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

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

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

OUTLINE OF CERTAIN MATTERS TO BE DISCUSSED BY THE MEETING

Document prepared by the International Bureau

Introduction

1. This document includes an outline of certain matters which the Meeting is invited to consider under various items of the draft agenda (document PCT/MIA/III/1) at its third session, but which are not covered by other, specific, working documents prepared for the session.

Demand Form PCT/IPEA/401 (see item 5.2 of the draft agenda)

2. Annotation of the demand (and other documents) where late submission is excused. There are a number of circumstances in which submission of a demand (or other document) by the applicant after the expiration of the relevant time limit may be excused, namely:

(a) where the time limit concerned expires on a non-working day or a day on which ordinary mail is not delivered (Rule 80.5*);

(b) where the period concerned is calculated with reference to the date of sending to the applicant of another document, the mail delivery of which takes more than seven days (Rule 80.6);

(c) where the mail delivery of the demand (or other document) submitted by the applicant takes more than five days (Rule 82.1);

(d) where the postal service is interrupted for certain specified reasons (Rule 82.2).

3. In such cases, Offices or Authorities other than that which received the demand (or other document) submitted by the applicant will often not be in a position to know, without making a specific enquiry, that the relevant provision enabling excuse of the late submission has been applied.

4. The Meeting is invited to consider whether a more uniform practice should be established, and if so what practice, for annotating a demand (or other document) whose late submission is excused, and to suggest any necessary changes to the Administrative Instructions, the Forms and/or the Guidelines.

PCT Preliminary Examination Guidelines (see item 5.4 of the draft agenda)

5. Issuance of written opinions. A number of applicants have expressed concern that the international preliminary examination report is, in some cases, established without prior issuance of a first written opinion. This practice can cause difficulties for an applicant who wishes to amend the international application during the international phase. The practice seems particularly likely to be followed, and to cause problems for applicants, in

* References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”), and of the Administrative Instructions under the PCT. References to the “Guidelines” are to the PCT Search Guidelines and/or the PCT Preliminary Examination Guidelines, as the case requires.

cases where the international preliminary examination report is favorable as to the main criteria (novelty, inventive step and industrial applicability) but mentions other substantive defects which would be capable of being overcome by amendment (for example, where there are adverse comments as to clarity or as to whether the claims are supported by the description, or where the claims are not in the prescribed two-part form).

6. Concern has also been expressed by some applicants that an adverse international preliminary examination report has been issued, rather than a second written opinion, even where the applicant has made a serious attempt to address the defects mentioned in the first written opinion.

7. The Meeting is invited to consider the question of when the international preliminary examination report should be issued rather than a first (or subsequent) written opinion, and to suggest any necessary changes to the Guidelines.

Practical problems where the international search and the international preliminary examination are carried out by different Authorities (see item 6 of the draft agenda)

8. Practical problems can arise where the international search and the international preliminary examination are not carried out by the same Authority. In particular, there can be difficulties where the international search report or the references cited therein are not available to the International Preliminary Examining Authority when the international preliminary examination begins.

9. The Meeting is invited to consider what practical problems exist in these circumstances and to suggest any necessary changes to the Administrative Instructions, the Forms and/or the Guidelines.

Establishment of a uniform format for nucleotide and/or amino acid sequence listings in machine readable form under Annex C of the Administrative Instructions (see item 7 of the draft agenda)

10. Development of a standard for sequence listings in computer readable form has been the subject of consideration within the framework of the Permanent Committee on Industrial Property Information (see documents PCT/A/XVIII/9, paragraph 26; PCIPI/EXEC/IX/4; PCIPI/EXEC/IX/9, paragraph 20; PCIPI/GI/VIII/2, paragraphs 19 to 23; PCIPI/EXEC/X/8, paragraphs 27 and 28; PCIPI/GI/IX/2, paragraphs 11 to 17 and Annex III; and PCIPI/EXEC/XI/13, paragraphs 37 to 39 and Annex III) and within the framework of the trilateral program of cooperation between the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office. A standard applicable by all Offices and Authorities is needed for the purposes of Rule 13^{ter}, Sections 208 and 513, and Annex C of the Administrative Instructions.

11. The Meeting is invited to consider the progress which has been made in the development of a standard for sequence listings in computer readable form and to suggest any further action which needs to be taken.

