

C. PCT 1296

March 10, 2011

Madam,
Sir,

Proposed modifications of the PCT Receiving Office Guidelines and proposed new Form relating to the International Searching Authority

This Circular is addressed to your Office in its capacity as receiving Office (RO) and as International Searching Authority (ISA) under the Patent Cooperation Treaty (PCT) for the purpose of consultation on proposed modifications to the PCT Receiving Offices Guidelines (ROGL) and on a proposed new form relating to the ISA. It is also addressed to certain non governmental organizations representing users of the PCT system.

The proposed modifications are consequential to amendments of the Regulations under the PCT adopted by the PCT Assembly at its fortieth session (see document PCT/A/40/7) which entered into force on July 1, 2010. These amendments concern the establishment of equivalent amounts of certain fees. Reference is also made to Circular C. PCT 1198, dated December 18, 2009 and Circular C. PCT 1266, dated June 25, 2010, promulgating modifications to the Administrative Instructions under the PCT (AIs) and the Request Form (Form PCT/RO/101) which entered into force on January 1, 2010 and July 1, 2010, respectively. It is recalled that these modifications concern, in particular, the possibility to obtain notifications from Authorities by e-mail only, the deletion of the possibility to exclude the designation of the Russian Federation in order to reflect the change in national law with effect of June 5, 2009 and the possibility for applicants to request that priority documents be obtained by the International Bureau or the receiving Offices from digital libraries.

The occasion of this Circular is also used to propose modifications to the ROGLs to address an issue which was raised at the third session of the PCT Working Group on June 14 to 18, 2010 (see document PCT/WG/3/10). Specifically, the Working Group agreed that the ROGLs should be modified to clarify how the receiving Office should deal with the correction of mistakes it had made in the processing of international applications (see document PCT/WG/3/14 Rev.).

/...

In addition, upon request of Offices, the proposed text of the ROGLs contains a clarification which concerns the processing of replacement sheets which contain corrections of the claim numbering, in order to comply with the requirements of Rule 6.1(b).

Lastly, following some discussions at the seventh session of the Meeting of International Authorities under the PCT held in Rio de Janeiro on February 9 to 11, 2010 (see document PCT/MIA/17/6), the occasion of this Circular is also used to propose a new form, PCT/ISA/207, – drafted on the basis of existing form PCT/IPEA/428 which serves the same purpose within the International Preliminary Examining procedure under Chapter II – to give the examiner at the ISA the opportunity to clarify certain issues directly with the applicant and/or his agent, when the examiner is unable to carry out the international search for the reasons referred to in Article 17(2)(a)(ii).

The paragraphs of the ROGLs which are proposed to be modified are set out in Annex I to this Circular. The proposed new form (PCT/ISA/207) is set out in Annex II to this Circular.

Comments on the proposed modifications to ROGLs and on the proposed new Form

In order to be able to adopt the modified ROGLs and the new form (PCT/ISA/207) as soon as possible, you are invited to provide comments, if any, to the International Bureau by April 8, 2011 preferably by fax to: (+41 22) 910 00 30 or by email to: pct.legal@wipo.int.

Yours sincerely,



Francis Gurry
Director General

Enclosures: Annex I – Proposed modified paragraphs of the ROGLs
Annex II – Proposed new Form PCT/ISA/237

Proposed modified paragraphs of the ROGLs

27. **Mailings by Receiving Offices.** Any document or letter emanating from or transmitted by the receiving Office constituting an event from the date of which any time limit under the Treaty and the Regulations commences to run is to be sent by airmail, provided that surface mail may be used instead of airmail in cases where surface mail normally arrives at its destination within two days from mailing or where airmail service is not available (Rule 92.3). In cases where the applicant's attention should be drawn urgently to a notification or other communication, the receiving Office should, to the extent possible, transmit such notification or other communication by facsimile and send a confirmation copy by mail. If the applicant or the agent has authorized either the sending of advance copies of notifications by e-mail or the sending of notifications exclusively by e-mail, by marking the corresponding check-box in Box No. II or Box No. IV of the request form, the receiving Office may, if it wishes to do so, send such notifications in respect of the international application to the applicant, thus avoiding postal delays. If an e-mail notification is followed by the official notification on paper, only the paper copy of the notification is considered to be the legal copy of the notification and only the date of mailing of the paper copy will commence any time limit within the meaning of Rule 80. Where the applicant requests the sending of notifications exclusively by e-mail, the date of mailing indicated on the electronic copy will commence any time limit within the meaning of Rule 80.

(...)

34. For refund of fees where any prescriptions concerning national security prevent transmittal of the record copy and search copy, see Rules 15.46(iii) and 16.2(iii) and paragraphs 268 to 271.

(...)

