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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

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**PROPOSED MODIFICATIONS OF THE
PCT PRELIMINARY EXAMINATION GUIDELINES AND
PROPOSED AMENDMENTS OF PCT RULES 64 AND 70.10**

Document prepared by the International Bureau

Proposed modifications of the PCT Preliminary Examination Guidelines

1. At its fourth session held in Geneva from June 27 to July 1, 1994, the Meeting agreed on certain modifications, based on proposals by the United States Patent and Trademark Office and the European Patent Office, of the PCT Preliminary Examination Guidelines (see document PCT/MIA/IV/14, paragraphs 19 to 38). Those modifications were subsequently promulgated.
2. The current text of the PCT Preliminary Examination Guidelines is that contained in document PCT/GL/3, dated March 1, 1993, and published as a Special Issue of the *PCT Gazette*, No. 07/1993, on March 18, 1993, as affected by modifications with effect on April 1, 1995, notified by WIPO Circular PCT 565, dated March 10, 1995, and published in *PCT Gazette* No. 14/1995 on March 30, 1995.
3. The International Bureau now proposes that the Meeting consider further modifications to those Guidelines. These proposals derive in large part from those made previously by the United States Patent and Trademark Office.

4. Brief explanations of the proposed amendments are set out in the following paragraphs. The paragraphs of the Guidelines, as proposed to be modified, appear in Annex I to this document.

5. *Chapter I, paragraph 3.3 [Nature of the Guidelines]* It is proposed to amend this paragraph in order to clarify that the Guidelines are designed to aid the International Preliminary Examining Authorities (IPEAs) in their work of formulating non-binding opinions in accordance with PCT Articles 33 and 34. It is further proposed to amend the wording of this paragraph to indicate that the interpretations given by the PCT Assembly should be referred to, in addition to the Minutes of the Washington Diplomatic Conference, on questions concerning international preliminary examination. It is also proposed to amend this paragraph to indicate that any failure by an IPEA to follow the Guidelines, as distinct from the provisions of the PCT, PCT Regulations and PCT Administrative Instructions, would not of itself constitute a basis for review of the action of the Authority except where such review is provided for under the applicable national law and practice.

6. *Chapter II, paragraph 2.2 [Use of abstract]* Noting that the interpretation of PCT Article 3(3) presently contained in this paragraph (to the effect that the abstract cannot be used to justify the addition to the application of matter disclosed in the abstract) is not shared by all IPEAs, it is proposed to amend the paragraph to replace that interpretation of PCT Article 3(3) with text corresponding to the wording of the Article itself.

7. *Chapter II, paragraph 4.4 [Background art (“prior art” portion of two-part claim and subsequently identified documents)]* It is proposed to delete from this paragraph passages which refer to the first portion of a claim in two-part form as the “prior art” portion, and replace these passages with the wording of PCT Rule 6.3(b)(i). Such a modification is intended to address concerns expressed by the United States Patent and Trademark Office that the use of the term “prior art” portion only creates an implied admission that the recitations constitute prior art, not, however, an irrebuttable conclusion that material in the first part of a two-part claim is prior art. It is further proposed to delete from this paragraph statements which encourage the examiner to invite the insertion into the statement of prior art of references to documents identified subsequently, for example, in the international search report (noting that such amendments containing additional references to the prior art may be found to involve the addition of new matter), but to clarify that such an insertion may, however, be appropriate if no addition of new matter would result.

8. *Chapter III, paragraph 3.7a [Dependent and independent claims]* It is proposed to delete the last three sentences of this paragraph which deal with the interpretation of claims containing cross-references to other claims when considering the questions of novelty and inventive step (related issues can also arise in considering the question of unity of invention). The IPEAs vary in their approach to deciding whether claims are truly “dependent” and thus whether they necessarily share the novelty of the claim(s) to which they refer. This is the case, for example, where an allegedly dependent claim is directed to a process for producing a (novel) product or to the use of a (novel) product. At its fourth session, the Meeting did not agree with the deletion of that passage (see document PCT/MIA/14, paragraph 25). While some IPEAs may wish to give guidance to their examiners going beyond the wording of PCT Rule 6.4, the passage in question does not seem to be a necessary inclusion in the Guidelines, having regard to the text of the Treaty and the Regulations itself (see PCT Rule 6.4, in particular).

