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

prepared by the International Bureau

SUMMARY

This document contains the second part (Chapters III to VI) of the Draft Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT). An introduction relevant to the said Guidelines as a whole appears in document PCT/WG/GSE/II/2, which contains the first part (Chapters I to III) of the said Guidelines.

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

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CHAPTER IV

GENERAL REQUIREMENTS FOR
INTERNATIONAL PRELIMINARY EXAMINATION1. General

Art. 33(1) 1.1 International preliminary examination is carried out on the basis of the following three basic requirements:

Art. 33(2) 1. That the claimed invention appears to be "novel."

Art. 33(3) 2. That the claimed invention appears to involve "inventive step" (non-obviousness).

Art. 33(4) 3. That the claimed invention appears to be "industrially applicable."

Art. 33(5) 1.2 Since these requirements serve the basis for international preliminary examination, any Contracting State may apply additional or different criteria for the purposes of deciding whether or not, in that State, the claimed invention will be protected (i.e., by a patent, an inventor's certificate, a utility certificate or a utility model). These basic requirements will be dealt with below.

1.3 In addition to these three basic criteria the examiner in the International Preliminary Examining Authority should be aware of the following two requirements that are implicitly contained in the PCT:

(i) The claimed invention must be such that it can be carried out by a person skilled in the art (after proper disclosure by the international application); this follows from Article 5. Instances where a claimed invention fails to satisfy this requirement are given in Chapter II, paragraph 4.11.

Rule 5.1(a)(i) (ii) The claimed invention must be of "technical character" to the extent that it must relate to a technical field, must be concerned with a technical problem, and must have technical features in terms of which the matter for which protection is sought can be defined in the claims (see Chapter III, paragraph 2.1). This requirement of "technical character" may be decisive in determining whether or not a claimed invention is excluded from international preliminary examination under Article 34(4)(a)(i) and Rule 67 (see Chapter IV, paragraphs 2.1 to 2.7 and Chapter VI, paragraph 5.3).

Rule 5.1(a)(iii) 1.4 The PCT does not require explicitly or implicitly that a claimed invention must entail some technical progress. Nevertheless, advantageous effects, if any, with respect to the prior art should be stated in the description, and any such effects are often important in determining "inventive step" (see Chapter IV, Section 9).

Rule 67 2. Exclusion from international preliminary examination

2.1 Rule 67 specifies certain subjects on which an International Preliminary Examining Authority is not required to carry out international preliminary examination in respect of an international application. These subjects are set out in paragraph 2.4 below. The subjects in respect of which a particular International Preliminary Examining Authority will not carry out international preliminary examination under Rule 67 will be set forth in the agreement (see Chapter VI, paragraph 1.2) between that International Preliminary Examining Authority and the International Bureau. Therefore, the subjects excluded from the international preliminary examination under PCT Rule 67 may vary between the various International Preliminary Examining Authorities (see also Chapter IV, paragraphs 2.4, items (a) to (f) and 2.7).

Art. 34(4)(b) 2.2 Where the subject matter of only some of the claims is a subject excluded from international preliminary examination this will be indicated in the international preliminary examination report (see Chapter VI, paragraph 8.9). International preliminary examination could of course be made in respect of the other claims.

2.3 In cases of doubt as to whether subject matter covered by a claim constitutes a subject excluded from the international preliminary examination, the International Preliminary Examining Authority should carry out the international preliminary examination to the extent that this is possible.

2.4 The following subjects may be excluded from international preliminary examination:

- Rule 67.1(i) (a) Scientific theories are a more generalized form of discoveries. For example, the physical theory of semi-conductivity would be excluded under Rule 67 whereas new semi-conductor devices and processes for manufacturing may require international preliminary examination on the part of an International Preliminary Examining Authority.
- Rule 67.1(ii) (b) Mathematical theories are a particular example of the principle that purely abstract or intellectual methods are excluded under Rule 67. For example, a shortcut method of division would be excluded but a calculating machine designed to operate accordingly may well require international preliminary examination.
- Rule 67.1(iii) (c) Schemes, rules or methods of doing business, performing purely mental acts or playing games: these are further examples of items of an abstract or intellectual character. In particular, a scheme for learning a language, a method of solving crossword puzzles, a game (as an abstract entity defined by its rules) or a scheme for organizing a commercial operation would be excluded under Rule 67. However, novel apparatus for playing a game or carrying out a scheme might require international preliminary examination.
- Rule 67.1(iv) (d) Methods for treatment of the human or animal body by surgery or therapy as well as diagnostic methods are further subject matter on which an International Preliminary Examination Authority is not required to carry out international preliminary examination. International preliminary examination should, however, be conducted for surgical, therapeutical or diagnostic instruments or apparatus for use in such methods. International preliminary examination may also be conducted for new products, particularly substances or compositions for use in these methods of treatment or diagnosis.
- Rule 67.1(v) (e) Mere presentations of information characterized solely by the content of the information would be excluded under Rule 67: this applies whether the claim is directed to the presentation of information per se (e.g., written instructions on how to operate a machine or use a chemical substance) or to an information carrier (e.g., a book, traffic sign or gramophone record). If, on the other hand, the manner of presentation of information has new technical features, these may well require international preliminary examination.
- Rule 67.1(vi) (f) Computer programs may take various forms, e.g., an algorithm, a flow-chart or a series of coded instructions which can be recorded on a tape or other machine-readable record-medium, and can be regarded as a particular case of either a mathematical theory (see above) or a presentation of information (see above). If the contribution to the known art resides solely in a computer program, then the subject matter may be excluded under Rule 67. For example, a claim to a computer characterized by having the particular program stored in its memory or to a process for operating a computer under control of the program would be as objectionable as a claim to the program per se or the program when recorded on magnetic tape. No International Preliminary Examining Authority is required to carry out an international preliminary examination on computer programs to the extent it is not equipped to carry out such examination.

Compilation of responses in respect of paragraph 2.4
(formerly paragraph 2.1)

para. 2.1
(pp.56-61) (all
parts of the
paragraph)
para. 2.1
(pp. 57-58)
(Discoveries)

Agree with the GB comment; the part of this paragraph concerning programs for computers should be redrafted in view of the difference between EPC and PCT in this respect (NL).

Maintain our view, the IPEA does not need to concern itself with what "invention" means (GB).

- para.2.1 (p.59)
(Aesthetic
Creation) Should be deleted (GB)
- para. 2.1
(pp. 59-60)
(Schemes, etc.) Should be deleted; these are excluded matter under Rule 67.1(iii) (GB).
- para. 2.1 (p.60)
(Programs for
Computers) A recitation of Rule 67.1(vi) is all that is necessary (GB)

Note:

The aforementioned paragraph 2.4 (formerly paragraph 2.1) has been revised by the International Bureau to reflect Rule 67, but some of the examples of excluded subject matter retained in substantially their original form for the sake of clearer guidance for the examiner in the International Preliminary Examining Authority.

2.5 It should be noted that Rule 67.1(iv) (referred to in paragraph 2.4, item (d) above) excludes only treatment by surgery or therapy. It follows that other methods of treatment of live human beings or animals, e.g., treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool, are appropriate for international preliminary examination provided that (as would probably be the case) such methods are of a technical, and not essentially biological, character (see Chapter IV, paragraph 2.7). A treatment or diagnostic method is only excluded if actually carried out on a living animal or human body, so that, for example, the treatment of blood for storage in a blood bank, or diagnostic testing of blood samples, the blood being contained in apparatus quite separate from the body, would not be excluded from international preliminary examination by virtue of Rule 67.1(iv).

2.6 In considering whether subject matter under Article 34(4)(a)(i) and Rule 67 is present, there are two general points the examiner in the International Preliminary Examining Authority must bear in mind. Firstly, he should disregard the form or kind of claim and concentrate on the content in order to identify the contribution which the claimed subject matter makes to the known art. This point is illustrated by the examples given in Chapter IV, paragraph 2.4, item (f) of different ways of claiming a computer program. Secondly, any exclusion under Rule 67 applies only to the extent that the international application relates to the excluded subject matter. Thus the exclusion might not apply if the claimed subject matter also provides new technical features. This is illustrated, for instance, by a gramophone record distinguished solely by the music recorded thereon whereas if the form of the groove were modified so that the record, when used with an appropriate pick-up mechanism, functioned in a new way (as in the first stereo record), the claimed subject matter could undergo international preliminary examination.

- Rule 67.1(ii) 2.7 Another category which need not require international preliminary examination is "plant or animal varieties or essentially biological processes for the production of plants and animals." The question whether a process is "essentially biological" is one of degree depending on the extent to which there is technical intervention by man in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would be excluded. For example, a method of selectively breeding horses involving merely selecting for breeding those animals having certain characteristics would be essentially biological. However, a method of pruning a tree would not be essentially biological since, although a biological process is involved, the essence of the claimed invention is technical; the same could apply to a method of treating a plant characterized by the application of a growth-stimulating substance or radiation.

2.8 The exclusion referred to in the preceding paragraph does not apply to microbiological processes or the products thereof. An international preliminary examination may be conducted not only for processes involving microorganisms, but also for microorganisms themselves (as well as inanimate products) when produced by a micro-biological process. An international preliminary examination may not, however, be conducted for microorganisms per se (see Chapter III, Section 6).

Art. 34(4) (a)
(ii) and (b)

3. Obscurities, inconsistencies or contradictions

3.1 A situation may exist where no meaningful opinion is possible on the question of novelty, inventive step (non-obviousness) or industrial applicability for all or part of the claimed subject matter because the international application contains obscurities, inconsistencies or contradictions to the extent that it is impossible to examine the claimed subject matter. In this case, an international preliminary examination report will not be established on these questions and this will be indicated in the international preliminary examination report. The examiner in the International Preliminary Examining Authority should examine the claimed subject matter to the extent that this is possible but should not ask for clarification (see Chapter VI, paragraph 8.9).

Compilation of responses in respect of former paragraphs 3.1 to 3.3
(now deleted)

(i) Delete paragraphs 3.1 to 3.3, not applicable to PCT (GB). These paragraphs should be redrafted in PCT terms (GB).

(ii) Do not agree with GB opinion (NL).

Note:

The contents of these paragraphs concerning expressions concerning public order ("ordre public") or morality are considered useful guidance for the examiner in the International Preliminary Examining Authority, but more appropriate to Chapter II; they now comprise paragraph 7.1 of Chapter II.

4. Industrially applicable

Art. 33(4)

4.1 "A claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry." "'Industry' is to be understood in its broadest sense as in the Paris Convention for the Protection of Industrial Property." Industry should also be understood in its broad sense as including any physical activity of a technical character, i.e., an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover a process for dispersing fog, or a process for converting energy from one form to another. Subject matter excluded would not be considered as industrially applicable, however, which consisted of articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g., a perpetual motion machine. Objection could arise under Article 33(4) only in so far as the claim specified the intended function or purpose of the invention. However, if a perpetual motion machine were claimed merely as an article having a particular specified construction, then objection should be made under Article 5 (see Chapter II, paragraph 4.11).

