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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 United States Patent and Trademark Office*

## SUMMARY

1. The PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) require updating in order to take account of a number of issues and developments. Annex I to this document contains a proposed draft of revisions to the Guidelines which are directed primarily to the changes to the PCT Regulations which will become effective on April 1, 2007. Further, this document raises issues with respect to other areas in which revision of the Guidelines should be considered. Specifically, whether some common approaches and harmonization can be achieved with respect to some of the divergent practices currently set forth in the appendices to the Guidelines. The Meeting is invited to consider and comment on the document and annexes.

## BACKGROUND

2. At the twelfth session of the Meeting of International Authorities, held in Geneva from December 12 to 16, 2005, it was agreed that the Guidelines should be reviewed and revised as necessary so as to accommodate the changes to the PCT Regulations which have come into effect since the Guidelines were published in 2004. It was also agreed that the opportunity should be taken to consider further revisions to the Guidelines with respect to the divergent practices set forth in the appendices to certain chapters of the Guidelines.

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3. With regard to the timeline for revising the Guidelines, it was agreed that a final draft of the revised Guidelines should be established by December 2006.

#### UPDATING THE GUIDELINES WITH RESPECT TO THE AMENDMENTS OF THE REGULATIONS

4. With regard to the amendments to the Regulations with effect from April 1, 2005, proposals for modifying the Guidelines have been proposed by the International Bureau, as set out in document PCT/MIA/13/2. These modifications reflect changes to the Regulations in the areas of simplification of protest procedures and furnishing of sequence listings, together with some minor corrections.

5. With regard to the amendments to the Regulations with effect from April 1, 2006, a review of the Guidelines reveals that the amendments would have no impact on the Guidelines.

6. With regard to the amendments to the Regulations with effect from April 1, 2007, a draft proposal for amending the Guidelines has been prepared by the USPTO and is attached to this document as Annex I. These changes to the Guidelines reflect changes to the Regulations in the areas of missing elements and parts, restoration of the right of priority, and rectification of obvious mistakes.

7. Annex I also includes additional proposed changes to the Guidelines for purposes of clarification or to rectify deficiencies in the Guidelines as originally drafted.

8. Annex II contains detailed explanations of the modifications set forth in Annex I.

#### UPDATING THE GUIDELINES WITH RESPECT TO DIVERGENT PRACTICES

9. Currently, the Guidelines provide for divergent practices in the following areas:

- (a) Background Art – Appendix to Chapter 4
- (b) Claims – Appendix to Chapter 5
- (c) Excluded Subject Matter – Appendix to Chapter 9
- (d) Novelty – Appendix to Chapter 12
- (e) Inventive Step – Appendix to Chapter 13
- (f) Industrial Applicability – Appendix to Chapter 14
- (g) New Matter – Appendix to Chapter 20

10. With regard to the provision within the Guidelines for various divergent practices, at its ninth session, the Meeting “noted that it was desirable to work towards increased consistency in practice and agreed that areas of difference should be the subject of further review in the future” (see paragraph 114 of document PCT/MIA/9/6). The elimination of divergent practices and the agreement of the Authorities on consistent common approaches in the above noted areas would be beneficial to both applicants and national offices in that it would replace the current level of uncertainty as to what practice has been followed by an Authority in processing an international application.

11. Therefore, in the context of the present revisions to the Guidelines, the Authorities are invited to reconsider the areas in which divergent practices have been accommodated and provide suggestions on where harmonization of practices may be achieved.

12. In that many of the divergent practices are the result of longstanding international and national practices, it is recognized that it may not be possible to resolve the differences in the practices of the different Authorities within the timeframe of the present revision of the Guidelines. Therefore, it is proposed that this matter be an ongoing consideration of the Meeting beyond the timeframe established for the present revision of the Guidelines.

13. *The Meeting is invited to:*

*(i) review and comment on the proposed changes to the Guidelines contained in the Annexes to this document; and*

*(ii) identify and present for discussion any areas of divergent practice currently provided in the Guidelines, in which harmonization may be achieved.*

[Annexes follow]

ANNEX I

PROPOSED MODIFICATIONS TO THE  
PCT INTERNATIONAL SEARCH AND  
PRELIMINARY EXAMINATION GUIDELINES  
NECESSITATED BY THE CHANGES TO THE  
PCT REGULATIONS EFFECTIVE APRIL 1, 2007

