

Patent Cooperation Treaty (PCT) Working Group

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FORMALITIES CHECKING IN THE PCT

Document prepared by the International Bureau

SUMMARY

1. The current handling of formalities examination in the PCT includes inconsistencies and uncertainty. Some issues will require further progress in the future on developing the formalities requirements themselves, including allowing color drawings and redefining the physical requirements to better reflect the needs of electronic processing. This document presents a proposal for improving the overall quality of service in the meantime by moving the primary responsibility for formalities examination from receiving Offices to the International Bureau, allowing for the assistance of the International Searching Authority in specific situations and distinguishing between defects that require correction and others that the applicant may wish to correct. This document also notes other combinations of similar options that could be considered.

BACKGROUND

REQUIREMENTS OF FORMALITIES CHECKING

2. PCT Article 11 requires the receiving Office to check that a purported international application fulfils the minimum requirements to be given an international filing date. Article 14 then sets out a further set of checks on defects that should be corrected before the application proceeds to international publication. Specifically, Article 14(1) states:

- (1)(a) The receiving Office shall check whether the international application contains any of the following defects, that is to say:
- (i) it is not signed as provided in the Regulations;
 - (ii) it does not contain the prescribed indications concerning the applicant;

- (iii) it does not contain a title;
- (iv) it does not contain an abstract;
- (v) it does not comply to the extent provided in the Regulations with the prescribed physical requirements.

(b) If the receiving Office finds any of the said defects, it shall invite the applicant to correct the international application within the prescribed time limit, failing which that application shall be considered withdrawn and the receiving Office shall so declare.

3. The requirement of Article 14(1)(a)(v) is implemented by Rule 11 (which contains the actual physical requirements) and Rule 26.3. Rule 26.3(a) includes the following requirements (with similar requirements in paragraph (b) dealing with documents not filed in a language of publication and corresponding translations):

26.3 *Checking of Physical Requirements under Article 14(1)(a)(v)*

(a) Where the international application is filed in a language of publication, the receiving Office shall check:

- (i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;
- (ii) any translation furnished under Rule 12.3 for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.

“REASONABLY UNIFORM INTERNATIONAL PUBLICATION”

4. The requirement of “the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication” is interpreted differently by different receiving Offices and the International Bureau, in some cases, a receiving Office may consider sheets satisfactory for international publication but then be requested by the International Bureau under Rule 28 (Defects Noted by the International Bureau) to raise an objection. The receiving Office might alternatively raise an objection to avoid the possibility of the International Bureau making such a request in cases where in fact the International Bureau would be satisfied with the application as filed. Alternatively, the receiving Office might correctly determine that the pages are not immediately suitable for reproduction, but find that the International Bureau would prefer that no invitation to correct be made because the defects are more easily fixed *ex-officio* than replacement sheets can be processed (this is typically the case for incorrect margins, page numbering errors or extraneous content in margins).

5. Defining more clearly what is needed for “reasonably uniform publication” is not easy. Some guidelines can be given, but since documents are still converted to black and white TIFF images for the purposes of international publication, it is necessary to see the results of the conversion, and to know which defects can be automatically corrected by the International Bureau more easily. Even then, the question is highly subjective, dependent on the assumption of the desired quality of international publication – whether the intention is a high quality publication of the standard implied by Rules defining expectations based on the use of a professional drafter to produce drawings, or something “good enough” to get the idea across.

6. The issue of knowing whether images will look acceptable after conversion should become largely irrelevant once color drawings are accepted, which is being pursued separately as part of the development of new publication systems based on XML processing. However, this will not solve all of the issues and it is desirable to address the question of formalities

checking more generally in its own right. Realistically it only makes sense for the IB to act as the ultimate arbiter of the standard since it is the IB which actually undertakes “reasonably uniform international publication.”

INFORMAL DRAWINGS

7. One of the key issues raised by the United States Patent and Trademark Office in document PCT/MIA/27/14 was the case of “informal drawings”. It is common in some jurisdictions for applicants initially to file sketched drawings, not prepared to the standard of a professional drafter as implied by the requirements of Rule 11.13(a) to (f). These are subsequently replaced by higher quality drawings. This process is typically quite simple in a national application. However, in some cases, it may not be appropriate to allow the formal drawings as corrections within the scope of PCT Rule 26. In other cases, it may be difficult for a formalities examiner to determine whether a correction is permissible. It is advisable for applicants to prepare formal drawings in time to submit them as part of international applications as filed, but there are a significant number of applications where this is not done.

8. At the twenty-ninth session of the Meeting of International Authorities under the PCT, some Authorities considered that “the question of the appropriate standard for publication was independent of whether informal drawings were sufficient for the purposes of international search – in most cases other than the question of the conversion of color drawings, informal drawings were perfectly sufficient to form the basis of an international search” (paragraph 21 of the Summary by the Chair, document PCT/MIA/29/10).

