WIPO

PCT/MIA/I/4
ORIGINAL: English
DATE: September 22, 1989

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT

First Session
Geneva, January 15 to 19, 1990

REVISION OF THE INTERNATIONAL PRELIMINARY EXAMINATION GUIDELINES

CONSIDERATION OF PROPOSALS MADE BY THE PRESENT INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES

Memorandum prepared by the International Bureau

The International Bureau, in response to Circular C.326, dated February 6, 1987, has received proposals to amend the Guidelines for International Preliminary Examination under the PCT. The said Circular, and the replies relating thereto, are reproduced in the Annex to this document.

[Annex follows]

WORLD INTELLECTUAL PROPERTY ORGANIZATION

世界知识产权组织

ORGANIZACION MUNDIAL DE LA PROPIEDAD INTELECTUAL

ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

C. 326
PCT 211

February 6, 1987

Sir,

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

The present "Guidelines for International Search To Be Carried Out under the Patent Cooperation Treaty (PCT)" and the present "Guidelines for International Preliminary Examination To Be Carried Out Under the Patent Cooperation Treaty (PCT)," which were published in 1977 as documents PCT/INT/5 and 6, respectively (copies attached), require modification in order to be adapted, on the one hand, to the various amendments which have been made to the Regulations and the Administrative Instructions under the PCT since 1978 and, on the other hand, to the practical needs and experience resulting from the daily operations under the PCT.

./.

The International Bureau invites your Office to make observations and concrete proposals on all items where you feel that the said Guidelines should be modified. Such observations and proposals should reach the International Bureau not later than July 31, 1987.

/...

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C. 326
PCT 211

February 6, 1987

Depending on the modifications which might be proposed, the International Bureau will then either prepare a modified draft of both Guidelines and submit it for consultations or convene a meeting for a discussion of the proposed modifications.

Sincerely yours,

Arpad Bogsch
Director General

Australian
Patent, Trade Marks
and Designs Offices

Scarborough House, Phillip, A.C.T.
P.O. Box 200
Woden, A.C.T. 2606

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Address all correspondence
to the Commissioner
of Patents

In reply please quote:

78/68

20 July 1987

Dr Arpad Bogsch
Director General
WIPO
34, chemin des Colombettes
1211 Geneva 20
SWITZERLAND

Guidelines for International Searching and International Preliminary Examination under the Patent Cooperation Treaty (PCT)

Dear Dr Bogsch

I refer to your circular C.326/PCT 211 of 6 February 1987, requesting observations on documents PCT/INT/5 and PCT/INT/6.

Our comments and proposed changes to these documents are attached.

Yours sincerely

Ian McCay
Senior Assistant Commissioner
Industrial Property Policy & Coordination Branch

INTERNATIONAL PRELIMINARY EXAMINATION (PCT/INT/6)

Page Number	Chapter Number	Clause Number	Line Number(s)	Change/Comment
5	I	1.4	18	These sections require amendment to reflect the change from 25 months to 30 months in Article 39(1)
5	I	1.5	1,8	
8	II	1.2	All	This paragraph should be deleted, as Rule 53.1(d) has now been deleted.
11	II	4.14	5-8	The sentence "This discretion may ..." should be deleted as Rule 55.2 has been deleted.
11	II	4.15	7-9	Temperatures are now to be given in degrees Celsius rather than degrees Centigrade. (Rule 10.1(b)).
11	II	4.15	8	The reference in the margin to Rule 10(c) should be deleted, as this Rule has been deleted.
19	III	7.2.-7.3	All	These passages require modification to relate to <u>three</u> rather than <u>two</u> specific combinations of different categories now allowed by Rule 13.2.
33	V	3.2	16	The priority document number may alternatively be furnished to the Receiving Office. (Rule 4.10(c)).
33	V	3.3	All	This passage needs redrafting to reflect the changes in Rules 66.7(a) and (b) and the deletion of Rule 66.7(c).
35	VI	3.1	15	This section requires amendment to reflect the change from 25 months to 30 months in Article 39(1).

114/130/4

Page Number	Chapter Number	Clause Number	Line Number(s)	Change/Comment
36	VI	3.3	All	This passage needs redrafting to reflect the changes in Rule 69(1).
36-37	VI	4.1-4.2	All	These passages need redrafting in view of the deletion of Rule 62.1.
37-38	VI	4.5-4.6	All	These passages are not relevant since Rule 55.2 has been deleted.
38	VI	4.7	All	This passage needs redrafting to more closely reflect to current Rule 55.1.
38	VI	4.9	All	This passage needs redrafting to reflect changes to Rules 66.7(a) and (b), and the deletion of Rule 66.7(c).
38	VI	4.10	11-12	This passage needs redrafting as the time limits of Rule 46.1 have been changed.
42	VI	6.1	6	The word "corrections" should now read "arguments" (Rule 66.4(b)).
43	VI	6.5	2	The words "or corrections" should be deleted to follow the present wording of Rule 66.2(c).
43	VI	7.1	1	Rule 66.5 is no longer limited to errors of transcription - these two words should be deleted.
43	VI	7.1	4-7	This needs redrafting as Rule 55.2 has been deleted. Language requirements of amendments are now governed by Rule 66.9.

Page Number	Chapter Number	Clause Number	Line Number(s)	Change/Comment
43	VI	7.5	5-7	The language requirements have changed as a result of Rule 92.2(c) being deleted.
45	VI	7.14-7.16	All	These passages need redrafting in view of the major amendments to Rule 91. Also Sect. 109 of the Administrative Instructions has been deleted.
50	VI	8.17	5-7	This section is not relevant since Rule 70.17(b) has now been deleted.
51	VI	12.1	3	Reference to Rule 75.3 should be removed since this Rule has been deleted.

Bundesministerium für wirtschaftliche Angelegenheiten
~~Bundesministerium für~~
~~Handel, Gewerbe und Industrie~~
Referat für den gewerblichen Rechtsschutz
A-1014 Wien, Kohlmarkt 8–10

Wien, am July 24, 1987

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Zl. 97.335/1-GR/87

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Mr. Arpad B o g s c h
Director General
World Intellectual Property
Organization

34, chemin des Colombettes
CH-1211 G e n e v a 20

Re: C.326
PCT 211

Dear Mr. Director General,

In reply to your letter of February 6, 1987 I have the honor to transmit the annexed proposals for modification of the "Guidelines for International Search To Be Carried Out under the Patent Cooperation Treaty (PCT)" and the "Guidelines for International Preliminary Examination To Be Carried Out Under the Patent Cooperation Treaty (PCT)" (documents PCT/INT/5 and PCT/INT/6).

It may be pointed out that the terms "new Regulations", "new Article" respectively "new Rule" should be understood as Regulations, Articles and Rules under the PCT as in force on January 1, 1985. The terms "former Regulations", "former Article" respectively "former Rule" relate to the PCT published in 1971.

Sincerely yours,

J. Fichte
Vice-President
Austrian Patent Office

Annex

Für die Richtigkeit
der Ausfertigung:

Reicher

000013

ANNEX
Zl. 97.335/1-GR/87

Document PCT/INT/5

Page 9, chapter IV 1.2

The first sentence of this paragraph ("If the search examiner... ...appropriate action (PCT Rule 28.1)") and the following word "Similarly" should be deleted because, according to the new Regulations, an information of the receiving Office on certain defects by the International Searching Authority is no more provided.

Annex B, chapter A.1.(vi)

In accordance with the new Rule 34.1 c)(vi) the word "or" between the words "French" and "German" should be deleted and after the word "German" the words "or Spanish" should be inserted.

Document PCT/INT/6

Page 5, chapter I 1.4 and 1.5

With regard to the new Article 39 (1) a) the terms "25th month" should be replaced by "30th month".

Page 8, chapter II 1.2

The term "two identical copies of the demand" should be replaced by "a demand" because the former Rule 53. 1 (d) has been deleted. The according reference to said former Rule should be replaced by "PCT Rule 53.1(a)".

Page 11, chapter ii 4. 14

The term "when such translation is required under PCT Rule 55.2." should be deleted because in the new Regulations said Rule is no more provided.

Page 11, chapter ii 4.15

The reference to PCT Rule 10.1(c) should be deleted because in the new Regulations this Rule is no more provided.

Page 20, chapter iii 7.8

The reference to PCT Rule 69.1(a)(ii) should be deleted because the new Rule 69.1(a)(ii) does no more provide a relation to Article 34(3).

Page 33, chapter V 3.3

The reference to Rule 66.7(c) should be deleted because in the new Regulations this Rule is no more provided.

Page 35, chapter Vi 3.1

With regard to the new Article 39(1)a) the term "25th month" in line 15 of this paragraph should be replaced by "30th month".

Page 36, chapter Vi 3.3

The text of this chapter should be replaced by the content of the new Rule 69.1a).

