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The International Bureau of the World Intellectual Property Organization  
./ (WIPO) presents its compliments and has the honor to transmit herewith  
documents PCT/R/WG/4/3, 6 and 9, prepared for the fourth session of the  
*Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will  
be held in Geneva from May 19 to 23, 2003.

The working documents are also available on WIPO's web site (see  
<http://www.wipo.int/pct/en/meetings>).

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Enclosures: documents PCT/R/WG/4/3, 6 and 9

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INTERNATIONAL PATENT COOPERATION UNION  
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WORKING GROUP ON REFORM OF THE PATENT  
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ASPECTS OF COPYRIGHT AND OTHER RIGHTS IN NON-PATENT LITERATURE  
MADE AVAILABLE BY INTELLECTUAL PROPERTY OFFICES

*Document prepared by the International Bureau*

## BACKGROUND

1. The Summary by the Chair of the third session of the Working Group on Reform of the Patent Cooperation Treaty states, in paragraph 63 (see document PCT/R/WG/3/5):

*“Copyright Issues Raised by the International Search and Preliminary Examination Procedure*

“63. Two delegations observed that the making and sending, by the International Searching Authority, of copies of documents cited in the international search report, as provided by Article 20(3) and Rule 44.3, could involve copyright infringement, in particular where it involved non-patent literature and the first digitization of a document. The International Bureau observed that the library community may also experience similar problems. It was agreed that the International Bureau, in cooperation with the Delegation of Canada and other Authorities, should study the matter with a view to having the matter considered by the appropriate body or bodies within WIPO.”

2. The present document contains a preliminary outline and discussion of certain legal issues arising from the making available of non-patent literature by industrial property offices (“Offices”) and outlines the broader context in which these issues might arise, taking into

account also the likely evolution of office practices in the digital environment. In light of this purpose, the document focuses not only on questions resulting from the application of Article 20(3) of the PCT and Rule 44.3 of the Regulations under the PCT, as mentioned in the summary of the Chair of the third session of the Working Group, but also on those that might arise from other, more technologically advanced, means for Offices to make non-patent literature available. The document was prepared by the International Bureau after making preliminary contacts with the Delegations of Australia and Canada, but it does not represent an agreed position.

## INTRODUCTION

3. Examination as to the novelty of a claimed invention requires a review of the relevant prior art. Traditionally, such examination was performed principally by reviewing paper-based sources of prior art, namely copies of published patent documents and of non-patent literature (the latter including, for instance, technical articles and textbooks).
4. During the last decade, in particular, the method by which the prior art review is performed has been profoundly affected by information technology, including the Internet. Sources of prior art which previously were only available on paper now also exist in digital form. Furthermore, in recent years, numerous databases providing online access to a wealth of patent and non-patent literature have become available, many of which can be consulted through the Internet. It is to be expected that this trend will intensify in the future. Some of these databases are made available on a commercial basis by private entities, while others have been developed by public authorities, most notably Offices. The value of these patent databases is a function of the richness of their content, as well as the ease of use. Aggregating a large amount of easily retrievable and relevant information, including non-patent literature, in such databases is a highly attractive proposition for the users of the patent system.
5. In the course of the performance of their functions, Offices make available sources of prior art, including non-patent literature, to a variety of persons and entities, including staff members within the Office, other Offices and applicants, and also third parties. There are various means by which these sources may be made available by the Offices concerned, including the mailing or distribution of paper copies of the materials at issue, the transmission of the same materials in electronic form through networks including the Internet (e-mail) and the making available of databases permitting online access to the materials in question. To the extent that those prior art sources include non-patent literature, their being made available in this manner by Offices may affect third parties' rights in the works concerned. Offices should therefore be aware of the legal implications which their practices may have in respect of those third party rights.

## THE MAKING AVAILABLE BY OFFICES OF NON-PATENT LITERATURE: SCENARIOS

6. As explained above, Offices may make non-patent literature available to different persons or entities by various means. While it is recognized that the list below is not exhaustive, it would appear that current and future Office practices typically would fall under one or more of the following categories:

- (i) the making by Offices of physical or digital copies of non-patent literature for consultation only by staff members of the Offices concerned ("Scenario A");

(ii) the creation by Offices of searchable databases containing non-patent literature, for consultation only by staff members of the Offices concerned, through the scanning, using Optical Character Recognition, and uploading of non-patent literature (“Scenario B”);<sup>1</sup>

(iii) the transmission by Offices of physical or digital copies of non-patent literature to designated Offices or applicants under Article 20(3) of the PCT (“Scenario C”);

(iv) the transmission by relevant Authorities of International Search Reports and International Preliminary Examination Reports containing hyperlink to non-patent literature hosted on third party Internet resources (for instance, a hyperlink to an article in a technical magazine posted on the website of an Internet publisher) (“Scenario D”);

(v) the creation and making available by Offices of databases, for consultation by the public through the Internet, containing hyperlink to non-patent literature hosted on third party Internet resources (“Scenario E”);

(vi) the making available by Offices of databases described in (ii) to the public for consultation through the Internet (“Scenario F”).

7. After a general review of the relevant legal principles, the remainder of this document will outline the legal issues which may arise from each of the above scenarios.

## RELEVANT LEGAL PRINCIPLES

8. A substantial portion of the non-patent literature, typically technical textbooks or articles in technical publications, are subject to exclusive rights granted to their authors by the copyright system and may also benefit from other forms of protection offered by similar rights. These exclusive rights or other forms of protection place important restrictions on the use which other parties may make of the works in question, absent authorizations (licenses) from the rightsholders. The international legal basis of these restrictions is discussed in the subsequent paragraphs of this paper.

### *Protection Under Copyright*

9. Article 2 of the Berne Convention for the Protection of Literary and Artistic Works (the Berne Convention) states that “[t]he expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings....” Many forms of non-patent literature, and certainly technical textbooks and articles in technical publications, qualify as “literary and artistic works” under the Berne Convention. The essential elements of the Berne Convention have been incorporated into the TRIPS Agreement through its Article 9(1) stating that “[m]embers shall comply with Articles 1 through 21 of the Berne Convention.”<sup>2</sup>

<sup>1</sup> See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

<sup>2</sup> Except in respect of the rights conferred under Article 6 *bis* of the Berne Convention.

10. The copyright system confers upon the author of literary and artistic works a bundle of different rights. Among the various rights granted, those that concern most directly the topic at issue are the right of reproduction, the right of distribution and the right of making available to the public.

