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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

REPORT

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its eighth session in Washington, D.C., from May 5 to 8, 2003.
2. The following nine International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Canadian Intellectual Property Office, the European Patent Office, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the Spanish Patent and Trademark Office, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in the Annex to this report.

OPENING OF THE SESSION

4. Mr. Philip Thomas, Director, Patent Policy Department, WIPO, on behalf of the Director General, opened the session and welcomed the participants, and thanked the United States Patent and Trademark Office for having offered to host the session in Washington, D.C.

5. The Hon. James E. Rogan, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and Mr. Jon W. Dudas, Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, also welcomed the participants. They noted that this was the first session of the Meeting that had been held in the United States of America, and wished the Meeting success in its important work, particularly that connected with the PCT International Search and Preliminary Examination Guidelines.

ELECTION OF A CHAIR

6. The Meeting unanimously elected Mr. Nicholas Godici (United States Patent and Trademark Office) as Chair.

ADOPTION OF THE AGENDA

7. The Meeting adopted the agenda contained in document PCT/MIA/8/1 Prov.

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8. The Meeting agreed that this report would contain the principal conclusions reached at the session rather than a record of the discussion in its entirety.¹

PCT MINIMUM DOCUMENTATION

9. The International Bureau informed the Meeting that it had sent a circular (C.PCT/911, dated March 28, 2003) to the members of the PCT Committee for Technical Cooperation (PCT/CTC), as had been requested by the Meeting at its previous session (see document PCT/MIA/7/5, paragraph 13). The circular invited the members of PCT/CTC to evaluate the Non-Exhaustive Inventory of Traditional Knowledge -Related Periodicals attached to the circular and to suggest a selection of appropriate periodicals from the Inventory, or other traditional knowledge -related periodicals, on the basis of the criteria set out in the circular (which were those that had been agreed by the Meeting; see document PCT/MIA/7/5, paragraph 12). The circular also invited the members of PCT/CTC to investigate alternative ways for providing access to traditional knowledge documentation, for example, by using databases that exclusively or partly contained relevant traditional knowledge data. The circular invited responses by June 1, 2003.

10. The Secretariat indicated that the responses to that circular would be reported to the next session of the Meeting, at which further steps to be taken in relation to the matter would be discussed.

¹ References in this document to "Articles," "Rules," "Sections" and "Forms" are, respectively, unless otherwise indicated, to those of the Patent Cooperation Treaty (PCT), the Regulations under the PCT ("the Regulations"), the Administrative Instructions under the PCT ("the Administrative Instructions") and the Forms annexed to the Administrative Instructions.

PROPOSEDREVISED PCT INTERNATIONAL SEARCH AND PRELIMINARY
EXAMINATION GUIDELINES

11. A first draft of the revised Guidelines had been discussed by the Meeting at its previous session (see document PCT/MIA/7/5, paragraphs 18 to 79). Discussions at the present session were based on documents PCT/MIA/8/2, containing a further revised draft prepared by the United States Patent and Trademark Office, and documents PCT/MIA/8/2 Add.1 and 2 Add.2 containing comments, respectively, by the United States Patent and Trademark Office and by the United States Patent and Trademark Office, the European Patent Office, the Russian Agency for Patents and Trademarks and IP Australia. In addition, the United States Patent and Trademark Office made a number of further proposals following discussions which that Office had had with the Japan Patent Office and the European Patent Office and also with IP Australia. Comments that had been submitted to the International Bureau by the Russian Agency for Patents and Trademarks, the Institute of Professional Representatives Before the European Patent Office (EPI) and the Union of Industrial and Employers' Confederations of Europe (UNICE) were also taken into account by the Meeting.

12. The Meeting agreed with the draft text contained in document PCT/MIA/8/2 subject to the comments and changes noted in the following paragraphs, and requested the United States Patent and Trademark Office to prepare a further revised draft accordingly, for consideration by the Meeting at its next session. The European Patent Office confirmed its offer, made at the previous session, to draft a concrete proposal which would draw together formalities and administrative matters relating to both international search and international preliminary examination (see document PCT/MIA/7/5, paragraph 22). Following the next session, at which it was expected that any outstanding substantive matters would have been resolved, the Secretariat would review the entire text for consistency of style and format.

General

13. The draft Guidelines would need revision, particularly in paragraph 3.13 and throughout Chapter 9, if the handling fee were to be abolished, as had been proposed by the International Bureau in document PCT/R/WG/4/8 submitted for consideration by the Working Group on Reform of the PCT ("the Working Group").

