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INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

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FORMALITIES CHECKING UNDER THE PCT

*Document prepared by the International Bureau*

## BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was a proposal to reduce or eliminate formalities review procedures at both the receiving Offices and the International Bureau.

2. The Working Group's discussions on this proposal are summarized in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 41 to 43, as follows:

### *“Formalities Review*

“41. Discussions were based on document PCT/R/WG/3/1, Annex I, item 1 (reduce or eliminate formalities review).

“42. Several delegations expressed the view that procedures relating to the checking of formalities by both the receiving Offices and the International Bureau should be reviewed so as to avoid unnecessary duplication of work and further streamline procedures. This would require consideration of many current processes, but would be

particularly relevant to procedures relating to international applications filed and processed, in the future, in electronic form.

“43. It was agreed that the International Bureau should work with interested delegations and representatives of users, using the PCT reform electronic forum, to identify:

(i) formalities checking processes that were carried out by both receiving Offices and the International Bureau, with a view to proposing changes to the Administrative Instructions and the PCT Receiving Office Guidelines to do away with any unnecessary duplication;

(ii) simplifications in the formalities review that could be progressively implemented together with the planned implementation of electronic filing and processing of international applications under the PCT.”

3. This document outlines the roles which the Treaty and the Regulations have assigned to receiving Offices and the International Bureau with regard to the checking of formalities, gives some statistical information on formal defects in international applications, and elaborates on the likely impact of recent developments (the latest Rule changes adopted by the Assembly in October 2002, the ongoing reorganization of the International Bureau's Office of the PCT and the planned implementation of electronic filing) may have on the formalities checking of international applications.

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#### THE ROLES OF RECEIVING OFFICES AND THE INTERNATIONAL BUREAU WITH REGARD TO FORMALITIES CHECKING

4. Before taking a closer look at how and by whom formalities checking of international applications is carried out under the present system, it is worthwhile to recall the history of the PCT so as to better understand the roles of receiving Offices and the International Bureau with regard to formalities checking.

##### *Early Draft of the PCT*

5. The 1967 draft of the PCT<sup>1</sup> provided that the International Bureau should be responsible for carrying out the examination of all international applications “as to form,” including compliance with what today would be referred to as filing date requirements under Article 11. Draft Article 7(1) of the 1967 draft PCT (“Examination of International Application as to Form”) provided (see document PCT/I/4, page 23):

“(1) The International Bureau shall examine the international application in order to discover whether it complies with the requirements prescribed in Article 5; however, as far as the description, claims, drawings, and the abstract, are concerned, the examination shall be limited to discovering whether they contain obvious formal defects.”

<sup>1</sup> References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be.

6. This proposal for draft Article 7(1), however, was not supported by a majority of delegations attending the first meeting of the "Committee of Experts on a Patent Cooperation Treaty (PCT)." The report of that meeting summarizes the discussion on draft Article 7 as follows (see document PCT/I/11, page 7):

"24. The majority of the Committee was of the opinion that the examination of the international application as to form should not be done by the International Bureau except when other authorities were not available, for example, when the international application is filed direct with the International Bureau. Opinions differed on who should, as a rule, do such examination. Some proposed that it be done by the searching Authorities, others that it be done by any national Office which is ready to receive and transmit international application even if such an Office is not a searching Authority. In any case, the International Bureau should set up a machinery to harmonize the practices of all authorities controlling the conformity of applications with the formal requirements of the PCT."

7. Consequently, later drafts and the final text of the Treaty and the Regulations assigned at the Washington Diplomatic Conference in June 1970 no longer provided for the International Bureau to be responsible for the examination of the international application "as to form." Rather, the receiving Offices were made responsible for the checking and processing of international applications (see Article 10), including checking for compliance with the filing date requirements under Article 11 and checking for formal defects under Article 14.

8. However, the International Bureau and, to a lesser extent, the International Searching Authorities, were given the responsibility of supporting the receiving Offices in carrying out their tasks. Procedures were put in place to ensure that certain defects noted by the International Bureau (and, in certain cases, by the International Searching Authority) were brought to the attention of the receiving Office (see present Rules 28.1 and 29.3; see also Rule 60.1(e) with regard to defects in the demand).