11. The right of reproduction is enshrined in Article 9 of the Berne Convention, which provides that “[a]uthor of literary and artistic works protected by this Convention shall have the exclusive right of authorizing the reproduction of these works, in any manner or form.” With respect to the application of this right in the digital environment, the agreed statement concerning Article 1(4) of the WIPO Copyright Treaty (WCT)<sup>3</sup> reads as follows:

“The reproduction right, as set out in Article 9 of the Berne Convention, and the exceptions permitted thereunder, fully apply in the digital environment, in particular to the use of works in digital form. It is understood that the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of Article 9 of the Berne Convention.”

12. The right of distribution is laid down in Article 6(1) of the WCT which stipulates as follows:

“Authors of literary and artistic works shall enjoy the exclusive right of authorizing the making available to the public of the original and copies of their works through sale or other transfer of ownership.”

13. With respect to the right of making available to the public, Article 8 of the WCT states as follows:

“Without prejudice to [certain provisions of the Berne Convention], authors of literary and artistic works shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them.”

The passage “making available to the public of . . . works in such a way that members of the public may access these works from a place and at a time individually chosen by them” covers the posting of works on the Internet in order to allow the public to access or download them.<sup>4</sup>

<sup>3</sup> The WCT is one of two treaties which were adopted in 1996 by the WIPO Member States (both commonly referred to as the “WIPO Internet Treaties”), the other being the WIPO Performances and Phonograms Treaty (WPPT). The treaties, each having reached their 30<sup>th</sup> ratification or accession, have both entered into force: the WCT on March 6, 2002, and the WPPT on May 20, 2002. The WIPO Internet Treaties are designed to update and supplement the existing international treaties on copyright and related rights, namely, the Berne Convention and the Rome Convention.

<sup>4</sup> For an extensive analysis of the background to this provision and its relationship with the interactive, on-demand transmission of works in digital networks, see Mihály Ficsor, *The Law of Copyright and the Internet* (Oxford University Press, 2002), pages 145 through 254. For a broad discussion of copyright in the digital environment, see WIPO, *Intellectual Property on the Internet: A Survey of Issues* (December 2002), pages 29 through 63, available at <http://ecommerce.wipo.int/survey/index.html>.

*Protection Under Similar Rights*

14. While copyright is the most important, as well as the most internationally harmonized, legal source of limitations on the use which third parties may make of protected works, it is not the only such source. Depending on the jurisdiction in question, a variety of comparable user restrictions may be grounded on legal foundations other than copyright, including, in particular, misappropriation, unfair competition and the protection of databases. The latter concept is discussed in more detail below, in light of its special relevance to the topic at issue.

15. The region of the world where the protection of databases has found its most explicit legal articulation is the European Union, through Directive 96/9/EC of the European Parliament and of the Council of March 11, 1996 on the Legal Protection of Databases (the Database Directive).<sup>5</sup> Article 1(1) of the Database Directive defines a database as “a collection of independent works, data or other material arranged in a systematic or methodical way and individually accessible by electronic or other means.” Article 7(1) of the Directive stipulates that “Member States shall provide for a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of the database.” Article 7(5) further states that “[t]he repeated and systematic extraction and/or re-utilization of insubstantial parts of the contents of the database implying acts which conflict with a normal exploitation of that database or which unreasonably prejudice the legitimate interests of the maker of the database shall not be permitted.”

16. At the international level, there does not exist at present a comparable “*suigeneris*” right in databases, such as the one provided for in Article 7 of the Database Directive, although the possible creation of international protection for databases which by their nature do not benefit from copyright protection (namely, non-original databases), has been the subject of discussion for several years in WIPO’s Standing Committee on the Law of Copyright and Related Rights.

*Exceptions: General*

17. The copyright system has traditionally maintained a balance between protecting creators’ property rights through exclusive rights to control the use of their works, and the public interest in having access to and reasonable possibilities to use such materials. Copyright laws permit exceptions and limitations to copyright, in order to maintain this balance. In the United States of America, for example, this balance has been enshrined in the principle of “fair use” limitations on the rights of authors, while in other countries such as Australia and the United Kingdom, the concept is recognized by way of statutory exceptions to copyright infringement for “fair dealing.” In other countries, such as France, there exists no broad doctrine governing exceptions (such as “fair use” or “fair dealing”),<sup>6</sup> but specifically enumerated exemptions are expressly foreseen in the copyright legislation.

<sup>5</sup> That Directive entered into force on January 1, 1998, and has since been implemented in the national legislation of all European Union Member States.

<sup>6</sup> See Paul Edward Geller, *International Copyright Law and Practice*, Volume I, Release No. 14 (LexisNexis, 2002), para. 8[2].

18. The scope of permissible exceptions is to a large degree a matter of national law, although a number of overarching general principles exist at the international level. With respect to the right of reproduction, Article 9 of the Berne Convention states as follows:

“It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.”

19. Article 10 of the WCT similarly foresees that Contracting Parties may provide for exceptions to the right of distribution and right of making available to the public, subject to their meeting the same “three step test” laid down in Article 9 of the Berne Convention. The agreed statement concerning Article 10 of the WCT furthermore adds the following:

“It is understood that the provisions of Article 10 permit Contracting Parties to carry forward and appropriately extend into the digital environment limitations and exceptions in their national laws which have been considered acceptable under the Berne Convention. Similarly, these provisions should be understood to permit Contracting Parties to devise new exceptions and limitations that are appropriate in the digital network environment.”

20. The law of copyright, like patent law, is territorial and this characteristic is perhaps nowhere felt more acutely than in the area of exceptions and limitations. Which use would fall under the scope of an exception varies significantly from one jurisdiction to another, and the analysis of whether certain cross-border uses of works may benefit from an exception therefore, will often require finding the applicable law. If use of the work is made on the Internet, finding the applicable law becomes an exceptionally difficult exercise, in the light of the ubiquitous and global nature of that medium.<sup>7</sup>

21. Article 9 of the Database Directive also foresees a number of exceptions to the database “*sui generis*” right which it creates. These exceptions present certain similarities to those that are found in the copyright system.

#### *Exceptions: Government Use*

22. Several countries have provided for copyright exceptions relating to certain government use of protected works. For example, Section 45 of United Kingdom Copyright, Designs and Patents Act states that “(1) [c]opyright is not infringed by anything done for the purposes of parliamentary or judicial proceedings and (2) [c]opyright is not infringed by anything done for the purposes of reporting such proceedings, but this shall not be construed as authorising the copying of a work which is itself a published report of the proceedings.”<sup>8</sup> In certain countries, the exceptions for government use are more broadly crafted. The French Intellectual Property Code, for instance, states in its Article L.331-4 that “[copyright] may not prevent actions

<sup>7</sup> For an introductory discussion of the interplay between private international law, intellectual property and the Internet, see WIPO, Intellectual Property on the Internet: A Survey of Issues (December 2002), pages 113 through 131, available at <http://ecommerce.wipo.int/survey/index.html>.

