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

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PCT**

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

COMMENTS ON AND PROPOSALS FOR MODIFICATION OF THE  
PCT PRELIMINARY EXAMINATION GUIDELINES  
RECEIVED FROM INTERNATIONAL AUTHORITIES

*Document prepared by the International Bureau*

1. The Annex to this document contains comments on and proposals for modification of the PCT Preliminary Examination Guidelines (document PCT/GL/3) provided by the United States Patent and Trademark Office.
2. 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 comment.

[Annex follows]

ANNEX



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

MAR - 9 1994

Busso Bartels  
Head, PCT Legal Section  
World Intellectual Property Organization  
P.O. Box 18  
1211 Geneva 20  
Switzerland

Dear Busso,

Attached are comments of the United States Patent and Trademark Office on and proposed changes to the PCT Preliminary Examination Guidelines. It is understood that these comments may serve as a topic for discussion at an upcoming Meeting of International Authorities under the PCT.

Sincerely,

*C.E. Van Horn*

Charles E. Van Horn  
Patent Policy and Projects Administrator  
Office of the Assistant Commissioner for Patents

## IPEA GUIDELINES

The IPEA Guidelines should allow some variation in practice, and make clear when IPEAs are taking a different approach. As many of the differences between IPEAs are no doubt based on differences in substantive law, consistency in practice is dependent on consistency in substantive law principles. Although the proposals made below would be consistent with U.S. law and practice, we have no intent of asking other authorities to change their practice to be consistent with our law. Likewise, however, we do not intend to have our examiners operating under different standards of examining practice for PCT and national applications. Unless the Guidelines are amended to reflect differences among the IPEAs, the national offices are not likely to fully appreciate the content of the preliminary examination report.

### CHAPTER I

PARAGRAPH 3.3 – The PCT should not impose rigid procedures which require examiners to adopt practices substantially different from their national practice. Therefore, provisions should be made for some flexibility in the Guidelines. Accordingly, paragraph 3.3 of Chapter I should be modified as follows (note that additions are underlined and deletions are indicated in brackets) :

3.3 The Guidelines are intended to cover typical occurrences. They should therefore be considered only as general directives; examiners will have to go beyond the instructions in exceptional cases. Nevertheless, applicants can expect the International Preliminary Examining Authorities to act, as a general rule, in accordance with the Guidelines until such time as they are revised. It should be noted also that the Guidelines do not have the binding authority of a legal text, **and as such, these Guidelines are merely advisory to the International Preliminary Examining Authorities.** For the ultimate authority on questions concerning international preliminary examination, it is necessary to refer to the PCT itself interpreted, where necessary, by reference to the Minutes of the Washington Diplomatic Conference.

### CHAPTER II

PARAGRAPH 2.2 – In U.S. practice, the abstract has legal effect and can be used to justify adding subject matter found in the abstract to the description. Specifically, U.S. law considers the abstract to be a part of the specification of an application which can be relied upon to provide an acceptable disclosure of the claimed invention. In re Armbruster, 185 USPQ 152 (CCPA 1975). Accordingly, the last sentence should be rewritten as follows:

2.2 Rule 8 delineates the requirements for the abstract

and it is for the International Searching Authority (Rule 38.2) to establish its final form (see Chapter XI, paragraphs 1 to 5 of the PCT Search Guidelines). The examiner will not be concerned with seeking any amendment of the abstract. He should, however, note that the abstract [has no legal effect on the international application containing it; for instance, it] cannot be used to interpret the scope of protection [or to justify the addition of new subject matter].

PARAGRAPH 4.4 - The U.S. takes a relatively strict position as to what constitutes new matter. The provisions of this paragraph which instruct the examiner to invite amendments containing additional descriptions of the prior art may involve the solicitation of new matter under U.S. law.

An applicant for a U.S. patent need only provide a disclosure which enables one skilled in the art to make and use the invention. There is no requirement that applicant describe the background of the invention - the state of the prior art at the time the invention was made.

An applicant may not introduce new matter into an application after the filing date. New matter is generally considered to be information that is not explicitly, implicitly, or inherently disclosed in the application as filed. Generally, the prohibition against adding new matter does not depend on whether the information was known at the time the application was filed. It has been held that the specification need not include that which is known and available to the public at the time the invention was made. In fact, "a patent need not teach, and preferably omits, what is well known in the art." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81 (Fed. Cir. 1986).

