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## WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

### PATENT COOPERATION TREATY

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

Second Session

Geneva, June 20 to 24, 1977

#### REPORT

##### INTRODUCTION

1. At its sixth session, in November 1976, the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee") decided to establish a Working Group on Guidelines for International Search and for International Preliminary Examination (hereinafter referred to as "the Working Group") for the purpose of assisting in the establishment of the PCT Guidelines for International Search and for International Preliminary Examination.
2. The second session of the Working Group took place in Geneva from June 20 to 24, 1977.
3. The following states, members of the Working Group, were represented: Austria, Germany (Federal Republic of), Japan, Netherlands, Norway, Soviet Union, Sweden, United Kingdom and United States of America. Hungary, also a member of the Working Group, was not represented. Two intergovernmental organizations, the Interim Committee of the European Patent Organisation (EPO) and the International Patent Institute (IIB), as well as four non-governmental organizations, the Council of European Industrial Federations (CEIF), the European Federation of Agents of Industry in Industrial Property (FEMIPI), the International Federation of Patent Agents (FICPI) and the Union of Industries of the European Community (UNICE) also participated. The list of participants is annexed to this report (Annex A).
4. Mr. J. Delorme (IIB), the Chairman of the Working Group, presided over the session. Mr. J. Franklin, Counsellor, PCT Division, WIPO, acted as Secretary to the Working Group.

##### ADOPTION OF THE PROVISIONAL AGENDA

5. The provisional agenda, as contained in document PCT/WG/GSE/II/1, was unanimously adopted.

GUIDELINES FOR INTERNATIONAL PRELIMINARY EXAMINATION  
UNDER THE PATENT COOPERATION TREATY (PCT)

6. At the first session of the Working Group held in Geneva from February 14 to 18, 1977, the Working Group held only a general discussion of the "Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT)," as contained in document PCT/TCO/VI/9. Since document PCT/TCO/VI/9 was more in the nature of a compilation of comments on provisions considered by various prospective PCT Authorities as appropriate for inclusion in guidelines for international preliminary examination under the PCT than of actual guidelines, the Working Group asked the International Bureau to prepare, for its second session, a single draft text of "Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT)" (hereinafter referred to as "the PCT Guidelines") taking into account such provisions of the latest (published) text of the Guidelines for Substantive Examination established in the context of the Interim Committee of the European Patent Organisation (hereinafter referred to as the "EPO Examination Guidelines") as were appropriate to international preliminary examination under the PCT, as well as the responses from prospective PCT Authorities set out in document PCT/TCO/VI/9 and the observations contained in document PCT/WG/GSE/I/3.

7. For the second session of the Working Group, the International Bureau prepared the said single draft text of the PCT Guidelines as contained in documents PCT/WG/GSE/II/2 and 3. Discussions at the session were based on the said documents PCT/WG/GSE/II/2 and 3, PCT/TCO/VI/9 and PCT/WG/GSE/I/3 and on document PCT/WG/GSE/I/5 prepared for the first session of the Working Group and containing a reference list of the comments reproduced in document PCT/TCO/VI/9.

General Discussion

8. The representatives of Japan, the Netherlands, the Soviet Union, the United Kingdom and the United States of America commended the draft of the PCT Guidelines prepared by the International Bureau (documents PCT/WG/GSE/II/2 and 3) which provided a good basis for detailed discussion by the Working Group and should enable its work to be carried out during the present session.

9. The representative of the Netherlands said that the Interim Committee of the EPO, in response to an indication to it of the clear interest of the International Bureau that both Chapters I and II of the PCT should enter into force as soon as possible, together with the entry into force of the European Patent Convention and that the EPO should participate in the PCT as an International Preliminary Examining Authority, had agreed in principle that it would be in favor of this but saw certain practical difficulties which it would investigate. The representative said that it would be easier for the EPO if there were as few differences as possible between the EPO Examination Guidelines and the PCT Guidelines since that was one of the difficulties. In this regard, the representative said that the PCT Guidelines were based on an earlier draft of the EPO Examination Guidelines and there were more differences between the PCT Guidelines and the published EPO Examination Guidelines than were thought justified. The differences should be limited to those arising from the provisions of the PCT.

10. The representative of the United States of America, while appreciating the desirability of harmonization with the EPO Examination Guidelines, pointed to the necessity for the PCT Guidelines not to detract from national laws or from the principles agreed to internationally in the PCT.

11. The representative of the International Bureau, affirming the desire of the International Bureau that the EPO should participate in the operation of both Chapters I and II of the PCT, noted that the draft text of the PCT Guidelines prepared by the International Bureau had, to the extent possible in the limited time available for their preparation, been based on the EPO Examination Guidelines. Since the basic concepts upon which international preliminary examination would be carried out under the PCT were also to be found in the European Patent Convention, a large degree of uniformity between the applicable Guidelines should be achieved, the differences only being related to procedural matters or to the fact that the PCT provided for only preliminary and not substantive examination.

12. The Working Group, in response to suggestions by a number of representatives, agreed that the International Bureau should, in the revised text of the PCT Guidelines which it would prepare on the basis of the Working Group's discussions,

(1) insert the prefix PCT before all references to Articles and Rules of the PCT in the PCT Guidelines,

(2) indicate on the top of each page of the PCT Guidelines a reference to the Chapter of the PCT Guidelines to which the page related,

(3) use the term "examiner" to refer to the examiner in the International Preliminary Examining Authority.

13. The Working Group agreed, however, that the question of the use of the prefix "PCT" before references to the Articles and Rules of the PCT in the text of the PCT Guidelines, and also in the text of the Guidelines for International Search under the Patent Cooperation Treaty (PCT), should be submitted to, and further considered by, the Interim Committee at its October 1977 session.

#### Further procedure

14. The Working Group agreed that, as regards the Guidelines for International Search to be Carried Out under the Patent Cooperation Treaty (PCT), it had completed its work in that it had finalized, at its first session, a text for adoption by the Interim Committee at its October 1977 session. As regards the PCT Guidelines, which it had dealt with at its present (second) session, the Working Group had reviewed the text of the draft of those PCT Guidelines, as contained in documents PCT/WG/GSE/II/2 and 3, and had made changes to the said text. The present report reflects those changes. Due to lack of time towards the end of the session, however, the Working Group had not been able to go completely through the text of those PCT Guidelines as changed, a second time, and thus finalize the said text. The Working Group therefore agreed to a further procedure which should result in the finalization of the PCT Guidelines by the Interim Committee at its October 1977 session. According to this procedure, the International Bureau should by July 11, 1977, send to the members of the Working Group both this report and the text of the PCT Guidelines revised on the basis of this report. The members of the Working Group would then submit any final comments they might wish to make on the said revised text to the International Bureau so that the said comments would be received by August 22, 1977. The revised text and a compilation of the said comments would be submitted to the Interim Committee at its October 1977 session, the mailing of the said compilation taking place by September 5, 1977. The Working Group noted that the comments would be largely on matters of detail and the Interim Committee could make a final decision for the adoption of the PCT Guidelines at its said session.

#### Discussion in detail

15. In the course of its detailed discussion of the PCT Guidelines, the Working Group asked that certain questions be considered by the International Bureau. The paragraphs in relation to which the questions arose and the matters which the Working Group asked to be considered are set out below:

- (1) Chapter V, paragraph 3.3 and Chapter VI, paragraph 4.9

the furnishing of a certified copy of the priority document to the International Preliminary Examining Authority under the procedure provided by PCT Rule 66.7(a) with appropriate advice to applicants in the part of the Guidelines for Applicants filing under the PCT relates to Chapter II;

- (2) Chapter VI, paragraph 4.2

the provision to the International Preliminary Examining Authorities of copies of documents cited in international search reports, taking into account the provisions of PCT Rule 44.3;

- (3) Chapter VI, paragraph 4.6

the consequences of the failure of the applicant to file, within the appropriate time limit, a translation of the international application when required under PCT Rule 55.2;

- (4) Chapter VI, paragraph 4.7

the inclusion, in an annex to the PCT Guidelines, of the requirements with respect to the demand;

(5) Chapter VI, paragraph 5.11 (new) = paragraphs 5.10 and 5.11 (old)

an amendment of the Regulations under the PCT (possibly PCT Rule 67) so that international preliminary examination need not be carried out to the extent that there is no international search report in respect of the international application.

Furthermore, the Working Group noted, in the course of its consideration of Chapter VI, paragraph 8.12, that PCT Rule 64.2 was silent on the question whether a document referring to a non-written disclosure prior to the relevant date of the international application, but published on the relevant date, should be considered prior art for the purposes of PCT Article 33(2) and (3). In view of the absence of any provision in the PCT in this respect, the Working Group suggested that PCT Rule 64.2 be interpreted to mean that such a document should not be considered part of the prior art for the purposes of PCT Article 33(2) and (3) if published on, as well as if published after, the relevant date. It was also suggested that a similar interpretation be given to PCT Rule 64.3, namely, that a patent document filed earlier than the relevant date of the international application, or claiming the priority of an earlier application which had been filed prior to the relevant date but published on or after the said relevant date, should not be considered part of the prior art for the purposes of PCT Article 33(2) and (3).

16. The Working Group decided that in this part of the report only the conclusions reached by it as to changes in the draft text of the PCT Guidelines should be stated; amended parts of, or deletions from, the draft text of the PCT Guidelines, as contained in documents PCT/WG/GSE/II/2 and 3, are reflected in this report; no reference is made to the said draft text of the PCT Guidelines which was retained by the Working Group without amendment. The conclusions of the Working Group are set out below under the numbers and titles of the Chapters of the draft text of the PCT Guidelines. The numbers and titles of the Chapters appear in capital letters with broken underlinings. Where, as a result of the addition or deletion of Sections or paragraphs, renumbering is necessary, both the new and old numbers of paragraphs are shown. It was agreed that the International Bureau should make minor modifications relating especially to marginal citations of relevant provisions and references within the text to other provisions of the said text, it being understood that the members of the Working Group would, in any event, make further comments as indicated in paragraph 14 above.

CHAPTER I--INTRODUCTION

17. The Working Group agreed that the material contained in the Explanatory Note should be incorporated in the Introduction, which should be as follows:

CHAPTER I

INTRODUCTION

1. General

1.1 The Patent Cooperation Treaty has two phases which correspond to Chapters I and II, respectively, of the Treaty. The present Guidelines relate to the second phase (Chapter II of the Treaty) which comprises international preliminary examination.

1.2 The preceding phase (Phase I) has three main features: international application, international search, and international publication of the international application and the international search report. Phase I is mandatory in the sense that every State becoming party to the Treaty must apply it and that, in the normal situation, an international application is the subject of an international search and, subsequently, of international publication.