<sup>8</sup> Similar provisions exist in the legislation of, for instance, Australia, Greece, India, Ireland, Spain and Singapore.

which are necessary for the accomplishment of a judicial or administrative procedure provided for by law, or which are undertaken for the purposes of public security.” As regards United States of America law, in an opinion of April 30, 1999 addressed to the General Counsel of the United States Department of Commerce, the Acting Assistant Attorney General concluded as follows on the question of whether government reproduction of copyrighted materials invariably is a “fair use”:

“There is no ‘per se’ rule that government reproduction of copyrighted material – including, in particular, government photocopying of copyrighted materials for internal government use – automatically qualifies as a fair use under section 107 of the Copyright Act of 1976. However, government photocopying would in many contexts be non-infringing because it would be a ‘fair use’; and there are good reasons that, if an agency decides to negotiate photocopying licensing agreements, it should seek to limit the scope of any such arrangement to cover only those government photocopying practices that otherwise would, in fact, be infringing.”<sup>9</sup>

23. With respect to the situation in Japan, a commentator from the Japan Patent Office (JPO) has stated the following:

“Article 42 of the Copyright Law of Japan stipulates that the right of reproduction shall not extend to (i) cases necessary for court procedures and (ii) those necessary for legislative and administrative internal use purposes, provided that the interests of the author are not unduly injured in light of the number and mode of the reproduction.”<sup>10</sup>

24. The subsequent section of this document considers each of the Scenarios identified in paragraph 7, above, in light of the aforementioned legal principles.

## APPLICATION OF LEGAL PRINCIPLES TO SCENARIOS

### *Scenarios A and B*

25. Several actions taken in Scenarios A and B may be viewed as implicating the right of reproduction and the right of distribution. In Scenario A, this is the case for the physical or digital reproduction of the copies of the prior art source materials by the Office (right of reproduction) and their transmission to the staff members of the Office (right of distribution). In Scenario B, the right of reproduction is implicated, at the very least, by the scanning of the works in question and their uploading into the database. Furthermore, the making available of the works through the database to the examiners of the Office may also implicate the right of communication to the public, notwithstanding the fact that these works may be accessible only by staff members of the Office and not the general public.

26. However, as observed above, certain countries recognize exceptions for government use and the actions taken by Offices in Scenarios A and B may, in a number of countries, fall under such exceptions. For instance, with respect to the situation in Japan concerning Scenario B, the Japan Patent Office has noted that:

<sup>9</sup> The full text of the Opinion is available at <http://www.cybercrime.gov/fairuse.htm>.

<sup>10</sup> See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).



“Understanding that the digitization of documents for [insertion into a database made available to the examiners of the Japan Patent Office (JPO)] is a permissible reproduction under Article 42 [of the Copyright Law of Japan], the JPO are continuing to digitize relevant documents for internal use only, without license agreement with the rightsholders.”<sup>11</sup>

27. It may be concluded that, in a number of countries, Scenarios A and B are problematic from a copyright perspective, unless appropriate licenses have been secured from the rightsholders, or unless they benefit from exceptions provided for under the applicable national law.

#### *Scenarios C and D*

28. Scenario C is based on Article 20(3) of the PCT, which reads as follows:

“At the request of the designated Office or the applicant, the International Searching Authority shall send to the said Office or the applicant, respectively, copies of the documents cited in the international search report, as provided in the Regulations.”<sup>12</sup>

With respect to the international preliminary examination report, Article 36(4) of the PCT furthermore states that:

“The provisions of Article 20(3) shall apply, *mutatis mutandis*, to copies of any document which is cited in the international preliminary examination report and which was not cited in the international search report.”

Copies of cited documents sent under Article 20(3) by relevant Authorities might be in paper or in electronic form (that is, scanned versions of the source material).

29. Scenario D reflects how the practice provided for in Article 20(3) might transform itself in the digital environment. Instead of sending physical or electronic copies of the documents, Authorities would simply provide hyperlinks, embedded in electronic versions of these search and examination reports, permitting recipients to access online the prior art source materials, which themselves would be hosted on third-party Internet resources.

30. In terms of the rights affected, Scenario C implicates the right of reproduction, the right of distribution, as well as the right of making available to the public.

31. With respect to Scenario D, the question is whether providing a hyperlink which resolves to a protected work may be infringing. No internationally harmonized rules governing specifically the liability for linking online content exist and, at the national level, the matter is mostly left for the courts to resolve. The case law which can be observed to date

<sup>11</sup> See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

<sup>12</sup> Rule 44.3 provides for modalities for the copying and transmission of the documents cited in the international search report.

is far from settled and it is therefore hard to draw any general conclusions, apart from the following:<sup>13</sup>

(i) Linking to the homepage of a website normally raises less concern than “deep-linking,” which connects a user directly to secondary material on another site, bypassing that site’s homepage. Links that might be provided in Scenario D would most likely qualify as deep links, as they would presumably resolve to a particular work (for example, a specific article in a technical magazine) hosted on the site of an online publisher, rather than its homepage.

(ii) The use of deep -links to retrieve pages from the targeted site’s database may, in some jurisdictions, amount to an infringement of rights in the database that contains the secondary information. As explained above, in the European Union, Article 7 of the Database Directive requires Member States to provide protection against the extraction and/or re-utilization of the “whole or of a substantial part of the contents of a database,” as well as against “the repeated and systematic extraction and/or re-utilization of insubstantial part of the contents of the database implying acts which conflict with a normal exploitation of that database or which unreasonably prejudice the legitimate interests of the maker of the database.”

32. While it is clear that Scenarios C and D raise important rights issues, a proper assessment of the legal appropriateness of these Scenarios should also take into account the following:

(i) The action taken by Offices in Scenario C (and, *mutatis mutandis*, perhaps also those in Scenario D) are mandated by treaty provision, namely Article 20(3) of the PCT. While this provision does not explicitly exempt Offices from complying with their copyright obligations, the fact that the practice at issue finds support in a rule of international law is not an irrelevant consideration. The relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law, and the impact this may have on the rights and obligations of relevant Authorities with respect to the reproduction and making available of non -patent literature to other Offices and applicants under the PCT merits further consideration.

(ii) Under Article 20(3) only the designated Office and the applicant would receive copies of (or hyperlinks permitting access to) the materials in question. As those materials thus would be made available only to a limited number of persons or entities (not the general public), such practice may benefit from an exception in a number of countries. A definitive answer to this question requires further analysis of the applicable national law by each Office concerned. To the extent the applicant and/or designated office is located in a jurisdiction other than that of the International Searching Authority or the International Preliminary Examination Authority, such analysis may require the consideration of more than one national law.