TABLE OF CONTENTS

Chapter 1	Introduction .....	2
Chapters 2 and 3	[No change] .....	3
Chapter 4	Content of the International Application (Other Than the Claims).....	3
Chapter 5	[No change] .....	4
Chapter 6	Priority .....	4
Chapter 7	[No change] .....	6
Chapter 8	Rule 91 – Obvious <del>Errors</del> <u>Mistakes</u> in Documents .....	6
Chapters 9 and 10	[No change] .....	11
Chapter 11	Prior Art.....	11
Chapters 12 to 14	[No change].....	12
Chapter 15	The International Search.....	12
Chapter 16	International Search Report.....	13
Chapter 17	Content of Written Opinions and the International Preliminary Examination Report.....	13
Chapter 18	[No change] .....	14
Chapter 19	Examination Procedure Before The International Preliminary Examining Authority.....	14
Chapter 20	Amendments.....	15
Chapters 21 and 22	[No change] .....	16

## Chapter 1 Introduction

1.01-1.02 [No change]

1.03 These Guidelines are common rules of international search and examination that provide instructions regarding international search and examination and assist in the application of the provisions of the PCT, PCT Regulations and PCT Administrative Instructions relating to international search and examination. They are intended to cover typical occurrences. They should therefore be considered only as general directives; examiners will have to go beyond the instructions in exceptional cases. Nevertheless, applicants can expect the International Searching and Examining Authorities to act, as a general rule, in accordance with the Guidelines until such time as they are revised. In addition, at various points throughout these Guidelines, the examiner is directed to interpret a claim in a particular fashion. This has been done to enable the designated and/or elected Offices to understand the examiner's conclusion as to novelty, inventive step (non-obviousness) and industrial application, and in no way binds the designated and/or elected Offices to adopt a similar interpretation. The Guidelines ~~also~~ set forth standards for quality for the International Searching Authorities and the International Preliminary Examining Authorities to follow so as to minimize differences in the results of the search and examination process among the various Authorities.

1.04-1.08 [No change]

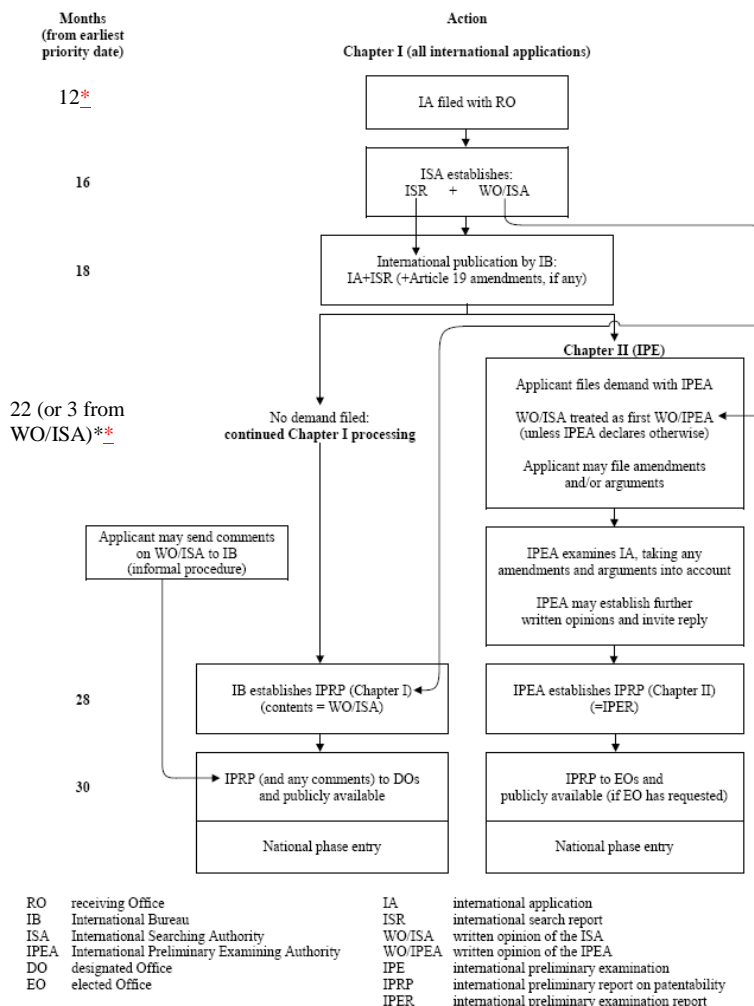
1.09 The procedure through which an international patent application under the Patent Cooperation Treaty proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two main stages, commonly referred to as the "international phase" and the "national phase" (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 43*bis*), 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 ~~II~~<sup>II</sup> through ~~VIII~~<sup>VIII</sup> of the Guidelines.

1.10-1.15 [No change]

The flowchart at the end of Chapter 1 is to be modified as follows:

PCT/GL/ISPE/1  
Page 17

Flowchart of Typical International Application Processing



\* If IA is filed later than 12 months from the priority date but within two months from the expiration of the priority period, the right of priority may be restored.

