

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

Twenty-Ninth Session
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FORMALITIES CHECKING IN THE PCT

Document prepared by the International Bureau

SUMMARY

1. The Meeting is invited to comment on aspects of formalities checking that affect the ability of International Searching Authorities (ISAs) to conduct effective international search, as well as to consider options for modifying the role of International Authorities that might make international phase processing more effective.

BACKGROUND

2. At the twenty-seventh session of the Meeting of International Authorities under the PCT in February 2020, the United States Patent and Trademark Office prepared a document discussing the handling of informal drawings in international applications (document PCT/MIA/27/14). This document proposed adding guidance to Form PCT/RO/106 to invite the applicant to correct defects in the international application by explaining the limitations of the receiving Office in its competence to check and correct defects under the procedure in Rule 26.4, and suggesting alternatives to file replacement drawings before the ISA or International Preliminary Examining Authority (IPEA). Specifically, the proposed guidance explained the possibility for an applicant to request the rectification of an obvious mistake at the ISA or IPEA under Rule 91, or to file amendments under Article 34 before the IPEA. Moreover, paragraph 14 of the document proposed a set of attributes for receiving Offices to determine the extent of compliance with the physical requirements of Rule 11 necessary for the purpose of reasonably uniform publication under Rule 26.3(a)(i). However, the Meeting considered that further work was required to clarify the proposals and to present them as part of a more holistic package of measures.

3. The discussions of document PCT/MIA/27/14 are summarized in paragraphs 51 to 54 of the Summary by the Chair of the session, document PCT/MIA/27/16, as follows:

“51. Discussions were based on document PCT/MIA/27/14.

“52. Authorities acknowledged the inefficiencies of handling drawings as a receiving Office that did not comply with Rule 11, which had been drafted when applications were received and processed on paper. Like the United States Patent and Trademark Office, other Authorities issued Form PCT/RO/106 on significant proportions of applications due to defects in the drawings. In addition, the requirement that the receiving Office should only check for compliance to the extent that compliance is necessary for the purpose of reasonably uniform international publication stated in Rule 26.3(a)(i) was unclear. Where receiving Offices applied these requirements strictly in view of highlighting potential issues in the national phase, applicants often filed further drawings that still did not meet the requirements since the wording in Form PCT/RO/106 was unclear and could imply the applicant needed to file such drawings or the international application would be withdrawn, which rarely happened in practice. One Authority suggested that additional outreach activity with the user community could explain the situation with drawing informalities and how to avoid certain pitfalls.

“53. While there were problems with the interpretation of “reasonably uniform publication” and the explanation in Form PCT/RO/106 on how to correct defects could be improved, some Authorities did not believe that the proposals in the document would necessarily rectify the problems encountered in many international applications with defects in the drawings. Some Authorities also stated that defining the attributes for reasonably uniform publication in paragraph 14 of the document would create a separate standard from Rule 11. The United States Patent and Trademark Office therefore proposed to work with the International Bureau to explore ways to achieve more efficient handling of drawings that do not comply with Rule 11. In this regard, the International Bureau commented that it was important to be clear on the goal of any proposal. A quick response to the immediate problem was needed, but further lines of work may be appropriate to deal more completely with the underlying issues. In that respect, one Authority suggested that the International Bureau should clarify its needs to achieve a “reasonably uniform publication” as this would help updating the requirements under Rule 11 that needed to be checked by receiving Offices.

“54. The Meeting invited the United States Patent and Trademark Office to work with the International Bureau to develop proposals to address the problems with handling informal drawings in international applications and related issues.”

CHECKING OF FORMALITIES DEFECTS

CHECKING IN THE INTERNATIONAL PHASE

4. The requirements of checking of physical requirements have been defined in terms of “the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication” since the Treaty was adopted in 1970. While details of the physical requirements have changed slightly and guidelines have been updated, the only change to the principles and distribution of responsibilities was made at the eleventh session of the PCT Assembly in January/February 1984, with effect from January 1, 1985.

5. Prior to 1985, Rule 26.3 stated, “The physical requirements referred to in Rule 11 shall be checked to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.” Rule 28.1(a) then required both the International Bureau and the ISA to bring any outstanding defects to the attention of the receiving Office.