1.3 The second phase (Phase II) is optional since any Contracting State may decide not to adhere to Chapter II and the applicant, even if entitled to have his international application subjected to international preliminary examination, may decide for himself whether or not he wants to take advantage of this possibility.

1.4 Under Chapter II, an applicant may file a "demand" for an international preliminary examination by an International Preliminary Examining Authority for use in one or more states (elected states) in which the applicant wishes to obtain protection for an invention. The applicant is entitled to amend his international application before an International Preliminary Examining Authority which will then carry out the international preliminary examination mainly on the basis of the international search report. The international preliminary examination has the objective of formulating a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. The results of the international preliminary examination are recorded in the international preliminary examination report, copies of which are then sent to the

applicant and the International Bureau, the International Bureau communicating the report to each elected Office. So long as the election of a Contracting State of the PCT has been effected prior to the expiration of the 19th month after the priority date (PCT Article 39(1)), the applicant is not required to furnish a translation of the international application to an elected Office, nor to pay the national fee, before the expiration of the 25th month after the priority date. Under Chapter II, the applicant is also given the opportunity to amend the claims, the description and the drawings of his application before each elected Office.

1.5 The main legal effect of using Phase II is--as already indicated--that the processing of the international application before the national Offices is delayed--that is, it cannot start, except upon the request of the applicant--at least until the expiration of the 25th month after the priority date when, normally, the international preliminary examination report has become available (PCT Article 39(1)).

1.6 Using the Phase II also has the practical effect that national processing starts under much more advantageous conditions both for the applicant and the national Offices than would be the case without the PCT or if Phase I only is used. The applicant has, thanks to the international preliminary examination report, a strong indication of his chances of obtaining protection. The elected Offices save a considerable amount of the effort of examination. The exact extent of the saving depends on the national law and practice.

## 2. Arrangement and terminology of these Guidelines

2.1 The text of these Guidelines has been divided into Chapters, each sub-divided into numbered Sections which are further sub-divided into paragraphs. Cross references to other paragraphs are in a standard form quoting in each case the Chapter, Section and the paragraph number (thus, Chapter III, paragraph 6.4 means paragraph 4 in section 6 of Chapter III). Marginal references indicate the Article or Rule of the Treaty which provides authority for what is stated. Such references avoid the need for extensive quotation from the PCT itself, but where the Treaty, the Regulations or the Administrative Instructions have been directly quoted this has been indicated by the use of quotation marks.

2.2 The term "examiner" is used in the Guidelines to refer to the examiner working in the International Preliminary Examining Authority. If an examiner in any other Authority is referred to, the term is qualified (e.g., "search examiner" refers to an examiner in an International Searching Authority).

## 3. Nature of the Guidelines

3.1 These Guidelines were elaborated by the PCT Interim Committee for Technical Cooperation. They constitute elaborations and clarifications of the provisions of the Treaty and the Regulations and the Administrative Instructions thereunder with respect to international preliminary examination.

3.2 The Guidelines give instructions as to the practice to be followed in the various stages of the international preliminary examination of international applications. They are addressed to the examiners in the various International Preliminary Examining Authorities but it is hoped that they will also be of assistance to the International Searching Authorities and to applicants and patent practitioners. Furthermore, the Guidelines may be useful to the patent Offices of the elected States in the national phase in the examination of the international application and in better understanding the international preliminary examination report. Although the Guidelines deal with international applications, they may be used *mutatis mutandis* by national Offices in dealing with national applications if the national law so permits; also they may be used in revising national laws with the purpose of unification of current practices in patent Offices of various countries.

3.3 The Guidelines are intended to cover typical occurrences. They should therefore be considered only as general directives; examiners will have to go beyond the instructions in exceptional cases. Nevertheless, applicants can expect the International Preliminary Examining Authorities to act, as a general rule, in accordance with the Guidelines until such time as they are revised. It should be noted also that the Guidelines do not have the binding authority of a legal text. For the ultimate authority on questions concerning international preliminary examination, it is necessary to refer to the PCT itself interpreted, where necessary, by reference to the Minutes of the Washington Diplomatic Conference.

3.4 At various points throughout these Guidelines the examiner is directed to interpret a claim in a particular fashion. This has been done to enable the elected Offices, when assessing the preliminary examination report, to understand the basis upon which the examiner has reached his conclusions as to novelty, inventive step (non-obviousness) and industrial applicability, and in no way binds the elected Offices to adopt a similar interpretation.

4. Carrying out international preliminary examination

4.1 The establishment of the International Preliminary Examining Authorities represents a major development in the history of the protection of inventions. However, it will be on the basis of well-reasoned international preliminary examination (and especially on how examiners deal with such difficult questions as inventive step) that its success will be judged.

4.2 Moreover, it is important to remember that all examiners in the various International Preliminary Examining Authorities will be working under a common system as laid down in the PCT and they should all apply the same standards.

4.3 As previously indicated, the primary objective of the international preliminary examination is the formulation of an opinion on the questions of novelty, inventive step and industrial applicability. The examiner should therefore only consider issues mentioned in PCT Rule 66.2(a) (v) such as clarity of the claims to the extent that this is necessary to deal with those questions.

4.4 The international preliminary examination will be carried out and the international preliminary examination report prepared by an International Preliminary Examining Authority.

4.5 The attitude of the examiner is very important. He should always try to be constructive and helpful. While it would, of course, be quite wrong for an examiner to overlook any major deficiency in an international application, he should have a sense of proportion. He should bear in mind that, subject to the requirements of the PCT, the drafting of the description and claims of an international application is the responsibility of the applicant or his authorized representative.

4.6 Finally, it should hardly need stating that all international applications, regardless of their country of origin and the language in which they are written, should receive equal treatment.

CHAPTER II--CONTENT OF THE INTERNATIONAL APPLICATION (OTHER THAN THE CLAIMS)

18. Paragraph 1.2: This paragraph should read as follows:

PCT Rule 53.1 (d) "The International Preliminary Examining Authority must receive two identical copies of the demand (Form PCT/IPEA/401) submitted by the applicant as a requirement to enter Phase II of the PCT (see Chapter VI, paragraphs 2.1 and 3.1)."

19. Paragraph 2.2: This paragraph should read as follows:

PCT Art. 3(3) "PCT Rule 8 delineates the requirements for the abstract and it is for the International Searching Authority (PCT Rule 38.2) to establish its final form (see Chapter XI, paragraphs 1 to 5 of the Guidelines for International Search to be Carried Out under the PCT). The examiner will not be concerned with seeking any amendment of the abstract. He should, however, note that the abstract has no legal effect on the international application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter."

20. Paragraph 3.2: This paragraph should read as follows:

PCT Rule 4.3 "The title of the invention disclosed in the international application "shall be short (preferably from two to seven words when in English or translated into English) and precise." Any obvious failures to meet these requirements are likely to be noted by the International Searching Authority (see Chapter XI, paragraph 6 of the Guidelines for International Search to be Carried Out under the PCT)."

21. Paragraph 3.3: This paragraph should read as follows:

"If any substantive amendments to the claims are made which affect the conciseness or preciseness of the title of the international application, the examiner may draw this to the attention of the applicant (see also Chapter II, paragraph 4.2)."

22. Paragraph 4.2: This paragraph should read as follows:

PCT Rule 5.1(a)

"The description should start with the same title that appears in the request (Form PCT/RO/101) (see also Chapter II, Section 3). The description should contain subheadings corresponding to those contained in Section 204 of the Administrative Instructions. Although such subheadings are not rigidly mandatory in number or wording, their use is highly recommended in order to provide uniformity in publication and to facilitate access to the information contained in the international application. The recommended subheadings are discussed in the following paragraphs."

23. Paragraph 4.5: This paragraph should read as follows:

"Since the reader is presumed to have the general background and technical knowledge appropriate to the art, the examiner should not invite the applicant to insert anything in the nature of a treatise or research report or explanatory matter which is obtainable from textbooks or is otherwise well-known. Likewise, the examiner should not invite the applicant to provide a detailed description of the content of cited prior documents. It is sufficient that the reason for the inclusion of the reference is indicated, unless in a particular case a more detailed description is necessary for a full understanding of the claimed invention. Lists of several reference documents relating to the same feature or aspect of the prior art are not required; only the most appropriate ones need to be referred to. On the other hand, the examiner should not invite the applicant to excise any such unnecessary matter, except when it is very extensive."

24. Paragraph 4.6: This paragraph should read as follows:

PCT Rule 5.1(a)  
(iii)

"Disclosure of invention: The invention as claimed should be disclosed by the applicant in such a way that the technical problem, or problems, with which it deals and the solution it provides can be understood. To meet this requirement, only such details should be included in the disclosure as are necessary for elucidating the invention. Where the invention lies in realizing what the problem is (see Chapter IV, 8.4(i)), this should be apparent and, where the means of solving the problem (once realized) are obvious, the details given of its solution may, in practice, be minimal. It is not necessary, moreover, that the invention be presented explicitly in problem and solution form. The applicant should "state the advantageous effects, if any, of the invention with reference to the background art," but this should not be done in such a way as to disparage any particular product or process. Furthermore, neither the background prior art nor the claimed invention should be referred to in a manner likely to mislead. This might be done, e.g., by an ambiguous presentation which gives the impression that the background art had solved less of the problem than was actually the case. Fair comment as referred to in Chapter II, paragraph 6.2 is, however, permitted."

PCT Rule 9.1(iii)

25. Paragraph 4.8: This paragraph should read as follows:

"The description and drawings shall be consistent with one another, especially in the matter of reference numbers and other signs (see Chapter II, paragraph 5.1). However, where, as a result of amendments to the description, whole passages are deleted, it may be tedious to delete all superfluous references from the drawings and in such a case the examiner need not pursue too rigorously the consistent use of reference signs as between the description and the drawings."

26. Paragraph 4.9: This paragraph should read as follows:

PCT Rule 5.1(a)  
(v)

"Best mode for carrying out the invention. The international application should "set forth at least the best mode contemplated by the applicant for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; where the national law of the designated State does not require the description of the best mode but is satisfied with the description of any mode (whether it is the best contemplated or not), failure to describe the best mode contemplated shall have no effect in that State." In many cases, a single example or single embodiment will suffice, but where the claims cover a broad field, the description should not usually be regarded as satisfying the requirements of PCT Article 5 unless it gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example."

