

WIPO



PCT/WG/GSE/1/3

ORIGINAL: English only

DATE: January 14, 1977

WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

PATENT COOPERATION TREATY

WORKING GROUP ON GUIDELINES FOR INTERNATIONAL SEARCH AND FOR INTERNATIONAL PRELIMINARY EXAMINATION

First Session

Geneva, February 14 to 18, 1977

COMMENTS ON THE DRAFT GUIDELINES FOR INTERNATIONAL PRELIMINARY EXAMINATION TO BE CARRIED OUT UNDER THE PATENT COOPERATION TREATY (PCT)

BACKGROUND

1. For the sixth session (November 3 to 8, 1976) of the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee"), the International Bureau prepared a document dated August 9, 1976, bearing the number PCT/TCO/VI/9 and entitled "Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT)" (hereinafter referred to as "the Guidelines"). This document contained a compilation of comments received from the State Committee for Inventions and Discoveries of the USSR Council of Ministers, the Patent Office of the United Kingdom and the United States Patent and Trademark Office on Draft Guidelines for Substantive Examination in the European Patent Office ("EPO Guidelines") arranged according to the chapters and paragraphs of the EPO Guidelines, together with a comparative analysis of the said comments.

2. The Interim Committee, in its session referred to above, held only a general discussion of the subject covered in the Guidelines and decided to set up the present Working Group ("PCT Working Group on Guidelines for International Search and for International Preliminary Examination (GSE)") (hereinafter referred to as "this Working Group") for the purposes of assisting in the establishment of the PCT Guidelines for International Searches and for International Preliminary Examination (see document PCT/TCO/VI/16, paragraphs 72 and 86). Concerning the composition of this Working Group, the Interim Committee decided that it would be open to all states members of the Interim Committee as well as all observer organizations which, by December 1, 1976, should express the wish to be its members. The following states expressed such a desire and are thus members of this Working Group: Hungary, Japan, Netherlands, Norway, Soviet Union, Sweden, United Kingdom and United States of America. The following two intergovernmental organizations, the Interim Committee of the European Patent Organisation (EPO) and the International Patent Institute (IIB), as well as the following five non-governmental organizations, the Council of European Industrial Federations (CEIF), the European Federation of Industrial Property Representatives of Industry (FEMIPPI), the International Federation of Patent Agents (FICPI), the Union of Industries of the European Community (UNICE) and the Committee of National Institutes of Patent Agents (CNIPA), which also expressed such a desire, are also participating in this Working Group.

CONTENTS OF THE PRESENT DOCUMENT

3. The International Bureau has received written comments on document PCT/TCO/VI/9 from Hungary, the Netherlands (comments prepared in consultation with the IIB) and the United Kingdom. These comments are attached to the present document as follows:

ANNEX A: comments received from the National Office of Invention
of Hungary

ANNEX B: comments received from the Patent Office of the Netherlands

ANNEX C: comments received from the Patent Office of the United
Kingdom.

4. This Working Group is invited to con-
sider these comments in conjunction with
document PCT/TCO/VI/9.

[Annex A follows]



ORSZÁGOS TALÁLMÁNYI HIVATAL
ELNÖK

PRESIDENT
OF THE NATIONAL OFFICE OF
INVENTIONS OF THE HUNGARIAN
PEOPLE'S REPUBLIC

ПРЕДСЕДАТЕЛЬ
ГОСУДАРСТВЕННОГО ВЕДОМСТВА
ПО ДЕЛАМ ИЗОБРЕТЕНИИ
ВЕНГЕРСКОЙ НАРОДНОЙ РЕСПУБЛИКИ

Budapest, November 24th 1976

500-PCT/TCO-31

500-PCT/AAQ-39

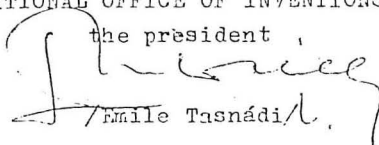
Mr. K. P f a n n e r
Deputy Director General of WIPO,
G e n e v a

Dear Mr. Pfanner,

Please find enclosed herewith our comments to some of the documents discussed at the last session of the Interim Committees of the PCT.

In file of the decision taken by the Committees to form Working Groups we transmit to the International Bureau the following remarks relating to the documents on the prospective agenda of these Groups.

Yours faithfully,
NATIONAL OFFICE OF INVENTIONS
the president


Emilé Tasnádi

Annexe

PCT/TCO/VI/9: Draft Guidelines for International Preliminary Examination.