6. Since 1985, these requirements have been slightly different. Rule 26.3 was amended to make clear that the receiving Office should “check the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication” (emphasis added). Rule 26.3*bis* was accordingly introduced to limit the obligation of the receiving Office to issue an invitation to correct defects to those that did not comply to the extent required under Rule 26.3. Rule 26.5 was also amended to make clear that the international application should not be considered withdrawn for lack of compliance with Rule 11 if it complies with the requirements to the extent necessary for the purpose of reasonably uniform international publication.

7. At the same time, the Assembly amended Rule 28 with effect from January 1, 1985 to remove the obligation for the ISA to notify defects to the receiving Office. In adopting this amendment, the PCT Assembly agreed that this did not prevent the ISA from bringing a previously overlooked defect to the attention of the receiving Office. However, in practice, very few significant defects were detected by the ISA that were not noticed by either the receiving Office or the International Bureau.

CHECKING IN THE NATIONAL PHASE

8. While the receiving Office should only check compliance with the physical requirements referred to in Rule 11 to the extent necessary for the purpose of reasonably uniform international publication, Rule 49.5(g) allows the designated Office (and by virtue of Rule 76.5, the elected Office), to invite the applicant to correct any defect in the drawings if they do not comply with Rule 11. The designated or elected Office may therefore raise objections to defects that were not pointed out to the applicant during the international phase. The designated or elected Office, however, is not obliged to make such objections and can limit its checking to the minimum level required to ensure that national processing, such as national publication or making available of copies, can be carried out effectively.

PREVIOUS DISCUSSIONS ON FORMALITIES CHECKING

DISCUSSION BY THE MEETING OF INTERNATIONAL AUTHORITIES

9. The Meeting, at its fourteenth session in February 2007, considered a document "Standard of Drawings Required for International Search and Preliminary Examination" (document PCT/MIA/14/6). This document discussed whether the requirements in Rules 11 and 26 with regard to drawings met the needs of ISAs and whether any other arrangements could be envisaged which would better meet those needs and also improve the value of drawings in the international publication to the applicant, third parties and designated Offices. The document also provided some examples of defective drawings in international applications. Paragraphs 7 to 10 of the document are reproduced below:

“7. The Guidelines provide no indication of which of the requirements of Rule 11 are particularly important to ensuring uniform publication or satisfactory reproduction and leave the matter to the judgement of the individual receiving Office.

“8. It is recalled that a number of Contracting States have suggested a need to review the requirements of Rule 11 itself, most notably in relation to photographs and color drawings, but also for other matters (see paragraphs 77 to 80 of document PCT/R/WG/8/9).

“9. Rule 28 allows the International Bureau to bring defects to the attention of the receiving Office; it is then up to the receiving Office to decide whether or not to request the applicant to correct the defects. There is no formal procedure for the International Searching Authority to request that defects be corrected before the international search is carried out. The Authority may note the defects in the written opinion once the search has been carried out, but there is no provision enabling the applicant to provide replacement

sheets in order to assist the international search. The only possibility would seem to be for the Authority to bring the matter informally to the attention of the International Bureau or receiving Office, but the International Searching Authority would need to know when, if ever, replacement sheets might arrive in order to decide when to start the international search.

“10. The issues appear to be slightly different for international preliminary examination since the International Preliminary Examining Authority can point out the defects (or rely on the statement made in the written opinion of the International Searching Authority) and has the chance to receive Article 34 amendments in response in time for the establishment of the international preliminary examination report. Nevertheless, it may be difficult to establish that there is no added subject matter, particularly if the deficiencies in the Authority’s copy were a result of scanning or copying and it does not have a copy of the originally filed sheets. Furthermore, amendments of the application made at this stage cannot rectify any deficiencies in the search which have been caused by the poor drawings.”

