> description, pages <u>9-10</u> description, pages _____ description, pages _____ description, pages _____ <input checked="" type="checkbox"/> claim(s) <u>10-20</u> claim(s) _____ claim(s) _____ claim(s) _____ <input type="checkbox"/> drawings, sheet/fig. _____ <input type="checkbox"/> drawings, sheet/fig. _____	as originally filed <u>are cancelled in letter of</u> filed with your letter of <u>10.3.83</u> filed with your letter of _____ filed with your letter of _____ as originally filed <u>are cancelled in letter of</u> filed with your letter of <u>10.3.83</u> filed with your letter of _____ filed with your letter of _____ as originally filed _____ filed with your letter of _____
<input type="checkbox"/> the application documents as filed <input checked="" type="checkbox"/> description, pages <u>9-10</u> description, pages _____ description, pages _____ description, pages _____ <input checked="" type="checkbox"/> claim(s) <u>10-20</u> claim(s) _____ claim(s) _____ claim(s) _____ <input type="checkbox"/> drawings, sheet/fig. _____ <input type="checkbox"/> drawings, sheet/fig. _____	as originally filed <u>are cancelled in letter of</u> filed with your letter of <u>10.3.83</u> filed with your letter of _____ filed with your letter of _____ as originally filed <u>are cancelled in letter of</u> filed with your letter of <u>10.3.83</u> filed with your letter of _____ filed with your letter of _____ as originally filed _____ filed with your letter of _____			
<p>2. PRIORITY⁴</p> <p>a. This report has been established as if no priority has been claimed due to the failure to furnish within the prescribed time limit the requested:</p> <p><input type="checkbox"/> copy of the earlier application whose priority has been claimed.</p> <p><input type="checkbox"/> translation of the earlier application whose priority has been claimed.</p> <p>b. <input type="checkbox"/> This report has been established as if no priority has been claimed due to the fact that the priority claim has been found invalid.</p> <p style="text-align: center;">Thus, for the purposes of this report, the international filing date indicated above is considered to be the relevant date.</p>				
<p>* Where this report contains attachments of corrections and amendments (including letters making amendments), a translation of these attachments must be furnished to the elected Offices together with the translation (if required) of the international application as originally filed.</p>				