9. Moreover, certain other responsibilities with regard to the checking of formalities were directly assigned to the International Bureau, requiring the International Bureau to invite the applicant to correct a defect rather than calling the defect to the attention of the receiving Office. For example, where the receiving Office fails to notice that a priority claim does not comply with the requirements of Rule 4.10, it is the International Bureau's responsibility to invite the applicant to correct such defective priority claim by furnishing the required correction directly to the International Bureau (see present Rule 26bis.2; a similar provision was already contained in Rule 4.10 in the final text of the Regulations as adopted at the Washington Diplomatic Conference in 1970). Similar responsibilities have been assigned to the International Bureau later by way of amendment of the Regulations, for example, in the context of the processing of declarations referred to in Rule 4.17 (both the receiving Office and the International Bureau may invite the applicant to correct a defective declaration (see Rule 26ter.2)).

10. While the records of the Washington Diplomatic Conference on the PCT and other available documents do not expressly elaborate on the reasoning behind this division of labor between receiving Offices and the International Bureau, the "founders" of the PCT clearly were concerned about issues such as how best to ensure uniform processing of all

international applications by all receiving Offices<sup>2</sup> and “reasonably uniform international publication.”<sup>3</sup> Moreover, it must have seemed logical in view of the division of labor between different Offices and Authorities and the International Bureau, to require the International Bureau to call a defect to the attention of the receiving Office where such defect had apparently been overlooked by that Office but had been noted by the International Bureau in the course of the processing of the international application, or to let the International Bureau deal directly with the applicant where the correction of a defect was required urgently in view of pending international publication.

### *Present System*

11. The role of the International Bureau under the present system in respect of formalities checking may thus best be described as:

(i) supporting receiving Offices and International Preliminary Examining Authorities in carrying out their tasks with regard to the formalities checking of the international application and of the demand, respectively, in the interest, in particular, of uniform processing of all international applications and demands by all receiving Offices and International Preliminary Examining Authorities, respectively, and “reasonably uniform international publication”; and

(ii) carrying out certain formalities checks directly assigned to it, in particular with regard to defects the correction of which is required in view of the pending international publication.

12. Accordingly, the International Bureau performs a formalities check of every record copy received and:

(i) where it considers that any of the filing date requirements listed in Article 11(1)(i) to (i ii) was not complied with on the date which was accorded as the international filing date and the receiving Office had not invited the applicant to correct such defect, brings such defect to the attention of the receiving Office (see Article 14(4) and Rule 29(3));

(ii) where, in its opinion, the international application contains any of the defects referred to in Article 14(1)(a)(i) (“it is not signed as provided in the Regulations”), Article 14(1)(a)(ii) (“it does not contain the prescribed indications concerning the applicant”) and Article 14(1)(a)(v) (“it does not comply to the extent provided in the Regulations with the prescribed physical requirements”) and the receiving Office had not invited the applicant to

<sup>2</sup> See the report of the first meeting of the Committee of Experts, document PCT/I/11, page 7, paragraph 24, at the end (cited in paragraph 6, above): “In any case, the International Bureau should set up a machinery to harmonize the practices of all authorities controlling the conformity of applications with the formal requirements of the PCT.”

<sup>3</sup> The 1968 draft of Rule 26.1(a) (which later was renumbered and became present Rule 28.1(a)) provided: “If, in the opinion of the International Bureau or of the Searching Authority, the international application contains certain defects, particularly that it does not comply with the prescribed physical requirements necessary for reasonable uniform publication, the International Bureau or the Searching Authority, respectively, shall bring such defects to the attention of the Receiving Office.”

corrects such defect, brings such defect to the attention of the receiving Office (see Rule 28.1);

(iii) where it finds that any priority claim does not comply with the requirements of Rule 4.10 and the receiving Office has failed to do so, invites the applicant to correct the priority claim (see Rule 26*bis*.2);

(iv) where it finds that any declaration referred to in Rule 4.17 does not comply with the requirements of that Rule, invites the applicant to correct the declaration (see Rule 26*ter*.2);

(v) under Chapter II, where a defect in the examination is noticed by the International Bureau, brings such defect to the attention of the International Preliminary Examining Authority (see Rule 60.1(e)).

13. Since record copies are usually received by the International Bureau together with copies of the invitation to correct formal defects sent by the receiving Office to the applicant, the International Bureau is in a position to see which defects, if any, the receiving Office had noticed and invited the applicant to correct. It is thus ensured, in accordance with the Regulations, that the International Bureau brings only those formal defects to the attention of the receiving Office which had been overlooked by that Office, or that the International Bureau invites the applicant to correct a defect only where the receiving Office had failed to do so.

