

# WIPO



PCT/MIA/17/6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PATENT COOPERATION TREATY (PCT)

Seventeenth Session  
Rio de Janeiro, February 9 to 11, 2010

INTRODUCTION OF A FORM FOR INFORMAL  
CLARIFICATION BEFORE SEARCH

*Proposal by the Japan Patent Office*

## OUTLINE OF THE PROPOSAL

1. The Japan Patent Office (JPO) agrees with the concept of making “informal clarification before search” (stipulated in the PCT Guidelines<sup>1</sup> paragraphs 9.34 and 9.35) more usable for the International Searching Authority (ISA), as proposed by the European Patent Office (EPO) in the sixteenth session of the Meeting<sup>2</sup>. To that end, the JPO proposes to establish a form for informal clarification before search as described in detail below. This proposal will help to enhance the quality and efficiency of international search, to make subsequent examination procedures less burdensome, and to improve the usability of the international search report for International Authorities as well as designated Offices in a manner which needs no change of any PCT Regulations.

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<sup>1</sup> PCT International Search and Preliminary Examination Guidelines

<sup>2</sup> PCT/MIA/16/11, paragraphs 2 to 10

## UTILITY OF THE “INFORMAL CLARIFICATION BEFORE SEARCH”

2. As stipulated in the PCT Guidelines paragraph 9.34, “[i]n the event that the description, claims, or drawings fail to comply with a requirement, such as clarity or support of the claims by the description, to such an extent that no meaningful search in an international stage can be made, the International Searching Authority may, where appropriate, ask the applicant informally for clarification before declaring that no international search report will be established.”

3. There are certain benefits, as follows, for examiners and applicants in clarifying the concept of the invention, when necessary, through informal communication before search:

(i) Reducing the workload for the ISA by relieving examiners from the “trial and error” search arising from insufficient understanding of the claimed invention.

(ii) Improving the quality of the international search report and written opinion of the International Searching Authority by citing more appropriate documents for the international search report based on examiners’ better understanding of inventions.

4. Therefore, an informal clarification before search at the international search stage may contribute to improving the utility of the international search report and written opinion so as to reduce workload of examiners.

## MERIT OF THE FORM FOR “INFORMAL CLARIFICATION BEFORE SEARCH”

5. While form PCT/IPEA/428 is provided for “informal communications with the applicant,”<sup>3</sup> at the international preliminary examination stage, there is presently no form provided for International Searching Authorities conducting “informal clarification before search” at the international search stage. The lack of such a form can be considered to be one reason that the informal clarification practice is not often used<sup>4</sup>.

6. In this proposal, the JPO would like to introduce a form for “informal clarification before search” for the following reasons, considering that such a form will motivate examiners, where appropriate, to make an “informal clarification before search”:

(i) Providing a certain form streamlines the examination procedure; i.e. each examiner does not have to prepare his/her original format to record the communication.

(ii) Introducing the form itself works to remind examiners of the practice of making “informal clarification before search”: The existence of the form will easily be recognized as forming part of the international search procedure.

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<sup>3</sup> PCT Rule 66.6; PCT Guidelines paragraphs 19.31 to 19.33

<sup>4</sup> According to paragraph 8 of PCT/MIA/16/11, “[t]hese enabling clauses for asking informal clarification during the Chapter I procedure has so far never been used” at the EPO.

7. Thus, the introduction of the form, which will simplify the examiners' work and clarify the practice being as one of the international search procedure, can encourage the examiners to make "informal clarification." In this regard, since 2004, the JPO has introduced its original form which the JPO examiners have been taking advantage of, and the usefulness of the form has been already demonstrated. In addition, the introduction of the form does not need any amendment of current regulations, so this proposal has a great benefit with minimum changes.

