

C. PCT 1547

November 6, 2018

Madam,
Sir,

Standardized Clauses in PCT International Search and Preliminary Examination Reports

This Circular is addressed to your Office in its capacity as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT).

Background

In Circular C. PCT 1426, dated October 2, 2014, the International Bureau communicated a set of standardized clauses in English for use in international search and preliminary examination reports. As well as the clauses, which cover matters relevant to Boxes V and VIII of written opinions and international preliminary reports on patentability, the Circular included a set of General Principles covering the use of the clauses. In particular, the General Principles state that the use of the clauses should never be mandatory, and also acknowledge the need for flexibility for the examiner to address relevant issues as deemed appropriate in a particular case.

Circular C. PCT 1426 also discussed implementation of these clauses by those Authorities interested in using them in the reports. In this regard, a page on the electronic forum of the Quality Subgroup was established for International Authorities to share experiences with the use of the standardized clauses. The Circular also offered the opportunity for International Authorities to request translation of the clauses into any other official language of publication

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if they were intending to use the standardized clauses in their reports. Since this Circular was issued, translations of the clauses have been provided in French, Spanish, Chinese and Arabic.

At the eighth informal meeting of the Quality Subgroup in February 2018, the Subgroup discussed a paper (Paper No. 6) on recent activities in the use and development of the Standardized Clauses. The Annex to the paper included modifications to the clauses in English. As part of the follow-up in paragraph 44 of the Summary by the Chair of the meeting (Paper No. 16), the Subgroup recommended that:

“44. The Subgroup recommended that ...

(b) the International Bureau issue a Circular to consult on the adoption of the modifications to the standardized clauses in the different languages and propose the idea of their inclusion as an Annex to the International Search and Preliminary Examination Guidelines;

...

(d) the International Bureau continue work on including the standardized clauses in search report and written opinions in ePCT, and Authorities interested in joining a pilot contact the International Bureau if they had not done so already”.

Proposed Modifications to the Standardized Clauses

Annex I to this Circular contains proposals to modify the standardized clauses in English, French and Spanish, along with explanatory text to explain the proposed modifications. The proposed changes are based on suggestions made by International Authorities that have been using the standardized clauses. Having reviewed the text of the clauses, these proposals include further revisions to those shown in the paper prepared for the Quality Subgroup in February 2018. In addition, changes to the French and Spanish translations have been made for greater alignment between the different language versions. For the clauses in Chinese and Arabic, the International Bureau will verify these translations against the adopted modifications and contact the International Authorities if it appears necessary to make any revisions.

Inclusion of the Standardized Clauses in the International Search and Preliminary Examination Guidelines

To incorporate the standardized clauses into the PCT International Search and Preliminary Examination Guidelines, it is proposed to modify the Guidelines to introduce a link to a page on the WIPO website with the current version of the standardized clauses in all the languages for which they have been made available. The clauses on this webpage will be imported from those available in ePCT for use by International Authorities. This option has the advantage that the standardized clauses will exist in a single version only, maintaining consistency and facilitating the process of updating the clauses. By contrast, the option of including the clauses as an Annex within the Guidelines themselves would involve separate updates to the clauses in ePCT and in the Guidelines, with the need to maintain consistency between the two versions. Proposed modifications to the Guidelines to refer to this webpage are set out in Annex II to this Circular.

You are invited to provide comments to the International Bureau on the proposed modifications to the standardized clauses and the proposed way of incorporation into the PCT International Search and Preliminary Examination Guidelines. You are also invited to

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contact the International Bureau if you are interested in using the standardized clauses for preparing reports using ePCT if you have not done so already. Replies should be sent by December 7, 2018, preferably by e-mail to the PCT Business Development Division: pct.bdd@wipo.int.

Yours sincerely,

A handwritten signature in black ink, appearing to read "John Sandage".