\*\* In practice, demand must be filed by 19 months for Article 22 transitional reservation countries.

## Chapters 2 and 3 [No change]

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

4.01-4.26 [No change]

4.27 A reference in the description to an unpublished, previously filed application (that is, not published before the international filing date) should not be regarded as being part of the disclosure, unless the application referred to is made available to the public on or before the

publication date of the international application. The reference to such an application made available to the public on or before the publication date of the international application may be replaced by the actual text referred to and may be taken into account by the examiner. Similarly, references to textbooks and periodicals are allowable under the same conditions if it can be proved that the content thereof was fixed prior to the international filing date. In the case of any document made available to the public later than the publication date of the international application or not to be published at all (for example, an application withdrawn before publication), the examiner should not take into account the reference to that document for the purposes of international preliminary examination. It should be noted, however, that this practice relates only to the international phase and does not preclude any designated or elected Office applying the relevant national law as far as it relates to the contents of the disclosure of the international application as filed.

4.28- A4.05[2] [No change]

## Chapter 5 [No change]

## Chapter 6 Priority

6.01 An international application is accorded as its international filing date the date on which it satisfies the requirements of Article 11. This date remains unchanged except in the special circumstances of later-filed drawings and/or parts of the description or claims that were missing upon filing of the international application, and sheets as provided in Article 14(2) and Rule ~~20.5(c)~~20.2. The international filing date may be the only effective date of the international application. It will be of importance for fixing the expiration of certain time limits and for determining the state of the art relevant for the purposes of the international search and examination.

6.02 [No change]

*Article 8(1); Rules ~~2.4, 4.10, 26bis.2, and 64.1~~*

6.03 For a valid claim to priority, several conditions must be satisfied. ~~The~~ earlier application whose priority is claimed must have been made by the applicant or his predecessor in title; and it must ~~have been filed not more than 12 months before the filing date of the international application; and~~ have been “filed in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention.” The words “in or for” any country or Member mean that the earlier application the priority of which is claimed may be an earlier national, regional or international application. Furthermore, the international application must have been filed within the period of 12 months from the filing date of the earlier application (the “priority period”). However, the claim to priority shall not be considered invalid only because the international application has a filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date. The earlier application may be for a patent or for the registration of a utility model or for an inventor’s certificate. So long as the contents of the earlier application were sufficient to establish a filing date, it can be used to create a priority date, no matter what

the final disposition of the application may later be; for example, it may subsequently be withdrawn or held withdrawn. Other conditions to be satisfied for a valid claim of priority are mentioned in paragraphs 6.04 and 6.11 to 6.17.

6.04 [No change]

*Article 8(1)*

6.05 An international application may claim rights of priority based on more than one earlier application (“multiple priorities”), even if they originate in different countries. ~~The earliest application must have been filed not more than 12 months before the date of filing of the international application.~~ An element of an international application will be accorded the priority date of the earliest priority application which discloses it. If, for instance, the international application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, ~~both filed within the preceding 12 months,~~ the priority dates of both the French and German applications may be claimed for the appropriate parts of the international application; embodiment A will have the French priority date and embodiment B the German priority date. If an international application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the international application itself. In other words, it is not permitted to make a mosaic of the priority documents. An exception might arise where one priority document contains a reference to the other and explicitly states that features from the two documents may be combined in a particular manner.

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. 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, on or after~~ 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).

6.07-6.12 [No change]

6.13 The examiner should keep in mind that the form of the declaration (see paragraph 6.11) claiming the priority of one or more earlier applications under Article 8(1) is prescribed under Rule 4.10(a). The prescribed form of declaration includes the giving of the following indications:



- (i) the date on which the earlier application was filed, ~~being a date falling within the period of 12 months preceding the international filing date;~~
- (ii) the number of the earlier application;
- (iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;
- (iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;
- (v) where the earlier application is an international application, the receiving Office with which it was filed.

6.14-17 [No change]

## Chapter 7 [No change]

## Chapter 8 Rule 91 – Obvious ~~Errors~~ Mistakes in Documents

*Rule 91.1(a), (c), (d) and (e)*

8.01 ~~Errors~~ Mistakes which are due to the fact that something other than that which was obviously intended ~~that~~ were written in the contents of the international application or in a later submitted paper (for example, linguistic errors, spelling errors) may usually be rectified if a request for rectification is submitted within 26 months from the priority date. The ~~error~~ mistake must be “obvious” in the sense that it is ~~immediately apparent~~ obvious to the competent authority:

- (i) that ~~an error~~ a mistake has occurred (i.e., something else was intended than what appears in the document concerned); and
- (ii) ~~that anyone would immediately recognize~~ that nothing else could have been intended other than the offered rectification.