The introduction of background information to an application is generally not permitted. For example, in General Railway Signal Co. v. Thullen, 32 App. D.C. 575, a general reference to transformers in the original application was not considered to have been a sufficient disclosure to justify entry of an amendment to specific transformers. However, in In re Chaplin, 77 USPQ 601 (CCPA 1948), an applicant was permitted to amend his specification to cite expired patents to illustrate mechanisms for driving various parts of a machine that were referred to in the original specification as being well known in the art. The court in Chaplin relied on the Supreme Court decision in The Webster Loom Co. v. Higgins, 105 U.S. 580 (1882) which stated "That which is common and well known is as if it were written out in the patent and delineated in the drawings."

Accordingly, such amendments require careful scrutiny and should not be solicited. Such amendments may be added during the national phase if the national law so permits.

Rewrite paragraph 4.4 as follows:

4.4 Background art. The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims (see Chapter III, paragraph 2.2). The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, **[should be invited] may be permitted, [where necessary, to put the invention into proper perspective,]** provided that the amendment would not go beyond the disclosure in the international application as filed. For instance, while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. **[In such a case, the examiner should invite the inclusion of a reference to these documents and a brief summary of the relevant contents. The subsequent inclusion of such a summary in the description does not contravene Article 34(2)(b). The latter merely lays down that, if the application is amended, for example by limiting it in the light of additional information on background art, its subject matter must not extend beyond the content of the application as filed. But the subject matter of the application within the meaning of Article 34(2)(b) is to be understood—starting off from the prior art—as comprising those features which, in the framework of the disclosure required by Article 5, relate to the invention (see Chapter VI, paragraph 7.8). References to the prior art introduced after filing must be purely factual. Any alleged advantages of the invention must be adjusted if necessary in the light of the prior art.]** New statements of advantage are permissible provided that they do not introduce into the description matter which could not have been deduced from the application as originally filed (see Chapter VI, paragraph 7.9).

### CHAPTER III

PARAGRAPH 3.7a - U.S. law and PCT Rule 6.4(b) provide that a dependent claim must include all of the limitations found in the claim from which it depends. U.S. practice does not permit a claim in dependent form which does not include all of the limitations of its parent claim. In addition, paragraph 3.7a

indicates that if a product is unobvious, a process which results in or uses that product is also unobvious. This interpretation is not consistent with current U.S. law. We propose that the first two sentences of paragraph 3.7a be retained and the remainder be eliminated.

3.7a A claim may also contain a reference to another claim even if it is not a dependent claim as defined in Rule 6.4. One example of this is a claim referring to a claim of a different category (e.g., "Apparatus for carrying out the process of Claim 1 ...", or "Process for the manufacture of the product of Claim 1 ..."). Similarly, in a situation like the plug and socket example in paragraph 3.3 of this Chapter, a claim to the one part referring to the other cooperating part (e.g., "plug for cooperation with the socket of Claim 1 ...") is not a dependent claim. **[References from one claim to another may also occur where alternative features which may be substituted for one another are claimed in separate claims. Thus, there may be a first independent Claim 1 for a machine including, inter alia, a feature X followed by further claims for alternatives such as "A machine according to Claim 1 modified in that feature X is replaced by feature Y." In all these examples, the examiner should carefully consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not. In the case of a claim for a process which results in the product, of a product claim, or a claim for the use of that product, if the product claim does not give rise to objections on novelty or inventive step grounds, then no separate examination for the obviousness of the process or use claim is necessary (see Chapter IV, paragraph 8.5). In all other instances, the fact that the claim referred to contains novel and inventive matter does not necessarily imply that the same is also true of the independent claim containing the reference.]**

PARAGRAPH 4.8 - The first example in this paragraph is inconsistent with U.S. practice in that a fish-hook may, in certain devices, such as miniature or toy cranes, be suitable for or capable of functioning as a hook for a crane. Therefore, we propose to modify this paragraph as follows:

4.8 If a claim commences with such words as "Apparatus for carrying out the process, etc., ..." this must be construed as meaning merely apparatus suitable for carrying out the process. Apparatus which otherwise possesses all of the features specified in the claim, but which would be unsuitable for the stated purpose or which would require modifications to enable it to be so used,

should not normally be considered as coining within the scope of the claim. Similar considerations apply to a claim for a product for a particular use. [For example/ **if a claim refers to "a hook for a crane," this implies, e.g., particular dimensions and strength in the hook. Therefore, a fish-hook could never come within the claim.**] **For example, if a claim refers to a "mold for molten steel," this implies certain limitations for the mold. Therefore, a plastic ice cube tray with a melting point much lower than that of steel would not come within the claim.** Similarly, a claim to a substance or composition for a particular use should be construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which is per se the same as the substance or composition defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty.