10. Some of the issues relating to the scanning and photocopying of drawings raised in document PCT/MIA/14/6 are now less relevant, noting that this document was written when slightly under half (47.3 per cent) of filings were either wholly or partly on paper, compared to 1.3 per cent according to the most recent figures for 2021. However, it is interesting to note that this document discussed the receiving Office not necessarily being able to determine if details in drawings could be seen clearly and complied with Rule 11.13, and potential difficulties in conducting a high quality search if the original drawings were poor, noting that the correction of the defects would probably add subject matter. Document PCT/MIA/14/6 also referred to the lack of a formal role of the ISA in drawing defects to the attention of the applicant. While the amendment to Rule 28.1(a) removed this role (via the receiving Office) as of January 1, 1985 (see paragraph 7, above), the document suggested that the ISA might be able to state with more certainty than the receiving Office whether the drawings are adequate “for the purpose of reasonably uniform international publication”.

11. Discussions of document PCT/MIA/14/6 are summarized in paragraphs 54 to 60 of the Summary by the Chair of the session, document PCT/MIA/14/8. Paragraph 60 is reproduced below:

“60. The Meeting agreed that the International Bureau should consider how best to address the issues outlined above, whether by modification of the Receiving Office Guidelines or by amendment of the Regulations under the PCT. Proposals should be discussed via the PCT/MIA electronic forum and submitted to the Meeting for discussion at its next session. Work should initially focus on matters relating to drawings, though extension of the task to include a broader review of Rule 11 and related matters might be considered at a later stage. Any proposals agreed by the Meeting should then be the subject of appropriate broader consultation, prior to promulgation of modifications of the Guidelines or the Administrative Instructions, or submission of proposals for amendment of the Regulations to the Assembly.”

12. In terms of Rule 11, the most recent amendments were adopted at the thirty-fifth session of the PCT Assembly in September/October 2006 shortly before the fourteenth session of the Meeting. These amendments entered into force on April 1, 2007, increasing the minimum text size to 28 mm in Rule 11.9(d) to facilitate conversion of documents from image to text files through optical character recognition (OCR) (see paragraphs 5 to 7 of Annex III to document PCT/A/35/2, and paragraphs 7 to 10 of document PCT/A/35/7). The minimum height of numbers and letters for drawings has always been 32 mm, as stated in Rule 11.13(h).

DISCUSSION BY THE PCT WORKING GROUP

13. The PCT Working Group, at its first session in May 2008, considered possible changes to the physical requirements of international applications (see document PCT/WG/1/5). This document reported on a review of the physical requirements for international applications that the International Bureau had undertaken to identify the requirements that were necessary for effective electronic processing. The review proposed amendment to Rule 11 relating to the description, claims and abstract. Another matter discussed in this document was the acceptance of color drawings and photographs.

14. With regard to the physical requirements of the application, paragraph 71(iii) of the Report of the session, document PCT/WG/1/16, summarizes the agreement of the Working Group, as follows:

“71. The Working Group agreed that:

...

(iii) the International Bureau should develop further recommendations in relation to the physical requirements of the international application, taking into account the comments set out in the following paragraphs and any conclusions reported by the ST.22 Task Force and the SCIT/SDWG, and in particular should develop proposals for modifying the PCT Receiving Office Guidelines to clarify cases in which a requirement stipulated in the Regulations need not be strictly enforced by receiving Offices in the international phase.”

15. In response to the invitation by the Working Group, the International Bureau proposed modifications to the Receiving Office Guidelines in Circular C. PCT 1157, dated December 19, 2008, which included clarification on the extent to which receiving Offices should enforce the requirements of Rule 11. These modifications entered into force with effect from January 1, 2009.

16. With regard to color drawings, following discussion at the ninth session of the Working Group in May 2016, applicants have been able to file color drawings electronically at certain receiving Offices using PCT-SAFE or ePCT-filing since July 1, 2017 (see document PCT/EF/PFC 17/003 for the technical details). However, any color or greyscale images are converted to black and white for formal publication and that version is used in eSearchCopy and in many cases where the receiving Office also acts as ISA. A notice appears on the front page of the published application to indicate that the original document contained color and is available for download in PATENTSCOPE. The color version is also available through ePCT, but in most cases will not be considered during international search.