9. *Chapter III, paragraph 4.9 [Claims to “use of” a substance]* It is proposed to further consider a proposal by the United States Patent and Trademark Office for deletion of passages requiring that claims directed to the “use of” a substance are to be treated as being equivalent to “process” claims. Such deletion would address concerns expressed by that Office that the national law applicable in the United States of America would often not follow such an interpretation and would often not take this approach in relation to particular “use of” claims. There does not seem to be any basis in the PCT for a general endorsement of any particular interpretation of “use of” claims. Reference to “use” claims is, however, also made in other parts of the Guidelines (for example, in Chapter III, paragraph 3.1) and in the Administrative Instructions (for example, in Annex B, Part 1, Instructions Concerning Unity of Invention). At its fourth session, the Meeting rejected this proposal and the report of the Meeting stated: “Most Authorities believe that, since the PCT did not prevent international applications from including claims directed to a ‘use,’ the International Preliminary Examining Authority should provide an opinion on such claims, although it was understood that such claims may not be allowable in the national phase of processing in the United States of America” (see document PCT/MIA/IV/14, paragraph 27).

10. *Chapter IV, paragraph 5.2 [Mandatory re-citing of irrelevant documents]* Subject to an amendment of PCT Rule 64.3 being adopted by the PCT Assembly (see paragraph 13, below, and the corresponding proposal to amend PCT Rule 64.3 in Annex II), it is proposed to delete from this paragraph the wording requiring that the international preliminary examination report must always re-cite documents which were cited in the international search report, but are not considered as prior art for the purposes of the international preliminary examination.

11. *Chapter IV, paragraph 8.7 [Person skilled in the art and number of documents as factors in assessing obviousness]* It is proposed to delete from this paragraph the limitation to the effect that the combination of two or more distinct documents, because of the nature and the content of the documents, would be obvious to a person skilled in the art only “when concerned with the problem solved by the claimed invention.” Under the national law applicable in the United States of America, such a limitation is not necessary and there does not seem to be any basis in the PCT for the passage which is proposed to be deleted. It is further proposed to delete the wording requiring that the examiner, in considering the question of obviousness, should have regard to the number of documents which need to be combined (Chapter IV, paragraph 8.7(iii)). Under the national law applicable in the United States of America, the actual number of documents is irrelevant to the issue of obviousness. At its fourth session, the Meeting did not agree on the proposal to delete item (iii) of paragraph 8.7, based on the view of other Authorities that the number of documents involved was one of the factors to be taken into account in determining whether it would be obvious to combine the documents (see document PCT/MIA/IV/14, paragraph 31). However, neither approach is required or endorsed by the PCT itself, and the proposed deletion would be entirely compatible with the PCT.

12. *Chapter VI, paragraph 3.3 [Time limit for establishing international preliminary examination report]* It is proposed to modify this paragraph to refer to those (exceptional) cases in which the international preliminary examination report cannot be issued within the applicable time limit specified in PCT Rule 69.2 because the question of lack of unity of invention has been raised (during either international search or international preliminary

examination). While the international search report (or declaration under PCT Article 17(2)) must, in principle, be established within the time limit applicable under PCT Rule 42.1, the PCT Search Guidelines provide that “[i]f in case of lack of unity of invention or of an invitation to file a sequence listing the time limit cannot be met, the international search report must be established promptly after the receipt of additional search fees or after the expiration of the time limit for payment of such fees, if no such payment is made, or after the receipt of the sequence listing” (Chapter X, paragraph 8.1). The PCT Preliminary Examination Guidelines do not contain any analogous provision. It is therefore proposed to modify paragraph 3.3 of Chapter VI of the latter Guidelines to incorporate such a provision.

Proposed amendment of PCT Rules 64 and 70.10

13. Patent documents published on or after the filing date of the searched application will be cited in the international search report if the filing or priority date of the application concerned is earlier than the filing date of the searched application. Such published patent documents, although cited in the international search report, are not considered as prior art for the purposes of the international preliminary examination (see PCT Rule 64). PCT Rule 64.3 nevertheless requires IPEAs to always re-cite documents which were cited in the international search report, even where they are not considered relevant by the IPEA. It is proposed to amend PCT Rule 64.3 to remove that mandatory requirement but to clarify that such a re-citing may, however, be permitted.

14. At its fourth session, the Meeting noted that, while PCT Article 33(6) clearly entitles the IPEA to take into consideration any additional documents considered to be relevant in a particular case, PCT Rule 64 only covers specific types of documents, and that an amendment of that Rule may therefore need to be considered (see document PCT/MIA/IV/14, paragraph 29). It is now proposed to add a new PCT Rule 64.4 so to allow the citation of such additional documents, for example, citations of non-patent literature having a publication date after the relevant date set out in PCT Rule 64.1.

15. It is further proposed to amend PCT Rule 70.10 to provide, similarly to Rule 70.7(b), for the manner of citation of additional documents referred to in the international preliminary examination report by virtue of proposed new PCT Rule 64.4.

16. The text of the proposed amendments to both Rules appears in Annex II to this document. When any necessary amendments of the PCT Regulations have been adopted by the PCT Assembly, corresponding changes would be proposed to the PCT Preliminary Examination Guidelines.