PARAGRAPH 4.9 - U.S. law does not permit claims drawn to a "use of" a substance. Such "use of" claims have been held to be improper process claims in that they fail to recite any process steps, and were accordingly found to be indefinite. Ex parte Erlich, 3 USPQ2d 1011 (BPAI 1986). Other cases have held that "use of claims" do not constitute a process and therefore do not qualify as statutory subject matter under 35 U. S. C. 101. Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967), Clinical Products, Ltd. v. Brenner, 255 F.Supp. 131, 149 USPQ 475 (D.D.C. 1966). **Accordingly, paragraph 4.9 of Chapter III should be deleted in its entirety.**

#### CHAPTER IV

PARAGRAPH 5.2 - Under U.S. law, non-patent literature having a publication date after the relevant date of an application may still constitute prior art or be relevant to the claimed invention in certain circumstances. For example, a document published after the filing date of an application may be used to establish that undue experimentation would be required to make or use the invention, that a recitation absent from the claims is critical, that the invention is inoperative, that a claim is indefinite or that characteristics of a prior art product were known. See In re Hogan, 194 USPQ 527 (CCPA 1977). Accordingly, provision should be made to cite such documents. An appropriate amendment to PCT Rule 64 may be in order. Also, under U.S. law, a written work must be accessible to the public to qualify as prior art. For example, a printed work must be cataloged and not merely placed on the shelf of some library. In addition, there is no need to again cite documents listed in the search report. Therefore, the phrase ", but are mentioned in the preliminary examination report" should be deleted as indicated below.

5.2 A written disclosure, i.e., a document, should be

regarded as made available to the public if, at the relevant date (as to "relevant date," see paragraph 5.4 of this Chapter), it was **[possible for members of the public to gain knowledge of the content of the document] accessible to the public** and there was no bar of confidentiality restricting the use or dissemination of such knowledge. As a general rule, no non-patent document will be cited in the international search report if the date of publication or public availability of the document concerned is clearly the same as, or later than, the filing date of the international application. However, patent documents published on or after the filing date of the searched application will be cited in the search report if the filing or priority date of such published application is earlier than the filing date of the searched application. Such published patent documents, although cited in the search report, are not considered as prior art for the purposes of Article 33(2 and (3) **[, but are mentioned in the preliminary examination report]**. The international search report may have cited a document where there is difficulty in establishing whether the date of publication or public availability of the document is or is not the same as, or later than, the filing date of the international application. The International Searching Authority will have tried to remove any doubt that may exist. Additional documents providing evidence in the case of doubt may have been cited. Any indication in a document of the date of its publication should be accepted as correct by the examiner unless proof to the contrary has been offered, e.g., by the International Searching Authority, showing earlier publication, or by the applicant, showing later publication. Also, if there is any ambiguity as to the precise date of publication of a document, the International Searching Authority may have established a publication date, e.g., the date of receipt in a library to which the public has access. If the applicant presents sound reasons for doubting that the document forms part of the prior art in relation to his international application and any further investigation does not produce evidence sufficient to remove that doubt, the examiner should not pursue the matter further.

PARAGRAPHS 5.3 & 5.4 - Move "64.1(b)" in the margin from paragraph 5.3 to 5.4, since paragraph 5.4 deals with the relevant date.

PARAGRAPH 8.7 - U.S. law provides that the number of documents which are combined is not relevant to a finding of obviousness. Therefore, the 4th line from the end of page 3 9 should be deleted. In addition, the phrase "it would be natural" is unclear; the phrase —there is reasonable basis— is more appropriate.