14. The draft Guidelines would require checking for consistency with the modified and new Forms which were adopted following the consultation currently underway pursuant to Rule 89.2(b) (see document PCT/MIA/8/4 and circular C.PCT/916, dated April 25, 2003).

Chapter 1

15. *Paragraph 1.01:* In the last line, "will be" should be replaced by "is."

16. *Paragraph 1.02:* In the last line, "Examination" should be replaced by "Examining."

17. *Paragraph 1.04:* In line 4, "also" should be deleted.

18. *Paragraph 1.05:* In line 10, "highlighted" should be replaced by "explained."

19. *Paragraph 1.08:* In line 8, "43 bis. Thus" should be replaced by "43 bis; thus."

20. *Flowchart*: The flowchart appearing at the end of Chapter 1 should be reviewed in respect of its format.

Chapter 2

21. *Paragraph 2.19*: In lines 5 to 9, the text “and to the payment... paragraph 63)” should be deleted.

22. *Paragraphs 2.20 and 2.21*: The text of these paragraphs should be combined.

Chapter 3

23. *Paragraph 3.08*: In the last sentence, “Current” should be deleted and the URL appearing at the end of the sentence should simply read “www.wipo.int/pct” without a reference to the search term to be used.

24. *Paragraph 3.21*: In the first sentence, the word “that” should be inserted after “provided” and the word “was” should be deleted.

25. *Paragraph 3.24*: In line 2, a new sentence should begin at the word “neither.” In line 3, the word “therefore” should be inserted between “may” and “allow.”

26. *Paragraph 3.28*: In lines 7 to 10, the text “and to the payment... paragraph 63)” should be deleted.

Chapter 4

27. *Paragraph 4.03*: In line 2, the words “effective date” should be added after “prior art.” In addition, the text of the paragraph should be expanded to give more direction to examiners as to how to proceed in the conduct of the international search having regard to the fact that different national Offices take different approaches in relation to prior art effective date.

28. *Paragraph 4.05*: A reference to Rule 33.1(d) should be added preceding the paragraph. At the end of the first sentence, the words “, which written disclosure constitutes the prior art” should be added. In addition, the paragraph should be expanded to clarify the approach to be taken by examiners, having regard to the fact that oral disclosures were not considered to be prior art for the purposes of the international phase but may be so considered for the purposes of the national law in the national phase.

29. *Paragraph 4.10.1*: At the end of the first sentence, the words “to file the required correction” should be replaced by “to correct the application by adding the free text to the main part of the description.”

30. *Paragraph 4.18*: This paragraph should be deleted since it dealt with matter covered in Chapter 13.

31. *Paragraph 4.19*: These two sentences should be deleted.

32. *Paragraph 4.20*: In line 3, the words “in writing or by phone” should be deleted.

33. *Paragraph 4.33:* The square brackets appearing around the paragraph should be deleted and the text retained.
34. *Paragraph 4.39:* In the last sentence, the words “the date of publication of” should be inserted before “the international application.”
35. *Paragraph 4.45:* In lines 7 to 8, the words “should be considered” should be replaced by “may provide a useful guide.” In addition, the reference to “Annex B” should be replaced by a reference to an “Intellectual Property Digital Library” (IPDL) to be established on WIPO’s website. The text for that IPDL would be provided by, and would be maintained in the future by, the United States Patent and Trademark Office in consultation with the other Authorities. (See also paragraph 117, below.)
36. *Paragraph 4.51:* At the end of the paragraph, the words “at or around the time the invention was made” should be deleted.
37. *Paragraph 4.52:* These two sentences should be deleted and replaced by the following: “Where the examiner intends to cite any prior art likely to be of assistance in determining sufficiency of description, then while conducting a search in a relevant area, the examiner should identify all documents, regardless of publication dates, which are highly relevant to the determination of novelty, inventive step, adequacy of support, and industrial applicability of the claimed invention.”
38. *Paragraph 4.57:* The third sentence should be deleted. The Authorities took different views as to whether and to what extent details concerning the search strategy used by the examiner could and should be recorded in the file of the International Searching Authority, in particular concerning search terms used in the consultation of electronic databases (see, in particular, the alternatives “must” and “may” in line 2). Certain Authorities believed that such details should be recorded wherever possible and that examiners should be encouraged to do so, particularly having regard to the usefulness of such information to other Offices under possible “work sharing” arrangements when processing the same application in the national phase. Other Authorities believed that the recording of full details of search strategies was impracticable, that such a requirement would be impossible for examiners to meet, and that misleading results would follow. It was agreed that further consideration of the matter was needed, including in the context of the more general question of a common quality framework. In any event, the Authorities agreed to consider further the possibility of mandatory recording of such details in specific cases, such as searches of databases of nucleotide and/or amino acid sequence listings.
39. *Paragraph 4.59:* This paragraph should be deleted.
40. *Paragraph 4.60:* At the end of the paragraph, the following sentence should be added: “Where the date of the reference is not clearly established, the examiners should cite the document as a category “L” document and indicate in the search report that the exact date of publication has not been established.”
41. *Paragraph 4.68:* This paragraph should be deleted.

