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ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

C. PCT 1181

July 14, 2009

Madam,
Sir,

This Circular is addressed to your Office in its capacity as a receiving Office (RO) under the Patent Cooperation Treaty (PCT). It is intended to give procedural guidance on how to deal with international applications containing sequence listings which are filed after July 1, 2009, in a manner which does not meet the requirements of the Administrative Instructions (AIs) as modified.

It is recalled that as of July 1, 2009, Part 8 of the AIs has been deleted and thus the possibility to file international applications on paper with the sequence listing part of the description or tables relating to sequence listings in electronic form only (sometimes referred to as “mixed mode filings”), is no longer available to applicants. While the International Bureau has tried to inform PCT users of this modification to the AIs through the usual channels, there remains a risk that some applicants might continue to try to file such “mixed mode” sequence listing applications after July 1, 2009. The following constitutes the proposed practice from the International Bureau for dealing with such cases.

It is recalled that this modification was primarily suggested and adopted in order to streamline the processing of international applications for Offices by abolishing a rather complex mode of filing international applications. Furthermore, a fee incentive was introduced that favors, as far as the international filing fee is concerned, the filing of sequence listings in Annex C/ST. 25 compliant text format. Because this modification was therefore not adopted to help applicants file international applications, the International Bureau is of the view that receiving Offices should make serious efforts so that applicants do not suffer any loss of rights due to this modification.

In the event that an applicant should (erroneously) submit, after July 1, 2009, an international application in such “mixed mode”, the International

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Bureau would recommend the following procedures be employed by receiving Offices to handle such cases:

1. If a receiving Office happens to notice the mistake on the date of receipt of the international application, the easiest manner to address this issue would be an informal contact directly with the applicant or agent (by telephone etc.) inviting him to file again on the same day in accordance with the correct procedures with an understanding that the first submission should be replaced by the second submission. However, it is likely that relatively few cases can be detected this quickly by the receiving Offices and therefore, for all other cases, the following procedures are recommended.

2. Applicants are most likely to attempt to continue to file “mixed mode” applications where the sequence listing part of the description or the tables relating to sequence listings are larger than 400 pages if printed out. It is recommended that such applications be accepted as defective (because of the paper parts) electronic submissions on physical media under Part 7 of the AIs. Even if the sequence listing was submitted as a PDF file and the applicant would no longer benefit from the fee benefit that existed under former Part 8, to deal with such applications as a defective electronic submission still benefits the Offices and the International Bureau by avoiding the obligation to deal with a potentially large volume of paper. It should be noted that in some cases, where the applicant has submitted the sequence listing in Annex C/ST. 25 text format, he may have overpaid the international filing fee since according to this arrangement, he will be entitled to the benefits of new Section 707(a-bis) (not counting such listings towards the number of pages on which fees are payable). However, the applicant would not be eligible for any of the “electronic filing” fee reductions (except any PCT-EASY filing reduction which might already have been claimed) because he would not actually have provided the listed items required to be in electronic form.

The theory behind this approach consists of considering the submission of the sequence listing on a CD or diskette as an attempt to file an international application fully electronically under Section 703 of the AIs on a physical medium. In a case where a receiving Office feels that such a submission does not comply with Section 703(b), in that it does not comply with the e-filing specifications notified by your Office to the International Bureau, receiving Offices should nevertheless consider relying on Section 703(e) which gives a receiving Office the authority to accept an electronically filed application on an *ad hoc* basis even if it does not fully comply with all the requirements of Section 703(b). Given the exceptional nature of such applications and the background to the modification of the AIs mentioned above, it would seem justified to rely on Section 703(e) and to accept such applications on this basis.

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Such filings in electronic form would obviously contain a number of defects. For example, the electronic application as such, appearing on the CD or diskette, would not seem to include a claim or claims (PCT Article 11(1)(iii)(e)). In such a case, PCT Article 11(2)(a) provides that the applicant should be invited to furnish the required corrections (e.g., submit the missing claims). Such corrections could, before most receiving Offices, only be submitted by way of paper replacement sheets. For “mixed mode” applications, it would seem, however, that even without issuance of an invitation by the receiving Office, any such defects are already corrected by the submission of the paper part of the initial “mixed mode” submission. The paper part of the “mixed mode” application could thus be regarded as a correction under either PCT Articles 11(2) (e.g. furnishing of the missing claims etc.) or 14(1)(b) (e.g. furnishing of a request form etc.). Since the correction has already been submitted on the same day as the electronic parts, the international filing date could therefore remain the date of receipt of the “mixed mode” sequence listing application.

3. In the event that receiving Offices currently do not accept international applications filed electronically (and would not wish to do so for such cases on an *ad hoc* basis) or if the receiving Office would prefer not to deal at all with such applications after July 1, 2009, the International Bureau would encourage such Offices to rely on PCT Rule 19.4(a)(iii) and transmit such cases to the receiving Office of the International Bureau. The International Bureau hereby declares its willingness to accept all such cases. Under PCT Rule 19.4(a)(iii), any such transmission would, however, also have to be authorized by the applicant.

4. As a last alternative, and if any receiving Office does not wish to follow any of the above recommendations, it is recommended that the receiving Office accept such applications as paper filings, though defective. In order to allow applicants to include the content of the sequence listing submitted on CD as part of the disclosure and thus complete the paper filing, the applicant would need to be given the opportunity to resubmit the sequence listing part of the description on paper. Since the content of the sequence listing was provided to the receiving Office at the time of filing of the international application, it is recommended that such a print-out of the content of the CD, accompanied by a statement that the content of the print-out is identical to what was submitted earlier in electronic form, be accepted as replacement sheets under PCT Rule 26. The international filing date should therefore not be modified.

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It is our hope that these practice notes will be useful to your Office. Receiving Offices which have questions or comments on this Circular should contact the PCT Legal Division at: pct.legal@wipo.int.

Yours sincerely,

A handwritten signature in blue ink, appearing to read 'Francis Gurry', with a stylized flourish at the end.

Francis Gurry
Director General