John Sandage
Deputy Director General

Enclosures: Annex I – Proposed Modifications to the Standardized Clauses
Annex II – Proposed Modifications to the International Search and Preliminary Examination Guidelines

PROPOSED MODIFICATIONS TO THE STANDARDIZED CLAUSES

CLAUSES

BOX V/ CADRE V/ RECUADRO V

| | Clause (EN) | Clause (FR) | Cláusula (ES) |
|--|--|--|--|
| V.1 | Reference is made to the following documents: D1 XX NNNNNNN A1 (COMPANY) date of publication D2 AUTHOR Title of Publication, Year, Volume, No. Pages Etc. | La présente notification/la présente opinion/le présent rapport <u>Le présent document</u> fait référence à mention des documents suivants: D1 XX NNNNNNN A1 (SOCIETE) date de publication D2 AUTEUR Titre de la publication, année, volume, pages Etc. | Se hace referencia a los siguientes documentos: D1 XX NNNNNNN A1 (EMPRESA O SOLICITANTE) fecha de publicación D2 AUTOR Título de la Publicación, año, volumen, nro. de páginas Etc. |
| <i>Explanation: Simplification of text and better alignment between different language versions.</i> | | | |
| | Novelty (N) | Nouveauté (N) | Novedad (N) |
| | Clauses for Lack of Novelty | Formulations concernant le manque de nouveauté | Cláusulas relativas a la falta de novedad |
| V.2 | Claim(s) ... is/are not novel and therefore do(es) not comply with PCT Article 33(2). | La revendication/les revendications ... ne remplit/remplissent pas les conditions énoncées à l'article 33(2) PCT, cette/ces revendications n'étant pas conforme(s) au critère de nouveauté. | La(s) reivindicación/reivindicaciones ... carece(n) de novedad y por tanto no cumple(n) con el Art. 33.2) PCT. |

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| | <i>Alternative A - Explanation by document</i> | <i>Variante A – explication en fonction d'un document</i> | <i>Alternativa A – Explicación basada en documentos</i> |
| V.3 | Document Dx discloses [insert description]. Therefore claim(s) ... is/are not novel. | Le document Dx divulgue [insérer la description]. Par conséquent, la revendication/les revendications... manque(nt) de nouveauté. | En el documento Dx se divulga [describir lo divulgado insertar descripción]. La(s) reivindicación/reivindicaciones ... por tanto carece(n) de novedad. |
| | <i>(Repeat clause V.3 for other documents as necessary)</i> | <i>(Reprendre la formulation V.3, le cas échéant, pour d'autres documents)</i> | <i>(Repetir la cláusula V.3 para otros documentos, si fuera necesario)</i> |
| | <i>Alternative B - Identification of closest prior art</i> | <i>Variante B – Identification de l'état de la technique le plus proche</i> | <i>Alternativa B – Identificación del estado de la técnica más próximo</i> |
| V.4.1 | Document D1 is considered to be the closest prior art and discloses [insert description]. Therefore claim(s) ... is/are not novel. | Le document D1, qui est considéré comme étant l'état de la technique le plus proche, divulgue [insérer la description]. Par conséquent, la revendication/les revendications... manque(nt) de nouveauté. | Se considera D1 el documento más cercano del estado de la técnica y divulga [describir lo divulgado insertar descripción]. La(s) reivindicación/reivindicaciones ... por tanto carece(n) de novedad. |
| V.4.2 | Document Dx discloses the additional features [insert description]. Therefore claim(s) ... is/are not novel. | Le document Dx divulgue les caractéristiques supplémentaires suivantes: [insérer la description]. Par conséquent, la revendication/les revendications... manque(nt) de nouveauté. | En el documento Dx se divulgan las siguientes características adicionales: [describir lo divulgado insertar descripción]. La(s) reivindicación/reivindicaciones ... por tanto carece(n) de novedad. |
| | <i>Alternative C - Separation between independent and dependent claims</i> | <i>Variante C – Distinction entre les revendications indépendantes et dépendantes</i> | <i>Alternativa C – Distinción entre reivindicaciones independientes y dependientes</i> |
| V.5.1 | Document(s) Dx, Dy ... disclose(s) [insert description]. Therefore claim 1 is not novel. | Le document/les documents Dx, Dy ... divulgue/divulguent [insérer la description]. Par conséquent, la revendication 1 manque de nouveauté.. | En el documento/los documentos Dx, Dy ... se divulga [describir lo divulgado insertar descripción]. La reivindicación 1 por tanto carece de novedad. |