<sup>13</sup> For a more detailed discussion of linking online content, see WIPO, Intellectual Property on the Internet: A Survey of Issues (December 2002), pages 51 through 53, available at <http://ecommerce.wipo.int/survey/index.html>.

*Scenarios E and F*

33. Scenarios E and F, implicating the right of reproduction, as well as the right of making available to the public, raise even more serious concerns from a copyright and database protection perspective, as any exceptions for government use that may be provided for under the applicable national law would not apply to them, since the general public would be the primary beneficiaries of the databases in question.

## POSSIBLE APPROACHES

34. The preceding paragraphs indicate that, to varying degrees, all Scenarios envisaged in this document raised delicate issues of copyright and similar rights. With respect to the question of how to address these issues, the following observations are offered for consideration by the Working Group:

(i) As noted above, the relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law merits further consideration. Such further consideration could occur in the context of the Study to be performed by the International Bureau, in cooperation with the Delegation of Canada and other Authorities, as envisaged by the Chair's Summary of the third session of the Working Group (see paragraph 1, above).

(ii) Certain of the Scenarios envisaged in this document may benefit from exceptions under national laws. Offices concerned therefore should review the legal position in their jurisdiction, taking into account also considerations of private international law to the extent the materials in question would be made available in other jurisdictions, possibly through the Internet.

(iv) A more global, systematic and comprehensive solution may require the conclusion of licensing agreements with the rightsholders of the principal sources of non-patent literature by Offices, International Search Authorities and International Preliminary Examining Authorities, as well as the International Bureau. The principle and the modalities of such license agreements might also usefully be further considered in the Study referred to in (i) above.

*35. The Members of the Working Group are invited to consider the contents of this document and to decide whether the International Bureau, in cooperation with the Delegation of Canada and other Authorities, should:*

*(i) further consider the relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law; and*

*(ii) further consider the principle and possible modalities of the licensing agreements referred to in paragraph 34(iv), above.*

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# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

GENEVA

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

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

**Fourth Session**

**Geneva, May 19 to 23, 2003**

**CENTRAL ELECTRONIC DEPOSIT SYSTEM FOR  
NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS**

*Document prepared by the International Bureau*

## BACKGROUND

1. At its third session, the Working Group agreed that, in order to facilitate the processing of sequence listings for the purposes of the international and the national phase of the PCT procedure, the International Bureau should further investigate the possibility of establishing a central electronic deposit system for such listings (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraph 58).

2. The Annex to this document contains proposals for amendment of the Regulations under the PCT so as to establish a central electronic deposit system for sequence listings for the purposes of disclosure of the invention and to facilitate access to deposited sequence listings by Offices and Authorities and also third parties. The main features of the proposed new system are outlined in the following paragraphs.

## DEPOSIT OF SEQUENCE LISTINGS

3. The idea of establishing a central electronic deposit system for sequence listings is not new. Previous discussions on this issue in the 1990s focused on the need to establish a data bank containing sequence listings of all published applications in a standardized form suitable for patent search purposes (the issue was discussed, for example, at the fifth session of the

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Meeting of International Authorities under the PCT; see document PCT/MIA/V/3, paragraphs 27 to 32). At that time it was envisaged that, where the International Searching Authority had received a sequence listing in computer readable form from the applicant, it would make that sequence listing available, promptly after international publication, to one of the existing sequence listing database institutions. Those institutions would then have served as data repositories for future access to the sequence listing, including by the International Preliminary Examining Authorities, designated/elected Offices and third parties. No such Authority or Office would have been entitled to ask the applicant to furnish it with a copy of the sequence listing in computer readable form where it was available from such an institution. However, the idea was not proceeded with when it was ascertained that the procedures followed by the institutions concerned did not meet certain general needs of the patent procedure (for example, in respect of guaranteeing the documentary integrity of sequence listings as originally filed).

4. In practice, the Trilateral Patent Offices, for example, systematically place sequence listings with public sequence listing database institutions: the European Patent Office with the European Bioinformatics Institute (EBI); the Japan Patent Office with the DNA Databank of Japan (DDBJ); and United States Patent and Trademark Office with the National Center for Biotechnology Information (NCBI). This applies in the case of sequences disclosed in patents and published patent applications, both in national/regional applications and in international applications for which the Office concerned acts as International Searching Authority.

5. A distinction needs to be drawn between three related purposes for which sequence listings in electronic form might usefully be stored in data banks:

(i) *international search (and international preliminary examination)*: a sequence listing in electronic form is needed to enable the International Searching Authority to carry out the international search, and provision of a listing in such form is the subject of present Rule 13ter; for this purpose, it is presently envisaged, although not expressly mentioned in Rule 13ter, that a sequence listing in electronic form which is furnished by the applicant to the International Searching Authority will be placed by that Authority in a sequence listing database in such a way that it can be searched using highly sophisticated algorithms designed to aid the examiner in deciding whether the invention is novel and involves an inventive step; similar considerations apply in the case of international preliminary examination;

(ii) *disclosure*: another purpose, not presently catered for, would be to enable the applicant to disclose the invention by way of reference to a deposit, so that there would be no need to file, as part of the international application, a sequence listing requiring up to many thousands of sheets of paper or even on a CD as is presently provided for under Part 8 (Sections 800 to 806) of the Administrative Instructions under the PCT;

(iii) *access*: patent Offices, PCT Authorities and third parties may need or wish to have access to deposited sequence listings for a number of purposes, including scientific research, technical information, international search and ascertaining the exact nature of the disclosure contained in a patent application as originally filed.

6. The presently available database institutions do not cater fully for all of those purposes. Their operations are geared towards practical needs for technical information for research purposes. While they are certainly useful or even essential for the carrying out of searches of the prior art in relation to patent applications, they are not designed or maintained in a way

which meets certain more specialized needs of the patenting procedure, notably in relation to establishing the precise nature of the disclosure made on a certain date (normally, in the case of a patent application, the filing date) in a way which would meet evidentiary requirements in the event that the nature or date of the disclosure is contested in court proceedings. The proposals made in the present document are for a deposit system intended to meet those more specialized needs.

7. It is thus proposed to set up a system, similar in certain ways to the system for the deposit of biological material with a depositary institution under the Budapest Treaty, under which a reference to a sequence listing in electronic form deposited with a prescribed sequence listing data bank would replace the need to include such listing in the description itself. Provided that the International Searching Authority has access to such a deposited sequence listing, there would then also be no need for the applicant to furnish a separate listing in electronic form to the International Searching Authority for the purposes of the international search (and similar considerations would apply to the procedure before the International Preliminary Examining Authority and designated/elected Offices).

