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FURNISHING OF SEQUENCE LISTINGS FOR SEARCH AND EXAMINATION

Document prepared by the International Bureau

INTRODUCTION

1. At its third session, the Working Group considered a proposal that Rule 13*ter* be amended to provide that International Searching Authorities and International Preliminary Examining Authorities would no longer be obliged to issue invitations to furnish sequence listings in computer readable form complying with the prescribed standard or to carry out an international search and international preliminary examination in case where a sequence listing complying with that standard had not been filed (see document PCT/R/WG/3/1, Annex I, item 5).¹

2. The Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standard should be furnished together with the international application so as not to delay the start of the international search, it was agreed that the International Bureau should prepare a proposal

¹ 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. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc.

which would permit Authorities to require the payment of a late furnishing fee where an invitation had to be issued under Rule 13*ter*.1(a)(ii) or (e) (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57).

3. At its fourth and fifth sessions, the Working Group discussed revised proposals for amendment of the PCT Regulations concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13*ter*.1. The Working Group's discussions at its fourth session are outlined in document PCT/R/WG/4/14, paragraphs 97 to 102. The Working Group's discussions at its fifth session are outlined in document PCT/R/WG/5/13, paragraphs 63 to 73, reproduced in the following paragraphs:

“LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

“63. Discussions were based on document PCT/R/WG/5/1, Annex I.

“64. In introducing the proposals for the introduction of a late furnishing fee for late submission of sequence listings, the Representative of the European Patent Office (EPO) stressed their significance in view of the fact that sequence listings in electronic form for search purposes were furnished late in the case of about 50% of all international applications containing disclosure of sequences. This caused significant difficulties and delays in the international search of these applications. The Representative expressed the view that it was necessary both to cover the additional administrative cost involved and to provide an incentive for applicants to furnish sequence listings complying with the relevant standard at the earliest time possible.

“*Rules 13ter.1(a) and (a-bis)*

“65. There was general support for the concept of allowing the International Searching Authority to require a late furnishing fee where it needed to invite the applicant to furnish a copy of the sequence listing complying with the relevant standard, whether the listing was in electronic or (in rare cases) paper form. The Working Group noted, in the latter context, that a further amendment of Rule 13*ter*.1(a)(i) that had been agreed at its fourth session should also be included, namely, the insertion after the words “furnish to it” of the words “and to pay, where applicable, the late furnishing fee referred to in paragraph (a-bis).” The Working Group also agreed, consequential on that change, that Rule 13*ter*.1(a-bis) should be further amended by inserting “(a)(i) or” before “(a)(ii)” in both instances.

“66. The Working Group agreed that, where sequence listings in both paper and electronic forms were required under Rule 13*ter*.1(a)(i) and (ii), the payment of only one late furnishing fee would be required.

“67. One delegation suggested that the late furnishing fee should be payable in each case where the necessary sequence listing was not provided on the international filing date. A number of other delegations, however, considered that it was not appropriate to require the payment of a late furnishing fee where the listing was received before the International Searching Authority had started the international search, noting that real difficulties in processing would only be caused by late furnished sequence listings where the search had already started.

“68. The Representative of the EPO proposed that a maximum amount of the late furnishing fee be fixed, and that the amount should be 25% of the international search fee. A considerable number of delegations and representatives of users expressed agreement with the proposal to introduce a maximum amount. Certain delegations believed that the fixing of fees associated with the international search should be left to the discretion of the International Searching Authorities. Some delegations supported the proposal that the maximum be 25% of the international search fee. Others considered that the maximum should be 25% of the international filing fee, referring to the need for uniformity amongst Authorities as well as consistency with the maximum amount of the late furnishing fee payable to receiving Offices under Rule 12.3(d) and (e) in the case of late furnishing of a translation needed for the purposes of international search. One delegation suggested that the amount was largely arbitrary, since there had been no study on how the level of the fee related to the degree of burden involved for Authorities.