17. The International Bureau eventually intends to offer full color processing of international applications throughout the international phase with an effective legal framework for recognition of color drawings in the national phase. However, this should be implemented as part of broader changes to the receiving, processing, modifying and publishing of application bodies to achieve effective full text processing. The International Bureau is therefore not yet able to propose amendments to Rule 11 to allow for full processing of color drawings.

EXPERIENCES OF INTERNATIONAL AUTHORITIES WITH INFORMAL DRAWINGS

18. Receiving Offices have the main role in the checking of drawings in international applications. However, international search may take place based on informal drawings pending the applicant filing replacement drawings in response to an invitation from the receiving Office, or there may be situations where a defect is apparent to the ISA, but the receiving Office did not invite the applicant to correct the defect. The ISA or IPEA may also be the competent authority to consider requests to rectify obvious mistakes. Furthermore, applicants may also

use the possibility under Article 34 to amend the drawings during international preliminary examination. Paragraphs 19 to 26, below, describe these situations.

PERFORMING INTERNATIONAL SEARCH BASED ON INFORMAL DRAWINGS

19. The ISA may be required to perform the international search based on informal drawings that do not meet the requirements of Rule 11 and may not meet the requirements for reasonably uniform international publication. As transmission of the search copy normally takes place before an applicant submits replacement drawings and the time limit for international search under Rule 42 is usually based on the receipt of the search copy, an examiner may be expected to search an international application pending the receipt of replacement drawings. Moreover, the examiner will not know if or when the ISA might receive the replacement drawings.

20. International Authorities are invited to comment on their experiences performing international search based on informal drawings. For example, ISAs could provide observations on the consistency of how different receiving Offices appear to apply the requirement for reasonably uniform publication, comparing this with their own application of the requirement. It could also be useful for Authorities to point out any added difficulties for international search when formalities examiners apply this requirement inconsistently. This could be in cases when the receiving Office has invited the applicant to correct a defect that would not appear necessary to ensure reasonably uniform publication, or when the receiving Office has not invited correction for a defect that the ISA believes it should have done.

PROCESSING REQUESTS FOR RECTIFICATION OF OBVIOUS MISTAKES

21. Under Rule 91.1, the ISA or IPEA is the competent authority to authorize rectification of obvious mistakes in the description, claims or drawings. In paragraph 4 of document PCT/MIA/27/14, the United States Patent and Trademark Office reports that it considers replacement drawings under Rule 91 in its capacity as an ISA when, as a receiving Office, it has determined that the replacement drawings contain substantive changes and require consideration of the ISA. However, the search examiner rarely authorizes replacement drawings as corrections under Rule 91 since it is difficult for the applicant to demonstrate that nothing else could be intended than the proposed corrections based on the informal drawings.

22. Requests for rectification of obvious mistakes should concern clear mistakes. While these may require the technical expertise of the search examiner to determine what might have been intended, applicants could use the possibility to submit a request to try to correct formal defects in drawings when the receiving Office had been able to make this determination but had not accepted the correction of the formal defects.

23. International Authorities are invited to comment on their experiences with requests to rectify obvious mistakes in drawings and indicate if this process could be improved.

CONSIDERING AMENDMENTS UNDER ARTICLE 34

24. International preliminary examination also provides the applicant with an opportunity to make changes to the drawings by filing amendments under Article 34, whether upon filing the demand for international preliminary examination or during the process itself. Amendments under Article 34 must not go beyond the disclosure in the international application as filed.

25. As international publication usually takes place before international preliminary examination, any drawings that an applicant wishes to amend under Article 34 should already be compliant with Rule 11 to the extent necessary for the purpose of reasonably uniform international publication. However, Offices in the national phase may invite the applicant to correct a defect in a drawing under Rule 49.5(g) (for a designated Office) or Rule 76.5 (for an elected Office) for any non-compliance with Rule 11. International preliminary examination

provides the possibility for an applicant to file new drawings for transmission to all elected Offices at the same time as making other amendments to the application. While in some cases, an elected Office may invite the applicant to provide translations of any text in the drawings, this could avoid the applicant needing to respond individually to invitations to correct defects in drawings when raised in the national phase.