8.02 It must be clearly apparent to the competent authority that a mistake was made. No special attributes should be ascribed to the person in the competent authority making the finding whether an alleged mistake is obvious and thus rectifiable. The competent authority makes the determination if a mistake is rectifiable.

*Rule 91.1(c)*

8.03 The test for the correction of an obvious mistake is a two-fold test: (i) the recognition that there was indeed a mistake and (ii) an assessment as to whether the proposed rectification was the only meaning which could have been intended. In other words, it first must be apparent that a mistake has been made. Then it must be clear that nothing else could have been intended other than the proposed rectification.

*Rule 91.1(d)*

8.0402 Examples of obvious ~~errors~~ mistakes that are rectifiable include linguistic errors, spelling errors and grammatical errors so long as the meaning of the disclosure does not change upon entry of the rectification. An obvious mistake is not solely limited to such mistakes, but for the correction to the description, claims, or drawings, the finding by the competent authority whether an alleged mistake is obvious would have to be made only on the basis of the international application itself, without any possible reliance on extrinsic

documents. The contents of priority documents should not be taken into account for the purposes of considering whether mistakes in the description, claims or drawings were obvious and thus rectifiable. Errors Mistakes in chemical or mathematical formulae would not generally be rectifiable unless the correct formulae would be common knowledge to anyone.

*Rule 91.1(c)*

~~8.0503~~ If a correction is not of this character (for example, if it involves cancellation of claims, omission of passages in the description or omission of certain drawings), it would ~~be treated not be authorized~~ by the competent Authority as an amendment and dealt with on that basis. It is noted that Rules 20.5 - 20.8 allow an applicant to request that the receiving Office replace a missing element or part of an application if the request included an incorporation by reference statement under Rule 4.18 and applicant makes such a request in compliance with Rules 20.5 and/or 20.6 within the time limits set forth in Rule 20.7. In view of Rules 20.5 - 20.8, it should not be necessary for applicants to request rectification of the omissions of entire elements or sheets under Rule 91.

*Rule 91.1(e)*

8.06 In the case of a mistake:

(i) in the request part of the international application or a correction thereof; or  
(ii) in a document other than the description, claims or drawings, or in a correction thereof, or in an amendment under Article 19 or 34;

the finding of the competent authority shall only take into account the contents of the international application itself and, where applicable, the correction concerned, or in said document, together with any other document submitted with the request, correction or document, as the case may be, any priority document in respect of the international application that is available to the authority in accordance with the Administrative Instructions, and any other document contained in the authority's international application file at the applicable date under paragraph 8.07, below. Extrinsic evidence filed with the request for rectification is not permitted to be used.

*Rule 91.1(f)*

8.07 The applicable date to be used in determining the approval of a rectification of a mistake shall be:

(i) the international filing date where the alleged mistake is in a part of the international application as filed;

(ii) the date on which a document containing the alleged mistake was received where the alleged mistake is in the document other than the international application as filed, including a mistake in a correction or an amendment of the international application. Where the alleged mistake is a part of the international application as filed, the rectification two part test discussed in the paragraph 8.03 must be met on the international filing date. Knowledge that came into being after the international filing date may not be used to rectify such a mistake. Where the alleged mistake is in another document, the rectification two-part test must be met on the date the paper was filed. Knowledge that came into being after the deposit date of the document may not be used to rectify such a mistake.

### **Mistakes that Cannot be Rectified Under Rule 91**

8.08 Under Rule 91.1(g), a mistake shall not be rectified if:

*Rule 66.5 and 91.1(g)(i)*

(i) the mistake lies in the omission of one or more entire elements of the international application referred to in Article 3(2) (request, description, claims, drawings, or abstract) or one or more entire sheets of the international application;

Rule 91.1(g)(ii)

(ii) the mistake is in the abstract;

Rule 91.1(g)(iii)

(iii) the mistake is in an amendment under Article 19, unless the International Preliminary Examining Authority is competent to authorize the rectification because a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examination shall start in accordance with Rule 69.1 has passed; or

Rules 26bis.2(e) and 91.1(g)(iv)

(iv) the mistake is in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date.

However, it is noted that provisions for providing a missing element or sheet to the receiving Office are provided in Rules 20.5-20.8. An applicant may, under Rule 38.3, propose modifications to the abstract established by the International Searching Authority. Changes to the priority claim, other than a change in the priority date, may be made under either Rule 91 or Rule 26bis.1(a).

### Correction of Priority Claims

8.09 Corrections or additions of the priority claim that would affect the priority date may only be corrected in accordance with Rule 26bis. However, where the applicant wishes to correct or add a priority claim but the time limit under Rule 26bis.1 has expired, the applicant may request the International Bureau to publish information concerning the matter. Any such request must be made prior to the expiration of 30 months from the priority date and is subject to the payment of a special fee.