Handling nucleotide and/or amino acid sequence listings/ in paper form and/or on diskette
(see item 8 of the draft agenda)

12. Some problems have arisen as to the procedures to be followed where the applicant files a sequence listing, on paper and/or on a diskette, with the receiving Office, for example:

(a) where a sequence listing on paper is filed at the same time as the international application but without page numbers on the sheets concerned (in which case the receiving Office could simply treat the pages as part of the international application and as giving rise to a defect under Rule 11.7 and, if applicable, to payment of a supplement to the basic fee);

(b) where a sequence listing on paper is filed later than the international application itself (in which case the listing could be treated as filed in anticipation of the requirements of Rule 13*ter*.1(a) but not as part of the international application under Rule 13*ter*.1(f));

(c) where a sequence listing on a diskette is filed at the same time as or later than the international application itself (in which case the listing could be treated as filed in anticipation of the requirements of Rule 13*ter*.1(a) but not as part of the international application under Rule 13*ter*.1(f)).

13. The Meeting is invited to consider the above matters and to suggest any necessary changes to the Administrative Instructions, the Forms and/or the Guidelines.

Impact of the EASY project on International Searching Authorities and International Preliminary Examining Authorities (see item 9 of the draft agenda)

14. Proposed amendments to the Regulations to enable implementation of the EASY system are set out in document PCT/CAL/V/2, for consideration by the PCT Committee for Administrative and Legal Matters at its fifth session to be held from May 24 to 28, 1993. That document proposes that the details of implementation of the EASY system be governed by the Administrative Instructions.

15. The Meeting is invited to discuss developments in the EASY project, having regard to the deliberations at the above-mentioned session, and particularly to address any problems relating to the International Searching and Preliminary Examining Authorities which can be foreseen in the implementation of the EASY project (for example, relating to the transmittal of the search copy where an international application is filed in electronic form) .

Establishment of two or more international search reports in relation to the same international application (see item 10 of the draft agenda)

16. It has happened that two competent International Searching Authorities have each established an international search report in relation to the same international application. A number of questions arise in that respect, for example:

(a) where two international search reports are established, what practice should be followed:

(i) in relation to the international publication of one or both reports?

(ii) in relation to the international publication, if different titles and/or abstracts have been established by the International Searching Authorities concerned?

(iii) in relation to amendments under Article 19, and in particular the time limit for filing such amendments?

(b) should an applicant be entitled to specifically request the establishment of more than one international search report (on the assumption that more than one International Searching Authority is competent and that the applicant pays the relevant search fees for each Authority concerned)?

17. The Meeting is invited to consider the matter and to advise the International Bureau on any action to be taken.

Filing of demands in relation to the same international application with two or more competent International Preliminary Examining Authorities (see item 11 of the draft agenda)

18. In several instances, it has emerged that the applicant has filed demands for international preliminary examination in relation to the international application with more than one competent International Preliminary Examining Authority. While not expressly prohibited, it is clear that such a possibility is not contemplated by the PCT or the Regulations.

19. There are, of course, certain difficulties and anomalies which arise from the filing of two demands, apart from the absence of any express authority for such action, for example:

(a) if two international preliminary examination reports are, in fact, established, which should be transmitted to the elected Offices?

(b) which version of the international application — that is, the international application as amended by which set of amendments annexed to the two international preliminary examination reports — should be regarded by the elected Offices as the version which enters the national phase?

(c) what are the consequences if different States are elected in the two demands?

20. On the other hand, from the applicant's point of view, the availability of more than one international preliminary examination report may be of considerable assistance in deciding whether and how to amend the international application and in assessing the likely prospects of the international application in the national phase. From the applicant's point of view, the payment of fees to two International Preliminary Examining Authorities for two reports may represent good value.

21. The Meeting is invited to consider the matter and to suggest whether the International Bureau should study any necessary changes to the Regulations, the Administrative Instructions, the Forms and/or the Guidelines.

Increasing the usefulness of international search reports and international preliminary examination reports for applicants and elected Offices (see item 12 of the draft agenda)

22. The following questions are proposed for consideration under this item, also taking into account the experience of Authorities in their capacities as designated Offices and elected Offices:

(a) are sufficiently detailed reasons given in international search reports and/or international preliminary examination reports for findings of lack of unity, especially in cases where the applicant disagrees with the finding and requests the elected Office to reconsider the decision of the International Searching or Preliminary Examining Authority?

(b) are the citations and explanations given in international preliminary examination reports to support the statement with regard to novelty, inventive step and industrial applicability (Box No. V of the international preliminary examination report) sufficiently detailed to be useful to the examiner in an elected Office, in particular to reduce the need for complete re-examination of the application (which may be the case where the statement contains only conclusions without reasons)?

(c) are some indications made in international preliminary examination reports so linked, in substance or in terminology, to the national law applicable by the Office acting as International Preliminary Examining Authority that they are likely to be considered irrelevant by elected Offices?

23. The Meeting is invited to consider the matter and to suggest any necessary changes to the Administrative Instructions, the Forms and/or the Guidelines with a view to making international search reports and international preliminary examination reports as meaningful as possible.

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