Pages 36, 37, chapter Vi 4.1, 4.2, 4.3

The references to PCT Rules 62.1 and 55.2 should be deleted because in the new Regulations these Rules are no more provided. Furthermore, the sentence "-translation of the international application where required: by the applicant" (paragraph 4.2) should be deleted.

Pages 37, 38, chapter VI 4.4 to 4.8
The text of these paragraphs should be replaced by the content of the new Rule 12.

Page 38, chapter Vi 4.9

The text of this chapter should be replaced by the content of new Rule 66.7.

Page 43, chapter Vi 7.1

The term "and, where translation of the international application is required under PCT Rule 55.2, in the language of translation." should be deleted because in the new Regulations the former Rule 55.2 is no more provided.

Page 43, chapter Vi 7.5

The term "unless a translation is required in which event it must be in the language of the translation." should be deleted. The last sentence of this paragraph ("if these requirements ....") should be replaced by the content of new Rule 92.1.b). Furthermore, the reference to PCT Rule 92.2(c) should be deleted because in the new Regulations this Rule is no more provided.

Page 45, chapter V, 7.16

The text of this paragraph should be modified in accordance with the new Rule 91.1 f) to 91.1 g^{quater}

Page 48, chapter V, 8.5

With regard to the new Rule 70.16 the term "or letters making the amendments" (last sentence of this paragraph) should be deleted.

Page 50, chapter V, 8.17

With regard to the new Rule 48.3 b) the word "or" between the words "Japanese" and "Russian" should be deleted and the words "or Spain" should be inserted after the word "Russian".

The term "both in the language in which the international application to which it relates was filed and also, if it is different," should be deleted with repect to new Rule 70.17 a). Furthermore, the reference to PCT Rule 70.17(b) should be replaced by reference to PCT Rule 70.17(a).

Page 51, chapter V, 12.

This paragraph should be deleted because a notification of the International Preliminary Examining Authority in accordance with former Rule 75.3 is no more provided.

In addition to the proposals disclosed above it may be suggested to complete the Guidelines by paragraphs re ting to the new Rules 13^{bis} and 16^{bis}.

PATENT- OCH REGISTRERINGSVERKET
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Telefon: vx 08-782 25 00.

0705L

July 23, 1987

Dr. A. Bogsch
Director General
WIPO
34, chemin des Colombettes
1211 Genéve 20

Dear Dr. Bogsch,

In response to WIPO circular No. 326 of 1987-02-06 concerning revision of the PCT Guidelines for Search (PCT/INT/5) and for Preliminary Examination (PCT/INT/6), we have the pleasure to enclose two Annexes.

Annex A contains some observations upon changes, which will have to be made in the Guidelines for Examination as a consequence of decided amendments to the Treaty and the Regulations.

Annex B contains our views - in general terms - upon the PCT Guidelines.

Hoping that our contribution might be of some use, I remain,

Yours sincerely

Lars Björklund
Deputy Director General

Valhallavägen 136.
Postgiro: 156 84-4.

Telex: 17978 PATOREG-S.
Telegram: PATOREG, Stockholm.

Annex A

Guidelines for International preliminary examination

Page 5, paragraph 1.4 and 1-5:

The time limit will be 30 months instead of 25 months.

Page 8, paragraph 1.2:

Rule 53.1 (d) will be deleted.

Page 35, paragraph 3.1:

The time limit will be 30 months instead of 25 months.

Page 36, paragraph 3.3:

Rule 69.1 (a) is changed and we suggest the following text:

"The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;

(ii) nine month from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date".

Page 37, paragraph 4.5:

Rule 55.2 will be deleted.

Page 38, paragraph 4.7:

Rule 55.1 is changed and we suggest the following text.

"The demand submitted to the International Preliminary Examining Authority shall be in the language of the International application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication".

Page 43, paragraph 7.1:

Rule 12.2 is changed.

We suggest the following text of the second sentence in the paragraph.

"Any amendments to the international application shall be submitted in the language of publication".

Page 43, paragraph 7.5:

Rule 92.2 (c) will be deleted and also the second and third sentence of paragraph 7.5.

Page 45, paragraph 7.16:

Rule 91.1 (h) and Administrative Instructions section 109 will be deleted and rule 91.1 (f) och 91.1 (g) are changed.

The last three sentences in paragraph 7.16 will be deleted and insert instead the following sentences.

"Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly"

Page 50, paragraph 8.17:

Rule 70.17 (b) will be deleted and also the last sentence in paragraph 8.17.

ANNEX B

The Swedish Patent Office has fulfilled its role as an ISA and an IPEA during 9 years, and we have analyzed our experience with the Guidelines PCT/INT/5 and PCT/INT/6, respectively.

The analysis is difficult, and in our opinion the reason for this is, that it is not clear for whom or for what purpose the Guidelines are intended.

Should the PCT Guidelines be elaborated in such a way as to serve as educational (maybe even scientific) literature? Or should the Guidelines serve as an everyday tool at the fingertips of examiners?

Our impression is, that the Guidelines for Search (PCT/INT/5), and especially the Guidelines for Examination (PCT/INT/6) both attempt to cover the respective areas as completely and correctly as possible. Naturally this results in very comprehensive texts, which can be favourably used in education. In addition, we note that the quality of the different chapters is very high and most of them still feel up-to-date.

However, in spite of this positive appraisal, we wonder whether the PCT Guidelines are effective. Again, for whom are they intended?

It is fairly safe to assume that very few people, if any, outside PCT Authorities have the slightest interest in the PCT Guidelines. Exceptions might include some patent agents practising before a PCT Authority.

The need for Guidelines within a PCT Authority is twofold:

(i) Educational material

(ii) Quick reference aid.

As already elaborated above, need No. (i) is satisfactorily met by the PCT Guidelines, but one can not help wondering whether, in those same Authorities, there already exists ample literature on the basic theory and practise of search and examination?

Need No. (ii) is definitely not met by the PCT Guidelines; the Guidelines contain far too many solid blocks of heavy text, filled with repetitions and references to other documents, very probably out of examiners' easy reach.

Examiners in PCT Authorities are generally very well trained in the general theory and practise of patent search and examination. When these examiners work on international applications they probably only do so during a limited part of their total time (10-20% ?). Furthermore, many hold that the PCT is very complicated in itself. It follows, that examiners in PCT Authorities could find good use for an easy-to-use support tool concentrating on the essential elements of practical work with search and examination.

A suggestion would be to compile an index, in alphabetical order, to all relevant items (key-words) in the Treaty, the Regulations, the Guidelines and the Administrative Instructions. It would be an advantage if such an index also comprised explanatory and/or commentating text, e.g. spelling out when and how "X" & "Y" (Adm. instr. Sec. 505) are used.

THE PATENT OFFICE
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Mr A Schäffers
Deputy Director General
W.I.P.O
34 Chemin des Colombettes
1211 GENEVA 20
Switzerland

Your reference
C.326/PCT 211

Our reference
IPCD 41472/4

Date
25 November 1987

Dear Mr Schäffers

Guidelines for International Preliminary Examination

I have just realised that due to an unfortunate error, a minute which I prepared on 2 June giving the UK Patent Office response to your circular C326/PCT 211 was never sent. I apologise for the delay and I now enclose the UK response, hoping it is not too late.

We have confined our study to the examination guidelines as we have no practical experience of the search guidelines.

Mr Kolle of the EPO has kindly supplied us with a copy of their response which we are currently studying. If as a result of this we have any further comments I shall let you have them as soon as possible.

Yours sincerely

J SHARROCK
Superintending Examiner
(Patent Practice)

UNITED KINGDOM PATENT OFFICE November 1987

UK PROPOSALS FOR THE REVISION OF GUIDELINES FOR INTERNATIONAL PRELIMINARY EXAMINATION (PCT/INT/6)

Introductory remarks:

1. A large part of the guidelines for IPE is closely based on the EPO Guidelines and it is logical that it should continue to be so. I have confirmed that the EPO would be suggesting revisions to the text where the EPO Guideline have been revised and therefore we have not duplicated this work. (We have been supplied with a copy of their proposals and are currently studying them).

2. Amendment is also needed in several places to take account of amendments to PCT Articles 22 and 39 and Rule amendments as adopted by the Assembly on 3 February 1984. We have assumed that the IB will draft the necessary consequential revisions and again we have not duplicated this work in detail. However, we have noted in passing that amendment will be needed in the following passages, referring to Chapters and paragraphs:-

I	1.4 and 1.5 for consistency with Art 39.
II	1.2 deletion of R. 53(1)(d)
II	4.15 deletion of R.10.1)c)
III	3.5 consistency with R.6.4(a) as amended, new sentence added)
V	3.3 consistency with amended R.66.7
VI	the whole of 3, consistency with amended Art. 39 and R.69
VI	4.5, 4.6 deletion of R.55.2
VI	4.9 deletion of R.66.7(c) and amendment of R.66.7(a) and (b)
VI	6.1 consistency with R.66.4(b)
VI	7.1 consistency with amended R.66.5
VI	7.5 consistency with amended R.52.2
VI	7.14 to 7.16 consistency with amended R.91.1
VI	8.5 consistency with amended R.70

3. We have therefore confined our comments to those chapters dealing with examination procedure and preparation of the Report. These chapters are in general well presented and provide no real problems either in interpretation or implementation. Consequently we have only a few suggested changes, and these are as follows:

Chapter VI para. 5.17

The third sentence is long and complicated. We feel it also requires some expansion.