4.2 Methods of testing generally should normally be regarded as inventions susceptible of industrial application provided that the test is applicable to the improvement or control of a product, apparatus or process which is itself susceptible of industrial application.

5. Novelty; prior art

Art. 33(2)

5.1 "A claimed invention shall be considered novel if it is not anticipated by the prior art." Thus a claimed invention is considered to be new if it does not form part of the prior art. The prior art is defined as "everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations)" before the "relevant date" (priority or international filing date of the international application (see Chapter IV, paragraph 5.3)).

Rule 64.1

The scope of this definition should be noted. There are no limitations as to where, when or in what manner the written information in question is made available. Since the prior art available to the examiner in the International Preliminary Examining Authority will mainly consist of the documents listed in the international search report, the following paragraphs deal with the question of public availability only in relation to written disclosure (either alone or in combination with an earlier oral disclosure or use).

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 Chapter IV, paragraph 5.3), it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. As a general rule, no document will be cited in the international search report unless the fact of its public availability has been clearly established or is highly probable. Moreover, 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 in the International Preliminary Examining Authority 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 have 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. The only other problem likely to arise for the examiner is where:

(a) a document reproduces an oral description (e.g., a public lecture) or gives an account of a prior use (e.g., display at a public exhibition); and

Rule 64.1(b)

(b) only the oral description or lecture was publicly available before the relevant date of the international application, the document itself being published on or after this date. In such cases, the examiner will not consider the earlier lecture, display or other event as part of the prior art for purposes of Article 33(2) and (3), but will call attention to such non-written disclosure in the manner provided for in Rule 70.9 (see also Chapter IV, Section 8 and Chapter VI, paragraphs 7.23 and 8.12).

Rule 64.2

Art. 2(xi)

5.3 It should be noted that the "relevant date," for the purpose of considering prior art, is defined in Rule 64.1(b) as meaning the international filing date or, where the international application contains a valid claim to priority, that date of priority (see also Chapter V, paragraph 1.4). It should be remembered also that different claims, or different alternatives claimed in one claim, may have different effective dates. The question of novelty must be considered against each claim (or part of a claim where a claim specifies a number of alternatives) and the prior art in relation to one claim, or to one part of a claim, may include matter which cannot be cited against another claim, or part of a claim, because the latter has an earlier effective date. Of course, if all the matter in the prior art was made available to the public before the date of the earliest priority document, the examiner in the International Preliminary Examining Authority need not (and should not) concern himself with the allocation of priority dates.

6. Documents to be cited according to PCT Rule 64.3

6.1 In cases where any application or any patent which would otherwise constitute prior art for the purposes of international preliminary examination as to novelty and inventive step (non-obviousness) was published after the relevant date (see Chapter IV, paragraph 5.3 as to the "relevant date") of the international application under consideration but was filed earlier than the relevant date or claimed the priority of an earlier application which was filed prior to the relevant date, the published application or patent is not to be considered part of the prior art for the purpose of international preliminary examination as to novelty and inventive step. Nevertheless, the international preliminary examination report must call attention to such application or patent in the matter provided for in Rule 70.10 (see also Chapter V, paragraph 1.4 and Chapter VI, paragraphs 7.23 and 8.13).

Rule 70.10

6.2 Rule 70.10 referred to in paragraph 6.1 above and Chapter VI, paragraph 8.13 provides that any published application or any patent referred to in the international preliminary examination report by virtue of Rule 64.3 shall be mentioned as such and shall be accompanied by an indication of its date of publication, of its filing date, and its claimed priority date (if any). In respect of the priority date of any such document, the report may indicate that, in the opinion of the International Preliminary Examining Authority, such date has not been validly claimed.

6.3 The PCT does not deal explicitly with the case of copending international applications of the same date. However, it is an accepted principle in most patent granting systems that two patents shall not be granted to the same applicant for one invention. It is permissible to allow an applicant to proceed with two international applications having the same description where the claims are quite distinct in scope and directed to different claimed subject matter. However, in the rare case in which there are two or more international applications from the same applicant designating the same State or States and the claims of those applications have the same priority date and relate to the same claimed invention (even though they may not necessarily claim that invention in identical terms), the applicant should be told that he may be required in the national phase to choose which one of those applications he wishes to proceed to grant. Should two such international applications of the same priority date be received from two different applicants, each must be allowed to proceed as though the other did not exist.

7. Test for novelty

7.1 It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together (see Chapter IV, paragraph 9.7).

7.2 A document takes away the novelty of any claimed subject matter derivable directly and unambiguously from that document when considered in the light of common general knowledge, including any features implicit to a person skilled in the art in what is explicitly contained in the document, e.g., a disclosure of the use of rubber in circumstances where clearly its elastic properties are used takes away the novelty of the use of an elastic material. For the meaning of person skilled in the art, see Chapter IV, paragraph 9.6.

7.3 A prior document should be construed only in the light of knowledge available at the time the document was published and excluding any knowledge subsequently discovered.

7.4 In considering novelty, it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of any generic claim embracing that disclosure, e.g., a disclosure of copper takes away the novelty of metal, and one of rivets takes away the novelty of fastening means.

7.5 In the case of a published document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. Lack of novelty of this kind should be raised by the examiner in the International Preliminary Examining Authority only where there can be no reasonable doubt as to the practical effect of the prior teaching.

7.6 In interpreting claims for the consideration of novelty, the examiner in the International Preliminary Examining Authority should have regard to the guidance given in Chapter III, Section 4. In particular, he should remember that non-distinctive characteristics of a particular intended use should be disregarded (see Chapter III, paragraph 4.8). For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (e.g., the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated but implied by the particular use should be taken into account; e.g., in considering the novelty of a hook for a crane over a known fish-hock of similar shape, one should take into account the differences of size and strength implied by these uses.

8. Non-written disclosures

8.1 As explained in Chapter IV, paragraph 5.2, if the examiner in the International Preliminary Examining Authority calls attention to a non-written disclosure in the international preliminary examination report by virtue of Rule 64.2, he should keep in mind that such disclosure "shall be mentioned by indicating its kind, the date on which the written disclosure referring to the non-written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public" (see also Chapter VI, paragraph 8.12).

9. Inventive step

9.1 A claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations (see Chapter IV, paragraph 5.2), it is not, at the relevant date (see Chapter IV, paragraph 5.3 as to the "relevant date") obvious to a person skilled in the art. Novelty and inventive step are different criteria. Novelty exists if there is any difference between the invention and the known art. In considering inventive step or non-obviousness, the examiner in the International Preliminary Examining Authority should take into consideration the relation of any particular claim to the prior art as a whole. He should take into consideration the claim's relation not only to individual documents or parts thereof taken separately but also its relation to combinations are obvious to a person skilled in the art.

9.2 The "prior art" for the purposes of considering inventive step is as defined in Article 33(3) (see Chapter IV, Section 5); it does not include later published applications or patents although, in the circumstances mentioned in Chapter IV, paragraph 6.1, a later published application or patent may be cited in the international preliminary examination report.

9.3 The question to consider, in relation to any claim defining the invention, is whether, at the priority date of that claim, it would have been obvious to a person skilled in the art to arrive at something falling within the terms of the claim having regard to the art known at that time. If so, the claim is considered to lack inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e., something which does not involve the exercise of any skill or ingenuity beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty (see Chapter IV, paragraph 7.3), it is fair to construe any published document in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person skilled in the art at the priority date of the claim.

9.4 While the claim should in each case be directed to technical features (and not, for example, merely to an idea) in order to assess whether an inventive step is present, it is important for the examiner in the International Preliminary Examining Authority to bear in mind that there are various ways in which a person skilled in the art may arrive at an invention. An invention may, for example, be based on the following:

(i) The formulation of an idea or of a problem to be solved (the solution being obvious once the problem is clearly stated).

Example: The problem of indicating to the driver of a motor vehicle at night the line of the road ahead by using the light from the vehicle itself. As soon as the problem is stated in this form the technical solution, viz., the provision of pieces of reflecting glass (or "cats' eyes") suitably positioned and angled along the road surface, appears simple and obvious.

(ii) The devising of a solution to a known problem.

Example: The problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze branding") consists in applying the discovery that the hide can be permanently depigmented by freezing.

(iii) The arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious).

Example: The agreeable flavor of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious.

Many inventions are of course based on a combination of the above possibilities, e.g., the arrival at an insight and the technical application of that insight may involve an inventive step.

9.5 In identifying the contribution any particular invention makes to the art in order to determine whether there is an inventive step, account should be taken first of what the applicant himself acknowledges in his description and claims to be known; any such acknowledgement of known art should be regarded by the examiner in the International Preliminary Examining Authority as being correct unless the applicant states he has made a mistake. However, the further prior art contained in the international search report may put the claimed invention in an entirely different perspective from that apparent from reading the applicant's description by itself (and indeed this cited prior art may cause the applicant voluntarily to amend his claims to redefine his invention before his international application comes up for international preliminary examination). In order to reach a final conclusion as to whether any claim includes an inventive step, it is necessary to determine the difference between the subject-matter of that claim and the whole of the known art and, in considering this matter, the examiner in the International Preliminary Examining Authority should not proceed solely from the point of view suggested by the form of claim (prior art plus characterizing portion-- see Chapter III, Section 2).

9.6 The person skilled in the art should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything in the "prior art," in particular, the documents cited in the international search report, and to have had at his disposal the normal means and capacity for routine experimentation. There may be instances where it is more appropriate to think in terms of a group of persons, e.g., a research or production team, than a single person. This may apply, e.g., in certain advanced technologies such as computers or telephone systems and in highly specialized processes such as the commercial production of integrated circuits or of complex chemical substances.

9.7 In considering whether there is inventive step (as distinct from novelty (see Chapter IV, Section 7)), it is permissible to combine the disclosures 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 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.

9.8 The following list gives examples, for guidance, of circumstances where a claimed invention should be regarded as obvious or where it involves a positive determination of an inventive step (non-obviousness). It is to be stressed that these examples are only guides for the examiners in the International Preliminary Examining Authority and that the applicable principle in each case is "was it obvious to a person skilled in the art?" Examiners should avoid attempts to fit a particular case into one of these examples where the latter is not clearly applicable. Also, the list is not exhaustive.

(A1) Claimed inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore to be ruled out:

(i) The teaching of a prior document is incomplete and at least one of the possible ways of filling the gap which would naturally or readily occur to the person skilled in the art results in the claimed invention.

Example: The claimed invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) The claimed invention differs from the known art merely in the use of well-known equivalents (mechanical, electrical or chemical).

Example: The claimed invention relates to a pump-motor combination which differs from a known pump-motor combination solely in that the motor is hydraulic instead of an electric motor.

