

# WIPO



PCT/MIA/III/4

ORIGINAL: English

DATE: June 8, 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 PRELIMINARY EXAMINING AUTHORITIES**

*Document prepared by the International Bureau*

1. The Annex to this document contains draft modified Forms for use by the International Preliminary Examining Authorities. It also contains, for easy reference, a list of those Forms.
2. The proposals take into account comments received from International Preliminary Examining Authorities, based on their experience with the Forms since July 1, 1992 (see document PCT/MIA/III/2), as well as the results of a study undertaken by the International Bureau.
3. The proposed modifications of Forms PCT/IPEA/410 and 411 are based on comments received from the United States Patent and Trademark Office (USPTO). The proposed modifications of Forms PCT/IPEA/408, 409 and 428 are based on the comments received from the USPTO and the Swedish Patent Office and on the results of the study undertaken by the International Bureau.
4. The major proposed modifications relate to the written opinion (Form PCT/IPEA/408) and the international preliminary examination report (Form PCT/IPEA/409). They are outlined in the following paragraphs. Reference is also made to the proposed modifications outlined in the comments and observations of the International Preliminary Examining Authorities contained in document PCT/MIA/III/2.

5. On the first sheet of Form PCT/IPEA/409, in connection with the basis of the report, it is proposed to modify item 2 to make it clear that the sheets of the description, claims and/or drawings annexed to the report may contain claims amended under Article 19 (i.e. amendments made before international preliminary examination started).

6. It is also proposed to modify Box I, Basis of the report, of Form PCT/IPEA/409, by adding,

(i) under item 1, a reminder for the benefit of examiners in the International Preliminary Examining Authority and in the elected Offices as well as of applicants that “replacement sheets” furnished in response to an invitation under Article 14 must be referred to as “originally filed” and not as “amended”, and that, as a consequence, these sheets are not to be annexed to the report; and

(ii) under item 2, a separate check box for each element of the international application which has been cancelled as a result of amendments.

7. In connection with the indications on lack of unity (Box IV), it is proposed to provide check-boxes for all possible situations which may occur depending on whether or not the International Preliminary Examining Authority invited the applicant to restrict the claims or pay additional fees, whether or not the applicant responded, either by restricting claims, or by paying additional fees and if so, whether the payment was made under protest. It is further proposed to provide for an indication of the reasons for the finding of lack of unity, not only where Rule 68.1 applies (i.e., where the International Preliminary Examining Authority chose not to invite the applicant to restrict the claims or pay additional fees) but in all cases. This is essential for the elected Offices and will make the report more useful and self-sufficient for the reader.

8. As far as the layout and presentation of the report are concerned, the following modifications are proposed in order to allow each International Preliminary Examining Authority to more easily produce computer-generated filled-in reports:

(i) simplification of the identification of the sheets of the report by way of the Box number rather than a sheet number, the “first sheet” becoming the “transmittal sheet”;

(ii) more uniform presentation with each Box starting on a new sheet (in the present form, Boxes I and II are still on the same sheet);

(iii) possibility to adjust the size of any Box in each case and avoid the need to refer to a supplemental sheet, since any “Box” could be several sheets long if necessary and its contents would appear directly under the relevant heading.

9. When considering the proposed modifications and the streamlining of the production of reports by the International Preliminary Examining Authority, due regard should be given to the needs of the International Bureau in the preparation of translations into English of reports established in languages other than English as well as to the question of use of reports by elected Offices, especially by elected Offices whose official language(s) is(are) not English. If, on the one hand, it may be desirable for International Preliminary Examining Authorities to streamline the production of reports, the use of such reports should, on the other hand, not be hampered by such streamlining. The reports should be user-friendly for elected Offices.