17. The Meeting is invited to consider the proposed modifications of the PCT Preliminary Examination Guidelines contained in Annex I and the proposed amendments of PCT Rules 64 and 70.10 contained in Annex II.

[Annexes follow]

ANNEX I

PROPOSED MODIFICATIONS OF THE
PCT PRELIMINARY EXAMINATION GUIDELINES

[CHAPTER I: INTRODUCTION]

[Nature of the Guidelines]

3.3 The Guidelines are intended to cover typical occurrences. They should therefore be considered only as general directives; examiners will have to go beyond the instructions in exceptional cases. Nevertheless, applicants can expect the International Preliminary Examining Authorities to act, as a general rule, in accordance with the Guidelines until such time as they are revised. It should be noted also that the Guidelines do not have the binding authority of a legal text. These Guidelines have been designed to assist International Preliminary Examining Authorities in formulating a non-binding opinion in accordance with PCT Articles 33 and 34. For the ultimate authority on questions concerning international preliminary examination, it is necessary to refer to the PCT itself interpreted, where necessary, by reference to the Minutes of the Washington Diplomatic Conference and interpretations given by the PCT Assembly. Any failure of an International Preliminary Examining Authority to follow these Guidelines, as distinct from the provisions of the PCT, PCT Regulations and PCT Administrative Instructions, would not of itself constitute a basis for review of the action of the Authority except where such review is provided for under the applicable national law and practice.

[CHAPTER II: CONTENT OF THE INTERNATIONAL APPLICATION (OTHER THAN THE CLAIMS)]

[*Use of abstract*]

2.2 Rule 8 delineates the requirements for the abstract and it is for the International Searching Authority (Rule 38.2) to establish its final form (see Chapter XI, paragraphs 1 to 5 of the PCT Search Guidelines). The examiner will not be concerned with seeking any amendment of the abstract. He should, however, note that the abstract “merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought” (~~Article 3(3)~~) ~~has no legal effect on the international application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition of new subject matter.~~

<Article 3(3), Rule 8, 38.2>

[*Background art (“prior art” portion of two-part claim, and subsequently identified documents)*]

4.4 *Background art.* The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to ~~the first or “prior art” portion of the independent claim or claims~~ those technical features of the invention which are necessary for the definition of the

claimed subject matter but which, in combination, are part of the prior art (see Rule 6.3(b)(i) and Chapter III, paragraph 2.2). The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, may be ~~invited, where necessary, to put the invention into proper perspective~~ appropriate if no addition of new matter would result. For instance, while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, these alleged developments were already known. ~~Where such an invitation is issued, the~~ The examiner ~~may~~ should invite the inclusion of a reference to these documents and a brief summary of the relevant contents. ~~A new statement of advantage may also be appropriate.~~ Care should be taken that any such inclusion does not contravene Article 34(2)(b) (see Chapter VI, paragraphs 7.8 to 7.13).

<Article 34(2)(b), Rule 5.1(a)(ii), 6.3(b)(i)>

[CHAPTER III: CLAIMS]

[Dependent and independent claims]

3.7a A claim may also contain a reference to another claim even if it is not a dependent claim as defined in Rule 6.4. One example of this is a claim referring to a claim of a different category (e.g., “Apparatus for carrying out the process of Claim 1 ...”, or “Process for the manufacture of the product of Claim 1 ...”). Similarly, in a situation like the plug and socket example in paragraph 3.3 of this Chapter, a claim to the one part referring to the other cooperating part (e.g., “plug for cooperation with the socket of Claim 1 ...”) is not a dependent claim. ~~The examiner should carefully consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not. In the case of a claim for a process which results in the product, of a product claim, or a claim for the use of that product, if the product claim does not give rise to objections on novelty or inventive step grounds, then no separate examination for the obviousness of the process or use claim is necessary (see Chapter IV, paragraph 8.5). In all other instances, the fact that the claim referred to contains novel and inventive matter does not necessarily imply that the same is also true of the independent claim containing the reference.~~

[Claims to “use of” a substance]

The United States Patent and Trademark Office has proposed the deletion of paragraph 4.9 (see paragraph 9, above, for further details). Paragraph 4.9 presently reads:

“For the purposes of international preliminary examination, a ‘use’ claim of a form such as ‘the use of substance X as an insecticide’ should be regarded as equivalent to a

‘process’ claim of the form ‘a process of killing insects using substance X.’ Thus a claim of the form indicated should not be interpreted as directed to the substance X recognizable (e.g., by further additives) as intended for use of an insecticide. Similarly, a claim for ‘the use of a transistor in an amplifying circuit’ would be equivalent to a process claim for the process of amplifying, using a circuit containing the transistor and should not be interpreted as being directed to ‘an amplifying circuit in which the transistor is used’, nor to ‘the process of using the transistor in building such a circuit’.”