(iii) The claimed invention consists merely in a new use of a well-known material employing the known properties of that material.

Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

(iv) The claimed invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use.

Example: An electric cable comprises a polythylene sheath bonded to a metallic shield by an adhesive. The claimed invention lies in the use of a particularly newly developed adhesive known to be suitable for polymer-metal bonding.

(v) The claimed invention consists merely in the use of a known technique in a closely analogous situation.

Example: The claimed invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

(A2) Claimed inventions involving the application of known measures in a non-obvious way and in respect of which an inventive step is therefore to be recognized:

(i) A known working method or means when used for a different purpose involves a new, surprising effect.

Example: It is known that high frequency power can be used in inductive butt welding. It should therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect; an inventive step would exist in this case, however, if high-frequency power were used for the continuous conductive butt welding of a coiled strip but without removing scale (such scale removal being on the face of it necessary in order to avoid arcing between the welding contact and the strip). The unexpected additional effect is that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric.

(ii) A new use of a known device or material involves overcoming technical difficulties not resolvable by routine techniques.

Example: The claimed invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

(B1) Obvious combination of features not involving an inventive step:

The claimed invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working inter-relationship.

Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed end to end.

(B2) Not obvious and consequently a combination of features involving an inventive step:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself.

Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquilizer (sedative). It was found that through the addition of the tranquilizer, which intrinsically appeared to have no pain-killing effect, the analgesic effect of the pain-killer was intensified in a way which could not have been predicted from the known properties of the active substances.

(C1) Obvious selection or choice among a number of known possibilities not involving an inventive step:

(i) The claimed invention consists merely in choosing from a number of equally likely alternatives.

Example: The claimed invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat, and the claimed invention resides merely in the choice of one alternative.

(ii) The claimed invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of normal design procedures.

Example: The claimed invention relates to a process for carrying out a known reaction and is characterized by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by a person skilled in the art.

(iii) The claimed invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.

Example: The claimed invention is characterized by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterizing feature can be derived merely by extrapolation on a straightline graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) The claimed invention consists merely in selecting a small number of chemical compounds from a broad field.

Example: The prior art includes disclosure of a chemical compound characterized by a specified structure including a substituent group designated "R." This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The claimed invention consists in the selection of a particular radical or small group of radicals from among those referred to, as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior art document since the question would then be one of lack of novelty rather than obviousness). The resulting compounds:

- (a) are not described as having, nor shown to possess, any advantageous properties not possessed by the prior art examples; or
- (b) are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection.

(C2) Non-obvious selection or choice and consequently inventive step among a number of known possibilities:

(i) The claimed invention involves special selection in a process of particular operating conditions (e.g., temperature and pressure) within a known range, such selection producing unexpected effects in the operation of the process or the properties of the resulting product.

Example: In a process where substance A and substance B are transformed at high temperature into substance C, it was known in the prior art that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130°C. It is now found that in the temperature range from 63 to 65°C, which previously had not been explored, the yield of substance C was considerably higher than expected.

(ii) The claimed invention consists in selecting a small number of chemical compounds from a broad field, such compounds having unexpected advantages.

Example: In the example of a substituted chemical compound given at (iv) under (C1) above, the claimed invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior art. In this case however not only does the selection embrace a relatively small area of the possible field, and result in compounds described and shown to possess advantageous properties, but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the described advantageous properties.

(D) Overcoming a technical prejudice:

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the claimed invention. This applies in particular when the person skilled in the art would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacles.

Example: Drinks containing carbon dioxide are, after being sterilized, bottled while hot in sterilized bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none are in fact necessary) could therefore involve inventive step.

9.9 It should be remembered that a claimed invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated, it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner in the International Preliminary Examining Authority should be wary of ex post facto analysis of this kind. In all cases, he should seek to make a practical "real-life" assessment. He should take into account all that is known concerning the background of the claimed invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, a claimed invention is shown to be of considerable technical value and, particularly, if it provides a technical advantage which is new and surprising and this can be convincingly related to one or more of the features included in the claim defining the invention, the examiner in the International Preliminary Examining Authority should be hesitant in raising a negative determination that such a claim lacks inventive step. The same applies where the claimed invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfills a long-felt need. Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate

commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the claimed invention and not from other influences (e.g., selling techniques or advertizing).

CHAPTER V

PRIORITY

1. The right to priority

1.1 An international application is accorded as its international filing date the date on which it satisfies the requirements of Article 11. This date remains unchanged except in the special circumstances of later-filed drawings and sheets as provided in Article 14(2) and Rule 20.2 and the making of a declaration (international application considered withdrawn) under Article 14(4). The international filing date may be the only effective date of the international application. It will be of importance for fixing the expiration of certain time limits and for determining the relevant dates of prior art for the purposes of international preliminary examination as to novelty and inventive step (non-obviousness) of the subject matter of the international application.

Art. 2(xi)

1.2 However, in many cases, an international application will claim the right of priority of the date of filing of an earlier application. In this case, it is the priority date (i.e., the filing date of the earlier application) which becomes the effective date for the purposes mentioned in the preceding paragraph.

1.3 For a valid claim to priority, several conditions must be satisfied: the earlier application whose priority is claimed must have been made by the applicant or his predecessor in title; it must have been filed not more than 12 months before the filing date of the international application; and it must have been made in or for a member State of the Paris Convention (Article 8(1)). The words "in or for" any member State of the Paris Convention mean that the earlier application the priority of which is claimed may be an earlier national, regional or international application. The earlier application may be for a patent or for the registration of a utility model or for an inventor's certificate. So long as the contents of the earlier application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the final disposition of the application may later be; for example, it may subsequently be withdrawn or held withdrawn.

1.4 Normally, the application the priority of whose filing date is claimed must be the first application that has been filed for the invention. However, a subsequent application for the same subject matter as the previous first application filed in or for the same State will be considered as the first application for priority purposes if, when this subsequent application was filed, the first application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The examiner in the International Preliminary Examining Authority will not normally consider this question unless there is clear evidence of the existence of an earlier application as, for example, in the case of a United States continuation-in-part application. Where it is clear that an earlier application for the same subject matter exists, and where the priority right is important because of intervening prior art (see Chapter V, paragraph 2.1), the applicant should be invited to satisfy the examiner in the International Preliminary Examining Authority that there were no rights outstanding in the earlier application.

Compilation of responses in respect to paragraph 1.4

Are the last two sentences of this paragraph necessary for International Preliminary Examining Authorities? (GB)

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 determine whether PCT rule 64.3 is applicable. (NL)

Note:

The two sentences have been retained since PCT Rule 64.1(b) defines "relevant date" for the purposes of PCT Rule 64.1(a) (Prior Art), PCT Rule 64.2 (Non-Written Disclosures) and PCT Rule 64.3 (Certain Published Documents) as being either the international filing date or "where the international application under international preliminary examination validly claims the priority of an earlier application, the filing date of such earlier application" (underlining supplied). This Rule implies consideration of questions affecting the validity of the priority claim coming to the notice of the examiner in the International Preliminary Examining Authority.

Art. 8(1)

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 includes 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 both 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 the German priority date. If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have the 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 (see also Chapter V, paragraph 1.4).

2. Determining priority dates

2.1 As a general rule, the examiner in the International Preliminary Examining Authority should not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if the subject matter of the claimed invention has been published within the meaning of PCT Rule 64.1 on or after the priority date claimed and before the international filing date or forms part of the content either of a non-written disclosure within the meaning of Rule 64.2, i.e., a non-written disclosure which occurred before the priority date and which was indicated in a written disclosure in the period between the priority date and the international filing date, or of an application or patent within the meaning of PCT Rule 64.3, i.e., an application or patent which was published after that date but was filed earlier than the international filing date or claimed the priority of an earlier application which was filed prior to the international filing date. In such cases, the examiner must satisfy himself that the priority date(s) claimed may be accorded to the appropriate parts of the international application he is examining and, where appropriate, will also consider the validity of any priority date claimed for the application or patent within the meaning of PCT Rule 64.3 (see also Rule 70.10, last sentence).

2.2 When the examiner in the International Preliminary Examining Authority needs to consider the question of priority date, he should bear in mind all the matters which are mentioned in Chapter V, paragraphs 1.3 to 1.5 and 2.1. He should also remember that, to establish a priority date, it is not necessary that all of the elements of the invention for which priority is claimed should be found among the claims in the previous application. It is sufficient that the documents of the previous application taken as a whole specifically disclose such elements. The description and any claims or drawings of the previous application should, therefore, be considered as a whole in deciding this question, except that account should not be taken of subject matter found solely in that part of the description referring to prior art, or in an explicit disclaimer.

2.3 The requirement that the disclosure must be specific means that it is not sufficient if the elements in question are merely implied or referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. Exact correspondence is not required, however. It is enough that, on a reasonable assessment, there is in substance a disclosure of all the important elements of the claim.

2.4 On the other hand, an element claimed broadly and generally in the international application should be considered to be specifically disclosed if there is a particular disclosure of that element in the priority document and the generalization is obvious from that particular disclosure. For example, a claim to apparatus including "releasable fastening means" would normally be entitled to the priority date of a disclosure of that apparatus in which the relevant fastening element was, say, a nut and bolt, or a spring catch or a toggle-operated latch, even when the earlier disclosure does not refer to the fastening element in broad terms.

2.5 If the tests set out in Chapter V, paragraphs 2.2 to 2.4 are not satisfied in relation to a particular earlier application, then the effective date of the claim will either be the priority date of the earliest application which satisfies the tests and does provide the required disclosure or, in the absence of such, will be the international filing date of the international application itself.

Compilation of responses in respect of paragraphs 2.1 to 2.5

- (i) Delete these sections, not necessary for IPEAs. (GB)
- (ii) Do not agree with the deletion of a part of paragraph 2.1 as proposed by the US (NL).

Note:

Paragraphs 2.1 to 2.5 have been redrafted in terms of PCT Rule 64.

3. Claiming priority

Rule 17.1

3.1 An applicant who wishes to claim priority must state this on the request (Form PCT/RO/101) giving particulars of the previous filing, as specified in Rule 4.10 (see, however, paragraph 3.2 below) and submit a certified copy of the priority document to the International Bureau within 16 months of the priority date unless it was already filed with the receiving Office together with the international application.

3.2 The examiner in the International Preliminary Examining Authority should keep in mind that the form of the declaration (see Chapter V, paragraph 3.1) claiming the priority of one or more earlier applications under Article 8(1) of the Treaty is prescribed in the Regulations under Rule 4.10(a), namely:

"(i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, the country or countries for which it was filed,

(ii) the date on which it was filed,

(iii) the number under which it was filed, and

(iv) when the earlier application is a regional or an international application, the national Office or intergovernmental organization with which it was filed."

