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OBSERVATIONS BY THE EUROPEAN PATENT OFFICE
RELATING TO DOCUMENT PCT/MIA/IV/2

Document prepared by the International Bureau

The Annex to this document contains observations by the European Patent Office on the comments and proposals for modification of the PCT Preliminary Examination Guidelines provided by the United States Patent and Trademark Office contained in document PCT/MIA/IV/2.

[Annex follows]

ANNEX

COMMENTS ON DOCUMENT PCT/MIA/IV/2

USPTO comments and proposals for modification of the PCT Preliminary Examination Guidelines

I. INTRODUCTORY COMMENT

1. The EPO considers it essential to maintain a harmonized practice among the IPEA's to the greatest extent possible. If this principle is weakened, more differences between the International Preliminary Examination Reports (IPER) will arise.

   This may well diminish the value of the IPER for applicants and the various elected Offices because they may be in doubt as to the basis of the statements appearing in the report.

2. Therefore, the aim of the EPO is to strive for harmonized international preliminary examination procedure, taking into consideration that Article 27(5) PCT allows the elected States to apply their substantive law after the international application has entered the national/ regional phase.

II. THE USPTO PROPOSALS

Chapter I
Paragraph 3.3

3. The USPTO proposal aims to dilute the Guidelines in rendering them **“merely advisory”** instead of **“guiding”.**

However, the agreements between WIPO and all the International Authorities under the PCT provide, in Article 2(1), last sentence, that the Authority “shall be guided by the Guidelines” (in French: “se conforme aux”, which means that the IPEA shall act in compliance with the Guidelines).

Therefore, the EPO cannot support the USPTO proposal.

Chapter II

Paragraph 2.2 - Abstract

4. The USPTO proposes cancelling the indication that the abstract may not “justify the addition of new matter” because such an addition to the scope of the description as filed is permitted under US practice.

5. The EPO would like to emphasise that Article 3(3) PCT, which is identical to Article 85 EPC, specifies that the abstract cannot be taken into account for any other purpose than technical information.

Based on this wording the EPO Boards of Appeal have consistently held that the abstract cannot be used to broaden the scope of the application as filed.

6. The USPTO Rules of Practice do not include the limitation of Article 3(3) PCT and therefore it is not surprising that the case law is different from that based on the PCT/ EPC wording.

7. The current PCT Guideline clarifies that a negative statement may appear in the written opinion or the IPER regarding an amendment of the description which would be

considered as not allowable if it went beyond the disclosure in the description as filed (Art. 34(2) (b) PCT) but was based on the subject-matter of the abstract.

8. The indication should therefore be retained. A further argument for following the current Guideline is that since the ISA is competent for the final wording of the abstract, it would be legally incorrect that a change by the ISA extending the scope of the originally filed abstract could permit a broadening of the original disclosure by the applicant .

Paragraph. 4.4 - Background, art

9. The USPTO proposes cancelling from Guideline II-4.4 the requirement that the examiner should invite the applicant to include references to the prior art cited in the search report with a view to giving a better understanding of the inventive subject-matter in comparison with the prior art .

10. Although the EPO acknowledges that the interpretation of the universal principle of not adding new matter may be stricter in the US than in Europe, it should be emphasised that the PCT Guideline is based on Rule 5(1)(a)(ii) PCT, which explicitly requires that the description shall “Indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the Invention, and, preferably, cite the documents reflecting such art”.

Consequently, the USPTO proposal cannot be supported.

Chapter III

Paragraph 3.7a - Not true dependent claims

11. The proposal referring to III-3.7a contains two parts:

(a) Alternative features being- substituted for one another in a "not–true" dependent claim

12. The EPO agrees to the proposed deletion of the 4th sentence of the Guideline "References … by feature Y".

(b) Process or use claims where product claim is patentable

13. However, the EPO cannot support the proposed deletion of the last two sentences of Guideline III-3.7a.

It is a long-established practice in Europe, amply supported by precedent, that where a product is considered as patentable the patentability of that product extends to a specific method disclosed in the application which results in the product. The same applies to a claim for a specific use of that product also disclosed in the application.

This principle means that no separate search and examination are necessary.

14. Departure from that principle, as the USPTO proposes, would have far-reaching consequences for the activity of the EPO as ISA and IPEA as far as the costs of carrying out international search and examination are concerned.

15. In this context, the EPO has taken note of the “Biotech Process Patent Bill” adopted by the US Senate last September, which is intended to preclude the rejection of a process claim on grounds of obviousness where the process uses a novel and non-obvious starting material, and this approach is likely to extend to other chemical fields.