50. **Negative Determination (Rule 20.4).** If the receiving Office finds that the corrections of defects under Article 11(1) have not been timely received or have been received but the application still does not fulfill the requirements of Article 11(1) or if the defects could not be resolved by way of incorporation by reference of a missing element under Rules 4.18 and 20.6, it proceeds, once the time limit under Rule 20.7 has expired, as follows:

(i) it deletes the letters "PCT" from the indication of the international application number on any papers marked previously with that number, and uses the said number without such letters in any future correspondence relating to the purported international application (Section 308(d));

(ii) it notifies (Form PCT/RO/104) the applicant that the application will not be treated as an international application and that the number marked on the papers will no longer be used as an international application number (Rule 20.4(i) and (ii)); it sends a copy of that notification to the International Bureau;

(iii) it abstains from transmitting the record copy and the search copy but keeps the application and any correspondence relating thereto (Rule 20.4(iii)); it sends a copy of the said papers to the International Bureau only upon special request in case of a review under Article 25(1) (Rule 20.4(iv)); and

(iv) it refunds (Form PCT/RO/119) any international filing fee and/or search fee received, (Rules 15.46(i) and 16.2(i)); it may also refund any transmittal fee received, subject to the provisions applied by the receiving Office; for the procedure for refunding fees, see paragraphs 268 to 271.

(...)

101. **Exclusion of Certain States from Designation.** Under Rule 4.9(b), the applicant may, by marking the applicable check-box(es), indicate that Germany, Japan ~~and/or~~ the Republic of Korea ~~and/or the Russian Federation~~ are not designated for any kind of national protection. This possibility is restricted to those ~~three~~four States ~~as no other State has notified the International Bureau that Rule 4.9(b), which provides for the possibility to exclude States from designation, is applicable in respect to the designation of that State.~~ Therefore, no other State can be excluded from the automatic and all-inclusive coverage of designations and no withdrawals of designations are allowed in the request. If the applicant adds in the request explicit indications as to the designation of a specific contracting State or a withdrawal of a designation, such indication should be deleted *ex officio* by the receiving Office, as provided in Rule 4.19(b) and Section 303 (paragraphs 161 to 165). However, the applicant may submit a separate notice of withdrawal of designation under Rule 90*bis*.2. The designations of Germany for the purposes of a European patent ~~is and of the Russian Federation for the purposes of a Eurasian patent are~~ not affected so that ~~this~~both States remains designated for regional protection if the ~~respective~~checkboxes ~~is~~are marked. Regarding further details concerning the indication that Germany, Japan ~~and/or~~ the Republic of Korea ~~or the Russian Federation~~ shall not be designated for any kind of national protection, see the Notes to the request form relating to Box No. V.

102. **Priority Claim from Excluded State.** Under Rule 4.9(b), the applicant may only exclude the designation of Germany, Japan ~~and/or~~ the Republic of Korea ~~and/or the Russian Federation~~ in Box No. V, if the priority of an earlier national application filed, respectively, in Germany, Japan ~~and/or the Republic of Korea~~, is claimed in Box No. VI. If, on the date of filing, the request contains an indication under Rule 4.9(b) that the designation of a State is not made, but does not contain a priority claim to an earlier national application filed in that State, the applicant shall be promptly notified and his attention drawn to Rule 26*bis* (Form PCT/RO/132). In accordance with Section 319, if, by the expiration of the time limit under Rule 26*bis*.1(a), no notice correcting or adding such a priority claim has been received, the indication in Box No. V shall be enclosed in square brackets and a line drawn between the square brackets, which leaves the indication legible, and in the margin, shall be indicated the words “CANCELLED EX OFFICIO BY RO”. The receiving Office shall promptly notify the applicant and the International Bureau accordingly (Form PCT/RO/146).

(...)

Certification of an Earlier Application, Obtaining of an Earlier Application from a Digital Library and Transmittal to the International Bureau

183. Where the earlier (national, regional or international) application was filed with the same Office that acts as receiving Office and the priority document is therefore to be issued by that Office, the applicant may, instead of obtaining the priority document from that Office and submitting it subsequently to that same Office or the International Bureau, request that Office as receiving Office to prepare the priority document and transmit it directly to the International Bureau. Such a request (“request for priority document”) must not be made later than 16 months from the priority date and may be subjected by the receiving Office to the payment of a fee (Rule 17.1(b)). The request for priority document may be made on the request form by marking the appropriate set of check-boxes in Box No. VI, or by making a request to that effect on any other paper, such as a letter accompanying the international application or on the fee calculation sheet. The latter contains a space for including the amount of the fee concerned. Such a request may also be submitted subsequently within the prescribed time limit by sending a letter to this effect.

