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(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

Thirteenth Session
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PCT INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION GUIDELINES

Document prepared by the Secretariat

1. Annex I sets out proposals by the International Bureau for modifications of the PCT International Search and Preliminary Examination Guidelines in respect of changes which have come into force since the Guidelines were adopted in 2004 and errors which have been discovered. The main changes reflect amendments to the Regulations which came into force on April 1, 2005, in the areas of simplification of protest procedures and furnishing of sequence listings. Annex II contains comments explaining the reasons for the proposed modifications.
2. Further proposals by the United States Patent and Trademark Office, mainly relating to the amendments to the Regulations under the PCT which are due to come into force on April 1, 2007, are contained in document PCT/MIA/13/2 Add.1.
3. These proposals do not, except where noted in Annex II, contain changes relevant to matters which are still under discussion and may be adopted prior to the intended entry into force of the next version of the Guidelines in April 2007. Examples of such matters include the proposals under discussion at the eighth session of the Working Group on Reform of the PCT, to be held in Geneva from May 8 to 12, 2006, and the ongoing consideration of proposed modifications of the Administrative Instructions as set out in Circular C. PCT 1014/C. SCIT 2609, dated February 7, 2005.

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4. The Meeting is invited to comment on the proposed changes to the Guidelines contained in Annex I.

[Annexes follow]

ANNEX I

PROPOSED MODIFICATIONS TO THE
PCT INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION GUIDELINES

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PART I INTRODUCTION AND OVERVIEW

Chapter 1 Introduction

Purpose and Status of These Guidelines

1.01 These Guidelines give instructions as to the practice to be followed by Authorities during the international search and examination procedures. ~~The Guidelines have been revised to incorporate the changes resulting from the amendments to the Regulations under the Patent Cooperation Treaty (PCT) adopted by the Assembly in September 2002, the main change relating to the procedure before the International Searching and Preliminary Examining Authorities being that the establishment of an examiner's written opinion is incorporated into the international search procedure.~~

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Overview of International Application Process

1.09 The procedure through which an international patent application under the Patent Cooperation Treaty proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two main stages, commonly referred to as the “international phase” and the “national phase” (or “regional phase” when an international application comes before a regional body rather than a national one). ~~As indicated in paragraph 1.01, a major change to processing international applications is that the International Searching Authority rather than the International Preliminary Examining Authority establishes a first written opinion (under PCT Rule 43bis), thus combining the international search and international preliminary procedures to a much greater extent than before.~~ The following paragraphs 1.10, 1.11 and the flowchart of typical international application processing that has been provided at the end of this chapter provide a brief overview of the international phase, with a complete explanation provided in Parts 2 through 8 of the Guidelines.

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Chapter 2 Overview of the International Search Stage

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The International Search Process

2.10 The role of the International Searching Authority is as follows, the details being considered in subsequent chapters referred to below:

(a) to (d) [No change]

(e) to determine whether to invite the applicant to provide a listing if the international application contains disclosure of one or more nucleotide and/or amino acid sequences but does not include a sequence listing in compliance with the ~~paper form or computer readable~~

Rule 13ter

~~sequence listing~~ standards [for sequence listings in paper or electronic form](#) provided for in the Administrative Instructions (see paragraphs 15.11 and 15.12);

(f) to (i) [No change]

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Chapter 3 Overview of the International Preliminary Examination Stage

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Preliminary Matters

Filing of Demand

Article 31(6); Rule 54bis

3.07 The applicant should file the demand with the competent International Preliminary Examining Authority before the expiration of the later of the following time limits:

- (a) three months from the date of transmittal to the applicant of the international search report [or the declaration referred to in Article 17\(2\)\(a\)](#), and written opinion established under Rule 43bis.1, ~~or of the declaration referred to in Article 17(2)(a)~~; or
- (b) 22 months from the priority date of the international application.

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Rule 69.1

3.13 The International Preliminary Examining Authority normally starts the international preliminary examination [\(see Chapter 19\)](#) when:

- (a) it is in possession of:
 - (i) the demand;
 - (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2; ~~and~~
 - (iii) if the applicant is required to furnish a translation under Rule 55.2, that translation; and
 - (iv) either the international search report [or the declaration by the International Searching Authority under Article 17\(2\)\(a\) that no international search report will be established](#), and the written opinion established under Rule 43bis.1 ~~or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established~~;
- and

(b) the time limit within which the applicant was permitted to file the demand (see paragraph 3.07) has expired, or earlier if the applicant has expressly requested an earlier start.

3.14 The exceptions to the above are as follows:

Rule 69.1(c)

(a) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned.

Rule 69.1(e)

(b) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) (see paragraph 18.04) has expired, whichever occurs first.

Rule 69.1(b) and (d)

~~(ac) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes, start at the same time as the international search (subject to the possible need to invite the applicant to provide copies of amendments under Article 34, as noted in paragraph (b), above), provided that the applicant has not indicated (under Rule 53.9(b)) in the statement of amendments that examination is not to be postponed until after the expiry of the time limit for filing amendments under Article 19 (such amendments only being permitted after the international search report has been received) according to the statement concerning amendments (see paragraphs (c) and (d) below).~~

~~(b) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned.~~

~~(e) Where the statement concerning amendments contains such an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority does not start the international preliminary examination before whichever of the following occurs first:~~

~~— (i) — until it has received a copy of any amendments made under Article 19,;~~

~~— (ii) — it has received or a subsequent notice from the applicant that he does not wish to make amendments under Article 19,; or the time limit under Rule 46.1 for filing Article 19 amendments has expired, whichever occurs first.~~

~~— (iii) — the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search will be established; or the expiration of 22 months from the priority date.~~

~~(d) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) (see paragraph 18.04) has expired, whichever occurs first. These examination procedures before the International Preliminary Examining Authority are set out in detail in chapter 19.~~

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PART II THE INTERNATIONAL APPLICATION

Chapter 4 Content of the International Application (Other Than the Claims)

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Rules 5.1(a)(ii), 6.3(b)(i)

4.05 [No change to body of paragraph]

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Rules 5.2, 13ter.1(a), (c) and (e); Sections 208, 801; AI Annex C

4.15 Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description should contain a separate sequence listing part complying with the standard provided for in Annex C of the Administrative Instructions. ~~The sequence listing may be in written form and computer readable form, both forms complying with the standard provided for in Annex C. Instead of in written form, the sequence listing may be filed on an electronic medium under the provisions of Section 801 of the Administrative Instructions, where the receiving Office in which the international application was filed accepts sequence listings filed on an electronic medium. The International Searching Authority carries out the international search on the basis of those forms of the listing.~~ Where the receiving Office accepts sequence listings filed on an electronic medium in accordance with Part 8 of the Administrative Instructions, the applicant may choose to file the sequence listing part of the description and/or any table related to the sequence listing either in paper form, in electronic form, or both. Either form must comply with the standard provided for in Annexes C and C-bis. However, where the listing is not available to the International Searching Authority (or International Preliminary Examining Authority) in electronic form, or the listing does not comply with the relevant standard, the International Searching Authority may invite the applicant to furnish a further copy of the listing in the appropriate format for the purposes of international search. For handling of the nucleotide and/or amino acid sequence listings, refer to paragraphs 15.11 and 15.12 (search stage) and paragraphs 18.17 to 18.18 (examination stage).