16. Finally, one wonders whether the USPTO proposal is perhaps linked to the different practices on unity of invention applying, on the one hand, in the PCT procedure – based on new Rule 13 PCT – and, on the other hand, under US national law, which is not yet harmonised with the PCT provisions. In this respect the EPO refers to Annex B “Unity of Invention” to the PCT Administrative Instructions, and more specifically to Part l(e), which explicitly provides

“In addition to an Independent: claim for a given product, an Independent claim fox- a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product”.

Reference is also made to Examples 1, 6 and 7 of the Administrative Instructions, Annex B.

Paragraph 4.8 – Fish hook/Mould for molten steel

17. The EPO agrees to the USPTO proposal.

Paragraph 4.9 – Use claims

18. Although the EPO agrees in principle that “use” claims belong to the category of “method” or “process” claims, “use” claims play an important role in European patent practice because they are considered by the applicants to define the scope of the invention better. A good example is the use of new or known substances for the first or second medical use where method claims were not acceptable because of the exception to patentability of medical treatments applied to the human or animal body.

19. Also, Annex B (“Unity of Invention”) of the Administrative Instructions under the PCT gives many examples where “use” claims are presented as current practice under the Treaty.

Additionally, the EPO fears that if “use” claims should give rise to negative statements by certain IPEAs, applicants may suffer loss of rights on entry into the national/regional phase with elected Offices which allow this kind of claiming.

20. Consequently, the EPO does not support the deletion of Guideline 4.9, but proposes including a **statement: in the IPER** where it is based on “use” claims:

“No unified criteria exist in the PCT as to acceptance of “use” claims. In some States, for example, such “use” claims have been held to be improper process claims.”

Chapter IV
Paragraph 5.2 – Novelty; prior art:

21. a) The EPO is not sure whether it understands the USPTO proposal addressed in the introductory explanation regarding Guideline IV-5.2.

If the proposal aims to consider for novelty patent documents published after the filing date of the examined application but not belonging to the "E-documents" category, the EPO cannot support this. Rule 64.1 PCT defines clearly the term "relevant date", and this should not be amended; this is due to the principle that novelty and inventive step are evaluated on the basis of the prior art available on the date of filing or the date of priority of the examined application. Moreover, any change in the direction of the USPTO proposal would have incidence on the carrying out of the international search.

b) Furthermore, the EPO cannot support the USPTO proposal to delete **"but are mentioned in the preliminary examination report"** in lines 11 and 12 of Guideline IV-5.2. Mentioning documents of category "E" in the examination report in accordance with Rule 70.10 PCT is of primary importance for elected Offices and applicants, with the view to clarifying for them that such documents may be considered in the national/regional phase.

c) The EPO sees no strong objection to the USPTO proposal regarding line 3 of Guideline IV-5.2, although it is not convinced that **"accessible to the public"** is clearer than "possible for members of the

public to gain knowledge of the content of the document".

Paragraphs 5.3 and 5.4

22. The USPTO proposal is acceptable.

Paragraph 8.7 – Combining- documents

23. Although the EPO agrees that the number of documents is not always pertinent in considering inventive step, this may play a certain role in inventions relating to a combination of features from documents belonging to the prior art. If the combination includes features disclosed in more than two or three documents, this may be a factor supporting non-obviousness.

24. Therefore the EPO prefers not to delete sub-paragraph (iii) of Guideline IV-5.2.

25. Concerning replacement of **"it would be natural"** by **"there is reasonable basis"**, the EPO agrees that more clarity is necessary. Because **"reasonable basis"** might also be difficult to interpret, the EPO suggests that the sentence be reworded as follows:

"The combining of two or more parts of the same document would be obvious **if [it would be natural] the person skilled in the art would inevitably be led to do so [for the person skilled in the art to associate these parts with one another]".**

Chapter V

Paragraph 1.5 – Multiple priorities

(a) Cancelling the admissibility of claiming alternatives having different priorities In one single claim

26. Although this is permitted under EPO practice, the EPO recognises that there is no common PCT/EPC legal basis for it.

Consequently the EPO can agree to the USPTO proposal because any future practice based on the USPTO proposal is not likely to lead to a loss of rights on entering the national/regional phase.

(b) Clarification as to “mosaic” priority In one claim

27. The USPTO proposal is acceptable.

Chapter VI

Paragraph 4.12 – Letter accompanying amendments

28. The USPTO proposal is acceptable in principle.

For the EPO it is important to keep the requirement that applicants explain the reasons for the amendments.

29. Therefore the EPO proposes to add the following at the end of the proposed sentence:

“replacement sheets and explain the reasons for the Amendments”.

Paragraph 8.16 – Authorised officer

30. The EPO supports the USPTO proposal

Chapter VII

Paragraph 15.1 – Lack of Signature

31. The EPO support s the USPTO proposal.

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