Chapter 6

42. *Paragraph 6.07:* A reference should be made, in this paragraph or elsewhere (for example, by way of a definition at the beginning of the Guidelines), to the need for the word “sheet” to be interpreted to include both a sheet on paper and its electronic equivalent.
43. *Paragraph 6.09:* In line 2, a reference should be added to “the special sheet (if any)” of the international search report.
44. *Paragraph 6.24:* In line 2, the words “The examiners should ensure” should be replaced by “It should be ensured.”
45. *Paragraph 6.25:* The text of the paragraph should be deleted and replaced by the following: “If the International Searching Authority is sending out documents, this box should be completed.”
46. *Paragraph 6.46.1:* In line 2, “their” should be replaced by “its.”
47. *Paragraph 6.53:* The text should be moved to appear under the heading “Fields searched” (see paragraph 6.55).
48. *Paragraph 6.54:* In line 3, the words “of the assignment” should be deleted.
49. *Paragraph 6.56:* The paragraph as a whole, and particularly the reference in line 3 to Annex B, should be reviewed having regard to the matter mentioned in paragraphs 35, above, and 117, below.
50. *Paragraph 6.57:* At the end of the first sentence, the words “when practicable” or “unless impracticable” should be added.
51. *Paragraphs 6.58 and 6.59:* Any requirement to include search queries and keywords (search terms) used to search an electronic database should be reviewed; see the discussion in paragraph 38, above.
52. *Paragraph 6.61, note (c):* The text should be redrafted to make its intent clearer, particularly in its reference to “regions” of sequence listings.
53. *Paragraph 6.62:* The text should be reviewed noting that it was sometimes impossible for practical reasons to include details of earlier search results taken into account.
54. *Paragraph 6.66.1:* Section (vii) should be deleted. It was noted that the United States Patent and Trademark Office intended to propose to WIPO’s Standing Committee on Information Technology the adoption of a new “M” category of citation. The last paragraph of this section headed “Relationship between documents and claims” (following section (x)) should be deleted.
55. *Paragraph 6.107:* The words “Copies of documents cited” appearing at the beginning of the paragraph should be deleted.

Chapter 9

56. *Paragraph 9.06:* The paragraph should be reviewed for consistency with Rule 60.1(b), which set out two criteria. Also, at the start of line 8, “if” should be inserted after “as.” The Meeting noted a proposal that had been submitted to the Working Group for an amendment of Rule 60.1(b) to remove the now unnecessary requirement for the demand to contain at least one election (see document PCT/R/WG/4/4 Add.5).

57. *Paragraph 9.22:* The square brackets should be deleted and the text retained.

58. *Paragraph 9.29:* The paragraph should be reviewed to clarify that it was not the International Preliminary Examining Authority’s responsibility to check with each of the receiving Office, the International Bureau and (where the International Searching Authority and International Preliminary Examining Authority were not the same body) the International Searching Authority whether a suitable power of attorney had been filed there. At line 9, the term “verify” should be clarified to indicate that this meant confirm by reference to the record or with the applicant, rather than determine the legal validity of the appointment.

59. *Paragraph 9.59:* One Authority doubted that this paragraph was required. It should in any case be moved to a new part of the Guidelines dealing with administrative matters (see paragraph 12, above).

Chapter 10

60. *Paragraph 10.11bis:* In line 3, “sought” should be inserted before “invention or” and “, subject to Rule 66.1(e),” should be inserted after those words.

61. *Paragraph 10.13(v):* A reference to Rule 69.1(b) should be added preceding the paragraph. The “s” should be deleted from the third word (“relates”).

62. *Paragraph 10.15:* Several Authorities considered that in the first sentence the option “may” was appropriate; one Authority strongly supported “will normally.” It was therefore agreed that the words from “the examiner” to “further written opinion” should be replaced by “no further written opinion need be issued before the international preliminary examination report is established.” In the second sentence, the words “, at the discretion of the International Preliminary Examining Authority,” should be inserted before “be issued.”