27. Paragraph 4.11: This paragraph should read as follows:

"Two instances where there is a fundamental insufficiency in the international application, and thus a failure to satisfy the requirements of PCT Article 5, deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, a person skilled in the art, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are not reproducible or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a microbiological process involving mutations. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures as can arise, e.g., in the manufacture of small magnetic cores or electronic components; in this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection necessarily arises under PCT Article 5. The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws--this applies, e.g., to a perpetual motion machine (see Chapter IV, paragraph 4.1)."

28. Paragraph 4.12: This paragraph should read as follows:

PCT Rule 5.1(a)  
(vi)  
PCT Art. 33(1)  
and (4)

"Industrial applicability. The description should "indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry." "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." The expression "capable of exploitation in industry" means the same as "industrially applicable." It is to be expected that, in most cases, the way in which the invention is "industrially applicable" will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g., in relation to methods of testing, when the way in which the invention is "industrially applicable" and the way in which it can be made and/or used are not obvious from the description or the nature of the invention and must be made so; the term "industry" is to be understood in its broadest sense as in the Paris Convention for the Protection of Industrial Property."

29. Paragraph 4.13: This paragraph should read as follows:

PCT Rule 5.1(b)

"The manner and order of presentation of the various parts of the description should be that specified in PCT Rule 5.1(b) and Section 204 of the Administrative Instructions, unless, "because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economic presentation." Since the responsibility for a clear and complete description of the invention lies with the applicant, the examiner should exercise his discretion as to whether to object to the presentation. Some departure from the requirements of PCT Rule 5.1(a) is acceptable, provided the description is clear and orderly and all the requisite information is present. For example, the requirements of PCT Rule 5.1(a)(iii), may be waived where the invention is based on a fortuitous discovery, the practical application of which is recognized as being useful, or where the invention breaks entirely new ground. Also certain technically simple inventions may be fully comprehensible with the minimum of description and but slight reference to prior art."

30. Paragraph 4.14: This paragraph should read as follows:

PCT Rule 10.2

"The description should be clear and straightforward with avoidance of unnecessary technical jargon. The use of recognized terms of art is acceptable, and will often be desirable. Little known or specially formulated technical terms may be allowed, provided that they are adequately defined and that there is no generally recognized equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the international application or in the language of its translation when such a translation is required under PCT Rule 55.2. Terms already having an established meaning should not normally be allowed to be used to mean something different as this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs must be consistent throughout the international application."



31. Paragraph 4.15: This paragraph should read as follows:

"When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published standard (e.g., a standard of sieve sizes), and such standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the specification. The metric system of units of weight and measures must be used or, if another system is used, the units must additionally be expressed in the metric system. Similarly, temperature must be expressed at least in degrees centigrade, i.e., in degrees Celsius or, in cryogenics, in degrees Kelvin. Other physical values (i.e., other than those having units directly derivable from length, mass, time and temperature) must be expressed in the units recognized in international practice; e.g., for electric units the MKSA (Meter, Kilogram, Second, Ampere) system should be used. Chemical and mathematical symbols, atomic weights and molecular formulae should be those in general use, and technical terms, signs and symbols should be those "generally accepted in the art." In particular, if there are any agreed international standards in the art in question, these should be adopted wherever practicable."

32. Paragraph 4.17: This paragraph should be deleted.

33. Paragraph 4.17(new) = paragraph 4.18(old): This paragraph should read as follows:

"References to previously (i.e., before the international filing date) published material including patent applications and specifications of granted patents, text books and periodicals, are allowable and often desirable (see Chapter II, paragraph 4.4 above) to explain the background art. A reference to an unpublished (i.e., not published before the international filing date) document describing background art, in particular an unpublished application, should not be regarded as adding anything to the content of the disclosure, unless the document referred to is made available to the public on or before the publication date of the international application. The reference to such document describing background art made available to the public on or before the publication date of the international application, which is supplemented or replaced by an indication of such background art contained in the document, may be taken into account by the examiner. In the case of any document made available to the public later than the publication date of the international application or not to be published at all (e.g., an application withdrawn before publication), the examiner should not take into account the reference to that document for the purposes of international preliminary examination. It should be noted, however, that this practice relates only to the international phase and does not preclude any decision applying relevant national law as far as it relates to the contents of the disclosure of the international application as filed."

34. Section 6: This Section should be deleted.

35. Paragraph 6.1(new) = paragraph 7.1(old): This paragraph should read as follows:

"There are four categories of expressions which should not be contained in an international application. These categories are specified in PCT Rule 9.1 (see also Chapter IV, Section 2). Examples of the kind of matter coming within the first and second categories--contrary to public order ("ordre public") or morality--are: incitement to riot or to acts of disorder; incitement to criminal acts; racial, religious or similar discriminatory propaganda; and grossly obscene matter. The purpose of PCT Rule 9 is to prohibit the kind of matter likely to induce riot or public disorder, or lead to criminal or other generally offensive behaviour. This Rule is likely to be invoked by the examiner only in rare cases."

36. Paragraph 6.4(new) = paragraph 7.4(old): This paragraph should read as follows:

"Generally, the receiving Office or the International Searching Authority will deal with matter failing under PCT Rule 9.1. If any such matter has not been so recognized, the International Preliminary Examining Authority may invite the applicant to remove such matter. The applicant should be informed of the category applied under which the prohibited matter is to be removed."

CHAPTER III--THE CLAIMS

37. Paragraph 1.3: This paragraph should be deleted.

38. Paragraph 2.1: This paragraph should read as follows:

PCT Rule 6.3  
(a)

"The claims must be drafted in terms of the "technical features of the invention." This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in defining the invention. It is not necessary that every feature should be expressed in terms of a structural limitation. Since it is a matter for national law, the examiner should normally not object to the inclusion of functional limitations in a claim provided that a skilled man would have no difficulty in providing some means of performing this function without exercising inventive skill or that such means are fully disclosed in the application concerned. Claims to the use of the invention in the sense of the technical application thereof are allowable."

39. Paragraph 2.2: This paragraph should read as follows:

PCT Rule 6.3(b)  
(ii)

"PCT Rule 6.3, paragraph (b), defines the two-part form which a claim should take "whenever appropriate." The first part should contain a statement indicating the designation of the subject matter of the invention, i.e., the general technical class of apparatus, process, etc., to which the claimed invention relates, followed by a statement of those technical features "which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art." It is clear from this wording that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the claimed inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter having ..." (here recite the known combination of features which is utilized) and there is no need to refer also to the other known features of a camera such as the lens and view-finder. The second part or "characterizing portion" should state the technical features which, in combination with the features stated under the first part (PCT Rule 6.3(b)(i)), it is desired to protect, i.e., the features which the invention adds to the prior art. If the international search report, or any additional documents considered to be relevant in accordance with PCT Article 33(6), reveal that any feature in the second part of the claim was, in fact, already known in combination with all the features in the first part of the claim and in that combination have the same effect as they have in the full combination according to the claimed invention, the examiner should invite the applicant to transfer such feature or features to the first part. Where, however, a claim relates to a novel combination, and where the division of the features of the claim between the prior art part and the characterizing part could be made in more than one way without inaccuracy and if the division of the features chosen by the applicant is not incorrect, the examiner should take no action. If the examiner, in the first written opinion, invites the applicant to adopt a different division but the applicant does not follow the invitation, the examiner should not pursue the matter further since the manner of claiming is a matter for national laws of elected states. Section 205 of the Administrative Instructions provides the applicant and the International Preliminary Examining Authority with the necessary instructions for numbering of claims upon their amendment."

PCT Rule 6.3(c)

40. Paragraph 2.3: This paragraph should read as follows:

"The applicant should be invited to follow the above two-part formulation where, for example, it is clear that his invention resides in a distinct improvement in an old combination of parts or steps. However, as is indicated by PCT Rule 6, this form need only be used in appropriate cases. The nature of the invention may be such that this form of claim is unsuitable, e.g., because it would give a distorted or misleading picture of the invention or the prior art. Examples of the kind of invention which may require a different presentation are:

(i) the combination of known integers of equal status, the inventive step lying solely in the combination;

(ii) the modification of, as distinct from addition to, a known chemical process, e.g., by omitting one substance or substituting one substance for another; and

(iii) a complex system of functionally interrelated parts, the inventive step concerning changes in several of these parts or in their interrelationships.

In examples (i) and (ii), the PCT Rule 6.3(b) form of claim may be artificial and inappropriate, whereas, in example (iii), it might lead to an inordinately lengthy and involved claim. Another example in which the PCT Rule 6.3(b) claim may sometimes be inappropriate is where the claimed invention is a new chemical compound or group of compounds which constitutes a new departure and does not fall within a known class. It is also likely that other cases will arise in which it will be appropriate to formulate the claim in a different form."

41. Paragraph 2.4: This paragraph should read as follows:

PCT Rule 11.10  
(a) and (b)  
PCT Rule 11.10  
(c)

"The claim, as well as the description, "may contain chemical or mathematical formulae" but not drawings. "Any claim may contain tables" but "only if the subject matter of the claim makes the use of tables desirable." In view of the use of the word "desirable," the International Preliminary Examining Authority should not object to the use of tables in claims where this form is convenient."

42. Paragraph 3.1: This paragraph should read as follows:

PCT Rule 13.3

"The PCT refers to different "categories of claim ("product, process, apparatus or use"). However, the main purpose of this classification is to provide a convenient way of indicating specific combinations permitted in accordance with PCT Rule 13 (see Chapter III, paragraph 7.2). In fact, there are only two basic kinds of claim, viz., claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or composition (e.g., chemical compound or a mixture of compounds) as well as any physical entity (e.g., object, article, apparatus, machine, or system of cooperating apparatus) which is produced by a man's technical skill. Examples are "steering mechanism incorporating an automatic feedback circuit..."; "a woven garment comprising..."; "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations." The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things (see, however, Chapter IV, paragraphs 2.4 item (b) and 2.5).

43. Paragraph 3.2: This paragraph should read as follows:

"It should be noted that claims which are worded differently may, in reality, fall within the same category and have effectively the same scope. For example, a claim referring to a "system" and a claim referring to "apparatus" may both be in the "apparatus" category. It should be further noted that it is permitted to include in the same international application claims of the said different categories provided that they comply with the requirement of PCT Rule 13.1 (see Chapter VI, paragraphs 5.5 to 5.9). The examiner should bear in mind that the presence of such different claims may assist an applicant in later obtaining full protection for his invention in all the elected States since infringement of a patent is dealt with by national law. Consequently, while the examiner should only draw attention to an unnecessary proliferation of independent claims (see Chapter III, Section 5), he should not adopt an over-academic or rigid approach to the presence of a number of claims which are differently worded but apparently of similar effect."