It is clear from the provisions of Rule 4.10(c) that the number of the priority document if not indicated in the request (Form PCT/RO/101) must be furnished by the applicant to the International Bureau within 16 months of the priority date. It is also clear from the provisions of Rule 4.10(b), however, that a priority claim will be considered not to have been made if it fails to specify at the time of filing the international application that the priority of an earlier application is claimed, or fails to specify the particulars required by Rule 4.10(b), namely:

"(i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, at least one country for which it was filed, and

(ii) the date on which it was filed."

Rule 66.7(a)

3.3 If the examiner in the International Preliminary Examining Authority needs a copy of the priority application, the copy is supplied on request by the International Bureau unless the International Bureau has not yet received the priority document in which event the applicant must, upon request by the International Preliminary Examining Authority, furnish such certified copy to the International Bureau and directly to the International Preliminary Examining Authority. If the priority application is not in the language, or one of the languages (if more than one), of the International Preliminary Examining Authority, the applicant must provide, on the invitation of the International Preliminary Examining Authority, a translation within two months of the invitation, failing which the priority claim will be disregarded and the international preliminary examination report will be established as if the priority had not been claimed.

Rule 66.7(b)

Rule 66.7(c)

CHAPTER VI

PROCEDURE BEFORE THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

1. Introduction

Art. 31 1.1 Subject to certain requirements as to entitlement to have international preliminary examination (because the Contracting States of the PCT are entitled to exclude the application of Chapter II of the PCT relating to international preliminary examination), an applicant under the PCT may, by filing a "demand," have an international preliminary examination of his international application. The report of the international preliminary examination will be transmitted to such of the States which are bound by Chapter II and were designated in his international application at the time it was filed (these are the States in which the international application has effect as a national application) as he elects. Under Chapter II, these nominated States are called the "elected States." The applicant may also add further designated States by means of a "later election." The international preliminary examination is carried out by the competent International Preliminary Examining Authority appointed by the Assembly of the PCT Union and has, as its objective, the formulation of a preliminary and non-binding opinion on the questions whether the invention claimed in the international application appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable.

Art. 32(2) 1.2 As a condition of its appointment, each International Preliminary Examining Authority enters into an agreement with the International Bureau. On the basis of this agreement, which specifies, among other things, the Contracting States for which the International Preliminary Examining Authority is prepared to act, the Contracting States indicate one or more International Preliminary Examining Authorities competent for the international preliminary examination of international applications filed with the national Offices of such States (or such other Office or intergovernmental organization as acts for any such State). The applicant submits his demand for international preliminary examination directly to the competent International Preliminary Examining Authority, or one of them, if there is more than one. Any later election adding to those elected in the demand is filed with the International Bureau.

Art. 34(2)(c) 1.3 The results of the international preliminary examination, in the course of which one or more written opinions may be issued to the applicant by the International Preliminary Examining Authority and communication with the applicant may occur, are given in an international preliminary examination report established by that Authority.

Art. 33(5) 1.4 The criteria of novelty, inventive step and industrial applicability which the International Preliminary Examining Authorities apply are not binding on the elected States which are free to apply additional or different criteria for the purpose of deciding whether, in such States, the claimed invention is patentable or not. Nevertheless, the criteria are such that the applicant will be assisted in determining, on the basis of the international preliminary examination report, whether he is likely to obtain protection in the elected States and, moreover, any amendments or further amendments he should make to his international application. Furthermore, the international preliminary examination report can be expected to be of assistance to the elected Offices and the applicant in the further processing of the international application in the national phase.

1.5 The present Chapter sets out the procedure before the International Preliminary Examining Authority with respect to international preliminary examination from the time such examination starts. Matters preceding the start of international preliminary examination do not come within the ambit of these Guidelines and, thus, are not taken into account except to the extent that they provide necessary background to the international preliminary examination procedure. Similarly, matters of internal administration are not mentioned since they fall within the province of each individual International Preliminary Examining Authority.

2. General outline of steps in the procedure before the International Preliminary Examining Authority

2.1 International preliminary examination involves the following steps: the applicant demands international preliminary examination; the demand is addressed to the International Preliminary Examining Authority; that Authority conducts the international preliminary examination, which is essentially directed to the questions whether the claimed invention is new, involves an inventive step (is non-obvious) and is industrially applicable; the Authority may issue one or more written opinions and the applicant and the Authority communicate with each other during the international preliminary examination and the applicant is given at least one opportunity to amend the claims, the description, and the drawings; the Authority issues its report which does not contain any statement on the question whether or not the claimed invention is or seems to be patentable according to the law of any country; it merely states--by a "Yes" or "No"--in relation to each claim whether such claim seems to satisfy the said three criteria and each such statement is accompanied by citations and other explanations; finally, the report and, where requested, copies of the documents cited therein which were not cited in the international search report are communicated to the applicant and the national Offices of the States in which the applicant wishes to use the international preliminary examination report ("elected States").

Art. 38

2.2 The international preliminary examination report is not published. The very fact that international preliminary examination has been demanded remains confidential. Possible withdrawal of the demand and the results of the international preliminary examination are equally confidential.

3. Start of, and time limit for, international preliminary examination

Art. 31(2)(3))
and (4)

3.1 Prior to the start of international preliminary examination of an international application, the applicant must, of course, have filed a demand (Form PCT/IPEA/401) that his international application be the subject of an international preliminary examination (as explained in Chapter VI, paragraph 1.2, the applicant submits the demand directly to the competent International Preliminary Examining Authority), the demand indicating the State or States ("elected States") in which the applicant intends to use the results of the international preliminary examination. Having regard to the nature of international preliminary examination and the varying situations which may exist with regard to the examination of the international application in the national phase (i.e., by the elected Offices), the PCT leaves open when the demand shall be filed. The demand can be filed with the international application or at any time thereafter. It is most likely that the applicant will, in fact, do this some time after the end of 18 months from the priority date since he should have received the international search report by the end of the 16th month, and use the 17th and 18th months to make up his mind whether to demand international preliminary examination.

3.2 The international preliminary examination starts upon receipt by the International Preliminary Examining Authority, of:

Rule 69.1(b)

(i) the claims as amended before the International Bureau under Article 19 (see Chapter VI, paragraph 4.10); or

(ii) a notice from the International Bureau that no amendments were filed within the prescribed time limit under Article 19 or that the applicant has declared that he does not wish to make such amendments (see Chapter VI, paragraph 4.10); or

(iii) a notice, after the international search report is in the possession of the International Preliminary Examining Authority, from the applicant expressing the wish that the international preliminary examination should start and be directed to the claims as specified in such notice; or

(iv) a notice of the declaration under Article 17(2)(a) by the International Searching Authority that no international search report will be established (see Chapter VI, paragraph 4.3).

Rule 69.1(a) 3.3 The time limit for the establishment of the international preliminary examination report is calculated from the start of the international preliminary examination. The time limit for any particular International Preliminary Examining Authority is set out in the agreement between that Authority and the International Bureau (see Chapter VI, paragraph 1.2). The time limit may not exceed:

(i) six months after the start of the international preliminary examination;

(ii) in cases where the International Preliminary Examining Authority issues an invitation to restrict the claims or pay additional fees under Article 34(3), (see Chapter VI, paragraph 5.4), eight months after the start of the international preliminary examination.

Rule 69.1(c) 3.4 However, if the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes, start at the same time as the international search. In such a case, the international preliminary examination report (see Chapter VI, Section 8) must be established, notwithstanding the prescribed time limit for establishing the international preliminary examination report, not later than six months after the expiration of the time limit allowed under Article 19 for amending the claims (see Chapter VI, paragraph 4.10) before the International Bureau.

Rule 69.1(a) (i)
and (ii)

3.5 Where the two procedures are "telescoped" in this way, the first written opinion of the examiner in the International Preliminary Examining Authority (see Chapter VI, paragraph 5.9) may be issued at the same time as the international search report, that is, in the normal situation where priority is claimed, by the end of the 16th rather than the 20th month. The four months so gained may then be used by the examiner to allow for a second written opinion and a second reply by the applicant during the international preliminary examination, should this be needed.

4. Documents for the International Preliminary Examining Authority

Rule 62.1((a)

4.1 The examiner will (where the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority) have in the dossier the documents making up the international application and a complete history of the proceedings up to the start of the international preliminary examination. In particular, this dossier will normally include, in addition to the demand (see Chapter VI, paragraph 3.1), the request, description, drawings (if any) and the claims as originally filed; any amendments proposed to date; the international search report with the applicant's comments (if any), and copies of any cited documents; the correspondence concerning any informalities from the receiving Office or the International Searching Authority and, depending upon the circumstances, the priority documents (see Chapter V, paragraph 3.1) as well as any required translations (see Chapter VI, paragraphs 4.4 to 4.9).

Rule 62.1(b)

4.2 In the case where the international search is performed by an International Searching Authority which is not part of the same national Office or intergovernmental organization as the International Preliminary Examining Authority, the dossier making up the international application will normally include the same contents as those referred to in Chapter VI, paragraph 4.1, subject to the receipt of the international application and the international search report from the International Bureau.

4.3 The examiner in the International Preliminary Examining Authority should keep in mind that the documents making up the international application may contain the declaration referred to in Article 17(2)(a) instead of an international search report, i.e., the declaration of the International Searching Authority that it considers that the international application relates to a subject matter which it was not required to search and decided not to search, or that the description, the claims, or the drawings failed to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out. In this case, the examiner should appraise the declaration as if it were the international search report (see also Chapter VI, paragraph 5.3).

Language and translation of the international application and language of the demand

Art. 3(4)(i)
Rule 12 4.4 Where the International Preliminary Examining Authority is a part of the same Office or intergovernmental organization as the International Searching Authority, it will not need a translation of the international application since that application will have been filed in the language, or one of the languages used by that Authority and specified in the agreement concluded between the International Bureau and that Office or organization as an International Searching Authority.

Rule 55.2(a) 4.5 Where the International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the International Searching Authority and the international application is in a language other than the one specified in the agreement between the International Bureau and the International Preliminary Examining Authority, the International Preliminary Examining Authority may require the applicant to submit a translation of the international application into that language, or one of them, not later than the later of the following dates:

Rule 55.2(b)
(i) and (ii) (i) two months from the date of transmittal of the international search report to the applicant and the International Bureau by the International Searching Authority or, if transmittal of the international search report took place before the expiration of 14 months from the priority date, three months from the date of such transmittal; or

(ii) the date on which the demand is submitted.

Rule 55.2(d) 4.6 If the requirements set forth in Chapter VI, paragraph 4.5 have not been complied with, the International Preliminary Examining Authority should invite the applicant to submit the required translation of the international application. The translation must be submitted within one month of the date of the invitation and, when submitted, must contain a signed statement by the applicant that the translation is, to the best of applicant's knowledge, complete and faithful. The International Preliminary Examining Authority must determine whether the translation has been timely filed and, if not, notify the applicant and the International Bureau that the demand shall be considered as if it had not been submitted.

