

# WIPO



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**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PCT**

**Eighth Session  
Washington, D.C., May 5 to 9, 2003**

**DRAFT PCT INTERNATIONAL SEARCH AND  
PRELIMINARY EXAMINATION GUIDELINES:**

**COMMENTS BY THE UNITED STATES  
PATENT AND TRADEMARK OFFICE**

*Document prepared by the International Bureau*

1. Document PCT/MIA/8/2 contains a revised draft set of combined guidelines for International Search and Preliminary Examination under the PCT submitted by the United States Patent and Trademark Office.

2. The Annex to this document reproduces the report of comments by the International Authorities during the seventh session of the Meeting of International Authorities (see document PCT/MIA/7/5, paragraphs 26 to 76) on the previous draft of these guidelines (see document PCT/MIA/7/2), together with responses by the United States Patent and Trademark Office, indicating how these comments have been reflected in the revised draft.

*3. The Meeting of International Authorities is invited to take note of the contents of the Annex to this document.*

[Annex follows]

**E**

ANNEX

RESPONSE BY THE UNIT ED STATES PATENT AND TRADEMARK OFFICE TO THE  
COMMENTS ON THE GUIDELINES REPORTED IN DOCUMENT PCT/MIA/7/5

*Chapter I (Introduction and Overview)*

26. The introductory comments in paragraphs 1.03 to 1.04 raised the question of the status of the Guidelines. The Meeting agreed that there was no reason to depart from the conclusion reached during the sixth session (see document PCT/MIA/VI/16, paragraphs 11 to 14), which had been incorporated into the present PCT International Search Guidelines at paragraph I -2 and the PCT International Preliminary Examination Guidelines at paragraphs I -3.1 to I -3.3, and that the content of those existing paragraphs should be included in the revised draft.

*[Response: Agree. The paragraphs have been revised such that the contents of the PCT International Preliminary Examination Guidelines at paragraphs I -3.1 to I.3 -3 have been included in the revised draft.]*

27. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 1.05:* The reference to “five parts and an annex” at line 4 will need to be updated to reflect the final numbers.

*[Response: Agree. This paragraph will be updated to reflect the final numbers.]*

(b) *Paragraph 1.08:* At line 8 it is necessary to make clear that the written opinion referred to at this point is that established under Rule 43 *bis*.

*[Response: The reference to Rule 43 *bis* has been inserted after the reference to PCT Article 34 to this paragraph.]*

(c) *Paragraph 1.10(b):* The reference to “16 months” should be reviewed in the light of the fact that this is the normal, practical result, rather than the strict definition in the Regulations (which is considered elsewhere).

*[Response: The suggested language has been inserted.]*

*Chapter 2 (Overview of the International Search Stage)*

28. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 2.05*: Rule 23.1 should be mentioned here, since this paragraph deals with the transmittal of the search copy from the receiving Office to the International Searching Authority.

*[Response: The suggested reference has been inserted.]*

(b) *Paragraph 2.10(b)*: The use of the term “determine” in relation to unity of invention (cf. “discover” in paragraph 2.10(f) in relation to the international search itself) should be revised to be consistent with the requirements of Article 17(3) and Rule 40.

*[Response: Suggestion is unclear with respect to the term “determine.” Paragraph has not been amended. Further discussion is necessary.]*

(c) *Paragraph 2.10(d)*: Rule 16.3 should be mentioned in this paragraph. It should be made clear that refunds are available in the case that they have been requested by using the relevant box on the demand form, identifying the earlier searched application. The wording should be changed to read “to determine whether to use the results...., and to consequently authorize...”

*[Response: The paragraph has been revised to include Rule 16.3.]*

(d) *Paragraph 2.13*: The word “established” should read “transmitted” for consistency with Rule 44.1.

*[Response: Disagree because the first part of the sentence refers to the establishment of the search report and written opinion before ISA transmits them to the IB and to the applicant. However, the paragraph has been revised to clarify this.]*

(e) *Paragraph 2.14*: This paragraph should be revised to reflect the fact that further search fees can be paid either without protest or under protest.

*[Response: Agree. The paragraph has been revised to reflect that further search fees can be paid either under protest or without protest.]*

(f) *Paragraph 2.15(b)*: Rule 46.4 should be mentioned in this paragraph. It should be made clear that the statement explaining amendments under Article 19(1) is optional.

*[Response: Agree. The paragraph has been revised to indicate that amendments under Article 19 are optional.]*

(g) *Paragraph 2.16*: Rule 44 ter.1 should be mentioned in this paragraph.

*[Response: The paragraph has been revised to include a reference to Rule 44 ter.1.]*

(h) *Paragraph 2.17:* It should be made clear that, if the applicant files amendments under Article 19 after a written opinion by the International Searching Authority but does not file a demand for preliminary examination, the international preliminary report on patentability (Chapter I) will be established without taking these amendments into consideration (Rule 44 *bis*).

*[Response: Agree. The paragraph has been revised to only refer to the publication of the search report. The comment on the international preliminary report on patentability has been incorporated into paragraph 2.18.]*

(i) *Paragraph 2.18:* The reference to Article 23(3) should read Article 23(2).

*[Response: The reference to Article 23 has been corrected. In addition, this paragraph has been revised to reflect the comment of paragraph 2.17.]*

(j) *Paragraph 2.19:* It was recalled that the question of copyright and copies of citations was under consideration by the Working Group (see document PCT/R/WG/3/5, paragraph 63), and a drafting note should be included to that effect as a reminder that further changes may be needed at a later stage.

*[Response: Agree. The paragraph has been revised to reflect their comment.]*

(k) *Paragraph 2.21:* The question was raised of whether the requirement of producing a written opinion in conjunction with the international search report meant that an equivalent opinion was required when producing an international -type search under Article 15(5). It was unanimously agreed that it did not. However, it was desirable to refer specifically to Article 15(5) rather than merely Article 15 in this paragraph.

*[Response: The paragraph has been revised to include Article 15(5).]*

*Chapter 3 (Overview of the International Preliminary Examination Stage)*

29. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 3.04:* The reference at line 3 to “Phase I” should be amended to read “Chapter I.”

*[Response: The paragraph has been revised to reflect Chapter I.]*

(b) *Paragraph 3.04 and throughout:* It was noted that the report under Chapter II could be referred to as either the “international preliminary examination report” or the “international preliminary report on patentability (Chapter II).” Either was valid, but it was desirable to use terminology consistently.

*[Response: USPTO agrees and for terminology consistency the report under Chapter II will be referred to as the international preliminary examination report (IPER).]*

(c) *Paragraph 3.08:* It may be desirable to include a reference to the WIPO website’s list of the remaining reservations.

*[Response: Agree. A reference to WIPO’s website has been inserted.]*

(d) *Paragraph 3.15:* Delete “if practicable.”

*[Response: The phrase has been deleted.]*

(e) *Paragraph 3.18:* A drafting note should be included, reminding of the need to review whether this paragraph is required, depending on whether any Authorities make a relevant notification.

*[Response: Suggestion is unclear with respect to this paragraph. Paragraph is not amended. Further discussion is necessary.]*

(f) *Paragraph 3.21:* The reference to the number of opinions issued need to be brought into line with the result of the discussion in connection with Chapter 10.

*[Response: Agree. The paragraph has been revised to reflect their comment.]*

(g) *Paragraph 3.22:* Considerations should be given to the importance of establishing the report prior to the normal time for entry into the national phase and the possible effects if the report is established after this time (recognizing that this is ultimately a question of national law).

*[Response: Although the comment is noted, this paragraph has not been revised to include their suggestion because it would require a rule change.]*

(h) *Paragraph 3.24:* The reference to transmittal of the report to the elected Offices, rather than establishment of the report is not strictly correct and should be reviewed, noting

the differences between Rule 44ter and Article 38 for international preliminary report on patentability Chapters I and II respectively.

*[Response: Agree. This paragraph has been revised to indicate when the IPEA may provide the documents to the elected Offices .]*

- (i) *Paragraph 3.25:* A reference should be made to communication on request.

*[Response: Agree. This paragraph has been revised to reflect their comment.]*

- (j) *Paragraph 3.28:* A drafting note referring to copyright issues should be included, similar to that for paragraph 2.19 above.

*[Response: Agree. The paragraph has been revised to reflect their comment.]*

*Chapter 4 (The International Search)*

30. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) The duplication between Chapters 2 and 4 (particularly the more general parts) should be reviewed.

*[Response: After carefully considered review, we believe that Chapter 2 and overview of Chapter 4 should not be further revised. Chapter 2 is an overview of the international search stage while Chapter 4 addresses the international search itself. As such there is necessarily some overlap of subject matter but neither the whole of the guidelines nor either Chapter 2 nor 4 would be improved by the deletion of the overlapping subject matter from either Chapter.]*

(b) *Paragraph 4.01*: While this was considered to be a statement of objective, rather than of how the objectives should be achieved, a reference to the PCT minimum documentations should be considered.

*[Response: Suggestion adopted. The reference has been added.]*

(c) *Paragraphs 4.02 and 4.52*: In paragraph 4.02, insert “In order to establish the written opinion of the International Searching Authority” at the beginning and replace “perform searching” with “cite.”

*[Response: The changes to paragraph 4.02 have been made. It is unclear why paragraph 4.52 is referenced here.]*

(d) *Paragraphs 4.04 and 4.07*: Delete the square brackets and retain the text. In paragraph 4.07, replace “can be dated and are indexed” with “are retrievable.”