In the present form the text is hardly to read and interpret as it is full of corrections further the remarks of the International Bureau can be found in a separate Annex. For the reasons as above we propose as next step a redrafting of this document in a way similar to that followed in the Guidelines for Search in order to produce a basic text for the discussions that contains all the comments and is free of the text deemed to be irrelevant by the International Bureau. This work ought to be performed in our opinion in the very next future and the redrafted document should be presented in the Working Group that is to be convened in this theme.

PCT/MG/GSE/I/3
ANNEX A

[Annex B follows]

Octrooiraad

Patentlaan 2
Rijswijk (Z-H)

Telefoon (070) 907616
Postgirorekening 17300

uw brief van

uw nummer

ons nummer
S 76/569

bijlagen

datum 27 December 1976

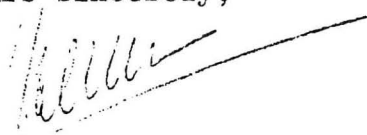
onderwerp

WIPO
Mr. E.M. Haddrick
Head PCT division
12, chemin des Colombettes
1211 Genève 20

Dear Mr. Haddrick,

1. Please find enclosed our comments on the Draft Guidelines for International Preliminary Examination. These comments were prepared in consultation with the I.I.B.
2. Please note that we have no intention to submit separate comments on the Draft Guidelines for the International Search, since we cooperated in the comments which will be submitted by the I.I.B.

Yours sincerely,



J. Dekker.

Draft guidelines for international preliminary examination to be carried out under the Patent Corporation Treaty (PCT), from the Netherlands Patent Office.

- 2 -

General remarks

In our opinion the guidelines for international preliminary examination to be carried out under the PCT should for the sake of harmonisation be drawn up as much as possible in accordance with the recently-published version of the guidelines for (substantive) examination in the European Patent Office (EPO). The version of the EPO Guidelines upon which the WIPO document PCT/TCO/VI/9 is based is not the latest version of these Guidelines. Any paragraph of the EPO Guidelines, the subject of which is pertinent to the PCT, but whose content or wording is not in agreement with the Articles and Regulations of the PCT, should be redrafted in terms of the PCT. In many paragraphs only certain obvious modifications, for instance the replacement of "European" by "International", will be necessary. Otherwise we would like the EPO Guidelines to be completely retained. However there may be good reasons to delete a particular paragraph, e.g. when (even after adaptation of the wording) it is not applicable under the PCT. In the marked-up versions of the EPO Guidelines received from the Patent Offices of the United Kingdom (GB) and the United States (US) quite a number of the original paragraphs have been deleted, but in several occasions we don't understand the reason for this. Our comments given hereafter do not individually mention those paragraphs of the EPO Guidelines that should be retained with obvious amendments or adaptation to the PCT, but are restricted to paragraphs requiring substantial modification. The paragraphs are numbered according to the numbers used in the document PCT/TCO/VI/9. Sometimes a reference is made to the comments issued by the Soviet Union, the United Kingdom or the United States or to the published version of the EPO Guidelines.

Comments concerning the Explanatory Note and the Introduction

The present paragraph 3 of the Introduction should be deleted as it is not relevant to PCT.

Comments concerning Chapter I

- I.1.1. Here a difference between the EPO Guidelines and the PCT exists.
This paragraph should be redrafted in terms of PCT Art 3 (4) and Rules 12 and 55.
- I.1.2. In view of PCT Rule 55.2(a) we agree with the amendments proposed by the United States.
- I.1.3. Since a change in language may be possible according to PCT Rule 92.2(b) this paragraph should be retained in adapted form. The last sentence of the paragraph however is not relevant to the PCT.
- I.1.4. This paragraph should be deleted since the PCT does not provide for divisional applications.
- I.2 This section should be deleted since the PCT does not provide for opposition proceedings or filing of evidence.
- I.3 Since PCT Art. 34 (2)(a) and Rule 66.6 provide the applicant with a right to communicate orally with the International Preliminary Examination Authority (IPEA), in our opinion there should be a paragraph concerning the language of the proceedings in such oral communications. One might apply the same policy as in the case of written correspondence according to PCT Rule 92.2.
- I.4.1. In view of PCT Rule 55 we do not agree with the opinion expressed by the United Kingdom. The final wording of this paragraph will depend on the wording of the redrafted paragraph I.1.1.

I.4.2. PCT Rule 92.2 will be useless if there is no sanction on the filing of documents in the wrong language. In several possible cases sanctions exist, cf PCT Rule 55.2(d), 60.1 and 66.7. Therefore we agree with the opinion expressed by the United States. However we don't understand their reference to PCT Rule 68.2.