8. Since the deposited sequence listing would replace a listing which would otherwise have to be handled by the International Bureau, whether in form of a sequence listing part of the description (on paper) or as a listing in electronic form separately furnished under Part 8 of the Administrative Instructions, and since its storage in the data bank would be for the purposes of disclosure and simple access rather than research or patent searching, it would appear to be logical for the functions of the data bank to be carried out by the International Bureau, while still allowing for the possibility that other data banks may also be prescribed. However, a study of the feasibility of such a possibility would need to be undertaken.

9. The main features of the proposed system would be as follows:

(i) the applicant would have the option, if so wished, to deposit, for the purposes of the PCT procedure in relation to an international application, a sequence listing in electronic form with a prescribed sequence listing data bank (which may include the International Bureau, as mentioned in paragraph 8, above);

(ii) in order to attract the operation of the provisions outlined further below, the sequence listing would have to be deposited on or before the international filing date and to comply with the standard prescribed in the Administrative Instructions (see present Annexes C and C-*bis*, which would have to be modified accordingly);

(iii) a reference in the description to a deposited sequence listing would replace the need to include such listing in the description itself (“sequence listing part of the description” – see present Rule 5.2(a));

(iv) a reference to a deposited sequence listing would replace the need to furnish, for the purposes of international search, the listing in electronic form to the International Searching Authority (and the International Preliminary Examining Authority and designated/elected Offices) as under present Rule 13*ter*;

(v) the deposited sequence listing would be published in electronic form only, similar as is presently provided for under Part 8 (Section 805) of the Administrative Instructions under the PCT;

(vi) access to the deposited sequence listing would be restricted, until the international publication of the international application concerned, in a similar way as access to the application itself;

(vii) Authorities and Offices would be entitled to access the deposited sequence listing, including for the purposes of search and examination, as they would be entitled to access the international application itself;

(viii) third parties would be entitled to access the deposited sequence listing on the same basis as they would be entitled to access the international application itself (that is, in general, only after the international publication of the international application concerned).

10. Details concerning the making of deposits (including details concerning submission of corrections under Rule 26.3, rectifications of obvious errors under Rule 91 and amendments under Article 34 in respect of a deposited sequence listing), the prescribing of data banks and the obligations of and procedures to be followed by prescribed data banks would be set out in the Administrative Instructions.

11. Adoption of proposals for amendment of the Regulations to implement such a system would necessitate consequential modifications of the Administrative Instructions to set out procedural details, and consequential modifications would be needed to Part 7 and Annex C of the Instructions. The procedures set out in Part 8 and Annex C-bis of the Instructions would probably be completely superseded by, or incorporated into, the new system and would thus be deleted.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

DEPOSIT OF SEQUENCE LISTINGS

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## Rule 5

### The Description

5.1 [No change]

#### 5.2 *Nucleotide and/or Amino Acid Sequence Disclosure*

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain, at the option of the applicant, either:

(i) 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 (“sequence listing part of the description”); or

[COMMENT: Clarification only; for the standard provided for in the Administrative Instructions, see Section 208 and Annex C to the Administrative Instructions.]

(ii) a reference complying with Rule 13ter.2(a) to a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions that was deposited with a prescribed sequence listing data bank in accordance with Rule 13ter.1 (“deposited sequence listing”) on or before the international filing date.

[COMMENT: See paragraphs 5(ii), 7 and 9 of the Introduction to this document. The Working Group may wish to consider whether an indication that a sequence listing has been deposited in accordance with Rule 5.2(a)(ii) should also be provided for in the request form (Rule 4 would have to be amended accordingly).]

*[Rule 5.2, continued]*

(b) Where the sequence listing part of the description [or the deposited sequence listing](#) 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.

[COMMENT: Consequential on proposed amendment to Rule 5.2(a), above.]

**Rule 13ter**

**Nucleotide and/or Amino Acid Sequence Listings**

13ter.1 Sequence Listing Deposits

A deposit of a sequence listing in electronic form for the purposes of Rule 5.2(a)(ii) shall be made in accordance with the Administrative Instructions.

[COMMENT: See paragraphs 10 and 11 of the Introduction to this document.]

13ter.2 References to Sequence Listings: Contents; Failure to Include Reference or Indication

(a) Any reference to a deposited sequence listing for the purposes of Rule 5.2(a)(ii) shall indicate:

(i) the name and address of the sequence listing data bank with which the deposit was made;

(ii) the date of the deposit; and

(iii) the number given to the deposit by that sequence listing data bank.

*[Rule 13ter.2, continued]*

(b) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences and the description as filed:

(i) does not contain a sequence listing part of the description or a reference to a deposited sequence listing; or

(ii) contains a reference to a deposited sequence listing but any of the indications referred to in paragraph (a) is not included in that reference;

the International Searching Authority shall invite the applicant to file a correction by furnishing a reference to a deposited sequence listing complying with Rule 5.2(a)(ii) or the missing indication within a time limit fixed in the invitation. 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. Any reference or indication furnished within the time limit fixed in the invitation shall be considered by any designated Office to have been furnished in time.

[COMMENT: Similar to the situation under Rule 13bis.4 with regard to the furnishing of a reference to deposited biological material, where the international application as filed does not contain a sequence listing part of the description and also does not contain a reference to a deposited sequence listing, or where any of the indications required under Rule 13ter.2(a) is missing from a reference contained in the international application as filed, the applicant would be given the opportunity, upon invitation by the International Searching Authority, to make the required correction by furnishing such a reference or the missing indication within the time limit fixed in the invitation. If furnished within that time limit, any designated Office would have to consider any such reference or indication to have been furnished in time. Note that, in practice, the invitation under Rule 13ter.2(b) would be combined with the invitation under Rule 13ter.3(a) (see below): the applicant would have the option either to comply with the invitation under Rule 13ter.2(b), in which case the deposited sequence listing referred to

[Rule 13ter.2(b), continued]

in the description would be used for the purposes of disclosure, international search and international preliminary examination, and access (see paragraph 5 in the Introduction to this document, above); or, alternatively, to comply with the invitation under Rule 13ter.3(a), in which case the sequence listing in electronic form furnished to the International Searching Authority would be used for the purposes of international search only. Note that any sequence listing deposited after the international filing date would not comply with the requirements of Rule 5.2(a)(ii) and thus not be accepted as a correction under Rule 13ter.2(b); any sequence listing deposited after the international filing date would also not be taken into account for the purposes of international search (see Rule 13ter.3(a), below).]