#### *Occurrence in Practice of Defects Found by the International Bureau*

14. The following figures regarding defects noticed by the International Bureau and, in accordance with Rule 28.1, called to the attention of the receiving Office concerned illustrate the role of the International Bureau in the formalities checking of international applications.

15. In 2002, the International Bureau received a total number of 84,102 record copies of international applications filed with the five biggest receiving Offices acting under the PCT, that is, the United States Patent and Trademark Office, the European Patent Office, the Japan Patent Office, the United Kingdom Patent Office and the German Patent Office. In respect of those 84,102 record copies, the International Bureau noted a total of 59,900 defects, which apparently had been overlooked by the receiving Office concerned, and brought those defects to the attention of that Office or, where the International Bureau has the authority to do so, directly invited the applicant to correct the defect.

16. Most of the defects noted by the International Bureau and brought to the attention of the receiving Office concerned fell in one of the following three categories:

(i) the international application was not signed as provided in the Regulations (see Article 14(1)(a)(i)) (32,540 defects related to missing or defective powers of attorney; 4,142 defects related to missing or defective signatures);

(ii) the international application did not comply to the extent provided in the Regulations with the prescribed physical requirements (Article 14(1)(a)(v)) (10,774 defects related to drawings; 1,606 defects related to description, claims or abstract; 2,214 defects related to the title of the invention (in particular, discrepancy between request and description); 114 defects related to the request; 237 missing abstracts);

(iii) the international application did not contain the prescribed indications concerning the applicant (see Article 14(1)(a)(ii)) (3,329 defects related to addresses and indications concerning nationality and residence of the applicant).

17. In addition, the International Bureau noted a total of 4,944 "other" defects (in particular, defects related to priority claims and declarations referred to in Rule 4.17) in respect of most of which the International Bureau invited the applicant to correct the defect rather than bringing the defect to the attention of the receiving Office.

18. Overall, more than 60% of all defects noted by the International Bureau related to signature requirements (in particular, missing powers of attorney), about 25% related to physical requirements of the international application (in particular, drawings), more than 5% related to defects relating to indications concerning the applicant, and more than 8% related to "other" defects.

#### IMPACT OF RECENT DEVELOPMENTS ON FORMALITIES CHECKING

19. A number of recent developments will likely have a substantial impact on the formalities checking of international applications by receiving Offices and the International Bureau, as outlined in the following paragraphs.

##### *Rule Changes Adopted by the PCT Assembly in October 2002*

20. In October 2002, in the context of the overhaul of the designations system, the PCT Assembly adopted amendments to the PCT Regulations which likely will have an immediate and considerable impact on formalities checking of international applications, in particular with regard to defects related to signature requirements (see paragraph 16(i), above) and furnishing of indications concerning the applicant (see paragraph 16(iii), above), which in 2002 made up more than 65% of all defects noted by the International Bureau and called to the attention of the receiving Office concerned.

21. In order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide signatures and indications in respect of all applicants (where there are two or more), under the amended Regulations as in force from January 1, 2004, it will be sufficient that the request be signed by at least one applicant and that indications be provided in respect of at least one applicant who is entitled under Rule 19 to file the international application with the receiving Office concerned. Moreover, as of January 1, 2004, whereas sole applicant is represented by an agent, or where all co-applicants are represented by a common agent or a common representative, the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the International Bureau will be entitled to waive the requirement that a separate power of attorney be submitted.

22. Consequently, as of January 1, 2004:

(i) where there are two or more applicants, the receiving Office will no longer be required to invite the furnishing of missing signatures if the request is signed by at least one applicant (see Rule 26.2*bis* as in force from January 1, 2004); this should dramatically reduce the number of defects related to signature requirements, the number of invitations to be issued by the receiving Office and, consequently, the number of cases in which the International

Bureau has to bring such defect to the attention of the receiving Office (see paragraph 16(i), above);

(ii) where there are two or more applicants, the receiving Office will no longer be required to invite the furnishing of missing indications with regard to address and nationality and residence, or the correction of defective indications, if such indications are furnished in respect of at least one applicant who is entitled to file the international application with the receiving Office concerned; this should dramatically reduce the number of defects related to indications concerning the applicant, the number of invitation to be issued by the receiving Office and, consequently, the number of cases in which the International Bureau has to bring such defect to the attention of the receiving Office (see paragraph 16(iii), above);

(iii) the receiving Office may waive the requirement that a separate power of attorney be submitted, in which case a missing power of attorney would no longer be considered a defect and thus no invitation would have to be issued by the receiving Office.