I.5 In view of PCT Rule 66.7 we agree with the text proposed by the United States.

I.6.1. We don't agree with the remark made in PCT/TCO/VI/9, Annex B, page 2, under Item 6, stating that from the EPO Guidelines it is clear that the language in which the International Application is filed is used as the language of the proceedings. According to the EPO Guidelines. PART A, Chapter VIII.1.1 and VIII.1.2, an application may be filed in a language which is not the language of the proceedings. However the text of an application in the initial language of the proceedings is the authentic text (PART A, Chapter VIII.5.1), and since under the European Patent Convention there is no need at all for a translation at the examination stage, the language of the authentic text will be used during the search as well as the examination procedure. Applying the same principle for the PCT, the text of an International Application for which a filing date is accorded (PCT Art 11(2)), will be the authentic text; this language will then be used before the International Searching Authority (PCT Rule 12.1) and this will also be the language before the IPEA unless a translation under PCT Rule 55.2 is required. This principle seems to be well in line with the content of PCT Rule 66.2(a)(IV).

Therefore we propose the following text:

"The text of an International Application as filed is the authentic text".

After that the last sentence of this paragraph is not applicable tot the PCT since according to PCT Rule 55.2(a) a translation of the application as a whole may be required.

I.6.2. We agree with the opinion expressed by the United States, but don't understand their reference to PCT Art 19 in this context. PCT Rule 55.2, mentioned in the GB-comment, is more relevant.

I.7.1. We agree with retaining the text as proposed by the United States.

Comments concerning Chapter II

II.1.1. We disagree with the addition of item f as desired by the United States; this demand does not form part of the application as described in PCT Art 3 (2); the same holds for the European request for examination.

II.3.2. We would like these paragraphs to be retained since they
and
II.3.3. give a useful explanation of the expression "short and precise" used in PCT Rule 4.3.

II.4.2. In view of PCT Rule 5.1 (c) we agree with the addition proposed by the United States; however we propose to replace "to speed information retrieval" by "to facilitate access to the information contained in the application".

II.4.4. In view of PCT Rule 66.2 (c) we agree with the opinion expressed by the United Kingdom that the IPEA in many respects will not be able to require certain amendments from an applicant; the expression "to invite" should be used instead. The same remark also concerns many other paragraphs that will not be specially mentioned.

II.4.10.A reference can be made to PCT Art 34(2)(b) (GB-comment). In our opinion PCT Art 19(2), mentioned by the United States, is less relevant since this Article concerns the amendment of the claims. The last sentence of this paragraph should be deleted since it is not applicable to the PCT.

II.4.18. Here a large difference exists between on the one hand the EPO Guidelines and the GB-comment and on the other hand the US-comment and the WIPO comment in PCT/TCO/VI/9, Annex B, pages 3 and 4, under item 10. In this respect we agree with the opinion expressed in the EPO Guidelines; the information necessary for a person skilled in the art to be able to carry out the invention, should be available to the public on the date of publication of the applicatio. We don't understand why the last part

of this paragraph is considered not appropriate by the United Kingdom.

II.6 In view of PCT Rule 67.1 (ii) we do not agree with the opinion expressed by the United Kingdom. The demand from the United States that the micro-organism should have been deposited in a culture collection not later than the date of filing of the application goes beyond the EPO Guidelines. According to these Guidelines, PART C, Chapter II.6.3, the date of deposit in a culture collection should have been supplied not later than two months after filing, but nothing is mentioned about the date of the deposit itself. It is suggested that the Guidelines be brought in line with whatever will be decided at next year's WIPO conference on this subject.

II.7.1-
II.7.3 In view of PCT Art 21 (6) stating that the International Bureau may omit such expressions, drawings, and statements, from its publications and PCT Rule 9.1 and 9.2, we agree with the opinion expressed by the United States to delete the second sentence of paragraph II.7.1. As already pointed out in the US- and GB-comments there are four categories of specifically prohibited matter instead of three.

II.7.4 In view of PCT Rule 9.2 the expression "should be required" cannot be justified.

Comments concerning Chapter III

III.1.3 We agree with the text as proposed by the United States.

III.2.3 We would like this paragraph to be retained as it gives a useful explanation of the expression "whenever appropriate" used in PCT Rule 6.3 (b).

III.3.1 In the published EPO Guidelines the content of this paragraph has been divided into two paragraphs (PART C, Chapter III.3.1 and III.3.2). The new paragraph III.3.2 is only partially relevant to the PCT and needs to be amended on the lines indicated by the United States.