Rule 55.2(c)

4.7 The demand submitted to the International Preliminary Examining Authority must be in the language of the international application (see Chapter VI, paragraph 4.4), unless a translation of the international application is needed, in which event the demand must be in the language of that translation.

4.8 The examiner in the International Preliminary Examining Authority should keep in mind that the text of the international application as filed ("record copy") is the authentic text. Where the facility provided for by Article 34(2)(b) (see also Chapter VI, paragraph 4.11) has been used and the question arises as to whether a particular amendment proposed by the applicant extends the content of the international application as filed (see Chapter VI, paragraphs 7.7 to 7.10), it is the authentic text which determines the content of the international application as filed and, thus, constitutes the basis for determining this question. The examiner should, however, normally assume, in the absence of evidence to the contrary, that the original translation into a language of the International Preliminary Examining Authority is in conformity with the text in the original language of filing. If the examiner determines that an erroneous translation has been furnished by the applicant, he may ask the applicant to bring such translation into conformity with the language of the authentic text at any time during the proceedings before the International Preliminary Examining Authority.

Priority document and translation thereof

Rule 66.7(a)
and (b) 4.9 Where the international application claims the priority of a previous application (priority document) and the examiner in the International Preliminary Examining Authority needs the priority document or a translation thereof, the examiner should request the International Bureau or, where the priority document has not yet been received by the International Bureau under Rule 17.1(a), the applicant himself, to furnish a certified copy of the priority document. When the priority document is not in the language or in one of the languages of the International Preliminary Examining Authority (see Chapter VI, paragraph 4.5), the examiner should invite the applicant to furnish a translation of the priority document within two months from the date of such invitation (see Chapter V, paragraphs 3.2, 3.3 and 3.5). If the examiner finds that the requested priority document and (where required) the translation have not been timely furnished, he must establish the international preliminary examination report as if the priority had not been claimed in the international application and indicate this in the report.

Rule 66.7(c)

Amendment prior to the start of international preliminary examination

- Rule 62.2(a) 4.10 The documents making up the international application referred to in paragraph 4.1 above, may include amendments of the claims filed by the applicant under Article 19. These will have been transmitted to the International Preliminary Examining Authority by the International Bureau. If a demand for international preliminary examination has already been submitted, the applicant must, at the time he files the Article 19 amendments, also file a copy of the amendments with the International Preliminary Examining Authority. In the event that the time limit for filing amendments under Article 19, as provided in Rule 46.1 (two months from the date of transmittal of the international search report by the International Bureau and to the applicant by the International Searching Authority or, when such transmittal takes place before the expiration of 14 months from priority date, three months from the date of such transmittal), expires without the applicant having filed amendments under that Article, the International Bureau will have notified the International Preliminary Examining Authority. (see Chapter VI, paragraph 3.2).
- Rule 62.2(b)
- Art. 34(2)(b)
Rule 66.1
Rule 66.8(a) 4.11 Article 34(2)(b) and Rule 66.1 provide that the applicant has the right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the start of international preliminary examination. The amendment must not go beyond the disclosure in the international application as filed.
- Rule 66.1 4.12 Such amendments may include comments on the international search report and amendments to the description, claims or drawings. 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) (see Chapter VI, paragraph 5.9) or under Rule 13 (i.e., that there is 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.
- Rule 66.1 4.13 The amendments are made by the applicant of his own volition. This means that the applicant is not restricted to amendment necessary to remedy a defect in his international application. It does not, however, mean that the applicant should be regarded as free to amend in any way he chooses. Any amendment must not add subject matter which goes beyond the disclosure of the international application as originally filed (see Chapter VI, paragraph 4.11). Furthermore, it should not itself cause the international application as amended to be objectionable under the PCT, e.g., the amendment should not introduce obscurity.
- Art. 34(2)(b)
Arts. 5 and 6

5. First stage of international preliminary examination

General

- Art. 34(2)(c)
(i) 5.1 The purpose of international preliminary examination is to render a non-binding opinion on the question whether the claimed subject matter of the international application meets the criteria set out in Article 33(1), i.e., whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. The task of the examiner in the International Preliminary Examining Authority in dealing with these criteria and judging whether or not they have been met is dealt with in more detail, in so far as appears necessary, in Chapter IV.
- 5.2 The international preliminary examination is to be carried out in accordance with Article 34 and Rule 66. The first step of the examiner in the International Preliminary Examining Authority is to study the description, the drawings (if any) and the claims of the international application.
- Art. 34(2)(c) 5.3 If the examiner in the International Preliminary Examining Authority is of the opinion that, having regard to the prior art, the claimed invention satisfies the criteria specified in Article 33(1), and that no defects exist in the form and contents of the international application (see Chapter VI, paragraph 5.9), he will not prepare a written opinion (see Chapter VI, paragraphs 5.9 to 5.19 and Section 6) but will instead prepare the international preliminary examination report (see

Chapter VI, section 8). More usually, however, there will be matters which require a written opinion. In addition, there may be a lack of unity of invention which the examiner will generally deal with before the first written opinion is issued to the applicant or, if appropriate, concurrently therewith.

Lack of compliance with the requirement of unity of invention

Rules 68.2 and
68.3(b)

5.4 Where the examiner in the International Preliminary Examining Authority finds lack of unity of invention (see Chapter III, section 7), a communication may, at the option of the examiner (see Chapter VI, paragraph 5.8), be sent to the applicant informing him why there is a lack of unity of invention and inviting him within a period stated in the invitation (the period may be between one and two months from the date of the invitation), either to restrict the claims or to pay an additional fee for each additional invention claimed. Where such a communication is sent, at least one possible restriction, according to the circumstances of the case, must be indicated by the examiner.

Art. 34(3) (c)

Rule 68.5

5.5 If the applicant does not comply with the invitation, the international preliminary examination report will have to be established on those parts of the international application which relate to what appears to be the "main invention" and the examiner will then indicate the relevant facts in such report. In cases of doubt as to which is the main invention, the invention first mentioned in the claims should be considered the main invention.

Rule 68.3(c) and
(d)
Section 603
Administrative
Instructions

5.6 There may be cases where the applicant makes payment of additional fees, but does so under protest. In this case, a competent higher authority of the International Preliminary Examining Authority (three-member board or other special instance not including any person who made the decision which is the subject of the protest) must hold a hearing and decide on the justification of the applicant's protest. The applicant is then notified of the decision. The International Preliminary Examining Authority registers the notice of protest and its decision thereon and, if requested by the applicant, forwards them together with the international preliminary examination report (after its establishment) to the International Bureau so that they may be notified to the elected Offices. If the applicant's protest is found to be justified, the additional fees, or the appropriate portion thereof, must be refunded.

5.7 Subject to the decision on protest, or if the applicant timely complied with the requirement to restrict or pay additional fees, the examiner in the International Preliminary Examining Authority will thereafter carry out international preliminary examination on those claimed inventions for which additional fees have been paid or to which international preliminary examination has been restricted.

Rule 68.1

5.8 The examiner in the International Preliminary Examining Authority may choose not to raise the question of lack of unity of invention which may exist in the international application (see also Chapter IV, paragraph 7.5). In this situation, he will carry out his examination and establish the international preliminary examination report on the entire international application (subject to Article 34(4) (a), see Chapter VI, paragraph 5.3), but will indicate, when establishing the report, his opinion that the requirement of unity of invention is not fulfilled and the reasons therefor.

First written opinion

5.9 The first written opinion of the examiner in the International Preliminary Examining Authority under Article 34(2) (c) should, cover all matters referred to in Rule 66.2. Such matters may be defects under Article 34(4) (subject matter of the application not required to be examined by the International Preliminary Examining Authority or meaningful opinion on novelty, inventive step or industrial applicability not possible because of lack of clarity or because the claims are not adequately supported by the description), an apparent failure to meet the criteria of novelty, inventive step or industrial applicability, defects in the form or contents of the international application (e.g., failure to comply with one or more of the requirements specified in Rules 5 to 11), amendments which appear to go beyond the disclosure of the international application as filed, and an apparent lack of clarity in the claims, the description or the drawings or of support for the claims in the description such as

would require some observations to be made in this respect in the international preliminary examination report should such report be established on the basis of the international application without further amendment.

- 5.10 In the event that the examiner in the International Preliminary Examining Authority finds that the international application is defective in that it lacks compliance with Article 34(4)(a)(i) or that all the claims of the international application lack compliance with Article 34(4)(a)(ii), he will indicate these defects in his first written opinion and will not go into the question, in that opinion, whether the claimed invention appears to be novel, appears to involve an inventive step and is industrially applicable. Where such a defect affects only some of the claims, a similar approach should be adopted in respect of such claims.
- Rule 66.2(a)(i)
- 5.11 The procedure in the case where no meaningful opinion can be formed, as explained in Chapter VI, paragraph 5.10, applies *mutatis mutandis* in the case where the international application relates to a subject matter on which the International Preliminary Examining Authority is not required, under Rule 67, to carry out international preliminary examination, and, in the particular case, decides not to carry out such examination. Furthermore, the procedure applies in relation to only one or some of the claims if either of these two situations are found to exist in respect of such claims.
- Rule 61.2(a)(i)
Article 34(4)(a)(i)
Article 34(4)(b)
- 5.12 Any amendment which appears to go beyond the disclosure in the international application as filed must be brought to the notice of the applicant since, although the international preliminary examination report (see Chapter V, Section 8) is established on the basis of the claims as amended, such report will not take into account any amendment which the International Preliminary Examining Authority considers to be beyond the disclosure in the international application as filed, but will instead indicate the opinion that the amendment goes beyond the disclosure in the international application as filed and the reasons for that opinion.
- Rule 70.2(a)
Rule 70.2(c)
- 5.13 For each ground of objection the first written opinion should indicate the part of the international application which is deficient and the requirement of the PCT which is not met, either by referring to specific Articles or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the main claim or claims, and if consequently there is lack of unity of invention between dependent claims, the applicant should be notified of this situation (see also Chapter III, Section 7 and Chapter VI, paragraphs 5.4 to 5.8) concurrently with the examiner's first written opinion. Substantive matter in the said opinion should normally be set out first. The opinion should be drafted in such a manner as to facilitate further international preliminary examination of the international application should it be amended, and, in particular, to avoid the need for extensive re-reading should the examiner wish to issue one or more additional written opinions (see Chapter VI, paragraphs 6.1 to 6.3).
- Rule 66.2(b)
- 5.14 The first written opinion should include an invitation to the applicant to file his observations, to correct any formal deficiencies and otherwise to submit amendments to the description, claims and drawings. It must also state the period (normally two months) within which the applicant must reply. Failure to reply to the invitation may cause the examiner to establish the international preliminary examination report with a negative determination in relation to certain claims or to take action as the circumstances of the case may require.
- Rule 66.2(c)
Rule 66.2(d)
- 5.15 It is emphasized that the first sentence of Chapter VI, paragraph 5.9 only sets out the general rule. There may be cases in which, although a meaningful international preliminary examination is possible, a fundamental objection arises, e.g., it is clear that certain claims lack novelty and that the claims will have to be drastically recast, or there are substantial amendments which are not proper for one of the reasons stated in Chapter VI, paragraph 4.13. In such cases, it may be more appropriate to deal with this objection before making a detailed international preliminary examination; if, e.g., the claims need re-casting, it may be pointless to raise objections to the clarity of some dependent claims or to a passage in the description which may have to be amended or even deleted

as a consequence. However, if there are other major objections, these should be dealt with. Generally the examiner should, at the first written opinion stage, seek to make the maximum impact with the broad aim of bringing matters to a conclusion without any undue delay in order to meet the time limits for establishing the international preliminary examination report (see Chapter VI, paragraph 3.3).

