

WIPO



PCT/MIA/IV/5

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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**

MATTERS CONCERNING THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES

Document prepared by the International Bureau

1. Part 1 of this document contains comments on and proposals for modification of Section 602 of the Administrative Instructions under the Patent Cooperation Treaty (PCT) provided by the European Patent Office.
2. Part 2 of this document contains comments on and proposals for modification of some forms for use by the International Preliminary Examining Authorities provided by the Australian Industrial Property Organisation, the European Patent Office, the United Kingdom Patent Office and the United States Patent and Trademark Office.
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 comment.

PART 1

COMMENTS ON AND PROPOSALS FOR MODIFICATION OF
THE ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

Proposal by the European Patent Office

We propose the following small change¹ (change in italic):

PCT ADMINISTRATIVE INSTRUCTIONS

PART 6

Section 602 – Processing of Amendments by the International
Preliminary Examining Authority

“(a) The International Preliminary Examining Authority shall:

(i) indelibly mark, in the upper right-hand corner of

.....

(ii) indelibly mark, in the middle of the bottom margin
of each replacement sheet, the words “*AMENDED SHEET (RULE 66.8)*”
or their equivalent in the language of the demand as well as an
indication of the International Preliminary Examining
Authority as provided for in Section 107(b);

.....”

This would make it clear what kind of rectification/amendment was meant
(reference is made in this context to sections 511, 607 and 417b).

¹ In the case that the ADMINISTRATIVE INSTRUCTIONS will be changed in addition a similar change could be envisaged concerning PART 3 - INSTRUCTIONS RELATING TO THE RECEIVING OFFICE - Section 325 - Corrections of Defects under Rule 26.4(a), Rectifications of Obvious Errors under Rules 4.10(b) and 91.1, and Corrections under Rule 9.2

“(a) Where the receiving Office receives a correction of
defects under Rule 26.4(a)

(ii) indelibly mark, in the middle of the bottom margin
of each replacement sheet, the words “*SUBSTITUTE SHEET (RULE
26)*” (where the replacement sheet contains a correction of
defects under Rule 26) or “*RECTIFIED SHEET (RULE 91)*”
(where the replacement sheet contains the rectification of an obvious
error) or their equivalent ”

PART 2

COMMENTS ON AND PROPOSALS FOR MODIFICATION OF SOME FORMS
FOR USE BY THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES

2.1 Proposal by the Australian Industrial Property Organisation

In box 1 of the written opinion and IPER the reference to claim numbers creates problems when a new claim page is filed which has part of a claim on it. Some means of identifying particular line numbers of claims appears to be required.

The reference to “certain documents cited” in box VI of the written opinion and the IPER does not seem to adequately reflect its purpose, namely, that it is concerned with cited documents which have an earlier priority date but were filed after the present international application. This wording is suggested.

2.2 Proposal by the European Patent Office

Form PCT/IPEA/415:

For practical reasons the EPO is using one form per file. It is proposed to change the layout accordingly.

In order to do so a new line for entering the relevant application number should be introduced and the space preserved for the entry of numbers of documents could be deleted.

[Sample shown on the next page]

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

NOTIFICATION CONCERNING
DOCUMENTS TRANSMITTED

To:

The International Bureau of WIPO
34, chemin des Colombettes
CH-1211 Geneva 20
Switzerland


Date of mailing
(day/month/year)

International application No.

This International Preliminary Examining Authority transmits herewith the following documents:

1. demand (Rule 61.1(a)).
2. copy of ^{the} international preliminary examination report and ~~its~~ annexes (Rule 71.1).
3. _____ other documents (specify):

The Annex contains a list identifying each document transmitted by the type of document it is, the corresponding international application number and, if necessary, other information.

Name and mailing address of the IPEA/
 European Patent Office, Erhardstrasse 27
 W-8000 Munich 2
 Tel. (+49-89) 2399-0, Tx: 523656 epmu d
 Fax: (+49-89) 2399-4465

Authorized officer

2.3 Proposal by the United Kingdom Patent Office

Written Opinion Form PCT/IPEA/408

The UKPO wishes to propose that first sheet of the Written Opinion Form be amplified as follows:

- (a) the Opinion should state how many sheets it consists of (cf entry 2 on the first sheet of the IPE Report Form PCT/IPE A/409);
- (b) there should be a box to indicate that the Written Opinion is accompanied by copies of cited documents, preferably including a space to indicate the number of such documents (eg 1 or 2).

2.4 Proposal by the United States Patent and Trademark Office

- PCT/IPEA/408
Cover Sheet
- Item 4 should be deleted. There is no substantial reason for giving the final date for establishing the IPER. In addition, it encourages late responses.
- PCT/IPEA/408
PCT/IPEA/409
Box I, Item 1
- After "the claims," change "Nos." to "-.pages/nos.-". This change allows flexibility. Our examiners have found the practice of identifying the pages of claims to be preferable over identifying the actual claim numbers. This is the practice which was in effect prior to January 1994. Also, confusion arises when subsequently filed substitute and rectified sheets are identified as "originally filed."
- PCT/IPEA/408
PCT/IPEA/409
Box II
- In item 1, delete "within the prescribed time limit the requested." There is nothing which prohibits the examiner from treating the priority claim as if it had not been made prior to receiving the priority document or translation thereof.
- In item 2, insert "-for the following reasons-" before the period in the first sentence. Also, more space should be allowed to permit the insertion of an explanation as to why the priority claim was invalid.
- PCT/IPEA/408
PCT/IPEA/409
Box IV
- Add an area where the reasons for finding lack of unity can be listed.
- PCT/IPEA/408
PCT/IPEA/409
Box VI
- Add a section for citation of non-patent literature having a publication date after the relevant date. As an alternative, such documents can be listed in under the heading "New Citations" in Box V, Item 2.