“*Rule 13ter.1(c)*

“69. The Working Group agreed that, if a sequence listing and any required late furnishing fee were received after the time limit fixed in the invitation but before the International Searching Authority had declared that a meaningful search could not be carried out, the Authority should use that listing. While one representative of users felt that a specific statement to this effect may be useful, the Working Group concluded that the words “shall not be required to search” provided sufficient flexibility to allow the search to be carried out anyway.

“70. The Working Group agreed to further amend Rule 13ter.1(c) as follows:

“(c) If the applicant ~~has~~ does not, within the time limit fixed in the invitation, furnished the required sequence listing and paid any required late furnishing fee ~~comply with an invitation under paragraph (a) within the time limit fixed in the invitation,~~ the International Searching Authority shall only ~~not~~ be required to search the international application to the extent that ~~such non-compliance has the result that a meaningful search can~~ cannot be carried out.”

“*Rule 13ter.1(f)*

“71. The Representative of the EPO proposed the deletion of the words “, subject to Article 34,” from Rule 13ter.1(f), suggesting that the reference to Article 34 was confusing and misleading to applicants, noting that the Rule was intended to cover situations in which sequence listings were filed for the purposes of the international search and not as amendments of the international application. On the other hand, it was noted that applicants had a right under Article 34(2)(b) to file amendments of any part of the application as filed, including the sequence listing part. The Representative noted that it was extremely difficult, if not impossible, for an examiner to ascertain what amendment had been made to a sequence listing and to assess whether the amendment resulted in added matter within the meaning of Article 34(2)(b). It was important, in any event, to make a clear distinction between a sequence listing filed as an amendment of the international application and one filed for the purposes of Rule 13ter.

“72. Several delegations expressed concern, however, that the simple deletion of the reference to Article 34 would have effects beyond the clarification intended. The Secretariat noted that the structure of Rule 13^{ter} might be improved by making a clearer distinction between a sequence listing forming part of the description and one provided for the purposes of international search, and suggested that it might be desirable to review the wording of the Rule in that context.

“73. The Working Group agreed that the issues outlined in paragraphs 63 to 72, above, should be further discussed by the International Authorities, using the electronic forum of the Meeting of International Authorities under the PCT, with a view to the submission of a revised draft of proposed amendments of Rule 13^{ter} to the Working Group for approval at its next session and subsequent submission to the Assembly for adoption in September 2004.”

4. Revised proposals for amendment of the PCT Regulations concerning the structure of Rule 13^{ter} as well as the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13^{ter} were prepared by the International Bureau accordingly and made available, in the form of a preliminary draft document, for comment by the Working Group and the International Authorities via the PCT reform electronic forum and the MIA (Meeting of International Authorities) electronic form, respectively. The further revised proposals contained in the Annex to this document take into account the comments received on the preliminary draft.

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

[Annex follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

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² 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.

Rule 3

The Request (Form)

3.1 and 3.2 [No change]

3.3 *Check List*

(a) The request shall contain a list indicating:

(i) [No change]

(ii) where applicable, that the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a sequence listing in electronic ~~computer~~ ~~readable~~ form, a document relating to the payment of fees, or any other document (to be specified in the check list);

[COMMENT: With regard to the wording “computer readable form,” it is proposed to align that wording with that used in Parts 7 and 8 of the Administrative Instructions and to use, throughout the Regulations, the wording “electronic form” instead. The Administrative Instructions would have to be modified accordingly.]

(iii) [No change]

(b) [No change]

3.4 [No change]

Rule 5

The Description

5.1 [No change]

5.2 [No change] *Nucleotide and/or Amino Acid Sequence Disclosure*

(a) [No change] Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing complying with the standard provided for in the Administrative Instructions and presented as a separate part of the description in accordance with that standard.

(b) [No change] Where the sequence listing part of the description contains any free text as defined in the standard provided for in the Administrative Instructions, that free text shall also appear in the main part of the description in the language thereof.