44. Paragraph 3.3: The Working Group agreed that this paragraph should be placed under the heading "Categories" and should read as follows:

"Subject to the conditions for unity of invention being satisfied (see Chapter III, Section 7, Chapter VI, paragraphs 5.5 to 5.9), PCT Rule 13.3 states that an international application may contain "two or more independent claims of the same category (i.e., product, process, apparatus, or use) which cannot readily be covered by a single generic claim." This means that while the examiner should take exception to an unnecessary proliferation of independent claims he should not take exception to two or more independent claims in the same category, provided that there is a unifying inventive concept and that the claims as a whole

satisfy the requirement of PCT Article 6 that they should be "concise" (see Chapter III, paragraph 5.1). In applying this principle, the examiner should have regard to the remarks made in Chapter III, paragraph 3.2 concerning claims of apparently similar scope. However, there are other circumstances where it may not be appropriate to cover the subject matter of an invention by a single independent claim in a particular category, e.g., (1) where the invention relates to an improvement in two separate but interrelated articles which may be sold separately, such as an electric plug and socket or transmitter and receiver, (2) where an invention is concerned with electrical bridge-rectifier circuits, it might be necessary to include separate independent claims to a single-phase and to poly-phase arrangements incorporating such circuits since the number of circuits needed per phase is different in the two arrangements, (3) where a known substance is disclosed for a number of distinct medical uses, and where an invention resides in a part of a more complex apparatus, where the various parts thereof are separately manufactured, and the part and the whole apparatus may be sold separately (e.g., an incandescent body for a lamp, and the lamp provided with such a body)."

45. Paragraph 3.4: This paragraph should read as follows:

PCT Rule 13.4

"All international applications will contain one or more independent main claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning specific forms of that invention. It is evident that any claim relating to a specific form must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The specific forms should be construed broadly as meaning any more specific definition or specifically different embodiments of the invention than that set out in the main claim or claims. It should be noted that, subject to PCT Rule 13.1, it is permitted to include a reasonable number of dependent claims claiming specific forms of the claimed invention in the independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention."

46. Paragraph 3.5: This paragraph should read as follows:

PCT Rule 6.4(a)  
and (b)

"Any dependent claim must be construed as including all the limitations contained in the claim to which it refers. Such a claim which refers to more than one other claim shall refer to them only alternatively. Multiple dependent claims cannot form a basis for other multiple dependent claims. A multiple dependent claim includes all the limitations contained in the particular claim in relation to which it is considered."

47. Paragraph 3.7 (new): The Working Group agreed to the inclusion of an additional paragraph reading as follows:

"A claim, whether independent or dependent, can contain alternatives, provided those alternatives are of a similar nature and can fairly be substituted one for another, and provided also, that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe (see also Chapter III, paragraph 7.4)."

48. Paragraph 4.1: This paragraph should read as follows:

PCT Art. 6

"The requirement that the claims shall be clear applies to individual claims and also the claims as a whole. The clarity of the claims is of the utmost importance for the purposes of formulating an opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and be industrially applicable in view of their function in defining the matter for which protection is sought. In view of differences in the scope of protection which may be attached to the various categories of claims, the examiner should draw attention to any wording of a claim leaving doubt as to its category (see also Chapter III, paragraph 3.1)."

49. Paragraph 4.3: The marginal reference to PCT Rule 66.2(a)(iii) and (c) should be deleted.

50. Paragraph 4.4: This paragraph should read as follows:

"An independent claim should clearly specify all of the essential features needed to define the invention except in so far as such features are implied by the generic terms used, e.g., a claim to a "bicycle" does not need to mention

the presence of wheels. If a claim is to a process for producing the product of the invention, then the process as claimed should be one which, when carried out in a manner which would seem reasonable to a person skilled in the art, necessarily has as its end result that particular product; otherwise, there is an internal inconsistency and therefore lack of clarity in the claim. In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in a certain respect, it is sufficient if the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for an apparatus."

51. Paragraph 4.5: This paragraph should read as follows:

"A claim should not include vague or equivocal forms of wording which leave the reader in doubt as to the exact scope of a feature. Examples of this are relative terms such as "thin," "wide," "strong." If such terms appear in a claim it is usually necessary to invite the applicant to either define or excise the terms. No objection arises, however, if the relative term has a precise meaning in the art, e.g., "high-frequency amplifier," and this is the meaning intended. The examiner should invite the applicant to remove trademarks and similar expressions from the claims of an international application unless their use is unavoidable; exceptionally, their removal need not be invited if they are generally recognized as having a precise meaning."

52. Paragraph 4.7: This paragraph should read as follows:

"The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention, or a feature thereof, by a result to be achieved should be objected to. However, no objection should be raised if the invention can only be defined in such terms and if the result is one which can be directly and positively verified."

53. Paragraph 4.8: This paragraph should read as follows:

"If a claim commences with such words as: "Apparatus for carrying out the process, etc., ..." this must be construed as meaning merely apparatus suitable for carrying out the process. Apparatus which otherwise possesses all of the features specified in the claim, but which would be unsuitable for the stated purpose or which would require modification to enable it to be so used, should not normally be considered as coming within the scope of the claim. Similar considerations apply to a claim for a product for a particular use. For example, if a claim refers to "A hook for a crane", this implies, e.g., particular dimensions and strength in the hook. Therefore, a fish-hook could never come within the claim. Similarly, a claim to a substance or composition for a particular use should be construed as relating to the substance or composition per se provided that it is not in a form which would render it unsuitable for the stated use."

54. Paragraph 4.10: This paragraph should read as follows:

"The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings "except where absolutely necessary." In particular, they must not normally rely on references such as: "as described in part ... of the description" or "as illustrated in Figure 2 of the drawings." The emphatic wording of the excepting clause should be noted. Thus, the applicant should be invited to show that it is "absolutely necessary" to rely on reference to the description or drawings in appropriate cases. An example of an exception would be that in which the invention as claimed involved some peculiar shape illustrated in the drawings but which could not be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products whose features can be defined only by means of graphs or diagrams."

55. Paragraph 6.2: This paragraph should read as follows:

"Most claims are generalizations from one or more particular examples. The extent of generalization permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art. Thus, an invention which opens up a whole new field may be entitled to more generality in the claims than one which is concerned with advances in a known technology. An appropriate claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. Obvious modifications and uses of and equivalents to that which the applicant has described should not be questioned. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, it is proper for the applicant to draw his claims accordingly."

PCT Rule 6.2  
(a)

56. Paragraph 6.4: This paragraph should read as follows:

"A claim in generic form, i.e., relating to a whole class, e.g., of materials or machines, may be acceptable even if of broad scope, if there is fair support in the description and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where the information given appears insufficient to enable a man skilled in the art to extend the teaching of the description to parts of the field claimed but not explicitly described by using routine methods of experimentation or analysis, the examiner should invite the applicant to establish, by suitable response, that the invention can in fact be readily applied on the basis of the information given over the whole field claimed or, failing this, to restrict the claim to accord with the description. An example of this might be a claim to a specified method of treating "synthetic resin moulding" to obtain certain changes in physical characteristics. If all of the examples described related to thermoplastic resins, and the method was such as to appear inappropriate to thermosetting resins, then restriction of the claims to thermoplastic resins might be necessary."

57. Paragraph 6.5 (new): The Working Group agreed to the inclusion of an additional paragraph reading as follows:

"A claim may broadly define a feature in terms of its function, even where only one example of the feature has been given in the description, if the skilled reader would appreciate that other means could be used for the same function. For example, "terminal position detecting means" in a claim might be supported by a single example comprising a limit switch, it being obvious to the skilled person that e.g. a photo-electric cell or a strain gauge could be used instead. In general, however, if the entire contents of the application are such as to convey the impression that a function is to be carried out in a particular way, with no intimation that alternative means are envisaged, and a claim is formulated in such a way as to embrace other means, or all means, of performing the function, then objection arises. Furthermore, it may not be sufficient if the description merely may be adopted, if it is not reasonably clear what they might be or how they might be used."

58. Paragraph 7.4: This paragraph should read as follows:

"Alternative forms of an invention may be claimed either in a plurality of independent claims as indicated in Chapter III, paragraph 7.1, or in a single claim (but see Chapter III, paragraph 3.7). In the latter case, the presence of the two alternatives as independent forms may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether or not there is unity of invention, and lack of unity of invention may then also exist within a single claim."

59. Paragraph 7.5 (new): The Working Group agreed to the inclusion of an additional paragraph reading as follows:

"Lack of unity may be directly evident a priori, i.e., before considering the claims in relation to any prior art, or may only become apparent a posteriori, i.e., after taking the prior art into consideration--e.g., a document discovered in the course of the international search shows that there is lack of novelty or inventive step in a main claim thus leaving two or more independent claims without a single general inventive concept."

60. Paragraph 7.6 (new) = paragraph 7.5 (old): This paragraph should read as follows:

"Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search report. If the common matter, of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a common inventive concept which appears novel and involves inventive step then objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered to its merits, the benefit of any doubt being given to the applicant."

61. Paragraph 7.8 (new) = paragraph 7.7 (old): This paragraph should read as follows:

PCT Art. 17(3)  
(a)

"The procedure before the International Preliminary Examining Authority regarding lack of unity of invention is governed by PCT Article 34(3) (a) to (c) and PCT Rule 68 (see also PCT Rules 69.1(a)(ii) and 70.13). This procedure is more fully explained in Chapter VI, paragraphs 5.5 to 5.9. It should be noted that in most instances lack of unity of invention will have been noted and reported upon by the International Searching Authority which will have drawn up an international search report based on those parts of the international application relating to the invention, or unified linked group of inventions, first mentioned in the claims ("main invention") unless the applicant has paid additional fees. The International Searching Authority may not hold the application withdrawn for lack of unity of invention, nor invite the applicant to amend the claims; but must inform the applicant that, if the international search report is to be drawn up in respect of those inventions present other than the first mentioned, then the additional fees must be paid within a stipulated period."

62. Paragraph 7.9 (new) = paragraph 7.8 (old): This paragraph should read as follows:

"If the applicant has not availed himself of the opportunity to have the international search report issued on the other inventions, this must be taken as an indication that the applicant is prepared for the international application to proceed on the basis that it relates to the invention first mentioned in the claims as originally contained in the said international application as filed."