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Chapter 5 [No change]

Chapter 6 Priority

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Determining Priority Dates

6.06 As a general rule, the examiner, in preparing a written opinion or an international preliminary examination report, should not make any investigation as to the validity of a right to priority (in which case, Box No. II ("Priority") of the opinion or report would not normally

[be included; see paragraph 17.25](#)). However, the priority right assumes importance if subject matter relevant with regard to the determination of novelty or inventive step (non-obviousness) of the claimed invention:

- (i) has been published within the meaning of Rule 64.1 on or after the priority date claimed and before the international filing date;
- (ii) forms part of the content of a non-written disclosure within the meaning of Rule 64.2, that is, a non-written disclosure which occurred before the priority date and which was indicated in a written disclosure in the period between, and including, the priority date and the international filing date; or
- (iii) forms part of the content of an application or patent within the meaning of Rule 64.3, that is, an application or patent which was published on or after that date but was filed earlier than the international filing date or claimed the priority of an earlier application which was filed prior to the international filing date.

In such cases (that is, cases where the art in question would be relevant if of earlier date), the examiner must satisfy himself that the priority date(s) claimed may be accorded to the appropriate parts of the international application he is examining and, where appropriate, will also consider the validity of any priority date claimed for the application or patent within the meaning of Rule 64.3 (see also Rule 70.10, last sentence).

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Rules 66.7(a) and (b), 17.1(c) and (d)

6.17 If the examiner needs a copy of the priority document (see paragraph 6.06), the copy is supplied on request by the International Bureau, unless the International Bureau has not yet received the priority document (see paragraph 6.12), ~~in which event the examiner may invite the applicant himself to furnish such a copy~~. If the priority document is not in the language, or one of the languages (if more than one) of the relevant Authority, the examiner may invite the applicant to furnish a translation of the priority document within two months of the invitation. In the meantime, any written opinion established while there is still time to furnish the priority document or translation thereof may proceed as if the priority had been validly claimed (see also paragraphs 11.05, 17.26 and 18.16); however, if the necessary priority document or its translation is not timely furnished, any further written opinion or the international preliminary examination report may be established as if the priority had not been claimed. No designated Office may disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances. Furthermore, no designated Office may disregard the priority claim if the priority document is available to it from a digital library in accordance with the Administrative Instructions.

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Chapter 7
[No change]

Chapter 8
[No change]

PART III
EXAMINER CONSIDERATIONS COMMON TO BOTH THE INTERNATIONAL
SEARCHING AUTHORITY AND THE INTERNATIONAL PRELIMINARY
EXAMINING AUTHORITY

Chapter 9
Exclusions from, and Limitations of, International Search and International
Preliminary Examination

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Extent of Search and Preliminary Examination in Certain Situations

9.19 There may be exceptional situations where the description, the claims or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out, that is, no search at all is possible for a particular claim (see paragraph 9.01). However, in certain situations where the description, the claims, or the drawings can be sufficiently understood, even though a part or parts of the application are not in compliance with the prescribed requirements, a search is performed taking into consideration the non-compliance in determining the extent of the search. In such cases, the [international search report and the](#) written opinion then indicates how the description, claims, or drawings fail to comply with the prescribed requirements ([see paragraphs 16.25 to 16.26 and 17.31](#)). In this indication, it is also noted by the International Searching Authority to what degree that non-compliance with the particular prescribed requirements has been taken into account for the purposes of determining the extent of the search, and this extent is indicated as precisely as possible. ~~In general, a search should be carried out to the maximum extent practical.~~

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Sequence Listings

Rule 13ter.1(a) and (b)(e) and (e); Section 208; AI Annex C

9.39 Another situation where a meaningful search or preliminary examination is not possible may arise where the international application contains disclosure of one or more nucleotide and/or amino acid sequences but the ~~applicant does not furnish a listing of the sequence in a written form, and/or a computer readable~~ [International Searching Authority does not have available to it a copy of the sequence listing in electronic form](#), complying with the standard provided for in Annex C of the Administrative Instructions. The International Searching Authority requests the provision of such a sequence listing as soon as possible, before the search report and written opinion are established (see paragraphs 15.11 and 15.12 and paragraph 4.15). However if the listing is not provided or is not provided in the form required by the **S**standard, the Authority makes a meaningful search or preliminary examination to the extent that this is possible. For example, if a named protein is claimed, such a protein could be searched by its name rather than by its sequence. [The same may occasionally apply also where a sequence listing is provided in paper form which does not comply with the standard provided for in Annex C of the Administrative Instructions and the International Searching Authority requires such a paper format for the purposes of the international search.](#)

Declaration of Non-Establishment of International Search Report

Article 17(2)(a)

9.40 Where the subject matter of all claims constitutes a subject excluded from the search (see paragraphs 9.02 to 9.18) or where no meaningful search is possible for all of the claimed subject matter (see paragraphs 9.01 and 9.26 to 9.39), a declaration of non-establishment of the international search report is issued pursuant to Article 17(2)(a) on Form PCT/ISA/203, [indicating the reasons](#). Nonetheless, a written opinion is established, even though, in the absence of a search, it cannot address the questions of novelty and inventive step and may not be able to address other questions, such as that of industrial applicability. [The detailed reasoning for not addressing those questions may be indicated by way of a reference to the full explanation in the declaration.](#)

Chapter 10 Unity of Invention

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Rule 13.2; AI Annex B, ~~Part I~~ [paragraph \(b\)](#)

10.02 [No change to body of paragraph]

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AI Annex B, ~~Part I~~ [paragraph \(c\)](#)

10.06 [No change to body of paragraph]

...

Illustrations of Particular Situations

AI Annex B, ~~Part I~~ [paragraph \(d\)](#)

10.11 [No change to body of paragraph]

Combinations of Different Categories of Claims

AI Annex B, ~~Part I~~ [paragraph \(e\)](#)

10.12 [No change to body of paragraph]

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“Markush Practice”

AI Annex B, ~~Part I~~ [paragraph \(f\)](#)

10.17 [No change to body of paragraph]

Intermediate and Final Products

AI Annex B, ~~Part I~~ [paragraph \(g\)](#)

10.18 [No change to body of paragraph]

AI Annex B, ~~Part I~~ [paragraph \(h\)](#)

10.19 [No change to body of paragraph]

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Process at the International Search Stage

Invitation to Pay Additional Fees

Article 17(3)(a); Rules 16, ~~40.1, 40.2, 40.3~~, 42

10.60 After deciding that lack of unity exists, except in the circumstances described in paragraphs 10.64 and 10.65, the International Searching Authority informs the applicant of the lack of unity of invention by a communication, preceding (but see paragraph 10.61, below) the issuance of the international search report and written opinion of the International Searching Authority, which contains an invitation to pay additional fees (Form PCT/ISA/206). This invitation specifies the reasons (see paragraph 10.63) for which the international application is not considered as complying with the requirement of unity of invention, identifies the separate inventions and indicates the number of additional search fees and the amount to be paid. The International Searching Authority cannot consider the application withdrawn for lack of unity of invention, nor invite the applicant to amend the claims, but informs the applicant that, if the international search report is to be drawn up in respect of those inventions present other than the first mentioned, then the additional fees must be paid within ~~a stipulated period~~ one month from the date of the invitation. If the applicant wishes to pay the additional fees under protest and a protest fee is payable (see paragraphs 10.66 to 10.70), the International Searching Authority also invites the applicant to pay any such fee within one month from the date of the invitation.