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| V.5.2 | The features added by dependent claim(s) ... are also disclosed in document Dx, for example [insert description]. [Repeat as necessary for other documents]. Therefore claim(s) ... is/are not novel. | Les caractéristiques introduites par la revendication dépendante/les revendications dépendantes ... sont également divulguées dans le document Dx, par exemple [insérer la description]. [Reprendre, le cas échéant, cette formulation pour d'autres documents]. Par conséquent, la revendication/les revendications... manque(nt) de nouveauté. | Las características añadidas en la(s) reivindicación/reivindicaciones dependiente(s) ... también se divulgan en el documento Dx, por ejemplo [describir lo divulgado insertar descripción]. [Repetir para otros documentos si fuera necesario]. La(s) reivindicación/reivindicaciones ... por tanto carece(n) de novedad. |
| <i>Explanation: Better alignment between different language versions.</i> | | | |
| | Clauses when Novelty is complied with | Formulations lorsque la demande est conforme au critère de nouveauté | Cláusulas aplicables cuándo la invención cumple con el requisito de novedad |
| V.6 | Claim(s)... is/are novel and therefore complies/comply with PCT Article 33(2). | La revendication/les revendications ... remplit/remplissent les conditions énoncées à l'article 33(2) PCT, cette/ces revendications étant conforme(s) au critère de nouveauté. | La(s) reivindicación/reivindicaciones ... tiene(n) novedad y por tanto cumple(n) con el Art. 33.2) PCT. |
| V.7 | Document D1 is considered to represent the closest prior art. Document D1 discloses [insert description]. However, none of the cited documents discloses [insert description]. Claim(s) ... is/are therefore novel. | Le document D1, qui est considéré comme étant l'état de la technique le plus proche, divulgue [insérer la description]. Cependant, aucun des documents cités ne divulgue [insérer la description]. Par conséquent, la revendication/les revendications... est/sont conforme(s) au critère de nouveauté. | Se considera D1 el documento más cercano del estado de la técnica y divulga [describir lo divulgado insertar descripción]. No obstante, en ninguno de los documentos citados se divulga [describir lo divulgado insertar descripción]. La(s) reivindicación/reivindicaciones por tanto presenta tiene(n) novedad. |

| | Inventive Step (IS) | Activité inventive (AI) | Actividad Inventiva (AI) |
|---|--|---|--|
| | Clauses for Lack of Inventive Step | Formulations concernant le manque d'activité inventive | Cláusulas relativas a la falta de actividad inventiva |
| V.8 | Claim(s)... do(es) not involve an inventive step and therefore do(es) not comply with PCT Article 33(3). | La revendication/les revendications ... ne remplit/remplissent pas les conditions énoncées à l'article 33(3) PCT, cette/ces revendications n'impliquant pas une activité inventive. | La(s) reivindicación/reivindicaciones ... no implica(n) una actividad inventiva y por tanto no cumple(n) con el Art. 33.3) PCT. |
| V.9 | Given the above novelty objection, claim(s) [same claim(s) not showing novelty] do(es) not involve an inventive step for the reasons above. | Compte tenu de l'objection soulevée ci-dessus en matière de nouveauté, la revendication/les revendications [les mêmes revendications qui manquent de nouveauté] <u>n'implique/n'impliquent</u> pas une activité inventive pour les raisons susmentionnées. | Dada la objeción por falta de novedad previamente establecida, la(s) reivindicación/reivindicaciones [las reivindicaciones carentes de novedad antes citadas] no implica(n) una actividad inventiva por las razones mencionadas |
| <i>Explanation: Phrase is redundant as explanation already refers to the novelty objection, which will contain the same reasons for lack of inventive step.</i> | | | |