8. It seems that the EPO would like to introduce a substantive communication process for informal clarification including applicant's reply within a prescribed period<sup>5</sup>. However, such communication process should better be flexible and simple, such as through telephone and interview, in light of the limited time period for search. Then, it may (must) be sufficient to record the "results" of the communication on the prescribed form. This is the same concept as the current PCT regulation 66.6 which allows examiners flexible communication with applicants and the form PCT/IPEA/428 is for recording the result of the communication.

#### CONTENTS OF THE PROPOSAL

9. A new form corresponding to the PCT Guidelines 9.34 and 9.35 should be established. Items based on IPEA/428 could be brought in for a new form. Annex I shows the draft form of this proposal. Comparing with current PCT/IPEA/428, shown in Annex II, you may understand that this form is identical to PCT/IPEA/428, except the following items:

- (1) Title of the form.
- (2) Code of the form (bottom left).
- (3) Eliminating checkboxes regarding PCT/IPEA/427, PCT/IPEA/429.

10. For information, the JPO has already introduced its own internal form (called "Additional Form 4") which is similar to PCT/IPEA/428 since 2004. It is shown in Annex III.

*11. The Meeting is invited to comment on the proposals put forward in this document.*

[Annexes follow]

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<sup>5</sup> PCT/MIA/16/11, paragraph 5

ANNEX I

PROPOSED FORM FOR "INFORMAL CLARIFICATION BEFORE SEARCH"

PATENT COOPERATION TREATY

**PCT**

NOTE ON INFORMAL CLARIFICATION BEFORE SEARCH

(PCT International Search and Preliminary Examination Guidelines 9.34)

International application No.	Applicant's or agent's file reference	Date of informal communication <i>(day/month/year)</i>
Applicant		
<u>Communication</u>  <input type="checkbox"/> by telephone  <input type="checkbox"/> personal	<u>Participants</u>  <input type="checkbox"/> Applicant:  <input type="checkbox"/> Agent:  <input type="checkbox"/> Examiner(s):	<input type="checkbox"/> identity checked <input type="checkbox"/> authorization checked <input type="checkbox"/> personally known
<u>Summary of communication:</u>  <div style="height: 300px;"></div>		
Applicant/Agent	Authorized officer of ISA/  Telephone No.	

Form PCT/ISA/\*\*\* (\*\*\* 2010)

[Annex II follows]



ANNEX III

REFERENCE 2: "ADDITIONAL FORM 4" CURRENTLY USED BY THE JPO

<p><b>PATENT COOPERATION TREATY</b>  <b>PCT</b>  <b>NOTE ON INFORMAL COMMUNICATION WITH THE APPLICANT</b>  <b>(INTERNATIONAL SEARCH STAGE)</b></p>		
International application No. PCT/JP XXXX /XXXXXX	Applicant's or agent's file reference PCTXXXXXXXXXX	Date of informal communication <i>(day/month/year)</i> XX/XX/XXXX
Applicant XXXXXXXXX		
Communication <input checked="" type="checkbox"/> by telephone <input type="checkbox"/> personal	Participants <input type="checkbox"/> identity checked <input type="checkbox"/> authorization checked <input type="checkbox"/> personally known <input checked="" type="checkbox"/> Applicants: XXXXXX XXXXXX <input type="checkbox"/> Agent: <input checked="" type="checkbox"/> Examiner(s): XXXXXX XXXXXX	
Summary of the Communication: <p>The examiner asked the applicant for explanation about support by the description about the 4th paragraph of Claim 1 and the 7th paragraph of Claim 7.                  The applicant explained that Claim 1 was supported by paragraphs 0014, 0048-0049 and 0068-0069 and Claim 7 was supported by paragraphs 0014, 0048-0049, 0051 and 0122.                  The examiner suggested that the paragraph 0048 etc. were not the statement about a gate insulating layer but the statement about a semiconductor layer.</p>		
Applicant/Agent Seal	Authorized officer XXXXXX XXXXXX Seal Telephone No. +81-3-3581-1101 Ext. XXXX	XX XXXX

Additional Form 4 (March 2006)