63. *Paragraph 10.17:* A new heading “Claims for which no international search report has been established” should be inserted before the paragraph.

64. *Paragraph 10.39:* The Meeting agreed that, where an amendment introduced added subject matter, the superseded sheets should be annexed to the international preliminary examination report in addition to the amended sheet (see also paragraphs 12.20 and 12.24), and noted that a Rule change to clarify this practice was to be considered by the Working Group (see paragraph 71, below). Consequently, the text in square brackets should be retained, but the following amendments made:

(a) The fourth sentence (“The examiners should clearly indicate... the application as filed”) should be deleted.

(b) The sixth sentence should read “However, if a first replacement sheet is acceptable and a second replacement sheet for the same numbered sheet contains subject matter that goes beyond the original disclosure of the application as filed, the second replacement sheet supersedes the first replacement sheet.”

(c) The following sentence should be added at the end: “In this case the superseded replacement sheet shall be marked as provided by the Administrative Instructions.”

65. *Paragraph 10.50*: In line 5, “examiner” should be replaced by “Authority.”

66. *Paragraph 10.62*: The square brackets should be deleted and the text retained.

67. *Paragraph 10.63(ii)*: The word “examination” should be deleted.

68. *Paragraph 10.65*: The third sentence should be clarified to read “The requirement for an agent to have a power of attorney cannot be waived for the purposes of withdrawal of the international application.”

Chapter 11

69. See paragraph 85, below.

Chapter 12

70. *Paragraph 12.17*: The paragraph should be moved to an administrative section of the Guidelines (see paragraph 12, above). The text in square brackets was considered to be correct, but the need for it should be reconsidered in the context of its new location.

71. *Paragraph 12.20*: The square brackets should be deleted, retaining the text, which should however be changed to read: “However, if a first replacement sheet is acceptable and a second replacement sheet for the same numbered sheet contains subject matter that goes beyond the original disclosure of the application as filed, the second replacement sheet supersedes the first replacement sheet. In this situation, both the first and second replacement sheets shall be attached to the international preliminary examination report. In this case the superseded replacement sheet shall be marked as provided by the Administrative Instructions.” (See the proposed changes to Rule 70.16 appearing in document PCT/R/WG/4/4Add.4.)

72. *Paragraph 12.22*: The content should be reviewed for consistency with the modified Forms (see the proposed modifications in document PCT/MIA/8/4; see also paragraphs 122 to 126, below).

73. *Paragraph 12.24*: The text should be revised for consistency with paragraphs 10.39 and 12.20 (see paragraphs 64 and 71, above).

74. *Paragraph 12.27*: The word “not” in the final line of paragraph (b) should be deleted. Subparagraphs (b) and (d) should be revised to make it more clear why, in the case considered in (b), priority is assumed to be valid (a written opinion of the International Searching Authority may be established prior to the expiration of the time limit for providing the copy of the earlier application under Rule 17.1) whereas, in the case considered in (d), the international preliminary examination report should be established as if the priority had not

been claimed (where the applicant had failed to supply a copy of the earlier application or a requested translation within the relevant period, which by then would have expired).

75. *Paragraph 12.55*: The first sentence should be amended to read “If the cited prior art is such as to demonstrate lack of novelty or inventive step in the main claim or claims, and if consequently there is lack of unity of invention between dependent claims, if there is enough time the applicant may be notified of this situation and invited to pay additional search fees (see also section III -7 [XR]).”

76. *Paragraph 12.58*: The first sentence should be replaced by “Any written opinion established by the International Preliminary Examining Authority must fix the time limit within which the applicant must reply.”

77. *Paragraph 12.72*: The paragraph should be replaced by the following text: “If, in the opinion of the examiner, issues such as: (1) the clarity of claims, the description, and the drawings; (2) the question as to whether the claims are fully supported by the description; and/or (3) defects existing in the form or contents of the international application, have not been suitably resolved by applicant in the prescribed time limit for establishing the international preliminary examination report, the examiner may indicate unresolved issues and the reasons therefor in the report.”

Chapter 13

78. *Paragraph 13.16*: The different practices concerning multiple dependent claims should be the subject of separate discussion in the Annex to Chapter 13. The main paragraph should retain sufficient discussion of the specific options set out by Rule 6.4(a).