10.61 If preferred, the said invitation may be already accompanied by a notification of the result of a partial international search drawn up for those parts of the international application which relate to what is to be considered as the “first” invention. The result of the partial international search will be very useful for the applicant in deciding whether additional search fees should be paid so that further parts of the international application would be subjected to the international search. The invention(s) or group(s) of inventions, other than the one first mentioned in the claims, will be searched, subject to paragraphs 10.64 and 10.65, only if the applicant pays the additional fees. Thus, whether the lack of unity of invention is directly evident *a priori* or becomes apparent *a posteriori*, the examiner, may proceed in one of two ways: he may immediately inform the applicant of his finding and invite him to pay additional search fees and any protest fee (with Form PCT/ISA/206) and search or continue to search the invention first mentioned in the claims (“main invention”); or alternatively, he may carry out the search on the “main invention” and draw up a partial international search report which will be sent together with the invitation to pay additional search fees and any protest fee (with Form PCT/ISA/206).

10.62 Since ~~these payments must take place within a period to be set by the International Searching Authority so as to enable the observation of the time limit for establishing the international search report set by Rule 42,~~ the applicant is given one month to make these payments before any further search will be made, the International Searching Authority should endeavor to ensure that international searches be made as early as possible after the receipt of the search copy so as to enable the observation of the time limit for establishing the international search report set by Rule 42. The International Searching Authority finally draws up the international search report and written opinion on those parts of the international application which relate to inventions in respect of which the search fee and any additional search fee have been paid. The international search report (see paragraph 16.29) and written opinion (see paragraphs 17.36 and 17.37) identify the separate inventions or groups of inventions forming unity and indicate those parts of the international application for which a search has been made. If no additional search fee has been paid, the international search report and written opinion contain only the references relating to the invention first mentioned in the claims.

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Protest Procedure

Rule 40.2(c) ~~and (e)~~

10.66 The applicant may protest the allegation of lack of unity of invention, or that the number of required additional fees is excessive and request a refund of the additional fee(s) paid. If, and to the extent that, the International Searching Authority finds the protest justified, the fee(s) are refunded. (The additional search fees must be paid for any protest to be considered.) The International Searching Authority may require a protest fee to be paid in order for the protest to be considered (see paragraph 10.69).

Rule 40.2(c)

10.67 [No change] Protest of allegation of lack of unity is in the form of a reasoned statement accompanying payment of the additional fee, explaining why the applicant believes that the requirements of unity of invention are fulfilled and fully taking into account the reasons indicated in the invitation to pay additional fees issued by the International Searching Authority.

Rule 40.2(c) ~~and (d)~~

10.68 The protest is examined by a ~~three-member board or other special instance of the International Searching Authority or any competent higher authority~~ review body constituted in the framework of the International Searching Authority, and a decision taken on it. The form of the examination process is determined by each International Searching Authority, although the review body must not be limited to the person who made the decision which is the subject of the protest. Some Authorities may review the protest in two stages, with a formal board being convened only if a preliminary review of the protest considers that the protest is not entirely justified. To the extent that the applicant's protest is found to be justified, the additional fee is totally or partly reimbursed. At the request of the applicant, the texts of both the protest and the decision on it are notified to the designated Offices by the International Bureau together with the international search report (see paragraph 10.70).

Rule 40.2(c) ~~to and (e)~~

10.69 ~~Where the applicant has paid an additional fee under protest, the International Searching Authority may require the applicant also to pay a fee for the examination of the protest ("protest fee").~~ Details of the protest fee, if any, charged by the International Searching Authorities appear in Annex D of the *PCT Applicant's Guide*, Volume I – Introduction to the International Phase. ~~If a protest fee is chargeable by the International Searching Authority, it is only required in a particular case after a prior review of the justification for the invitation to pay additional search fees. The review should not be made by the examiner who made the finding alone. If the invitation to pay additional fees is maintained, the applicant is invited to pay the protest fee within one month from the date of the notification to the applicant of the result of the review. The notification of the result of the review, if negative, gives a technical reasoning of that result. If the protest fee is not paid within one month from the date of the invitation to pay additional fees, the protest is considered ~~withdrawn~~ not to have been made. The protest fee is only refunded to the applicant under Rule 40.2(e) where the ~~three-member board, special instance or higher authority~~ review body finds that the protest was entirely justified. ~~The applicant may, on the payment of the protest fee, supplement the reasoned statement which accompanied the protest, taking into consideration the result of the review.~~~~

Rule 40.2(c); Section 502

10.70 Where the applicant paid additional search fee(s) under protest, he is informed promptly (using Form PCT/ISA/212 ~~may be used for that purpose~~) of any decision about the

compliance with the requirement of unity of invention. At the same time the International Searching Authority transmits to the International Bureau a copy of the protest and of the decision thereon as well as any request by the applicant to forward the texts of both the protest and the decision thereon to the designated Offices.

Process at the International Preliminary Examination Stage

Article 34(3)(a) to (c); Rule 68

10.71 The procedure before the International Preliminary Examining Authority regarding lack of unity of invention is governed by Article 34(3)(a) to (c) and Rule 68 (see also Rule 70.13). This procedure is more fully explained in paragraphs 10.74 to 10.76~~82~~. It should be noted that in most instances lack of unity of invention will have been noted and reported upon by the International Searching Authority, which will have drawn up an international search report and written opinion based on those parts of the international application relating to the invention, or unified linked group of inventions, first mentioned in the claims (“main invention”), unless the applicant has paid additional fees.

10.72 [No change] If the applicant has not availed himself of the opportunity to have the international search report issued on at least some of the other inventions, this must be taken as an indication that the applicant is prepared for the international application to proceed on the basis that it relates to the invention first mentioned in the claims as originally contained in the international application as filed.

10.73 [No change] However, whether or not the question of unity of invention has been raised by the International Searching Authority, it may be considered by the examiner during international preliminary examination. In his consideration, he should take into account all the documents cited in the international search report and any additional documents considered to be relevant.

Rule 68.2, 68.3

10.74 Where the examiner finds a lack of unity of invention, a communication may, at the option of the examiner (see paragraph 10.76), be sent to the applicant, using Form PCT/IPEA/405, informing him why there is a lack of unity of invention and inviting him, within ~~a period stated in the invitation (the period may be between one and two months~~ from the date of the invitation), either to restrict the claims or to pay an additional fee for each additional invention claimed. Where such a communication is sent, at least one possible restriction, which would avoid the objection of lack of unity of invention, is indicated by the examiner. In the invitation to pay additional fees, the examiner sets out a logically presented, technical reasoning containing the basic considerations behind the finding of lack of unity in accordance with these Guidelines. Where a protest fee is payable if the applicant wishes to pay the additional fees under protest (see paragraphs 10.78 to 10.82), the International Preliminary Examining Authority also invites the applicant to pay any such fee within one month from the date of the invitation.

