

WIPO



PCT/MIA/III/2

ORIGINAL: English

DATE: May 14, 1993

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

**Third Session
Geneva, June 21 to 25, 1993**

**OBSERVATIONS AND SUGGESTIONS FOR MODIFICATIONS OF VARIOUS DOCUMENTS
RECEIVED FROM INTERNATIONAL AUTHORITIES**

prepared by the International Bureau

1. The Annex to this document contains the observations on, and suggestions for, modifications of some Forms for use by the International Searching and Preliminary Examining Authorities, of the PCT Search Guidelines and of the Administrative Instructions, provided by the Swedish Patent Office and the United States Patent and Trademark Office in response to circular PCT 490 dated January 28, 1993.
2. These observations and suggestions are hereby provided to all International Authorities for information and comments.

[Annex follows]

ANNEX



Box 5025, 102 42 STOCKHOLM M
Telefon: nr 08-782 25 00

1993-03-17

WIPO

Dear Mr Bartels,

according to a letter, WIPO C. PCT 490/211 of January 28, 1993 in which we are invited to provide comments and observations for the meeting in June with the International Authorities under the PCT we are pleased to give the following observations.

We would like to have information about all implications from the EASY-project on the receiving officieis, the international searching authorities as well as the international preliminary examining authorities. We also want to know from a legal point of view in which ways the EASY-project give influence to the PCT-convention, regarding both the articles and the rules.

In addition we want to mention a small point concerning the new forms 408 and 409, box 1 "basis of the report". Between the square concerning "the claims" the new text in the form is "pages" in stead of "claims" as before. Contacts with your office has led us to understand that it is correct to give information about the claims and we think that the text should be changed to "claims".

Yours sincerely,


Jan-Eric Bodin



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAR 16 1993

Dr. Arpad Bogsch
Director General
World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20
Switzerland

Dear Dr. Bogsch:

In response to your Circular PCT 490 of January 28, 1993, enclosed are the comments of the U.S. Patent and Trademark Office on the PCT Authorities' forms and the Administrative Instructions related to those Authorities. Some initial comments on the PCT Search Guidelines document are also offered and we await the PCT Preliminary Examination Guidelines document.

Sincerely,

A handwritten signature in cursive script, appearing to read "Michael K. Kirk".

Michael K. Kirk
Acting Assistant Secretary
and Acting Commissioner of
Patents and Trademarks

Enclosure

Proposed Changes to ISA Forms

PCT/ISA/205 Move the lower box and associated text downward to allow more room for an explanation under the top box.

PCT/ISA/210 A) Delete the passage
(first sheet) "This international search report consists of a total of _____ sheets."

This phrase is not needed and causes unnecessary work after the forms have been completed.

B) In #4, insert --, see PCT Rule 4.3-- after "follows" adjacent the second box.

This will aid applicant in determining why the title was changed.

C) In #5, insert --See PCT Rule 8.-- at the end of the text adjacent the second box.

This change will direct applicants to the relevant rule pertaining to the proper contents of the abstract.

D) In #6, insert -- See PCT Rule 8.2(a).-- after the text adjacent the lowest box, and insert -- See PCT Rule 8.2(b).-- after "None of the figures."

These changes would provide reference to the appropriate Rule dealing with drawing selection and would reduce the number of inquiries to the ISA's.

PCT/ISA/210 In "B. FIELDS SEARCHED", combine the top two boxes
(second sheet) under the heading -- Documentation searched --

This change would simplify the form. No substantial need is seen to distinguish between "minimum documentation" and "other" documentation.

PCT/ISA/214 Change the form's title to
-- REQUEST FOR THE PRODUCTION OF
 PROOF OF RIGHT TO PRACTICE--

The current title gives no indication of the purpose of the form.

PCT/ISA/216

The question mark at the end of the heading "HOW TO CORRECT AN ERROR" should be deleted since the statement is not a question.

Change the text under this heading to read:

-- A request for rectification of an obvious error must be submitted in a letter.

- The rectification may be stated in that letter.
- The applicant is required to submit a replacement sheet embodying the rectification and the letter containing the request for rectification must draw attention to the difference between the replaced sheet and the replacement sheet (Rule 26.4(a)).--

This change allows the ISA to give specific instructions to applicants as to the form the rectification should take.

PCT/ISA/220
Notes
(second sheet)

The question marks at the ends of the last two headings on the page should be deleted since the statements are not questions.

PCT/ISA/224

In #1, the blank line adjacent the second box is not needed and should be deleted. Also, the third and fourth boxes and adjacent text should be deleted. These last two boxes have caused confusion and are unnecessary. Virtually any communication is "important."

Proposed Changes to IPEA Forms

PCT/IPEA/408
(first sheet)

#3. Delete the sentence "The applicant may, before the expiration of that time limit, request this Authority to grant an extension."

This sentence is misleading since in many instances there is not sufficient time to provide for an extension. In addition, the United States does not normally grant extensions of time to respond to the Written Opinion.

PCT/IPEA/408
(second sheet)

A) I., #2. Change "cancellation" to --deletion--. This change makes this phrase consistent with Administrative Instruction 311, which speaks of the "deletion" of sheets.

B) I., #3. Add --(Rule 70.2(c))-- after "Box."

This change points out the basis for treating amendments which go beyond the disclosure as filed as if they had not been made.

C) II. This box, which deals with priority, does not provide for the treatment of plural priority claims, only some of which may be valid. The box should be modified so plural priority claims can be treated.

PCT/IPEA/408
(fifth sheet)

Add the words "YES" and "NO" adjacent the blank lines similar to what is found on the International Preliminary Examination Report (form PCT/IPEA/409).