26. International Authorities are invited to comment on the situations where they receive amendments to the drawings under Article 34 and any issues relating to their consideration and acceptance during international preliminary examination that could be relevant to the physical requirements of drawings in the Regulations.

POSSIBLE CHANGES TO THE REQUIREMENTS AND HANDLING OF PHYSICAL DEFECTS

27. In view of their experiences with informal drawings during international search and preliminary examination, International Authorities are invited to comment from their perspectives on possible changes to the legal framework in the PCT as background for preparing a document for the whole PCT membership to consider at the PCT Working Group. Changes could be related to the physical requirements of an international application in Rule 11, or the responsibilities of the receiving Office, International Bureau and ISA in the consideration of drawings in an international application.

AMENDMENTS TO RULE 11

28. PCT Contracting States last considered amendments to the physical requirements of international applications in Rule 11 in 2008 (see paragraph 13, above). These discussions resulted in modifications to the Receiving Office Guidelines in terms of the practical application of Rule 11 (see paragraph 14, above).

29. The previous consideration of the physical requirements of drawings took place when nearly half of international applications were filed on paper. The numbers of paper filings have fallen significantly in recent years and are now between 1 and 2 per cent. Most electronic filings are in PDF; between 27 and 30 per cent of all applications are filed in XML. While applications are usually filed in electronic format, XML is not yet the dominant filing format at many Offices. For XML filings, the physical requirements in Rule 11 are largely obsolete, as an application package filed in compliance with Annex F of the Administrative Instructions would result in compliant page rendering for the international application, although some requirements such as the number of words in drawings would need consideration.

30. In the long term, Rule 11 could be amended to refer primarily to a few fundamental requirements that should apply to all applications, irrespective of format, with annexes providing additional requirements for "special cases" of applications filed on paper or in electronic image formats. A reference to the format of physical sheets and their layout would be an ongoing need in view of the application of the PCT to the requirements on form and contents in Article 6 of the Patent Law Treaty (PLT) and continuing receipt of a few international applications on paper or electronically as image files. However, this should not drive the consideration of the requirements and processing of applications in full text format.

31. A review of the physical requirements of an international application should move towards the processing of photographs and color drawings throughout the international and national phases. However, the timing of this review will depend on the completion of technical work for the international phase. Careful consideration will also be needed of how to handle a transitional period where color drawings can be accepted for some national phases but not all.

32. Pending a review of the physical requirements, one option that the PCT Working Group could consider is to provide the possibility for receiving Offices to indicate any defects to the applicant that do not comply with Rule 11 but are not necessary for the purpose of reasonably

uniform international publication. In this situation, Form PCT/RO/106 would require modification to distinguish these defects, where correction would be optional, from defects requiring action from the applicant before publication. The applicant would therefore be aware of defects in the drawings found by the receiving Office that a designated or elected Office might require correcting, and have the option to make these corrections in the international phase, thereby facilitating processing in the national phase.

COMPETENT AUTHORITY FOR CORRECTION OF FORMALITIES DEFECTS

33. The receiving Office is presently the competent authority for the correction of formalities defects under Article 14 and Rule 26. The International Bureau can formally bring defects to the attention of the receiving Office under Rule 26, but the receiving Office retains responsibility to determine whether drawings meet the requirements of Article 14(1)(b)(v) as Rule 28.1(b) only requires the receiving Office to take action if it agrees with the opinion of the International Bureau. It is therefore possible for inconsistent determinations between receiving Offices on whether drawings meet the requirements for reasonably uniform publication.

34. While there has been no formal way of the ISA drawing any defects to the attention of the receiving Office since 1985, this does not prevent the ISA bringing a defect to the attention of the receiving Office.

