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PATENT COOPERATION TREATY (PCT) WORKING GROUP

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PROPOSAL FOR MODIFICATION OF THE PCT ADMINISTRATIVE INSTRUCTIONS

Document prepared by the European Patent Office, Japan and the United States of America

SUMMARY

1. In November 2007, the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office (the Trilateral Offices) agreed on finalization of a Common Application Format (CAF) and publicized the agreement on the Trilateral website.
2. The Common Application Format is established within the framework of the current PCT system. Therefore, an application made according to the CAF should be accepted by any of the PCT receiving Offices as of now. However, some titles in the CAF are not the same as those recommended in the current Administrative Instructions.
3. This proposal is to clarify the conformance of the CAF to the PCT Administrative Instructions by adding an option of the headings in the CAF.
4. The benefit of the proposed modification is significant because the applicants clearly recognize the merit that the CAF can be used not only for the direct national application to the Trilateral Offices or other offices which accept the CAF but also for the PCT applications.
5. A draft of proposed modification of PCT Administrative Instructions is presented in the Annex to this document. The Working Group is invited to consider the proposal.

BACKGROUND

6. In November 2005, the Trilateral Offices established a Technical Working Group on the Formal Aspects of Patent Applications in response to a request made by the Industry Trilateral that the Trilateral Offices begin working on the standardization of formal aspects of patent applications. The Trilateral Offices have come to an understanding with respect to a common format for patent applications in response to the request from users, after having intensive discussions at six Working Group meetings from 2006 to 2007. As a result, the Trilateral Office agreed on finalization of a Common Application Format (CAF) and publicized the agreement on the Trilateral website in November 2007.

7. Full details of the Common Application Format can be found on the Trilateral website at <http://www.trilateral.net/news/20080425/index.php>. The document consists of the paper titled "Basic Principles of the Common Application Format" and two Annexes thereto, that is, Annex I titled "Common Requirements for All Types of Documents" and Annex II titled "Comparative Table of Examples for Each Type of the Applications."

SUMMARY OF THE AGREED-UPON COMMON APPLICATION FORMAT

8. As described in the document noted above, an application which complies with the CAF shall be accepted without any further amendment by any of the Trilateral Offices as a national/regional application as far as the agreed-upon formal requirements are concerned. The details of the requirements are described in Annex I of the agreement.

9. Each of the Trilateral Offices may provide requirements which are more favorable for applicants than the requirements provided for by the CAF.

10. The CAF allows an applicant wishing to file an application in each office need only prepare a single application in the CAF, and it will be accepted by each office without the need for amendments (except for amendments made in response to substantive objections/rejections that may be required by national/regional law after filing). The need to prepare only a single application will result in a considerable cost savings to applicants.

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11. When applications drafted according to the CAF agreement are also acceptable as international applications under the PCT, it is expected that this will bring more significant benefits to applicants than those brought by the CAF agreement among the Trilateral Offices.

12. "Headings of the Parts of the Description" set forth in the current Section 204 of the Administrative Instructions under the PCT are listed only as recommended ones and on a flexible basis. This means the headings in the CAF also falls within the framework of the current PCT system. However, in order to clarify that the users can file a PCT application using the CAF, it is preferable to modify the Administrative Instructions, by adding an option of the headings in the CAF.

13. The proposed text is contained in the Annex to this document. This proposal is co-sponsored by the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office.

14. First, the proposed marked-up text of Section 204 that provides for “Headings of the Parts of the Description” is presented in the Annex. Modifications on this proposal shown as underlined, that is, addition of the headings “Summary of Invention”, “Description of Embodiments” and “Title of Invention” is related to the provisions of the item “e. Section Titles and Order” in Annex I of the CAF agreement.

15. In addition, addition of Section 204*bis* regarding “Numbering of Claims” is proposed. This is related to the provision of the CAF agreement, Annex I, 1, “1. Claims,” as follows.

“Each of the claims shall be preceded by a sign that shows that it is a claim (“Claim”), space, and with an Arabic numeral that designates the claim. (e.g., Claim 1, Claim 2).”

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

16. This amendment of the Administrative Instructions would enter into force on January 1, 2009, and would apply to international applications whose international filing date is on or after that date.

IN THE FUTURE

17. In the future, a PCT Circular regarding this proposal will be sent to the PCT Contracting States.

18. The Working Group is invited to consider the proposal contained in the Annex to this document.

[Annex follows]

ANNEX

DRAFT MODIFICATIONS OF THE PCT ADMINISTRATIVE INSTRUCTIONS

Proposed by the European Patent Office, Japan and the United States of America

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Section 204

Headings of the Parts of the Description

(a) The headings of the parts of the description shall preferably ~~should~~ be as follows:

(i) and (ii) [No change]

(iii) or matter referred to in Rule 5.1(a)(iii), “Disclosure of Invention” or “Summary of Invention”;

(iv) [No change]

(v) for matter referred to in Rule 5.1(a)(v), “Best Mode for Carrying out the Invention,” or, where appropriate, “Mode(s) for Carrying out the Invention” or “Description of Embodiments”;

(vi) to (viii) [No change]

(b) The heading “Title of Invention” shall preferably precede the title of the invention.

[COMMENT: See paragraph 14 in the main body of this document.]

Section 204bis

Numbering of Claims

The number of each claim referred to in Rule 6.1(b) shall preferably be preceded by the expression “Claim” (for example, “Claim 1”, “Claim 2”, “Claim 3”).

[COMMENT: See paragraph 15 in the main body of this document.]

[End of Annex and of document]