79. *Paragraph 13.20*: The start of the second sentence should be replaced by “Each claim should be read giving the words the ordinary meaning and scope which would be attributed to them by a person skilled in the relevant art, unless...”

80. *Paragraph 13.21*: Both sets of square brackets should be deleted and the text retained. The overlap in content between the text within the second set of square brackets and the Annex to Chapter 13 should, however, be reviewed.

81. *Paragraph 13.30*: In line 3, the reference to “Article 5” should be to “Article 6.”

82. *Paragraph 13.36*: The third sentence (commencing “In such case...”) should be reviewed for clarity. IP Australia agreed to suggest an alternative, indicating better the issue that difficulty in searching was not in itself grounds for objection to particular parameters.

83. *Paragraph 13.42*: This should be replaced by a main paragraph, supplemented by paragraphs for inclusion in the Annex to Chapter 13, indicating alternative practices as follows:

“13.42[E -III-5.1] The requirement that the claims shall be concise refers to the claims in their entirety as well as to the individual claims. For example, undue repetition of words or an undue multiplicity of claims of a trivial nature which render it unduly burdensome to determine the matter for which protection is sought, could be considered as not complying with this requirement. See Annex to Chapter 13 for further guidance relating to determinations of “conciseness” of claims.

“Conciseness

“A13.42 The Authorities have divergent practices with regard to whether claims, both individually and in their totality, are concise. Either of the alternative guidelines below may be relied upon by an Authority as appropriate.

“A13.42[01] Claims may be objected to as lacking conciseness when they are unduly multiplied or duplicative. Claims are unduly multiplied where, in view of the nature and scope of the invention, an unreasonable number of claims are represented which are repetitious and multiplied, the net result of which is to confuse rather than to clarify. The claims should not be unduly multiplied so as to obscure the definition of the claimed invention in a maze of confusion. However, if the claims differ from one another and there is no difficulty in understanding the scope of protection, an objection on this basis generally should not be applied. In addition, claims should differ from one another. If claims are represented in the same application that are identical or else are so close in content that they both cover the same thing, despite a slight difference in wording, an objection on the basis of conciseness may be proper. However, such an objection should not be applied if the change in wording results even in a small difference in scope between the two claims. Individual claims may be objected to as lacking conciseness only when they contain such long recitations or unimportant details that the scope of the claimed invention is rendered indefinite thereby.

“A13.42[02] The number of claims must be considered in relation to the nature of the invention the applicant seeks to protect. Undue repetition of words or a multiplicity of claims of a trivial nature which render it unduly burdensome to determine the matter for which protection is sought could be considered as not complying with this requirement. What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case. Regard also has to be had to the interests of the relevant public. The presentation of claims should not obscure the matter for which protection is sought. Furthermore, the number of alternatives presented within a single claim should not make it unduly burdensome to determine the subject matter for which protection is sought.”

84. *Paragraph 13.44:* In these two sentences, the words “be of a technical character” should be replaced by “relate to the features of the claimed invention” and the words “other relevant” should be inserted in front of “content.” The final sentences should read “Where an objection is raised, the reasons, where possible, should be supported specifically by a published document.”

85. *Paragraphs 13.59, 13.60 and A13.60:* The square brackets should be deleted and the contents of these paragraphs should be moved to form new paragraphs 11.06, 11.07 and A11.07 under the heading “Lack of Support.” The following amendments should also be made:

(a) The third sentence (“Further, if subject matter...claims or description”) in the resulting paragraph 11.06 should be replaced by “If there is a contradiction or inconsistency between the claims and description, this will have to be resolved by amendment of either the claims or description. In some occasional circumstances, this may raise a question of lack of support.”

(b) The example in the fourth sentences should be clarified, referring in the first set of parentheses to “a control for a reclining chair” and in the second parentheses stating that “the control could be anywhere.”

(c) The words “new matter” in the penultimate and final sentences should be replaced by “lack of support.”

(d) In resulting paragraph A 11.07[02], the words “, such as, adding “non-human” as a limitation in a claim drawn to an animal” should be added at the end.

Chapter 14

86. *Paragraph 14.05*: This should be revised for consistency with paragraph 12.27(b). In line 8, the words “the international filing date and not” should be deleted. The last sentence of the paragraph should be deleted.