183A. Where the earlier (national, regional or international) application is available to the receiving Office from a digital library in accordance with Rule 17.1(b-bis)(i), the applicant may request the receiving Office to obtain the priority document from such a digital library and to transmit it to the

International Bureau. Such a request (“request for priority document”) must not be made later than 16 months from the priority date and may be subjected by the receiving Office to the payment of a fee (Rule 17.1(b-bis(i)). The request to obtain the priority document may be made on the request form by marking the appropriate set of check-boxes in Box No. VI, or by making a request to that effect on any other paper, such as a letter accompanying the international application or on the fee calculation sheet. The latter contains a space for including the amount of the fee concerned. Such a request may also be submitted subsequently within the prescribed time limit by sending a letter to this effect.

183B. It is recommended that applicants mark only one set of check-boxes in Box No. VI. Where the applicant has marked the check-boxes in Box No. VI to request both the International Bureau and the receiving Office to, respectively, obtain the priority document(s) from a digital library and where the receiving Office prepares itself or has successfully obtained the priority document(s) from a digital library and transmits the priority document(s) to the International Bureau, it is recommended that the receiving Office deletes *ex officio* the marked check-box concerning the request to the International Bureau. Where the receiving Office cannot prepare or could not successfully obtain the priority document(s), it should preferably delete *ex officio* the marked check-boxes concerning the request to the receiving Office. The receiving Office should notify the applicant accordingly (Form PCT/RO/146).

(...)

186. Where, prior to the expiration of 16 months from the priority date, a request for priority document has been made (paragraphs 183 to 185), and any required fee has been paid, the receiving Office promptly prepares, or obtains from a digital library, that document and transmits it ~~that document~~ together with Form PCT/RO/135 to the International Bureau (Section 323(b) and (c)). It marks the international application number indelibly in the top right corner of the first sheet.

(...)

188A. As outlined in Section 716(b), where a request to obtain (a) priority document(s) from a digital library has been made with the receiving Office only (otherwise see paragraph 183B), but all attempts to obtain the priority document(s) from the digital library accessible to the receiving Office have failed, the receiving Office notifies the applicant (Form PCT/RO/132), giving the opportunity to either furnish the priority document(s) to the receiving Office or to the International Bureau, or to ensure that the document(s) is (are) made available to it or to the International Bureau from a digital library, within a time limit of not less than two months from the date of the notification or within the time limit specified in Rule 17.1(a), whichever time limit expires later. If the priority document(s) is (are) furnished or become(s) available to the receiving Office within the time limit, the requirements of Rule 17.1(b-bis) are considered to have been met. If the priority document(s) is (are) not furnished or do(es) not become available within the time limit, the request to obtain the document from a digital library shall be considered not to have been made.

(...)

191. Where a request for priority document has not been validly made because the earlier application was not filed with the receiving Office or, as outlined in Section 716(c), the priority document is not considered to be available to the receiving Office from a digital library in accordance with Section 715(a), the receiving Office *ex officio* ~~deletes~~ corrects the ~~corresponding mark in the~~ indications made ~~check-box~~ in Box No. VI by replacing the initial request with a request to the International Bureau to obtain the priority document from a digital library; and notifies the applicant accordingly

(Form PCT/RO/146); ~~the receiving Office may~~ explaining the relevant reasons for this correction using Form PCT/RO/132.

(...)

209A. Where the replacement sheets submitted contain corrections of the claim numbering, in order for the international application to comply with the requirements of Rule 6.1(b), the receiving Office may accept these changes under Rule 26 provided that the new numbering, which may also include the correction of cross-references in one or several claims, is only a correction of a formal defect. If the renumbering results, however, in any other changes of contents of the claims, the receiving Office should invite the applicant to submit to the International Searching Authority a request for rectification of an obvious mistake under Rule 91.1(b)(ii) (Form PCT/RO/108). Alternatively, the receiving Office may itself submit the replacement sheets containing the corrections to the competent International Searching Authority for its view and notify the applicant accordingly (Form PCT/RO/132).

(...)

240. The search fee is payable in the currency or one of the currencies prescribed by the receiving Office (“~~prescribed receiving Office~~ currency”, see Rule 16.1(b)). To the extent that the prescribed currency is freely convertible, tThe amounts of the search fee in those currencies are established as set out in Rule 16.1(~~d~~) and the Directives of the PCT Assembly Relating to the Establishment of New Equivalent Amounts of Certain Fees and notified by the International Bureau to each receiving Office prescribing payment in that ~~prescribed receiving Office~~ currency.