10. The observations made in paragraphs 6 to 8 in relation to the report (Form PCT/IPEA/409) apply equally to the written opinion (Form PCT/IPEA/408) .
11. Each proposed modification is identified by a heavy line in the margin of the Form concerned.
12. It is noted that a draft modified Demand Form (PCT/IPEA/401) is contained in document PCT/MIA/III/5.
13. The modifications are submitted to the International Preliminary Examining 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/IPEA/408	Written Opinion
PCT/IPEA/409	International Preliminary Examination Report
PCT/IPEA/410	Request for the Production of Proof of Right to Practice
PCT/IPEA/411	Invitation to Request Rectification
PCT/IPEA/428	Note on Informal Communication with the Applicant

PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

WRITTEN OPINION

(PCT Rule 66)

To:		Date of mailing (day/month/year)	
Applicant's or agent's file reference		REPLY DUE	within _____ months/days from the above date of mailing
International application No.	International filing date (day/month/year)	Priority date (day/month/year)	
International Patent Classification (IPC) or both national classification and IPC			
Applicant			

1. This written opinion is the \_\_\_\_\_ (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I  Basis of the opinion
- II  Priority
- III  Non establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV  Lack of unity of invention
- V  Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI  Certain documents cited
- VII  Certain defects in the international application
- VIII  Certain observations on the international application

3. The applicant is hereby **invited to reply** to this opinion.

**When?** See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension.

**How?** By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

**Also** For an additional opportunity to submit amendments, see Rule 66.4.  
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis.  
For an informal communication with the examiner, see Rule 66.6.

**If no reply is filed**, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: \_\_\_\_\_

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

WRITTEN OPINION

International application No. \_\_\_\_\_

I. Basis of the opinion

1. This opinion has been drawn on the basis of (*Replacement sheets which have been furnished in response to an invitation under Article 14 are referred to in this opinion as "originally filed".*):

- the international application as originally filed.
- the description, pages \_\_\_\_\_, as originally filed,  
pages \_\_\_\_\_, filed with the demand,  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_.
- the claims, Nos. \_\_\_\_\_, as originally filed,  
Nos. \_\_\_\_\_, as amended under Article 19,  
Nos. \_\_\_\_\_, filed with the demand,  
Nos. \_\_\_\_\_, filed with the letter of \_\_\_\_\_.
- the drawings, sheets/fig \_\_\_\_\_, as originally filed,  
sheets/fig \_\_\_\_\_, filed with the demand,  
sheets/fig \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

2. The amendments have resulted in the cancellation of:

- the description, pages \_\_\_\_\_
- the claims, Nos. \_\_\_\_\_
- the drawings, sheets/fig \_\_\_\_\_

3.  This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

WRITTEN OPINION

International application No.

## II. Priority

1.  This opinion has been established as if no priority had been claimed, or, if more than one priority has been claimed, as if the following priority had not been claimed: \_\_\_\_\_ ,  
due to the applicant's failure to furnish within the prescribed time limit:
- the requested copy of the earlier application whose priority has been claimed (Rule 66.7(a)).
- the requested translation of the earlier application whose priority has been claimed (Rule 66.7(b)).
2.  This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid.
3.  Thus, for the purposes of this opinion, the following date is considered to be the relevant date according to Rule 64.1:
- the international filing date indicated above.
- where more than one priority has been claimed, the following date: \_\_\_\_\_ .
4. Additional observations, if necessary:

WRITTEN OPINION

International application No. \_\_\_\_\_

III. Non establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been and will not be examined in respect of:

- the entire international application,
- claims Nos. \_\_\_\_\_

because:

- the said international application, or the said claims Nos. \_\_\_\_\_ relate to the following subject matter which does not require an international preliminary examination (*specify*):

- the description, claims or drawings (*indicate particular elements below*) or said claims Nos. \_\_\_\_\_ are so unclear that no meaningful opinion could be formed (*specify*):

- the claims, or said claims Nos. \_\_\_\_\_ are so inadequately supported by the description that no meaningful opinion could be formed.

- no international search report has been established for said claims Nos. \_\_\_\_\_



## WRITTEN OPINION

International application No. \_\_\_\_\_

## IV. Lack of unity of invention

1.  The applicant has restricted the claims and this Authority accordingly finds that the requirement of unity of invention according to Rules 13.1 and 13.2 is complied with:
- in respect of all the claims.
- in respect of the following claims which have been examined: \_\_\_\_\_  
The other claims were not subjected to international preliminary examination (see Box III).
2.  This Authority finds that, for the reasons indicated under item 4, below, the requirement of unity of invention according to Rules 13.1 and 13.2 is not complied with. It invited the applicant (Form/PCT/IPEA/405) to restrict the claims or pay additional examination fees. In response to the invitation, the applicant has:
- restricted the claims; however, the requirement of unity of invention is still not complied with.
- paid additional examination fees for the following inventions:
- paid, under protest, additional examination fees for the following inventions:
- neither restricted the claims nor paid additional examination fees.
3.  This Authority finds that, for the reasons indicated under item 4, below, the requirement of unity of invention according to Rules 13.1 and 13.2 is not complied with but it chose, according to Rule 68.1, not to invite the applicant to restrict the claims or pay additional examination fees. Therefore, this opinion is based on all claims except where indications to the contrary are made in Box III.
4. Reasons for finding of lack of unity (*only where item 2 or 3, above, applies*):
- are set out in Form PCT/IPEA/405.
- are as follows:
5. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this opinion:
- all parts.
- the parts relating to claims Nos. \_\_\_\_\_

International application No.

WRITTEN OPINION

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	_____	YES
	Claims	_____	NO
Inventive Step (IS)	Claims	_____	YES
	Claims	_____	NO
Industrial Applicability (IA)	Claims	_____	YES
	Claims	_____	NO

2. Citations and explanations

WRITTEN OPINION

International application No.

VI. Certain documents cited

1. Certain published documents (Rule 70.10)

Application No. Patent No.	Publication date ( <i>day/month/year</i> )	Filing date ( <i>day/month/year</i> )	Priority date (valid claim) ( <i>day/month/year</i> )
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2. Non-written disclosures (Rule 70.9)

Kind of non-written disclosure	Date of non-written disclosure ( <i>day/month/year</i> )	Date of written disclosure referring to non-written disclosure ( <i>day/month/year</i> )
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WRITTEN OPINION

International application No.

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

**WRITTEN OPINION**

International application No.

**VIII. Certain observations on the international application**

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

WRITTEN OPINION

International application No.

**Supplemental Box**  
(To be used when the space in any of Boxes I to VIII is not sufficient)

Continuation of Box [No.]:

## PATENT COOPERATION TREATY

## PCT

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No.	International filing date ( <i>day/month/year</i> )	Priority date ( <i>day/month/year</i> )
International Patent Classification (IPC) or national classification and IPC		
Applicant		

<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of _____ sheets.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority.</p> <p>These annexes consist of a total of _____ sheets.</p> <p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the report</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input type="checkbox"/> Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>
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Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/  Facsimile No.	Authorized officer  Telephone No.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. \_\_\_\_\_

I. Basis of the report

1. This report has been drawn on the basis of (*Replacement sheets which have been furnished in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

- the international application as originally filed.
- the description, pages \_\_\_\_\_, as originally filed,  
pages \_\_\_\_\_, filed with the demand,  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_,  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_.
- the claims, Nos. \_\_\_\_\_, as originally filed,  
Nos. \_\_\_\_\_, as amended under Article 19,  
Nos. \_\_\_\_\_, filed with the demand,  
Nos. \_\_\_\_\_, filed with the letter of \_\_\_\_\_,  
Nos. \_\_\_\_\_, filed with the letter of \_\_\_\_\_.
- the drawings, sheets/fig \_\_\_\_\_, as originally filed,  
sheets/fig \_\_\_\_\_, filed with the demand,  
sheets/fig \_\_\_\_\_, filed with the letter of \_\_\_\_\_,  
sheets/fig \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

2. The amendments have resulted in the cancellation of:

- the description, pages \_\_\_\_\_
- the claims, Nos. \_\_\_\_\_
- the drawings, sheets/fig \_\_\_\_\_

3.  This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

II. Priority

1.  This report has been established as if no priority had been claimed, or, if more than one priority has been claimed, as if the following priority had not been claimed: \_\_\_\_\_ ,  
due to the applicant's failure to furnish within the prescribed time limit:
  - the requested copy of the earlier application whose priority has been claimed (Rule 66.7(a)).
  - the requested translation of the earlier application whose priority has been claimed (Rule 66.7(b)).
2.  This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid.
3.  Thus, for the purposes of this report, the following date is considered to be the relevant date according to Rule 64.1:
  - the international filing date indicated above.
  - where more than one priority has been claimed, the following date: \_\_\_\_\_ .
4. Additional observations, if necessary:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. \_\_\_\_\_

III. Non establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been and will not be examined in respect of:

- the entire international application,
- claims Nos. \_\_\_\_\_

because:

- the said international application, or the said claims Nos. \_\_\_\_\_  
relate to the following subject matter which does not require an international preliminary examination (*specify*):

- the description, claims or drawings (*indicate particular elements below*) or said claims Nos. \_\_\_\_\_  
are so unclear that no meaningful opinion could be formed (*specify*):

- the claims, or said claims Nos. \_\_\_\_\_ are so inadequately supported  
by the description that no meaningful opinion could be formed.

- no international search report has been established for said claims Nos. \_\_\_\_\_

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. \_\_\_\_\_

## IV. Lack of unity of invention

1.  The applicant has restricted the claims and this Authority accordingly finds that the requirement of unity of invention according to Rules 13.1 and 13.2 is complied with:
- in respect of all the claims.
- in respect of the following claims which have been examined: \_\_\_\_\_  
The other claims were not subject to international preliminary examination (see Box III).
2.  This Authority finds that, for the reasons indicated under item 4, below, the requirement of unity of invention according to Rules 13.1 and 13.2 is not complied with. It invited the applicant to restrict the claims or pay additional examination fees. In response to the invitation, the applicant has:
- restricted the claims; however, the requirement of unity of invention is still not complied with.
- paid additional examination fees for the following inventions:
- paid, under protest, additional examination fees for the following inventions:
- neither restricted the claims nor paid additional examination fees.
3.  This Authority finds that, for the reasons indicated under item 4, below, the requirement of unity of invention according to Rules 13.1 and 13.2 is not complied with but it chose, according to Rule 68.1, not to invite the applicant to restrict the claims or pay additional examination fees. Therefore, this report is based on all claims except where indications to the contrary are made in Box III.
4. Reasons for finding of lack of unity (*only where item 2 or 3, above, applies*):
5. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:
- all parts.
- the parts relating to claims Nos. \_\_\_\_\_

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	_____	YES
	Claims	_____	NO
Inventive Step (IS)	Claims	_____	YES
	Claims	_____	NO
Industrial Applicability (IA)	Claims	_____	YES
	Claims	_____	NO

2. Citations and explanations

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

VI. Certain documents cited

1. Certain published documents (Rule 70.10)

<u>Application No. Patent No.</u>	<u>Publication date (day/month/year)</u>	<u>Filing date (day/month/year)</u>	<u>Priority date (valid claim) (day/month/year)</u>
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2. Non-written disclosures (Rule 70.9)

<u>Kind of non-written disclosure</u>	<u>Date of non-written disclosure (day/month/year)</u>	<u>Date of written disclosure referring to non-written disclosure (day/month/year)</u>
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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

**Supplemental Box**  
(To be used when the space in any of Boxes I to VIII is not sufficient)

Continuation of Box [No.]:





PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING 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	<b>REPLY DUE</b> see item 2 and the last paragraph below
International application No.	International filing date (day/month/year)
Applicant	

1. This International Preliminary Examining 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 Preliminary Examining 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 (see Rule 91.1(g) to (g-quarter) for further details and for time limits).

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