87. *Paragraph 14.10*: This paragraph should be revised, deleting the portion from line 10 indicating that the applicants should be notified that they may be required in the national phase to choose which one of those applications they wish to proceed with. The examiners should rather record the application in the search report as category “L” (see paragraph 6.66.1(ix)) with a note that it is a co-pending application of the same date by the same applicant. The last two sentences of the paragraph should be reviewed. st

88. *Paragraph 14.13*: The words “for example” should be inserted in the penultimate sentence after the word “credible.” The final sentence should be deleted.

Chapter 17

89. *Paragraph A 17.01*: The United States Patent and Trademark Office agreed to consult with the Russian Agency for Patents and Trademarks about an addition to the Annex to Chapter 17 to outline the methodology for assessment of industrial applicability which is used by that Agency.

Chapter 19

90. *Paragraphs 19.06 and 19.07*: There was no agreement concerning whether it was appropriate to invite an applicant to introduce references to the prior art into the international application, though it was agreed that in some cases a reference could introduce new subject matter. The main paragraphs should be generalized and material relating to practices which differed between Authorities should be moved to an Annex to Chapter 19. onal

Chapter 20

91. *Paragraphs 20.02 to 20.06 and A 20.04(c)*: The language of these paragraphs, or at least the introduction in paragraph 20.02, should be reviewed to make it more clear to the reader that these related to subject matter which could be excluded from search and examination, but would not necessarily be so, depending on the policy of the particular Authority. The square brackets around paragraphs 20.05 and 20.06 should be removed.

92. *Paragraph 20.04(c)*: The consistency of this paragraph with the European Commission’s proposed directive on this matter should be checked.

93. *Paragraph A20.04(c)*: The European Patent Office agreed to provide a short discussion of practice relating to the “technical contribution” method of assessing subject matter.

94. *Paragraph 20.04(e)(2)*: Examples based on Annex I of document PCT/MIA/8/2 Add.2 should be added in square brackets, for further discussion.

95. *Paragraph 20.04(f)*: The square brackets should be removed in the fifth line from the bottom and the text retained.

96. *Paragraph 20.11*: In the explanation under Example 2, the words “positive, active” at line 10 should be deleted and “of a process” inserted after the word “steps.” A new Example 4 from Annex II of document PCT/MIA/8/2 Add.2 should be inserted, in square brackets, for further discussion, but the word “technical” should be deleted from lines 4 and 7.

97. *Paragraph 20.18*: There was concern over the clarity of the final two sentences. The United States Patent and Trademark Office and the European Patent Office agreed to discuss possible alternative wording.

98. *Paragraph 20.20*: In line 7, after the words “if the listing is not provided” the words “or is not provided in the form required by the standard” should be inserted.

Chapter 21

99. *Paragraph 21.02*: The Meeting considered that further consideration was required of proposals to rely on matters other than prior art in formulating an objection to lack of unity of invention. The United States Patent and Trademark Office would develop its proposal further and submit an amended version for consideration using the PCT/MIA electronic forum.

100. *Paragraph 21.20*: The additional examples from Annex IV of document PCT/MIA/8/2 Add.2 should be inserted in square brackets for further consideration and for comment by Authorities via the PCT/MIA electronic forum.

101. *Paragraph 21.27*: This paragraph should be reviewed for consistency with current searching techniques since simultaneous searching was mainly relevant to paper-based searching, whereas separate search strategies usually needed to be formulated for each invention when performing a computer-based search.

102. *Paragraph 21.28*: The European Patent Office agreed to provide a proposal for discussion, clarifying that it might be justified to charge additional search fees, even if the extra effort involved in making these searches itself of an additional invention was negligible, if there was significant work involved in creating the written opinion covering that invention.

Chapter 22

103. The Meeting noted that a proposal for amending Rule 91 was to be considered by the Working Group (see document PCT/R/WG/4/4 Add.2), but it was agreed that work on the Guidelines should continue on the assumption that no amendment would be in force by January 1, 2004.

104. *Paragraphs 22.01 to 22.04:* The square brackets should be removed from paragraphs 22.01, 22.03 and 22.04 and the text retained. Paragraph 22.02 should be deleted.

Chapter 23

105. The discussion of Chapter 23 took into account the presentation at the session by representatives of the United Kingdom Patent Office of the results so far of the PCT quality assurance task force and the discussion that ensued (see document PCT/MIA/8/5 and paragraphs 118 to 121, below).

106. The Japan Patent Office believed that the question of quality assurance systems was one for those responsible for the management of the Authorities and was not appropriate to be dealt with in the Guidelines, which were primarily directed to examiners. The question should be addressed in a wider forum in which the views of designated and deleted Offices could be expressed and would therefore be more appropriately dealt with by the Working Group, although the Office was not opposed to discussion of the issues by the Meeting.