(c) ~~13ter.1(d)~~ Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to file the required correction within a time limit fixed in the invitation. 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: Clarification only.]

13ter.3 ~~13ter.1~~ *Sequence Listings Required for the Purposes of International Search or International Preliminary Examination* ~~for International Authorities~~

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences and the description does not contain a reference to a deposited sequence listing, or the description contains a reference to a deposited sequence listing but the deposited sequence listing does not comply with Rule 5.2(a)(ii), the International Searching Authority may require that the applicant furnish to that Authority, for the purposes of the

*[Rule 13ter.3(a), continued]*

international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions. Where such a listing is so required but has not been furnished by the applicant, the International Searching Authority may invite the applicant to furnish such a listing within a time limit fixed in the invitation.

[COMMENT: A sequence listing in electronic form is needed to enable the International Searching Authority to carry out the international search. Provided that the International Searching Authority has access to a deposited sequence listing complying with the standard provided for in the Administrative Instructions, there is no need for the applicant to furnish a separate listing in electronic form to the International Searching Authority for the purposes of international search. In all other cases, that is, in cases where the International Searching Authority does not have access to a deposited sequence listing complying with the standard provided for in the Administrative Instructions, the International Searching Authority would be entitled to invite the applicant to furnish such separate listing in electronic form. Any such listing in electronic form furnished by the applicant would not form part of the international application (see Rule 13ter.3(d), below). In practice, the invitation under Rule 13ter.3(a) would be combined with the invitation under Rule 13ter.2(b) (see Comment on Rule 13ter.2(b), above). Note that proposed new Rule 13ter.3(a) would no longer provide for an invitation to furnish a sequence listing in paper format (as present Rule 13ter.1(a) does), taking into account that such listing in paper format would not allow a meaningful search to be carried out by the International Searching Authority. Note further that that proposed new Rule 13ter.3(a) would not provide for an applicant to furnish, in response to an invitation under that Rule, a reference to a sequence listing deposited with a sequence listing data bank.]

~~[13ter.1](a) 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;~~

[Rule 13ter.3(a), continued]

~~(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.~~

(b) ~~[13ter.1](e)~~ If the applicant does not comply with an invitation under paragraph (a) within the time limit fixed in the invitation, the International Searching Authority shall not be required to search the international application to the extent that such non-compliance has the result that a meaningful search cannot be carried out.

(c) ~~[13ter.1](e)~~ Paragraphs (a) and (b) ~~(e)~~ shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

(d) ~~[13ter.1](f)~~ Any sequence listing in electronic form furnished pursuant to paragraphs (a) to (c) ~~not contained in the international application as filed~~ shall not, ~~subject to Article 34,~~ form part of the international application.

[COMMENT: The proposed amendment of present Rule 13ter.1(f) (new paragraph (d)) is consequential on the proposed deletion of present Rule 13ter.1(a) (see above) and the fact that Rule 13ter.3(a) as proposed to be amended would no longer provide for an invitation to furnish a sequence listing in paper format (see Comment on Rule 13ter.3(a), above).]

13ter.4 ~~13ter.2~~ Sequence Listings for Designated Offices

Once the processing of the international application has started before a designated Office, Rules 13ter.2(b) and 13ter.3(a) ~~13ter.1(a)~~ shall apply *mutatis mutandis* to the procedure before that Office. No designated Office shall require the applicant to furnish to it:

(i) a sequence listing where a reference to a deposited sequence listing complying with Rule 5.2(a)(ii) is included in the description;

(ii) a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

[COMMENT: Proposed amendment of present Rule 13ter.2 (new Rule 13ter.4) is consequential on the proposed creation of a central electronic deposit system for sequence listings under which a sequence listing data bank would serve as a data repository for future access to the sequence listing, including by the designated/elected Offices.]

13ter.5 Prescribed Sequence Listing Data Banks

The Administrative Instructions shall set out the sequence listing data banks that are prescribed for the purposes of Rules 5.2(a)(ii) and 13ter.1 and the provisions and requirements in relation to deposited sequence listings, including but not limited to, provisions and requirements in relation to [the status of sequence listing data banks, making of deposits, issuance of receipts for deposits, recognition and effect of a deposit, storage of deposited sequence listings, furnishing of copies of deposited sequence listings, and fees].



*[Rule 13ter.5, continued]*

[COMMENT: The Administrative Instructions may, subject to further study of the feasibility (see paragraph 8 of the Introduction to this document) prescribe the International Bureau as a data bank. In that case, a deposit with the International Bureau as data bank should be possible by way of filing the sequence listing in electronic form together with the international application with the receiving Office, in which case it would be considered to have been deposited with the International Bureau on the date of receipt by the receiving Office.]

[End of Annex and of document]

# WIPO



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# E

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
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INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

Fourth Session  
Geneva, May 19 to 23, 2003

DIVISIONAL APPLICATIONS 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 allow for divisional applications to be filed under the PCT.

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 50 and 51, as follows:

### *“Divisional Applications*

“50. Several delegations supported the proposal that further considerations should be given to providing under the PCT for the filing of international applications as divisional applications of earlier international applications, with a view to taking the greatest possible advantage of the centralized processing offered by the international phase, particularly in cases where there had been a finding of lack of unity of invention. However, while there was no objection in principle to such a possibility, it was recalled that problems had been identified when such a proposal had been made in the past, in

particular with regard to the added complexity involved, to the difficulty in according an international filing date in accordance with both Article 11 and the Paris Convention, and to the need for compliance with time limits for international search and international preliminary examination.

“51. It was agreed that the International Bureau, in cooperation with the Delegation of the Netherlands, should further consider the matter and that any proposal which emerged would be considered by the Working Group at a future session.”

3. The International Bureau and the Delegation of the Netherlands have consulted on the matters since the third session of the Working Group. The present document was prepared by the International Bureau in the light of those consultations, but it does not reflect an agreed position.

#### *Divisional applications under the Paris Convention*

4. Article 4G of the Paris Convention for the Protection of Industrial Property (“Paris Convention”) requires countries of the International Union for the Protection of Industrial Property (“Paris Union”) to provide for the filing of divisional applications, as follows:

“[4G](1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

“(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such divisions shall be authorized.”