35. The first draft of a treaty that was referred to as the Patent Cooperation Treaty (PCT) was prepared for the Committee of Experts on the BIRPI Plan for Facilitating the Filing and Examination of Applications for the Protection of the Same Invention in a Number of Countries: Plan for a Patent Cooperation Treaty (PCT) "the Committee of Experts" that met from October 2 to 10, 1967. This draft proposed that the International Bureau would check the requirements of the application in terms of form (see paragraph 11 of document PCT/I/3 and Article 7 of the draft PCT in document PCT/I/4). However, the Committee of Experts, while not excluding the International Bureau from performing the formalities examination, considered that either receiving Offices or the ISAs should perform this task (see paragraph 24 of the Report, document PCT/I/11):

"24. The majority of the Committee was of the opinion that the examination of the international application as to form should not be done by the International Bureau except when other authorities were not available, for example, when the international application is filed direct with the International Bureau. Opinions differed on who should, as a rule, do such examination. Some proposed that it be done by the searching Authorities, others that it be done by any national Office which is ready to receive and transmit international applications, even if such an Office is not a searching Authority. In any case, the International Bureau should set up machinery to harmonize the practices of all authorities controlling the conformity of applications with the formal requirements of the PCT."

36. Certain considerations by the Committee of Experts in 1967 differ from those relevant to today. Offices now have electronic access to the file of an international application, for example, through ePCT, and application specifications and data are transferred electronically between receiving Offices, the International Bureau and ISA/IPEAs. There is no fundamental reason that ISAs and/or the International Bureau could not have a greater role in the formal examination of an international application if agreed among PCT Contracting States, amending Rules 26 and 28, as appropriate.

37. The International Bureau is assessing possible options that might improve the handling of formal defects. To assist in this process, International Authorities are invited to comment on goals that might assist them in performing efficient and high quality search work, and on whether it may be desirable for the ISA to take a new role in formalities checking, at least for handling informal drawings.

38. For example, as noted above, it is not generally within the competence of the receiving Office to decide whether replacement sheets are appropriate to replace informal drawings. On the other hand, rectification of an obvious mistake is typically not appropriate for the purpose because in most cases the formal drawings will not meet the test that “nothing else could have been intended than the proposed rectification”. However, Rule 28 could be amended to allow the possibility of correction before the ISA if a replacement sheet containing drawings meets the requirements of Rule 11 and accurately represents the content of the sheet as filed.

39. International Authorities are invited to comment on:

(a) whether such an arrangement for correction before the ISA might be desirable and practical to administer;

(b) whether it should be possible for the applicant to send corrections to the ISA unprompted, or only at the invitation of either the receiving Office or the ISA;

(c) whether such corrections should be limited to drawings or cover any part of the application body – and, if so, whether for any type of defect or only specified types that may be difficult for the receiving Office to assess effectively; and

(d) whether any other limitations should apply.

40. Another possibility would be to provide for the possibility of the International Bureau interacting directly with the applicant to invite the correction of formal defects. This would involve amendment to Rule 28, which currently requires the International Bureau to bring such defects to the attention of the receiving Office. A process between the applicant and the International Bureau for correcting formal defects could improve consistency in international publication and be more efficient for applicants, the International Bureau and receiving Offices, alike. As this change would mainly concern the work of receiving Offices, the International Bureau intends to discuss this possibility in the document to the PCT Working Group.

DEFECTS OF PARTICULAR RELEVANCE TO INTERNATIONAL AUTHORITIES

41. This document has focused primarily on informal drawings, since these are both a particular problem for ISAs in efficiently assessing an invention when carrying out an international search, and an issue where the ISA examiner has the relevant technical qualifications to assess whether a proposed correction would be an appropriate way to address a defect. Another part of an international application relevant for ISAs to determine physical defects are sequence listings, which at present are handled by the possibility to invite the furnishing under Rule 13*ter* of a sequence listing for the purposes of the international search.

42. International Authorities are nevertheless invited to identify other types of physical defects where either the result is a particular problem for the ISA, or else it might be desirable to involve the ISA in determining the allowance of corrections as part of the processing of the international application.

NEXT STEPS

43. The International Bureau intends to prepare a document for consideration at the next session of the PCT Working Group on the issue of formalities checking, noting that this responsibility lies with receiving Offices. International Authorities are invited to share their perspectives for the International Bureau to take into account in preparing the content of that document.

44. The Meeting is invited to comment on the issues set out in paragraphs 18 to 42 of this document.

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