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| V.10 | <p>Document D1 discloses</p> <p>Document D2 discloses</p> <p>[Insert description to explain lack of inventive step].</p> <p>It would have been obvious to a person skilled in the art to arrive at the matter defined in claim(s) ... by combining the teachings of documents D1 and D2.</p> <p>EITHER: Document(s) ... therefore show(s) that claim(s) ... do(es) not involve an inventive step.</p> <p>OR: Document(s) ... when combined with document(s) ... therefore show(s) that claim(s) ... do(es) not involve an inventive step.</p> | <p>Le document D1 divulgue...</p> <p>Le document D2 divulgue...</p> <p>[Insérer une explication concernant le manque d'activité inventive].</p> <p>Il serait évident pour la personne du métier d'arriver à l'objet défini dans la revendication/les revendications ... en combinant les enseignements des documents D1 et D2.</p> <p>SOIT: Le document/les documents ... démontre(nt) donc que la revendication/les revendications ... n'implique/n'impliquent pas une activité inventive.</p> <p>SOIT: Le document/les documents ..., en combinaison avec le document/les documents ..., démontrent donc que la revendication/les revendications ... n'implique/n'impliquent pas une activité inventive.</p> | <p>En el documento D1 se divulga ...</p> <p>En el documento D2 se divulga ...</p> <p>[Incluir la descripción de la falta de actividad inventiva]</p> <p>Sería evidente para un experto en la materia llegar al objeto recogido en la(s) reivindicación/reivindicaciones ... como consecuencia de la combinación de lo divulgado en los documentos D1 y D2.</p> <p>BIEN:</p> <p>La(s) reivindicación/reivindicaciones ... no implica(n) una actividad inventiva con respecto al/a los documento(s)</p> <p>O BIEN:</p> <p>La(s) reivindicación/reivindicaciones ... no implica(n) una actividad inventiva con respecto al/a los documento(s) ... , en combinación con lo(s) documento(s)</p> |
| | <p>Clauses for when Inventive Step is complied with</p> | <p>Formulations lorsque la demande est conforme au critère d'activité inventive</p> | <p>Cláusulas aplicables cuándo la invención cumple con el requisito de actividad inventiva</p> |
| V.11 | <p>Claim(s) ... involve(s) an inventive step and therefore complies/comply with PCT Article 33(3).</p> | <p>La revendication/les revendications ... remplit/remplissent les conditions énoncées à l'article 33(3) PCT, cette/ces revendications impliquant une activité inventive.</p> | <p>La(s) reivindicación/reivindicaciones ... implica(n) una actividad inventiva y por tanto cumple(n) con el Art. 33.3 PCT.</p> |

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| V.12 | [Insert description of feature] would not have been obvious to a person skilled in the art from the cited documents, when taken individually or in any combination. Claim(s) ... therefore involve(s) an inventive step. | Pour la personne du métier, [insérer la description de la caractéristique] <u>n'est pas évident à la lumière</u> ne découle pas à l'évidence des documents cités, considérés seuls ou en une combinaison quelconque. La revendication/les revendications ... implique/impliquent donc une activité inventive. | [Describir la(s) característica(s) en cuestión] no es/son evidente(s) para un experto en la materia a partir de los documentos citados, considerados aisladamente o combinados de cualquier modo. La(s) reivindicación/reivindicaciones ... por tanto implica(n) una actividad inventiva. |
| <i>Explanation: Better clarity of French translation.</i> | | | |

BOX VIII/ CADRE VIII/ RECUADRO VIII

| | Clause | Formulation | Cláusula |
|--|---|---|---|
| | Article 5 | Article 5 | Artículo 5 |
| VIII.1 | The description does not comply with PCT Article 5. | La description n'est pas conforme aux dispositions de à l'article 5 PCT. | La descripción no cumple con el Art. 5 PCT. |
| <i>Explanation: Simplification of text and better alignment between different language versions.</i> | | | |
| VIII.2 | The description does not disclose the invention in a manner sufficiently clear and complete to be carried out by a person skilled in the art. [Add explanation] | La description n'expose pas l'invention d'une manière suffisamment claire et complète pour qu' un homme <u>une personne</u> du métier puisse l'exécuter. [Ajouter l'explication] | La descripción no divulga la invención de una manera suficientemente clara y completa para que pueda ser realizada por un experto en la materia. [Añadir explicación] |
| <i>Explanation: Replacement with gender-neutral term</i> | | | |
| | Article 6 | Article 6 | Artículo 6 |
| VIII.3 | Claim(s) ... do(es) not comply with PCT Article 6. | La revendication/les revendications ... ne remplit/remplissent pas les <u>n'est pas conforme/ne sont pas conformes aux</u> conditions énoncées à l'article 6 PCT. | La(s) reivindicación/reivindicaciones ... no cumple(n) con el Art. 6 PCT. |

