

# WIPO



PCT/MIA/III/3

ORIGINAL: English

DATE: May 18, 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**

**DRAFT OF PROPOSED MODIFIED FORMS FOR USE BY  
THE INTERNATIONAL SEARCHING AUTHORITIES**

*Document prepared by the International Bureau*

1. The Annex to this document contains draft modified Forms for use by the International Searching Authorities. It also contains, for easy reference, a list of those Forms.
2. The proposals take into account comments received from International Searching Authorities, based on their experience with the Forms since July 1, 1992 (see documents PCT/MIA/III/2 and PCT/MIA/III/2 Add.1), as well as the results of a study undertaken by the International Bureau.
3. The proposed modifications of Forms PCT/ISA/214 and 216 are based on comments received from the United States Patent and Trademark Office (USPTO). The proposed modifications of Forms PCT/ISA/205, 210 and 220 are based both on comments received from the USPTO and on the study undertaken by the International Bureau. The proposed modifications of Form PCT/ISA/202 are based on the study undertaken by the International Bureau. The proposed modifications of Form PCT/ISA/228 are based both on an earlier suggestion by the European Patent Office (EPO) (see document PCT/MIA/III/2 Add.1) and on the study undertaken by the International Bureau.
4. Each proposed modification is identified by a heavy line in the margin of the Form concerned.
5. The proposed modifications are submitted to the International Searching Authorities for their observations and for the purpose of the consultations required under PCT Rule 89.2(b).

[Annex follows]

## ANNEX

This Annex contains the following draft modified Forms:

<u>Form No.</u>	<u>Title of Form</u>
PCT/ISA/202	Notification of Receipt of Search Copy
PCT/ISA/205	Notification of Change in Abstract as Previously Established by International Searching Authority
PCT/ISA/210	International Search Report (first sheet)
PCT/ISA/214	Request for the Production of Proof of Right to Practice
PCT/ISA/216	Invitation to Request Rectification
PCT/ISA/220	Notification of Transmittal of the International Search Report or the Declaration
PCT/ISA/228	Notification of Result of Review of Justification for Invitation to Pay Additional Search Fees

From the INTERNATIONAL SEARCHING AUTHORITY

# PCT

## NOTIFICATION OF RECEIPT OF SEARCH COPY

(PCT Rule 25.1)

To:		Date of mailing (day/month/year)	
		Applicant's or agent's file reference	
Applicant's or agent's file reference		IMPORTANT NOTIFICATION	
International application No.	International filing date (day/month/year)	Priority date (day/month/year)	
Applicant			
<p>1. <b>Where the International Searching Authority and the receiving Office are not the same Office:</b> The applicant is hereby notified that the search copy of the international application was received by this International Searching Authority on the date indicated below.</p> <p><b>Where the International Searching Authority and the receiving Office are the same Office:</b> The applicant is hereby notified that the search copy of the international application was received on the date indicated below.</p> <p>_____ (date of receipt).</p>			
2. <input type="checkbox"/> The search copy was accompanied by a diskette containing nucleotide and/or amino acid sequence listings.			
3. <b>Time limit for establishment of international search report</b> The applicant is informed that the time limit for establishing the international search report is 3 months from the date of receipt indicated above or 9 months from the priority date, whichever time limit expires later.			
4. A copy of this notification has been sent to the International Bureau and, where the first sentence of paragraph 1 applies, to the receiving Office.			
Name and mailing address of the ISA/		Authorized officer	
Facsimile No.		Telephone No.	

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

To:

PCT

NOTIFICATION OF RECEIPT  
OF SEARCH COPY

(PCT Rule 25.1)

Date of mailing  
(day/month/year)

Applicant's or agent's file reference		IMPORTANT NOTIFICATION	
International application No.	International filing date (day/month/year)	Priority date (day/month/year)	
Applicant			

1. **Where the International Searching Authority and the receiving Office are not the same Office:**  
The applicant is hereby notified that the search copy of the international application was received by this International Searching Authority on the date indicated below.

**Where the International Searching Authority and the receiving Office are the same Office:**  
The applicant is hereby notified that the search copy of the international application was received on the date indicated below.

\_\_\_\_\_ (date of receipt).

2.  The search copy was accompanied by a diskette containing nucleotide and/or amino acid sequence listings.

3. **Time limit for establishment of international search report**  
The applicant is informed that the time limit for establishing the international search report is 3 months from the date of receipt indicated above or 9 months from the priority date, whichever time limit expires later.

4. A copy of this notification has been sent to the International Bureau and, where the first sentence of paragraph 1 applies, to the receiving Office.

Name and mailing address of the ISA/	Authorized officer
Facsimile No.	Telephone No.

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference	<b>FOR FURTHER ACTION</b>	see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.
International application No.	International filing date (day/month/year)	(Earliest) Priority Date (day/month/year)
Applicant		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of \_\_\_\_\_ sheets.

It is also accompanied by a copy of each prior art document cited in this report.

1.  Certain claims were found unsearchable (See Box I).
2.  Unity of invention is lacking (See Box II).
3.  The international application contains disclosure of a nucleotide and/or amino acid sequence listing and the international search was carried out on the basis of the sequence listing
  - filed with the international application.
  - furnished by the applicant separately from the international application,
    - but not accompanied by a statement to the effect that it did not include matter going beyond the disclosure in the international application as filed.
  - transcribed by this Authority.
4. With regard to the title,  the text is approved as submitted by the applicant.  
 the text has been established by this Authority to read as follows (Rule 37.2):
5. With regard to the abstract,
  - the text is approved as submitted by the applicant.
  - the text has been established by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority (Rule 38.2).
6. The figure of the drawings to be published with the abstract is:
 

Figure No. \_\_\_\_\_  as suggested by the applicant.  None of the figures (Rule 8.2(b)).

  - because the applicant failed to suggest a figure (Rule 8.2(a)).
  - because this figure better characterizes the invention (Rule 8.2(a)).

**PATENT COOPERATION TREATY**

From the INTERNATIONAL SEARCHING AUTHORITY

**PCT**

**REQUEST FOR THE PRODUCTION OF PROOF  
OF RIGHT TO PRACTICE**

(PCT Article 49 and Rule 83)

To:		Date of mailing (day/month/year)	
in its capacity as receiving Office		REPLY DUE within months/days from the above date of mailing	
Applicant's or agent's file reference		International filing date (day/month/year)	
International application No.		Applicant	

This International Searching Authority hereby requests the receiving Office to inform it whether the following person has the right to practice before it:

Name:

Address:

Name and mailing address of the ISA/ Facsimile No.	Authorized officer Telephone No.
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PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

INVITATION TO REQUEST RECTIFICATION

(PCT Rule 91.1(d))

To:	Date of mailing (day/month/year)
	Applicant's or agent's file reference
International application No.	REPLY DUE see item 2 and the last paragraph below
Applicant	International filing date (day/month/year)

1. This International Searching Authority has discovered in the international application/in other papers submitted by the applicant/what appears to be an obvious error

- as shown on the attached copy  
 as specified hereafter:

2. The applicant is hereby invited to submit a request for rectification to the following authority:

- the receiving Office     this International Searching Authority     the International Bureau of WIPO  
34 chemin des Colombettes  
1211 Geneva 20, Switzerland

HOW TO CORRECT AN ERROR

A request for rectification of an obvious error must be submitted in a letter (Rule 26.4(a)).

- 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 differences between the replaced sheet and the replacement sheet.

ATTENTION

No rectification will be made without the express authorization of the competent authority indicated above and, in order to be effective, the authorization by that authority must reach the International Bureau, or be given by the International Bureau, as the case may be, before the completion of the technical preparations for international publication (Rule 91.1(g) to (g-quater)).

Name and mailing address of the ISA/	Authorized officer
Facsimile No.	Telephone No.

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

**PCT**

NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL SEARCH REPORT  
OR THE DECLARATION

(PCT Rule 44.1)

To:	
Applicant's or agent's file reference	<b>FOR FURTHER ACTION</b> See paragraphs 1 and 4 below
International application No.	International filing date (day/month/year)
Applicant	

1.  The applicant is hereby notified that the international search report has been established and is transmitted herewith.

**Filing of amendments and statement under Article 19:**  
The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

**When?** The time limit for filing such amendments is normally 2 months from the date of transmittal of the international search report; however, for more details, see the notes on the accompanying sheet.

**Where?** Directly to the International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland  
Facsimile No.: (41-22) 740.14.35

**For more detailed instructions, see the notes on the accompanying sheet.**

2.  The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3.  **With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:**

the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Further action(s):** The applicant is reminded of the following:

Shortly after **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

Within **19 months** from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within **20 months** from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the ISA/	Authorized officer
Facsimile No.	Telephone No.



## NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

### INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

#### What parts of the international application may be amended ?

The claims only.

The description and the drawings may only be amended during international preliminary examination under Chapter II (Article 34).

**When ?** Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

#### Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

**How ?** Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

**The amendments must be made in the language in which the international application is to be published.**

#### What documents must/may accompany the amendments ?

##### Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

**The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.**

**NOTES TO FORM PCT/ISA/220 (continued)**

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:  
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:  
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:  
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or  
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:  
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

**"Statement under Article 19(1)" (Rule 46.4)**

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

**It must be in the language in which the international application is to be published.**

It should be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It should not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

**Consequence if a demand for international preliminary examination has already been filed**

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

**Consequence with regard to translation of the international application for entry into the national phase**

The applicant's attention is drawn to the fact that, where upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.

**PATENT COOPERATION TREATY**

From the INTERNATIONAL SEARCHING AUTHORITY

**PCT**

**NOTIFICATION OF RESULT OF REVIEW  
OF JUSTIFICATION FOR INVITATION TO PAY  
ADDITIONAL SEARCH FEES**

(PCT Rule 40.2(e))

To:		Date of mailing (day/month/year)
Applicant's or agent's file reference	<b>PAYMENT DUE</b>	<b>ONLY if item 1 applies:</b> within <b>ONE MONTH</b> from the above date of mailing
International application No.	International filing date (day/month/year)	
Applicant		

The applicant is hereby notified that, with regard to the protest filed on \_\_\_\_\_, this International Searching Authority has reviewed the justification for the invitation to pay additional search fees (Form PCT/ISA/206), the result of which is stated below.