### **Transmittal to Another Authority of a Request for Rectification**

Rule 91.1(be)

8.1004 The following authorities are competent to authorize rectifications in the international application and associated papers:

- (i) the receiving Office if the ~~error~~ mistake is in the request part of the international application or in a correction thereof,
- (ii) the International Searching Authority if the ~~error~~ mistake is in the description, claims or drawings or in a correction thereof, unless the International Preliminary Examining Authority is competent under item (iii) any part of the international application other than the request or in any paper submitted to that Authority,
- (iii) the International Preliminary Examining Authority if the ~~error~~ mistake is in the description, claims, drawings or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which the international preliminary examination shall start in accordance with Rule 69.1 has passed any part of the international application other than the request or in any paper submitted to that Authority,
- (iv) in the case of a the International Bureau if the ~~error~~ mistake is in a document not referred to in items (i) to (iii) submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, other than a mistake in the abstract or in an amendment under Article 19 - by that Office, Authority or Bureau as the case may be any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

8.1105 If an International Authority receives a request for rectification of an obvious ~~error~~ mistake in the request or a paper for which it is not the authority competent to authorize the rectification, it transmits that request together with any proposed replacement sheet to the appropriate authority, as listed above, and informs the applicant accordingly. It may, instead of transmitting the request, inform the applicant that the request should be sent to the authority competent to rectify the ~~error~~ mistake. For the language(s) in which such request for rectification must be submitted, see Rule 12.2(b).

### **Invitation to the Applicant to Request Rectification**

*Rule 91.1(h)*

8.1206 If the International Searching Authority or the International Preliminary Examining Authority discovers what appears to be an obvious ~~error~~ mistake in the international application or any other paper submitted by the applicant, it may invite (optionally using Form PCT/ISA/216 by the ISA or PCT/IPEA/411 by the IPEA) the applicant to submit a request for rectification to the Authority competent to authorize the rectification (Rule 91.1(~~bd~~) and (he)). Although Rule 91.1(~~hd~~) allows the International Searching Authority and the International Preliminary Examining Authority to invite rectifications, it is not expected that such invitations will be issued since any ~~error~~ mistake which can be rectified under Rule 91 will not be an impediment to establishing the search report and should not affect the substance of any written opinion or international preliminary examination report.

### **Submission and Processing of a Request for Rectification Submitted to the International Searching Authority**

*Rule 91.2*

8.13 A request for rectification shall be submitted to the competent authority within 26 months from the priority date. A request for rectification shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation.

*Rule 91.34; Section 511*

8.1407 Where a request for rectification is submitted to the International Searching Authority and the International Searching Authority is competent to authorize the rectification ~~in respect of any document other than the request Form is sought~~, the International Searching Authority considers whether the ~~error~~ mistake is rectifiable under Rule 91.1, marks the documents in accordance with Section 511 and completes Form PCT/ISA/217. The International Searching Authority forwards the request for rectification and the PCT/ISA/217 to the receiving Office, the International Bureau and the applicant.

*Rule 91.1(b), (g)(i), (g-bis), (g-ter) and (g-quater)*

~~8.08 Authorization of rectifications is determined solely by Rule 91.1(b) and (c) (see paragraphs 8.01 to 8.03) while Rule 91.1(g)(i), (g-bis), (g-ter) and (g-quater), determines if they are of effect (in general, where the notification of the authorization for rectification reaches the International Bureau before the completion of the technical preparations for international publication). Whether such rectifications can be effective is not a consideration in authorizing and thus of no concern to the search examiner. No authorization will be approved once publication has occurred.~~

## **Request for Rectification Submitted to the International Preliminary Examining Authority**

*Rules 66.5, 91.1(b)*

~~8.1509~~ During the time of international preliminary examination ~~Subject to authorization (see paragraph 8.10), a request for~~ rectification of obvious errors mistakes in the international application can be made ~~at the request of~~ by the applicant of his own volition. In addition, the examiner, upon study of the international application (other than the request) and any other papers submitted by the applicant, might also note obvious errors mistakes. ~~Although Rule 91 allows the International Preliminary Examining Authority to invite applicants to submit a request for rectification (optionally using Form PCT/IPEA/411), it is not foreseen that such invitations will be issued since any error which can be rectified under Rule 91 will not be an impediment to establishing the international preliminary examination report.~~

*Rule 91.31(e), (f) and (g)(ii); Section 607*

~~8.1610~~ Rectification of an obvious error cannot be made before the International Preliminary Examining Authority without the express authorization of that Authority. The Authority is permitted to authorize rectification of such errors in a part of the international application other than the request or in any papers submitted to it. The examiner may only authorize rectification of obvious errors up to the time the international preliminary examination report is established. The time within which requests for rectification can be made to that Authority is limited accordingly. Any The International Preliminary Examining Authority which authorizes or refuses any rectification promptly notifies the applicant of the authorization or refusal using Form PCT/IPEA/412 and, in the case of refusal, of the reasons therefor. The International Preliminary Examining Authority marks the request as set forth in Section 607 and sends a copy of the request for rectification and the Form PCT/IPEA/412 to the International Bureau.