*[Response: Suggestion adopted.]*

(e) *Paragraphs 4.05 to 4.07*: These paragraphs describe prior art and the relationship with Chapter 14 should be reviewed. Paragraph 4.07 should include a cross-reference to paragraph 14.13.

*[Response: Paragraph 4.05 has been revised and is now consistent with paragraph 14.15. A cross-reference to paragraph 14.15 has been added to paragraph 4.05 and cross-references to paragraphs 14.12 to 14.13 have been added to paragraph 4.07.]*

(f) *Paragraph 4.17*: This paragraph should be made consistent with Rule 33.3(b).

*[Response: Suggestion adopted.]*

(g) *Paragraphs 4.18 and 4.24 (and elsewhere more generally)*: It would be desirable to find different or extra examples which will be meaningful to examiners in all fields of technology, rather than matters such as pipe clamps, which require some knowledge of a specific art.

*[Response: Although this would appear to be highly desirable, it would not be practical to attempt to provide examples from the diverse myriad of technologies that are considered by the ISAs. Therefore, the example, which is clearly understandable for the vast majority of readers, should be maintained.]*

(h) *Paragraph 4.20:* Add a reference to the possibility of contacting the applicant.

*[Response: Suggestion adopted.]*

(i) *Paragraph 4.23:* The final sentence contained many caveats and consequently did not give clear, general advice. Suggestions were requested from Authorities for alternative wordings.

*[Response: Suggestion adopted.]*

(j) *Paragraph 4.31:* The words “such situations should be apparent” should be made more direct, indicating that the examiners should state the objection.

*[Response: Suggestion adopted.]*

(k) *Paragraph 4.31:* The square brackets should be deleted and the text between them retained.

*[Response: Suggestion adopted.]*

(l) *Paragraph 4.33:* There is no guidance on what to do in the event that the applicant refuses to correct the international application voluntarily to remove matter contrary to public order. Suggestions were requested from Authorities who had any experience of such events either under the PCT or comparable national provisions.

*[Response: If the applicant does not make the suggested correction the examiners should have the option of excluding the noted matter from search and examination. Further, the IB may omit the noted matter from the publication in accordance with Article 21(6).]*

(m) *Paragraph 4.36:* It is extremely rare to require an applicant to provide a copy of a document that is unavailable to the Authority but required before a meaningful international search was possible. Nevertheless at least one Authority had occasionally found it necessary to use such a procedure and consequently it was agreed to retain this paragraph.

*[Response: Agreed.]*

(n) *Paragraph 4.37:* This should be redrafted to provide that the abstract may be considered prior to or after the search, since the examiner may feel that he understands the invention better afterwards.

*[Response: Suggestion adopted.]*

(o) *Paragraph 4.51:* In the third line, change “should also endeavor to discover...” to read “be encouraged to cite.”

*[Response: Suggestion adopted.]*



(p) *Paragraph 4.57:* Some Authorities objected to any obligation to retain the search history on the file (see Rule 43.6) (see also paragraphs 6.55 and 6.58). However it was suggested that it may be desirable to redraft the paragraph to make clear that Authorities may require the examiner to do so, rather than it being the choice of each individual examiner. The questions of whether requiring such search history would bolster confidence in the quality of the search and whether the history would be meaningful (or whether it might in some cases be positively misleading) should be considered separately at a later time.

*[Response: Alternative language has been proposed to require a detailed history only for those components of the search that discovered the prior art references cited in the search report.]*

(q) *Paragraph 4.59:* The term “types of expression” is not an example of a “specific claim type” and should be replaced by a better example.

*[Response: Paragraph has been amended to make it clear that when the examiner interprets the claims for the purpose of determining the appropriate search to conduct, the evaluation of the references for those claims should be consistent with that interpretation.]*

(r) *Paragraph 4.62:* The word “references” should be replaced by “prior art documents” and the term “non-statutory” should be replaced by “matter excluded under Article 17(2)(a)(i).” The term “statutory subject matter” should be revised accordingly.

*[Response: Suggestion adopted.]*

(s) *Paragraph 4.69:* Should refer to the written opinion as well as the search report.

*[Response: Suggestion adopted.]*

*Chapter 5 (“Reserved”)*

31. It was clarified that this Chapter was not reserved for further material, but was simply a discontinuity in the numbering, which would be corrected before finalization of the Guidelines, but probably not in the next draft, since this might complicate revision marking.

*[Response: Agreed.]*

*Chapter 6 (International Search Report)*

32. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 6.04:* It was felt that a new heading was required above this paragraph. In addition the word "Chapter" in line 1 might be replaced by "the following paragraphs" or the like.

*[Response: Suggestion adopted.]*

(b) *Paragraph 6.07:* A drafting comment should be added to remind of the need to review in the light of new forms, particularly if computer-generated forms are introduced (though this is not likely to be before the current revision must come into force).

*[Response: Suggestion adopted.]*

(c) *Paragraph 6.19:* In the second line, after "mentioned of those" add "on the request form" to clarify where the applicant's name is mentioned.

*[Response: Suggestion adopted.]*

(d) *Paragraph 6.20:* This should contain an exhaustive list of the subjects which may be excluded from search and examination (see Rules 39 and 67).

*[Response: Suggestion adopted.]*

(e) *Paragraphs 6.36 to 6.48:* These paragraphs covered the same subjects as paragraphs 8.01 to 8.07. The duplication should be avoided; one Authority expressed a preference for the version of the explanation of procedure provided in these paragraphs over that in Chapter 8.

*[Response: The whole of Chapter 8 has been eliminated and its contents have been redistributed to other parts of the Guidelines. Specifically, the contents of paragraphs 8.01 to 8.07 have been moved to paragraphs 6.36 to 6.47. The contents of paragraph 8.08 have been moved to paragraph 19.17. The contents of paragraphs 8.09 to 8.10 have been moved to paragraph 4.10 and new paragraph 4.10.1 respectively. In addition, a cross-reference to paragraph 4.10 has been added to paragraphs 4.31, 6.20, and 6.27. Further, a cross-reference to paragraph 19.17 has been added to paragraph 6.27.]*

(f) *Paragraph 6.37:* Redraft to differentiate between Rules 37 and 38.

*[Response: Paragraph 6.37 has been amended to address Rule 38 and not Rule 37. New paragraph 6.46.1 has been added to address Rule 37.]*

(g) *Paragraph 6.39(c):* Change the first sentence to read "only one figure should normally be selected. The..."

*[Response: Suggestion adopted.]*

(h) *Paragraph 6.39(d)*: In thesecondline, change “text” to “abstract.”

*[Response: Suggestion adopted.]*

(i) *Paragraph 6.46*: This wording could be replaced by wording taken from the European Patent Office’s Guidelines, which is more complete (EPC Guidelines, A -III 7.1, adapted to the PCT procedure) as follows:

*“Title of the invention* .According to Rule 4.3 PCT, the title must be short and precise (preferably from two to seven words in English or when translated into English). Furthermore, the title should clearly and concisely state the technical designation of the invention and should exclude all fancy names. In this regard the following should be taken into account:

(a) personal or trade names, fancy names, the word “patent” or similar terms of a non-technical nature which do not serve to identify the invention should not be used;

(b) the abbreviation “etc.,” being vague, should not be used and should be replaced by an indication of what it is intended to cover;

(c) titles such as “Method,” “Apparatus,” “Chemical Compounds” alone or similar vague titles do not clearly state the technical designation of the invention.”

This section should also clarify that the International Searching Authority may change a deficient title at its own discretion according to Rule 37.2.

*[Response: The suggested text taken from the EPC Guidelines has been added. However, the comment in the last sentence suggesting that a clarification be made to indicate that the ISA may change a deficient title at its discretion in accordance with Rule 37.2 is not understood. Rule 37.2 states that the ISA shall establish a title if the application does not contain a title and the ISA has not been notified that the applicant has been invited to furnish a title or if the ISA finds that the title does not comply with Rule 4.3. Rule 37.2 does not indicate that the ISA has any discretion in the event it determines the title to be deficient.]*

(j) *Paragraph 6.47*: Make any necessary changes in view of new paragraph 6.46.

*[Response: Suggestion adopted.]*

(k) *Paragraphs 6.53 to 6.61*: See comments on paragraph 4.57 above.

*[Response: With regard to paragraphs 6.60 to 6.61, the term “partial”, from the terminology “partial structure searches”, has been deleted since it is not readily apparent what type of structure search this particularly specifies. For the purposes of the International Search Report, any structure or sequence search need only be specified as set forth in 6.60 and 6.61, respectively. The detailed search history should provide more details of any structure or sequence query for art which was cited in the search report and obtained from such searches.]*

(l) *Paragraphs 6.55 and 6.58*: See comments on paragraph 4.57 above.

(m) *Paragraph 6.64(a)*: Placethetextinsquarebracketsforreconsideration.

*[Response: Thisparagraphhasbeendeleted.]*

(n) *Paragraph 6.64(b)*: Omitthisparagraph.

*[Response: Suggestionadopted.]*

(o) *Paragraph 6.64(c)*: Redrafttoaddressrelyingontheclosestpriorartwithoutthe citationofduplicatepriorart.

*[Response: Suggestionadopted.]*

(p) *Paragraph 6.64(d)*: Omitthisparagraph.

*[Response: Suggestionadopted.]*

(q) *Paragraph 6.64(e)*: Redraft tomakeitclearwhattheexaminerisrelyingon (abstractorwholedocument).

*[Response: Suggestionadopted.]*

(r) *Paragraph 6.64(f)*: Omitthisparagraph.

*[Response: Suggestionadopted.]*

(s) *Paragraph 6.65*: Omitthisparagraph.