107. The Korean Intellectual Property Office expressed agreement with the Japan Patent Office and believed that the matters should be further discussed at the next session of the Meeting.

108. The European Patent Office believed that quality standards and quality assurance should be addressed in the Guidelines. The Office noted that the Guidelines formed part of the common rules of international search and international preliminary examination which Authorities are obliged, by the agreements with the International Bureau under which they carry out their functions, to apply and observe, and as such their legal status was clear. The inclusion of quality management issues in the Guidelines would emphasize the Authorities' commitment to the matter and would enable rapid implementation. The draft "Common Framework for International Search and Preliminary Examination" contained in the interim report of the task force (see Annex I of document PCT/MIA/8/5) formed a good basis for further discussion and should be included in the next draft of the Guidelines.

109. The Spanish Patent and Trademark Office, the Swedish Patent and Registration Office, the United States Patent and Trademark Office, the Austrian Patent Office, the Canadian Intellectual Property Office and IP Australia expressed general agreement with the views of the European Patent Office on this question.

110. The United States Patent and Trademark Office stressed that it would emphasize certain other general principles relating to quality standards when revising the draft Guidelines.

111. The Chair noted that the majority of the Authorities at the session, but not including the Japan Patent Office or the Korean Intellectual Property Office, had agreed that quality management (that is, both quality standards and quality assurance) be dealt with in the Guidelines, and concluded that the draft Common Framework suggested by the task force should be included in the next draft of the Guidelines, in Chapter 23 or as an Annex, for discussion by the Meeting at its next session, subject to possible changes or additions to be identified in the draft. The results of the present consideration of the matter by the Meeting should be brought to the attention of the Working Group at its fourth session to be held in May 2003.

112. The following changes to the text of the draft Common Framework were suggested at the present session:

- (a) In paragraph 4(g), “testing” should be replaced by “assessing .”
- (b) Paragraph 5(d) should be relocated as paragraph 6(d).
- (c) Paragraph 17 should be reviewed with a view to avoiding unnecessarily onerous reporting requirements for Authorities.

113. The representatives of the United Kingdom Patent Office offered to cooperate in the formulation of possible further changes or additions to the draft Common Framework.

114. In connection with paragraph 17 of the draft Common Framework, the United States Patent and Trade Mark Office voiced objections to reporting on results of its internal reviews as opposed to reporting on what quality practices were successful. The European Patent Office queried whether it would be appropriate to use a standard template for reporting the results of internal reviews.

115. It was noted that, while the Guidelines were addressed specifically to Authorities in the context of international search and international preliminary examination under the PCT, the section concerning quality management would, like the rest of the Guidelines, serve as a useful model for all Patent Offices which undertake search and examination work.

Annex A

116. *Paragraph A.04:* The Meeting noted that this paragraph may need to be amended to reflect any decision of the Committee for Technical Cooperation relating to minimum documentation at its next session (see paragraphs 9 and 10, above).

Annex B

117. The Meeting agreed that the contents of this Annex should be omitted from the Guidelines and instead made available as an IPDL (see paragraph 35, above).

REPORT OF THE “VIRTUAL” TASK FORCE ON A PCT COMMON QUALITY FRAMEWORK

118. As had been agreed by the Meeting at its previous session, a report on the results of the work so far of the “virtual” task force on a PCT quality framework established by the Working Group was presented to the Meeting by representatives of the United Kingdom Patent Office in its capacity as task force coordinator (see documents PCT/R/WG/3/5, paragraph 11, and PCT/MIA/7/5, paragraph 75). For this purpose, the Office was represented by Mr. Ron Marchant, Director of Patents, and Mr. Mike Wright, Assistant Director, Patents Legal Division.

119. The representatives of the United Kingdom Patent Office, in presenting the report, which was set out in document PCT/MIA/8/5, outlined some of the background to it:

- (a) An important aim was to establish systems making it possible to avoid re-doing in the national phase work which had already been done in the international phase.

(b) A number of representatives of users had expressed support for the proposals developed by the task force.

(c) The report took account of a number of concerns of those who took part in the work of the task force, including some of the Authorities. Those concerns, together with other views that had been expressed, were summarized in document PCT/MIA/8/5.

(d) A proposal for an independent assessment or review panel had been discussed by the task force but had since been omitted.

(e) The proposed framework was designed to operate as simply and economically as possible, avoiding unnecessary administrative burdens for Authorities.