#### *Divisional applications under the 1968 and 1970 drafts of the PCT*

5. While, at present, the PCT does not provide for the filing, during the international phase, of divisional applications, it is to be noted that the 1968 draft of the PCT contained provisions in both the draft Treaty and the draft Regulations under the Treaty which would have allowed the applicant, in the case of lack of unity of invention, at his option, to either (i) restrict the claims, or (ii) to pay additional fees, or divide the application, or both (see document PCT/III/5 (Draft Treaty), Articles 17 (Procedure Before the Searching Authority) and 34 (Procedure Before the Preliminary Examining Authority), and document PCT/III/6 (Draft Regulations under the PCT), Rules 37 (Lack of Unity of Invention (Search)) and 62 (Lack of Unity of Invention (Preliminary Examination)). Excerpts of the 1968 draft of Articles 11 (Filing Date and Effects of the International Application), 17 and 34, as well as the 1968 draft of Rules 37 and 62, are reproduced for ease of reference in Annex IV to this document.

6. However, in the 1969 draft of the PCT those provisions were deleted, and the final text of the PCT assigned at the Washington Diplomatic Conference in June 1970 does not contain any provisions concerning the division of international application during the international phase. The records of the Washington Diplomatic Conference on the PCT (1970) do not state any reasons for the deletion in the 1969 draft of the provisions concerning divisional

applications as contained in the 1968 draft. Document PCT/DC/3 (Main Differences between the 1968 and 1969 Drafts), paragraph 31, simply states the following:

“31. *Division of the international application*. As opposed to the 1968 Draft (Articles 17(3)(a)(ii) and 34(3), Rules 37.5, 37.7 and 62), the International Searching Authority and the International Preliminary Examining Authority cannot request, nor can the applicant volunteer, under the 1969 Draft, division of the international application in the international phase. Of course, the designated or elected Offices may require division if the international application does not comply, in their opinion, with the requirement of unity of invention as defined in Rule 13. Furthermore, the applicant may voluntarily divide his application before any national Office to the extent permitted by the national law of that Office.”

7. Thus, as indicated above, there is at present no provision in the PCT which would allow for the filing, during the international phase, of divisional applications based on an “initial international application.” If the international application does not, in the view of a designated/elected Office, comply with the requirement of unity of invention as defined in Rule 13 in that it contains more than one invention (compare Article 4G(1) of the Paris Convention), the applicant may, before each designated/elected Office, be required, under the national law applicable by that Office, to restrict the claims to a single invention or to file a separated divisional application in respect of each additional invention contained in the international application.

8. Obviously, the introduction of a procedure allowing the applicant to file an international application as a divisional application of an initial international application (“divisional international application”) would greatly simplify, from the applicant’s perspective, the processing of the international application where the International Searching Authority or the International Preliminary Examining Authority makes a finding of lack of unity of invention, replacing the need to individually file, after national phase entry, divisional (national) applications with each designated or elected Office concerned. Similar considerations apply where applicants wish to file one or more divisional international applications on their own initiative (as provided for under Article 4G(2) of the Paris Convention).

9. On the other hand, it needs to be remembered that the present system already provides for a procedure which enables the applicant, in the case of a finding of lack of unity of invention by the International Searching and Preliminary Examining Authority, to obtain an international search report and an international preliminary examination report in respect of all parts of the international application, no matter how many inventions are contained in it, against the payment of additional (search and preliminary examination) fees. The introduction of a further procedure which would allow the applicant to divide the initial international application, during the international phase, by filing divisional international applications, would not necessarily be desirable if the result was to add further complexity to the overall system, as might be the case if complicated amendments to the Regulations were needed.

#### DIVISION OF INTERNATIONAL APPLICATIONS DURING THE INTERNATIONAL PHASE

10. The Annex to this document set out three separate possibilities in the form of preliminary proposals, each of which is designed to permit the division of international applications by taking steps during the international phase of the PCT procedure. It is hoped

that consideration of those proposals will facilitate discussion of possible future work on the matter. The possibilities are the following:

(i) *possible revision of the PCT (Treaty)* in order to provide expressly for the filing of divisional international applications;

(ii) *amendments of the Regulations* in order to provide expressly for the filing of divisional international applications;

(iii) *amendments of the Regulations* to provide a new procedure allowing for the *internal division* of international applications during the international phase, to be followed by a simplified way of proceeding with the divided parts of the international application as separated divisional applications in the national phase.

#### POSSIBLE REVISION OF THE PCT (TREATY)

11. Annex I contains a proposal for a new Article 17 *bis* of the Treaty which would expressly provide for the filing of divisional international applications. Consequential amendments of other Articles would also be required, such as Articles 2 (Definitions), 8 (Claiming Priority) and 11 (Filing Date and Effect of International Application), as well as other Articles concerning the international search procedure, international publication and communication to designated Offices, the international preliminary examination procedure, and national phase entry.

#### DIVISIONAL INTERNATIONAL APPLICATIONS

12. Annex II contains proposals for amendment of the Regulations which would allow the applicant to divide an initial international application into separated divisional international applications during the international phase. Those proposals are based on the premise that the Treaty as currently worded would permit the Regulations to be amended by the Assembly to provide for the division of international applications in order to comply with Article 4 G of the Paris Convention, noting that, under PCT Article 62(1), any PCT Contracting State must be a member of the Paris Union and thus must apply all of the mandatory provisions of the Paris Convention, including the obligation under Article 4 G of that Convention. On that view, amendment of the PCT Regulations to provide for the division of international applications, including the preservation of the (filing) date of the initial international application as the (filing) date of a divisional international application, would appear to be possible under Article 58(1)(iii) in that it would provide Rules concerning "details useful in the implementation of the Treaty" including Article 62(1). If, contrary to that premise, the Working Group considers that the Treaty as currently worded would not permit such amendment of the Regulations, it would not appear possible to provide for the filing of divisional international applications until the Treaty itself is revised in this respect.

#### *Filing of Divisional International Applications*

13. *Possibility of filing divisional international applications:* Proposed Rule 30 *bis.1* would give effect to the general provisions of Article 4 G(2) of the Paris Convention relating to the filing of divisional international applications. It is proposed that divisional international applications be able to be filed either where there has been a finding of lack of unity of invention by the International Searching Authority or where the applicant acts on his own initiative.

14. While certain special requirements would apply for divisional international applications with regard to filing, international search and international preliminary examination (see below), every divisional international application would be treated as a "regular" international application (separate and distinct from the initial international application from which it was divided) in respect of which fees would have to be paid, an international search report would be established, international publication would take place and, if so requested by the applicant by making a demand, international preliminary examination would be carried out.

15. *International filing date and right of priority:* In accordance with Article 4G(2) of the Paris Convention, every divisional international application would preserve as its international filing date the international filing date of the initial international application and its right of priority, if any, provided that the conditions set out in subparagraphs (a) and (b) are met.

