

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

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REQUIREMENTS UNDER RULE 6.4

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BACKGROUND

1. The Korean Intellectual Property Office (KIPO) as an International Authority felt that some issues relating to requirements under PCT Rule 6.4 may not be clearly addressed in the Regulations or in the PCT International Search and Examination Guidelines (hereinafter referred to as "the Guidelines").
2. Furthermore, through consultations with some other Authorities and the International Bureau (IB), it realized that there are discrepancies in the practices of each International Authority and concluded that further clarifications on those requirements need to be provided in the Guidelines.
3. KIPO would like to invite other Authorities to share their views on the following cases and to consider proposed modifications to the Guidelines as set out in the Annex to this document.

NON-DEPENDENT CLAIMS MAKING REFERENCE TO OTHER CLAIM(S)

4. Paragraph 5.19 of the Guidelines indicates that all claims referring to other claim(s) are not dependent claims, reading "A claim may also contain a reference to another claim even if it is not a dependent claim as defined in Rule 6.4." However, current Rule 6.4 does not explicitly address non-dependent claims making reference to other claims.
5. Considering Rule 6.4(a) aims at preventing unnecessary confusion from ambiguous or overly complicated references, the following requirements in the second and third sentences of Rule 6.4(a) may have to be extended to non-dependent claims making reference to other claims(s): (1) the requirement that reference shall be made in the alternative; and 2) prohibition

of multiple dependent claims from serving as a basis for any other multiple dependent claim. It should be also noted that if those requirements are applied only to dependent claims; examiners will have additional workload to decide whether the claim is dependent or not.

6. During informal consultations, some Authorities agreed with KIPO that those requirements should be extended to such claims.

7. It is proposed to add paragraph 5.19*bis* in the Guidelines clarifying that Authorities may decide to apply those requirements to claims which are non-dependent yet making reference to other claim(s) in case their respective national laws do so.

A MULTIPLE DEPENDENT CLAIM IN EFFECT SERVING AS A BASIS FOR ANOTHER MULTIPLE DEPENDENT CLAIM

8. KIPO examiners reported actual cases of a multiple dependent claim serving as a basis for a non-multiple dependent claim, but in effect serving as a basis for another multiple dependent claim.

An example of these cases is:
Claim 3 referring to claim 1 or 2;
Claim 4 referring to claim 3;
and Claim 5 referring to claim 2 or 4.

Multiple dependent claim 3 does not serve as a basis for a multiple dependent claim, as it serves as a basis for claim 4. However, claim 4 serves as a basis for claim 5 which is a multiple dependent claim. Therefore, multiple dependent claim 3, in effect, serves as a basis for another multiple dependent claim, claim 5.

9. On this issue, all Authorities answered to KIPO, which apply the requirement of the third sentence of Rule 6.4(a), explained that they apply the requirement to such claims. Considering the intent of the provision, KIPO agrees with those Authorities that such claims can be grounds of indication under Article 17(2)(b) if the Authority applies the requirement.

10. It is proposed to add paragraph 9.41*bis* to clarify that requirement under the third sentence of Rule 6.4(a) may be applied to such cases if the Authority applies this requirement.

A DEPENDENT CLAIM MAKING REFERENCE TO ITSELF, E.G. CLAIM 1 REFERRING TO CLAIM 1

11. KIPO found that there are discrepancies in the practice of Authorities on such claims. Some Authorities do not apply Rule 6.4 and view them as not complying with Article 6 since they are not clear on which claim they make reference to. Two of those Authorities explained that they consider such a claim is not a dependent claim according to Rule 6.4(a) since it does not include features of one or more *other* claims. Therefore, the requirement of Rule 6.4 cannot be applied.

12. Meanwhile, an Authority answered that it views such claims are considered not to comply with Rule 6.4(c) as they are not "referring back" to a previous claim.

13. In KIPO's view, Rule 6.4(c) is to recommend methodology of grouping dependent claims, rather than to provide obligation on how claims should be referred. Therefore, it proposes adding paragraph 5.19*ter* with a general principle that claims making ambiguous reference to other claims or itself and not complying with Article 6 may form grounds of indication under Article 17(2)(b).

A CLAIM MAKING REFERENCE TO SUCCEEDING CLAIM(S), E.G. CLAIM 1 REFERRING TO CLAIM 3

14. In KIPO's view, Rule 6.4 does not explicitly prohibit these claims. However, some examiners at KIPO were confused since Rule 6.4(c) states "All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims" and they thought it might mean that a dependent claim shall refer back to previous claim(s).

15. Two of the Authorities contacted by KIPO answered that they treat such claims as not complying with Rule 6.4(c) for the same reason with those KIPO examiners. However, another Authority viewed that Rule 6.4(c) is to simply provide for a preferred claims grouping and does not preclude a dependent claim from referring to succeeding claim(s).

16. KIPO believes that Rule 6.4 is not designed to preclude such claims, and as long as the claim itself is clear, a search may be performed. A clarification by introducing paragraph 5.19*quater* in the Guidelines is proposed in the Annex to this document.

17. One of the Authorities which did not share the view of KIPO on this topic, proposed an alternate text of paragraph 5.19*quater*. The text is also included in the Annex for discussion.

INTERPRETATION OF PARAGRAPH 9.41 OF THE GUIDELINES

18. The paragraph reads:

"9.41 Where an international application contains multiple dependent claims drafted in a manner different from that provided for in Rule 6.4(a), second and third sentences, the International Searching Authority may make an indication under Article 17(2)(b). Such an indication, however, is only made if and to the extent to which a meaningful search is not possible. The latter applies also in the case where the national law of the Office acting as International Searching Authority does not allow multiple dependent claims to be drafted in the said different manner. Such a case is also noted in the written opinion, and it will of course only be possible to establish a written opinion or international preliminary examination report on novelty and inventive step to the extent that the claims have in fact been searched."