### **Authorization and Effect of Rectifications**

*Rule 43.6bis(a)*

8.17 An authorized rectification of an obvious mistake under Rule 91.1 shall, subject to paragraph 8.18, be taken into account by the International Searching Authority for the purpose of the international search. The international search report shall indicate that the rectification has been taken into account, subject to paragraph 8.18.

*Rule 43.6bis(b)*

8.18 The international search report shall, if possible, indicate whether the rectification of an obvious mistake has been taken into account in the situation where the processing or examination of the international application has already started prior to the date on which that Office is notified under Rule 91.3(a) of the authorization of the rectification by the competent authority. If the report fails to indicate whether the rectification of an obvious mistake was taken into account, the International Searching Authority shall notify the International Bureau accordingly, and the International Bureau shall proceed as provided for in the Administrative Instructions.

91.3(d)

8.19 Upon applicant's request, if the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall publish the request for rectification, the reasons for the refusal by the authority and any further brief comments that may be submitted by the applicant, if possible, together with the international application. Such a request must be submitted within 2 months from the date of the refusal and is subject to the payment of a special fee.

Rule 48.2(a)(vii)

8.20 If authorization of rectification of an obvious mistake was received by the International Bureau before the completion of the technical preparations for international publication, the international publication shall include the rectification.

Rule 48.2(i)

8.21 If authorization of rectification of an obvious mistake in an international application referred to in Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for the international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2. Additionally, the front page shall be republished.

Rule 48.2(k)

8.22 If the request for the publication under Rule 91.3(d) was received by the International Bureau after completion of technical preparations for the international publication, the request for rectification of obvious mistake, any reasons and any comments shall be promptly published after the receipt of such request for publication. Additionally, the front page shall be republished.

### **Effective date of Rectification**

Rule 91.3 (c)

8.23 Where the rectification of an obvious mistake has been authorized, it shall be effective:  
(i) in the case of a mistake in the international application as filed, from the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which the document was submitted.

A rectification of an obvious mistake in the international application as filed is effective from the international filing date rather than from the date the rectification is proposed. A rectification of a mistake in another document is effective from the date on which the document was submitted rather than from the date the rectification is proposed.

## **Chapters 9 and 10** **[No change]**

## **Chapter 11** **Prior Art**

11.01 [No change]

Rules 2.4, 33.1, 43bis.1, and 64.1

11.02 It should be noted that the definition of relevant prior art for purposes of international search report is different from the definition of relevant prior art for other purposes, including the written opinion established by the International Searching Authority because “relevant date” is defined differently for international search report purposes and for written opinion and international preliminary examination purposes.

11.03 [No change]

11.04 For the purposes of the written opinion and international preliminary examination, Rule 64.1 defines the relevant date as:

(i) subject to items (ii) and (iii), the international filing date of the international application under international preliminary examination (or, in conjunction with Rule 43bis.1(b), for which a written opinion is being established by the International Searching Authority); ~~or~~

(ii) where the international application claims the priority of an earlier application and has an international filing date which is within the priority period (12 months from the filing date), the filing date of such application, unless the International Authority considers that the priority claim is not valid; where that international application validly claims the priority of an earlier application, the filing date of such earlier application.

(iii) where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

11.05-11.26 [No change]

## **Chapters 12 to 14** **[No change]**

## **Chapter 15** **The International Search**

15.01-15.09 [No change]

*Article 19; Rules 5.2, 13ter, 91.1; Section 208, AI Part 8, AI Annex C*

15.10 There is no right to amend the application until after the international search has been established, consequently the international search must be carried out on the basis of the search copy of the application as transmitted to the International Searching Authority by the receiving Office, except that obvious ~~errors~~ mistakes may be corrected (see chapter 8).

15.11-15.18 [No change]

15.19 Since the applicant is not permitted to amend the claims before receiving the international search report, except to rectify obvious ~~errors~~ mistakes or to correct formal matters which are contrary to the PCT and are called to the applicant's attention by the receiving Office, the international search is directed to the claims as filed. See paragraph 15.21.

15.20-15.29 [No change]

*Obvious ~~Errors~~ Mistakes and Matter Contrary to Public Order*

*Rules 9.1, 9.2, 91.1, 33.3(b); Sections 501, 511(a)(v)*

15.30 If the examiner notices any obvious ~~error~~ mistake in the international application, the International Searching Authority may invite (optionally using Form PCT/ISA/216, see paragraph 8.06) the applicant to request the rectification of the error.

