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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

**Fourth Session
Geneva, June 27 to July 1, 1994**

**FURTHER PROPOSALS RELATING TO
MATTERS CONCERNING THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES**

Document prepared by the International Bureau

1. Part 1 of this document contains further comments on and proposals for modification of the PCT Preliminary Examination Guidelines (document PCT/GL/3) and Rules 61.1(a) and 93.4 of the Regulations under the PCT provided by the European Patent Office. (Part 1 of this document relates to matters discussed in documents PCT/MIA/IV/2 and 8.)
2. Part 2 of this document contains a further comment on and proposal for modifications of the international preliminary examination report form (Form PCT/IPEA/409) provided by the European Patent Office. (Part 2 of this document relates to matters discussed in documents PCT/MIA/IV/5, Part 2 and PCT/MIA/IV/10.)
3. These comments and proposals, which will serve as a topic for discussion at the fourth session of the Meeting of International Authorities under the PCT, are hereby provided to all International Authorities for information and

PART 1
COMMENTS ON AND PROPOSALS FOR MODIFICATION OF
THE PCT PRELIMINARY EXAMINATION GUIDELINES AND
CERTAIN OF THE REGULATIONS UNDER THE PCT

Proposal by the European Patent Office

Meetings of International Authorities under the PCT

EPO project ELFOS

1. ELFOS = (**EL**ectronic **F**ile **O**perating **S**ystem) will handle facsimile pages of the patent application files on optical disks in The Hague and in Munich. ELFOS will make it possible to handle the content of the paper dossiers on the screen. In particular, the users will be able to view the documents, print them, send replies to the applicant and perform all other tasks now done with the paper dossiers.
2. When introducing ELFOS in respect of Chapter II file handling it may be necessary to adapt the PCT PRELIMINARY EXAMINATION GUIDELINES accordingly.
3. Chapter VII-8.1 should be made more neutral and allow that instead of the original a copy of the demand be transmitted to the IB. Therefore it is proposed to reword the Guideline as follows:
 - “8. Transmittal of the demand to the International Bureau.
 - 8.1 The International Preliminary Examining Authority transmits the **[original]** demand to the International Bureau in all cases, including demands ...”
4. It is further proposed that Rule 61.1(a) , second sentence PCT should be clarified as follows:

“The International Preliminary Examining Authority shall promptly send the demand or a copy thereof to the International Bureau, and shall keep the original or a copy in its files.”

5. In addition, paragraph 295 of the PCT Applicants' Guide should be changed appropriately.
6. Chapter VI–8.16 last sentence should be harmonised with Rule 70.14 where no signature is requested. It is proposed to substitute the words “be signed by an” by **“Indicate the name of an”**.

This would bring that Guideline in line with the PCT Search Guidelines Chapter X–7.2, Rule 43.8 and Administrative Instruction 514.

7. Rule 93.4 PCT stipulates that records, copies and files also means photographic reproductions of records, copies and files, whatever the form of such reproductions may be. Accordingly, PCT files may consist not only of the “hard copy” but also of photographic reproductions thereof. However, it cannot be considered that the data stored in ELFOS files, which were obtained by way of scanning the original documents, or even a print-out from an ELFOS file are photographic reproductions. They are data obtained, stored and reproduced by **electronic** means.

Therefore the EPO insists that Rule 93.4 PCT be amended as already discussed in the PCT/CAL/V meeting (see Doc. PCT/CAL/V/4, p. 9:

“93.4 Reproductions

For the purpose of this Rule, records, copies and files shall also mean photographic **electronic or other** reproductions of records, copies and files, **for example, on paper, in microform or stored on electronic media (microfilms, computerised records, optical discs, or other).**”

PART 2

COMMENT ON AND PROPOSAL FOR MODIFICATION OF ONE OF THE FORMS
FOR USE BY THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES

Proposal by the European Patent Office

Form PCT/IPEA/409

1. Since the international preliminary examination report is the end of the Chapter II procedure, the applicant should be informed by means of a small notice incorporated in Form 409 that no further amendments/observations are accepted by the IPEA but that any such amendments/observations should preferably be filed in the national/regional phase.

2. **Reason for the proposal**

Currently, many applicants file further amendments to their international application after they have received the IPER and want to continue the procedure with the IPEA. This causes additional work for the IPEA which is obliged to deal with these documents, even if only to send a notification to the applicant to inform him accordingly .

By inserting a note in the IPER, it is expected that the number of further amendments will decrease.

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