Article 34(3)(c); Rule 68.4, 68.5

10.75 [No change] If the applicant does not comply with the invitation (by not paying the additional fees or by not restricting the claims either sufficiently or at all), the international preliminary examination report is established on those parts of the international application which relate to what appears to be the “main invention” and the examiner indicates the relevant facts in such report. In cases of doubt as to which is the main invention, the invention first mentioned in the claims is considered the main invention.

Rule 68.1, ~~68.3(c) to (e); Section 603~~

10.76 However, there are cases of lack of unity of invention where, compared with the procedure of inviting the applicant to restrict the claims or to pay additional fees (Rule 68.2), no or little additional effort is involved in establishing the international preliminary

examination report for the entire international application. Then, reasons of economy may make it advisable for the examiner to avail himself of the option referred to in Rule 68.1 by choosing not to invite the applicant to restrict the claims or to pay additional fees. In this situation, he carries out his preliminary examination and establishes the international preliminary examination report on the entire international application, but indicates, when establishing the report, his opinion that the requirement of unity of invention is not fulfilled and the reasons therefore.

Article 34(3)(c)

10.77 [No change] If the applicant timely complies with the invitation to pay additional fees even under protest, or to restrict the claims, the examiner carries out international preliminary examination on those claimed inventions for which additional fees have been paid or to which the claims have been restricted. It should be noted that “the national law of any elected State may provide that, where its national Office finds the invitation of the IPEA justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office” (Article 34(3)(b)).

Protest Procedure

~~10.78—Where the applicant has paid an additional fee under protest, the International Preliminary Examining Authority may require the applicant also to pay a fee for the examination of the protest (“protest fee”). Details of the protest fee, if any, charged by the International Preliminary Examining Authorities appear in Annex E of the PCT Applicant’s Guide, Volume I—Introduction to the International Phase. If a protest fee is chargeable by the International Preliminary Examining Authority, it is only required in a particular case after a prior review of the justification for the invitation to pay additional fees. The review should not be made by the examiner who made the finding alone. If the invitation to pay additional fees is maintained, the applicant is invited to pay the protest fee within one month from the date of the notification to the applicant of the result of the review. The notification of the result of the review, if negative, gives a technical reasoning of that result. If the protest fee is not paid, the protest is considered withdrawn. The protest fee is refunded to the applicant under Rule 68.3(e) where the three-member board, special instance or higher authority finds that the protest was entirely justified. The applicant may, on the payment of the protest fee, supplement the reasoned statement which accompanied the protest, taking into consideration the result of the review.~~

Rule 68.3(c)

10.78 The applicant may protest the allegation of lack of unity of invention or that the number of required additional fees is excessive and request a refund of the additional fees paid. If, and to the extent that, the International Preliminary Examining Authority finds the protest justified, the fees are refunded. (The additional examination fees must be paid for any protest to be considered.) The International Preliminary Examining Authority may require a protest fee to be paid in order for the protest to be considered (see paragraph 10.81).

Rule 68.3(c)

10.79 Protest of allegation of lack of unity is in the form of a reasoned statement accompanying payment of the additional fee, explaining why the applicant believes that the requirements of unity of invention are fulfilled and fully taking into account the reasons indicated in the invitation to pay additional fees issued by the International Preliminary Examining Authority.

Rule 68.3(c) and (d)

10.80 The protest is examined by a review body constituted in the framework of the International Preliminary Examining Authority, and a decision taken on it. The form of the

examination process is determined by each International Preliminary Examining Authority, although the review body must not be limited to the person who made the decision which is the subject of the protest. Some Authorities may review the protest in two stages, with a formal board being convened only if a preliminary review of the protest considers that the protest is not entirely justified. To the extent that the applicant's protest is found to be justified, the additional fee is totally or partly reimbursed. At the request of the applicant, the texts of both the protest and the decision on it are notified to the elected Offices by the International Bureau as an annex to the international preliminary examination report (see paragraph 10.82).

Rule 68.3(e)

10.81 Details of the protest fee, if any, charged by the International Preliminary Examining Authorities appear in Annex E of the PCT Applicant's Guide, Volume I – Introduction to the International Phase. If the protest fee is not paid within one month from the date of the invitation to pay, the protest is considered not to have been made. The protest fee is only refunded to the applicant under Rule 68.3(e) where the review body finds that the protest was entirely justified.

Rule 68.3(c); Section 603

10.82 Where the applicant paid additional examination fees under protest, he is informed promptly (using Form PCT/IPEA/420) of any decision about the compliance with the requirement of unity of invention. At the same time the International Preliminary Examining Authority transmits to the International Bureau a copy of the protest and of the decision thereon as well as any request by the applicant to forward the texts of both the protest and the decision thereon to the elected Offices.

...

Chapter 11
[No change]

Chapter 12
[No change]

Chapter 13
[No change]

Chapter 14
[No change]

PART IV
THE INTERNATIONAL SEARCH

Chapter 15
The International Search

...

Rule 13ter.1; Section 513

15.11 If the application contains disclosure of one or more nucleotide and/or amino acid sequences but does not contain a sequence listing complying with the relevant standard (see paragraph 4.15) or contains the sequence listing only in paper form, the International

Searching Authority may invite the applicant (with Form PCT/ISA/225) to furnish, within a fixed time limit, a sequence listing in ~~written paper~~ form and/or in ~~computer readable electronic~~ form complying with the standard for purposes of completion of the international search. The furnishing of a sequence listing in response to an invitation by the International Searching Authority may be subject to the payment of a fee set by the International Searching Authority, which may not exceed 25% of the international filing fee (not taking into account any fee for each sheet of the international application in excess of 30 sheets). If the applicant complies with the invitation, the International Searching Authority proceeds with the completion of the international search, the international search report, and the written opinion on the basis of the ~~written paper~~ and/or ~~computer readable electronic~~ forms of the sequence listing provided. However, any sequence listing not contained in the international application as filed will not, subject to Article 34, form part of the international application, but will be used as a search tool. The Authority marks in the upper right hand corner of the first sheet of any such listing provided in paper form “SUBSEQUENTLY FURNISHED SEQUENCE LISTING” or their equivalent in the language of publication of the international application. If the applicant does not comply with the invitation within the time limit or if the response to the invitation does not comply with the standard, the International Searching Authority is ~~not required to carry out the international search to the extent that such non-compliance has the result that a meaningful search cannot be carried out~~ only be required to search the international application to the extent that a meaningful search can be carried out without the sequence listing.

Rules 5.2(b), 13ter.1(df); Section 513; AI Annex C

15.12 Where the sequence listing part of the description contains free text as defined in the standard provided for in Annex C of the Administrative Instructions, but that free text does not also appear in the main part of the description in the language thereof, the International Searching Authority invites the applicant (with Form PCT/ISA/233) to correct the application by adding the free text to the main part of the description. If the applicant complies with the invitation, the International Searching Authority marks the replacement sheet with the words “SUBSTITUTE SHEET (RULE 13ter.1(df))” or their equivalent in the language of publication of the international application and the date of receipt, and transmits the substitute sheets containing that free text to the receiving Office and the International Bureau for inclusion of the sheets concerned in the home copy and the record copy, respectively; it keeps a copy of those sheets for inclusion in the search copy. If the applicant does not comply with the invitation, the International Searching Authority nevertheless continues to perform the international search.