15.31-15.70 [No change]

## **Chapter 16**

### **International Search Report**

16.01-16.66 [No change]

*Potentially conflicting patent documents*

*Section 507(b)*

16.67 Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date) but published later than that date and the content of which would constitute prior art relevant to novelty (Article 33(2)) or inventive step (Article 33(3)) is indicated by the letter "E" (see section 507(b) and Rule 33.1(c)). Where the patent document and the application searched have the same date, the patent document is also identified by the letter "E". An exception is made for patent documents based on the priority under consideration.

16.68-16.80 [No change]

## **Chapter 17**

### **Content of Written Opinions and the International Preliminary Examination Report**

17.01-17.25 [No change]

17.26 Where one or more citations of the international search report were published after the earliest priority date, the validity of that earliest priority date requires checking. (See paragraph 6.03 for formal requirements for validity and paragraph 6.05 for substantive requirements for validity.)

(a)-(d) [No change]

17.27-17.44 [No change]



17.45 The report may also indicate that, in the opinion of the International Searching Authority or the International Preliminary Examining Authority, the priority date of the international application has not been validly claimed (see also paragraphs 17.26-~~17.28~~).

17.46-17.70 [No change]

## Chapter 18 [No change]

## Chapter 19 Examination Procedure Before The International Preliminary Examining Authority

19.01-19.21 [No change]

19.22 Where a response to a written opinion is received in the form of arguments only, the written opinion is reconsidered in the light of those arguments. Where the response includes some amendments, other than rectification of obvious ~~errors~~ mistakes (Rule 66.5), the amended description, drawings, and/or claims are considered as in paragraphs 20.04 to 20.22. In such a case the international preliminary examination report should indicate that the applicant's arguments have been taken in account in establishing the international preliminary examination report. In addition, the examiner should comment on any relevant arguments made by the applicant.

19.23-19.27 [No change]

### *Rectification of Obvious ~~Errors~~ Mistakes*

*Rules 66.5, 91.2~~(b)~~*

19.28 ~~Errors~~ Mistakes which are due to the fact that something other than that which was obviously intended was written in the contents of the international application (other than the request) or other paper submitted to the International Preliminary Examining Authority (for example, linguistic errors, spelling errors) may ~~usually be rectified at any time during international preliminary examination~~ be rectified if a request for rectification is submitted within 26 months from the priority date. If a correction is not of this character (for example, if it involves cancellation of claims, omission of passages in the description or omission of certain drawings), it ~~is treated by the examiner as an amendment and dealt with on that basis would not be authorized by the Authority~~ (see paragraph 20.09 and chapter 8).

*Rule 91.1(a), (b), and (h)~~(d)~~*

19.29 Subject to authorization (see paragraph 19.30), rectification of obvious ~~errors~~ mistakes in the international application can be made at the request of the applicant on his own volition. In addition, the examiner, upon study of the international application (other than the request) and any other papers submitted by the applicant, might also note obvious ~~errors~~ mistakes. (See chapter 8). Although Rule 91 allows the International Preliminary Examining Authority to invite the applicant to submit a request for rectifications, it is not foreseen that such invitations will be issued since any ~~error~~ mistake which can be rectified under Rule 91 will not be an impediment to establishing the international preliminary examination report.

*Rule 91.1(a) and (b)(e), (f) and (g)(ii) and 91.2; Section 607*

19.30 Rectification of an obvious ~~error~~ mistake cannot be made before the International Preliminary Examining Authority without the express authorization of that Authority. The Authority is permitted to authorize rectification of such ~~errors~~ mistakes in a part of the international application other than the request or in any papers submitted to it. The Authority may only authorize rectification of obvious errors ~~up to the time the international preliminary examination report is established if a request for rectification is submitted within 26 months from the priority date.~~ See paragraph 8.1340.

*Rule 66.1(d-bis)*

19.31 A rectification of an obvious mistake that is authorized under Rule 91.1 shall be taken into account by the International Preliminary Examining Authority for the purposes of the international preliminary examination, subject to paragraph 19.32 below.

*Rule 66.4bis*

19.32 A rectification of obvious mistakes need not be taken into account by the International Preliminary Examining Authority for purposes of the written opinion or the international preliminary examination report if they are received by, authorized by or notified to that Authority after it has begun to draw up that opinion or report.

### *Informal Communication with the Applicant*

Current paragraphs 19.31-19.38 are to be renumbered 19.33-19.40 respectively.