It (and the final sentence) could be replaced by:-

"Also, while any serious inconsistencies between the claims and description as filed should be objected to (see Chapter III paragraph 4.3) it should be borne in mind that

the claims may also require substantial amendment. In such a situation the examiner might invite the applicant to amend the description to be in conformity with the final form of the amended claims even though the final form of the main claims may still not be settled. This procedure may help the examiner to expedite the issuance of the international preliminary examination report. However it should also be appreciated that the applicant should not be put to unnecessary expense and trouble in providing amended description if there is any likelihood that the claims will have to be changed again. It may therefore be preferable to settle the final form of the claims before inviting the applicant to amend the description to conform".

We also feel that this point is not really related to that raised in the first two sentences of this paragraph which would fit more happily in paragraph 5.18, in which case the first word 'Also' of the above redraft could be omitted.

Chapter VI para 8.10

This paragraph is not clear. The requirement that "The statement should be made on the three criteria taken as a whole" is not consistent with the following requirement that "if any of the criteria taken separately is satisfied, an indication must be given .....".

It has always been our practice where one (or more) criterion is not satisfied to give separate statements for the different criteria, eg in the form YES (N, IA) NO (IS). This seems to be consistent with the lay-out of Form PCT/IPEA/409 and with the wording of Article 35(2) that "[The international preliminary examination report] shall state ..... in relation to each claim, whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability ....". It is also frequently convenient to deal with different criteria separately, in particular industrial applicability for which the statement is almost invariably "yes" and a blanket statement can be put at the beginning: "YES IA All claims meet the requirements of industrial applicability".

We appreciate that the wording of paragraph 8.10 reflects in part that of Rule 70(6)(b) but we would suggest that this paragraph be redrafted to specify precisely how the form should be completed in cases where any negative statement has to be made. It may be sufficient simply to omit the words: "The statement should be made on the three criteria taken as a whole".

para 8.11

This paragraph should be amended to reflect the present wording of section 604 of the Administrative Instructions.

Paragraph 8.10 or 8.11 should apparently also be revised to reflect the view of the majority of participants of the PCT International Meeting in Tokyo in May 1981. (PCT/TIM/I/13, para 39) that it was useful to include a reasoned statement in the report also where the report was positive with respect to novelty, inventive step and industrial applicability.

J SHARROCK

17 August 1987

TO: World Intellectual Property Organization
34 chemin des Colombettes
1211 Geneva 20
Switzerland

FROM: PCT International Services Division
Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231

SUBJECT: Circular 326/PCT 211

I. PCT/INT/5

Chapter II

Section 3: should "and extracts (or extractions) from subject matter databases" be included as part of a document collection?

Section 4: should --and extractions from databases-- be included between "documents" and "constituting"?

Chapter III

Section 3.8: 7th line, typo: "intenational" should be --international--.

Chapter VI

Sections 1.1 and 1.2: Can data which is part of a computer database but which is not available otherwise by means of a written disclosure be considered relevant prior art under Rule 33.1(a)? How does the examiner know when such data became part of a database?

General:

Additionally, comment should be provided by examiners or former examiners who are familiar with preparing international search reports, or by administrators familiar with the process of preparing international search reports.

II. PCT/INT/6

Chapter I

Sections 1.4 and 1.5: 30th instead of 25th month.

Chapter III

Section 2.3, item (i) should "know" be --known--?

Chapter IV

Sections 5.2: See comment on PCT/INT/5, Chapter VI, Sections 1.1 and 1.2 above.

Chapter VI

Section 1.4: I'm curious as to whether during international preliminary examination the invitation referred to in the last sentence of this section has been extended, or would the International Bureau not know this because it would have been extended in the Written Opinion?

Section 3.1: 30th instead of 25th month.

Section 3.3(i): nine instead of six months; (ii) delete?

Sections 4.10 - 4.13: mention of Rule 66.8(a) should be made in more detail than "in the prescribed manner"? Include some statement such as that in Section 5.4 of this Chapter or move 5.4 to 4.13 or 4.14?

Section 7.19, 3rd from last line: should "than" be --then--?

Section 9.3: does the next-to-last clause, "the . . . paragraph 5.6);" mean that if Form PCT/IPEA/405 is mailed, the examiner should examine the main invention while waiting to see if the applicant is going to restrict or pay additional fees, or should the examiner always wait until the period for response to the 405 has expired to begin examination, in case the applicant restricts his claims to other than what the examiner considers to be the main invention?

General:

Additionally, comment should be provided by examiners who set up the procedures for international preliminary examination in the USPTO.

Jane Corrigan
Manager, PCT International Services Division

Europäisches Patentamt | European Patent Office | Office européen des brevets

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Mr. Arpad BOGSCH
Director General
World Intellectual Property Organization
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Zeichen / Reference / Référence: 57.8.12 LG/ka

Datum / Date / Date: - 6. Nov. 1987

Subject: Circular C.326/PCT 211

Sir,

I refer to your Circular C.326/PCT 211, dated 26 February 1987.

I have pleasure in enclosing the proposals and comments of the EPO relating to the amendment of the present Guidelines for International Search (Part I of the EPO document enclosed herewith) and to the amendment of the present Guidelines for International Preliminary Examination (see Part II of the EPO document).

We send for information a copy of these proposals and comments to our partners in the Trilateral Cooperation and to the national offices of our Contracting States acting as International Searching Authorities and/or International Preliminary Examining Authority.

Yours sincerely,

pp J. Rlz

P.C.M. Zwartkruis
Vice-President

000003

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PART II

EPO proposals relating to the revision of Chapter II PCT Examination Guidelines (PCT/INT/6)

SECTION I

Introductory remarks

1. General scope of the EPO's proposals

1.1 The PCT provisions relating to patentability and to the content of the international application are almost word for word the same as the EPC provisions. The reason is that at the time both treaties were drafted the Strasbourg Convention criteria were considered acceptable as international standards. Consequently, the original Guidelines for International Examination (PCT/INT/6) were also drawn up in harmony with the EPC Guidelines for substantive examination.

1.2 In formulating its proposals relating to the revision of Document PCT/INT/6, as contained in Section II (Amendments to existing paragraphs) and Section III (new paragraphs) enclosed herewith, the EPO considered that the original idea of aligning as much as possible the PCT and EPC Guidelines was to be followed. Consequently, Sections I and II reflect the amendments which are suggested for the purpose of taking into account the results of the ten years' activity of the EPO.

In Sections I and II each proposal refers to a relevant current Guideline in PCT/INT/6 as indicated in the margin. Where necessary a specific comment is added in the margin to explain why the proposal differs from the current wording of the corresponding EPO Guideline, Chapter C.

1.3 Because "Unity of invention" and "Inventive step" are subject-matters dealt with in trilateral co-operation between the EPO, JPO and USPTO and by the WIPO Committee of experts on harmonisation, the EPO reserves the right to restate its position regarding these matters at a later date.

2. Additional matters for consideration

2.1 Amendments deriving from modification of the PCT Article 39 and Regulations after the Washington Conference

The EPO noticed the following items in PCT/INT/6 which need to be amended in order to conform with the amendments to PCT Article 39 and the Regulations under the PCT.

I, 1.5 and 3.3 consistency with the current state of PCT and Regulations
II, 1.2 deletion of R. 53(1)(d)
II, 4.15 deletion of R. 10.1(c)
III, 3.5 consistency with R. 6.4(a) as amended (new sentence added)
V, 3.3 consistency with amended R. 66.7
VI, 3 consistency with amended Art. 39 and R. 69
VI, 4.5, 4.6 deletion of R. 55.2
VI, 4.9 deletion of R. 66.7(c)
VI, 7.5 consistency with amended R. 52.2
VI, 7.14 - 7.16 consistency with amended R. 91.1
VI, 8.5 consistency with amended R. 70

.../...

2.2 Cross-references

In general the PCT Guidelines make cross-references to other parts of the Guidelines in the following manner: "Chapter III, paragraph 2.2", instead of "III, 2.2", as used in the proposed amendments (see page 1, II. 4.4).

The EPO suggests that for the sake of clarity and conciseness its proposed method of citing references, which is similar to that of the EPO Guidelines, be adopted.