Art. 34(2)(b) 5.16 When making the full international preliminary examination for the purposes of the first written opinion, the examiner in the International Preliminary Examining Authority should concentrate on trying to understand what contribution the invention as defined in the claims makes to the prior art. This should normally be sufficiently clear from the international application as filed. If it is not, the applicant should be invited to elucidate the matter (see Chapter III, paragraph 4.2); but the examiner should not raise an objection of this kind unless he is convinced it is necessary, since to do so might result in the applicant introducing additional subject matter going beyond the disclosure in the international application as filed (see Chapter VI, paragraph 4.11).

5.17 Although the examiner in the International Preliminary Examining Authority must bear in mind all the requirements of the PCT, the requirements which are most likely to require attention in the majority of cases are sufficiency of disclosure (see Chapter II, Section 4); clarity, especially of the independent claims (see Chapter III, Section 4); novelty (see Chapter IV, Section 5); and inventive step (see Chapter IV, Section 9).

5.18 The examiner in the International Preliminary Examining Authority should not suggest amendments merely because he thinks they will improve the wording of the description or claims. A pedantic approach is undesirable; what is important is that the meaning of the description and claims should be clear. Also, while any serious inconsistencies between the claims and the description as filed should be objected to (see Chapter III, paragraph 4.3), if the claims appear to require substantial amendment the examiner should invite the applicant to also amend the description, if necessary, cautioning the applicant, however, that the description must be in conformity with the final form of the amended claims without including any additional disclosure not supported by the international application as originally filed, even though the final form of at least the main claims may still not be settled. This procedure may help the examiner to expedite the issuance of the international preliminary examination report within the prescribed time limits.

Rule 66.8(a) 5.19 It must be emphasized that it is not part of the duty of the examiner in the International Preliminary Examining Authority to invite the applicant to amend the international application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and he should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of the PCT. However, it may sometimes be useful if the examiner suggests, at least in general terms, an acceptable form of amendment; but if he does so, he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered.

6. Further stage of international preliminary examination

Art. 34(2)(d)
Rule 66.4 (a) 6.1 When the applicant has responded to the first written opinion, the examiner in the International Preliminary Examining Authority may, if necessary and if sufficient time remains for the applicant to respond and for the international preliminary examination report to be established (see Chapter VI, paragraph 3.3), issue one or more additional written opinions. Likewise, if the applicant so requests, the examiner may give him one additional or more opportunities to submit amendments or corrections.

Rule 66.4(b) 6.2 The examiner in the International Preliminary Examining Authority should apply the same standard of international preliminary examination in relation to matters of substance at all stages in the processing of the international application. However, after the first written opinion stage, he will not normally need to completely re-read the amended application if he has drafted his first written opinion in a comprehensive way (see Chapter VI, paragraph 5.9) but should concentrate on the amendments themselves and any related passages, and on the deficiencies indicated in his first written opinion.

- 6.3 The examiner in the International Preliminary Examining Authority should be guided at the additional written opinion stage by the over-riding principle that an international preliminary examination report should be established after as few written opinions as possible, and he should control the procedure with this always in mind. The PCT provides that the process of communicating with the applicant described in Chapter VI, paragraph 5.14, shall be repeated if the International Preliminary Examining Authority so wishes. Nevertheless, if it is clear that the applicant is not making any real effort to deal with the examiner's objections, either by amendments or by counter-arguments, then at the conclusion of the first written opinion stage the examiner should establish the international preliminary examination report (see Chapter VI, Section 8). In the majority of cases, however, the re-examination will show that a bona fide attempt has been made to meet the examiner's objections. In these cases, if there are still objections that require to be met, the examiner must consider whether they could best be resolved by a further written opinion, a telephone discussion or an interview.
- 6.4 If the matters are such that the applicant is likely to require time to consider them, it will probably be preferable to deal with them by means of an additional written opinion. If, however, there seems to be confusion about points in dispute, e.g., if the applicant seems to have misunderstood the examiner's reasons, or if the applicant's own argument is not clear, then it may expedite matters if the examiner proposes an interview. On the other hand, if the matters to be resolved are minor, or can quickly and easily be explained and dealt with, then they might be settled more expeditiously by telephone discussion. Discussion with the applicant by interview or telephone is more fully considered in Chapter VI, paragraphs 7.16 to 7.21.
- 6.5 The additional written opinion from the examiner in the International Preliminary Examining Authority would, normally, again invite the applicant to submit a written reply together with amendments or corrections. After receipt of this opinion, the applicant may respond by amending the claims, description and drawings or if he disagrees with the opinion, submit arguments, as the case may be, or do both. The conditions for amendments set out in Chapter VI, paragraph 4.13 and Section 7 would apply.
7. Matters applicable generally to various stages of international preliminary examination
- Making the amendments--general considerations
- 7.1 Amendments to the claims, the description and the drawings must be made by filing replacement sheets when, on account of the amendments, the replacement sheet differs from the sheets of the international application as originally filed. The replacement sheets must be accompanied by a letter which draws attention to the differences between the replaced sheets and the replacement sheets.
- 7.2 In the particular case where the amendments cancel the claims, passages in the description or certain drawings, resulting in the cancellation of an entire sheet, the amendment must be submitted in the form of a letter cancelling the sheet.
- 7.3 It should be noted that, when a replacement sheet or letter is required under Chapter VI, paragraphs 7.1 and 7.2, the applicant must submit such sheet or letter typed in amended form. However, in cases where the correction or amendment made by the applicant is insubstantial (e.g., not more than a few, say, for example, up to six words), he may submit a replacement sheet to the International Preliminary Examining Authority on which the correction or amendment is interlineated in typescript, if such interlineation is free from erasures, alterations and overwriting, and so long as the authenticity of the replacement sheet is not in question and the requirements for good reproduction are met. The International Preliminary Examining Authority should invite the applicant to resubmit his amendments in proper form whenever compliance with these principles is lacking.
- 7.4 The examiner in the International Preliminary Examining Authority should also note that any paper submitted by the applicant in the course of international preliminary examination other than the international application itself, if not in the form of a letter, must be accompanied by a letter signed by the applicant. The letter should identify the international application to which it relates and be in the same language as the said application unless a translation is required in which event it must be in the language of that translation.

If these requirements are not complied with, the applicant should be notified that the paper shall be considered not to have been submitted.

Rule 92.2(b)

7.5 In the exceptional case, the applicant may request the International Preliminary Examining Authority to allow a change in the language of correspondence being submitted to another language authorized by the International Preliminary Examining Authority. If such a change is allowed, correspondence with the applicant would be in the new authorized language.

Appraisal of amendments

7.6 Any amendments filed in accordance with the PCT which are necessary to correct any deficiencies notified to the applicant should be accepted. The examiner should also consider as acceptable restriction of the scope of the claims or amendments which improve the clarity of the description or amendment of the claims in a manner clearly desirable, without changing their subject-matter content or scope. An amended international application must, of course, satisfy all the requirements of the PCT including the matters listed in Chapter VI, paragraph 5.17 (see also Chapter VI, paragraph 4.12). However, especially when the claims have been substantially limited, the examiner in the International Preliminary Examining Authority should bear in mind that the following questions may require special consideration at the amendment stage:

(i) Unity of invention: Do the amended claims still satisfy the requirement of Rule 13? If the international search report seems to clearly reveal lack of novelty or inventive step in the concept common to all the claims and the amended claims do not necessitate further search, the examiner should not object to lack of unity of invention (see Chapter III, paragraph 7.5). If, however, the claims lack a common inventive concept and a further search is necessary, unity of invention may be raised (see also Chapter VI, paragraphs 5.4 to 5.8).

(ii) Agreement of description and claims: If the claims have been amended, will the description require corresponding amendment to remove serious inconsistency between them? For example, is every embodiment of the invention described still within the scope of one or more claims? (see Chapter III, paragraph 4.3). Conversely, are all of the amended claims supported by the description? (see Chapter III, section 6). Also, if the categories of claims have been altered, will the title require a corresponding amendment? (See Chapter II, paragraph 3.2.)

It is important also to ensure that no amendment adds to the content of the application as filed and thus violates Article 34(2)(b) as explained in the following paragraphs.

Additional subject matter

7.7 There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant, nor should the straightforward clarification of an obscurity, or the resolution of an inconsistency, be objected to. When, however, the applicant seeks to amend the description (other than references to the prior art), the drawings, or the claims in such a way that subject matter which extends beyond the content of the application as filed is thereby introduced, the amendment cannot be taken into account in the establishment of the international preliminary examination report.

Art. 34(2)(b)
Rule 70.2(c)

7.8 An amendment should be regarded as extending the content of the international application and, therefore, not be taken into account for the purposes of international preliminary examination if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the person skilled in the art being presented with information which differs from that presented by the international application as originally filed.

7.9 The subject matter newly presented may be introduced by explicitly mentioning matter which was either not previously mentioned at all, or only implied. For example, if in an international application relating to a rubber composition comprising several ingredients the applicant seeks to introduce the information that a further ingredient might be added, then this amendment should normally be regarded as going beyond the disclosure in the application as originally filed. Likewise, if an application which describes and claims apparatus "mounted on resilient supports," without disclosing any particular kind of resilient support the applicant seeks to add specific information that the supports are, or could be, e.g., helical springs (see, however, Chapter VI, paragraph 7.10), then the amendment should normally be regarded as going beyond the disclosure in the application as originally filed.

7.10 If, however, the applicant can show convincingly that the subject matter in question would, in the context of the claimed invention, be so well-known to the person skilled in the art that its introduction could be regarded as an obvious clarification, and, therefore, as not extending the content of the application, it is permissible. For example, if in the case of the rubber composition referred to in Chapter VI, paragraph 7.9, the applicant were able to show that the further ingredient which he sought to introduce was a well-known additive normally used in rubber compositions of that kind as an aid to mixing and that its omission would generally be questioned, then reference to such an additive would be permissible on the ground that it merely clarified the description and introduced nothing not already known to the person skilled in the art. However, if the introduction of this additive brought about some special effects not originally disclosed, an amendment mentioning this would not be permissible. Similarly, if in the above-mentioned case of the resilient supports the applicant were able to demonstrate that drawings, as interpreted by the person skilled in the art, showed helical springs, or that the person skilled in the art would naturally use helical springs for the mounting in question, then specific reference to helical springs should be regarded as permissible.