63. Paragraph 7.10 (new) = paragraph 7.9 (old): This paragraph should read as follows:

PCT Art. 33(6)

"Whether or not the question of unity of invention has been raised by the International Searching Authority, it may be considered by the examiner. In his consideration he should take into account all the documents cited in the international search report and any additional documents considered to be relevant. However, there are cases of lack of unity of invention, where, compared with the procedure of inviting the applicant to restrict the international application or to pay additional fees (PCT Rule 68.2), no or little additional effort is involved in establishing the international preliminary examination report for the entire international application. Then, reasons of economy may make it advisable for the examiner to avail himself of the option referred to in PCT Rule 68.1 by choosing not to invite the applicant to restrict the claims or to pay additional fees (see Chapter VI, paragraph 5.9)."

#### CHAPTER IV--REQUIREMENTS FOR INTERNATIONAL PRELIMINARY EXAMINATION

64. Title of Chapter IV: This title should read as shown above except for the broken underlining as to which see paragraph 16 of this report.

65. Paragraph 1.1: This paragraph should read as follows:

PCT Art. 33(1)

"The objective of international preliminary examination of an international application is to formulate a preliminary and non-binding opinion as to:

PCT Art. 33(2)

1. Whether the claimed invention appears to be "novel."

PCT Art. 33(3)

2. Whether the claimed invention appears to involve "inventive step" (non-obviousness)

PCT Art. 33(4)

3. Whether the claimed invention appears to be "industrially applicable."

66. Paragraph 1.2: This paragraph should read as follows:

PCT Art. 33(5)

"Although these criteria serve as 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 criteria will be dealt with below."

67. Paragraph 1.3: This paragraph should be deleted.

68. Paragraph 2.4: The Working Group agreed that the previous paragraphs 2.7 and 2.8 should be incorporated in this paragraph which should read as follows:

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

- PCT Rule 67.1  
(i) (a) Scientific and mathematical theories. Scientific theories are a more generalized form of discoveries. For example, the physical theory of semi-conductivity would be excluded under PCT Rule 67 whereas new semi-conductor devices and processes for manufacturing would require international preliminary examination on the part of an International Preliminary Examining Authority. Mathematical theories are a particular example of the principle that purely abstract or intellectual methods are excluded under PCT Rule 67. For example, a shortcut method of division would be excluded but a calculating machine designed to operate accordingly would require international preliminary examination.
- PCT Rule 67.1  
(ii) (b) Plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes. 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 not be excluded. For example, a method of selectively breeding horses involving merely selecting for breeding and bringing together 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. The exclusion referred to above does not apply to microbiological processes or the products thereof. International preliminary examination should 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.
- PCT 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, or 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 PCT Rule 67. However, novel apparatus for playing a game or carrying out a scheme would require international preliminary examination.
- PCT Rule 67.1  
(v) (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 Examining 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 should also be conducted for new products, particularly substances or compositions for use in these methods of treatment or diagnosis.
- PCT Rule 67.1  
(v) (e) Mere presentations of information characterized solely by the content of the information would be excluded under PCT 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 would require international preliminary examination.
- PCT 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 PCT 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 could be excluded 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."



69. Paragraph 2.6: This paragraph should read as follows:

"In considering whether subject matter under PCT Article 34(4)(a)(i) and PCT Rule 67 is present, there are two general points the examiner must bear in mind. Firstly, he should disregard the form or kind of claim and concentrate on the content in order to identify the subject matter. The first point is illustrated by the examples given in Chapter IV, paragraph 2.4, item (f) which illustrate different ways of claiming a computer program. Secondly, any exclusion under PCT 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."

70. Section 3: The Working Group agreed that the title of this Section should be "Article 34(4)(a)(ii) and (b) defects."

71. Paragraph 3.1: This paragraph should read as follows:

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

"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 description, the claims or the drawings of the international application are so unclear, or the claims are so inadequately supported by the description, that it is impossible to examine the claimed subject matter. In this case, an international preliminary examination report will not be established for all or part of the claimed subject matter and this will be indicated in the international preliminary examination report (see Chapter VI, paragraph 8.9). The examiner should examine the claimed subject matter to the extent that this is possible but should ask the applicant for clarification at the time of his first written opinion."

72. Paragraph 4.1: This paragraph should read as follows:

PCT Art. 33(4)

"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" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property." Industry therefore includes 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. If any product or process is alleged to operate in a manner clearly contrary to well-established physical laws and thus the invention cannot be carried out by a person skilled in the art, objection could arise because the description and claims are so unclear that no meaningful opinion can be formed. Accordingly, the examiner would not be obliged to form an opinion on the question of novelty, inventive step (non-obviousness) and industrial applicability of the claimed invention (see Chapter IV, paragraph 1.1)."

PCT Art. 5

PCT Art. 34(4)  
(a)(ii)  
PCT Art. 35(3)  
(a)

73. Paragraph 4.2: This paragraph should be deleted.

74. Paragraph 5.1: This paragraph should read as follows:

PCT Art. 33(2)

PCT Rule 64.1

"A claimed invention shall be considered novel if it is not anticipated by 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 5.4). The scope of this definition should be noted. There are no restrictions whatever as to the geographical location where, or the language or manner in which the relevant information contained in the written disclosure was made available to the public; also no age limit is stipulated for the documents which contain the written disclosure."

75. Paragraph 5.2: This paragraph should read as follows:

"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 5.4), 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 of dissemination of such knowledge. As a general rule, no document will be cited in the international search report if the date of publication or public availability of the document concerned is clearly later than the filing date of the international application. The international search report may have cited a document where there is difficulty in establishing whether the date of publication or public availability of the document is or is not later than the filing date of the international application. 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 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."

76. Paragraph 5.3 (new): The Working Group agreed to the inclusion of an additional paragraph reading as follows:

"The only other question which the examiner is required to consider is where 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 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 PCT Article 33(2) and (3), but will call attention to such non-written disclosure in the manner provided for in PCT Rule 70.9 (see also Chapter VI, paragraph 8.12)."

PCT Rule 64.1  
(b)

PCT Rule 64.2

77. Paragraph 5.4 (new) = paragraph 5.3 (old): This paragraph should read as follows:

"It should be noted that the "relevant date," for the purpose of considering prior art, is defined in PCT 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, paragraphs 1.3 and 4). It should be remembered also that different claims, or different alternatives claimed in one claim, may have different relevant 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 relevant 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 need not (and should not) concern himself with the allocation of priority dates."

PCT Art. 2(xi)

78. Paragraph 6.1: This paragraph should read as follows:

"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 5.4 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 manner provided for in PCT Rule 70.10 (see also Chapter V, paragraph 1.4 and Chapter VI, paragraph 8.13)."

79. Paragraph 6.3: This paragraph should read as follows:

"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 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 invention (even though they may not necessarily claim that invention in identical terms), the applicant should be notified that he may be required in the national phase to choose which one of those applications he wishes to proceed to grant. However, no such notification should be given where two such international applications of the same priority date are received from two different applicants."

80. Paragraph 7.2: This paragraph should read as follows:

"A document takes away the novelty of any subject matter explicitly contained in the document."

81. Section 8: This Section should be deleted.

82. Paragraph 8.1 (new) = paragraph 9.1 (old): This paragraph should read as follows:

"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 5.4 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 claimed invention and the known art. In considering inventive step or non-obviousness, the examiner 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 whether its relation to combinations are obvious to a person skilled in the art."

83. Paragraph 8.3 (new) = paragraph 9.3 (old): This paragraph should read as follows:

"The question to consider, in relation to any claim defining matter for which protection is sought, 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 ability 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."

84. Paragraph 8.5 (new) = paragraph 9.5 (old): The Working Group agreed that this paragraph should read as follows:

"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 as being correct unless the applicant states he has made a mistake. However, the further prior art contained in the international search report or any additional document considered to be relevant may put the claimed invention in an entirely different perspective from that apparent from the disclosure 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 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)."

85. Paragraph 8.8 (new) = paragraph 9.8 (old): The Working Group agreed that the examples appearing in this paragraph should be amended so that item (iv) under heading (A1) and item (ii) under heading (C2) should read as appears below (the paragraph otherwise remaining unchanged):

"(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:

(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 polyethylene 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.

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

(ii) The claimed invention consists in selecting a particular 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 particular 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."

86. Paragraph 8.9 (new) = paragraph 9.9 (old): This paragraph should read as follows:

"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 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 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 advertising)."

87. Paragraph 8.10 (new): The Working Group agreed to the inclusion of an additional paragraph reading as follows:

"The examiner should bear in mind that when considering whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable, a dependent claim is regarded as limited by all the features of the claim on which it depends. Therefore, if the statement concerning novelty of the independent claim is positive, it should normally be positive for the dependent claim. This principle applies to inventive step as well."

CHAPTER V--PRIORITY

88. Paragraph 1.1: This paragraph should read as follows:

"An international application is accorded as its international filing date the date on which it satisfies the requirements of PCT Article 11. This date remains unchanged except in the special circumstances of later-filed drawings and sheets as provided in PCT Article 14(2) and PCT Rule 20.2. 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."

89. Paragraph 1.3: This paragraph should read as follows:

"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 have been "filed in or for any country party to the Paris Convention for the Protection of Industrial Property." The words "in or for" any country party to 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. Other conditions to be satisfied for a valid claim of priority are mentioned in Chapter V, Section 3."

PCT Art. 8(1)

90. Paragraph 1.4: This paragraph should read as follows:

"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 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 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 that there were no rights outstanding in the earlier application in respect of the subject matter of the application being examined."

PCT Art. 8(2)(a)

91. Paragraph 1.5: This paragraph should read as follows:

"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."

PCT Art. 8(1)

92. Paragraph 2.1: This paragraph should read as follows:

"As a general rule, the examiner should not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if subject matter relevant with regard to the determination of novelty or inventive step (non-obviousness) 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 PCT 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 PCT Rule 70.10, last sentence)."

93. Paragraph 2.2: This paragraph should read as follows:

"When the examiner 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. 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."

94. Paragraph 2.3: This paragraph should read as follows:

"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 the combination of all the important elements of the claim."

95. Paragraph 2.5: This paragraph should read as follows:

"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 relevant 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."

96. Paragraph 3.1: This paragraph should read as follows:

PCT Rule 17.1(a) "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 PCT Rule 4.10 (see 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."

97. Paragraph 3.3: This paragraph should read as follows:

PCT Rule 66.7(a) "If the examiner needs a copy of the priority application (see Chapter V, paragraph 2.1), the copy is supplied on request by the International Bureau unless the International Bureau has not yet received the priority document (see PCT Rule 66.7(c) Chapter VI, paragraph 3.1) in which event the examiner should request the applicant himself to furnish such a copy not later than the expiration of two months after the date of the request. 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 examiner should invite the applicant to furnish a translation of the priority document within two months of the invitation, failing which PCT Rule 66.7(c) the international preliminary examination report will be established as if the priority had not been claimed (see also Chapter VI, paragraph 4.9).