#### *Reorganization of the Office of the PCT*

23. In the context of the ongoing project to automate PCT operations at the International Bureau (the IMPACT project), a new organizational structure and new and more efficient business processes have been introduced within the Office of the PCT. The Office of the PCT has moved away from the previously rigid and task-specific hierarchical organizational structure and adopted a team-oriented approach, resulting in a more flexible organizational structure that will allow for innovative new functions and services to be introduced over time, with a view, in particular, to improving the day-to-day operational cooperation between the International Bureau and receiving Offices, International Authorities and designated/elected Offices.

24. Under the new organizational structure, small processing teams have been put in place, each being responsible for the processing of record copies received from a limited number of particular receiving Offices. In each processing team, experienced senior staff will act as points of contact for questions by applicants, receiving Offices, International Authorities and designated/elected Offices relating to international applications processed by that team, with the aim of providing a superior level of customer-oriented service. So as to improve the day-to-day cooperation between each processing team and "its" receiving Office, particular emphasis will be put on training, advice and support, and personal contacts between staff in receiving Offices and the processing teams. It is hoped and expected that these measures will lead to a more uniform and efficient processing of international applications by all receiving Offices and the International Bureau, including uniform international publication.

25. In this context, it is to be noted that one of the processing teams, namely, the processing team which processes record copies received from the International Bureau as receiving Office, has started a pilot study, together with the staff from the International Bureau as receiving Office, to identify inefficiencies and unnecessary duplication of work in the formalities checking processes that are carried out by both the International Bureau as receiving Office and the International Bureau (proper), with a view to introducing simplified and more efficient business processes in the day-to-day cooperation between all receiving Offices and the International Bureau. It may be worthwhile to consider whether a similar study should also be carried out with regard to further simplifications in the formalities review of international applications filed in electronic form.

*Filing and Processing of International Applications in Electronic Form*

26. Filing and processing of international applications and related documents in electronic form has become possible and will inevitably change the way in which Offices, Authorities and the International Bureau process international applications. Modifications of the Administrative Instructions under the PCT designed to enable the implementation of electronic filing and processing of international applications and related documents entered into force on January 7, 2002. The modifications (Part 7 and Annex F of the Administrative Instructions) contained, respectively, the necessary legal framework and technical standard. In November 2002, the European Patent Office as receiving Office received the first international application filed in electronic form. PCT-SAFE, the electronic filings software being developed by the International Bureau as an extension of the PCT-EASY software, will be made available to applicants and receiving Offices later this year. In the context of the checking of formalities, it is of particular interest to note that:

(i) the PCT-SAFE electronic filings software will contain approximately 200 validations; the validation function is used to check and confirm that data entered by the applicant are consistent and meet the PCT requirements for according an international filing date as well as formality requirements, avoiding mistakes made by the applicant before the international application is filed;

(ii) compliance of the body of the international application (description, claims, abstract) with certain physical requirements (such as margins, writing of text matter, numbering of sheets, etc.) in the interest of "reasonable uniform international publication" will be of less importance, given that the body of the international application will be in fully electronic form and thus can be brought into any required format or shape for the purposes of international publication;

(iii) receiving Offices, when performing the formalities check, will benefit from the automated validation functions of the software, automatically detecting defects still contained in the international application.

#### REVIEW OF FORMALITIES CHECKING PROCESSES CARRIED OUT BY BOTH RECEIVING OFFICES AND THE INTERNATIONAL BUREAU

27. In light of what has been outlined above, the Working Group, when reviewing the formalities checking processes that are carried out by both receiving Offices and the International Bureau, may wish to consider the following questions:

(i) In the context of formalities checking, is the "division of labor" between the receiving Offices and the International Bureau as envisaged by the "founding fathers" of the PCT and provided for in the Regulations still appropriate?

(ii) Are the issues of "uniform international processing of all international applications by all receiving Offices" and "uniform international publication" still of concern?

(iii) Do the formalities checking processes that are carried out by both receiving Offices and the International Bureau add any value to the system, in particular, from the applicant's point of view, or do they constitute an unnecessary duplication of work which should be avoided and done away with?



(iv) In view of the likely impact of the Rule changes adopted in October 2002 and the ongoing "pilot study" by the International Bureau on formalities checking processes (see paragraph 25, above), should proposals for changes to the Regulations, the Administrative Instructions or the Receiving Office Guidelines be included in the work program of the Working Group now, or should such proposals await the likely impact of these Rule changes and the results of the pilot study?

28. *The Working Group is invited to consider the issues raised in this document.*

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