[CHAPTER IV: REQUIREMENTS FOR INTERNATIONAL PRELIMINARY
EXAMINATION]

[Mandatory re-citing of irrelevant documents]

5.2 A written disclosure, i.e., a document, should be regarded as made available to the public if, at the relevant date (as to “relevant date,” see paragraph 5.4 of this Chapter), it was possible for members of the public to have access to the content of the document and there was no bar of confidentiality restricting the use or dissemination of knowledge gained thereby. As a general rule, no non-patent document will be cited in the international search report if the date of publication or public availability of the document concerned is clearly the same as, or later than, the filing date of the international application. However, patent documents published on or after the filing date of the searched application will be cited in the search report if the filing or priority date of such published application is earlier than the filing date of the searched application. Such published patent documents, although cited in the search report, are not considered as prior art for the purposes of Article 33(2) and (3), but ~~are~~ may be mentioned in the preliminary examination report as provided in Rule 64.3*. The international search report may have cited a document where there is difficulty in establishing whether the date of publication or public availability of the document is or is not the same as, or later than, the filing date of the international application. The International Searching Authority will have tried to remove any doubt that may exist. Additional documents providing evidence in the case of doubt may have been cited. Any indication in a document of the date of its publication should be accepted as correct by the examiner unless proof to the

* Change to be made after amendment of PCT Rule 64.3 (see paragraph 9, above, and Annex II).

contrary has been offered, e.g., by the International Searching Authority, showing earlier publication, or by the applicant, showing later publication. Also, if there is any ambiguity as to the precise date of publication of a document, the International Searching Authority may have established a publication date, e.g., the date of receipt in a library to which the public has access. If the applicant presents sound reasons for doubting that the document forms part of the prior art in relation to his international application and any further investigation does not produce evidence sufficient to remove that doubt, the examiner should not pursue the matter further.

<Rule 33.1(c), 64.3, 70.10>

[Person skilled in the art and number of documents as factors in assessing obviousness]

8.7 In considering whether there is inventive step as distinct from novelty (see section 7 of this Chapter), it is permissible to combine the disclosures of two or more documents or parts of documents, different parts of the same document or other pieces of prior art, but only where such combination would be obvious to the person skilled in the art. In determining whether it would be obvious to combine two or more distinct documents, the examiner should have regard to the following:

- (i) whether the nature and content of the documents are such as to make it likely or unlikely that the person skilled in the art, ~~when concerned with the problem solved by the claimed invention,~~ would combine them;
- (ii) whether the documents come from similar, neighboring or remote technical fields;
- ~~(iii) the number of documents which need to be combined.~~

The combining of two or more parts of the same document would be obvious if there is a reasonable basis for the person skilled in the art to associate these parts with one another. It would normally be obvious to combine with other prior art documents a well-known text book or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents, one of which contains a clear and unmistakable reference to the other.

[CHAPTER VI: PROCEDURE BEFORE THE INTERNATIONAL PRELIMINARY
EXAMINING AUTHORITY]

[Time limit for establishing international preliminary examination report]

3.3 The time limit for the establishment of the international preliminary examination report is the same for all International Preliminary Examining Authorities and is set out in Rule 69.2.

This time limit may not exceed:

- (i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;
- (ii) nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

If, in case of lack of unity of invention, the time limit cannot be met, the international preliminary examination report must be established promptly after the receipt of additional preliminary examination fees or after the expiration of the time limit for payment of such fees, if no such payment is made.

<Rule 69.2>

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF PCT RULES 64 AND 70.10

Rule 64

Prior Art for International Preliminary Examination

64.1 and 64.2 [No change]

64.3 Certain Published Documents

In cases where any application or any patent which would constitute prior art for the purposes of Article 33(2) and (3) had it been published prior to the relevant date referred to in Rule 64.1 was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report ~~shall~~ may call attention to such application or patent in the manner provided for in Rule 70.10.

64.4 Additional Relevant Documents

The international preliminary examination report may contain citations of any additional document considered to be relevant in the particular case.

Rule 70

The International Preliminary Examination Report

70.1 to 70.9 [No change]

70.10 *Certain Published Documents*

(a) Any published application or any patent referred to in the report by virtue of Rule 64.3 shall be mentioned as such and shall be accompanied by an indication of its date of publication, of its filing date, and its claimed priority date (if any). In respect of the priority date of any such document, the report may indicate that, in the opinion of the International Preliminary Examining Authority, such date has not been validly claimed.

(b) Any additional document referred to in the report by virtue of Rule 64.4 shall be cited in accordance with Rule 43.5(b) and (e).

70.11 to 70.17 [No change]

[End of Annex II and of document]