Rule 13ter

Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Procedure Before the International Searching Authority *Sequence Listing for International Authorities*

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, unless such listing in electronic form is already available to it, and to pay to it, where applicable, the late furnishing fee referred to paragraph (c), within a time limit fixed in the invitation.

~~Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:~~

~~(i) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing complying with that standard;~~

~~(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.~~

[Rule 13ter.1(a), continued]

[COMMENT: The existing text of paragraph (a) is proposed to be deleted and replaced by the text appearing here. The relevant standard (covering sequence listings in both paper and electronic forms) is set out in Annexes C and C-bis of the Administrative Instructions. Where the international application is in paper form, paragraph (a) would enable the International Searching Authority to invite the furnishing of a sequence listing in electronic form complying with the standard whether or not there is a complying listing in paper form as required by Rule 5.2. Where the international application is filed in fully electronic form (under Part 7 of the Administrative Instructions), or where the international application is filed on paper together with a sequence listing in electronic form (under Part 8 of the Administrative Instructions), paragraph (a) would enable the Authority to invite the furnishing of a further sequence listing complying with the standard only if that already furnished did not comply with the standard. Where a complying sequence listing is furnished in electronic form spontaneously by the applicant before being invited by the Authority, a further listing would obviously not be needed and could not be required by the Authority. The possibility for the International Searching Authority to require a sequence listing in paper form, which seems less likely to arise in practice, is dealt with in paragraph (b), below.]

(b) ~~[Deleted]~~ Where the entire international application is filed on paper and the International Searching Authority finds that the description does not comply with Rule 5.2(a), it may invite the applicant to furnish, for the purposes of the international search, a sequence listing in paper form complying with the standard provided for in the Administrative Instructions, unless such listing in paper form is already available to it, whether or not the furnishing of a sequence listing in electronic form is invited under paragraph (a).

[COMMENT: A sequence listing in paper form cannot be required where the international application is filed in fully electronic form (under Part 7 of the Administrative Instructions), or where the international application is filed on paper together with a sequence listing in electronic form (under Part 8 of the Administrative Instructions). It is expected that a sequence listing in paper form would be required only in exceptional circumstances. The Authority would of course be free to print out a listing from the electronic version. Since non-compliance with Rule 5.2(a) is not in the nature of a formal defect, it cannot be addressed by way of a “correction.” However, defects under Rule 5.2(b) may be corrected under Rule 13ter.1(f), below.]

[Rule 13ter.1, continued]

(c) The furnishing of a sequence listing in response to an invitation under paragraph (a) or (b) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 25% of the [search fee] [international filing fee].

[COMMENT: See the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 65, 66 and 68. Following comments received on the preliminary draft made available for comments via the PCT reform electronic forum and the MIA electronic forum, it is no longer proposed, as was in the preliminary draft, to fix the maximum amount of the late furnishing fee at 25% of the international filing fee. Rather, noting the clear division of opinion in the fifth session of the Working Group, the Working Group may again wish to consider whether the maximum amount should be fixed by a reference to the search fee or the international filing fee.]

(d) (e) If the applicant does not, ~~comply with an invitation under paragraph (a)~~ within the time limit fixed in the invitation under paragraph (a) or (b), furnish the required sequence listing and pay any required late furnishing fee, the International Searching Authority shall only not be required to search the international application to the extent that ~~such non-compliance has the result that~~ a meaningful search can cannot be carried out without the sequence listing.

[COMMENT: It is proposed to further amend present paragraph (c) (proposed new paragraph (d)) by adding, at the end, the words “without the sequence listing” so as to avoid a possible argument by the applicant that a meaningful search could be carried out where the required sequence listing was furnished but the required late furnishing fee not paid. Otherwise, the proposed amendment of paragraph (e) was approved by the Working Group at its fifth session (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 70). In approving this proposed amendment, the Working Group concluded that, if a sequence listing and any required late furnishing fee were received after the time limit fixed in the invitation but before the International Searching Authority had declared that a meaningful search could not be carried out, the words “shall not be required to search” provided sufficient flexibility to allow the search to be carried out anyway (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 69).]

