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REVISED DRAFT PCT INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION GUIDELINES:
COMMENTS BY THE RUSSIAN AGENCY FOR PATENTS AND TRADEMARKS

Document prepared by the International Bureau

1. Document PCT/MIA/9/2 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 contains comments which have been received from the Russian Agency for Patents and Trademarks (Rospatent) concerning those draft Guidelines.
3. *The Meeting of International Authorities is invited to take note of the contents of the Annex to this document in conjunction with the relevant parts of the draft Guidelines in the Annex to document PCT/MIA/9/2.*

[Annex follows]

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ANNEX

COMMENTS BY THE RUSSIAN AGENCY FOR PATENTS AND TRADEMARKS

CHAPTER 10

Paragraph 10.15

We are of the opinion that in the first sentence the option “may” is preferable; the option “will normally” is inconsistent with the interests of the Applicants and elected smaller Offices, which rely on the results of the international preliminary examination procedure, since the Examiner will be encouraged by the Guidelines to directly issue a negative international preliminary examination report thus postponing the necessary dialogue to the national phases.

CHAPTER 12

Paragraph 12.66

We agree with the comments of EPO of 24.06.03 in respect to the deletion of the wording “where the intent is to provide more than one written opinion, in that circumstance” since the ISA cannot know in advance the outcome of the IPE procedure.

CHAPTER 17

The Rospatent is still of the opinion that proposed Chapter 17 doesn't provide the Examiners with the necessary instructions as to the practice to be followed in the assessment of industrial applicability, especially in comparison with the methodologies suggested in Chapters 15 and 16 for the assessment of novelty and inventive step.

It seems to us reasonable to include the methodology which is used by our Agency (it was submitted to the electronic forum on 30.04.03) as the Annex to Chapter 17, especially taking into account that such proposal has been brought up in the Report of the eighth session of the Meeting of International Authorities under the PCT. The inclusion of step-by-step methodology with concrete examples can be useful for the Examiners and it may be relied upon by an ISA/IPEA.

CHAPTER 20

Paragraph 20.04

We can't agree with the suggested wording since, on the one hand, two alternative approaches in respect to the following paragraphs are mentioned, and on the other hand, it is unclear which approach is applied.

We are not sure that it is necessary to reflect these approaches in the Guidelines taking into account that Rules 39 and 67 completely specify certain subject matters that may be excluded from international search or preliminary examination. But in case of their inclusion it seems useful to explain in each case what approach is applied and how, and may be it is better to describe these approaches in an annex similar to other chapters.

[End of Annex and of document]