III.3.2. We agree with the opinion expressed in the GB-comment. The expression "for example" should be retained.

III.3.4. Since PCT Rule 6.4(a) states that a multiple dependent claim shall not serve as a basis for any other multiple dependent claim we agree with the comments issued by the United Kingdom and by the Soviet Union.

III.4.2. From the more extensive version of this paragraph in the published EPO Guidelines PART C, Chapter III.4.2, the sentence "This is important ... of the Office" should be deleted.

III.4.7. In our view the opinion expressed by the Soviet Union in its first sentence in practice will cause large difficulties in particular in the case of inventions relating to functionally defined systems. Although the final sentence weakens this position considerably, we prefer to retain the original text.

III.7.2. We agree with the United Kingdom that PCT Rule 13.2 contains only two combinations, The wording of this Rule however, indicates that these are only particular examples of such allowable combinations, and in practice the result may be the same as under EPO Rule 30.

III.7.4. In the published version of the EPO Guidelines this paragraph is combined with PART C, Chapter III.3.1.

III.7.5. We do not agree with the deletion proposed by the United States, since in particular in chemical cases these would lead to high numbers of claims. Chapter III.3.6 also refers to allowing the presence of alternatives in a single claim, and was not objected to by the United States.

III.7.6. In view of PCT Art 34 (3)(a) and Rule 68 we do not agree with the opinion expressed by the United Kingdom that this paragraph is not relevant to an IPEA. Furthermore we do not agree with the addition proposed by the United States, in particular in view of the draft guidelines for international searches to be carried out under the PCT, PCT/TCO/VI/8, Chapter VII.11. Occasionally in cases of lack of unity of invention no objection will be raised by the International Search Authority. However in such cases it may be sufficient to mention the lack of unity not in the first written opinion, but only in the

International Preliminary Examination Report in accordance with PCT Rule 68.1.

III.7.8- In our view these paragraphs should be retained. However
III.7.11. one should realise that under the PCT upon payment of additional fees the examination of more than one invention is possible according to PCT Art 34 (3)(a) and Rule 68.2, whereas under the EPO only one invention can be examined per application, and any others for which examination is desired, must first be made subject of divisional applications.

Comments concerning Chapter IV

Title With the United States we agree that "Patentability" is not a correct title under the PCT, cf PCT Art 35(2). We suggest: General substantive patentability requirements.

IV.1.1 In view of PCT Art 33(1) we do not agree with the opinion expressed by the United Kingdom. We may remark that in the published version of the EPO Guidelines two new paragraphs have been added (PART C, Chapter IV.1.2 and IV.1.3). The contents of those paragraphs seem to be well in line with the PCT, cf PCT Art 5 (carried out by a person skilled in the art), PCT Art 33 (4) and Rules 6.2, 6.3 and 8.1 (technological sense, technical features, technical field), and PCT Rule 5.1(a)(III) (stating advantageous effects); and we suggest to insert similar paragraphs here.

IV.2.1. We agree with the GB-comment that PCT Rule 67 (neither rule 39) does not mention discoveries or aesthetic creations. However in our view the fact that PCT does not mention these categories does not imply that they would have to be searched and examined under the PCT, since it is obvious and generally accepted that they don't constitute patentable inventions of the kind intended in art 3(1). In view of PCT Rule 67.1 (vi) the part of paragraph IV.2.1 concerning programs for computers should be redrafted in view of the difference between EPC and PCT in this respect.

- IV.3 The title should be changed, cf our comment concerning the title of Chapter IV.
- IV.3.1- In view of PCT Rule 66.2 (a)(iii) and 70.12 (i) we
- IV.3.3. don't agree with the opinion expressed by the United Kingdom. Inventions, the exploitation of which would be contrary to public order or morality may be seen as showing defects in view of PCT Art 21 (6) and Rule 9.1.
- IV.4.2. We agree with the proposal of the United States to delete the center part of this paragraph.
- IV.5.1. As already pointed out in the GB-comment the definition of Prior Art given in PCT Rule 64.1 (a) is different from the definition in this paragraph with respect to non-written disclosures. Only a written disclosure shall be considered. A complete redraft of this paragraph is necessary.
- IV.5.2. Item (b) of this paragraph should be modified to indicate that according to the PCT Rule 64.2 the type of written disclosure mentioned here shall not be considered part of the prior art.
- IV.6.1- In view of PCT Rule 64.3 we agree with the opinion
- IV.6.3. expressed by the United Kingdom. The International Preliminary Examination Report should call attention to a conflicting application or patent.
- IV.6.4. PCT Rule 64.3 does not deal explicitly with the case of copending international applications of the same relevant date. However in our opinion there should be a guideline concerning this matter. The same policy as described in PCT Rule 64.3 may be adopted.
- IV.8 This section should be deleted since it is not applicable to the PCT. Although we agree with the proposal of the United Kingdom we would prefer to place such a new paragraph elsewhere, e.g. in Chapter IV.5.2.
- IV.9.7. As already pointed out in the GB-comment the last sentence of this paragraph should be deleted in view of PCT Rule 65.1 and the definition of Prior Art given in PCT Rule 64.

