

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twentieth Session
Munich, February 6 to 8, 2013**

PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

Document prepared by the International Bureau

1. A thorough revision of the then separate sets of Guidelines for International Search and International Preliminary Examination, respectively, was undertaken by the Meeting up to 2004, particularly in response to major changes that had been introduced into the PCT system (notably, the enhanced search and examination system under the PCT), and also taking into account the practices of the various International Authorities. As a result, combined PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) were promulgated as document PCT/GL/ISPE/1 dated March 11, 2004, entering into force on March 25, 2004.
2. A number of matters have since arisen which require further modifications to be considered. Two of these matters have already been taken into account in modifications made since document PCT/GL/ISPE/1 was issued, namely, the common quality framework, and the making of third party observations. These modifications are reflected, respectively, in document PCT/GL/ISPE/2 dated October 3, 2011, which entered into force on November 1, 2011, and in document PCT/GL/ISPE/2 Add. dated June 22, 2012, which entered into force on July 1, 2012.
3. The Meeting has considered proposed modifications of the Guidelines at several of its sessions since 2004, notably relating to the supplementary international search system that was introduced in 2009, but also on a number of other matters. Certain proposals have also been the subject of consultation by way of PCT Circulars.

4. A consolidated draft of the Guidelines, taking into account all the outstanding issues previously discussed, comments on previous drafts and certain new points, has now been prepared in the form of document PCT/GL/ISPE/3 Prov., attached as an Annex to the version of Circular C. PCT 1371 dated January 31, 2013 available on the WIPO web site at <http://www.wipo.int/pct/en/circulars/index.html>. The text of this Circular without its Annex is reproduced in the Annex to the present document.

5. The International Bureau regrets the difficulties caused by the fact that so many of the previously proposed modifications have not yet been incorporated into the Guidelines. The International Bureau now has in place the resources to deal with modifications more effectively. Once the “backlog” of changes which are the subject of the current consultation has been cleared, the International Bureau will generally issue consultation circulars concerning modifications which appear to be required as a result of amendments to the Regulations in the same way and according to the same timescales which apply to equivalent modifications to the PCT Administrative Instructions and the Receiving Office Guidelines.

6. It will, of course, remain possible to bring proposals for modifications to the Meeting, which may be the most appropriate way to discuss certain types of modification, such as dealing with the issues where differences in practices between Authorities are set out in appendices.

7. The Meeting is invited to note the steps that have been taken for consultation on a broad package of proposed modifications of the PCT International Search and Preliminary Examination Guidelines by way of Circular C. PCT 1371 and document PCT/GL/ISPE/3 Prov., as well as for future revisions.

[Annex follows]

PROPOSED MODIFICATIONS OF THE
PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES
(reproduced from Circular C. PCT 1371)

C.PCT 1371

January 31, 2013

Madam,
Sir,

Proposed modifications of the PCT International Search and Preliminary Examination Guidelines

1. This Circular is addressed to your Office in its capacity as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT) for the purposes of consultation on proposed modifications of the PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) as set out in document PCT/GL/ISPE/3 Prov. An electronic version of document PCT/GL/ISPE/3 Prov. is available on WIPO’s website at http://www.wipo.int/pct/en/circulars/2013/1371_ax.doc as an Annex to the electronic version of this Circular.
2. The current version of the Guidelines appears in document PCT/GL/ISPE/2 dated October 3, 2011, as in force from November 1, 2011, as subsequently modified by document PCT/GL/ISPE/2 Add. dated June 22, 2012, which entered into force on July 1, 2012. Both documents are available on WIPO’s website at <http://www.wipo.int/pct/en/texts/gdlines.html>.
3. The Guidelines as in force prior to November 1, 2011, were as set out in document PCT/GL/ISPE/1 dated March 11, 2004, which entered into force on March 25, 2004. That document incorporated the results of extensive work that had been undertaken by the Meeting of International Authorities under the PCT (“MIA”). It amalgamated the previously separate sets of Guidelines relating to international search and to international preliminary examination, respectively, and included a large number of modifications reflecting changes that had been introduced into the PCT system as well as the practices of the various Authorities.
4. The modifications more recently included by way of documents PCT/GL/ISPE/2 and 2 Add. related to the *common quality framework* (replacing the text of Chapter 21 by a new text) and the making of *third party observations* (with the addition of three new paragraphs). Apart from those modifications, there is a backlog of other matters requiring modification of the Guidelines including, perhaps most notably, the introduction of the *supplementary international search* system in 2009.
5. Most of the topics addressed by proposed modifications or annotations in document PCT/GL/ISPE/3 Prov. have already been the subject of some discussion and/or consultation. Proposals on substantive matters generally derive from reports of and documents considered by MIA, and/or PCT Circulars issued by the International Bureau, but regard has also been had to amendments of the PCT Regulations adopted by the PCT Assembly since March 2004 and to the reports of the PCT Working Group, which first met in 2008.
6. The main areas affected by the proposed modifications relate to adjustments needed to the *enhanced search and examination system*, the recently introduced *supplementary international search* system, and the provisions for *rectification of obvious mistakes*.

7. Explanatory notes have been included as footnotes in document PCT/GL/ISPE/3 Prov. to indicate briefly, where appropriate, the nature and/or source of the particular proposals. More detailed explanation can generally be found in the source documents concerned. Certain matters that have been raised but not discussed by Authorities in a substantive way (for example, as noted in the reports of MIA sessions) are also the subject of annotations in the footnotes. Some of those matters may, as a result of the present consultation, mature into modifications to be incorporated in the body of the text of the Guidelines. In other instances, comments are made in footnotes to flag the fact that further work appears to be needed in order to progress consideration of a matter.

8. All of the footnotes are intended to facilitate consultation rather than contribute to the substance of the Guidelines themselves, and will be removed in the course of the preparation of the final version of the modifications to be promulgated in the form of document PCT/GL/ISPE/3.

9. A considerable number of drafting, formatting and editorial changes also appear in document PCT/GL/ISPE/3 Prov., including changes made in some instances to text that has already been the subject of consultation. In general, no specific explanation is given for such changes where the reasons for their inclusion are self-evident.

10. A continuous numbering system for paragraphs in the document is used, in instances where new paragraphs are proposed to be inserted, rather than adding suffixes to existing paragraph numbers. It would be desirable to use a more consistent and workable system for the numbering of paragraphs in the appendixes that are included in certain chapters. Such a system may be implemented when document PCT/GL/ISPE/3 is being finalized.

11. Your Office is invited to provide comments on the proposed modifications of the Guidelines as set out in document PCT/GL/ISPE/3 Prov. to the International Bureau, by May 31, 2013, preferably by e-mail sent to my colleague Mr. Claus Matthes, Director, PCT Business Development Division (claus.matthes@wipo.int; fax: (+41-22) 338 7150; tel: (+41-22) 338 9809).

Yours sincerely,

James Pooley
Deputy Director General

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