*[Response: Suggestionadopted.]*

(t) *Paragraphs 6.67to6.93*: Redraftinviewofcommentsindocument PCT/MIA/7/2Add.1andthosementionedinthefollowingfiveparagraphs.

*[Response: Suggestionadopted.Newparagraph6.66.1replacesoldparagraphs6.67to 6.93.]*

(u) *Paragraph 6.71*: Considerationshouldbegiventooanexplicitstatementthat documentsmaybecitedascategoryXiftheycallintoquestiontheinventivestepofaclaim whenconsideredinthelightofcommongeneralknowledge.

*[Response: Suggestion adopted.Seenewparagraph6.66.1(i).]*

(v) *Paragraph 6.73*: Furtherdraftingisrequiredtoclarifythatifanyalternative, takenasawhole,withinthescopetheclaimwouldhavebeenobvious,thentheclaimlacks inventivestep,ratherthanthathewholebreadthoftheclaimmustbeobviousforsuchan objection.

*[Response: Theoffendinglanguageinthedescriptionofacategory“Y”referenceisno longerpresent.Seenewparagraph6.66.1(i).]*

(w) *Paragraphs 6.75 and 6.81*: It may be desirable to note that where a single document is cited as suggesting a lack of inventive step, that document would normally be listed as category X.

*[Response: Suggestion adopted. See new paragraph 6.66.1(i).]*

(x) *Paragraph 6.76*: Redrafting was required to clarify that “as a whole” related to each dependent claim as read together with the claims from which it depends, rather than all dependent claims being read together as a whole.

*[Response: The offending language is no longer present. See new paragraph 6.66.1]*

(y) *Paragraph 6.85*: It was agreed that the Guidelines were not the appropriate place to define a new symbol – this should be raised with the Standing Committee on Information Technologies (SCIT). It was agreed that the paragraphs should remain in square brackets for the moment as a reminder of the issue, but be marked with a drafting note to make clear that it was not intended to introduce it until the proper process had been completed. It was also noted that the intention was to provide a manner of marking a category of documents which were known to the examiner, not to introduce an obligation to extend the search. It was also noted that “D” was not a good symbol since it already has a specific, different meaning in European practice (relating to a document cited by the applicant in the description).

*[Response: See new paragraph 6.66.1(vii). The subject matter has been placed in square brackets and marked with the requested drafting note. Symbol “D” has been replaced with symbol “M”.]*

(z) *Paragraph 6.105*: Omit this paragraph.

*[Response: Suggestion adopted.]*

(aa) *Paragraph 6.107*: A drafting note should be included to remind of the consideration being given to copyright citations in other forums, as noted above in respect of paragraph 2.19.

*[Response: Suggestion adopted.]*

(bb) *Paragraphs 6.109 to 6.114*: Some concern was expressed at including details of the issue of search reports in the Guidelines, since this is done by the Authorities as a service, not an obligation. There was a general agreement that there were times when all Authorities would agree that the issue was appropriate and that this could be mentioned in the Guidelines, but that there should be no implication of an obligation and that much of the detail of internal practice was a matter for the individual Authorities and not relevant to these Guidelines. Consideration might be given to referring to “replacement” search reports, rather than reissues, noting that any second search report would be a replacement. Redraft these paragraphs to provide that any second (optional) search report should be a replacement of that first issued.

*[Response: Suggestion adopted. See new paragraph 6.109.]*

*Chapter 7 (Classification of International Applications)*

33. It was pointed out that a large part of this Chapter is a summary of matter which appears in the Guide to the International Patent Classification (IPC). It was questioned whether it might be better simply to provide a reference to that Guide.

*[Response: The original text was modified to eliminate specific classification guidance and refer the reader to the IPC Guide. The remaining language is thought to be of a general nature or describing practices not covered by the IPC guide.]*

34. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 7.02:* The relationship between this paragraph and paragraph 6.53 should be examined. They were generally felt not to be inconsistent, but the phrase “all such classifications should be assigned” may require further knowledge of the rules of the IPC to reconcile easily with the statement “non-obligatory IPC symbols do not need to be applied.”  
[Response: Paragraph 6.53 now addresses only field of search classifications, and 6.54 addresses classification of applications. The phrase “all such classifications...” in paragraph 7.03 is now followed by a reference to the IPC guide.]

(b) *Paragraph 7.03:* The need for all relevant classifications could be expressed more simply, without reference to main groups within subclasses.

*[Response: Reference to IPC groups and subclasses deleted.]*

*Chapter 8 (Errors and Deficiencies Checked at the Search Stage)*

35. A significant overlap between this and Chapter 6 was noted. It may be desirable for the two chapters to be merged.

*[Response: The whole of Chapter 8 has been eliminated and its contents have been redistributed to other parts of the Guidelines. Specifically, the contents of paragraphs 8.01 to 8.07 have been moved to paragraphs 6.36 to 6.47. The contents of paragraph 8.08 have been moved to paragraph 19.17. The contents of paragraphs 8.09 to 8.10 have been moved to paragraph 4.10 and new paragraph 4.10.1 respectively.]*



*Chapter 9 (Preliminary Procedure on Receipt of the Demand)*

36. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraphs 9.02 and 9.12:* In line 12 of paragraph 9.02, change “is not in conformance” to “does not comply” and in line 4 of paragraph 9.12 change “in conformance” to “does not comply.”

*[Response: Adopted for paragraph 9.02; the proposed language was modified slightly in paragraph 9.12, that is, “in conformance with Section 102(h) and (i) was not used” was replaced with ---that does not comply with Section 102(h) and (i) was used ---.]*

(b) *Paragraph 9.07:* It may be worth noting that there are no current reservations in respect of Chapter II so that this paragraph is not operative at the time that the Guide lines are established, but it was not appropriate to delete it entirely.

*[Response: Adopted.]*

(c) *Paragraphs 9.08 and 9.15:* The significance of the references to 19 months should be clarified, indicating that failure to notify the applicant quickly may result in loss of rights in States where an notification in respect of the modification to Article 22(1) is still in force.

*[Response: Adopted.]*

(d) *Paragraph 9.10:* It should be clarified that it is only necessary to check that new applicants are entitled to file the demand if the change under Rule 92bis is recorded by the International Bureau prior to the demand being filed.

*[Response: the comment is not understood. A newly named applicant's entitlement to file a demand would need to be checked irrespective of whether the IB has recorded the change prior to the demand being filed.]*

(e) *Paragraph 9.20:* In line 2, “(preferably by facsimile transmission)” should be deleted.

*[Response: Adopted.]*

(f) *Paragraphs 9.22, 9.28, 9.29 and 9.34:* Update required to reflect amended Rule 90.4, whereby Authorities are not required to call for a power of attorney and also need not routinely forward this to the International Bureau. It may also be necessary to note the new provisions in relation to withdrawal of the international application. IP Australia offered to draft new text.

*[Response: No change was made to paragraph 9.22. However if the IB decides to waive the requirement that a separate power of attorney be submitted to it, alternative language for this paragraph is offered within the parentheses.]*

Paragraph 9.28 – *Updates made. These sentences specific to applicants for the purposes of the US only have been deleted since the US will be waiving the requirement in accordance with Rule 90.4.*

Paragraph 9.29 – *Updates made.*

New Paragraph 9.29bis *was added for those IPEAs which waive the requirement for a separate power of attorney under amended Rule 90.4.*

Paragraph 9.30 – *Not mentioned in the report but paragraph 9.30 was modified in a similar manner since it also concerns signature of the agent.*

Paragraph 9.34 – *Response: no change was made. This paragraph does not concern signature of the agent so no change was made.*

*Note that comments also mentioned that it might be necessary to note the new provisions in relation to withdrawal of the international application but those changes were incorporated into this section on withdrawal found in Chapter 10, paragraph 10.65.]*

(g) *Paragraph 9.36 (and possibly elsewhere):* Update required to reflect new Rule 60.1ter, whereby when there are several applicants it is sufficient for the demand to be signed by anyone applicant.

*[Response: Adopted.]*

*[Paragraph 9.37 was not mentioned in the report. However, the US delegation recalled that the parenthetical material “(black ink should be used),” should be deleted.]*

(h) *Paragraph 9.58:* In line 6, change “the file will not be forwarded to the examiner” to “examination will not start” since whether or not to forward a file should be left to internal practice.

*[Response: Adopted]*

(i) *Paragraph 9.59:* Needs review for consistency with Rule 53.9(a)(ii). This rule specifically refers to the case where Article 34 amendments “reverse” (the term used as opposed to “cancel”) Article 19 amendments.

*[Response: Adopted. Should this entire paragraph be deleted? There is no basis in Rule 53.9(a)(ii) for the practice of reversing Article 19 amendments, except with Article 34 amendments.]*

(j) *Paragraph 9.64:* Consider whether the word “or” at the beginning of line 5 should read “and/or” to take account of the different possible ways in which an abstract might come to be established.