241. ***The International Filing Fee.*** The amount of the international filing fee is set out (in Swiss francs) in the Schedule of Fees, which is annexed to the Regulations, and is payable in the currency or one of the currencies prescribed by the receiving Office. The amount of the international filing fee depends on the total number of sheets of the international application at the time of filing, which appears under “Total number of sheets” in Box No. IX (check list) of the request. If the international application contains more than 30 sheets, a supplement to the international filing fee must be paid for each sheet in excess of 30 (Rules 15.2(a)~~1~~ and 96 and the Schedule of Fees). This supplement is also due for the sheet containing the abstract, even where such abstract is missing at the time of filing the international application.

(...)

253. The transmittal fee, the international filing fee and the search fee are payable within one month from the date of receipt of the international application by the receiving Office. The amount payable is the amount applicable on that date of receipt (Rules 14.1(c), 15.34 and 16.1(f)).

(...)

259. Where the receiving Office finds that, by the time they are due under Rules 14.1(c), 15.34 and 16.1(f), no fees were paid, or the amount paid is not sufficient to cover the transmittal fee, the international filing fee and the search fee, it invites (Form PCT/RO/133) the applicant to pay the amount required to cover those fees within one month from the date of the invitation and sends to the International Bureau a copy of that invitation (Rule 16*bis*.1(a)).

(...)

268. The receiving Office refunds (Form PCT/RO/119) to the applicant, in compliance with Rule 15.46, any amount paid to cover the international filing fee:

(i) if the determination under Article 11(1) is negative (and, therefore, an international filing date cannot be accorded);

(ii) if the international application is withdrawn or considered withdrawn before the record copy has been transmitted to the International Bureau; or

(iii) if, due to prescriptions concerning national security, the international application is not treated as such.

(...)

272. The receiving Office should, each month, transfer to the International Bureau and the International Searching Authority, respectively, moneys received as international filing fee (Rule 15.2(~~ca~~) and (d)) ~~and search fees~~ (Rule 16.1(~~cb~~) and (d)) during the preceding month. The receiving Office keeps for its own benefit any moneys received as transmittal fees (Rule 14) and late payment fees (Rule 16*bis*.2).

(...)

282. Rules 17.1(b) and 17.1(b-bis(i)), concerning preparation or the obtaining from a digital library and transmittal to the International Bureau of a priority document upon request of the applicant, does not apply where a purported international application is transmitted under Rule 19.4.

(...)

309B. Where the request for the recording of a change concerns the indication of an e-mail address of the applicant or the agent, the receiving Office, when preparing Form PCT/RO/113, checks the appropriate box next to the e-mail address, if the applicant or agent has given his express authorization that the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority may use the e-mail address provided to send advance copies of notifications, or to send notifications exclusively by e-mail in respect of this international application.

(...)

339. A receiving Office may, at any time, correct any errors made by it relating to the processing of an international application, unless the correction of such errors by the receiving Office is covered by specific procedures provided for in the Treaty, the Regulations, the Administrative Instructions or these Guidelines. Upon doing so, it should promptly notify the applicant, the International Bureau and, where applicable, the International Searching Authority and International Preliminary Examining Authority (Form PCT/RO/132).

[End of annex I, annex II follows]

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

INFORMAL CLARIFICATION:
NOTE/INVITATION
(PCT Article 17(2) and PCT/GL/ISPE
paragraphs 9.34 and 9.35)

Applicant's or agent's file reference	Date of mailing (<i>day/month/year</i>)
International application No.	International filing date (<i>day/month/year</i>)
Applicant	

It appears to the International Searching Authority that the description, claims or drawings **fail to comply with the PCT requirements** to such an extent that a meaningful search cannot be carried out in relation to the international application (Article 17(2)(a)(ii)).

1. The International Searching Authority **has contacted** the applicant on _____ (*day/month/year*) (see below) to **informally discuss** the application and obtain the required clarification.

Communication type

- by telephone
- personal
- by e-mail
- by facsimile
- by regular mail

Participants

- Applicant: _____
- Agent: _____
- Examiner(s): _____
- identity checked authorization checked personally known

A **Summary** of the discussions is set out under item 3.

2. The International Searching Authority hereby **invites** the applicant **to provide informal clarification** on the issue(s) indicated under item 3 within _____ (*days/months*) from the date of mailing of this Invitation.

IMPORTANT: Failure to react timely and/or furnish the clarification required by the International Searching Authority may result in either the establishment of a partial search report or a declaration under Article 17(2)(a)(ii) that no International Search Report will be established by the International Searching Authority (Form PCT/ISA/203).

3. **Summary** of the discussions/detailed issue(s) requiring **informal clarification** (if necessary continued in the Annex to this Form).

4. A copy of this Note/Invitation is being sent to the applicant and to the International Bureau.

Name and mailing address of the ISA/	Authorized officer
Facsimile No.	Telephone No.

ANNEX TO FORM PCT/ISA/207

International application No.

Continuation of item 3: