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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT

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

CONTENT OF CERTAIN FORMS: INTERNATIONAL PRELIMINARY EXAMINATION
REPORT UNDER CHAPTER II OF THE PCT

Document prepared by the International Bureau

1. At its seventh session, the Meeting of International Authorities considered the matter of how amended sheets should be treated and referred to when they are considered to include amendments which go beyond the disclosure in the application as filed (see PCT/MIA/7/5, paragraph 43(q)). It was felt by most Authorities that these sheets should be available with the international preliminary examination report for elected Offices to form their own conclusions in the national phase. Nevertheless, it was noted that it may be desirable to distinguish more clearly those new pages which are considered to contain additional subject matter from the others.
2. Annex I of this document contains a proposal by the United States Patent and Trademark Office to expand the contents of check-box 5 in Box I of the international preliminary examination report (Form PCT/IPEA/409), as shown in Annex II of this document, to include further detail of which amendments were considered as if they had not been made for the purposes of establishing the report. Annex III shows the current Box I for reference.
3. The Meeting may wish to consider whether this modification should be made in conjunction with associated amendments to Rules 70.2(c) and 70.16, which could be presented to the Working Group on Reform of the PCT (at its fourth session) for consideration and for subsequent adoption by the PCT Assembly (at its thirty-second session)

and entry into force on January 1, 2004; in addition, modification of the Administrative Instructions under the PCT and the Guidelines for International Search and Preliminary Examination would need to be made for entry into force also as from January 1, 2004.

4. The Meeting of International Authorities is invited to discuss the proposals of the United States Patent and Trademark Office set out in Annexes I and II to this document and to make a decision in respect of paragraph 3.

[Annex I follows]

ANNEX I

PROPOSAL BY THE UNITED STATES PATENT AND TRADEMARK OFFICE

Proposed Revision to Box No I – Basis of the report (Form PCT/IPEA/409)

The proposed revision to Box No I would allow the IPEA to distinguish those sheets that form the basis of the report from those sheets that the IPEA considers to go beyond the disclosure as filed and therefore have not been taken into account to establish the report. The sheets of the description, claims, drawings and sequence listing part of the description that form the basis of the report, including later filed sheets which are annexed to the report, would be indicated in item 1. Where the report has been established as if (some of) the amendments had not been made since they have been considered to go beyond the disclosure as filed, those sheets of the description, claims, drawings and the sequence listing part of the description would be separately indicated in item 5 and also annexed to the report. Any such sheets could be marked "NOT CONSIDERED BY THE IPEA (RULE 70.2(c))" to distinguish them from amended sheets that formed the basis of the report.

When reviewing the revision of the form itself¹, we realized that on the second sheet (Continuation of: I Basis of the report), we should have replaced “in the Supplemental Box” with ---below--- since there would be sufficient room on the page to include the reason why the IPEA considers the amendment to have new matter. Item 5 would then read:

“This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated below (Rule 70.2(c)).**

“** Any replacement sheet containing such amendment must be annexed to this report.”

[Annex II follows]

¹ As shown in Annex II

ANNEX II

Proposed Revision

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. _____

I. Basis of the report

1. With regard to the elements of the international application:*

- the international application as originally filed
- the description:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- the claims:
 pages _____, as originally filed
 pages _____, as amended (together with any statement) under Article 19
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- the drawings:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- the sequence listing part of the description:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- the language of publication of the international application (under Rule 48.3(b)).
- the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- contained in the international application in written form.
- filed together with the international application in computer readable form.
- furnished subsequently to this Authority in written form.
- furnished subsequently to this Authority in computer readable form.
- The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- the description, pages _____
- the claims, Nos. _____
- the drawings, sheets/fig _____

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. _____

Continuation of: | I. , Basis of the report

5. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

** Any replacement sheet containing such amendments must be annexed to this report.

the description:

pages _____, filed with the demand

pages _____, filed with the letter of _____

the claims:

pages _____, as amended (together with any statement) under Article 19

pages _____, filed with the demand

pages _____, filed with the letter of _____

the drawings:

pages _____, filed with the demand

pages _____, filed with the letter of _____

the sequence listing part of the description:

pages _____, filed with the demand

pages _____, filed with the letter of _____

ANNEX III

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. _____

I. Basis of the report

1. With regard to the elements of the international application:*

- the international application as originally filed
- the description:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- the claims:
 pages _____, as originally filed
 pages _____, as amended (together with any statement) under Article 19
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- the drawings:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- the sequence listing part of the description:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- the language of publication of the international application (under Rule 48.3(b)).
- the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- contained in the international application in written form.
- filed together with the international application in computer readable form.
- furnished subsequently to this Authority in written form.
- furnished subsequently to this Authority in computer readable form.
- The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- the description, pages _____
- the claims, Nos. _____
- the drawings, sheets/fig _____

5. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.