| <i>Explanation: Better alignment between different language versions.</i> | | | |
|---|--|--|--|
| | <u>Support</u> | <u>Fondement</u> | <u>Fundamento</u> |
| | Essential feature of the invention not in the claims | Caractéristique essentielle de l'invention absente des revendications | Las reivindicaciones no contienen una característica esencial de la invención |
| VIII.4 | The description indicates [describe missing essential feature(s)] on page(s) ... to be an essential feature of the invention. This feature is not recited in claim(s) ... | Il ressort de la page/des pages ... de la description que [décrire la/les caractéristiques essentielles manquantes] est/sont une caractéristique/des caractéristiques essentielle(s) de l'invention. La revendication/les revendications ... ne contient/contiennent pas cette/ces caractéristique(s). | En la(s) página(s) ... de la descripción se indica que [describir las características esenciales faltantes] es/son una característica(s) esencial(es) de la invención. Esta(s) característica(s) no está(n) recogida(s) en la(s) reivindicación/reivindicaciones |
| VIII.5 | The description indicates on page(s) ... that [describe missing essential feature(s)] materially affects the way the invention works, and is therefore essential. This feature is not recited in claim(s) | Il ressort de la page/des pages ... de la description que [décrire la/les caractéristique(s) essentielle(s) manquante(s)] est/sont indispensable(s) au fonctionnement de l'invention. Elle/elles est/sont donc essentielle(s) à l'invention. La revendication/les revendications ... ne contient/contiennent pas cette/ces caractéristique(s). | En la(s) página(s) ... de la descripción se indica que [describir las características esenciales faltantes] es/son necesarias(s) para el funcionamiento de la invención, y es/son por lo tanto esencial(es). Esta(s) característica(s) no está(n) recogida(s) en la(s) reivindicación/reivindicaciones |
| | Element in claim missing from the description | Elément des revendications absent de la description | Ausencia de elementos reivindicados en la descripción |
| VIII.6 | Claim(s) ... is/are not fully supported by the description. Specifically (describe missing element) is not present in the description. | La revendication/les revendications ... ne se fonde/fondent pas entièrement sur la description. En particulier, [décrire l'élément manquant] n'apparaît pas dans la description. | La(s) reivindicación/reivindicaciones ... no está (n) enteramente soportada(s) en la descripción. Concretamente, [insertar el/los elemento(s) faltante(s)] no figura(n) en la descripción. |

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| | Operative range of claim outside that of description | Intervalle défini dans une revendication se situant en dehors de celui de la description | El rango operativo reivindicado está fuera del mencionado en la descripción |
| VIII.7 | Claim(s) ... describe(s) a range which is out of the operative range disclosed in the description on page(s) ... [Add explanation]. | La revendication/les revendications ... décrivent un intervalle qui se situe en dehors de l'intervalle divulgué à la page/aux pages ... de la description. [Ajouter l'explication]. | En la(s) reivindicación/reivindicaciones ... se describe un rango que está fuera del divulgado en la(s) página(s) ... de la descripción. [Añadir explicación]. |
| | Claim excessively broad without solving problem | Portée de la revendication trop vaste, n'apportant pas de solution au problème | Reivindicaciones demasiado amplias que no resuelvan ningún problema |
| VIII.8 | Claim(s) ... include(s) a broad statement that includes all possible means without qualification for solving the problem facing the inventor. This/These claim(s) therefore merely re-state(s) the problem or the desired result. | La revendication/les revendications ... comporte(nt) une déclaration d'ordre général qui couvre tous les moyens possibles sans spécifier de quelle manière est résolu le problème auquel l'inventeur est confronté. Cette revendication/ces revendications se contente(nt) ainsi simplement d'énoncer de nouveau le problème ou le résultat souhaité. | La(s) reivindicación/reivindicaciones ... están redactadas de manera excesivamente amplia incluyendo todos los medios posibles sin justificar cómo se resuelve el problema planteado. La(s) reivindicación/reivindicaciones ... es/son el mero enunciado del problema planteado o del resultado que se pretende conseguir. |
| | <u>Clarity and conciseness</u> | <u>Clarté et concision</u> | <u>Claridad y concisión</u> |
| | Lack of conciseness | Manque de concision | Falta de concisión |
| VIII.9(a) | Claim(s) ... is/are not concise. | La revendication/les revendications ... n'est/ne sont pas concise(s)/ manque(nt) de concision . | La(s) reivindicación/reivindicaciones ... no es/son concisa(s). |
| VIII.9(b) | Claims ... are not concise. The number of claims shall be reasonable in consideration of the nature of the invention claimed (PCT Rule 6.1(a)). | Les revendications ne sont pas concises. Il sera considéré que le nombre de revendications est raisonnable compte tenu de la nature de l'invention revendiquée (règle 6.1(a) PCT). | Las reivindicaciones ... no son concisas. El número de las reivindicaciones deberá ser razonable, teniendo en cuenta la naturaleza de la invención reivindicada (Regla 6.1(a) PCT). |

