

WIPO



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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

Document 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 provided by the European Patent Office.
2. These observations and suggestions are hereby provided to all International Authorities for information and comments.

[Annex follows]

ANNEX



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Patentamt

European
Patent Office

Office européen
des brevets

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☎ 089/23 99-0
Tx 523 666 eomu d
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Zeichen/Reference/Reference

57.8

Denim/Date/Date

7 June 1993

Dear Deputy Director General,

**Re: PCT Meeting of International Authorities,
Geneva 21-25 June 1993**

I refer to the letter C. PCT 490/211 of 28 January 1993.

The EPO will be represented in the third session of the MIA as follows:

- Mr A. Cardon, Director, DG1
- Mr B. Hjelm, Principal Examiner, DG2
- Ms L. Gruszow, Principal Administrator, DG5
- Mr I. Koch, Principal Lawyer, DG5

The EPO has elaborated a few contributions which we suggest be submitted for discussion. They are enclosed as Annexes herewith:

- Annex 1 : Comments on the practice of the EPO as an ISA under Rules 5.2 and 13ter PCT - Sequence Listings.

- Annex 2 : The EPO as ISA : Transmittal of the Search Copy.


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- Annex 3* : The EPO as ISA and IPEA : Statement relating to unity of invention in the search report where no additional search or examination fee has been required.

- Annex 4 : Identification of documents in the International Search Report (PCT-Administrative instructions section 503).

- Annex 5 : EPO AS ISA : Practice under Rule 40.2(e) - Lack of Unity - Prior Review.

Yours sincerely,


U. Schatz
Principal Director
International Affairs

* will be sent at a later date

European Patent Office

Annex 1

June 1993

Comments on
the practice of the EPO as an ISA
under Rules 5.2 and 13ter PCT

Sequence Listings

INTRODUCTION

1. Since 1 January 1993, the EPO as ISA has been making use of Rule 13ter PCT for international applications disclosing a nucleotide and/or amino acid sequence of the kind requiring a sequence listing (SL) in accordance with WIPO Standard ST.23. The EPO further requires that the SL on paper be accompanied by an electronic data carrier (diskette) in accordance with Annex C of the PCT Administrative Instructions (See Annex II to the Decision of the President of the EPO dated 11 December 1992 concerning the representation of nucleotide and/or amino acid sequences in patent applications and the filing of sequence listings, published in Supplement No. 2 to OJ EPO 12/1992, p. 32).
2. Between the beginning of this year and the end of April, 125 search copies were received involving a sequence listing. In 85% of cases problems have arisen and an invitation under Rule 13ter.1 has had to be issued. The vast majority of applicants then fulfilled the necessary requirements, enabling the EPO to proceed with the international search. Until now the EPO has not had a case in which the search has been refused. In the cases where the requirements were not

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completely fulfilled, it was considered that a meaningful search was still possible. In future, however, cases may arise where this will not be possible.

A few examples of the problems the EPO was faced with are given below:

1. Receiving the diskette from the receiving Office

Although the EPO had asked receiving Offices specifying the EPO as ISA to transmit any SL diskettes filed with international applications, one or two failed to do so.

The situation improved dramatically after contacts between the EPO and the receiving Offices involved.

The EPO suggests amending Administrative Instruction Section 313(c) to make it clear that it refers to the SL on electronic data carriers, since the SL filed on paper with the international application forms part of the description. The following wording is proposed:

"(c) Where a nucleotide and/or amino acid sequence listing on electronic data carrier has been filed with the international application, it shall be transmitted to the International Searching Authority together with the search copy".

2. Numbering of sheets of the international application where the description contains the SL

(a) In a few cases the sheets containing the SL filed with the international application were numbered either separately or not at all.

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The EPO corrected this *ex officio* and sent a copy of the substitute sheets to the applicant and the International Bureau.

The EPO suggests adding the following to Administrative Instruction Section 207, paragraph (b)(ii):

"(ii) the second series commencing with the first sheet of the description, including any nucleotide and/or amino acid sequence listing, and continuing through the claims until the last sheet of the abstract, and"

Although WIPO Standard ST. 23 already requires this, the EPO is of the opinion that repeating it in the Administrative Instruction might help to avoid errors.

- (b) The EPO would like to raise the question as to whether lack of numbering the pages containing the sequence listing on paper (no problem with the diskette) or erroneous numbering should be considered as a formal defect under Art. 14(1)(v) PCT together with Rule 11.7(a) and Administrative instruction 207(b)(ii) rather than a defect under Rule 13^{ter}.

It this is so, then, in accordance with Art. 17(1)(b) PCT, it is the task of the receiving Office to invite the applicant to correct that defect under Rule 26 PCT.

Should the ISA then contact the receiving Office for the purposes of inviting the applicant to correct the

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numbering of the sheets of the international application in cases where the receiving Office has not proceeded in accordance with Rule 26 PCT?

Although this procedure appears to be cumbersome, it seems to be more appropriate than a procedure under Rule 13^{ter}.1 (the sequence listing does not comply with the WIPO Standard ST. 23, Introduction, point 4) because it allows the originally-filed sequence listing to be maintained and consequently to be published as part of the international application.

3. Spontaneous subsequent filing of SL with the receiving Office

In one case the applicant subsequently filed an SL on paper and on diskette with the receiving Office.

The hard copy of the SL was numbered as from the last sheet of the originally filed description; also filed were new sheets containing the claims and abstract and renumbered following on from the SL.

The receiving Office accepted the above items, and after stamping the sheets as "substitute sheets" sent them to the EPO, which was acting as ISA.

In our opinion, in this case the receiving Office should simply have forwarded the subsequently filed elements to the ISA.

It is for the ISA to deal with such items and inform the applicant that the SL cannot be considered as forming part of the international application.

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The receiving Office should further inform the applicant that any subsequently filed SL must be filed direct with the ISA.

4. Subsequently filed SL as part of a subsequently filed description

In this case, following an invitation under Rule 13ter by the EPO as ISA to file an SL and a diskette, the applicant - as in the case under item 3 - filed the SL as part of a newly filed description, claims and abstract.

The EPO separated the SL from the subsequently filed documents, renumbered the sheets of the SL as from the first one, and informed the applicant that it would be ignoring the remaining subsequently filed documents.

5. SL filed as part of the description - Invitation from the ISA to conform with ST.23 - Transmission to the International Bureau of substitute sheets of the SL

The EPO would like confirmation that in the case of substitute sheets filed in support of an SL filed with the international application but having been corrected either to comply with WIPO ST.23 or under Rule 91 PCT, the ISA should notify the International Bureau and transmit a copy of the substitute sheets to be included in the international publication, by analogy with Rule 91.1(f) PCT.

6. General information on the diskette

A discussion took place with one applicant about whether, in cases where the international publication was filed by more than one applicant, the general information

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appearing on the diskette under WIPO Standard 24 should give the names and bibliographic data of all the applicants. This also applies to the SL on paper.

The EPO is of the opinion that all names should be indicated, with a view to avoiding any risk of confusion between applications and diskettes if several applications happen to be filed simultaneously and one of the applicants is identical in all of them.

The EPO would appreciate any comments on its practice.

7. Box No. VIII of the PCT Request Check List

In the current check list of Form PCT/RO/101, the only reference to any nucleotide and/or amino acid sequence listing is in point 7 of the list of accompanying items (see copy enclosed).

In our opinion, this is misleading for the applicant.

In point 2 of the left-hand column ("2. description") the following should be added:

"including, where applicable, a nucleotide and/or amino acid sequence listing"

whereas item 7 of the accompanying items should refer to:

"machine-readable form of nucleotide and/or amino acid sequence".

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The EPO suggests amending Box No. VIII of Form PCT/RO/101 accordingly. A draft is enclosed.

8. Conclusion

The EPO suggests that the Guidelines for the receiving Offices and for the ISAs be complemented with regard to handling of international applications referring to nucleotide and amino acid sequences.

Sheet No.

Appendix to
Annex 1

Box No. VI PRIORITY CLAIM		Further priority claims are indicated in the Supplemental Box <input type="checkbox"/>	
The priority of the following earlier application(s) is hereby claimed:			
Country <small>(in which, or for which, the application was filed)</small>	Filing Date <small>(day/month/year)</small>	Application No.	Office of filing <small>(only for regional or international application)</small>
item (1)			
item (2)			
item (3)			
Mark the following check-box if the certified copy of the earlier application is to be issued by the Office which for the purposes of the present international application is the Receiving Office (a fee may be required): <input type="checkbox"/> The receiving Office is hereby requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) identified above as item(s) : _____			
Box No. VII EARLIER SEARCH			
Fill in where a search (international, international-type or other) by the International Searching Authority has already been carried out or requested and the Authority is now requested to base the international search, to the extent possible, on the results of that earlier search. Identify such search or request either by reference to the relevant application (or the translation thereof) or by reference to the search request: Country (or regional Office): _____ Date (day/month/year): _____ Number: _____			
Listing LL and/or amino acid sequence ✓			
Box No. VIII CHECK LIST <i>L including, where applicable, a nucleotide</i>			
This international application contains the following number of sheets: 1. request : _____ sheets 2. description : _____ sheets 3. claims : _____ sheets 4. abstract : _____ sheets 5. drawings : _____ sheets Total : _____ sheets		This international application is accompanied by the item(s) marked below: 1. <input type="checkbox"/> separate signed power of attorney 2. <input type="checkbox"/> copy of general power of attorney 3. <input type="checkbox"/> statement explaining lack of signature 4. <input type="checkbox"/> priority document(s) identified in Box No. VI as item(s): _____ 5. <input type="checkbox"/> fee calculation sheet 6. <input type="checkbox"/> separate indications concerning deposited microorganisms 7. <input type="checkbox"/> nucleotide and/or amino acid sequence listing (diskette) 8. <input type="checkbox"/> other (specify): _____	
Figure No. _____ of the drawings (if any) should accompany the abstract when it is published.			
Box No. IX SIGNATURE OF APPLICANT OR AGENT			
Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the request).			

For receiving Office use only	
1. Date of actual receipt of the purported international application:	2. Drawings: <input type="checkbox"/> received: <input type="checkbox"/> not received:
3. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:	
4. Date of timely receipt of the required corrections under PCT Article 11(2):	
5. International Searching Authority specified by the applicant: ISA/	6. <input type="checkbox"/> Transmittal of search copy delayed until search fee is paid

For International Bureau use only
Date of receipt of the record copy by the International Bureau:

European Patent Office

Annex 2
June 1993

The EPO as ISA: Transmittal of the Search Copy

Rule 23 PCT forbids the receiving Offices to transmit the search copy to the ISA until the search fee has been paid.

Some receiving Offices fail to observe that provision. Either they send the search copy before the search fee has been paid and transmit at the same time a copy of the invitation under Rule 16^{bis} PCT (Form PCT/RO/133). In another case, a receiving Office sent the search copy and subsequently transmitted a copy of the declaration that the international application is considered as withdrawn because of lack of payment of the prescribed fees (Form PCT/RO/117). In that specific case the international search report was already established and the question arises as to whether the EPO is entitled to recover the search costs from the receiving Office.

European Patent Office

Annex 4

June 1993

The EPO as ISA: Proposal for simplifying the identification of documents in the International Search Report (PCT-Administrative instructions Section 503)

1. The EPO suggests to bring few amendments to Section 503 of the PCT-Administrative instructions, with a view to excluding redundant information and thereby simplifying the task of the search examiner in those cases where he creates himself by computer the international search report.

The EPO reflects on amending accordingly the EPC Guidelines and would like to know the opinion of the other ISAs.

(a) Patent documents

....

- (v) the date of publication of the cited patent document as indicated thereon, unless it is evident that the cited document was published well before the reference date for the search.

....

Example

JP, B, 50-14535 (NCR CORPORATION)
column 4, lines 3 to 27.

....

(c) Articles published in a periodical or other serial publication

- (1) the title of the periodical or other serial publication (when abbreviations are used, the

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international standard practice for quoting non patent literature should preferably be used¹

....

(iii) delete

(iv) the author of the article and the number of the page both on which the article starts and ends; and

....

Example

IBM Tech. Discl. Bull.
Vol. 17, No. 5, October 1974
pages 1344 and 1345
Drop J.G.

....

(e) Reference obtained on-line of non accessible documents

Where the document (e.g. abstract) was obtained by an on-line search and neither the printed version from the data bank (e.g. Pascal, Compendex) nor the original document itself is available, the print-out itself has to be cited. The identification of both the print-out and the complete document (in the manner

¹ For abbreviations referencoc can be made to sources such as the standard ISO 4-1972 (E): Documentation-International code for the abbreviation of titles of periodicals, or the Chemical Abstracts Service Source Index (CASSI), published by the American Chemical Society, or to the World List of Scientific Periodicals

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indicated in (a), (b) or (c) above, depending on the nature of the document, PCT Art. 15(2) and Rule 43.5) must be done.

Example:

DATABASE WPIL

week 9016

Derwent Publications Ltd., London, GB

AN 90-121923

Class Q51

& SU-A-1511467 (BRYAN MECH)

* abstract *

European Patent Office

Annex 5

June 1993

**EPO as ISA: Practice under Rule 40.2(e) - Lack of Unity -
Prior Review**

1. As from the 1 October 1992, the EPO makes use of the procedure under Rule 40.2(e) where the applicant pays additional fees under protest, an EPO review panel examines whether the invitation to pay additional fee(s) was justified. The review panel is composed of the Head of the Directorate from which the invitation was issued, an examiner with special expertise of unity of invention and, normally the examiner who issued the invitation. If the review panel concludes that the invitation was not justified, the additional fee(s) is (are) refunded; in the contrary case, the applicant is invited to pay a protest fee if he wants that the protest and the conclusion of the review panel be transmitted for decision to the EPO Boards of Appeal.
2. Since the start of the review procedure:
 - (a) 322 invitations to pay additional search fees have been sent by DG1
 - (b) 29 cases have been sent to a review panel
 - (c) conclusions have been reached by the review panels, resulting in 4 cases of complete refund of the search fees and 1 case of partial refund
 - (d) number of invitations to pay additional search fees confirmed by the review panels where the time-limit to pay the protest fee has elapsed: 8; no case where the protest fee has been paid.

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3. A similar review procedure applies in case of lack of unity during the PCT Chapter II procedure under Rule 68.3(e) PCT. It is too early to report on practice at that stage.

[End of annex and of document]