8.7 In considering whether there is inventive step as distinct from novelty (see section 7 of this Chapter), it is permissible to combine the disclosure of two or more documents or parts of documents, different parts of the same document or other pieces of prior art, but only where such combination would be obvious to the person skilled in the art. In determining whether it would be obvious to combine two or more distinct documents, the examiner should have regard to the following:

(i) whether the nature and content of the documents are such as to make it likely or unlikely that the person skilled in the art, when concerned with the problem solved by the claimed invention, would combine them;

(ii) whether the documents come from similar, neighboring or remote technical fields. [ ;

**(iii) the number of documents which need to be combined.]**

The combining of two or more parts of the same document would be obvious if **[it would be natural] there is reasonable basis** for the person skilled in the art to associate these parts with one another. It would normally be obvious to combine with other prior art documents a well-known text book or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents, one of which contains a clear and unmistakable reference to the other.

## CHAPTER V

PARAGRAPH 1.5 - U.S. law does not permit two different priority dates for a single claim. Specifically, to be entitled to foreign priority under U.S. law (35 U.S.C. 119), the priority application must provide a sufficient written description of the entire subject matter of the claim in question. In re Gosteli, 10 USPQ2d 1614 (Fed. Cir. 1989) . In addition, a mere reference in one application to a second application may not be sufficient to establish that the subject matter of the first application may form a combination with the subject matter of the second application. Accordingly, the following changes should be made.

1.5 An international application may claim rights of priority based on more than one earlier application ("multiple priorities"), even if they originate in different countries. The earliest application must have

been filed not more than 12 months before the date of filing of the international application. An element of an international application will be accorded the priority date of the earliest priority application which discloses it. If, for instance, the international application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the preceding 12 months, the priority dates of the French and German applications may be claimed for the appropriate parts of the international application; embodiment A will have the French priority date and embodiment B will have the German priority date. **[If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have different priority dates.]** If, **on the other hand,** an international application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the international application itself. In other words, it is not [normally] permitted to make a mosaic of the priority documents. An exception might arise where one priority document contains a reference to the other **and explicitly states that features from the two documents can be combined in a particular manner.**

## CHAPTER VI

PARAGRAPH 4.12 – A letter must be filed with each amendment which draws attention to the differences between the replaced sheets and the replacement sheets. Accordingly, the following changes should be made in the first sentence of this paragraph.

4.12 When amendments to the description, claims or drawing are made under Rule 66.8, **[they may be accompanied by an explanation] they must be accompanied by a letter which draws attention to the differences between the replaced sheets and the replacement sheets.** These amendments may have been submitted to avoid possible objections of lack of novelty or lack of inventive step in view of the citations listed in the international search report: to meet any objections noted by the International Searching Authority under Article 17(2)(a)(ii) (i.e., that all or at least some claims do not permit a meaningful search) or under Rule 13 (i.e., that there is a lack of unity of invention); or to meet objections that may be raised for some other reason, e.g., to remedy some obscurity which the applicant himself has noted in the original documents.

PARAGRAPH 8.16 – This paragraph indicates that the IPER must be signed. This is inconsistent with Rule 70.14, which indicates that the IPER "shall indicate the name of the officer responsible for the report."

In the next to last line of this paragraph, change "be signed by" to – indicate–.

8.16 When completing the certification of the report, the examiner must indicate the date on which the demand for international preliminary examination was submitted and the date on which the report was completed and the name and address of the International Preliminary Examining Authority. These last-mentioned items may either be completed when including the other data or when completing the certification. Every international preliminary examination report must **[be signed by]** **indicate the name of** an authorized officer of the International Preliminary Examining Authority responsible for that report.

## CHAPTER VII

PARAGRAPH 15.1 – In line 6, "sends" should be changed to – may send–. This change gives flexibility to the IPEA & may decrease the amount of paper generated.

15.1 If the International Preliminary Examining Authority finds one or more defects referred to in Rule 60.1(a) and (b), it invites the applicant to correct the defects within one month from the date of the invitation (Form PCT/IPEA/404). The International Preliminary Examining Authority notifies the International Bureau by sending it a copy of the invitation. Where the defect consists of the lack of the signature and Rule 53.8(b) does not apply (see paragraph 11 of this Chapter), the International Preliminary Examining Authority **[sends]** **may send** to the applicant, together with the invitation to correct, a copy of the last sheet of the demand which the applicant returns after affixing thereto the prescribed signature.