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| VIII.10 | Claim(s) ... is/ are not concise. The claims are identical or are so close in content that these claims address the same subject matter. | La revendication/les <u>Les</u> revendications ... n'est/ne sont pas concise(s)/ manque(nt) de concision . Les revendications sont identiques ou ont une teneur si proche qu'elles couvrent le même objet. | La(s) reivindicación/ reivindicaciones ... no es/son concisa(s). Las reivindicaciones son idénticas o son tan parecidas en su contenido que cubren el mismo objeto. |
| <i>Explanation: The requirement that the claims should be concise refers to the claims in their entirety as well as to the individual claims (paragraph 5.42 of the Guidelines). VIII.9(a) should be used where one or more claims are, in themselves, not concise. VIII.9(b) should be used where the claims, as a whole are not concise because of undue numbers. VIII.10 should be used where two or more claims are identical or very close in content. Better alignment between different language versions.</i> | | | |
| | Lack of clarity | Absence de clarté | Falta de claridad |
| VIII.11 | Claim(s) ... is/are not clear. The term/expression [describe term/expression] is not clear from the description. | La revendication/les revendications ... n'est/ne sont pas claire(s). Le terme/l'expression [insérer le terme/l'expression] n'est pas clair(e) à la lumière de la description. | La(s) reivindicación/reivindicaciones ... no es/son claras. El término/la expresión [insertar el término/la expresión] no se explica claramente en la descripción. |
| VIII.12 | Claim(s) ... is/are not clear. The term/expression [describe term/expression] is used in the claim(s) to mean [enter meaning], which does not have a well-recognized meaning in the art. | La revendication/les revendications ... n'est/ne sont pas claire(s). Le terme/l'expression [insérer le terme/l'expression] est utilisé(e) dans la revendication/les revendications dans le sens de [insérer la signification], ce qui n'a pas un sens bien établi dans la technique considérée. | La(s) reivindicación/reivindicaciones ... no es/son claras. El término/la expresión [insertar el término/la expresión] se utiliza en la(s) reivindicación/reivindicaciones con el significado [insertar significado] que no está generalmente reconocido en el ámbito técnico. |
| VIII.13 | Claim(s) ... is/are not clear. The term/expression [describe term/expression] is ambiguous. | La revendication/les revendications ... n'est/ne sont pas claire(s). Le terme/l'expression [insérer le terme/l'expression] est ambigu(ë). | La(s) reivindicación/reivindicaciones ... no es/son claras. El término/la expresión [insertar el término/la expresión] es ambiguo/ambigua. |

[Annex II follows]

PROPOSED MODIFICATIONS
OF THE INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

Chapter 17
**Content of Written Opinions and the International Preliminary
Examination Report**

17.01 to 17.55 *[No change]*

Standardized Clauses

[17.55A](#) [A set of standardized clauses has been established for facilitating the preparation of the opinion or report. International Searching and Preliminary Examining Authorities are encouraged to recommend the use of these clauses to examiners in cases where they are appropriate. The examiner should, however, always be free to make appropriate modifications or use alternative text, particularly where this is considered to fit the context better or express an opinion more effectively. The clauses have been established in English and in the languages of International Authorities which have indicated that they will recommend the use of these clauses to their examiners. The latest version of the clauses can be found on the WIPO website¹. Modifications to the clauses may be established by the International Bureau following consultation with the International Searching and Preliminary Examining Authorities. Modifications to translations of the clauses may be adopted following consultation between the International Bureau and the Authorities which establish reports in the language concerned.](#)

17.56 to 17.73 *[No change]*

[End of Annex II and of the Circular]

¹ Link to webpage where clauses will be listed.