2.3 Addition of an annex to Chapter II,4 of the PCT Guidelines

Part C, Chapter II of the EPC Guidelines for Examination contains an Annex 1 which defines SI units (copy attached herewith). This annex is based on EEC Directives 76/770/EEC and 71/354/EEC which, of course, have no binding effect on PCT Contracting States outside the EEC. Nevertheless, the annex contains a great deal of helpful information concerning the use and definition of SI units and could usefully be incorporated into the PCT Guidelines as an annex to Chapter II.

2.4 Micro-organisms

Examination of international applications relating to or involving the use of a micro-organism poses a problem because there are no harmonised criteria as to substantive subject-matter, e.g.

a) Need for deposit in relation to sufficiency of disclosures (EPO Guidelines, C-II, 6.1, C-II, 6.2).

.../...

b) Was the deposit made at the right depositary institution in accordance with the right legal provisions (EPO Guidelines, C-II, 6.3(ii))?

c) Does the application contain the prescribed information on the characteristics of the micro-organism (EPO Guidelines, C-II, 6.3(i))?

d) Patentability of micro-organisms per se (EPO Guidelines, C-IV, 3.5).

e) Sufficiency of disclosure satisfied by deposit in the case of claims directed to the micro-organism per se (EPO Guidelines, C-IV, 3.6).

The EPO suggests that the possibility of establishing basic international standards be studied with a view to guaranteeing a meaningful examination of biotechnology-related international applications.

Simple incorporation of Rule 13bis would not be sufficient as this rule offers only a framework permitting a broad variety of formal requirements to be fulfilled during the international phase.

It is suggested that this question be co-ordinated with the on-going travaux of the WIPO Committee of experts on biotechnology-related inventions and with the EPO/JPO/USPTO project on harmonisation in the field of biotechnology-related inventions.

.../...

2.5 Medical use-type claims

Insofar as the EPO as an IPEA is concerned and in accordance with PCT Rule 67.1(iv), methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human and animal body are excluded from international preliminary examination.

This practice is based on Article 52(4) EPC, which excludes medical methods from patentability because they are not susceptible of industrial application.

Additionally, Article 54(5) EPC provides for exceptional treatment of what are known as first medical use inventions.

EPO Guidelines, C-IV, 4.2 explain current practice with regard to examination of medical use-type claims under the EPC.

Because the current PCT Guidelines do not deal with this question that is specific to the EPC the EPO has drawn up internal instructions for examiners dealing with such cases (copy attached as Annex 2) with a view to establishing a basis for a meaningful preliminary examination, having regard to the subsequent national phase of the application.

Although this subject-matter should not be included in the PCT Guidelines it could possibly appear as an annex, specific to the EPO, to Chapter IV, 2.4(d).

Annex 1 to Part II

COUNCIL DIRECTIVE

of 27 July 1976

amending Directive 71/354/EEC on the approximation of the laws of the Member States relating to units of measurement

(76/770/EEC)

ANNEX

LIST OF CONTENTS

1) Published in Official Journal of the European Communities No L 262 of 27 September 1976

CHAPTER A

UNITS OF MEASUREMENT THE USE OF WHICH MUST BE MADE MANDATORY AS FROM 21 APRIL 1978 AT THE LATEST

I. SI UNITS AND THEIR DECIMAL MULTIPLES AND SUBMULTIPLES

1.1. SI base units

Quantity	Unit	
	Name	Symbol
Length	metre	m
Mass	kilogramme	kg
Time	second	s
Electric current	ampere	A
Thermodynamic temperature	kelvin	K
Amount of substance	mole	mol
Luminous intensity	candela	cd

Definitions of SI base units:

Unit of length

The metre is the length equal to 1 650 763·73 wavelengths in vacuum of the radiation corresponding to the transition between the levels $2p_{10}$ and $5d_5$ of the krypton 86 atom.

(Eleventh CGPM (1960), resolution 6).

Unit of mass

The kilogramme is the unit of mass; it is equal to the mass of the international prototype of the kilogramme.

(Third CGPM (1901), page 70 of the conference report).

Unit of time

The second is the duration of 9 192 631 770 periods of the radiation corresponding to the transition between the two hyperfine levels of the ground state of the caesium 133 atom.

(Thirteenth CGPM (1967), resolution 1).

Unit of electric current

The ampere is that constant current which if maintained in two straight parallel conductors of infinite length, of negligible circular cross-section and placed one metre apart in a vacuum, would produce between these conductors a force equal to 2×10^{-7} newton per metre of length.

(CIPM (1946), resolution 2, approved by the ninth CGPM (1948)).

Unit of thermodynamic temperature

The kelvin, unit of thermodynamic temperature, is the fraction 1/273·16 of the thermodynamic temperature of the triple point of water.

(Thirteenth CGPM (1967), resolution 4).

Unit of amount of substance

The mole is the amount of substance of a system which contains as many elementary entities as there are atoms in 0·012 kg of carbon 12.

When the mole is used the elementary entities must be specified and may be atoms, molecules, ions, electrons, other particles or specified groups of such particles.

(Fourteenth CGPM (1971), resolution 3).

Unit of luminous intensity

The candela is the luminous intensity, in the perpendicular direction, of a surface of 1/600 000 m^2 of a black body at the temperature of freezing platinum under a pressure of 101 325 newtons/m^2.

(Thirteenth CGPM (1967), resolution 5).

1.1.1. Special name and symbol of the SI unit of temperature for expressing Celsius temperature

Quantity	Unit	
	Name	Symbol
Celsius temperature	degree Celsius	°C

Celsius temperature t is defined as the difference $t = T - T_0$ between the two thermodynamic temperatures T and T_0, where $T_0 = 273{\cdot}15$ kelvins. An interval of or difference in temperature may be expressed either in kelvins or in degrees Celsius. The unit of 'degree Celsius' is equal to the unit 'kelvin'.

1.2. Other SI units

1.2.1. Supplementary SI units

Quantity	Unit	
	Name	Symbol
Plane angle	radian	rad
Solid angle	steradian	sr

(Eleventh CGPM, 1960, resolution 12).

Definitions of supplementary SI units:

Plane angle unit

The radian is the plane angle between two radii which, on the circumference of a circle, cut an arc equal in length to the radius.

(ISO recommendation R 31, Part I, second edition, December 1965).

Solid angle unit

The steradian is the solid angle which has its apex at the centre of a sphere and which describes on the surface of the sphere an area equal to that of a square having as its side the radius of the sphere.

(ISO recommendation R 31, Part I, second edition, December 1965).

1.2.2. Derived SI units

Units derived coherently from SI base units and supplementary SI units are given as algebraic expressions in the form of products of powers of the SI base units and/or supplementary SI units with a numerical factor equal to 1.

1.2.3. Derived SI units having names and symbols

Quantity	Unit		Expression	
	Name	Symbol	In other SI units	In terms of base or supplementary SI units
Frequency	hertz	Hz		s^{-1}
Force	newton	N		$m \cdot kg \cdot s^{-2}$
Pressure, stress	pascal	Pa	$N \cdot m^{-2}$	$m^{-1} \cdot kg \cdot s^{-2}$
Energy, work, quantity of heat	joule	J	$N \cdot m$	$m^2 \cdot kg \cdot s^{-2}$
Power (1)	watt	W	$J \cdot s^{-1}$	$m^2 \cdot kg \cdot s^{-3}$
Quantity of electricity, electric charge	coulomb	C		$s \cdot A$
Electric tension, electric potential, electromotive force	volt	V	$W \cdot A^{-1}$	$m^2 \cdot kg \cdot s^{-3} \cdot A^{-1}$
Electric resistance	ohm	Ω	$V \cdot A^{-1}$	$m^2 \cdot kg \cdot s^{-3} \cdot A^{-2}$
Electric conductance	siemens	S	$A \cdot V^{-1}$	$m^{-2} \cdot kg^{-1} \cdot s^3 \cdot A^2$
Electric capacitance	farad	F	$C \cdot V^{-1}$	$m^{-2} \cdot kg^{-1} \cdot s^4 \cdot A^2$
Magnetic flux	weber	Wb	$V \cdot s$	$m^2 \cdot kg \cdot s^{-2} \cdot A^{-1}$
Magnetic flux density	tesla	T	$Wb \cdot m^{-2}$	$kg \cdot s^{-2} \cdot A^{-1}$
Electric inductance	henry	H	$Wb \cdot A^{-1}$	$m^2 \cdot kg \cdot s^{-2} \cdot A^{-2}$
Luminous flux	lumen	lm		$cd \cdot sr$
Illuminance	lux	lx	$lm \cdot m^{-2}$	$m^{-2} \cdot cd \cdot sr$
Activity	becquerel	Bq		s^{-1}
Absorbed dose (2)	gray	Gy	$J \cdot kg^{-1}$	$m^2 \cdot s^{-2}$

(1) Special names for the unit of power: the name volt-ampere (symbol 'VA') when it is used to express the apparent power of alternating electric current, and var (symbol 'var') when it is used to express reactive electric power. The 'var' is not included in CGPM resolutions.
(2) And other quantities of ionizing radiations of the same dimensions.