...

Chapter 16 International Search Report

...

Filling Out the Notification of Transmittal of the International Search Report or the Declaration, and of the Written Opinion of the International Searching Authority, of the Declaration (Form PCT/ISA/220)

...

Filling Out the International Search Report (Form PCT/ISA/210)

...

Nucleotide and/or Amino Acid Sequence Listings and Related Tables

16.24 Where the application discloses any nucleotide and/or amino acid, box 1.b of the first sheet is checked and Box No. I (appearing on “continuation of first sheet (1)”) indicates the form (that is, whether in paper copy or ~~computer-readable~~ [electronic](#) form) and status (that is, whether filed with the international application or later, for the purposes of search) of the sequence listing, and any related tables, that the search was carried out on. See paragraphs 4.15 and 15.11 for further details.

Restriction of the Subject of the International Search

16.25 The report indicates whether the search was restricted or not for any of the reasons indicated below. If any such restrictions are applied, the claims in respect of which a search has not been carried out are identified and the reasons for this are indicated. The four categories where such restrictions may arise are:

- (i) claims drawn to subject matter not required to be searched by the International Authority (see chapter 9);
- (ii) claims in respect of which a meaningful search cannot be carried out (see chapter 9);
- (iii) multiple dependent claims which do not comply with Rule 6.4(a) (see paragraph 5.16);
- (iv) lack of unity of invention (see chapter 10).

[The written opinion of the International Searching Authority will also report the relevant facts, usually by way of a reference to the full explanation in the international search report.](#)

...

PART V WRITTEN OPINION/INTERNATIONAL PRELIMINARY EXAMINATION REPORT

Chapter 17

Content of Written Opinions and the International Preliminary Examination Report

...

Different Types of Opinion and Report

Written Opinion of the International Searching Authority

Rule 43bis, 66.1bis

17.04 A written opinion will be issued by the International Searching Authority together with the international search report [or the declaration under Article 17\(2\)\(a\) that no international search report will be established](#). This will normally be treated as the first written opinion of the International Preliminary Examining Authority under Article 34(2) in the event that international preliminary examination is demanded and, as such, the opinion

will include an invitation to submit a response, together with a time-limit (see Rules 43*bis*.1(c) and 54*bis*.1(a)) for that response, if the applicant wishes to demand international preliminary examination. However International Preliminary Examining Authorities may notify the International Bureau that this will not be the case for written opinions issued by specified International Searching Authorities other than themselves. Such notifications are published by the International Bureau in the Gazette.

...

Nucleotide and/or Amino Acid Sequence Listings

17.21 With regard to any nucleotide and/or amino acid sequence listing, one or more of the following indications must be given with respect to the sequence listing, and/or tables related thereto, on which the examination is based, either in item 2 of Box No. I (for the written opinion of the International Searching Authority) or in item 1 of the Supplemental Box Relating to Sequence Listings (in written opinions of the International Preliminary Examining Authority or the international preliminary examination report):

- (a) the type of material (sequence listing only or also related tables);
- (b) format of material (~~written or computer readable~~ [paper or electronic](#) form); and
- (c) the time of filing or furnishing (contained in the application as originally filed, filed together with the international application in ~~computer readable~~ [electronic](#) form, subsequently furnished for the purposes or search and/or examination, or filed as an amendment).

Where more than one version or copy of a sequence listing and/or table related thereto has been filed, the check box under item 2 (or item 3 of Box No. 1 of the written opinion of the International Searching Authority) is used to indicate whether the required statements were included, that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed. For further discussions of the nucleotide and/or amino acid sequence listings, refer to chapter 18.

...

Box No. II: Priority

17.25 This part of the opinion or report is not relevant if the international application does not claim priority. Furthermore, where priority is claimed, but the citations in the international search report were all published before the earliest priority date, it is not necessary to consider whether the priority claim is valid (see chapter 6). [In either of these cases, this Box should not normally be included in the opinion or report.](#)

...

17.28 “Additional observations” in item 3 of Box No. II relate to Priority considerations only and not to clarity, descriptive support, defects or any other consideration relevant to Box No. VIII. [Such observations might include the reasons for which a priority claim was considered to be invalid, or else an indication that the priority claim had been checked and was considered to be valid.](#)

Box No. III: Non-Establishment of Opinion with Regard to Novelty, Inventive Step and Industrial Applicability

Article 17(2)(a)(i); Rules 43bis.1, 67

17.29 This part of the opinion or report explains why an opinion as regards novelty, inventive step and industrial applicability may not have been established for some or all of the subject matter of the international application for any reason other than because the international application lacks unity of invention and the required additional fees have not been paid (this is dealt with in Box No. IV, see paragraphs 17.36 to 17.39). For example, Rules 43bis.1(b) and 67.1 establish that no International Authority shall be required to examine certain subject matter within an international application, such as mathematical theories, plant or animal varieties and methods for treatment of the human or animal body. The agreements between the International Bureau and the International Preliminary Examining Authorities further qualify this by excepting from exclusion any subject matter which is examined under the relevant national grant procedures. See paragraph 17.58 and chapter 9 for details of excluded matter. The first two check boxes of Box No. III are used to indicate the extent to which no opinion has been established. [In a written opinion of the International Searching Authority, the reasons for not establishing an opinion will usually be identical to the reasons for not establishing an international search and can usually be indicated by way of a reference to the full explanation in the international search report \(see paragraph 16.25\) or in the declaration under Article 17\(2\)\(a\) \(see paragraph 9.40\).](#)

...

Language of the Written Opinion and the International Preliminary Examination Report

Rules 48.3(a) and (b), 70.17(+)

17.50 [No change to body of paragraph] The written opinion and the international preliminary examination report, together with its annexes, if any, are established in the language of publication, or, if the international search and/or the international preliminary examination is carried out on the basis of a translation of the international application, in the language of that translation. An international application filed in Chinese, English, French, German, Japanese, Russian or Spanish is published in that language; an international application filed in any other language is published in the language of a translation into one of these languages.

...

PART VI
THE INTERNATIONAL PRELIMINARY EXAMINATION STAGE
(OTHER THAN THE INTERNATIONAL PRELIMINARY REPORT)

Chapter 18
Preliminary Procedure on Receipt of the Demand

...

Article 19; Rules 46.1, 53.9(b), 69.1(d)

18.06 If the International Searching Authority is also to act as International Preliminary Examining Authority and wishes to start the international preliminary examination at the same time as the international search in accordance with Rule 69.1(b), but the demand includes a statement that the start of the international preliminary examination is to be postponed under Rule 53.9(b) ~~because the time limit for filing amendments under Article 19, as provided in Rule 46.1, has not expired~~, the International Preliminary Examining Authority waits until it receives a copy of any amendments made under Article 19 or a notice from the applicant that he does not wish to make amendments under Article 19 before beginning the international preliminary examination. Where neither a copy of the amendments nor a notice has reached the International Preliminary Examining Authority by the expiration of ~~22~~ 16 months from the priority date or ~~three~~ two months from the date of transmittal of the international search report, whichever expires later (the time limit in accordance with Rule 46.1 for filing amendments under Article 19), examination starts on the basis of the documents in the file.

