

WIPO



PCT/R/WG/2/8

ORIGINAL: English

DATE: March 26, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

ABSENCE OF “FORMAL” CLAIMS

Document prepared by the International Bureau

BACKGROUND

1. During its first session, held in Geneva from November 12 to 16, 2001, the Working Group discussed proposals to amend the Regulations so as to align the requirements of the Patent Cooperation Treaty (PCT) with regard to claims as a filing date requirement to those of the Patent Law Treaty (PLT) (see document PCT/R/WG/1/5, paragraphs 5 and 6, and Annex I).¹ PCT Article 11(1)(iii)(e) requires that for an international filing date to be accorded, an international application shall, *inter alia*, contain a part which on the face of it appears to be a claim or claims. In contrast, under PLT Article 5(1), claims are not required for a filing date to be accorded. As reported in the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”):

“25. Discussions were based on document PCT/R/WG/1/5, and in particular on proposed new Rules 20.4(d) and 26.3*ter*, contained in Annex I to that document, which would provide for claims to be considered to be filed as a legal fiction and to be added

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

later as a correction of a formality defect. The comments and concerns expressed by various delegations included the following:

- (i) the idea of according a filing date under the PCT to an international application without claims was widely supported, but the wording of Articles 11(1)(iii)(e) and 58 did not support the draft Rules proposed; it would be necessary to develop a proposal to revise the Treaty itself;
- (ii) to adopt amended Regulations that were so clearly inconsistent with the Treaty itself would jeopardize the rights of applicants;
- (iii) the Treaty provided no basis for adding claims before the international search took place; a problem may also be posed by Articles 19 and 34 which provide that amendments shall not go beyond the disclosure in the international application as filed;
- (iv) the representatives of users emphasized the need to find a solution in the PCT for such cases; PCT applicants should not be at a disadvantage in this respect compared to applicants filing national applications.

“26. The Working Group would be prepared to consider other ways of dealing with international applications having no claims pending revision of the Treaty itself. The International Bureau would attempt to elaborate proposals bearing in mind, in particular, the following possibilities:

- (i) the Treaty distinguishes between the “international application” on the one hand and the “record copy” on the other; different treatment may be able to be accorded to papers according to those different notions;
- (ii) advantage might be able to be taken in cases where there is “claim-like” wording appearing in the description; it was noted that the procedure under the European Patent Convention provided for the description to repeat, in effect, the wording of the claims;
- (iii) the request form could include pre-printed wording sufficient to constitute “a part which on the face of it appears to be a claim or claims” for the purposes of Article 11(1)(iii)(e);
- (iv) the international search might be able to be undertaken without the presence of formal claims, or on the basis of a “search statement” furnished by the applicant;
- (v) new possibilities being developed for combined search and examination under the PCT might allow for claims furnished under Article 34 to be taken into account for both international search and international preliminary examination.”

2. As requested by the Working Group, the International Bureau has studied various proposals, bearing in mind, in particular, the possibilities outlined in paragraph 26(i) to (v) of

the first session summary. This document² contains revised proposals designed to align the PCT requirements with those under the PLT as regards according an international filing date to international applications filed without “formal” claims, based on the possibilities set out in paragraph 26(ii) and (iii) of the first session summary.

ABSENCE OF “FORMAL” CLAIMS

3. The proposals set out in the Annex³ are based on the following approach:

(i) a suitably worded *pre-printed statement*, which would be included in the printed request form proposed new Rule 4.1(c)(iv),⁴ would be sufficient to constitute “a part which on the face of it appears to be a claim or claims” and hence to support the according of an international filing date;

(ii) the presence of “*claim-like*” wording in the description is sufficient to constitute “a part which on the face of it appears to be a claim or claims” and hence to support the according of an international filing date, noting that Article 11(1)(iii)(e) does not prescribe where that part shall be included in the international application and does not require that the claims be expressly identified as such); while that position is true at present, proposed new Rule 20.4(e) would put the matter beyond doubt;

(iii) where compliance with Article 11(1)(iii)(e) relies solely on either of the two possibilities just mentioned, the application should be considered to contain a formal defect under Article 14; such a defect can be remedied by the *furnishing of “formal” claims as a correction* under Rule 26.