Comments concerning Chapter V

- V.1.1 We agree with the opinion expressed by the United Kingdom and the United States that several parts of this paragraph should be deleted.
- V.1.3 In view of PCT Art. 8(1) we agree with the deletion of a part of this paragraph as proposed by the United States and the United Kingdom.
- V.1.4-
V.1.5-
V.2 In view of PCT Rule 64.1(b)(ii) we do not agree with the deletions proposed by the United Kingdom, since it may be necessary for the examiner to investigate the validity of the claimed priority to establish whether PCT Rule 64.3 is applicable.
We do not agree with the deletion of a part of Chapter V.2.1 as proposed by the United States, in view of PCT Rule 70.10, which requires the investigation of the validity of the priority claim of a conflicting application.
- V.3 In addition to PCT Art. 8 and Rules 4.10 and 17, already mentioned in the GB-comment, PCT Rule 66.7 should be taken into account.
One of the amendments in Chapter V.3.1. proposed by the United States, i.e. "with the International Bureau or directly with the International Preliminary Examination Authority", is not in agreement with PCT Rule 66.7.
A delay of the examination as mentioned in the last sentence of Chapter V.3.2. could possibly conflict with the need to maintain the time limit for establishment of the International Preliminary Examination report (PCT Rule 69).
In the published version of the EPO Guidelines PART C, paragraph V.3.3 has been completely rewritten and a new paragraph V.3.4 has been added. The last sentence of this new paragraph V.3.3. should be deleted since it is not relevant to the PCT. In our opinion paragraph V.3.4 (new) should be retained; although the PCT is silent on this matter, we see no reason not to follow the proposed European Guideline in this respect.

Comments concerning Chapter VI

- VI.1.1 In our opinion PCT Art. 31(1) should also be referred to here. We have not been able to find in the PCT a time limit for the filing of a demand concerning International Preliminary Examination. In the US-comment a time limit of 25 months is mentioned in view of PCT Art. 39(1)(a). However article 39(1) (and also 40(1)) deal only with the case where an election took place within 19 months from the priority date, and we see no reason why a demand could not be filed after that time (not withstanding PCT Rule 61.2(c)).
- VI.1.2 This paragraph is not relevant to the PCT and should be deleted. Instead a paragraph should be written concerning the start of the examination as described in PCT Rule 69 (b) and (c).
- VI.1.4 An Examining Division consisting of three technical examiners is not prescribed for an IPEA, and should be left to the individual IPEA's and possibly their agreements with the International Bureau. Therefore this paragraph should be deleted.
- VI.2.3 In view of PCT Rule 64.3 this paragraph in our opinion should be retained.
- VI.2.5. We agree with the modification proposed by the United States. This paragraph gives a useful comment concerning PCT Rule 66.4.
- VI.2.6-
VI.2.8 These paragraphs should be deleted since they are not relevant to the PCT.
- VI.3.2 Although PCT Art. 19 only mentions item (a), from this paragraph (b) and (c) are also applicable since it is obvious that an amendment should not introduce new defects. We agree with the GB-comment that the first two sentences of the last part of this paragraph should be deleted since they are not relevant to the PCT. However, in view of PCT Rule 91.1(d) the last sentence of this paragraph should be retained.