*Article 35(1), 47(1)*

~~19.4139~~ When it is a matter for the Authority to determine applicable time limits referred to in the PCT, the examiner must consult all the factors relevant to the particular international application under consideration as well as the Regulations under the PCT which govern such time limits. The most important time limits for international preliminary examination so far as International Preliminary Examining Authorities are concerned, have been considered in more detail in the various chapters and paragraphs as follows:

- (i) and (ii) [No change]
- (iii) rectifications of obvious ~~errors~~ mistakes: see paragraph 19.30 and chapter 8;
- (iv) - (vii) [No change]

Current paragraphs 19.40-19.42 are to be renumbered 19.42-19.44 respectively.

## **Chapter 20 Amendments**

20.01-20.03 [No change]

20.04 Any change, other than the rectification of obvious ~~errors~~ mistakes, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings is considered an amendment. Any amendment to the international application must be submitted in the language in which the international preliminary examination is carried out.

20.05- A20.21[2] [No change]

PCT/MIA/13/2 Add.1  
Annex I, page 16

**Chapters 21 and 22**  
**[No change]**

[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

*Missing elements and parts of the international application*

1. Rules 4.1(c)(iv), 4.18, 4.19, 12.1*bis*, 12.3, 20.1 to 20.9, 21.2, 22.1, 26.1, 26.2, 26.3*ter*, 26.5, 26.6, 48.2(b)(v), 51.1, 51.2, 51*bis*.1, 55.2 and 82*ter*.1 have been amended to provide a mechanism whereby elements and/or parts of an application which are missing upon the initial filing of international application papers can be included in the international application without the loss of the international filing date. The amended rules provide that such missing elements and/or parts may be included in the international application if the application, as of its initial receipt date, claimed priority to an earlier application and if the Request contained an incorporation by reference statement for such a purpose. In addition, Rule 20 has been restructured so as to align the order of the provisions dealing with the according of the international filing date with the (logical) order in which a receiving Office determines whether to accord, and which date to accord, as the international filing date.

2. These amendments are reflected by the proposed modifications of paragraphs 4.27 and 6.01 of the Guidelines.

*Restoration of the right of priority.*

3. Rules 2.4, 4.1(v), 4.10, 26*bis*.2(a) to (d), 26*bis*.3, 48.2(a)(ix) and (xi), 48.2(b)(iv), (vi), (vii) and (viii), 48.2(j), 49*ter*.1, 49*ter*.2, 64.1, 76.5 and 82*ter*.1(a) have been amended to provide for the restoration of the right of priority in applications filed later than the date on which the priority period expired but within the period of two months from that date. Under the amended rules the right of priority can be restored in such applications upon the finding of the receiving Office that the failure to file the international application within the priority period occurred either in spite of due care or was unintentional, at the option of the receiving Office. Additionally, such a priority claim would be retained irrespective of whether the applicant requests the receiving Office to restore the right of priority, and even where such a request is made but refused by the receiving Office, and would therefore be taken into account during the international phase for the purposes of international search and international preliminary examination, and for the purpose of the computation of time limits, including that for entry into the national phase.

4. These amendments are reflected by the proposed modifications of the flowchart at the end of Chapter 1 and of paragraphs 6.03, 6.05, 6.13, 11.02, 11.04, 17.26 and 17.45 of the Guidelines.

*Rectification of obvious mistakes*

5. Rules 11.14, 12.2, 26*bis*.1, 26*bis*.2(e), 38.2, 38.3, 43.6*bis*, 43*bis*.1, 48.2(a)(vii), 48.2(i), 48.2(k), 66.1, 66.4*bis*, 66.5, 70.2, 70.16, 91.1, 91.2 and 91.3 have been amended to rationalize the operation of Rule 91, whose provisions are open to different interpretations, to introduce more consistent practices in PCT Offices and Authorities, and to bring PCT practice into line, to the extent possible, with the provisions of the PLT relating to rectification of mistakes.

6. These amendments are reflected by the proposed modifications of all of Chapter 8 and paragraphs 15.10, 15.19, 15.30, 17.16, 19.22, 19.28-19.44 and 20.04 of the Guidelines.

#### OTHER MODIFICATIONS

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

(a) Paragraph 1.03 has been modified to clarify that Chapter 21 of the Guidelines is not considered to be additional to the common rules of international search and examination, but rather is considered, along with all of the other chapters, to constitute part of the common rules of international search and examination.

(b) Paragraph 1.11 has been amended to correct the reference to Parts II through VIII of the Guidelines.

(c) Paragraph 6.06 has been amended to remove the reference to the international filing date in sub-paragraph (ii) as the reference is not in accordance with Rule 64.2.

(d) Paragraph 16.67 has been amended to indicate that “E” type references are also pertinent with respect to inventive step in accordance with Rules 33.1(c) and 64.3.

[End of Annex II and of document]