4. The pre-printed statement referred to in paragraph 3(i), above, is proposed to read as follows:

“In the absence of any other claim or claims in the international application, the following matter for which protection is sought is hereby claimed: The invention set out in the description and illustrated in the drawings, if any, of this international application.”

² This and other working documents for the present session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

⁴ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 and the Regulations under the PLT (see document PT/DC/47 on WIPO’s web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

The proposed statement would not apply, under its own terms, if the international application contains a “formal” claim or claims.

5. If the approach just outlined is acceptable, there is no need to further consider, for the time being, the possibilities mentioned in paragraph 26(iv) of the first session summary, since the formal claims so furnished would form the basis for the international search. An appropriate provision may be needed to deal with the consequences for the application if the formal claims added by way of correction went beyond the disclosure in the international application as filed (see, for example, Articles 19(2) and (3), 28(2)(b) and 34(2)(b)).

6. As mentioned in paragraph 26(i) of the first session summary, the Treaty distinguishes between the “international application” on the one hand and the “record copy” on the other, so that different treatment might be accorded to papers according to those different notions. However, at this point, it is proposed that this possibility should only be investigated if the proposals contained in this document do not find favor with the Working Group.

7. As mentioned in paragraph 26(v) of the first session summary, new possibilities developed for combined search and examination under the PCT might allow for claims furnished under Article 34 to be taken into account for both international search and international preliminary examination. However, pending discussions in the Working Group on the issue of an expanded international search system (see document PCT/R/WG/2/1), such new possibilities have not been further investigated, but they should be looked at more closely at a later stage as a supplementary procedure to the proposal outlined in this document.

8. In the event that the correction procedure mentioned in paragraph 3(iii), above, is found not to be appropriate, it would be possible for the international search to be undertaken, in the absence of “formal” claims, on the basis of a “search statement” that the applicant would have the option of furnishing. Such a “search statement” would, while not forming part of the international application, replace “formal” claims for the purposes of the international search. It would be worded in accordance with Rule 6 (which outlines the requirements for “formal” claims”), would be published together with the international application and the international search report, and would be taken into account when determining whether the international application complies with the requirement of unity of invention. It would be used for the purposes of international search only but not for the purposes of international preliminary examination since, following the establishment of the international search report, the applicant has several opportunities to amend the claims (under Articles 19 and 34) so as to have international preliminary examination carried out on the basis of the claims so amended.

9. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

ABSENCE OF “FORMAL” CLAIMS

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Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [no change]

(c) The request may contain:

(i) and (ii) [no change]

(iii) declarations as provided in Rule 4.17.:

(iv) a claim worded as provided in the Administrative Instructions.

(d) [No change]

[COMMENT: The following text would be included in a new box in the PCT request (Form PCT/RO/101), provided for in the Administrative Instructions: “In the absence of any other claim or claims in the international application, the following matter for which protection is sought is hereby claimed: The invention as set out in the description and illustrated in the drawings, if any, of this international application.”.]

Rule 6

The Claims

6.1 to 6.5 [No change]

6.6 Inclusion of Formal Claims

Where the receiving Office finds that the international application includes a part which on the face of it appears to be a claim or claims only by virtue of Rule 4.1(c)(iv) or 20.4(e), the international application shall be considered not to comply with Article 14(1)(a)(v) and Rule 26 shall apply accordingly.

[COMMENT: New Rule 6.6 would enable the applicant to include “formal” claims by way of correction of a formal defect under Rule 26.]

Rule 20

Receipt of the International Application

20.1 to 20.3 [No change]

20.4 *Determination Under Article 11(1)*

(a) to (d) [No change]

(e) For the purposes of Article 11(1)(iii)(e), it shall be sufficient that there is wording in any part of the international application which makes it clear what is the matter for which protection is sought.

[COMMENT: Paragraph (e) is included for the sake of clarification to cover cases where there is no part headed “Claims” but where there is clearly “claim-like” wording in the description; see paragraph 26(ii) of the first session summary and paragraph 3(ii) under Background, above. Article 6 refers to claims as defining “the matter for which protection is sought.”]

20.5 to 20.9 [No change]

[End of Annex and of document]