Units derived from SI base units may be expressed in terms of the units listed in Chapter A.

In particular, derived SI units may be expressed by the special names and symbols given in the above table; for example, the SI unit of dynamic viscosity may be expressed as $m^{-1} \cdot kg \cdot s^{-1}$ or $N \cdot s \cdot m^{-2}$ or $Pa \cdot s$.

1.3. Prefixes and their symbols used to designate certain decimal multiples and submultiples

Factor	Prefix	Symbol	Factor	Prefix	Symbol
10^{18}	exa	E	10^{-1}	deci	d
10^{15}	peta	P	10^{-2}	centi	c
10^{12}	tera	T	10^{-3}	milli	m
10^{9}	giga	G	10^{-6}	micro	μ
10^{6}	mega	M	10^{-9}	nano	n
10^{3}	kilo	k	10^{-12}	pico	p
10^{2}	hecto	h	10^{-15}	femto	f
10^{1}	deca	da	10^{-18}	atto	a

The names and symbols of the decimal multiples and submultiples of the unit of mass are formed by attaching prefixes to the word 'gramme' and their symbols to the symbol 'g'.

Where a derived unit is expressed as a fraction, its decimal multiples and submultiples may be designated by attaching a prefix to units in the numerator or the denominator, or in both these parts.

Compound prefixes, that is to say prefixes formed by the juxtaposition of several of the above prefixes, may not be used.

1.4. Special authorized names and symbols

1.4.1. Special names and symbols of decimal multiples and submultiples of SI units

Quantity	Unit		
	Name	Symbol	Value
Volume	litre	l	$1\ l = 1\ dm^3 = 10^{-3}\ m^3$
Mass	metric ton	t	$1\ t = 1\ Mg = 10^3\ kg$
Pressure, stress	bar	bar	$1\ bar = 10^5\ Pa$

1.4.2. Special names and symbols of decimal multiples and submultiples of SI units which may be used only in specialized fields

Quantity	Unit		
	Name	Symbol	Value
Area of farmland and building land	are	a	$1\ a = 10^2\ m^2$
Mass per unit length of textile yarns and threads	tex* (*)	tex*	$1\ tex = 10^{-6}\ kg \cdot m^{-1}$

(*) The character * after a unit name or symbol indicates that these do not appear in the lists drawn up by the CGPM, CIPM, or BIPM. This applies to the whole of this Annex.

Note: The prefixes and their symbols listed in 1.3 may be used in conjunction with the units and symbols contained in Tables 1.4.1 and 1.4.2.

The multiple 10^2 a is, however, called a 'hectare'.

2. UNITS WHICH ARE DEFINED ON THE BASIS OF SI UNITS BUT ARE NOT DECIMAL MULTIPLES OR SUBMULTIPLES THEREOF

Quantity	Unit		
	Name	Symbol	Value
Plane angle	revolution* (a)		1 revolution = 2π rad
	grade* or gon*	gon *	1 gon = $\frac{\pi}{200}$ rad
	degree	°	$1° = \frac{\pi}{180}$ rad
	minute of angle	′	$1′ = \frac{\pi}{10\,800}$ rad
	second of angle	″	$1″ = \frac{\pi}{648\,000}$ rad
Time	minute	min	1 min = 60 s
	hour	h	1 h = 3 600 s
	day	d	1 d = 86 400 s

(a) No international symbol exists.

Note: The prefixes listed in 1.3 may only be used in conjunction with the names 'grade' or 'gon' and the symbols only with the symbol 'gon'.

3. UNITS DEFINED INDEPENDENTLY OF THE SEVEN SI BASE UNITS

The unified atomic mass unit is one-twelfth of the mass of an atom of the nuclide ^{12}C.

The electronvolt is the kinetic energy acquired by an electron passing in a vacuum from one point to another whose potential is one volt higher.

Quantity	Unit		
	Name	Symbol	Value
Mass	unified atomic mass unit	u	$1\ u \approx 1{\cdot}6605655 \times 10^{-27}$ kg
Energy	electronvolt	eV	$1eV \approx 1{\cdot}6021892 \times 10^{-19}$ J

The value of these units, expressed in SI units, is not exactly known.

The above values are taken from CODATA Bulletin No 11 of December 1973 of the International Council of Scientific Unions.

Note: The prefixes and their symbols listed in 1.3 may be used in conjunction with these two units and with their symbols.

4. UNITS AND NAMES OF UNITS PERMITTED IN SPECIALIZED FIELDS ONLY

Quantity	Unit	
	Name	Value
Vergency of optical systems	dioptre*	1 dioptre = 1 m^{-1}
Mass of precious stones	metric carat	1 metric carat = 2×10^{-4} kg

Note: The prefixes listed in 1.3 may be used in conjunction with the above units.

5. COMPOUND UNITS

Compound units are formed by combining the units mentioned in Chapter A.

Medical use-type claims

There are four basic types of claims involving known compositions or substances (A) in methods of treatment or diagnosis (hereinafter referred to as medical treatment) which can arise:

1.
Use of a composition (A) in medical treatment - or otherwise expressed, method of treatment using (A). According to the EPC this type of claim can be refused under Article 52(2) as it is not considered to be industrially applicable. The PCT, Rule 67.1.iv, on the other hand, provides that such claims should be excluded from the international preliminary examination.

2.
Composition (A) for first use in medical treatment. The EPC, Articles 52(4) and 54(5) permits such purpose limited product claims.

3.
Composition (A) for second and further uses in medical treatment. such a claim, on present case law, (decision of the Enlarged Board of Appeal 1984, Gr 05/83), is not permissible under the EPC.

4.
Use of composition (A) for the manufacture of a medicament for a new medical treatment. This is the appropriate type of claim for protecting second and further medical uses under the EPC and was found allowable in the above referred-to decision.

.../...

It is therefore important to avoid giving a negative judgement, particularly on novelty and inventive step, especially where it is clear that a later EURO-PCT application containing claims of the types 2 and 4 would be found allowable. Where the claim is a genuine product claim clearly lacking novelty on the basis of the cited prior art or is of the type 1, the applicant should be given the opportunity to recast the claim in use or purpose limited form (types 2 and 4). Provided that such use were found novel and inventive, a positive statement on these grounds should then be made in the Preliminary Examination Report, but judgement reserved on industrial application.

The following statement should be made in the report on claims presented in any of the above forms 1-4.

"For the assessment of the presently worded claims on the question whether they are industrially applicable no unified criteria exist in the PCT. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognise as industrially applicable claims to the use of a compound in medical treatment, but will allow however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment."

SECTION II

PCT Examination Guidelines - Amendments to Existing Paragraphs

No	Amendment
I.1.4, line 18) I.1.5, lines 4,8)	25th month 30th month
II.2.2, line 8	delete "to the description"
II.4.4	Replace by: **4.4** The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims (see III, 2.2). The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, should be required, where necessary, to put the invention into proper perspective. For instance while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examiner should require a reference to these documents and a brief summary of the relevant contents. The subsequent inclusion of such a summary in the description does not contravene Article 34(2)(b). The latter merely lays down that, if the application is amended, for example by limiting it in the light of additional information on the background art, its subject-matter must not extend beyond the content of the application as filed. But the subject-matter of the application within the meaning of Article 34(2)(b) is to be understood - starting off from the prior art - as comprising those features which, in the framework of the disclosure required by Article 5, relate to the invention (see also VI, 7.8). References to the prior art introduced after filing must be purely factual. Any alleged advantages of the invention must be adjusted if necessary in the light of the prior art. New statements of advantage are permissible provided that they do not introduce into the description matter which could not have been deduced from the application as originally filed (see VI, 7.9).

No.	Amendment
II.4.6	To read: **4.6** The invention as claimed should be disclosed in such a way that the technical problem, or problems, with which it deals can be appareciated and the solution can be understood. To meet this requirement, only such details should be included as are necessary for elucidating the invention. In cases where the subject-matter of a dependent calim can be understood either by the wording of the claim itself or by the description of a way of performing the invention, no additional explnation of this subject-matter will be necessary. A mention in the description that a particular embodiment of the invention is set out in the dependent claim will then be sufficient. Where in the invention lies in realising what the problem is (see IV, 4.8(i)), this should be apparent, and, where the means of solving the problem (once realised) are obvious, the details given of its solution may, in practice, be minimal. When there is doubt, however, as to whether certain details are necessary, the examiner should not insist on their excision. It is not necessary, moreover, that the invention be presented explicitly in problem and solution form. Any advantageous effects which the applicant considers the invention to have in relation to the prior art should be stated, but this should not be done in such a way as to disparage any particular prior product or process. Furthermore, neither the prior art nor the applicant's invention should be referred to in a manner likely to mislead. This might be done, e.g. by an ambiguous presentation which gives the impression that the prior art had solved less of the problem than was actually the case. Fair comment as referred to in II, 6.2 is, however, permitted. Regarding amendment to, or addition of, a statement of problem, see VI, 7.12b.
II.4.8, last line	Add: The reverse situation should never occur, i.e. all reference numbers or signs used in the description of claims must also appear on the drawings.
II.4.17	Replace lines 1-14 "References... date." by the following: References in international applications to other documents may relate either to the background art or to part of the disclosure of the invention. Where the reference relates to the background art, it may be in the application as originally filed or introduced at a later date (see II, 4.4 and 4.5). Where the reference relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus) then, if it is to be taken into account in respect of Article 5, it must be in the

No.	Amendment
	application as originally filed and clearly identify the document referred to in such a manner that the document can be easily retrieved. If matter in the document referred to is essential to satisfy the requirements of Article 5, at least a summary of this matter should be incorporated expressis verbis in the description, because the patent specification should, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document.
II.6.3	To read: 6.3 The fourth category is irrelevant matter. It should be noted however that such matter is specifically prohibited under the Rule only if it is **"obviously irrelevent or unnecessary"**, for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art (see also II, 4.5). The matter to be removed may already be obviously irrelevant or unnecessary in the original description. It may, however, be matter which has become obviously irrelevant or unnecessary only in the course of the examination proceedings, e.g. owing to a limitation of the claims of the patent to one of originally several alternatives.
Last sentence of EPC Guidelines II 7.4 not necessary	
III.3.3	Delete example (3). Then add: A further example is when the invention resides in a group of new chemical compounds and there are a number of processes for the manufacture of such compounds
III.3.5	Having regard to the last two sentences of Rule 6.4(a), the examiner should not interpret the foregoing provisions of Rule 6.4(a) more restrictively than in the case of national applications.
III.3.6	Add, as last sentence: In general, however, when no objections are raised against the corresponding independent claim, the examiner should not concern himself unduly with the subject-matter of dependent claims, provided he is satisfied that they are truly dependent and thus in no way extend the scope of protection of the invention defined in the corresponding independent claim (see III, 3.7a).

.../...

No.	Amendment
III.4.2	Add, as last sentence: Such a reading may involve a departure from the strict literal meaning of the wording of the claims.
III.4.3 Article 69 EPC is irrelevant	4.3 Any inconsistency between the description and the claims should be avoided if it may throw doubt on the extent of protection sought and therefore render the claim unclear. Such inconsistency can be of the following kinds: (a) Simple verbal inconsistency. For example, there is a statement in the description which suggests that the invention is limited to a particular feature but the claims are not so limited; also, the description places no particular emphasis on this feature and there is no reason for believing that the feature is essential for the performance of the invention. In such a case the inconsistency can be removed either by broadening the description or by limiting the claims. Similarly, if the claims are more limited than the description, the claims may be broadened or the description may be limited. (b) Inconsistency regarding apparently essential features. For example, it may appear, either from general technical knowledge or from what is stated or implied in the description, that a certain described technical feature not mentioned in an independent claim is essential to the performance of the invention, or in other words is necessary for the solution of the problem to which the invention relates. In such a case the claim is unclear, because Article 6 when read in conjunction with Rule 6, paragraphs 3 and 4, has to be interpreted as meaning not only that an independent claim must be comprehensible from a technical point of view but also that it must define clearly the object of the invention; that is to say indicate all the essential features thereof. If, in response to this objection, the applicant shows convincingly, e.g. by means of additional documents or other evidence, that the feature is not in fact essential, he may be allowed to retain the unamended claim and, where necessary, to amend the description instead. The opposite situation in which an independent claim includes features which do not seem essential for the performance of the invention is not objectionable. This is a matter of the applicant's choice. The examiner should therefore not suggest that a claim be broadened by the omission of apparently inessential features, except possibly in cases where the applicant is not assisted by a professional representative.
Appeal Board Decision unnecessary	
	(c) Part of the subject-matter of the description and/or drawings is not covered by the claims. For example, the claims all specify an electric circuit

.../...

No.	Amendment
	employing semi-conductor devices but one of the embodiments in the description and drawings employs electronic tubes instead. In such a case, the inconsistency can normally be removed either by broadening the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter from the description and drawings. However, if examples in the description and/or drawings which are not covered by the claims, are presented, not as embodiments of the invention, but as background art or examples which are useful for understanding the invention, the retention of these examples may be allowed.
III. 4.5	This section is to be expanded follows: 4.5 It is preferable not to use a relative or similar term such as "thin", "wide" or "strong" in a claim unless the term has a well-recognised meaning in the particular art, e.g. "high-frequency" in relation to an amplifier, and this is the meaning intended. Where the term has no well-recognised meaning it should if possible be replaced by a more precise wording found elsewhere in the original disclosure. Where there is no basis in the disclosure for a clear definition, and the term is not essential having regard to the invention, it should normally be retained in the claim, because to excise it would generally lead to an extension of the subject-matter beyond the content of the application as filed - in contravention of Article 34(2)(b). However an unclear term cannot be allowed in a claim if the term is essential having regard to the invention. Equally, an unclear term cannot be used by the applicant to distinguish his invention from the prior art.
C.III.4.7	4.7 The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention, or a feature thereof, by a result to be achieved should be objected to. However, no objection should be raised if the invention can only be defined in such terms and if the result is one which can be directly and positvely verified by tests of procedures adequately specified in the description and involving nothing more than trial and error. For example, the invention may relate to an ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary considerably in a manner difficult to define whilst still providing the desired effect. So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be

.../...

No.	Amendment
	achieved, provided that the specification includes adequate directions to enable the reader to determine the required dimensions by routine test procedures.
III.4.8	From "Similarly" in line 10 to read as follows: Similarly a claim to a substance or composition for a particular use should be construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which is per se the same as the substance or composition defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty, but if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use it would deprive the claim of novelty.
Reference in EPCG III,4.8 to IV.4.2 not necessary	
III.4.9	Add a new paragraph: Thus a claim of the form indicated should not be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use of an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit".
III.5.1	Add at end of paragraph: As for dependent claims, while there is no objection to a reasonable number of such claims directed to particular preferred features of the invention, the examiner should object to a multiplicity of claims of a trivial nature.
II.6.3	To read: As a general rule, a claim should be regarded as supported by the description unless exceptionally there are well-founded reasons for believing that the skilled man would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must however be of a technical character; vague statements or assertions having no technical content provide no basis.

.../...

No.	Amendment
	Since the examiner should raise an objection of lack of support only if he has well-founded reasons, it follows that the applicant should be given the benefit of the doubt. Where objection is raised, the reasons should preferably be supported specifically by a published document.
III.6.4	To read: The question of support is illustrated by the following examples: (a) A claim relates to a process for treating all kinds of "plant seedlings" by subjecting them to a controlled cold shock so as to produce specified results, whereas the description discloses the process applied to one kind of plant only. Since it is well known that plants vary widely in their properties, there are well-founded reasons for believing that the process is not applicable to all plant seedlings. Unless the applicant can provide convincing evidence that the process is nevertheless generally applicable, he must restrict his claim to the particular kind of plant referred to in the description. A mere assertion that the process is applicable to all plant seedlings is not sufficient. (b) A claim relates to a specified method of treating "synthetic resin mouldings" to obtain certain changes in physical characteristics. All the examples described relate to thermoplastic resins and the method is such as to appear inappropriate to thermosetting resins. Unless the applicant can provide evidence that the method is nevertheless applicable to thermosetting resins, he must restrict his claim to thermoplastic resins. It should be noted that, although an objection of lack of support is an objection under Article 6, it can often, as in the above examples, also be considered as an objection of insufficient disclosure of the invention under Article 5, the objection being that the disclosure is insufficient to enable the skilled person to carry out the "invention" over the whole of the broad field claimed (although sufficient in respect of a narrower "invention").
Reference in EPCG III 6.4 to Opposition Proceedings irrelevant	

No.	Amendment
III.7.7 Minor difference between EPCG and PCTG insignificant	Add new paragraph at the end: As another example, suppose that the main claim defines a process for the preparation of a product A starting from a product B and the second claim reads: Process according to Claim 1 characterised by producing B by a reaction using the product C. In this case, too, no objection arises under Rule 13(1), whether or not the process for preparation of B from C is novel and inventive, since Claim 2 contains all the features of Claim 1. The subject-matter of Claim 2 therefore falls within Claim 1.
IV.2.4(b)	After "radiation." in line 13 replace the following sentences by: The treatment of soil by technical means to suppress or promote the growth of plants is also not excluded. The exclusion referred to above does not apply to <u>microbiological processes or the products thereof</u>. The term "microbiological process" is to be interpreted as covering not only industrial processes using micro-organisms but also processes for producing micro-organisms, e.g. by genetic engineering. The product of a microbiological process may also be subject to an international preliminary examination (product claim). Propagation of the micro-organism itself is to be construed as a microbiological process for the purposes of Rule 67.1(ii); consequently, the micro-organism can be protected per se as it is a product obtained by a microbiological process. The term micro-organism covers plasmids and viruses also. In the case of microbiological processes, particular regard should be had to the requirement of repeatability referred to in II.4.1 1. As for micro-organisms deposited under the terms of Rule 13 bis repeatability is assured by the possibility of taking samples and there is thus no need to indicate another process for the production of the micro-organism.
Reference to patentability in EPCG incorrect for PCT	
IV.2.4(e)	Replace by: **Mere Presentations of information** Any representation of information characterised solely by the content of the information would be excluded under Rule 67. This applies whether the claim is directed to the presentation of the information <u>per se</u> (e.g. by accoustical signals, spoken words, visual displays), to information recorded on a carrier (e.g. books characterised by their subject, gramophone records characterised by the musical piece recorded,
Multiple references to 'patentable' in EPCG IV.2 amended	

No.	Amendment
	traffic signs characterised by the warning thereon, magnetic computer tapes characterised by the data or program recorded), or to processes and apparatus for presenting information (e.g. indicators or recorders characterised solely by the information indicated or recorded). If, however, the presentation of information has new technical features these should be examined if the subject-matter relates to the information carrier or to the process apparatus for presenting the information. The arrangement or manner of representation, as distinguished from the information content, may well constitute a technical feature requiring examination. Examples in which such a technical feature may be present are: a telegraph apparatus or communication system characterised by the use of a particular code to represent the characters (e.g. pulse code modulation); a measuring instrument designed to produce a particular form of graph for representing the measured information; a gramophone record characterised by a particular groove form to allow stereo recordings; or a diapositive with a sound-track arranged at the side of it.
IV.2.4(f)	Replace by:
As above	**Programs for computers** The basic considerations here are exactly the same as for the other exclusions listed in Rule 67. However a data-processing operation can be implemented either by means of a computer program or by means of special circuits, and the choice may have nothing to do with the inventive concept but be determined purely by factors of economy or practicality. With this point in mind, examination in this area should be guided by the following approach: A computer program claimed by itself or as a record on a carrier should not be examined irrespective of its content. The situation is not normally changed when the computer program is loaded into a known computer. If however the subject-matter as claimed makes a technical contribution to the known art, examination should not be denied merely on the ground that a computer program is involved in its implementation. This means, for example, that program-controlled machines and program-controlled manufacturing and control processes should normally be regarded as subject-matter on which an international preliminary examination can be carried out. It follows also that where the claimed subject-matter is concerned only with the program-controlled internal working of a known computer, the subject-matter could be examined if it provides a technical effect. As an example consider the case of a known data-processing system with a small fast working memory and a larger but slower further memory. Suppose that

No.	Amendment
	the two memories are organised under program control, in such a way that a process which needs more address space than the capacity of the fast working memory can be executed at substantially the same speed as if the process data were loaded entirely in that fast memory. The effect of the program in virtually extending the working memory is of a technical character and might therefore require examination. Where the invention depends on a technical effect, the claims must be so drafted as to include all the technical features of the invention which are essential for the technical effect. Where examination on such claims is carried out then, generally speaking, product, process and use claims should also be examined. See however in this context III.3.2 and 4.1. No International Preliminary Examination Authority is required to carry out an international preliminary examination on computer programs to the extent it is not equipped to carry out such examination.
IV.2.5	Replace by:
As above	It should be noted that PCT Rule 67.1(iv) (referred to in Chapter IV; paragraph 2.4, item (d)) excludes only treatment by surgery or therapy or diagnostic methods. It follows that other methods of treatment of live human beings or animals (e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool) or other methods of measuring or recording characteristics of the human or animal body are appropriate for international preliminary examination, provided that (as would probably be the case) such methods are of a technical, and not essentially biological character IV, (see IV, paragraph 2.4, item (b)). For example, an application containing claims directed to the cosmetic treatment of a human by administration of a chemical product should be examined. An international preliminary examination on a cosmetic treatment involving surgery should not however by carried out (see below). A treatment or diagnostic method, to be excluded, must actually be carried out on the living human or animal body. A treatment of or diagnostic method practised on a dead human or animal body would therefore not be excluded from international preliminary examination by virtue of Rule 67.1(iv). Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon would not be excluded insofar as these tissues or fluids are not returned to the same body. Thus the
Taken from EPOG 4.3	

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	treatment of blood for storage in a blood bank or diagnostic testing of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body would be excluded. Diagnostic methods comprise the carrying out of an investigation for medical purposes into the state of a human or animal body, so that a method of measuring the blood pressure of a body or a method of obtaining information regarding the internal state of a body by passing X-rays through the body would be excluded from international preliminary examination. A treatment by therapy implies the curing of a disease or malfunction of the body; prophylactic methods, e.g. immunisation, are considered to be therapeutic treatments and thus excluded. Surgery is not limited to healing treatments, being more indicative of the nature of the treatment; methods of cosmetic surgery are thus excluded.
IV.2.6	To be added at end as separate paragraph: For the application of Rule 67, the examiner shall not interpret the relevant criteria more restrictively than in the case of national applications.
IV.7.1	Add at end new paragraph:
Appeal Board Decision	However, if a document (the "primary" document) refers explicitly to another document (e.g. as providing more detailed information on certain features), the teaching of the latter may be regarded as incorporated into the document containing the reference. Equally, it is permissible to use a dictionary or similar document of reference in order to interpret a special term used in the primary document.
IV.7.2	Replace by:
	7.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the documents; this is a matter of obviousness.

No.	Amendment
IV.7.3	Replace by:
EPCG IV 7.3, reference to Article 54(3) is irrelevant	**7.3** In determining novelty, a prior document should be read as it would have been read by a person skilled in the art on the effective date of the document. By "effective" date is meant the publication date in the case of a previously published document. However, it should be noted that a chemical compound, the name of formula of which was mentioned in a document, is not considered as known unless the information in the document, together, where appropriate, with knowledge generally available on the effective date of the document, enable it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.
IV.7.4	Replace by:
	7.4 In considering novelty it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.
IV.8.6	Add after "experimentation" in line 7:
Reference to Appeal Board Decision irrelevant (EPCG 9.6)	If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability.
IV.8.8 (A1) (iv)	Add after "use" in line 3: (analogous substitution).
IV.8.8 (A1) (v)	Add after "situation" in line 2: (analogous use).

No.	Amendment
V.1.4	Replace by:
References to "European" amended to "international" (see EPCG V, 1.4)	**1.4** Normally (except as explained in V.1.4(a)) the filing date of the "first application" must be claimed as a priority, i.e. the application disclosing for the first time any or all of the subject-matter of the international application. If it is found that the application to which the priority claim is directed is in fact not the first application in the above sense, but some or all of the subject-matter was disclosed in a still earlier application originating from the same inventor, the priority claim is invalid as far as the subject-matter was already disclosed in the still earlier application. To the extent the priority claim is invalid, the effective date of the international application is the date of its filing. The previously disclosed subject-matter of the international application is not novel, if the still earlier application referred to above was published prior to the effective date of the international application.
V.1.5	In line 6, replace "includes" by "discloses".
V.2.1	Add, after "cases", in line 14: (i.e. cases where the art in question would be relevant if of earlier date).
V.2.4	Replace by: **2.4** The basic test to determine whether a claim is entitled to the date of a priority document is the same as the test of whether an amendment to an application satisfies the requirement of Article 34(2)(b). That is to say for the priority date to be allowed, the subject-matter of the claim must be derivable directly and unambiguously from the disclosure of the invention in the priority document, when account is taken of any features implicit to a person skilled in the art in what is expressly mentioned in the document. As an example of an implicit disclosure, a claim to apparatus including "releasable fastening means" would be entitled to the priority date of a disclosure of that apparatus in which the relevant fastening element was, say, a nut and bolt, or a spring catch or a toggle-operated latch, provided the general concept of "releasable" is implicit in the disclosure of such element.

No.	Amendment
VI.3.1	Line 15: amend "25th" to "30th".
VI.3.3 Has no equivalent, of course, in EPCG. Proposed new paragraph to take account of change in Rule 69.	Replace by: The time limit for the establishment of the international preliminary examination report is the same for all International Preliminary Examining Authorities and is set out in the agreement between each Authority and the International Bureau (see Chapter VI, paragraph 1.2). This time limit may not exceed: (i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date: (ii) nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.
VI.4.1 to 4.3	delete.
VI.7.9	Replace by: **7.9** An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art in what has
Reference to Appeal Board Decision (EPCG IV 5.4)	been expressly mentioned. The test for additional subject-matter therefore corresponds to the test for novelty given in IV, 7.2.
VI.8.1	Line 5: amend "eventually" to "possibly".