7.11 Amendment by the introduction of further examples, e.g., in the chemical field, should always be looked at very carefully, since prima facie any further example to illustrate a claimed invention may extend the disclosure of the international application as originally filed.

7.12 As indicated in Chapter VI, paragraph 7.9, alteration or excision of the text, as well as the addition of further text, may introduce new subject matter. For instance, suppose a claimed invention related to a multi-layer laminated panel and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment either to alter the outer layer to polypropylene or to omit this layer altogether would not normally be regarded as permissible. In each case the panel disclosed by the amended example would be quite different from that originally disclosed and hence the amendment would be considered as introducing new subject matter.

Correction of obvious errors of transcription

- Rule 91.1(b) 7.13 Errors which are due to the fact that something other than that which was obviously intended was written in the contents of the international application (other than the request) or other paper submitted to the International Preliminary Examining Authority by the applicant (e.g., linguistic errors, spelling errors) may usually be corrected at any time during international preliminary examination. The correction must be "obvious" in the sense that it is immediately apparent from the subject matter which it is sought to correct:
- (i) that an error has occurred; and
 - (ii) what the correction should be.
- Rule 66.5 If a correction is not of this character (e.g., if it involves cancellation of claims, omission of passages in the description or omission of certain drawings), it would have to be submitted by the applicant as an amendment and dealt with on that basis (see Chapter VI, paragraph 7.6).
- Rule 91.1(d) 7.14 Rectification of obvious errors of transcription in the international application can be made on the request of the applicant of his own volition. In addition, the examiner in the International Preliminary Examining Authority, upon study of the international application and any other papers submitted by the applicant other than the request, might also note obvious errors of transcription. In this latter case, the examiner should invite the applicant to submit a request for rectification of such errors.
- Rule 91.1(g)
(iii) 7.15 The examiner in the International Preliminary Examining Authority may only authorize corrections of obvious errors of transcription up to the time the international preliminary examination report is established. Where such corrections are authorized by him, he must record the date of authorization for rectification in the file of the international application. The examiner must notify the applicant and the International Bureau of any rectification authorized or, where he has denied the authorization for rectification, notify only the applicant of such denial and the reasons therefor.
- Rule 91.1(f)
- Rule 91.1(h)
Section 109
Administrative
Instructions

Informal communication with the applicant

Rule 66.6

7.16 "The International Preliminary Examining Authority may, at any time, communicate informally, over the telephone, in writing, or through personal interviews, with the applicant." The circumstances in which it may be appropriate for the examiner in the International Preliminary Examining Authority to communicate with the applicant by telephone or propose an interview rather than send an additional written opinion are considered in Chapter VI, paragraphs 6.3 and 6.4. Communication will, in most instances, be with the applicant's authorized agent (the meaning of agent in the PCT is set out in Rule 2.2) rather than the applicant himself. If the applicant, or his agent request an interview, the examiner, at his discretion, can grant such interview unless he believes that no useful purpose would be served by such a discussion.

7.17 When an interview is arranged, whether by telephone or in writing, and whether by the examiner in the International Preliminary Examining Authority or by the applicant, the matters for discussion should be stated. If the arrangement is made by telephone, the examiner should record the particulars and briefly indicate, on the file, the matters to be discussed.

7.18 The interview will normally be conducted solely by the examiner in the International Preliminary Examining Authority who is responsible for the international application. It is an informal procedure and the recording of the interview depends upon the nature of the matters under discussion. Where the interview is concerned with the clarification of obscurities, the resolution of uncertainties, or putting the international application in order by clearing up a number of minor points, it will usually be sufficient if the examiner makes a note on the file of the matters discussed and the conclusions reached, or amendments agreed upon. If, however, the interview is concerned with reviewing weightier matters, such as questions of novelty, inventive step, or whether the amendment introduces new subject matter, then a fuller note of the matters discussed should be made in the file for use in an additional written opinion (if any) or the international preliminary examination report. It should always be made clear to the applicant or agent that any agreement reached may ultimately be subject to further review.

Rule 66.4

Rule 66.6

Rule 66.3

7.19 If a new defect of substance is raised at an interview and no amendment to meet it is agreed upon at the time, the defect should be confirmed in an additional written opinion inviting the applicant, within a prescribed time limit, to respond, if he so wishes. The examiner in the International Preliminary Examining Authority should, however, keep in mind the time limit for the establishment of the international preliminary examination report (see Chapter VI, paragraph 3.3).

7.20 When the telephone is used to settle outstanding matters, the normal procedure should be for the examiner to telephone the applicant or the agent identifying the international application he wishes to discuss and requesting the applicant or agent to telephone back at a specific time. A note should be made on the file, giving particulars and identifying the matters discussed and any agreements reached. Any matters on which agreement was not reached should also be noted and the arguments adduced by the applicant or agent should be summarized.

7.21 The records of interviews or telephone conversations should always indicate whether a response is due from the applicant or agent or whether the examiner wishes to issue an additional written opinion or establish the international preliminary examination report.

Citation of certain documents in the international search report

7.22 The international search report will cite a document which is not in the official language of the International Searching Authority only if the search examiner knows or has strong evidence leading him to suspect (e.g., from the drawings, from an abstract, a corresponding patent in a known language, or from a translation produced by some other person familiar with the language of the document) that the document is relevant. The examiner in the International Preliminary Examining Authority, in his first written action, may cite the document on the basis of similar evidence; an abstract or corresponding document in an official language, if known to the examiner, will also be cited. If, however, the applicant's response to the first written opinion disputes the relevance of the document and gives specific reasons, the examiner should consider whether, in the light of these reasons and of the other prior art available to him, he

is justified in pursuing the matter. If so, he may obtain a translation of the document (or merely the relevant part of it if that can be easily identified). If he remains of the view that the document is relevant, he should consider whether it is necessary to send a copy of the translation to the applicant either with an additional written opinion or by way of an informal communication with the applicant.

Rule 66.6

Additional searches during international preliminary examination

Rule 66.1

7.23 The examiner in the International Preliminary Examining Authority may need to make an updated search of relevant published applications or patents which only became available subsequent to the issuance of the international search report having regard to Rule 64.1 and 64.3. In the event that the examiner is unable to complete this updated search at the time of his first written opinion, he should ensure that such search is completed before the establishment of the international preliminary examination report. In the case in which (e.g., due to an early request for international preliminary examination by the applicant) the international application fulfills the conditions of Article 34(2)(c) and no first written opinion is necessary before this updated search can be completed, the examiner should try not to substantially delay the establishment of the international preliminary examination report for this reason unless the examiner specifically knows of the existence of an as yet unpublished document which will have to be cited when it is published and that the document will be available within the prescribed time limit for the establishment of such report (see Chapter VI, paragraph 3.3).

Rule 69.1(b)
(iii)

7.24 In some cases, a further search will sometimes be required by the examiner in the International Preliminary Examining Authority after the applicant's first amendment or subsequently. This may arise either because the international search report was somewhat incomplete, or because the International Searching Authority has not searched a particular part of the international application because of a requirement of lack of unity of invention, and the examiner disagrees with the requirement; or because the claims have been so amended that their scope is no longer the same as originally filed.

7.25 If, for example, because of a badly drafted set of claims, the international search report was incomplete to an extent such that the further search now to be made is in reality the first effective one, then the examiner in the International Preliminary Examining Authority should indicate in his first written opinion which claim, or claims in his opinion define the scope of the invention for which the search was made, and reasons why a particular interpretation is to be placed upon any wording in these claims. If it seems probable that the scope of the search resulting from the selected claims will, even at the first written opinion stage, be very broad, the examiner should, if possible, indicate how in his opinion the applicant's response (if any) might narrow the claimed subject matter and possibly overcome the effectiveness of the newly discovered relevant prior art.

7.26 If a further search in addition to the international search is made but a still further search in the same technical field is required due to the applicant's response to the first written opinion, and as a result thereof, the examiner in the International Preliminary Examining Authority then discovers further relevant prior art, it may be necessary for him either to issue an additional written opinion if this is still possible or to include in the international preliminary examination report an explanation indicating the claim or claims and the basis for his opinion in rendering a positive or negative statement under Article 35(2) (see Chapter VI, paragraph 8.1).

Art. 33(6)

7.27 Although, in principle, international preliminary examination is based on the international search report, the examiner should not be deterred from looking for relevant documents which he personally knows, or has reason to suspect, exist, if he can locate such documents in a short time from material available to him.

8. Establishment of international preliminary examination report

General

8.1 An international preliminary examination report must be issued within the prescribed time limit (see Chapter VI, paragraph 3.3) in all cases. Except in the case of an international application in respect of which an affirmative opinion can be given initially to the three criteria referred to in Chapter VI, paragraph 2.1,

Art. 35(2)
Rule 70.6(b)

this will follow one or more written opinions or other communications with the applicant. If the examiner in the International Preliminary Examining Authority considers that the possibility exists of amending or correcting the international application to bring it into a form which meets the requirements of Article 33 (see Chapter IV, paragraph 1.1), then the examiner should communicate to the applicant in his first written opinion, that the International Preliminary Examining Authority is of the opinion that satisfactory amendments must be submitted within a stated period (see Chapter VI, paragraph 5.14). If, within the time limit, satisfactory amendments are made, the examiner will then prepare the international preliminary examination report. If no amendments are made, he may have to prepare a negative international preliminary examination report. If unsatisfactory amendments are made, the examiner should evaluate whether additional amendments could bring the case within Article 33 requirements within the time limits for issuance of the report (see Chapter VI, paragraph 3.3).

8.2 The international preliminary examination report giving the results of the international preliminary examination is prepared by the examiner in the International Preliminary Examining Authority by the completion of the prescribed form (Form PCT/IPEA/409). The examiner should keep in mind, when establishing the international preliminary examination report, that it does not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law. The succeeding paragraphs deal with the completion of the prescribed form by the examiner.

Data

8.3 The examiner should include first certain data required to be given in the report under PCT Rules 70.3, 70.4 and 70.5. This data (insofar as set out on the front page of the form) relates to:

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Section 108(b)

- (a) the applicant's or agent's file reference
- (b) the international application number
- (c) the name of the applicant
- (d) the name of the receiving Office
- (e) the international filing date
- (f) the claimed priority date

Rule 70.5 (a)
and (b)
Administrative
Instructions
Section 504
Rule 70.3
and 70.4

(g) the classification of the subject matter by the International Searching Authority at least according to the International Patent Classification (IPC) if the examiner agrees with that classification or, if the examiner does not agree with that classification, the classification, at least according to the IPC, which the examiner considers to be correct. In addition, 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 (see Chapter VI, paragraph 8.16).