...

18.12 In the cases where the international search has been performed by an International Searching Authority which is not part of the same national Office or intergovernmental organization as the International Preliminary Examining Authority, the various elements of the file making up the international application will be supplied to the International Preliminary Examining Authority as follows:

Article 31(6)(a)

(i) demand: by the applicant;

(ii) request, description, drawings (if any), claims, and sequence listing filed under the provisions of Section 801 (if applicable), as originally filed: by the International Bureau;

Rule 43bis

(iii) the international search report or declaration under Article 17(2)(a), and the written opinion established under Rule 43bis.1 ~~or declaration under Article 17(2)(a)~~: by the International Bureau;

Rule 55.2

(iv) where neither the language in which the international application is filed nor the language in which the international application is published is accepted by the International Preliminary Examining Authority, a translation of the international application into a language which is both a language accepted by the International Preliminary Examining Authority and a language of publication: by the applicant (see, however, paragraph 18.11);

Rule 62

(v) amendments and statement under Article 19 (if any): where the applicant has marked the appropriate check box in Box No. IV of the demand (Form PCT/IPEA/401) that amendments under Article 19 are to be taken into account, the International Preliminary Examining Authority indicates on the last sheet of the demand whether a copy of such amendments was actually received with the demand. Where no copy of the amendments under Article 19 was received with the demand, a copy of such amendment will be transmitted by the International Bureau promptly after that Bureau receives the demand. If no amendments under Article 19 have been made at the time when the demand is received by the International Bureau, the International Preliminary Examining Authority is so informed by the International Bureau. If, at the time of filing such amendments, the demand has already been submitted, the applicant should also submit a copy of such amendments to the International Preliminary Examining Authority. In any event, the International Bureau will promptly

transmit a copy of any amendments under Article 19 to the International Preliminary Examining Authority;

Rule 13ter.1; Section 208; AI Annex C

(vi) nucleotide and/or amino acid sequence listing in ~~written paper~~ form and/or in ~~computer readable~~ electronic form, both forms complying with the standard provided for in Annex C of the Administrative Instructions: where the International Searching Authority and the International Preliminary Examining Authority are part of the same national Office or intergovernmental organization, by the International Searching Authority; otherwise, by the applicant;

Rule 66.1

(vii) amendments according to Article 34(2)(b): by the applicant;

(viii) copies of any documents cited in the international search report which are not available from the databases of the International Preliminary Examining Authority: by the International Searching Authority;

Rule 66.7(a)

(ix) priority document: by the International Bureau;

Rule 66.7(b)

(x) translation of the priority document where required: by the applicant (subject to an invitation to furnish the translation having been made, see paragraph 18.16).

18.13 The examiner should keep in mind that the documents making up the international application may contain, instead of an international search report, the a declaration ~~referred to in according to~~ Article 17(2)(a) ~~instead of an international search report, and written opinion of the International Searching Authority~~, that is, the a declaration ~~of by~~ the International Searching Authority that it considers that the international application relates to a subject matter which it was not required to search and decided not to search, or that the description, the claims, or the drawings failed to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out. In this case, the examiner should appraise the declaration as if it were the international search report.

...

Nucleotide and/or Amino Acid Sequence Listings

~~*Rule 13ter.1(a), (e) and (e)*~~; *Section 208; AI Part 8; AI Annex C*

18.17 Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences and a corresponding sequence listing in ~~written paper~~ form and in ~~computer readable~~ electronic form (both forms complying with the standard provided for in Annex C of the Administrative Instructions) the International Preliminary Examining Authority carries out the international preliminary examination on the basis of those listings. Instead of a ~~written paper~~ form, the sequence listing may be provided on an electronic medium under the provisions of Section 801 of the Administrative Instructions (see paragraph 4.15).

~~*Rules 13ter.1(a), (e) and (e)*~~, *13ter.2*; *Section 208; AI Annex C*

18.18 Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences but does not contain a corresponding sequence listing in ~~written paper~~ form and/or in ~~computer readable~~ electronic form complying with the standard provided for in Annex C of the Administrative Instructions, the International Preliminary Examining Authority may invite the applicant (with Form PCT/HPEA/441) to furnish to it, within a time limit fixed in the invitation, a sequence listing in ~~written paper~~ form and/or ~~computer readable~~ electronic form, as the case may be, complying with the standard. The furnishing of a

sequence listing in response to an invitation by the International Preliminary Examining Authority may be subject to the payment of a fee set by the International Preliminary Examining Authority, which may not exceed 25% of the international filing fee (not taking into account any fee for each sheet of the international application in excess of 30 sheets). If the applicant complies with the invitation, the procedure outlined in the preceding paragraph applies. If the applicant does not comply with the invitation within the time limit or the response to the invitation is defective, the International Preliminary Examining Authority is not only required to carry out the international preliminary examination to the extent that ~~such non-compliance has the result that~~ a meaningful examination can ~~not~~ be carried out without the sequence listing (see paragraph 9.39).

Chapter 19

Examination Procedure Before The International Preliminary Examining Authority

...

Start of Examination

Rule 69.1

~~19.07—The International Preliminary Examining Authority starts the international preliminary examination when it is in possession of the demand; if the applicant is required to furnish a translation under Rule 55.2, that translation; and of either the international search report and the written opinion established under Rule 43bis.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, provided that the International Preliminary Examining Authority does not start the international preliminary examination before the expiration of the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date unless the applicant expressly requests an earlier start, with the exception of the following situations:~~

~~(a)—If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes, start at the same time as the international search, provided that the examination is not to be postponed according to the statement concerning amendments:~~

~~(b)—Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned. These will be transmitted to the International Preliminary Examining Authority by the International Bureau. If a demand for international preliminary examination has already been submitted, the applicant should preferably, at the time he files the Article 19 amendments with the International Bureau, also file a copy of the amendments with the International Preliminary Examining Authority.~~

~~(c)—Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority does not start the international preliminary examination before:~~

~~——(i) it has received a copy of any amendments made under Article 19;~~

~~—— (ii) — it has received a notice from the applicant that he does not wish to make amendments under Article 19; or~~

~~—— (iii) — the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date;~~

~~whichever occurs first.~~

~~(d) — Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.~~

Rule 69.1

19.07 The International Preliminary Examining Authority normally starts the international preliminary examination (see Chapter 19) when:

(a) it is in possession of:

—— (i) the demand;

—— (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2;

—— (iii) if the applicant is required to furnish a translation under Rule 55.2, that translation; and

—— (iv) either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, and the written opinion established under Rule 43bis.1;

and

(b) the time limit within which the applicant was permitted to file the demand (see paragraph 3.07) has expired, or earlier if the applicant has expressly requested an earlier start.

19.07.1 The exceptions to the above are as follows:

Rule 69.1(c)

(a) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority does not start the international preliminary examination before it has received a copy of the amendments concerned.

Rule 69.1(e)

(b) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) (see paragraph 18.04) has expired, whichever occurs first.