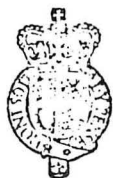
- VI.3.5. In view of PCT Art.34 and Rule 66.2 we agree with the opinion expressed by the United Kingdom. The last sentence of this paragraph should be deleted.
- VI.3.6. In view of PCT Rule 66.2(a) and 66.4 this efficient procedure appears allowable under the PCT; therefore we do not agree with the deletion proposed by the United Kingdom. This paragraph should be retained.
- VI.3.11. According to PCT Art.19(1) and Rule 46(1) the applicant shall be entitled to one opportunity to submit to the International Bureau an amendment of the claims upon receipt of the search report. Furthermore after the filing of a demand for an International Preliminary Examination, the applicant may make amendments of the claims, the description and the drawings according to PCT Art.34 (2)(b) and Rule 66.1. According to PCT Rule 66.1 the time limit for these amendments is the start of the international preliminary examination which itself is detailed in PCT Rule 69.1(b). This rule does not indicate any time limit for the filing of the notice of 69.1(b)(iii). It is not clear whether in cases where the demand is filed after expiry of the time limit of art.19, the International Bureau will perform the actions of rule 69.1(b)(i) and (ii) directly after receipt of the demand (see also our comments on Chapter VI.1.1).
- VI.4.3-
VI.4.5. As already mentioned in our comment concerning Chapter VI.1.4 the examination will not necessarily be carried out by an Examining Division consisting of three examiners. If the applicant has made no real effort to deal with the objections, the International Preliminary Examination Report may be established. Otherwise much will depend on the amount of time still available in view of the time limit mentioned in PCT Rule 69. In Chapter VI.4.3. the last sentence should be deleted.
- VI.4.7. There is a considerable difference between PCT Rule 66.4 and the content of this paragraph. In this stage Rule 66.4 allows the applicant to amend only if on his request the IPEA gives him the opportunity to do so or in case the IPEA issues an additional written opinion. This paragraph should be redrafted accordingly.

- VI.5.1-
VI.5.2 In view of the restrictions imposed by PCT Rule 66.8 we agree with the opinion expressed by the United Kingdom. A list of amendments with a request to the Office to effect these is not allowed.
- VI.5.3. In our opinion lack of unity of invention should be mentioned for the benefit of the national Offices, even if no further search is necessary. In view of PCT Rule 68.1 this may be done in the International Preliminary Examination Report.
- VI.5.10 PCT Rule 91 mentions not only the possibility of rectification of obvious errors of transcription but also the different Bodies that should authorize these rectifications; the paragraph should be expanded accordingly. In view of PCT Rule 66.4(b) and 66.5 the last sentence of this paragraph should be retained.
- VI.5.11-
VI.5.15 These paragraphs should be deleted since they are not relevant to the PCT.
- VI.6.1 According to PCT Art. 34(2)(a) and Rule 66.6 the applicant has a right to communicate orally with the IPEA and to at least one interview. Therefore the last sentence of this paragraph should be redrafted accordingly.
- VI.6.3-
VI.6.6 Any amendment agreed upon by telephone or during an interview shall be confirmed in writing according to PCT Rule 66.8. Paragraph VI.6.4 stating that a fresh objection must be confirmed by a letter to the applicant is not required by PCT Rule 66.4 or 66.6; nevertheless in our opinion such a letter is to be recommended. The examiner, keeping in mind the time limit mentioned in PCT Rule 69, should in each case determine the most appropriate way to continue the proceedings. This paragraph should be elaborated accordingly.
- VI.7.1-
VI.7.5 In view of our comment concerning Chapter VI.1.4 these paragraphs should be deleted.

- VI.7.6 We agree with the opinion expressed by the Soviet Union and the United States to replace this paragraph by a paragraph concerning the drafting of the International Preliminary Examination Report. In our view the draft proposed by the Soviet Union will be a very useful starting point.
- VI.7.7- These paragraphs should be deleted since the granting
VI.7.9 or refusal of a patent is not relevant to the PCT.
- VI.8.1- We do not agree with the opinion expressed by the United
VI.8.2 Kingdom that these paragraphs are not applicable to the PCT. For the sake of uniformity with the present-day EPO Guidelines PART C, Chapter VI.8.1 and VI.8.2 we would like these paragraphs to be retained. It should be kept in mind that according to PCT Art. 17(3)(a) only one International Search Report shall be established.
- VI.8.3 In our opinion this paragraph describes a very useful procedure. We agree with the United States that this paragraph should be retained. Perhaps a definition should be given of the expression "unfamiliar language" in accordance with the provisions of PCT Rule 55,2 and 63.1(iii).
- VI.8.4 In view of PCT Rule 64.3 this paragraph should be retained, cf our comment concerning Chapter VI.2.3.
- VI.8.5- In view of PCT Art. 33.6 and Rule 63.1(ii) we do not agree
VI.8.9 with the opinion expressed by the United Kingdom. However in our opinion PCT Rule 63.1 (ii) implies that the examiner needs not rely upon the International Search Authority to execute the additional search as proposed by the United States. Therefore we agree with the deletion of a part of Chapter VI.8.6.
- VI.8.10 This paragraph should be deleted since it is not applicable to the PCT.
- VI.9,10, These sections should be deleted since they are not appli-
12-15 cable to the PCT.