[Rule 13ter.1, continued]

(e) ~~(f)~~ Any sequence listing not contained in the international application as filed, whether furnished in response to an invitation under paragraph (a) or (b) or otherwise, shall not, ~~subject to Article 34,~~ form part of the international application, but this paragraph shall not prevent the applicant from amending the description in relation to a sequence listing pursuant to Article 34(2)(b). ~~Paragraphs (a) and (e) shall apply mutatis mutandis to the procedure before the International Preliminary Examining Authority.~~

[COMMENT: It is proposed to amend present paragraph (f) (proposed new paragraph (e)) so as to clarify that a sequence listing (either in paper form or in electronic form) furnished by the applicant only for the purposes of the international search would not form part of the international application, and so as to clarify that this would not preclude the possibility that an applicant, under Chapter II, may amend the sequence listing part of the description under Article 34 (see proposed new Rule 13ter.2, below; see also the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 71 and 72). As regards present paragraph (e), it is proposed to move its contents (further amended) to Rule 13ter.2 as proposed to be amended (see below).

(f) ~~(d)~~ Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to submit ~~file~~ the required correction. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

[COMMENT: Drafting change only.]

13ter.2 ~~13ter.1(e)~~ Procedure Before the International Preliminary Examining Authority

Rule 13ter.1 ~~Paragraphs (a) and (e)~~ shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority[, provided that any reference to the search fee shall be construed as a reference to the international preliminary examination fee].

[COMMENT: The proposed amendments to present Rule 13ter.1(e) (proposed new Rule 13ter.2) are consequential on the proposed amendments to Rule 13ter.1. The text presented in square brackets would only need to be included should the Working Group decide to fix the maximum amount of the late furnishing fee by a reference to the search fee (see Rule 13ter.1(c), above).]

13ter.3 ~~13ter.2~~ Sequence Listing for Designated Office

~~Once the processing of the international application has started before a designated Office, Rule 13ter.1(a) shall apply *mutatis mutandis* to the procedure before that Office.~~ No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

[COMMENT: It is proposed to delete the first sentence of present Rule 13ter.2 (proposed new Rule 13ter.3), consequential on the proposed amendments to Rule 13ter.1(a), and to leave the procedure with regard to sequence listings before designated Offices to the applicable national law of the designated Office concerned, except that no such Office would be permitted to require the applicant to furnish a sequence listing (be it in paper form or in electronic form) other than a listing complying with the standard provided for in the Administrative Instructions.]

Rule 23

Transmittal of the Search Copy, Translation and Sequence Listing

23.1 *Procedure*

(a) and (b) [No change]

(c) Any sequence listing ~~in computer readable form~~ which is furnished to the receiving Office shall be transmitted by that Office to the International Searching Authority.

[COMMENT: It is proposed to broaden the scope of the Rule so as to ensure that any sequence listing furnished to the receiving Office for the purposes of international search, be it on paper or in electronic form, is transmitted to the International Searching Authority.]

Rule 76

~~Copy, Translation and Fee Under Article 39(1); Translation of Priority Document;~~

Application of Certain Rules to Procedures Before Elected Offices

[COMMENT: The proposed amendment of the title of this Rule is consequential on the proposed amendment of the subtitle of Rule 76.5 (see below).]

76.1, 76.2 and 76.3 [*Remain deleted*]

76.4 [No change]

76.5 Application of Certain Rules to Procedures Before Elected Offices ~~22.1(g), 47.1, 49, 49bis and 51bis~~

[COMMENT: Clarification and simplification only.]

Rules 13ter.3, 22.1(g), 47.1, 49, 49bis and 51bis shall apply, provided that:

[COMMENT: It is proposed to amend Rule 76.5 so as to ensure that Rule 13ter.3 is also applied in respect of elected Offices.]

(i) to (v) [No change]

[End of Annex and of document]