9. Noting that many national Offices will require a high quality of drawing to be prepared for the national phase and that it is desirable for patent publications to be read and understood easily, rather than merely being sufficient to support the legal requirement of disclosure, the International Bureau considers that a good standard of drawing should be required. However, once again it is difficult to define the standard objectively.

SERVICE TO APPLICANTS

10. A further issue is whether the Rules at present deliver the most appropriate service to applicants. While many applicants will prefer not to make corrections to the international application unless required to do so, others may welcome a warning of defects that are not considered relevant to reasonably uniform international publication but which would provide applicants with an opportunity to correct a defect in the international phase that might otherwise be the subject of objections in several Offices during the national phase.

OPTIONS

11. The solution to many of the underlying issues lies in improvement of the systems for filing, processing and publishing international applications, as well as updating Rule 11 (which still stems from a world of paper filings and paper publication) to more effectively represent the needs of electronic processing and to permit color drawings. In the meantime however, several measures could be considered in various combinations.

- (a) Formalities checking, beyond the checking necessary for the purpose of satisfactory reproduction to ensure that the record copy is complete and can be properly transmitted to the International Bureau, could be delegated to the International Bureau.
- (b) Substantive examiners from the International Searching Authority could be given a role in deciding whether certain corrections were appropriate, notably with regard to “informal drawings” and whether any text contained in the drawings is required for understanding and merits translation by the IB.
- (c) Formalities checking could be done at two levels, indicating defects that require correction and others that the applicant may optionally wish to correct.

12. The standard of “satisfactory reproduction” is already used in the Regulations (see PCT Rules 26.3(a)(ii) and (b)(i)). It is proposed to clarify for receiving Offices how to interpret this standard. The overarching goal of such provisions would be to attempt to ensure that any international application filed electronically in accordance with Annex F of the Administrative Instructions and any international application filed on paper the contents of which can be captured without losing any information into an Annex F compliant package would meet this standard.

FORMALITIES EXAMINATION BY THE INTERNATIONAL BUREAU

13. The Annex contains draft amendments to the PCT Regulations that would have the effect of moving the primary responsibility for formalities examination under the PCT to the International Bureau. This would have the advantage of bringing greater consistency to the process and eliminating many unnecessary invitations to submit corrections. The staff involved would be viewing the international application as converted. They are also the same staff responsible for preparing the international publication and are in a good position to know whether the application body is suitable for international publication and whether defects can easily be corrected *ex-officio* without the need for requesting replacement sheets. For example, in most cases, errors in margins, page numbering and inappropriate content within the margins can be fixed automatically. Some scanning blemishes can also be fixed without the need to request replacement sheets.

14. This formalities examination service could be offered in all ten languages of publication. Rule 92.2(d) at present requires any letter from the applicant to the International Bureau to “be in English, French or any other language of publication as may be permitted by the Administrative Instructions.” As explained in document PCT/WG/8/23, this is being used to gradually extend the options for language use by applicants where the International Bureau has the capacity and it can be done “without detriment to third parties or designated Offices who rely on being able to understand the outcomes of the International Bureau’s work”. Since this work is traditionally done by receiving Offices, where file access is difficult, this proposal should improve accessibility and multilingual processing, rather than reduce it.

15. Current Rule 92.2(e) states “[a]ny letter or notification from the International Bureau to the applicant or to any national Office shall be in English or French.” The proposal in Annex I would extend a similar possibility in terms of Administrative Instructions that would allow certain actions to be taken in other languages of publication. As a result, any form inviting correction of defects could be rendered for sending to the applicant in the language of the request. The International Bureau has staff with the various language capabilities to deal with this responsibility at the estimated volume of work required for this purpose.

ROLE OF THE INTERNATIONAL SEARCHING AUTHORITY

16. The International Bureau has a wide range of expertise on which to call for the purpose of deciding whether corrections are appropriate, both for informal drawings and other cases, and believes that it could make reasonable judgements in most cases. However, document PCT/MIA/29/3 suggested the possibility that the International Searching Authority might be called on to assist in certain specific cases requiring an understanding of the subject matter in the application, which goes beyond mere formalities. The discussion was summarized as follows (paragraph 22 of document PCT/MIA/29/10):

“22. Some Authorities were supportive of the idea of the International Searching Authority taking a role supporting the receiving Office in the assessment of formalities requirements. The search examiners were in a better position than formalities examiners at the receiving Office to assess the question of added subject matter in replacement drawings. Others raised concerns including the issue of confusing processes by including additional actors, additional costs and burdens for Authorities and potential delays caused

by further layers of processing. One Authority emphasized that if such a role were given, it should be based on an invitation being made to the applicant to submit corrections to the Authority in specific cases, not a general right for the applicant to submit corrections of their own volition.”