[Annex C follows]

- VI.11.1- Concerning these paragraphs we agree with the opinion
VI.11.7 expressed by the United Kingdom. These paragraphs should
VI.11 be revised to deal with PCT time limits so far as an IPEA is concerned and with the consequences of failure to comply. The survey of Articles and Rules concerning time limits, given in document PCT/TCO/VI/9, Annex B, page 13, under item 41 will be very useful for this purpose.
- VI.11.8- We agree with the opinion expressed by the United Kingdom
VI.11.10 that these paragraphs are not applicable to the PCT.



THE PATENT OFFICE

25 Southampton Buildings London WC2A 1AY

Telegrams Patoff London WC2

Telephone 01-405 8721 ext

Mr E M Haddrick
Head of the Patent Cooperation Treaty Division
WIPO
32 Chemin des Colombettes
1211 Geneva 20
Switzerland

Your reference

Our reference IPCD 40118 40120

Date 17 December 1976

Dear Mr Haddrick,

I have pleasure in enclosing the observations and comments of the United Kingdom delegation on the following documents:-

- (1) Draft Guidelines for publication under the PCT (PCT/AAQ/VII/4).
- (2) Draft Guidelines for the presentation and execution of drawings under the PCT (PCT/AAQ/VII/11).
- (3) Draft Guidelines for the International Searches to be carried out under the PCT (PCT/TCO/VI/8).
- (4) Draft Guidelines for International Preliminary Examination to be carried out under the PCT (PCT/TCO/VI/9).

These are forwarded, as requested by the Secretariat, for consideration by the TCO and AAQ Working Groups which are to take place next February.

I wish you a very happy Christmas.

Yours sincerely,

M F VIVIAN

(patents 2).

Observations of the United Kingdom on the Guidelines for International Preliminary Examination under the PCT (PCT/TCO/VI/9)

General

Our comments and suggested amendments are largely set out in our letter dated 17 June, 1976 and accompanying marked up copy of PCT/TCO/VI(CI/44/75) addressed to the Deputy Director General Mr. F A Sviridov. Those comments are maintained except where indicated to the contrary in the present observations. Additional observations are confined to matters referred to in Annex F of PCT/TCO/VI/9 and to further comments in the light of proposals made by other delegations in document PCT/TCO/VI/9.

Annex A:-

Point (1) The explanatory note needs redrafting in PCT terms. In particular there should be no reference to guidelines for examination in the national offices.

Page 8 In the US version, para 2, second line, 'substantive' should be replaced by 'preliminary'; and in line 12 "firstly" should be deleted (because the 'secondly' point has been deleted).

Page 10 In the US version, the last line on the original text should be restored in para 7.

Page 12 We agree with the Secretariat's note.

Point (3) We support the Secretariat's view in the second paragraph on Item 3 of Annex B, but we still recommend deletion of 3.2-3.6.

Point (4) We support the Secretariat's proposal.

Point (5) We support the Secretariat's proposal.

Rule 92.2 (a) gives the authority.

Point (7) We agree to the US version in view of the Secretariat's comments.

Page 21 We accept the US version with the following amendments:-

in (b), delete 'of the invention'

in (d), insert at beginning "one or more"

Page 22 We accept the US version with the following amendment:

In the last sentence replace "part of the state of the art" by "part of the prior art".

Pages 28/29 We maintain our original proposal. However, lines 2/3 of 4.11 should read Article 5 (not 33) and line 7 should read 'not reproducible' instead of "unrepeatable".

Pages 29/30 We accept US version if the last sentence of 4.12 is redrafted with reference to Rule 5.1(a)(vi).

Point (10) We maintain our original proposal. The reference may be to one of the applicants own applications the content of which is known only to him. (cf comments of the Secretariat in Annex B).

Point (11) We maintain our view. It is somewhat late to provide Rules to cover the proposals made by US. In any case, action such as is suggested in 6.1 - 6.3 appears to be outside the objective of the International Preliminary Examination as defined in Article 33 and to be proper to the elected states.

Pages 34/35

paras. 7.1 - 7.4 We accept the US version if the reference opposite 7.3 is amended to read "Rule 9.1 (iv)".

Point (12) We feel that having regard to Rule 66.2(v) it has to be considered to what extent the IPEA report should comment on these matters. In our view comment should be made only in the clearest cases. We could accept the US version if it included a reference to Article 6 which contains the requirement for clarity and conciseness.