CHAPTER VI--PROCEDURE BEFORE THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

98. Paragraph 1.1: This paragraph should read as follows:

PCT Rule 56  
PCT Art. 32(3)  
PCT Art. 33(1)

"Subject to certain requirements as to entitlement to have international preliminary examination in accordance with PCT Article 31(2)(a) and (b), 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 by the International Bureau 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."

99. Paragraph 1.2: This paragraph should read as follows:

PCT Art. 32(2)  
PCT Art. 31(6)(a)  
PCT Art. 31(6)(b)

"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 receiving Offices for which the International Preliminary Examining Authority is prepared to act, the receiving Offices 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."

100. Paragraph 1.3: This paragraph should read as follows:

PCT Art. 34(2)(c)  
PCT Art. 35

"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 other communications with the applicant may occur, are given in an international preliminary examination report established by that Authority."

101. Paragraph 2.1: This paragraph should read as follows:

PCT Rule 66.1

"Before international preliminary examination starts, the applicant may make amendments according to PCT Article 34(2)(b) and the international preliminary examination shall initially be directed to the claims, the description, and the drawings, as contained in the international application to the time the international preliminary examination starts. International preliminary examination involves the following steps: the applicant demands international preliminary examination; the demand is addressed to the competent 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")."

102. Paragraph 2.2: This paragraph should read as follows:

PCT Art. 38

"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. However, the international application as well as the international preliminary examination report is communicated to elected Offices."

PCT Art. 36(3)  
(a)

103. Paragraph 3.1: This paragraph should read as follows:

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

"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 should be noted, however, that, in accordance with PCT Article 40, unless any particular Contracting State is elected prior to the expiration of the 19th month after the priority date, the 25th month period of delay in the commencement of national processing will not obtain. It is most likely that the applicant will, in fact, submit his demand some time after the end of 18 months after 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."

104. Paragraph 3.3: This paragraph should read as follows:

PCT Rule 69.1  
(a)

"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, which is the same for all International Preliminary Examining Authorities, is set out in the agreement between each 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 PCT Article 34(3) (see Chapter VI, paragraph 5.5), eight months after the start of the international preliminary examination."

105. Paragraph 4.1: This paragraph should read as follows:

PCT Rule 62.1  
(a)

"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 formalities from the receiving Office or the International Searching Authority and, depending upon the circumstances, the priority documents as well as any required translations (see Chapter V, paragraph 3.3 and Chapter VI, paragraph 4.9)."

106. Paragraph 4.2: This paragraph should read as follows:

PCT Rule 62.1  
(b)

"In the cases 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. The various elements of this dossier will be supplied to the International Preliminary Examining Authority as follows:



- PCT Art. 31(6)(a) - demand: by the applicant
- PCT Rule 62.1 (b) - request, description, drawings (if any) and claims as originally filed: by the International Bureau
- PCT Rule 62.1 (b) - the international search report and/or declaration under PCT Article 17(2)(a): by the International Bureau
- PCT Art. 19 - amendments under PCT Article 19 and statements (if any): by the International Bureau or, if at the time of filing such amendments the demand for international preliminary examination has already been submitted, by the applicant
- PCT Rule 62.2 (a)
- PCT Rule 66.1 - amendment according to PCT Article 34(2)(b): by the applicant
- PCT Art. 16 (3)(b) - copies of any documents cited in the international search report: by the International Bureau or by the International Searching Authority (depending upon agreement being reached with the competent International Searching Authority)
- PCT Rule 62.1 (b) - correspondence concerning formalities emanating from the receiving Office or the competent International Searching Authority: by the International Bureau
- PCT Rule 66.7 (a) - priority document: by the International Bureau or by the applicant if the International Bureau has not received the priority document (subject to a request having been made)
- PCT Rule 55.2 (a) - translation of the international application where required: by the applicant
- PCT Rule 66.7 (b) - translation of the priority document where required: by the applicant (subject to an invitation to furnish the translation having been made)."

107. Paragraph 4.3: This paragraph should read as follows:

"The examiner should keep in mind that the documents making up the international application may contain the declaration referred to in PCT 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."

PCT Rule 62.1 (b)

108. Paragraph 4.5: This paragraph should read as follows:

"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 language, or one of the languages, 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:

PCT Rule 55.2 (a)

PCT 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 after the priority date, three months after the date of such transmittal; or

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

109. Paragraph 4.6: This paragraph should read as follows:

PCT Rule 55.2(d) "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 the applicant's knowledge, complete and faithful. The International Preliminary Examining Authority must determine whether the translation, and the signed statement by the applicant, have been timely filed within one month of the date of the invitation and, if not, notify the applicant and the International Bureau that the demand shall be considered as if it had not been submitted."

PCT Rule 55.2(c)

110. Paragraph 4.7: This paragraph should read as follows:

PCT Rule 55.1 "The demand submitted to the International Preliminary Examining Authority must be in the language of the international application, unless a translation of the international application is needed, in which event the demand must be in the language of that translation."

111. Paragraph 4.8: This paragraph should read as follows:

"Where the facility provided for by PCT Article 34(2)(b) (see also Chapter VI, paragraph 4.11) has been used, the question may arise whether a particular amendment proposed by the applicant extends the content of the international application as filed (see Chapter VI, paragraphs 7.8 to 7.11). The examiner should 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 of 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 text as filed at any time during the proceedings before the International Preliminary Examining Authority."

112. Paragraph 4.9: This paragraph should read as follows:

PCT Rule 66.7 (a) and (b) "Where the international application claims the priority of a previous application and the examiner needs the priority document, the examiner should request the International Bureau to furnish promptly a copy of the priority document or, where a certified copy of the priority document has not yet been received by the International Bureau under PCT Rule 17.1(a) shall request the applicant himself, to furnish a certified copy not later than the expiration of two months from the date of the request. When the priority document is not in the language or in one of the languages of the International Preliminary Examining Authority, 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, paragraph 3.3). If the examiner finds that the requested priority document and (where required) the translation have not yet been timely furnished, he must establish the international preliminary examination report as if the priority has not been claimed in the international application and indicate this in the report."

PCT Rule 66.7(c)

113. Paragraph 4.10: This paragraph should read as follows:

PCT Rule 62.2 (a) "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 PCT 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 PCT 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 PCT Article 19, as provided in PCT Rule 46.1 (two months after the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or, when such transmittal takes place before the expiration of 14 months after priority date, three months after 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)."

PCT Rule 62.2 (b)

114. Paragraph 4.11: This paragraph should read as follows:

PCT Rule 66.1  
PCT Rule 66.8  
(a)

"PCT Rule 66.1 provides that the applicant has the right to amend the claims, the description, and the drawings, in the prescribed manner and before the start of international preliminary examination. The amendment must not go beyond the disclosure in the international application as filed."

115. Paragraph 4.12: This paragraph should read as follows:

PCT Rule 66.1

"When amendments to the description, claims or drawings are made under PCT Rule 66.1 they may be accompanied by explanation. 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 PCT Article 17(2)(ii) (i.e., that all or at least some claims do not permit a meaningful search) or under PCT Rule 13 (i.e., that there is a 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."

116. Paragraph 5.2: This paragraph should read as follows:

"The international preliminary examination is to be carried out in accordance with PCT Article 34 and PCT Rule 66. The first step of the examiner is to study the description, the drawings (if any), and the claims of the international application and the documents describing the prior art as cited in the international search report."

117. Paragraph 5.3: This paragraph should read as follows:

PCT Art. 34(2)  
(c)

"The examiner will not prepare a written opinion (see Chapter VI, paragraphs 5.10 to 5.18 and Section 6) but will instead prepare the international preliminary examination report (see Chapter VI, Section 8) where -

(a) he is of the opinion that, having regard to the prior art, the claimed invention satisfies the criteria specified in PCT Article 33(1);

(b) he is not aware of any lack of compliance with the requirements of the PCT as regards the form and contents of the international application; and

(c) he does not intend to make any observations on the clarity of the claims, the descriptions and the drawings or the question whether the claims are fully supported by the description as provided for in PCT Article 35(2) and PCT Rule 70.12(ii).

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."

118. Paragraph 5.4 (new): The Working Group agreed to the addition of a new paragraph 5.4 in Chapter VI, Section 5, under the heading "General" and reading as follows:

"It is to be noted that international preliminary examination can, in general, be carried out only on those inventions in respect of which the International Searching Authority has established the international search report. This follows from the requirement in PCT Article 33(6) that the International Preliminary Examining Authority has to take into consideration the documents cited in the international search report (see, however, Chapter III, paragraph 7.6)."

119. Paragraph 5.5 (new) = paragraph 5.4 (old): This paragraph should read as follows:

PCT Rules 68.2  
and 68.3

"Where the examiner finds lack of unity of invention (see Chapter III, Section 7), a communication may, at the option of the examiner (see Chapter VI, paragraph 5.9), 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, which would avoid the objection of lack of unity of invention must be indicated by the examiner."

120. Paragraph 5.6 (new) = paragraph 5.5 (old): This paragraph should read as follows:

PCT Art. 34(3)  
(c)  
PCT Rule 68.4  
PCT Rule 68.5

"If the applicant does not comply with the invitation (by not paying the additional fees or by not restricting the claims either sufficiently or at all), 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."

121. Paragraph 5.7 (new) = paragraph 5.6 (old): This paragraph should read as follows:

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

"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 examine the applicant's protest and decide on the justification of the 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."

122. Paragraph 5.8 (new) = paragraph 5.7 (old): This paragraph should read as follows:

PCT Art. 34(3)  
(c)

"If the protest is found to be justified or if the applicant timely complied with the invitation to restrict or pay additional fees, the examiner 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. It should be noted that "the national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office."

123. Paragraph 5.9 (new) = paragraph 5.8 (old): This paragraph should read as follows:

PCT Rule 68.1

"The examiner may choose not to issue an invitation to the applicant pursuant to PCT Rule 68.1 in respect of lack of unity of invention in the international application for reasons of economy mentioned in Chapter III, paragraph 7.10. In this situation, he will carry out his examination and establish the international preliminary examination report on the entire international application, but will indicate, when establishing the report, his opinion that the requirement of unity of invention is not fulfilled and the reasons therefor."

124. Paragraph 5.10 (new) = paragraph 5.9 (old): This paragraph should read as follows:

"The first written opinion of the examiner under PCT Article 34(2) should cover all matters referred to in PCT Rule 66.2. Such matters may be:

- defects under PCT 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 PCT 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."