Rule 69.1(b) and (d)

(c) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes, start at the same time as the international search (subject to the possible need to invite the applicant to provide copies of amendments under Article 34, as

noted in paragraph (b), above), provided that the applicant has not indicated (under Rule 53.9(b)) in the statement of amendments that examination is to be postponed until after the expiry of the time limit for filing amendments under Article 19 (such amendments only being permitted after the international search report has been received). Where the statement concerning amendments contains such an indication that the start of the international preliminary examination is to be postponed, the International Preliminary Examining Authority does not start the international preliminary examination until it has received a copy of any amendments made under Article 19, or a subsequent notice from the applicant that he does not wish to make amendments under Article 19, or the time limit under Rule 46.1 for filing Article 19 amendments has expired, whichever occurs first.

...

Chapter 20
[No change]

PART VII
QUALITY

Chapter 21
[No change]

PART VIII
CLERICAL AND ADMINISTRATIVE PROCEDURES

Chapter 22
Clerical and Administrative Procedures

...

Rule 59.3(a), (c) and (f)

22.03 The non-competent International Preliminary Examining Authority may, instead, choose to transmit the demand directly to the competent International Preliminary Examining Authority. In such a case, if only one International Preliminary Examining Authority is competent, it transmits the demand to that Authority and notifies the applicant accordingly, using Form PCT/IPEA/436. If two or more International Preliminary Examining Authorities are competent, it must first invite the applicant to indicate, within the time limit applicable under Rule 54bis.1(a), that is, 3 months from the date of transmittal of the international search report ~~and the written opinion under Rule 43bis.1(a)~~, or the declaration referred to in Article 17(2)(a), and the written opinion under Rule 43bis.1(a), or 22 months from the priority date, or 15 days from the date of the invitation, whichever is later, to which one of those Authorities the demand should be transmitted (using Form PCT/IPEA/442). If the applicant responds to the invitation, the non-competent International Preliminary Examining Authority promptly transmits the demand to the competent Authority specified by the applicant and notifies the applicant accordingly. If the applicant does not respond, or responds after the expiration of the time limit, the non-competent International Preliminary Examining Authority declares that the demand is considered as if it had not been submitted and notifies

the applicant accordingly, using Form PCT/IPEA/407. If the demand is filed with the receiving Office, International Searching Authority or International Bureau, that body follows the same procedure specified above for the non-competent International Preliminary Examining Authority, except that the forms used are Forms PCT/RO/153, PCT/ISA/234 and PCT/IB/368, respectively.

...

Checking Whether Demand Is Timely Filed

Rule 54bis

22.14 The International Preliminary Examining Authority checks to see that the demand is filed within three months from the date of transmittal of the international search report ~~and the written opinion established under Rule 43bis.1,~~ or ~~of~~ the declaration referred to in Article 17(2)(a), and the written opinion established under Rule 43bis.1; or 22 months from the priority date, whichever expires later. If the demand is filed later, the International Preliminary Examining Authority considers the demand as having not been submitted and issues a declaration to that effect by sending a copy of Form PCT/IPEA/407 to the applicant and the International Bureau. If the demand is timely filed, the International Preliminary Examining Authority notifies the applicant accordingly (Form PCT/IPEA/402).

...

Invitation to Correct Defects in the Demand

Rules 53, 55, 60.1(a), (a-ter) and (b)

22.37 If the International Preliminary Examining Authority finds one or more defects referred to in Rule 60.1(a) ~~and (b)~~, it invites the applicant to correct the defects within a time limit which is reasonable in the circumstances and at least one month from the date of the invitation (Form PCT/IPEA/404). The International Preliminary Examining Authority notifies the International Bureau by sending it a copy of the invitation. Where the defect consists of the lack of the signature of at least one applicant (see paragraph 22.28), the International Preliminary Examining Authority may include with the invitation to correct, a copy of the last sheet of the demand which the applicant returns after affixing thereto the prescribed signature. Where the defect consists of the lack of the signature on the demand and the demand is filed with an International Preliminary Examining Authority which has waived the requirement for a separate power of attorney, the International Preliminary Examining Authority may include with the invitation to correct, a copy of the last sheet of the demand which the agent returns after signing.

Rule 60.1(b) and (d); Section 602(a)

22.38 Upon receipt of a letter containing a correction or accompanying a replacement sheet of the demand the International Preliminary Examining Authority marks on that letter and any accompanying sheets the date on which they were received. It verifies the identity of the contents of any replacement sheet of the demand with that of the replaced sheet (see paragraphs 22.40 and 22.41 for the consequences of this check). ~~If the applicant complies with the invitation within the time limit, the demand is considered as if it had been received on the actual filing date provided that the demand as submitted permitted the international application to be identified.~~ The International Preliminary Examining Authority marks in the upper right-hand corner of the replacement sheet, the international application number and the date on which the replacement sheet was received and, in the middle of the bottom margin, the words “~~AMENDED~~ SUBSTITUTE SHEET (RULE 60.1).” It keeps in its files a copy of

any letter and any replacement sheet. It transmits any replacement sheet of the demand and a copy of any letter to the International Bureau. The International Preliminary Examining Authority undertakes the actions referred to in this paragraph not only where the corrections submitted by the applicant are timely received and satisfactory, but also where they are not and, consequently, the demand is considered as if it had not been submitted.

22.39 [No change] If the International Preliminary Examining Authority receives a replacement sheet of a sheet of the demand embodying a correction of a defect referred to in Rule 60.1(a), which was submitted by the applicant of his own volition without having been invited to correct a defect, the International Preliminary Examining Authority proceeds as outlined in the preceding paragraph.

Rule 60.1(a) and (b)

22.40 The International Preliminary Examining Authority checks whether the defects referred to in Rule 60.1(a) have or have not been timely corrected. If the applicant complies with the invitation within the time limit, the demand is considered as if it had been received on the actual filing date provided that the demand as submitted permitted the international application to be identified. The ~~one-month~~ time limit for correction may be extended. If a correction of a defect is received after the expiration of the time limit for correction but before a decision is taken, the time limit for correction should be extended *ex officio* so that the said correction is considered as having been timely received.

Rule 60.1(b) and (c)

22.41 If the International Preliminary Examining Authority finds that any of the defects referred to in Rule 60.1(a), ~~with the exception of those also referred to in Rule 60.1(d)~~, have not been corrected or have not been timely corrected (see the preceding paragraph), it declares that the demand is considered as if it had not been submitted and notifies the applicant and the International Bureau (Form PCT/IPEA/407). If the date of receipt of the demand is changed, the International Preliminary Examining Authority notifies the applicant and the International Bureau (Form PCT/IPEA/402).

Rule 60.1(d)

22.42 ~~[Deleted] If the International Preliminary Examining Authority finds that any of the defects referred to in Rule 60.1(d) have not been corrected or have not been timely corrected, it notifies the applicant and the International Bureau (Form PCT/IPEA/439).~~

...