PCT/IPEA/408
(sixth sheet)

VI., 1. Certain published documents
Change "Priority date (valid claim)" to --Claimed priority date--.

The examiner should not be required to determine the propriety of the priority claim. For example, the examiner may not have the priority document and it may be unnecessary to establish the validity of the priority date, at least at this point in prosecution.

Also, an area should be established to cite non-patent literature in box VI.

PCT/IPEA/409
(second sheet)

A) I., #2. Change "cancellation" to --deletion--. This change makes this phrase consistent with Administrative Instruction 311, which speaks of the "deletion" of sheets.

B) I., #3. Add --(Rule 70.2(c))-- after "Box."

This change points out the basis for treating amendments which go beyond the disclosure as filed as if they had not been made.

C) II. This box, which deals with priority, does not provide for the treatment of plural priority claims, only some of which may be valid. The box should be modified so plural priority claims can be treated.

PCT/IPEA/409
(sixth sheet)

VI., 1. Certain published documents
Change "Priority date (valid claim)" to --Claimed priority date--.

The examiner should not be required to determine the propriety of the priority claim. For example, the examiner may not have the priority document and it may be unnecessary to establish the validity of the priority date, at least at this point in prosecution.

Also, an area should be established to cite non-patent literature in box VI.

PCT/IPEA/410

Change the form's title to
--REQUEST FOR THE PRODUCTION OF
PROOF OF RIGHT TO PRACTICE--

The current title gives no indication of the purpose of the form.

PCT/IPEA/411

The question mark at the end of the phrase "HOW TO CORRECT AN ERROR" should be deleted since the statement is not a question.

PCT/IPEA/416

#4. REMINDER

In the second paragraph, change "that translation must contain a translation of any annexes to the international preliminary examination report. It" to --it--. There is no absolute requirement that a translation of the annex be submitted. For example, no such absolute requirement exists in the United States.

PCT/IPEA/424

In #1, the blank line adjacent the second box is not needed and should be deleted. Also, the third and fourth boxes and adjacent text should be deleted. These last two boxes have caused confusion and are unnecessary. Virtually any communication is "important."

Comments on and Proposed Changes to the PCT Search Guidelines

- Chapt. III
3.5 It does not appear that claims which relate to inventions for which no fees have been paid must be excluded from the international search. Additional inventions which can be searched without additional effort should be searched.
- Chapt. III
3.9
Chapt. IV
2.8 These paragraphs indicate that features which are "trivial" or which are "generally known in the art" need not be searched. Many features can be well known per se, yet contribute an inventive step to the claimed combination. Treatment of "trivial" portions of a claim as being nonexistent is not a proper approach to the conduct of a search since the claim is used to define the legal boundaries of protection and all limitations of a claim should be considered material to patentability.

Proposed Changes to Administrative Instructions - Parts 5 & 6

- § 508 At the end of the first paragraph under "(b)", add the sentence --Each category and each relevant claim or group of claims should be separated by a line.--

Lines would also be drawn in the example shown in §508.

This change would make it much easier to correlate the category symbol with the associated claim or group of claims.

- § 612 Rewrite as --The officer of the International Preliminary Examining Authority responsible for the international preliminary examination report, as referred to in Rule 70.14, means the person who actually performed the examination work and prepared the international preliminary examination report, or another person who has been assigned responsibility for supervising the examination of the application by the IPEA.--

This change allows an IPEA to assign ultimate responsibility for the contents of the International Preliminary Examination Report to someone other than the person actually doing the work, such as a more senior person or the Examiner's supervisor.

PCT/GEN/11
page 40

sheet, provided that the family to which they belong shall be clearly identified and that any text matter on that sheet, if not in the English language, shall also be furnished to the International Bureau in English translation.

(h) A document whose contents have not been verified by the search examiner but are believed to be substantially identical with those of another document which the search examiner has inspected, may be cited in the international search report in the manner indicated for patent family members in the first sentence of paragraph (g).¹⁰

Section 508

Manner of Indicating the Claims to Which the Documents
Cited in the International Search Report Are Relevant

(a) The claims to which cited documents are relevant shall be indicated by placing in the appropriate column of the international search report:

(i) where the cited document is relevant to one claim, the number of that claim; for example, "2" or "17";

(ii) where the cited document is relevant to two or more claims numbered in consecutive order, the number of the first and last claims of the series connected by a hyphen; for example, "1-15" or "2-3";

(iii) where the cited document is relevant to two or more claims that are not numbered in consecutive order, the number of each claim placed in ascending order and separated by a comma or commas; for example, "1, 6" or "1, 7, 10";

(iv) where the cited document is relevant to more than one series of claims under (ii), above, or to claims of both categories (ii) and (iii), above, the series or individual claim numbers and series placed in ascending order using commas to separate the several series, or to separate the numbers of individual claims and each series of claims; for example, "1-6, 9-10, 12-15" or "1, 3-4, 6, 9-11".

(b) Where different categories apply to the same document cited in an international search report in respect of different claims or groups of claims, each relevant claim or group of claims shall be listed separately opposite each indicated category of relevance.

The following example illustrates the situation where a document is of particular relevance under Section 505(b) as to claims 1 to 3 and under Section 505(c) as to claim 4, and indicates the general state of the art under Section 507(c) as to claims 11 and 12:

| <i>Category</i> | <i>Citation</i> | <i>Relevant to claim No.</i> |
|-----------------|-------------------------------------------------|------------------------------|
| | GB, A 392,415 (JONES) 18 May 1933 (18.05.33) | |
| X | Fig.1 | 1-3 |
| Y | page 3, lines 5-7 | 4 |
| A | Fig.5, support 36 | 11-12 |

[End of example]

Section 509

[Deleted]