125. Paragraph 5.11 (new): The Working Group agreed to the inclusion of an additional paragraph combining paragraphs 5.10 and 5.11 of the existing text and reading as follows:

PCT Rule 66.2  
(a) (i)

PCT Art. 34(4)  
(b)

"In the event that the examiner finds that the international application contains subject matter falling within PCT Article 34(4)(a)(i) (i.e., subject matter on which the International Preliminary Examining Authority is not required, under PCT Rule 67, to carry out international preliminary examination) or that all the claims of the international application lack compliance with PCT Article 34(4)(a)(ii) (i.e., the description, the claims or the drawings are so unclear, or the claims are so inadequately supported by the description that no meaningful opinion can be formed), he will indicate this defect or 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 any such defect affects only some of the claims, a similar approach should be adopted in respect of such claims."

126. Paragraph 5.12: This paragraph should read as follows:

PCT Rule 70.2

PCT Rule 66.2(a)  
(iv)

"Normally, the international preliminary examination report is established on the basis of the international application as amended except where amendments extend the disclosure in the international application as filed (see Chapter VI, paragraphs 7.8 to 7.13). Such amendments which extend the disclosure must be brought to the notice of the applicant in the first written opinion."

127. Paragraph 5.13: This paragraph should read as follows:

PCT Rule 66.2  
(b)

"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 explanation; 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 5.5 to 5.9) in 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). Although the examiner is not obliged to do so, he should try to indicate to the applicant those amendments which would avoid a negative statement in the international preliminary examination report."

128. Paragraph 5.14: This paragraph should read as follows:

PCT Rule 66.2  
(c)

PCT Rule 66.2  
(d)

"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 fix the time limit within which the applicant must reply. "[Such] time limit shall be reasonable under the circumstances. It shall normally be 2 months after the date of notification. In no case shall it be shorter than 1 month after the said date. It shall be at least 2 months after the said date where the international search report is transmitted at the same time as the notification. In no case shall it be more than 3 months after the said date." 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."

129. Paragraph 5.17: This paragraph should be deleted.

130. Paragraph 5.18 (new) = paragraph 5.19 (old): This paragraph should read as follows:

PCT Rule 66.8  
(a)

"It must be emphasized that it is not part of the duty of the examiner 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. The form of the amendment should be as prescribed in PCT Rule 66.8(a)."

131. Paragraph 6.2: This paragraph should read as follows:

"The examiner 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 5.13) but should concentrate on the amendments themselves and any related passages, and on the deficiencies indicated in his first written opinion."

132. Paragraph 6.3: This paragraph should read as follows:

PCT Rule 66.4

"The examiner 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, subject to sufficient time being available having regard to the time limit for the establishment of the international preliminary examination report (see Chapter VI, paragraph 3.3), whether they could best be resolved by a further written opinion, a telephone discussion or an interview."

PCT Rule 66.6

133. Paragraph 6.5: This paragraph should read as follows:

PCT Rule 66.2(c)  
(c)  
PCT Rule 66.3

"The additional written opinion from the examiner should 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 paragraphs 7.1 to 7.6 would apply."

134. Paragraph 7.1 (new): The Working Group agreed to the inclusion of an additional paragraph at the beginning of Chapter VI, Section 7, reading as follows:

PCT Rule 66.5

PCT Rule 12.2

"Any change, other than the rectification of obvious errors of transcription, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings shall be considered an amendment." Any amendment to the international application "shall be in the same language as the said application."

135. Paragraph 7.4 (new) = paragraph 7.3 (old): This paragraph should read as follows:

PCT Rule 11.14

PCT Rule 11.12

"It should be noted that, when a replacement sheet or letter is required under Chapter VI, paragraphs 7.2 and 7.3, 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 over-writings, 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."

136. Paragraph 7.5 (new) = paragraph 7.4 (old): This paragraph should read as follows:

T Rule 92.1(a)

PCT Rule 92.2(a)

PCT Rule 92.2(c)

"The examiner 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 (see PCT Rule 2). 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."

137. Paragraph 7.7 (new) = paragraph 7.6 (old): This paragraph should read as follows:

"The examiner should make sure that amendments filed in accordance with the PCT, which are necessary to correct and deficiencies notified to the applicant, do not add to the content of the application as filed, thus violating PCT Article 34(2)(b). The examiner should 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 4.12. However, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage:

(i) Unity of invention: Do the amended claims satisfy the requirement of PCT Rule 13? When considering this matter paragraphs 5.5 to 5.9 of Chapter VI are applicable.

(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)."

138. Paragraph 7.8 (new) = paragraph 7.7 (old): This paragraph should read as follows:

PCT Rule 70.2(c) "There is normally no objection to an applicant's 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 international preliminary examination report must be established as if such amendment had not been made."

139. Paragraph 7.9 (new) = paragraph 7.8 (old): This paragraph should read as follows:

PCT Art. 34(2)(b) "An amendment should be regarded as extending the content of the international application if the overall change in the content of the application (whether by  
PCT Rule 70.2(c) 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."

140. Paragraph 7.13 (new) = paragraph 7.12 (old): This paragraph should read as follows:

"As indicated in Chapter VI, paragraph 7.8, 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."

141. Paragraph 7.14 (new) = paragraph 7.13 (old): The Working Group agreed that the title preceding this paragraph, and the paragraph itself, should read as follows:

"Rectification of obvious errors of transcription"

PCT Rule 91.1(b) 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 rectified at any time during international preliminary examination. The error must be "obvious" in the sense that it is immediately apparent:

- (i) that an error has occurred; and
- (ii) what the rectification should be.

PCT 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 7.7)."

142. Paragraph 7.15 (new) = paragraph 7.14 (old): This paragraph should read as follows:

PCT Rule 91.1(d) "Subject to authorization (see Chapter VI, paragraph 7.16), rectification of obvious errors of transcription in the international application can be made at the request of the applicant of his own volition. In addition, the examiner, 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 may invite the applicant to submit a request for rectification of such errors."

143. Paragraph 7.16 (new) = paragraph 7.15 (old): This paragraph should read as follows:

PCT Rule 91.1(e) "Rectification of an obvious error of transcription cannot be made before the International Preliminary Examining Authority without the express authorization of that Authority. The Authority is permitted to authorize rectification of such errors in a part of the international application other than the request or in any papers submitted to it. The examiner may only authorize rectification of obvious errors of transcription up to the time the international preliminary examination report is established. The time within which requests for rectification can be made to that Authority is limited accordingly. Where such rectifications are authorized by the examiner, 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  
PCT Rule 91.1(h) where he has denied the authorization for rectification, notify only the applicant  
Section 109 of such denial and the reasons therefor."  
Administrative Instructions



144. Paragraph 7.17 (new) = paragraph 7.16 (old): This paragraph should read as follows:

PCT Rule 66.6

"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 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 agent (the meaning of "agent" in the PCT is set out in PCT Rule 2.2) rather than the applicant himself. If the applicant, or his agent requests an interview, the examiner, at his discretion should grant more than one interview if he believes that a useful purpose would be served by such a discussion."

145. Paragraph 7.19 (new) = paragraph 7.18 (old): This paragraph should read as follows:

PCT Rule 66.6

"The interview 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, than a fuller note of the matters discussed may be made in the file for use in an additional written opinion (if any) or the international preliminary examination report."

146. Paragraph 7.20 (new) = paragraph 7.19 (old): This paragraph should read as follows:

PCT Rule 66.4

PCT Rule 66.6

PCT Rule 66.3

"If a new objection as to 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 should, however, keep in mind the time limit for the establishment of the international preliminary examination report (see Chapter VI, paragraph 3.3)."

147. Paragraph 7.21 (new) = paragraph 7.20 (old): This paragraph should read as follows:

"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."

148. Paragraph 7.23 (new) = paragraph 7.22 (old): This paragraph should read as follows:

PCT Rule 66.6

The international search report may cite a document which is not in a working language of the International Searching Authority because 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 his first written action, may cite the document on the basis of similar evidence; an abstract or corresponding document in a working language of the International Preliminary Examining Authority, 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."

149. Paragraph 7.24 (new) = paragraph 7.27 (old): The Working Group agreed that paragraphs 7.23 (old) to 7.26 (old) and the title preceding those paragraphs should be deleted, paragraph 7.27 (old) becoming paragraph 7.24 (new) preceded by a new title, as follows:

"Additional documents taken into consideration in certain cases"

PCT Art. 33(6)

"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. Such documents shall be considered on the same footing as the documents cited in the international search report."

150. Paragraph 8.1: This paragraph should read as follows:

"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 PCT Article 34(2)(c), this will follow one or more written opinions and eventually other communications with the applicant. If the examiner considers that the possibility exists of amending or correcting the international application to bring it into a form which meets the requirements of PCT Article 33 (see Chapter IV, paragraph 1.1), then the examiner should communicate to the applicant in his first written opinion, indicating that the International Preliminary Examining Authority is of the opinion that suitable amendments must be submitted within a stated period (see Chapter VI, paragraph 5.14). Ultimately, the examiner will have to prepare a preliminary examination report, taking due account of any amendments or comments received from the applicant."

PCT Art. 35(2)  
PCT Rule 70.6  
(b)

151. Paragraph 8.3: This paragraph should read as follows:

"The following data (in so far as set out on the front page of the form) should first be included in accordance with PCT Rules 70.3, 70.4, 70.5 and with the relevant Administrative Instructions under the PCT:

- (a) the international application number
- (b) the name of the applicant
- (c) the name of the receiving Office
- (d) the international filing date
- (e) the classification of the subject matter, at least according to the International Patent Classification (IPC)
- (f) the claimed priority date
- (g) the applicant's or agent's file reference (composed either of letters or numbers, or both, but not exceeding ten characters).

Administrative  
Instructions  
Section 108(b)

The indication of the classification of the subject matter referred to in item (e) above shall repeat the classification of the subject matter by the International Searching Authority given under PCT Rule 43.3 if the examiner agrees with such classification, or if the examiner does not agree with that classification should set forth the classification which the examiner considers to be correct (see Chapter V, of the "Guidelines for International Search to be Carried Out under the Patent Cooperation Treaty (PCT)")."

Administrative  
Instructions  
Section 504

152. Paragraph 8.4: This paragraph should read as follows:

"The examiner should then fill up 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."