[Annex II follows]

ANNEX II

DETAILED EXPLANATION OF
PROPOSED MODIFICATIONS TO THE GUIDELINES
AS CONTAINED IN ANNEX I

MODIFICATIONS CONSEQUENTIAL TO AMENDMENTS OF THE RULES OR OF
THE ADMINISTRATIVE INSTRUCTIONS

1. It is proposed to remove the reference in paragraph 1.01 to the amendments adopted in September 2002, which were the main reason for producing the original combined PCT International Search and Preliminary Examination Guidelines, but which are not the subject of the currently proposed revisions. It is not proposed to introduce a description of the reasons for the current revisions into the body of the Guidelines; rather this will be the subject of a covering paragraph, together with a note concerning the transitional arrangements.

Simplified Protest Procedure in Case of Non-Unity of Invention

2. Rules 40.1, 40.2, 40.3, 68.2 and 68.3 have been amended to remove the need to make a review of the justification to invite the payment of additional fees before the Authority can require the applicant to pay a protest fee (see paragraphs 1 to 7 of Annex II to document PCT/A/33/2). In addition, the structure of the Rules has been rationalized, grouping the procedures in a more logical manner and, for consistency with Articles 17(3)(a) and 34(3)(a) and other Rules, the term “additional fees” has been used in Rules 40.2 and 68.3 to cover cases even when there is only a single invention in addition to the first invention.

3. These amendments are reflected by the proposed modifications of paragraphs 10.60 to 10.78 of the Guidelines. It is also proposed that paragraph 10.78 should be expanded and split into new paragraphs 10.78 to 10.82, so that the Guidelines deal consistently with equivalent parts of the protest procedure at the search and preliminary examination stages.

Furnishing of Sequence Listings for Search and Examination

4. Rules 3.3, 13^{ter}, 23.1 and 76.5 have been amended to clarify the situations in which International Authorities and designated and elected Offices may require the applicant to furnish a copy of a sequence listing in paper or electronic form, and to allow International Authorities to require a late furnishing fee to be paid in the event that it is necessary for them to invite a copy of a sequence listing to be furnished (see paragraphs 8 to 16 of Annex II to document PCT/A/33/2). This aspect of the amendments (together with a consequential modification of Section 513 of the Administrative Instructions) is reflected in the proposed modifications of paragraphs 4.15, 9.39, 15.11 and 15.12.

5. In addition, the term “computer readable form” has been changed to “electronic form” for consistency with the terminology used in Part 7 of the Administrative Instructions. It is proposed to adopt this terminology in paragraphs 2.10, 4.15, 15.11, 16.24, 17.21, 18.12(vi), 18.17 and 18.18. However, the term “computer readable form” is also used in a different context in paragraphs 9.12 and A9.15[1], where it is proposed to leave it unchanged.

Corrigenda and Consequential Amendments

6. Minor corrigenda and consequential amendments have been made to Rules 4.6, 16^{bis}.1, 43^{bis}.1, 44.1, 53.9 and 69.1 (see paragraphs 17 to 24 of Annex II to document PCT/A/33/2).

– *Written Opinion of the International Searching Authority*

7. Rules 43*bis*.1, 44.1 and 69.1(a) were amended to clarify that a written opinion is established by the International Searching Authority irrespective of whether a search report is issued or a declaration is made under Article 17(2)(a). A corresponding proposal is made in respect of Rule 54*bis*.1 in document PCT/R/WG/8/2 Add.1. The Guidelines generally supported this interpretation already, but modifications are proposed to clarify paragraphs 3.07, 18.12(iii), 18.13, 19.07, 22.03, 22.14, which closely followed the original wording of the relevant Rules, and paragraph 17.04, which did not previously mention the possibility of a declaration as an alternative at all.

– *Statement Concerning Amendments*

8. Rules 53.9 and 69.1(d) were amended to take account of the fact that there is usually no need (nor, indeed, any possibility) for the applicant to request postponement of the start of international preliminary examination pending filing of amendments under Article 19, except in the case where a demand has been filed and the relevant fee paid prior to the start of the international search, and the International Preliminary Examining Authority wishes to start international preliminary examination at the same time as the international search.

9. The possibility of requesting postponement of international preliminary examination is more specifically limited to this particular case, noting that it was necessary to maintain the possibility in order to ensure that the applicant retained the right to have international preliminary examination carried out on the basis of the claims as amended under Article 19. These amendments are reflected in proposed modifications of paragraphs 3.13, 3.14 and 18.06, and the rewriting of paragraph 19.07 as two paragraphs in the same terms as modified paragraphs 3.13 and 3.14.

Modifications to Annex B of the Administrative Instructions

11. Part 2 of Annex B of the Administrative Instructions, which gave examples illustrating unity of invention practice under the PCT, has been deleted (see Circular C. PCT 1021). Since the Guidelines as originally promulgated were intended to be a replacement for these examples, the only modification which appears to be required is the deletion of the words “Part 1” in the references which occur in paragraphs 10.02 to 10.19.

MODIFICATIONS FOLLOWING FROM DISCUSSIONS IN PCT/MIA

Dealing With Checked and Unchecked Priority Claims

12. The tenth session of the Meeting of International Authorities under the PCT recognized that there was potential for confusion in comprehending indications made in item 1 of Box No. II of Form PCT/ISA/237, which is used to indicate that the validity of a priority claim has not been considered because the International Searching Authority does not have a copy of the priority document available (see paragraphs 21 to 25 of document PCT/MIA/10/11).

13. Form PCT/ISA/237 has been modified (see Circular C. PCT 1024) to clarify the issue in the manner agreed by the International Authorities (see paragraph 23 of document PCT/MIA/10/11).

14. As also agreed by the Meeting of International Authorities, modifications are proposed:

(a) of paragraphs 6.06 and 17.25, to clarify that Box No. II should only be included when there is a need to investigate the validity of the priority claim in view of the relevant dates of the prior art found (see paragraph 25 of document PCT/MIA/10/11); and

(b) of paragraph 17.28, to clarify that item iii of that Box (“Additional observations, if necessary”) could be used, where necessary, to indicate that the priority claim had been checked and was considered to be valid.

– *Presenting Reasoning When No (or Limited) International Search Can Be Performed*

15. The Meeting of International Authorities agreed that the Secretariat should draft proposals for modifying the Guidelines to emphasize that the international application should be searched to the maximum extent possible and that any limitations should be set out, with reasons, in the international search report (or the declaration under Article 17(2)(a)) in order that the scope and reasoning should be clear to third parties. (See paragraph 31 of document PCT/MIA/10/11.) This is reflected in the proposed modifications to paragraphs 9.19, 9.40, 16.25 and 17.29.

CORRECTION OF ERRORS

16. It is also proposed to correct the following errors, which have been noted in the Guidelines:

(a) The missing word “examination” should be inserted in paragraph 1.09.

(b) The words “, in which event the examiner may invite the applicant himself to furnish such a copy” should be deleted from paragraph 6.17 since the rules do not allow for an International Authority to request a copy of a priority document (as opposed to a translation of a priority document) directly from the applicant.

(c) Incorrect references to Rules should be corrected in paragraphs 4.05 and 17.50.

(d) The procedure described in paragraphs 22.37 to 22.42, for the International Preliminary Examining Authority to invite correction of defects in the demand, should be updated to reflect the amendments of Rule 60 (and associated modifications of the Administrative Instructions) which came into force January 1, 2004.

[End of Annex II and of document]