(f) A quality management system should not only establish quality standards but also deal with how to meet them and how to keep them up to date, taking feedback from users (including both applicants and Offices) into account.

120. The representatives of the United Kingdom Patent Office also outlined particular features of the proposed framework set out in Annex I of document PCT/MIA/8/5.

121. The Chair, on behalf of the Meeting, thanked the representatives of the United Kingdom Patent Office for their contribution to the work of the task force and for presenting the report at the present session.

NEW AND AMENDED FORMS RELATING TO INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION

Content of Written Opinions and Reports

122. Discussions were based on documents PCT/MIA/8/4 and 4 Add. 1 relating to proposed modified Forms PCT/ISA/210 and 237 and PCT/IPEA/408 and 409 (referred to here as Forms 210, 237, 408 and 409, respectively).

123. The Meeting agreed generally with the proposals subject to the comments appearing in the following paragraphs.

124. *Nucleotide and/or amino acid sequence listings (Box No. I, or the continuation thereof, in each of Forms 201, 237, 408 and 409):* See document PCT/MIA/8/4, Annex II, pages 2, 14, 24 and 34.

(a) The introductory text at the top of the part of the Box relating to sequence listings should be reviewed to avoid any implication that the mere presence of a disclosure of a sequence listing in the application meant that it should be the subject of an international search.

(b) The United States Patent and Trademark Office would suggest to the Secretariat an alternative wording for the text relating to the first checkbox in each of items (a) and (b) in order to clarify that the search may be based upon a sequence set forth in the written description rather than upon a sequence from the sequence listing.

125. *Basis of the report (Form 409, Box No. I, item 5):* The wording of the text as proposed in document PCT/MIA/8/4 Add. 1, Annex II, page 2, relating to superseded replacement sheets should be reviewed in the light of proposed changes to Rule 70.16 (see document PCT/R/WG/4/4 Add. 4) and of paragraph 12.20 of the Guidelines (see paragraph 71, above).

126. *Priority (Form 237, Box No. II):* Alternatives A and B (see document PCT/MIA/8/4, Annex II, page 7) should be reviewed in view of the discussion of the treatment of priority claims when the earlier application or translation thereof had not yet been made available by the applicant (see paragraph 74).

Format of Written Opinions and Reports

127. Discussions were based on document PCT/MIA/8/3.

128. The Meeting agreed that the new format which would eventually replace the traditional "Box-based" version of the Forms concerned should be in single column format rather than double column (see document PCT/MIA/7/5, paragraphs 80 to 89, as to previous consideration by the Meeting of this question, including practical considerations relating to the timing of the introduction of the new format). The European Patent Office agreed to provide further proposals taking into account the content of the traditional Forms when agreed after the consultation process presently being undertaken (see paragraphs 122 to 126, above).

NEXT SESSION

129. The Secretariat indicated that the ninth session of the Meeting was tentatively scheduled for July 21 to 25, 2003, in Geneva.

130. The Meeting unanimously adopted this report on May 8, 2003.

[Annex follows]

ANNEX

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

AUSTRIAN PATENT OFFICE

Peter HOFBAUER, Deputy Director, Technical Department 4a

CANADIAN INTELLECTUAL PROPERTY OFFICE

David CAMPBELL, Acting Division Chief, Chemical Division, Patent Branch

Scott VASUDEV, Project Officer, Legislation and International, Patent Branch

Nathalie TREMBLAY, Project Officer, ISA/IPEA Implementation, Patent Branch

EUROPEAN PATENT OFFICE

Colin PHILPOTT, Director, Practice and Procedure

André CARDON, Director, DG1

Brian DERBY, Lawyer, DG5

Alfred SPIGARELLI, Principal Examiner, DG2

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Dave HERALD, Deputy Commissioner of Patents

Ed KNOCK, Supervising Examiner of Patents

JAPAN PATENT OFFICE

Shimpei YAMAMOTO, Deputy Director, Examination Standards Office

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KOREANINTELLECTUALPROPERTYOFFICE

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In-SunCHOI, Deputy Director, Examination Coordination Division

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II. OFFICERS

Chair: NicholasGODICI (United States Patent and Trademark Office)

Secretary: PhilipTHOMAS (WIPO)

III. INTERNATIONAL BUREAU
OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Jay ERSTLING, Director, Office of the PCT

Philip THOMAS, Director, Patent Policy Department

Michael RICHARDSON, Consultant

Louis MAASSEL, Consultant

[End of Annex and of document]