153. Paragraph 8.5: This paragraph should read as follows:

PCT Rule 70.11 "In completing the indications in relation to amendments and/or corrections,  
the examiner should first indicate the amendments and/or corrections taken into  
account in establishing the international preliminary examination report. 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  
PCT Rule 70.2 taken into account in the establishment of the report (e.g., an amendment not taken  
(c) 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 re-  
PCT Rule 70.16 placement sheets) are included as an annex to the report."

154. Paragraph 8.6: This paragraph should read as follows:

PCT Rule 70.2 "If the report is established as if the priority claim contained in the inter-  
(b) national application had not been made, it shall so indicate. 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)."

155. Paragraph 8.7: This paragraph should read as follows:

"If the applicant has paid additional fees or has restricted the claims in  
response to an invitation to do so or if the applicant has failed to respond to  
the invitation to pay additional fees or restrict the claims (see Chapter VI,  
paragraphs 5.5 to 5.9) the international preliminary examination report shall so  
indicate. In addition to the general indication on the first page of the form,  
the report should also include the indications provided in the supplemental sheet  
which indicate whether:

- (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 the claims 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.

PCT Rule 70.13 In addition, should the international application be restricted to the claims which  
PCT. Art. 34(3) the applicant chooses as complying with the requirement of unity of invention, or  
which the examiner considers to be the main invention, the report must indicate  
which parts of the international application were, and which parts were not, the  
subject of international preliminary examination (see also Chapter VI, paragraph 5.6)."

156. Paragraph 8.8: This paragraph should read as follows:

PCT Rules 68.3 "In the case where the additional fees are paid under protest, the text of the  
(c) and 70.12 protest, together with the decision thereon, must be annexed to the report if the  
(i) applicant has so requested (see Chapter VI, paragraph 5.7). Where an indication  
has been given under item (e) above, the examiner must also specify the reasons  
Section 603 for which the international application was not considered as complying with the  
Administrative requirement of unity of invention."  
Instructions

157. Paragraph 8.9: This paragraph should read as follows:

"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:

- (a) the application relating to subject matter which does not require inter-  
national preliminary examination (see Chapter VI, paragraph 5.11);
- (a) (i) (b) the description, claims or drawings being so unclear that no meaningful  
PCT Rule 67 opinion could be formed (see Chapter VI, paragraph 5.11);
- (c) the claims being so inadequately supported by the description that no  
PCT Art. 34(4) meaningful opinion could be formed (see Chapter VI, paragraph 5.11).  
(a) (ii)
- (b) Where the report has not been established in relation to certain claims only, this  
PCT Art. 34(4) is indicated and the claims affected must be specified."

158. Paragraph 8.10: This paragraph should read as follows:

PCT Art. 35.2  
PCT Rule 70.6  
(a) "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 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 5.10). 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:

PCT Rule 70.6  
(b)  
PCT Rule 43.5  
(b)  
PCT Rule 70.7  
(b)  
PCT 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."

159. Paragraph 8.12: This paragraph should read as follows:

PCT Rule 70.9 "If the examiner 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 on or after the relevant date of the international application, he must indicate in the international preliminary examination report:

PCT Rule 70.7  
(b)  
Section 507(a)  
Administrative  
Instructions

(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."

160. Paragraph 8.13: This paragraph should read as follows:

PCT Rule 70.10 "The examiner should also mention as such, any published application or any patent referred to in the report by virtue of PCT Rule 64.3 and should provide for each such published application or patent the following indications:

PCT Rule 70.7  
(b)  
Section 507(b)  
Administrative  
Instructions

(i) its date of publication;  
(ii) its filing date, and its claimed priority date (if any);  
(iii) placing the letter "E" next to the citation.

PCT Rule 70.10 The report may also indicate that, in the opinion of the International Preliminary Examining Authority, the priority date has not been validly claimed."

161. Paragraph 8.14 (new): The Working Group agreed to the inclusion of an additional paragraph reading as follows:

PCT 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 507(c), (d), and (e) of the Administrative Instructions."

162. Paragraph 8.15 (new) = paragraph 8.14 (old): This paragraph should read as follows:

PCT Rule 70.12 "If, in the opinion of the examiner, 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 has not been suitably solved at the prescribed time limit for establishing the international preliminary examination report, he may include this opinion in the report and if he does, shall also indicate the reasons therefor (see also Chapter VI, paragraphs 5.10 and 5.12)."

163. Paragraph 8.16 (new) = paragraph 8.15 (old): This paragraph should read as follows:

PCT Rules 70.3  
and 70.4

"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. 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."

PCT Rule 70.14

164. Paragraph 8.16 (old): This paragraph should be deleted.

165. Paragraph 8.17: This paragraph should read as follows:

PCT Rule 70.17  
(a)

"The international preliminary examination report must be in the language in which the international 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 the international application to 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."

PCT Rule 48.3  
(a) and (b)

PCT Rule 70.17  
(b)

166. Paragraph 9.1: This paragraph should read as follows:

PCT Art. 47(1)

"When it is a matter for the examiner 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 V, paragraph 3.3 and Chapter VI, paragraphs 4.5, 4.6 and 4.9;

(ii) amendments--see Chapter VI, paragraphs 4.10, 4.11 and 5.14;

(iii) rectifications of obvious errors of transcription--see Chapter VI, paragraph 7.16;

(iv) response by applicant to first written opinion--see Chapter VI, paragraph 5.14;

(v) restricting claims or payment of additional fees--see Chapter VI, paragraph 5.5;

(vi) furnishing priority documents--see Chapter V, paragraphs 3.1 and 3.3 and Chapter VI, paragraph 4.9;

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

167. Section 11 (new): The Working Group agreed to the inclusion of an additional Section 11 (Section 11 (old) being renumbered as Section 12) reading as follows:

"11. Translation of the international preliminary examination report

PCT Rule 72

11.1 Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, at its national Office, be translated into English, French, German, Japanese, Russian or Spanish. Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette."

168. This report was unanimously adopted by the Working Group at its closing meeting on June 24, 1977.

[Annex follows]

LIST OF PARTICIPANTS/  
LISTE DES PARTICIPANTS

(in the English alphabetical order of the names of the States)  
dans l'ordre alphabétique anglais des noms des Etats)

I. STATES/ETATS

AUSTRIA/AUTRICHE

Mr. G. GALL, Ratssekretaer, Federal Ministry for Trade, Commerce and Industry,  
Austrian Patent Office, Vienna

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. J. HAUGG, Regierungsdirektor, German Patent Office, Munich

JAPAN/JAPON

Mr. S. MURAMATSU, Director General, Fifth Examination Department, Japanese Patent  
Office, Tokyo

Mr. K. HATAKAWA, Director, Patent Section, Japan Trade Center, Düsseldorf

NETHERLANDS/PAYS-BAS

Mr. J. DEKKER, Vice-President, Netherlands Patent Office, Rijswijk (Z.H.)

Mr. S. de VRIES, Examiner, Patents Council, Netherlands Patent Office, Rijswijk (Z.H.)

NORWAY/NORVEGE

Mr. O. OS, Overingeniør, Norwegian Patent Office, Oslo

SOVIET UNION/UNION SOVIETIQUE

Mr. E. BURYAK, Head, International Patent Cooperation Division, All-Union Research  
Institute of the State Patent Examination, State Committee for Inventions and  
Discoveries of the USSR Council of Ministers, Moscow

SWEDEN/SUEDE

Mr. Y. TRUVE, Member of the Board of Appeal, Royal Patent and Registration Office,  
Stockholm

UNITED KINGDOM/ROYAUME-UNI

Mr. M. F. VIVIAN, Senior Examiner, The Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr. H. D. HOINKES, International Patent Specialist, Office of Legislation and  
International Affairs, United States Patent and Trademark Office, Washington, D.C.

II. INTERGOVERNMENTAL ORGANIZATIONS/ORGANISATIONS INTERGOUVERNEMENTALES

EUROPEAN PATENT ORGANISATION (EPO)/ORGANISATION EUROPEENNE DES BREVETS

Dr. R. SINGER, Head of the Planning Group of the Interim Committee of the European Patent Organisation, Munich, Germany (Federal Republic of)

INTERNATIONAL PATENT INSTITUTE/INSTITUT INTERNATIONAL DES BREVETS (IIB)

M. J. DELORME, Directeur Général, IIB, Rijswijk (Z.H.), Pays-Bas

M. J. A. H. van VOORTHUIZEN, Directeur Technique Adjoint, IIB, Rijswijk (Z.H.), Pays-Bas

III. NON-GOVERNMENTAL ORGANIZATIONS/ORGANISATIONS NON-GOUVERNEMENTALES

COUNCIL OF EUROPEAN INDUSTRIAL FEDERATIONS (CEIF)/CONSEIL DES FEDERATIONS INDUSTRIELLES D'EUROPE

Mr. M. van DAM, Patent Agent, Eindhoven, Netherlands

Dr. R. KOCKLAUNER, Farbwerke Hoechst, Wiesbaden, Germany (Federal Republic of)

EUROPEAN FEDERATION OF AGENTS OF INDUSTRY IN INDUSTRIAL PROPERTY/FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN PROPRIETE INDUSTRIELLE (FEMIP)

M. F. A. JENNY, Membre du Conseil d'Administration de la Fédération, c/o Patent Department, Ciba-Geigy AG, Basle, Switzerland

INTERNATIONAL FEDERATION OF PATENT AGENTS/FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE (FICPI)

Mr. V. BALASS, Patent Attorney, Schaad, Balass, Sandmeier, Zürich, Switzerland

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES INDUSTRIELS DE LA COMMUNAUTE EUROPEENNE (UNICE)

Mr. M. van DAM, Patent Agent, Eindhoven, Netherlands

Dr. R. KOCKLAUNER, Farbwerke Hoechst, Wiesbaden, Germany (Federal Republic of)

IV. OFFICERS/BUREAU

Chairman/Président : Mr. J. DELORME (IIB)

Secretary/Secrétaire : Mr. J. FRANKLIN (WIPO/OMPI)

V. WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)/  
ORGANISATION MONDIALE DE LA PROPRIETE INTELLECTUELLE (OMPI)

- Mr. F. A. SVIRIDOV, Deputy Director General/Vice-directeur général
- Mr. E. M. HADDRICK, Head, PCT Division/Chef de la Division du PCT
- Mr. J. FRANKLIN, Counsellor/Conseiller, Head, PCT Technical Section/Chef de la Section technique du PCT
- Mr. D. BOUCHEZ, Technical Counsellor/Conseiller technique, PCT Division/Division du PCT
- Mr. Y. GYRDYMOV, Technical Officer/Assistant technique, PCT Division/Division du PCT
- Mr. A. OKAWA, Consultant, PCT Division/Division du PCT

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