

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

Twenty-First Session
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TREATMENT OF A SEQUENCE LISTING SUBMITTED IN AN INTERNATIONAL APPLICATION ON THE INTERNATIONAL FILING DATE

Document submitted by the United States Patent and Trademark Office

SUMMARY

1. This document discusses the problems that can occur when the applicant incorrectly indicates or does not indicate a sequence listing to be part of the international application, and whether the current framework provides adequate remedy in these situations.

BACKGROUND

2. Proper characterization of an image or text format sequence listing for an international application can be confusing for applicants. Too frequently, applicants are unaware of the need to indicate that a sequence listing is part of the international application in the Check List of the Request, or improperly indicate it as an accompanying item only. When the error is recognized during the pendency of the international application, the receiving Office (RO) may make an *ex officio* correction or allow the applicant to make a correction of the Check List. However, often the error is not recognized until national or regional phase, when the RO would not normally allow correction, since the international phase has concluded. Such an error may have fatal consequences in the national or regional phase where the disclosure does not otherwise provide sufficient information regarding the sequences.

3. Proper characterization of an image or text format sequence listing for an international application can be confusing also for International Searching, Supplementary International Searching, and International Preliminary Examining Authorities. The sequence listing portion of forms issued by these authorities should indicate whether the sequence listing was filed or furnished "in the international application as filed," "together with the international application in electronic form," or subsequently to this Authority for the purposes of search (and/or

examination).” This indication is, with some frequency, inconsistent with the indications on the Request. The United States Patent and Trademark Office (USPTO) has proposed changes to the language used in these forms.

4. Finally, proper characterization of an image or text format sequence listing seems to be an area of confusion also for the International Bureau regarding publication of the international application. On occasions, international applications have been incorrectly published: a) without any indication of a sequence listing part of the international application; b) with a sequence listing indicated as part of the application, when it should not have been indicated as such; or c) with an indication of the wrong format, i.e. image or text, as part of the application.

LEGAL PROVISIONS

5. PCT Rule 5.2 *Nucleotide and/or Amino Acid Sequence Disclosure*

(a) Where an international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing...presented as a separate part of the description...

PCT Rule 3.3 *Check List*

(a) The Request shall contain a list indicating:

(i) the total number of sheets constituting the international application and the number of sheets of each element of the international application: ...description (separately indicating the number of sheets of any sequence listing part of the description)...

(b) The list shall be completed by the applicant, failing which the receiving Office shall make the necessary indications...

6. The PCT Regulations require a sequence listing part of the international application where the application contains a disclosure of sequences. Further, the Regulations require that if applicant does not complete the Check List, the RO shall make the indications, including those for the sequence listing. Therefore, the Regulations seem to imply that if a sequence listing is present, it is deemed part of the international application, and its inclusion in the Check List is simply a formality, rather than a definitive indication of its status as part of the application or as an accompanying item.

ISSUES

7. To alleviate these issues regarding proper characterization of a sequence listing, the USPTO invites Authorities and the International Bureau to consider and comment on the following:

- Whether or not the current situation is perceived as problematic;
- Whether an Office, in its capacity as a designated Office, has encountered problems with regard to this issue;
- Whether the automatic inclusion of a sequence listing provided on the international filing date in either image or text format as part of an international application, is perceived as a simplification for applicants, Offices, and the International Bureau;
- Whether PCT Rules 5.2 and 3.3 are sufficient legal basis for such treatment, or whether other changes are needed in the Regulations, Administrative Instructions, or International Search and Preliminary Examination Guidelines.

8. *The Meeting is invited to consider and comment on the issues in paragraph 7.*

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