Basis of report

8.4 The examiner should then complete the items of the report indicating the basis on which the report was established as regards amendments and corrections; unity of invention; the priority date; and the non-establishment of the report as regards novelty, inventive step or industrial applicability due to:

- (i) the subject matter not being required to be searched;
- (ii) lack of clarity in the description, claims or drawings; and
- (iii) the claims being inadequately supported by the description to the extent that no meaningful opinion can be formed.

- 8.5 In completing the indications in relation to amendments and corrections, the examiner in the International Preliminary Examining Authority should first indicate the amendments and/or any corrections accepted by the International Preliminary Examining Authority. The amendments or corrections should be indicated by reference to the dates on which the amendments were submitted. Amendments and/or corrections submitted but not taken into account in the establishment of the report (e.g., an amendment not taken into account because the amendment went beyond the disclosure in the international application as filed) are then indicated separately. The replacement sheets or letters making the amendments (but not replacement sheets superseded by later replacement sheets) are included as an annex to the report (see Chapter VI, paragraph 8.17).
- Rule 70.2(a)
- Rule 70.2(c)
- Rule 70.16
- 8.6 An indication is also completed on the form if the report is established as if the priority claim contained in the international application had not been made. This will occur in the event that the applicant has failed to comply with the invitation to furnish either a copy of the earlier application whose priority has been claimed or a translation of the earlier application (see Chapter VI, paragraph 4.9) or where the priority claim has been found invalid (see Chapter V, Section 2).
- Rule 70.2(b)
- 8.7 The indication in relation to unity of invention is completed where the applicant has paid additional fees or has restricted the claims in response to an invitation to do so or where the applicant has failed to respond to the invitation to pay additional fees or restrict the claims (see Chapter VI, paragraphs 5.4 to 5.8). In addition to completing the general indication on the first page of the form, the examiner in the International Preliminary Examining Authority should also complete the indications provided in the supplemental sheet which indicate whether:
- Rule 70.13
- (a) the claims have been restricted
 - (b) additional fees have been paid without protest
 - (c) additional fees have been paid by the applicant under protest
 - (d) the applicant has neither restricted nor paid additional fees
 - (e) the examiner was of the opinion that the international application did not comply with the requirement of unity of invention but decided not to issue an invitation to restrict the claims or pay additional fees.
- In addition, should the international application be restricted to the claims which the applicant chose as complying with the requirement of unity of invention, or which the examiner considers to be the main invention, the examiner must indicate in the report which parts of the international application were, and which parts were not, the subject of international preliminary examination (see also Chapter VI, paragraph 5.5).
- Rule 70.13
Art. 34(3)
- 8.8 In the case where the additional fees are paid under protest, the text of the protest, together with the decision thereon, must be annexed to the report if the applicant has so requested (see Chapter VI, paragraph 5.6). Where an indication has been given under item (e) above, the examiner in the International Preliminary Examining Authority must also specify the reasons for which the international application was not considered as complying with the requirement of unity of invention.
- Rule 68.3(c)
and (d)
section 603
Administrative
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- 8.9 Indications that a report has not been established on the questions of novelty, inventive step or industrial applicability are given in the appropriate parts of the report form where the report has not been so established as a result of:
- Art. 34(4) (a)
(i)
Rule 67
- (a) the application relating to subject matter which does not require international preliminary examination (see Chapter VI, paragraph 5.11);
 - (b) the description, claims or drawings being so unclear that no meaningful opinion could be formed;
 - (c) the claims being so inadequately supported by the description that no meaningful opinion could be formed (see Chapter VI, paragraphs 5.9 and 5.12).
- Art. 34(4) (a)
(ii)
- Art. 34(4) (b) Where the report has not been established only in relation to certain claims, this is indicated and the claims affected must be specified.

statement concerning criteria of novelty, inventive step and industrial applicability and supporting citations and explanations

Rule 70.6(a)

8.10 This statement is as to whether the claims appear to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability (see Chapter IV, paragraph 1.1). The examiner in the International Preliminary Examining Authority must make this statement in relation to each claim which is to be examined, i.e., by the words "YES" or "NO," or their equivalents in the language of the report, accompanied by the citations, his explanations and observations, if any (see Chapter VI, paragraph 5.9). The statement should be made on the three criteria taken as a whole. If any of the criteria is not satisfied, the statement shall be negative but if any of the criteria taken separately is satisfied, an indication must be given as to the criterion or criteria so satisfied. The examiner should always cite documents believed to support any negative statement with respect to any of the claimed subject matter. The citation of these documents should be in accordance with Section 503 of the Administrative Instructions. An explanation should also be given where:

Rule 43.5(b)
Rule 70.7(b)
Rule 70.8

- (a) the statement in relation to any claim is negative;
- (b) the statement is positive, but it is not easy to understand the reason for citing a document on the basis of consultation of the cited document;
- (c) any of the criteria of novelty, inventive step or industrial applicability is not satisfied but another or other criteria is satisfied.

Section 604
Administrative
Instructions
Rule 43.5(e)
Rule 70.7(b)

8.11 Explanations should clearly indicate, with reference to the cited documents, the reasons supporting the conclusions that any of the said criteria is or is not satisfied. If only certain passages of the cited documents are relevant, or particularly relevant, the examiner in the International Preliminary Examining Authority should identify these, for example, by indicating the page, column or the lines where such passages appear.

Non-written disclosures and certain published documents

Rule 70.9

8.12 If the examiner in the International Preliminary Examining Authority has discovered or the international search report has cited, a relevant document which refers to a non-written disclosure, and the document was only published after the relevant date (see Chapter V, section 2) of the international application, he must indicate in the international preliminary examination report (see also Chapter VI, paragraph 7.23):

Rule 70.7(b)
Section 508(a)
Administrative
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- (i) its nature (by placing the letter "O" next to the citation);
- (ii) the date on which the document was made available to the public;
- (iii) the date on which the non-written public disclosure occurred.

Rule 70.10

8.13 The examiner in the International Preliminary Examining Authority should also indicate in the report any relevant published application or any patent discovered by him or cited in the international search report which was published later than but had a priority or a filing date earlier than the relevant date of the international application (see also Chapter IV, paragraphs 6.1 and 6.2). He should indicate any such published documents in the report by:

Rule 70.7(b)
Section 508(b)
Administrative
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- (i) its date of publication;
- (ii) its filing date, and its priority date (if any);
- (iii) placing the letter "E" next to the citation.

Rule 70.7(b)

Guidelines explaining to the examiner the manner of indicating certain other special categories of documents which may be cited in the international preliminary examination report as well as the manner of indicating the claims to which the documents cited in such report are relevant can be found in Sections 508(c), (d), and (e) of the Administrative Instructions.

Defects in the international application or lack of clarity

Rule 70.12 8.14 If, in the opinion of the examiner in the International Preliminary Examining Authority, defects exist in the form or contents of the international application, the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description have not been suitably corrected at the prescribed time limit for establishing the international preliminary examination report, he may include this opinion in the report and the reasons therefor (see also Chapter VI, paragraphs 5.9 and 5.12).

Rule 70.14 Certification

8.15 Every international preliminary examination report must be signed by an authorized officer of the International Preliminary Examining Authority and carry the indication of the name of the Authority.

Annexes to the international preliminary examination report

Rule 70.16 8.16 The examiner in the International Preliminary Examining Authority should annex to the report each replacement sheet representing corrections and amendments, and if the amendment is communicated in a letter, a copy of such letter (see Chapter VI, paragraph 8.5) is attached to the international preliminary examination report. Any replacement sheets superseded by later replacement sheets should not be annexed.

Language of the international preliminary examination report and annexes

Rule 70.17(a) 8.17 The international preliminary examination report must be in the language
Rule 70.17(b) in which the international application was published, whereas the annexes (if any) (see Chapter VI, paragraph 8.5) must be in the language in which the international application was filed or if the language of the annexes is different than that of the international application as filed (see also Chapter VI, paragraph 4.5), the annexes must also be in the language in which the application was published. An international application filed in English, French, German, Japanese or Russian is published in that language. However, an application filed in any other language is published in English. Any annex shall be both in the language in which it relates was filed and also, if it is different, in the language in which the international application to which it relates is published.

Rule 70.17(b)

9. Determination of time limits

Art. 47(1) 9.1 When it is a matter for the examiner in the International Preliminary Examining Authority to determine applicable time limits referred to in the PCT, he must consult all the factors relevant to the particular international application under consideration as well as the Regulations under the PCT which govern such time limits. The most important time limits for international preliminary examination so far as International Preliminary Examining Authorities are concerned, have been considered in more detail in the various Chapters and paragraphs as follows:

- (i) translations--see Chapter VI, paragraphs 4.5 and 4.9;
- (ii) amendments--see Chapter VI, paragraphs 4.10, 4.11 and 5.14;
- (iii) corrections of obvious errors of transcription--see Chapter VI, paragraph 7.15;
- (iv) start of international preliminary examination--see Chapter VI, paragraph 3.2;
- (v) response by applicant to first written opinion--see Chapter VI, paragraph 5.14;
- (vi) restricting claims or payment of additional fees--see Chapter VI, paragraph 5.4

(vii) furnishing priority documents---see Chapter V, paragraph 3.2;

(viii) establishment of the international preliminary examination report--see Chapter VI, paragraph 3.3.

Rule 80.1

9.2 Any time limit period fixed by the International Preliminary Examining Authority will usually be specified in full months which should be calculated from the day following the date of mailing of a particular communication inviting a response by the applicant. Rules 80.1 to 80.4 provide precise details for the determination of the day of expiration of the prescribed time limit. Rule 80.5 contains provisions covering certain contingencies, e.g., that the Office of the International Preliminary Examining Authority is not open on the day on which the time limit to respond by the applicant expires. Rule 82 covers the situation where there is a general disruption in the postal service.

Failure of applicant to respond within a prescribed time limit

9.3 If the applicant has not responded within a prescribed time limit, the effect of such lack of response differs as the circumstances of the case may require under the PCT and its Regulations. For instance, the international preliminary examination report may be established as if priority had not been claimed (see Chapter VI, paragraph 4.9); the international preliminary examination report may be established on the "main invention" (see Chapter VI, paragraph 5.5); the international preliminary examination report may be established with a negative determination (see Chapter VI, paragraph 5.9).

10. Transmittal of international preliminary examination report

Rule 71.1

10.1 The International Preliminary Examining Authority must on the same day transmit one copy of the international preliminary examination report (Form PCT/IPEA/409) and its annexes, if any, to the International Bureau and one copy to the applicant.

11. Withdrawal of the demand or all elections

Rule 75.1(b)

11.1 In the particular case where the applicant, by a signed notice sent to the International Bureau, withdraws the demand or all elections, the International Preliminary Examining Authority would be notified of the withdrawal by the International Bureau and the International Preliminary Examining Authority, accordingly, would not have to carry out, or complete, as the case may be, international preliminary examination.

Rule 75.3

[End of Annex and
end of document]