1.  The applicant is invited to pay a protest fee, within the time limit indicated above, for further examination of the protest, in the amount of \_\_\_\_\_ (amount/currency)

because  the invitation is justified.  
 the invitation is justified in part.  
 To the extent the invitation is not justified, \_\_\_\_\_ additional search fee(s) paid under protest will be refunded in due course.

The reasons for this invitation to pay a protest fee are indicated below in the Annex.

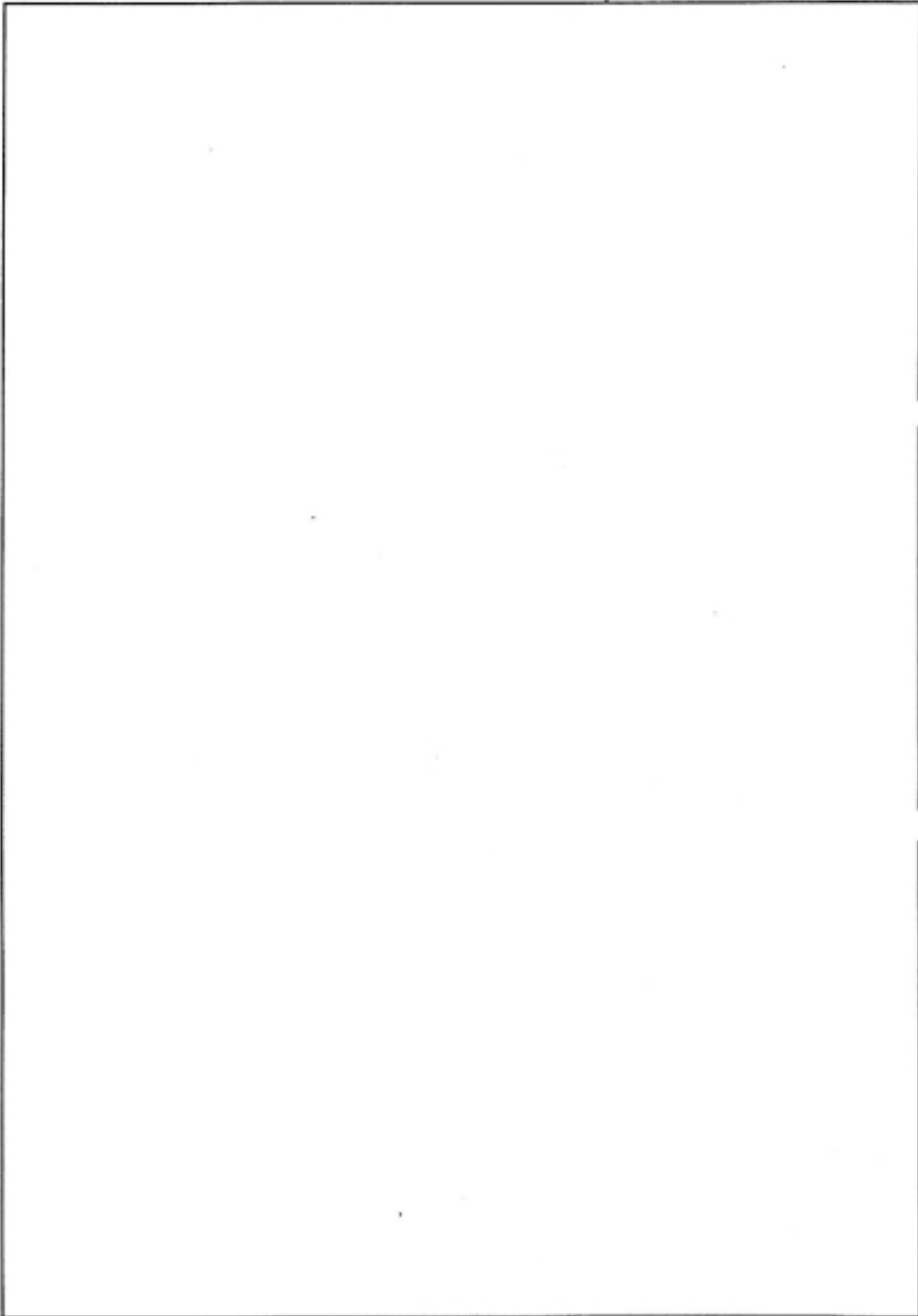
**Failure to pay the protest fee within the time limit indicated above will result in the protest being considered withdrawn.**

2.  The invitation was not justified and the protest is allowed. All additional search fee(s) paid under protest will be refunded in due course.

Name and mailing address of the ISA/ Facsimile No.	Authorized officer Telephone No.
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Annex to Form PCT/ISA/228

International application No.



Form PCT/ISA/228 (Annex) (DRAFT/MIA/June 1993)

[End of Annex and of document]