Page 37

We maintain our version, but think that, in view of the last sentence of 2.2, the passage at lines 12-13 of this paragraph should be amended to read:-

"part of the claim to read "A photographic camera including a focal plane shutter having (here recite the known combination of features which is utilised) and there is no need to refer also to the other known features."

Point (13) In view of the comment by the Secretariat we can accept the US version. We feel, however, that example (iii) should be deleted because this kind of invention can most clearly be defined using the two-part formulation with the first part setting out the known combination of parts and the second part the changes in the parts or their interrelationship.

- Pages 39/40 (Para 3.2) We maintain our original view. In particular, any examples must clearly be examples not as in US version (where 'example' is deleted).
- Pages 40/41 (Para 3.3) We maintain our original view.
- In particular "particular embodiments" should be replaced by "specific forms" wherever it occurs and "any more specific disclosure of the invention" (penultimate line of 3.3) by "any more specific definition of the invention".
- Page 42 (Para 3.5) We accept the US version.
- Page 42 (Para 3.6) We agree to the US proposed addition which should refer to Rule 6.4(a) for authority.
- Point (14) We maintain the view that the IPEA cannot require amendment. Rule 66.2 (c) clearly says 'invite'. This is not tantamount to a requirement, because the applicant can decline the invitation and there is no sanction which can be applied against him.
- Page 45 (Para. 4.7) We prefer the US version.
- Page 47 (Para. 4.11) We prefer the US version.
- Para. 5.1 We prefer the US version.
- Page 48 (Para 6.1) We prefer the UK text, but with reference to 'Art. 6' as in the US version.
- Para 6.2 We prefer the US version, but with the second sentence reading "..... in each particular case in the light of the validity of the inventive concept over the area sought to be covered by the claims."
- Para 6.3 Needs to distinguish between lack of fair basis and insufficiency.
- Point (15) and (17) We maintain our view. The IPEA cannot insist upon amendment.
- Point (20) We maintain our view.
- The IPEA does not need to concern itself with what "invention" means.
- Point (21) The passage dealing with aesthetic creations should be deleted.
- Page 60 (schemes, etc) This passage should be deleted. Schemes etc. are excluded matter under Rule 67.1(iii). If anything at all is needed a statement to this effect will suffice.
- Point (22) A recitation of Rule 67.1(vi) is all that is necessary. Statements such as a computer program is not an invention or is not patentable are out of place in IPEA Guidelines. Such decisions will be made by national offices in the light of their laws.
- Point (23) We maintain our view. An IPEA can only exclude matter in Rule 67 - it cannot exclude other matter.
- Point (24) Paragraphs 3.1 to 3.3 should be redrafted in PCT terms, including IPEA drawing attention to as yet undetected presence of such matter. The suggestion of the Secretariat could be followed up, but it has to be remembered that at this stage the international application may well have already been published with the matter in question in it.
- Page 65 (Para 4.2) The first sentence should be redrafted in terms of Rule 67.1(iv) and the second and third sentences retained. However, the rest of paragraph 4.2 should be deleted because some patent laws allow claims to pharmaceutical compositions per se, that is not limited to a specific, ~~or~~ the first, medical use; and to a second or subsequent use of a known composition.
- Page 66 (Para 4.3) We maintain our proposed version, but amended to refer to "exclusion from preliminary examination" instead of to "patentability", with which Rule 67.1(iv) is not concerned.
- Pages 68/69 (Para 5.2) We can accept the US version if references to "state of the art" are corrected to 'prior art' (PCT terminology) and line 2 of (b) refers to "relevant date" (Rule 64.1(a) and (b)).
- Pages 69/70 (Para 5.3) This should be amended to refer to "the relevant date" in terms of Rule 64.1.
- Page 74 (Para 9.1) We agree with the US definition.
- The commentary should be in terms of Rule 65.
- Page 79 et seq (Para 9.8) Example A1 (ii) is not happily worded because a pump does not include motive

power - what is being referred to here is a pump/motor combination.

We should like to see it amended in this respect.

We prefer the US text for Examples A' (iii), (iv), C1(ii), (iv)

(B1) The last three words should read "end to end".

Chapter V

Point (28)

We maintain our view on para. 1.4 "establish by evidence" should be deleted, but para 1.5 could be retained if appropriately reworded.

Chapter VI

Point (29)

Chapter VI needs complete redrafting to bring it strictly into line with PCT procedure, e.g. Rule 66. Strict attention should be paid to the fact that the IPEA has no sanctions to apply to the applicant and cannot require any action to be taken.

[End of document]