SECTION III

PCT Examination Guidelines - Additional Paragraphs

No.	Text of New paragraph
II..4.6a Adapted to meet requirement of Decision in T26/81, OJ 6/1982, page 211(see EPCG II.4.6a)	If the examiner comes to the conclusion that an independent claim defines an inventive step it must be possible to derive a technical problem from the application. In this case the requirement of Rule page 211 5.1(a)(iii) is fulfilled. Inventive step considered as a step from the technical problem to its solution. In other words, whether the condition of Rule 5.1(a)(iii) is fulfilled will have to be judged in relation to or as consequence of the examination of the pertinent claim in respect of novelty and inventive step and this condition cannot be set up as a separate formal requirement independent of inventiveness.
II.4.9a	**4.9a** In order that the requirements of Article 5 and of Rule 5.1(a)(iii) and 5.1(a)(v) may be fully satisfied, it is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed, in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.
II.4.14a	**4.14a** In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention. The description, as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by those skilled in the art who are deemed not to be programming specialists. Short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention.
III.2.3a	When examining whether or not a claim is to be put in the form provided by Rule 6.3(b), it is important to assess whether this form is "appropriate". In this respect it should be borne in mind that the purpose of the two-part form of claim is to allow the reader to see clearly which features necessary for the definition of the claimed subject-matter are, in combination, part of the prior art. If this is sufficiently clear from the indication of prior art made in the description, to meet the requirement of Rule 5.1(a)(ii) the two-part form of claim should not be insisted on.

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No.	Text of New Paragraph
III.3.6a	**3.6a** If the two-part form is used for the independent claim(s), dependent claims may relate to further details of features not only of the characterising portion but also of the preamble.
III.3.7a	**3.7a** A claim may also contain a reference to another claim even if it is not a dependent claim as defined in Rule 6, paragraph 4. One example of this is a claim referring to a claim of different category (e.g. "Apparatus for carrying out the process of Claim 1...", or "Process for the manufacture of the product of Claim 1..."). Similarly, in a situation like the plug and socket example of III, 3.3, a claim to the one part referring to the other co-operating part (e.g. "plug for cooperation with the socket of Claim 1...") is not a dependent claim. References from one claim to another may also occur where alternative features which may be substituted for one another are claimed in separate claims. Thus there may be a first independent Claim 1 for a machine including, inter alia, a feature X followed by further claims for alternatives such as "A machine according to Claim 1 modified in that feature X is replaced by feature Y". In all these examples, the examiner should carefully consider the extent to which the claim containing the reference necessary involves the features of the claim referred to and the extent to which it does not. In the case of a claim for a process which results in the product of a product claim or a claim for the use of that product, if the product claim does not give rise to objections on novelty or inventive step grounds, then no separate examination for the obviousness of the process or use claim is necessary (see IV.8.5a). In all other instances, the fact that the claim referred to contains novel and inventive matter does not necessarily imply that the same is also true of the independent claim containing the reference.
Amended due to EPCG III 3.7a references to patentability	
III.4.3a	**4.3a** General statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined why should be objected to. In particular, objection should be raised to any statement which refers to the extent of protection being expanded to cover the "spirit" of the invention; objection should likewise be raised, in the case where the claims are directed to a combination of features, to any statement which seems to imply that protection is nevertheless sought not only for the combiantion as a whole but also for individual features of sub-combinations thereof.

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No.	Text of New Paragraph
III.4.5a	**4.5a** Particular attention is required whenever the word "about" or similar terms such as "approximately" are used. Such a word may be applied, for example, to a particular value (e.g. "about 200°C") or to a range (e.g. "about x to about y"). In each case, the examiner should use his judgment as to whether the meaning is sufficiently clear in the context of the application read as a whole. However, the word can only be permitted if its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to novelty and inventive step.
III.4.5b	**4.5b** The examiner should invite the applicant to remove trademarks and similar expressions in claims unless their use is unavoidable; they may be allowed exceptionally if they are generally recognised as having a precise means (see also II, 4.16 and 4.17).
III.4.7a	**4.7a** Where the invention relates to a chemical compound it may be characterised in a claim in various ways, viz., by its chemical formula, as a product of a process or exceptionally by its parameters. Characterisation of a chemical compound solely by its parameters should, as a general rule, not be allowed. It may, however, be allowable in those cases where the invention cannot be adequately defined in any other way. This can arise, e.g. in the case of macromolecular chains. But in such cases, only parameters usual in the art should be employed to characterise the compound. The examiner should be aware of the possibility that applicants may attempt to employ unusual parameters to disguise lack of novelty (see IV, 7.5).
III.4.7b Amended due to references in EPCG III 4.7b to "patentability"	**4.7b** Claims for products defined in terms of a process of manufacture are admissible only if the products as such are, inter alia, new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process. A claim defining a product in terms of a process is to be construed as a claim to the product as such and the claim should preferably take the form "Product X obtainable by process Y", or any wording equivalent thereto, rather than "Product X obtained by process Y".
III.4.8a	**4.8a** Where a claim for an apparatus seeks to define the invention by reference to features of the use to which the apparatus is to be put, a lack of clarity can result. For example a claim reading "A box for storing magnetic tape cassettes on end, characterised in that the stored cassettes project beyond the upper edges of

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No.	Text of New Paragraph
	the box to facilitate removal" is unclear since, though directed to a nox, it defines not a box per se but its relationship to cassettes. Such a claim must either make clear the size of the box, if desired by defining the size of the cassettes, or must be directed to a combination of box and cassettes, e.g. "A storage box containing magnetic tape cassettes on end...".
III.4.12	Generally, the subject-matter of a claim is defined by means of positive features. However, the extent of a claim may be limited by means of a "disclaimer"; in other words, an element clearly defined by technical features may be expressly excluded from the protection claimed, for example in order to meet the requirement of novelty. A disclaimer may be used only when the claim's remaining subject-matter cannot be defined more clearly and concisely by means of positive features.
Appeal Board Decision	
III.6.6	**6.6** Where certain subject-mater is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention (see II, 4.6).
III.7.4a	Objection of lack of unity does not normally arise because a claim contains a number of individual features in combination even if these are unrelated.
IV.1.2a	In addition to these basic three criteria, the examiner should be aware of the following two criteria that are implicitly contained in the Treaty and the Regulations: (i) The invention must be such that it can be carried out by a person skilled in the art (after proper instruction by the application); this follows from Article 5. Instances where the invention fails to satisfy this requirement are given in II, 4.11. (ii) The invention must be of "technical character" to the extent that it must relate to a technical field (Rule 5.1.a(i); must be concerned with a technical problem (Rule 5.1.a(iii), and must have technical features in terms of which the matter for which protection is sought can be defined in the claim (Rule 6.3(a) (see III, 2.1).

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No.	Text of New Paragraph
IV.8.3a	The invention claimed must normally be considered as a whole. Thus it is not correct as a general rule, in the case of a combination claim, to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. The only exception to this rule is where there is no functional relationship between the features of the combination, i.e. where the claim is merely for a juxtaposition of features and not a true combination (see the example at IV, 8.8 B1).
IV.8.5a Amendment necessary due to EPOG IV 9.5a references to "patentability"	If an independent claim is new and non-obvious, there is no need to investigate the obviousness or non-obviousness of any claims dependent thereon. Similarly, if a claim to a product is new and non-obvious there is no need to investigage the obviousness of any claims for a process which inevitably results in the manufacture of that product or any claims for a use of that product, in spite of the fact that claims in different categories are referred to in Rule 13.2 as "independent" claims. This applies, in particular, to analogy processes insofar as they provide a novel and inventive product.
V.1.4a	**1.4a** A subsequent application for the same subject-matter and filed in or for the same State shall be considered as the first application for priority purposes if, when this subequent application was filed, the first application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The international preliminary examining authority will not consider this question unless there is evidence of the existance of an earlier application as, for example, in the case of a United States continuation-in-part application.
VI.7.11a	Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application as filed, subsequent clarification of that effect in the description does not contravene Article 34(2)(b).
VI.7.12a	However, later filed examples or statements of advantage even if not allowed into the application may nevertheless be taken into account by the examiner as evidence in support of the allowability of the claims

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No.	Text of New Paragraph
	in the application. For instance, an additional example may be accepted as evidence that the invention can be readily applied, on the basis of the information given in the originally filed application, over the whole field claimed (see III, 6.4); or an additional statement of advantage (for example the advantage mentioned in VI.7.12 may be accepted as evidence in support of inventive step (see IV, 8.9). When such evidence is used by the examiner to support a positive conclusion on inventive step, a mention of this evidence should be made in the International Preliminary Examination Report.
Added to be consistent with current practice	
VI.7.12b	Care must also be taken to ensure that any amendment to, or subsequent insertion of, a statement of the technical problem solved by the invention meets Article 34(2)(b). For example it may happen that following restriction of the claims to meet an objection of lack of inventive step, it is desired to revise the stated problem to emphasise an effect attainable by the thus restricted invention but not by the prior art. It must be remembered that such revision is only permissible if the effect emphasised is one deducible by a person skilled in the art without difficulty from the application as filed (see 7.11a and 7.12 above).

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