19. KIPO finds it unclear what "the latter" in paragraph 9.41 refers to.

(1) If it refers to "the International Searching Authority may make an indication under Article 17(2)(b)", the ISA, of which national law does not allow multiple dependent claims to be drafted in the said different manner, can make such indication regardless of whether a meaningful search is possible.

(2) On the other hand, if "the latter" refers to "Such an indication, however, is only made if and to the extent to which a meaningful search is not possible", the ISA cannot make the indication if a meaningful search is possible.

20. In KIPO's view, this leads to an issue relating to implementation of Rule 6.4(a) at each Authority with its national law not allowing said multiple dependent claims. If interpretation (1) is pursued, the Authority may set up a universal principle requesting its examiners to make an indication under Article 17(2)(b) whenever they find such claims. However, if interpretation (2) is followed, an indication under Article 17(2)(b) indication should be made at the discretion of the examiner regardless of its national law prohibiting such claims.

21. During informal consultations with the IB and some Authorities, it was found that there exist different understandings of the paragraph, and all respondents agreed to the necessity of clarification.

22. If a meaningful search is possible, it is not advisable to give an examiner obligation to make an indication under Article 17(2)(b), as the search, if performed, would be useful to both the applicant and the public. However, it should be also noted that Rule 6.4(a) allows Authorities freedom to make the indication where their respective national law does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a).

23. Therefore, it is proposed to modify paragraph 9.41 of the Guidelines to clarify that a search may be performed if and to the extent possible even if the national law does not allow dependent claims drafted in a manner different from the second and third sentences of Rule 6.4(a). It should be also noted that the proposed modified paragraph does not preclude possibility of indication under Article 17(2)(b) in case a meaningful search is possible.

24. International Authorities are invited to comment on the proposals set out in this document and its Annex.

[Annex follows]

PROPOSED MODIFICATIONS FOR THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES CONCERNING REQUIREMENTS UNDER PCT RULE 6.4

1. It is proposed to add the following paragraph to address the issue of non-dependent claims making reference to other claim(s):

5.19bis There may be claims which are not dependent claims but make reference to other claim(s). Where an international application contains such claims drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Searching Authority may make an indication under Article 17(2)(b) if such claims are not allowed by its national law.

2. It is proposed to add the following paragraph to clarify that a multiple dependent claim serving in effect as a basis for a non-multiple dependent claim may be prohibited under Rule 6.4(a).

9.41bis The decision on whether a multiple dependent claim is drafted in a manner different from that provided for in the third sentence of Rule 6.4(a) should be made based on whether the claim in effect serves as a basis for another multiple dependent claim, either directly or indirectly. For instance, a multiple dependent claim serving as a basis for a non-multiple dependent claim, but in effect serving as a basis for another multiple dependent claim may form grounds of indication under Article 17(2)(b) if the national Office acting as International Searching Authority applies the third sentence of Rule 6.4(a).

An example of these cases is:
Claim 3 referring to claim 1 or 2;
Claim 4 referring to claim 3;
And Claim 5 referring to claim 2 or 4.

Multiple dependent claim 3 does not directly serve as a basis for a multiple dependent claim, as it serves as a basis for claim 4. However, claim 4 serves as a basis for claim 5 which is a multiple dependent claim. Therefore, multiple dependent claim 3, in effect, serves as a basis for another multiple dependent claim (claim 5).

3. It is proposed to add the following paragraph on claims with ambiguous reference(s).

5.19ter In case where it is not clear which claim(s) a claim refers to, the International Searching Authority may make an indication under Article 17(2)(b) for that claim if it does not comply with Article 6. A claim making reference to itself (e.g. claim 2 referring to claim 2) can be an example. However, it should be noted that if it is obvious to the examiner which claim the applicant intended to make reference to, search on the claim may be performed.

4. It is proposed to add the following paragraph on claims with reference to succeeding claims

5.19quater It should be noted that Rule 6.4(c) is to provide a regulation on the way for dependent claims referring back to previous claim(s) to be grouped rather than to provide obligation that claims shall refer back to a single previous claim. For example, claim 2 referring to claim 3 is considered to comply with Rule 6.4(c).

[Alternate text for discussion]

5.19^{quater} A dependent claim making reference to a succeeding claim, e.g. claim 2 referring to claim 3, is considered not to comply with Rule 6.4(c), which explicitly uses the terminology “referring back to a single/several previous claim(s)”. Such a claim may be objected to under Article 6 and Rule 6.4(c), because the arrangement of claims is such as to create obscurity in the definition of the subject-matter to be protected.

5. Following modification to paragraph 9.41 is proposed for clarification.

9.41 Where an international application contains multiple dependent claims drafted in a manner different from that provided for in Rule 6.4(a), second and third sentences, the International Searching Authority may make an indication under Article 17(2)(b). ~~Such an indication, however, is only made if and to the extent to which a meaningful search is not possible. The latter applies also~~ Even in the case where the national law of the Office acting as International Searching Authority does not allow multiple dependent claims to be drafted in the said different manner, a search may be performed if and to the extent to which a meaningful search is possible. Such a case is also noted in the written opinion, and it will of course only be possible to establish a written opinion or international preliminary examination report on novelty and inventive step to the extent that the claims have in fact been searched.

[End of Annex and of document]