*[Response: no change was made. The US does not understand this comment. ]*

*[Paragraph 9.68 was not mentioned in the report. However, the paragraph was revised in order to provide instructions as to what the IPEA does where applicant doesn't respond to the invitation to translate the demand.]*

*Chapter 10 (Examination Procedure Before the International Preliminary Examining Authority)*

– *Cases Where a Further Written Opinion May Be Issued*

37. See paragraphs 10.14 and 10.15 of the draft revised Guidelines.

38. The Meeting noted that the Treaty and Regulations did not impose any obligation on the International Preliminary Examining Authority under Chapter II to establish any further written opinion beyond the first, although the possibility that such further opinion(s) might be issued was envisaged. That position was equally true under the existing Regulations (under which the first written opinion was established under Chapter II by the International Preliminary Examining Authority) and under the Regulations as amended with effect from January 1, 2004 (under which the first written opinion would, subject to the exception provided by Rule 66.1 bis(b), be established under Chapter I by the International Searching Authority). There was some discussion, however, about the extent to which the Guidelines should indicate whether, and in what circumstances, the International Preliminary Examining Authority should exercise its discretion to establish a further written opinion. ry

39. It was noted that the amended provisions relating to the International Searching Authority did not, unlike the existing provisions relating to the International Preliminary Examining Authority, give the applicant the opportunity of having amendments or arguments considered by the International Searching Authority in establishing the first written opinion, although it was pointed out by one Authority that such opportunity was, under the present provisions, seldom taken advantage of by applicants in practice. It was also noted that the amended provisions did not, of course, affect the applicant's right to submit amendments or arguments under Article 34, and that such amendments or arguments would be taken into account by the International Preliminary Examining Authority in establishing the international preliminary examination report, where appropriate, in issuing a further written opinion.

40. Certain Authorities expressed the view that there were circumstances in which the issuance of a further written opinion should be encouraged by the Guidelines, provided that there was sufficient time available, that the applicant was making a real effort to meet the examiner's objections and that the Authority had adequate resources, and felt that the wording of the present Guidelines relating to international preliminary examination (see paragraph VI-6.3) was preferable to the revised draft. The value of the international phase of the PCT procedure to applicants and elected Offices, particularly smaller Offices, which relied on the results of the international preliminary examination procedure would be reduced, it was felt, if examiners were not encouraged to issue further written opinions, since more outstanding objections would then remain to be resolved in the national phase. Such an approach was felt to be inconsistent with the objective of making the PCT a more useful tool in the obtaining and granting of patent protection internationally, and would increase costs and work for applicants and Offices. The comments by the International Federation of Industrial Property Attorneys (FICPI) that were reproduced in document PCT/MIA/7/2Add.2 were noted.

41. Other Authorities believed that the revised Guidelines should not restrict the discretion of the International Preliminary Examining Authority, noting that the Regulations did not make the issuance of a further written opinion obligatory in any circumstances. It was noted

that the draft revised Guidelines made it clear that the International Preliminary Examining Authority remained at liberty to issue further written opinions where appropriate.

*[Response: The guidelines neither make a second written opinion mandatory nor restrict the issuance of a second written opinion. All comments have been taken into consideration, and the revisions allow for an IPEA to issue a second written opinion if the IPEA believes that the issuance of a second written opinion would be helpful in facilitating a final resolution of significant issues.]*

42. A majority of the Authorities which took the floor considered that the current draft of paragraphs 10.14 and 10.15 was acceptable, subject to amendment of the words “need not be required” at line 1 of paragraph 10.14 to read “is not required” and deletion of the word “only” at line 7 of paragraph 10.15 (which amendments were, in themselves, generally agreed), but it was noted that it was open to Authorities to propose alternative texts which might form an acceptable compromise in future revised drafts. h

– *Other Matters*

43. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 10.03*: Reference to “technical character” were not necessary in this context. Delete the bracketed text.

*[Response: Text deleted.]*

(b) *Paragraph 10.04*: Considerations should be given to the location of this paragraph and to a change of emphasis, providing guidance to examiners.

*[Response: Paragraph was combined with 10.03(ii).]*

(c) *Paragraph 10.08*: Inline 4 after “search report” add “and the written opinion established under Rule 4Bis 1.”

*[Response: Suggested wording added. Also, paragraph 11.01 was inserted into this paragraph.]*

(d) *Paragraph 10.11*: Change the last sentence to read: “If the application complies with PCT Article 34(2)(c), the Authority need not issue a written opinion but may establish the international preliminary examination report directly.”

*[Response: Paragraph has been changed because it was not accurate. It has been rewritten to indicate that if a written opinion needs to be established, it is established by the ISA and that any further written opinions are issued by the IPEA. Also indicate that the IPEA may issue the IPEA directly if a positive IPEA can be established without the issuance of a written opinion by the ISA.]*

(e) *Paragraph 10.12*: Inline 2, change “should” to “would normally.” Inline 7, add “should” before “study.”

*[Response: Suggested wording added.]*

- (f) *Paragraph 10.13:* Redrafting within inclusion of items from Rule 66.2.

*[Response: Paragraph redrafted to include inclusion of items from Rule 66.2.]*

- (g) *Paragraph 10.14:* In the first line replace “need not be required” with “is not required.”

*[Response: Suggested wording added.]*

- (h) *Paragraph 10.15:* In the 4th line from the bottom delete “only.”

*[Response: Suggested text deleted.]*

- (i) *Paragraph 10.16:* The procedure as to lack of unity of inventions should be dealt within Chapter 12.

*[Response: Paragraph has been retained in Chapter 10 with a cross reference to Chapter 12. This paragraph is of general instruction that the examiners should consider lack of unity during the examination phase and should consult detailed instructions in Chapter 12. The paragraph has been moved prior to paragraph 10.12.]*

- (j) *Paragraph 10.19:* For consistency with Rule 66.2(c), the words “, where appropriate,” should be inserted in front of “the amendments” in line 2.

*[Response: Suggested wording added.]*

- (k) *Paragraph 10.21:* Rewrite the last line to read “The examiner may also consider whether outstanding issues would best be resolved by a further written opinion, a telephone discussion or an interview.”

*[Response: Suggested wording to last sentence has been added. Fourth and fifth sentences have been redrafted for clarification and to take in consideration of comments in paragraphs 40 and 41.]*

- (l) *Paragraph 10.23:* Redraft to indicate that the examiners should comment briefly on those arguments considered to be relevant.

*[Response: Paragraph has been redrafted to reflect that the examiners should briefly comment on relevant arguments.]*

- (m) *Paragraph 10.26:* Delete.

*[Response: Paragraph deleted.]*

- (n) *Paragraph 10.27:* Amend the wording “there is no restriction on resuming...” to “International preliminary examination may exceptionally be resumed after a report...”

*[Response: Suggested wording added. Also paragraph redrafted to indicate that a corrected IPER will not be issued merely because applicant disagrees with the IPER. Finally, paragraph 10.29 has been inserted into paragraph 10.27.]*

(o) *Paragraph 10.34:* Should be amended to make clear that interlineations are acceptable only at the discretion of the Authority and not as of right for the applicant.

*[Response: Paragraph has been redrafted to allow an IPEA to accept such amendments, but the IPEA is not required to accept such amendments.]*

(p) *Paragraph 10.36:* Should be amended to make clear that an Authority may, if it wishes, accept a change of language of correspondence without a formal request being made by the applicant.

*[Response: Paragraph has been redrafted to indicate that an IPEA may allow a change in the language of correspondence.]*

(q) *Paragraph 10.39:* There was general agreement that “will not” should be deleted. It was felt by most Authorities that the rule was appropriate since the question of added matter was simply the opinion of the examiner and the relevant sheets should be available for the Office to form their own conclusions in the national phase. Nevertheless, it was noted that it may be desirable to introduce a new stamp for amended pages, to distinguish those which are considered to contain additional subject matter.

*[Response: The paragraph has been redrafted that the examiner must clearly indicate in the IPEA each replacement sheet that contains subject matter that goes beyond the original disclosure. Further the paragraph has been amended to instruct the examiner to mark such an amended sheet at the bottom of the sheet that the amendment goes beyond the content of the application as filed. Additionally the paragraph has been amended to include instructions for when there are two replacement sheets for any given page of the application. E.g. an applicant files an acceptable amendment to sheet 2 of the description with the Demand. Applicant then files another amendment to sheet 2 that goes beyond the disclosure of the description. Under the PCT Rules, the IPEA would be established as if the second amendment had not been made (Rule 70.2(c)), but would annex (Rule 70.16) the second replacement sheet to the IPEA and not the first amended sheet even though the IPEA was being established on the first amended sheet. Therefore the paragraph has been amended to indicate that if there are two replacement pages for the same sheet, and the second contains subject matter that goes beyond the disclosure both must be annexed to the IPEA.]*

(r) *Paragraph 10.40:* There was broad agreement that the first text in square brackets should be removed, leaving these second options. However, one Authority was unfamiliar with the test of “not expressly or inherently presented” and might need to return to this after further study.

*[Response: The first text in square brackets has been deleted. Paragraph has been amended to add a definition of inherently to address the concern of one authority.]*

(s) *Paragraph 10.53:* A reference should be made in the final sentence to optional Form PCT/IP EA/428, which Authorities may use to record informal communications with the applicant.

*[Response: Suggested wording added.]*

(t) *Paragraphs 10.62 to 10.63:* These paragraphs should be combined, removing the redundancy within them. Item (iii) of paragraph 10.63 could only apply where the International Searching Authority and the International Preliminary Examining Authority were the same and may be too much a matter of internal practice to be relevant to the Guidelines.

*[Response: Paragraph 10.62 and 10.63 have been combined and item (iii) has been corrected to refer to examination copy.]*

(u) *Paragraphs 10.62 to 10.70:* These paragraphs relate to administrative matters and considerations should be given to moving them to a separate part dealing with more procedural and administrative matters.

*[Response: Paragraphs 10.62 to 10.65 have been retained. Paragraphs 10.66 – 10.70 have been removed. Access to information held by the IB (paragraph 10.66) is discussed in the PCT Applicant's Guide at paragraph 475. Paragraph 10.67 has been moved to paragraph 3.24. Access to information held by the Elected Office (Paragraphs 10.68 – 10.70) is discussed in the PCT Applicant's Guide at paragraphs 476. Since applicants will be seeking access, it is believed that the PCT Applicant's Guide is a better location and since these are research and examination guidelines, the information held by the IB and the Elected Office do not seem to belong in these guidelines.]*

(v) *Paragraph 10.67:* Amendment is required to take into account Rule 73.2, whereby the international preliminary examination report is communicated to elected Offices only after 30 months from the priority date, except where the applicant has made an express request to an elected Office under Article 40(2). It was agreed that, under Rule 94.2, there is no obligation for International Preliminary Examining Authorities to provide copies to third parties.

*[Response: Paragraph 10.67 has been moved to paragraph 3.24. Paragraph 3.24 was amended to indicate that an IPEA may provide copies to third parties.]*



*Chapter 11 (Amendments)*

44. *Paragraph 11.02* requires an amendment to make clear that, under Rule 66.4bis, an applicant may file amendments up until the International Preliminary Examining Authority has begun to draw up the international preliminary examination report, even if this is outside the time limit for reply set under Rule 66.2(d).

*[Response. Chapter 11 has been incorporated into sections 10.08(b), 10.08(c), 10.31, 10.32, 10.36 and 10.37 of Chapter 10. Comments to paragraph 11.02 have been incorporated into 10.31.]*

*Chapter 12 (Content of Written Opinions and the International Preliminary Examination Report)*

*[Response. NOTE: Many of the original paragraphs have been renumbered for clarity. Where appropriate, the reply to the comments on the old paragraphs will reference the corresponding new paragraph numbers.]*

45. The European Patent Office presented a proposal in document PCT/MIA/7/2Add.3, splitting the content of Chapter 12 into separate chapters for the written opinion of the International Searching Authority and those of the International Preliminary Examining Authority. It was explained that the main reason for this was to highlight that, while it was important to maintain common standards between the different stages, there were inevitably differences resulting from the time at which the actions were performed (particularly in the areas of considering priority, unity of invention and the fact that amendments cannot have been filed prior to the international search).

46. Advantages were seen both in maintaining the current approach of dealing with all written opinions and the international preliminary examination report in a single chapter and with dividing matters to allow the points relevant to only one stage or the other to be presented more clearly. Either way, the European Patent Office's proposal was extremely useful since it made clear the areas where the differences needed to be considered.

47. It was agreed that the United States Patent and Trademark Offices should review the issues which were raised by the European Patent Office's paper and make a new proposal reflecting their view of the best way to present these matters.

*[Response. Reviewed the proposed PCT/MIA/7/2Add.3 document in which Chapter 12 was split into two chapters (Chapters X & Y) to specifically accommodate the WO - ISA and WO - IPEA. As noted in the comments above, separating chapter 12 has the advantage of highlighting the differences which may be specific to the written opinion of the ISA & IPEA. However, splitting the chapter is not deemed necessary since all of the differences can be fully and adequately addressed in a single chapter. The revisions to the chapter were prepared by reviewing and addressing the comments below and the proposed Chapters X & Y.]*

48. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 12.02:* Add a reference to new Rule 43bis.1(a)(ii). Amend "which may be in the application" to "insofar as checked by the Authority."

*[Response. Added a reference to new Rule 43bis.1(a) on last line of the paragraph. Also, replaced the phrase "which may be in the application" to "insofar as checked by the Authority".]*

(b) *Paragraph 12.04:* Clarify which time limit applies: Article 19(1)/Rule 46, Rule 66 or Rule 43 bis.

*[Response. Added reference to Rule 43bis.1(c) (response period for WO - ISA) and 54 bis.1(a) (time limit for making a Demand).]*

(c) *Paragraph 12.13:* The word “almost” in these second lines should be deleted unless an example of a case can be found where the written opinion of the International Searching Authority would be drawn up other than on the basis of the application as filed. The status of sequence listings filed for search purposes, which under Rule 13ter do not form part of the international application, should be corrected. The United States Patent and Trademark Offices should consider adding a clarification that corrections are considered to be part of the application as filed.

*[Response. Now paragraph 12.12, deleted the word “almost”. Added clarifications that the “rectifications” are filed before the IPEA & ISA and “amendments” are filed before the IPEA. Further, deleted the problematic sequence listing example.]*

(d) *Paragraph 12.22:* Amend the words following “sequence listings” in line 1 to read “one or more of the following indications must be given with respect to these sequence listings in which the examination is based: (i)...”

*[Response. Now paragraph 12.21, amended as suggested above.]*

(e) *Paragraph 12.24:* Further clarification is required of the appropriate manner of presenting the basis of the opinion in the case where amendments are considered to go beyond the original disclosure. The Secretariat may also suggest to the Working Group that Rule 70.2(c) be clarified.

*[Response. Now paragraph 12.23, added language that the examiner will identify the amended sheet(s) that goes beyond the original disclosure and also indicate at the bottom of the amended sheet(s) that the amendment goes beyond original disclosure.]*

(f) *Paragraph 12.27(b):*

(i) Requires updating to reflect amended Rule 66.7, whereby Authorities may not request copies of priority documents which are available to them through a digital library.

*[Response. Now paragraph 12.26, new subparagraphs 12.26(b) & 12.26(d) reflect the amended Rule 66.7 regarding the availability of the priority documents from the digital library.]*

(ii) Requires updating to take into account the establishment of written opinions of the International Searching Authority when the priority document is not available, but there is still time for the applicant to provide it. There was a difference of opinion on whether the opinions should in this case make the assumption that the priority is valid (which is true in a large majority of cases) or that it is not valid (in which case detailed reports would be made on the possible relevance of “P” category documents, which may not be relevant if priority is later found to be valid, but which would give more complete information at an early stage in the event that the priority was not valid). It was noted that the international search report would always be established using the categories based on the claimed priority date and that this did not have to be consistent with the written opinion, where the validity of the priority is, where possible, taken into account. It was also noted that, if the priority claim was presumed to be valid, this may result in a misleading positive opinion of the International Searching Authority and misleading positive international preliminary report on patentability (Chapter I), which could have a negative effect on parties relying on such opinions and

reports. It was agreed that the United States Patent and Trademark Office would consider the matter further, noting that the contents of the opinion form could be amended to take this possibility more readily into account, and attempt to find a suitable solution.

*[Response. Now paragraph 12.26, new subparagraph 12.26(b) allows the authority to establish the written opinion and/or the IPEA if no priority was claimed if the priority document is not available which should allow more complete information at an early stage. Further, new subparagraph 12.26(c) also allows the WO -IPEA and/or IPEA to reconsider the validity of the priority claim when the priority document is provided in compliance with Rule 17.1 after the preparation of the ISR and WO -ISA.]*

(g) Paragraph 12.30: Refer also to the International Searching Authority.

*[Response. Now paragraph 12.29, added reference to Rule 43bis.1(b) and ISA.]*

(h) Paragraph 12.48: Add the words “insofar as checked by the International Searching Authority.”

*[Response. Now paragraph 12.49, added the phrase “insofar as checked by the International Authority” to accommodate both Searching and Examining authorities.]*

(i) Paragraphs 12.51 to 12.52: Require an appropriate heading, for example “Form of objection.”

*[Response. Now paragraphs 12.52 to 12.53, inserted the heading “Form of objection”.]*

(j) Paragraph 12.54: In line 2, change “should” to “must.”

*[Response. Now paragraph 12.55, changed “should” to “shall” as recited in Rule 43bis.1(c).]*

(k) Paragraph 12.61: There is a difference between the requirements of Article 17(1), whereby the first invention is to be searched, and of Article 34(3)(c), whereby what appears to be the main invention should be examined. It was agreed that the practical result of Rules 66.1(e) and 68.5 was that the international search report and written opinions would invariably cover the same inventions. This should be clarified.

*[Response. Now paragraph 12.62, added the language that the claims which were not subject of the written opinion of ISA need not be the subject of examination. Further, the preceding paragraph 12.60 clearly defines that the WO -ISA should be established for which the ISR is established.]*

(l) Paragraph 12.63: Clarify the term “improper amendment.”

*[Response. Now paragraph 12.64, deleted the word “improper”.]*

*Chapter 13 (Claims)*

49. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraphs 13.05 to 13.06:* These paragraphs refer to the first written opinion inviting the applicant to adopt the two-part formulation. Noting that the first written opinion is (normally) the written opinion of the International Searching Authority, it was agreed that it was quite appropriate for the ISA to invite the applicant to take a particular action. Even if no demand is filed, the applicant may find it useful to follow up the advice in amendments to the claims under Article 19 or else during proceedings in the national phase. *[Response: No change necessary]*

(b) *Paragraph 13.05:* It was suggested that the statement in the penultimate sentence “if...the applicant does not follow the invitation, the examiners should not pursue the matter further” raised the question of whether it was worth raising such an objection at all. It was felt that since the particular claim formulation was a requirement of the Rules at least an initial comment should be made. It was suggested that there may be some variation in practice in this area and that the Guideline should more clearly indicate what was common to all Authorities and where it was possible for practice to vary. *[Response: Only minor change made. Clarification as to how practice varies among the Authorities would be helpful for further revisions.]* Delete the final sentence (“See paragraph 13.20”). *[Response: Adopted]*

(c) *Paragraph 13.08:* The final sentences should be redrafted to remove the implication that an Authority may in some cases be obliged to require the two-part formulation. Where an Authority does, however, apply Rule 6.3(b), this sentence is appropriate. *[Response: Revised first and last sentence of 13.08 to address concern.]*

(d) *Paragraph 13.13:* Consider returning to the original language of paragraph III-3.2 of the International Preliminary Examination Guidelines. *[Response: Suggestion adopted.]*

(e) *Paragraph 13.14:* Adopt the second bracketed option in the text. *[Response: Suggestion adopted.]*

(f) *Paragraph 13.20:* It was recognized that practice in relation to interpretation of claims was a fundamental matter, but that there were significant variations in practice. For a number of Authorities, claims were considered to stand alone and could only be interpreted using the description in certain very limited circumstances; for these Authorities, the text in the final square brackets was very important. Others felt that the description could be relevant, either in including specific definitions of terms used in the claims, or else more generally as to how the claims should be understood. It was agreed that a harmonization of practice would not be possible at this stage and that the next draft should take this non-uniformity better into account. *[Response: Language generally agreed upon was retained; bracketed alternatives were moved to Annex to Chapter 13.]*

(g) *Paragraph 13.21:* Guidance on interpretation of claims in the form “X when used in a process Y” would be useful. IP Australia offered to provide a draft text. *[Response: Suggestion adopted.]*

(h) *Paragraph 13.22:* The statements as to the limiting effect of the preamble are contradictory. Consider deleting second, third and fourth sentences. [Response: Suggestion adopted.]

(i) *Paragraph 13.24:* It was observed that the particular words considered in this paragraph may be interpreted in various ways under different national laws. Furthermore the situation described in sub-paragraph (a) was unusual; a more relevant type of claim is one where a feature usually existing in a type of apparatus is excluded. IP Australia offered to provide a draft text for such a situation. [Response: Revisions suggested by IP Australia with respect to subparagraph (a) were not adopted. Subparagraph (a) reflects the language of current S-III-3.12. The IP Australia proposal regarding subparagraph (a) appears to introduce ambiguity. IP Australia's proposal regarding subparagraph (b) was adopted.]

(j) *Paragraphs 13.26 to 13.27:* Should be redrafted, particularly paragraph 13.26, to take into account differences in practice in relation to product by process claims. There is a difference in understanding over whether such claims relate to (and would be anticipated by) a product which has actually been produced by a process or to any product which has the same characteristics as one which had been produced by that process. Furthermore the question was raised of how to ascertain whether the result is inventive over the prior art – whether physical differences needed to be “significant” and whether differences of any nature needed to be taken into account or only ones relevant to the alleged inventive effect. It was observed that product by process claims were originally used in cases where the characteristics of the product could only be described in that way, but were now used more widely. These claims should not be confused with protection for a product made by a patented process in accordance with TRIPS Article 28.1(b). [Response: Paragraph 13.26 revised to reflect most aspects of original S-III-3.12, and to take into account areas where the Authorities seem to be in agreement. Bracketed material reflecting differing practices was moved to Annex to Chapter 13. Paragraph 13.27 was not redrafted because the text of this paragraph does not appear to be impacted by the concerns raised with respect to paragraph 13.26.]

(k) *Paragraph 13.28:* Amend preceding title to “Product and Apparatus Limitations in Process Claims.” Add “and apparatus.” [Response: Adopted]

(l) *Paragraph 13.30:* Should be redrafted to offer more advice to examiners. [Response: Revised to clarify intent of paragraph. Suggestions with regard to offering more advice to examiners would be helpful for further revision.]

(m) *Paragraph 13.31:* In the final sentence, the important matter is that the examiner is able to interpret the claim unambiguously, rather than that the claim exactly fits one of the “standard” categories. [Response: Final sentence deleted.]

(n) *Paragraphs 13.34 and 13.35:* These paragraphs should reflect how to interpret, or object to, claim during examination, rather than how it is desirable that they be drafted. [Response: Paragraph 13.34 revised consistent with suggestion. Paragraph 13.35 revised consistent with EPO suggestion in PCT/MIA/7/2Add.1 (minor changes made to EPO suggested text).]

(o) *Paragraph 13.36:* A distinction should be drawn between claims where unusual parameters may be hiding a lack of novelty and those where the parameters used are the only

effectivewayofdefiningtheinvention.[ *Response:Paragraph13.36revisedconsistentwith EPOsuggestioninPCT/MIA/7/2Add.1(minorchangesmadetoEPOsuggestedtext).*]

(p) *Paragraph13.39:* Theparagraphshouldindicateinherentproblemof trademarks:thattheycharacterizethecommercialoriginofgoods,notthe propertiesrelevant totheinvention. [*Response:Suggestionadopted.*]

(q) *Paragraph13.41:* Inthebracketedparagraphinsert“wherethishasbeen originallydisclosed”after“orlanguage.” [*Response:Suggestionadopted.*] Thefinal sentenceshouldprovideadvice totheexaminer ratherthantoapersondraftingtheclaims. [*Response:Deletedsentenceandaddedmoredetailedexplanationregardingtreatmentof negativelimitations.*]

(r) *Paragraph13.42:* Couldprovidebetteradviceontheappropriateactionfor examiners.[*Response:AdoptedEPOsuggestioninPCT/MIA/7/2Add.1(minorchanges madetoEPOsuggestedtext).Also revisedlanguageaddressingnumberofalternatives presentedwithinasingleclaim.*]

(s) *Paragraphs13.31to13.42:* Itwasagreedthattheredraftedtextforthese paragraphsshouldtaketheEPO’sdrafttextindocumentPCT/MIA/7/2Add.1intoaccount, whichappearedtoaddressmostoftheissuesnoted initems(m)to(r)above. [*Response: Suggestionadopted.*]

(t) *Paragraphs13.44and13.45:* Amend“description”to“disclosure”intheheading andinlines1and3ofparagraph13.45. [*Response:Suggestionadopted.*]

(u) *Paragraph13.47:* Shouldberedraftedtomakeclearthatitisnotnecessaryto provideexamplescoveringeverypossiblevariationwithinthescopofaclaim. [*Response: Suggestionadopted.*]

(v) *Paragraph13.48:* Delete“Thenatureoftheclaimedinvention,i.e.”inline1. [*Response:Suggestionadopted.*]

(w) *Paragraph13.51:* Deletethewords“inscope” intheheading. [*Response: Suggestionadopted.*]

(x) *Paragraph13.52:* Sinceitprovidesageneralrule,thecontentsofthisparagraph maybebetterplacedatthestartofthesectiononsupport. [*Response:Suggestionadopted; movedtofollowparagraph 13.43.Interveningparagraphsrenumbered.*]

(y) *Paragraph13.57:* Deletethewords“acceptableand”inline3. [*Response: Suggestionadopted.*] Reconsiderhowandwheretodealwiththeconceptofshiftingthe burdenofprooftotheapplicantafterthe establishmentofa *prima facie* case. [*Response: Conceptisnotcurrentlyaddressedanywhereincurrentdraftofguidelines.Chapter12will berevisedtoproposelanguagedealingwiththeconceptofshiftingtheburdenofproof.*]

(z) *Paragraph13.58:* “May”inthesecondlineshouldbereplacedby“will”sinceit isnotpssibleforthedescriptiointobesufficientifaclaimistoobroadtobesupportedbyit. [*Response:Suggestionnotadopted;paragraphrevisedtoreflectintenttoindicatethat in somecases,theclaimmayfailtocomplywithboththesufficiency(enablement)andsupport requirements.*] Add“(seeparagraph19.14)”attheend. [*Response:Suggestionadopted.*]

(aa) *Paragraph 13.59:* If subject matter from the claims is introduced into the description which thereby creates a contradiction or inconsistency, this will have to be resolved by amendment either of the claims or description. *[Response: Substance of above sentence added to paragraph 13.59.]*

(bb) *Paragraphs 13.61 to 13.62:* Add a definition of "biological material." *[Response: Adopted EPO suggestion from PCT/MIA/7/2Add.1.]* Redraft to reflect differences in practice, whereby before the EPO a deposit is only relevant in order to remedy issues of enablement, whereas in US practice the deposit may also be relevant to support. *[Response: Revised in accordance with EPO suggestion, assuming that the other Authorities also permit reliance on a deposit to remedy issues of enablement. Relevance of a deposit to support (consistent with at least US practice) is reflected in the Annex to Chapter 13.]*



*Chapter 14 (Prior Art)*

50. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) Paragraph 14.01: The paragraph should be amended to clarify that an admission is not conclusive proof that the subject matter referred to is prior art. The applicant may rebut the presumption. *[Response: Suggestion adopted.]*

(b) Paragraphs 14.05 and 14.07: Should be reviewed following conclusions on the treatment of "P" category documents when the priority date cannot be established. *[Response: No change made. The subject matter in brackets needs to be further discussed at the next MIA meeting.]*

(c) Paragraph 14.08: Should remain as it stands – it was agreed that it was necessary for the international preliminary examination report to draw attention to the relevant published patent applications and patents. *[Response: Suggestion adopted. Subject matter in brackets has been deleted.]*

(d) Paragraph 14.10: Any proposal for a new symbol will be referred to the Standing Committee on Information Technologies Standards and Documentation Working Group (see also item 32(y) above). *[Response: Sentence added at the end of the bracketed subject matter to indicate that the issue of new category symbols will be referred to the Standing Committee on Information Technologies Standards and Documentation Working Group.]*

(e) Paragraph 14.11: Some concern was expressed at the idea of providing documents relevant to sufficiency as well as novelty and inventive step. It was also noted that the word "incorrect" at the end of the first sentence might be misleading. Noting the statement that these searches should not specifically be extended to look for such matter, it was agreed that it was useful to provide evidence which had become known to the examiner on matters that he was required to comment on. *[Response: No change made to the word "incorrect" since this is the same language used in the Administrative Instructions Section 507(e).]*

(f) Paragraph 14.12: It was questioned whether there was any difference in practice in respect of whether a document was prior art if not indexed. *[Response: No change made. As noted in the second sentence of paragraph 14.12, whether a document is indexed or not is a factor to be considered in determining the accessibility of the content of the document to the public. The principle for determining accessibility is set forth in the first sentence.]*

(g) Paragraph 14.13: A new heading, such as "Disclosure on the Internet," is required. To be drafted in more general terms. The term "credibility" in particular requires further consideration. *[Response: Suggestion regarding new heading, adopted and new sentence added at the end of the paragraph regarding credibility of website.]*

Chapter 15 (Novelty)

51. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 15.01*: The words “persons of ordinary skill” should be replaced by “persons skilled in the art.”  
[Response: Adopted. This change was also made to paragraphs 15.03, 15.04 and 15.06.]

(b) *Paragraph 15.02*:

(i) The reference to the “effective date” should be reviewed in view of the lack of agreement on whether the teaching of a document should be assessed for novelty purposes as it would have been understood when it was published, or on the priority date of the international application in the light of knowledge discovered in the meantime (see document SCP/8/9 Prov., paragraph 323, summarizing discussion of draft Rule 14(2) under the draft Substantive Patent Law Treaty (SPLT)).

[Response: Document SCP/8/9 Prov., paragraph 323 indicates there was some discussion as to whether the relevant date for the determination of the scope of the item of prior art should be the claim date or the date on which the item of prior art was made available to the public. An Annex to Chapter 15 has been added to address the two alternatives for the cutoff date applicable to extrinsic evidence that may be considered in making the enablement/novelty determination. “Effective date” now appears only in A15.02[01]. It continues to be defined as the publication date in the case of a previously published document. A question was raised with respect to patents that rely upon a deposit of biological material to meet the sufficiency of disclosure requirements of Article 5. In such a situation, it was asked whether the prior art document was required to be enabling as of its filing date, rather than as of its date of publication.]

(ii) The last sentences should be broadened to indicate that this principle is not limited specifically to chemical compounds.

[Response: This objection has been addressed by specifically setting forth, in the first sentence of paragraph 15.02, the requirement for the prior art document to enable a person skilled in the art to carry out the claimed invention.]

(c) *Paragraph 15.03(iii)*: Add “in combination” after “disclosed.”  
[Response: Adopted.]

(d) *Paragraph 15.06*: Should be reviewed to indicate that the teaching of a second document incorporated by reference should only be considered to the extent indicated by that reference, though it is recognized that this may not be clear when the reference is not specific.

[Response: Revised to indicate the teachings of these second references may be regarded as incorporated into the primary document “to the extent indicated in the primary document”. Also, occurrences of “effective date” have been changed to “date of publication”. Due to the divergent procedures now set forth in the Annex, cross-reference to paragraph 15.02 and to the Annex were inserted in paragraph 15.06. Not all Authorities require the enablement issue to have been resolved on the publication date of the primary document. See A15.02[02].]

(e) *Paragraph 15.07*: Should be clarified in view of different understandings of anticipation: the majority of Authorities saw a claim which embraced an alternative

as a single entity, which was anticipated if any one of the alternatives had been disclosed (though it was of course likely that it could be amended to overcome the novelty objection). One Authority however viewed such a claim as being notionally many claims relating to the individual alternatives and only those parts which had been disclosed were anticipated, rather than the claim as a whole.

*[Response: The language has been modified to cover both understandings of anticipation.]*

(f) *Paragraph 15.10:* An amendment was suggested to indicate that where a claimed range overlaps with a previously disclosed range, there will normally be a lack of novelty. However it was agreed to leave the draft as it stands since the generality of the draft reflects the fact that the issue of ranges is difficult and case law on the subject varies significantly.

*[Response: Since it was agreed to leave the draft as it stands, paragraph 15.10 has not been revised.]*

*Chapter 16 (Inventive Step)*

52. This chapter was recognized as an area where there are many different approaches worldwide. The draft needed to provide guidance which was detailed enough to allow examiners to apply common rules. However, there may be a need to establish an Annex to provide guidance where practices diverge.

53. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 16.01*: The word “any” in line 4 should be reviewed since many jurisdictions would not be so strict. *[Response: The third sentence has been replaced with the definition of novelty set forth in Chapter 15, paragraph 15.01: “A claim lacks novelty if every element or step is explicitly or inherently disclosed within the prior art”]*

(b) *Paragraph 16.03*: Item (ii) should be amended to “the references must be considered as a whole and must prompt the skilled person into combining the teachings of the documents so as to arrive at the subject matter as claimed.” The European Patent Office offered to propose new language for item (iv). *[Response: Adopted suggestion for item (ii); awaiting proposed new language for item (iv)]*

(c) *Paragraph 16.08*: The European Patent Office had made comments in document PCT/MIA/7/2Add.1. *[Response: Paragraph 16.08 describes general considerations to be taken into account when determining inventive step. The paragraph has been amended to recognize that one specific approach for determining inventive step is the problem-solution approach. The problem-solution analysis is described in the Annex to Chapter 16, the language being adopted from the EPO comments in PCT/MIA/7/2Add.1.]*

(d) *Paragraph 16.12*: The term “specialist in that field” may be misleading in implying a higher level of knowledge than an “ordinary practitioner.” *[Response: Adopted]*

(e) *Paragraphs 16.13 and 16.14*: Should be redrafted to make clear throughout that it is the teachings within documents which are being combined, rather than the documents as a whole. *[Response: The paragraphs have been amended to emphasize that the teachings within the documents are being combined]*

(f) *Paragraph 16.15(a)(ii)*: These two sentences should be clarified to indicate better that the applicant’s recognition within the international application that an element is equivalent to another which had previously been used for a purpose does not mean that the use of this element instead of the other is obvious. *[Response: Adopted]*

(g) *Paragraph 16.15(b)(ii)*: Add at the end “providing the means for overcoming the technical difficulties are defined in the claim.” *[Response: Adopted]*

(h) *Paragraph 16.16*: One Authority suggested that “and” should be replaced by “and/or” in the sentence in square brackets. Another suggested that neither the suggestion nor the reasonable likelihood of success being found in the prior art were absolutely essential factors, though they were certainly highly relevant. The other Authorities which spoke considered that both were necessary. The United States Patent and Trademark Office offered to attempt to draft the paragraph taking these differences of view into account. *[Response: Paragraph has been redrafted to take alternative practices into account and to reflect that*

*reasonable likelihood of success is a factor to be considered when determining the rationale for combining references.]*

*ng motivation or*

*Chapter 17 (Industrial Applicability)*

54. The United States Patent and Trademark Office indicated that this chapter had been introduced because it was an area where the current Guidelines lacked any significant guidance. While the terminology used was largely derived from that Office's practice, it was not believed that "utility" was different from "industrial applicability" and should be included at least as a manner of approaching this issue. It was pointed out that "industrial applicability" was the term used under the PCT and this should be used. It was acceptable to have a reference to utility, but the status of this should be clear. It was agreed that the chapter would be further redrafted and the results of the survey currently being undertaken by the Secretariat on national laws in this area would be considered.

*[Response: Paragraph 17.01 has been revised to indicate that "[a] claimed invention may be considered industrially applicable if it has a specific, substantial, and credible utility". Other than this single reference to "utility", all other references to utility in paragraphs 17.01 - 17.05 have been changed to discussions of the "industrial applicability" requirement. Paragraphs 17.07-17.09 have been moved to an Annex to Chapter 17. These paragraphs provide specific guidelines for determining whether a particular claimed invention has "utility".*

*The results of the survey currently being undertaken by the Secretariat on national laws in this area have been considered. It is felt that further discussion among the PCT International Examining Authorities should take place regarding: 1) claims that cannot be considered to be susceptible of industrial application because they fall entirely within the private or personal sphere of a human being; and 2) claims to inventions such as gene sequences and protein sequences that cannot be considered to have industrial applicability because the applicant has not disclosed a specific, substantial, and credible utility for the invention.]*

*Chapter 18 (Priority)*

55. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 18.09*: An equivalent change to the term “directly and unambiguously” as in paragraph 15.01 in relation to novelty. *[Response: Adopted]*

(b) *Paragraphs 18.12 and 18.17*: Should be updated to reflect amended Rule 17.1, allowing for the possibility of the priority document being available from a digital library. *[Response: Adopted]*

*Chapter 19 (Content of the International Application (Other than the Claims))*

56. The European Patent Office's proposed alternative to paragraph 19.14 from document PCT/MIA/7/2Add.1 was agreed.

*[Response. The proposed paragraph 19.14 from PCT/MIA/7/2Add.1 has been incorporated.]*

57. See also "Addressee of Guidelines," paragraph 25, above.

*[Response. The issue of Addressee of Guidelines is still under consideration. The question remains whether or not chapter 19 is directed primarily to the examiners in the various International Searching and Preliminary Examining Authorities. Generally, this chapter merely provides explanation of concepts and contents of the international application which would serve to benefit the applicants and practitioners more than the examiners. Although somewhat useful to the examiners of these searching and examining authorities, chapter 19 can be eliminated from the guidelines and possibly be placed in the Applicant's Guide.]*



*Chapter 20 (Exclusions From, and Limitations of, International Search and International Preliminary Examination)*

58. The general question was raised of whether it was necessary for an Authority to give an opinion on novelty and inventive step for claims which had been found to lack industrial applicability. It was suggested that this would depend on circumstances. Where a claim was framed in such a way that it was not considered to include an industrial application, but it could be seen how it might be amended to overcome this problem, then it would be desirable to include an opinion on novelty and inventive step. If the Authority could see no way in which this objection could be overcome then it may be appropriate not to perform a search or to establish an opinion as to novelty or inventive step. It was agreed that the next draft should include a paragraph on this subject, not necessarily in this chapter (possibly in Chapter 12).

*[Response: It appears that this issue should be more properly dealt with in Chapter 12. A cross-reference is suggested in paragraph 20.14, which involves the distinct issue of citing art relevant to determination of industrial applicability rather than whether a novelty or inventive step analysis is appropriate.]*

59. The proposed amendments to paragraphs 20.01, 20.08, 20.10, 20.11 and 20.15 set out in document PCT/MIA/7/2Add.1 were accepted, subject to the need for some redrafting.

*[Response: For paragraphs 20.01, 20.08, 20.10, and 20.11, changes agreed to have been incorporated. As to 20.15, in response to the suggestion that the paragraph is confusing and should be redrafted, the paragraph has been entirely redrafted to discuss when such informal contacts are appropriate in respect of this matter.]*

60. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 20.04(c)*: The words “industrial applicability” in line 7 should be reviewed for consistency with the rest of the paragraph.

*[Response: Upon review, the two sentences involving “industrial applicability” in lines 7 and 9-10 appear to be drawn to a situation that does not clearly fit within the exclusion of “schemes, rules or methods of doing business, performing purely mental acts or playing games.” In order to address this matter, we suggest deletion of the two sentences beginning with “However, novel apparatus which only carries...” and ending with “would require preliminary search and examination.” If, subject to further discussion, the particular matter of an apparatus which solely carries out a process lacking industrial applicability should be addressed, this topic should likely be addressed in a different manner or different section.]*

(b) *Paragraph 20.11*: The meaning of the words “non-prior art grounds,” which appear in the final sentences explaining each of Examples 1 to 3, should be clarified (these words do not appear in the version of this paragraph noted in paragraph 59, above).

*[Response: We have now provided a definition of “non-prior art grounds” in parentheses referring to the requirements of Articles 5 and 6 as well as industrial applicability. We hope that this clarifies the terminology.]*

*Chapter 21 (Unity of Invention)*

61. The Meeting noted that there was as yet no common approach among Authorities as to how the PCT criteria for determining unity of inventions should be applied (see Articles 17(3) and 34(3) and Rule 13). This was exemplified by discussion of paragraph 21.02 and a specific example concerning the question of whether support and sufficiency may be relevant to the existence of a “contribution over the prior art.” It was agreed that, for the foreseeable future (and pending any developments in the context of consideration of the draft Substantive Patent Law Treaty by the WIPO Standing Committee on the Law of Patents), the Guidelines would need to reflect a range of different practices, and Chapter 21 should be revised accordingly.

*[Response: A revised example has been prepared to better explain the use of support and sufficiency in the determination of a “contribution over the prior art.” As for reflection of a range of different practices within the Guidelines, revision will follow the provision and review of further guidance as to practices in various Authorities.]*

62. The Meeting noted the outline of the practice of the European Patent Office set out in document PCT/MIA/7/2Add.1, Annex II, and agreed that it would be useful if other Authorities were to provide similar outlines via the MIA electronic forum.

*[Response: See above.]*

63. The question of how the different practices should appear in the Guidelines (for example, whether in the text of Chapter 21 or in one or more Annexes), remained to be determined. It was not clear at this stage how much agreement could be reached on a common core of practice or of how this might best be presented in the Guidelines. An overriding consideration was the need for each Authority to be able to provide the Guidelines to its examiners as a practical and unambiguous work tool.

*[No comment necessary.]*

64. The Meeting agreed with the proposed relocation of examples illustrating unity of invention practice from the Administrative Instructions (Annex B, Part 2), where they currently appear, to the Guidelines.

*[Response: The explanatory paragraph in the beginning of the chapter concerning incorporation of Annex B into the guidelines has been deleted.]*

65. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 21.19:* IP Australia offered to provide further examples illustrating unity of invention practice in the area of biotechnology.

*[Response: The two examples provided by IP Australia have not been incorporated.]*<sup>1]</sup>

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<sup>1</sup>These examples are included in document PCT/MIA/8/2Add.2 for consideration by the Meeting.

(b) *Paragraph 21.19, Examples 18ff:* It would be desirable to include some non-chemical examples of “Markush practice.”

*[Response: The two examples provided by IP Australia are both directed to non-chemical examples of “Markush practice.”]*

(c) *Paragraphs 21.26 to 21.30:* These paragraphs would need to be reviewed in the light of the Working Group’s intention to review the Regulations concerning the protest procedure in cases of findings of lack of unity of invention (see document PCT/R/WG/3/5, paragraphs 95 to 98).

*[Response: Awaiting further direction from the Working Group.]*

*Chapter 22 (Rule 91 – Obvious Errors in Documents)*

66. The Meeting agreed that a Chapter dealing with the rectification of obvious errors under Rule 91 should be included in the Guidelines but, noting that the Working Group had requested that proposals for amendment of Rule 91 be submitted to it by the Secretariat, did not discuss the draft text of Chapter 22 in detail. Authorities were invited, in the meantime, to submit comments via the electronic forum on the existing text, particularly in relation to the matters covered in paragraphs 22.01 to 22.04.

*[Response: In paragraph 22.02, revised the definition of “Anyone” to “a hypothetical person of average intelligence who has normal ability to read and write the language in which the application has been properly filed and/or translated but who has no special skill in the particular art involved in the application”.]*

67. The word “foreseen” at line 5 of paragraph 22.06 should be amended to “expected” equivalent to the amendment agreed to in paragraph 10.49.

*[Response: Changed the word “foreseen” to “expected.”]*

Chapter 23 (Quality Assurance)

– Quality Standards and Quality Management

68. The Meeting noted the conclusions of the Working Group on Reform of the PCT as to how further work relating to the quality of international search and international preliminary examinations should proceed (see document PCT/R/WG/3/5, paragraph 111):

“111. The Working Group agreed that work in this area should continue along the following two paths:

(a) The standards to which PCT search and examinations should conform should be established in the PCT International Search and Preliminary Examination Guidelines. Work should continue on revision of those Guidelines, which would be effected by January 1, 2004, when the recently adopted enhanced international search and preliminary examinations system came into effect.

(b) A “virtual” task force should be established to consider which of the other points noted above [in paragraphs 101 to 110], or in document PCT/R/WG/3/4, should be taken forward and how. The International Bureau would set up a page on its Web site, open to registration by any State or organization represented in the Working Group, with an electronic forum and mailing list to facilitate discussion. The work of the task force would be coordinated by the United Kingdom. The results of the work of the task force would be reported to the Working Group and to the Meeting of International Authorities, the first such report being requested by the end of April 2003.”

69. The Meeting noted that the electronic forum for the task force had been set up<sup>2</sup> and that a further discussion paper prepared by the United Kingdom Patent Office had been posted on it. It was agreed that Chapter 23 of the draft Guidelines should refer in an explanatory note to the work of the Working Group and the task force. The results of that work should also be taken into account in the future, when it became available, in the substantive text of the Chapter. In the meantime, the present text of paragraphs 23.07 and 23.08 should be omitted. It was noted that Authorities were, of course, free to take part in the work of the task force. *[Response: Suggestions adopted.]*

70. The Meeting noted that a clear distinction could not easily be drawn between matters relating to quality standards and those relating to quality management and assurance, and that both matters were of vital concern to the International Searching and Preliminary Examining Authorities in ensuring that their work met the expectations of users, including applicants, third parties, and designated and elected Offices.

71. Certain Authorities expressed the view that it would be appropriate for the Meeting to address quality management and assurance issues in parallel with the work of the task force; other Authorities believed that the Meeting should restrict its approach, for the time being, to quality standards.

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<sup>2</sup> See <http://www.wipo.int/pct/reform/qualityframework/en>.

72. The Japan Patent Office reserved its position on the contents of Chapter 23, stating its view that the Meeting was not the appropriate forum for consideration of quality management and assurance issues and that the Meeting should await the results of the work of the task force on such issues before attempting to deal with them in the Guidelines.

73. IP Australia, while believing that a detailed discussion by the Meeting would be premature at this stage, said that the application of ISO 9000 could be not only possible but also desirable.

74. The European Patent Office, while welcoming a discussion on quality, expressed concern with one aspect of the United Kingdom's discussion paper, namely, its proposal that the quality of the work of the Authorities be subject to review by an independent (that is, external) body. The Office believed that the proposal would create practical difficulties and that the internal mechanisms for quality management and assurance would be more appropriate. The Swedish Patent and Registration Office, the United States Patent and Trademark Office, IP Australia, the Russian Agency for Patents and Trademarks, the Austrian Patent Office, the Korean Intellectual Property Office, the Canadian Intellectual Property Office and the Spanish Patent and Trademark Office also expressed opposition to or concern about the proposal for external quality review.

75. The Meeting, noting that the first report on the work of the task force was to be available by the end of April 2003, agreed that consideration of that report be included on the agenda for the next session of the Meeting, to be held in May 2003, and that the United Kingdom Patent Office should be invited, in its capacity as task force coordinator, to attend the session for that agenda item for the purpose of presenting the report to the Meeting.

– *Other Matters*

76. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Chapter title*: This should be amended to read “Standards for Quality Assurance.” [*Response: Suggestion adopted.*]

(b) *Paragraph 23.06(i)*: The repetition of the word “reviews” should be reviewed. [*Response: Suggestion adopted.*]

[End of Annex and of document]