17. Taking this into account, the International Bureau considers that it would be useful to have the ability to call on the International Searching Authority to assist in particular situations. However, it agrees that it would not be desirable to allow applicants to submit corrections (as distinct from rectifications) to the Authority of their own volition. If International Searching Authorities so agree, it is proposed that the responsible authority for corrections (whether the receiving Office or the International Bureau) should transmit copies to the International Searching Authority for their opinion in cases requiring the understanding of the substance of the application. At least in the case where the International Bureau was responsible for formalities examination, it is expected that this would only need to be done on relatively rare occasions. It is further proposed that this should initially be tried on an informal basis. A specific legal basis could be added later if experience showed that this was necessary.

INDICATING DEFECTS WITHOUT AN OBLIGATION TO CORRECT

18. As noted in paragraph 10, above, it may be possible to give applicants a better service by bringing defects to their attention even if there is no legal obligation to correct them in the international phase, since these may be raised later by designated or elected Offices in the national phase.

19. The Annex contains a possible way to offer such a service. This is done in the context of the proposal to move, with the exception of the checking necessary for the purpose of satisfactory reproduction, the criteria for which is to be specified in the Receiving Office Guidelines, primary responsibility for formalities examination to the International Bureau. The proposal includes a reference to the Administrative Instructions to allow additional guidance to be offered based on experience as to when it might be appropriate to bring defects to the attention of applicants, so as to find the right balance of good information against the work involved for Offices and applicants, particularly in the case where there are no defects the correction of which would be obligatory.

20. The Working Group is invited to consider the amendments in the Annex to document PCT/WG/15/6 and the proposal in paragraph 17, as well as the other options referred to in paragraphs 11 and 12.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

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Rule 26

**Checking by, and Correcting before, the Receiving Office
of Certain Elements of the International Application**

26.1 to 26.2bis [No change]

26.3 *Checking of Physical Requirements under Article 14(1)(a)(v)*

The receiving Office shall check the international application and any translation furnished under Rules 12.3 or 12.4 for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction. ~~(a) Where the international application is filed in a language of publication, the receiving Office shall check:~~

~~(i) — the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;~~

~~(ii) — any translation furnished under Rule 12.3 for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.~~

~~(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:~~

~~(i) — the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction;~~

~~(ii) — any translation furnished under Rule 12.3 or 12.4 and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.~~

~~26.3bis— Invitation under Article 14(1)(b) to Correct Defects under Rule 11~~

~~The receiving Office shall not be required to issue the invitation under Article 14(1)(b) to correct a defect under Rule 11 where the physical requirements referred to in that Rule are complied with to the extent required under Rule 26.3.~~

26.3ter to 26.5 [No change]

Rule 28

Checking of Defects **Noted** by the International Bureau

28.1 ~~Note on Certain~~ Checking of Defects by the International Bureau

~~(a) If, in the opinion of the International Bureau, the international application contains any of the defects referred to in Article 14(1)(a)(i), (ii) or (v), the International Bureau shall bring such defects to the attention of the receiving Office.~~

~~(b) The receiving Office shall, unless it disagrees with the said opinion, proceed as provided in Article 14(1)(b) and Rule 26.~~

(a) The International Bureau shall check the international application and any translations furnished under Rule 12.3 or 12.4 for compliance with Rule 11.

(b) Where a document

(i) to form part of the international publication fails to meet the requirements referred to in Rule 11 to the extent necessary for the purpose of reasonably uniform international publication, or

(ii) any other document referred to in paragraph (a) fails to meet the requirements referred to in Rule 11 to the extent necessary for the purpose of satisfactory reproduction,

the International Bureau shall, preferably within one month of receiving the international application, issue an invitation to correct the defect within two months from the date of the invitation. The time limit may be extended by the International Bureau at any time before a decision is taken.

(c) The International Bureau may, in accordance with the Administrative Instructions, bring other defects under Rule 11 to the attention of the applicant. The International Bureau shall clearly indicate that the applicant is not obliged to correct such defects.

(d) The applicant shall submit any correction to the International Bureau as a replacement sheet embodying the correction. A letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

(e) The International Bureau shall decide whether the applicant has submitted the correction within the applicable time limit under paragraph (b). If the correction has been submitted within the applicable time limit but does not correct the lack of compliance which was the subject of the invitation under paragraph (b)(i), the International Bureau may consider the international application as withdrawn in accordance with Article 14(1)(b).

Rule 92

Correspondence

92.1 [No change]

92.2 *Languages*

(a) [No change]

(b) [No change]

(c) [Remains deleted]

(d) [No change] Any letter from the applicant to the International Bureau shall be in English, French or any other language of publication as may be permitted by the Administrative Instructions.

(e) Any letter or notification from the International Bureau to the applicant or to any national Office shall be in English, ~~or~~ French or any other language of publication as may be permitted by the Administrative Instructions.

[End of Annex and of document]