(a) *Subject matter and disclosure:* It is implicit in Article 4G of the Paris Convention, in order for a divisional international application to preserve as its international filing date the international filing date of the initial international application, that the subject matter contained in the divisional international application must have been wholly contained within the initial international application as filed. In other words, using the terminology of PCT Rule 66.2(a)(iv), the disclosure in the divisional international application may not go beyond the disclosure in the initial international application on its international filing date. Note that the approach suggested here is different from the approach chosen in the 1968 draft Regulations under the PCT (see draft Rule 37.5(a) in Annex IV to this document).

(b) *Time limit:* Since divisional international applications will mainly (although not necessarily) be filed in response to a finding by the International Searching Authority of lack of unity of invention and the invitation to pay additional (search) fees, it appears necessary to allow the applicants sufficient time to consider (i) the results of the international search, particularly if one or more additional fees referred to in Article 17(3)(a) had been paid, and (ii) the result of any protest procedure under Rule 40.2(c), before deciding whether to file divisional international applications. Since these considerations are also relevant to making a demand, it is proposed that the time limit for filing a divisional international application should be the same as the time limit for making a demand under Rule 54bis.1 in respect of the initial application, that is, three months from the date of receipt of the international search report on, or 22 months from the priority date of, the initial international application, whichever expires earlier.

16. In addition to the matters just outlined, which are dealt with in proposed Rule 30bis, a number of other matters would need to be dealt with in amendments of the Regulations if it is decided to proceed further in this direction. Some of those other matters are outlined in the following paragraphs.

#### *Status of Initial International Application*

17. It may be desirable to clarify expressly that the initial international application must be pending when a divisional international application is divided from it is filed.

*Priority claims*

18. Any time limit which is computed from the priority date (see Article 2(xi)) would be computed from the priority date of the divisional international application. A divisional international application would retain the right of priority of the initial international application, without the need to formally claim it in the divisional international application. The making of priority claims may, however, need to be regulated in the specific context of the PCT procedure, for example:

(i) by expressly providing that priority claims in the initial international application would be considered to be made in the divisional international application;

(ii) to deal with cases where priority claims are added or corrected under Rule 26bis.1 or withdrawn under Rule 90bis.3.

*Competent receiving Office*

19. Some specific provision may be needed as to the Offices which would be competent to receive divisional international applications. For example, should the matter be left to existing Rule 19, as for any international application, to govern the matter according to the nationality and residence of the applicant(s), or would it be preferable to somehow provide for filing of divisional international applications with the International Searching Authority or International Preliminary Examining Authority which had made a finding of lack of unity of invention?

*Designations*

20. The filing of a request in respect of a divisional international application should presumably constitute the designation of all Contracting States that are designated in the initial international application on the date of receipt of the divisional international application by the receiving Office. It should not be possible, by filing a divisional international application, to add the designation of a Contracting State which was not designated in the initial international application at the time of filing the divisional international application.

*Request Form*

21. The request form would need to indicate the divisional international application as such and identify the initial international application from which the divisional international application derives (see Rules 4.1 and 4.11).

*Language*

22. It may be desirable to require that a divisional international application be filed in a language in which international search can be carried out and in which international publication can take place.

*International Search*

23. A number of specific provisions may need to be made in connection with the international search procedure for divisional international applications, including the matters outlined in subparagraphs (a) to (c).

(a) *Competent International Searching Authority:* In order to minimize duplication of work, it may be desirable to provide that the International Searching Authority which is to carry out, or has carried out, the international search on the initial international application should also be the sole competent International Searching Authority for any divisional international application.

(b) *Refund of search fees:* Rule 16.3 provides for the (partial) refund of international search fee where an international application claims the priority of an earlier international application which has been the subject of an international search. For consistency with this provision, the international search fee paid in connection with a divisional international application should be partially refunded where the international search report on that divisional international application can be wholly or partly based on the results of the international search carried out on the initial international application, due account being taken of any payment by the applicant of additional fees referred to in Article 17(3)(a)).

(c) *Remarks on possible double patenting:* In order to assist designated and elected Offices as well as applicants, the written opinion by the International Searching Authority (and hence the international preliminary report on patentability under Chapter I) could include appropriate observations where the claims of a divisional international application overlap with the claims in the initial international application or another divisional international application deriving therefrom.

#### *International Publication*

24. The general rule under PCT Article 21 is that an international application is published promptly after the expiration of 18 months from the priority date. That would not be possible for a divisional international application in cases where it is filed after that period (see paragraph 15(b), above). It would appear to be consistent with Article 21(2)(a) to provide for a divisional international application to be published promptly after it had been filed, but not before the expiration of 18 months from the priority date (a similar approach is taken under some national and regional laws, such as the European Patent Convention).

#### *International Preliminary Examination*

25. A number of specific provisions may need to be made in connection with the international preliminary examination procedure for divisional international applications, dealing, for example, with the matters set out in subparagraphs (a) to (c).

(a) *Time limit for making a demand:* A demand in respect of a divisional international application would, in general, have to be submitted within the applicable time limit under Rule 54bis.1 in respect of the initial international application if the deadline for the international preliminary examination report of 28 months from the priority date is to be met. That is, in practice, the demand would generally need to be filed at the same time as the divisional international application. Special consideration might be given to cases where the initial international application is subsequently withdrawn.

(b) *Competent International Preliminary Examining Authority:* In order to minimize duplication of work, it may be desirable to provide that the International Preliminary Examining Authority which is to carry out, or has carried out, the international search on the initial international application should also be the sole competent International Preliminary Examining Authority for any divisional international application.



(c) *Remarkson double patenting*: In order to assist designated and elected Offices as well as applicants, the international preliminary report on patentability under Chapter II could include appropriate observations where the claims of a divisional international application overlap with the claims in the initial international application or another divisional international application deriving therefrom.

#### “INTERNAL” DIVISION OF INTERNATIONAL APPLICATIONS DURING THE INTERNATIONAL PHASE

26. Annex III contains a proposal which would give effect to a procedure that could be introduced by way of an amendment of the Regulations, pending a future revision of the Treaty as proposed in Annex I, allowing for the “internal” division of international applications during the international phase under Chapter II, to be followed by a simplified way of proceeding with the divided parts of the international application as separated divisional applications in the national phase.

27. The proposal is based on the fact that the present system enables the applicant, in the case of a finding of lack of unity of invention by the International Searching Authority or International Preliminary Examining Authority, to obtain an international search report or international preliminary examination report in respect of all parts of the international application, no matter how many inventions are contained in it, provided that additional (search and preliminary examination) fees are paid.

28. Under the proposal, instead of filing one or more divisional international applications during the international phase, the applicant would be permitted, after having made a demand for international preliminary examination, to amend the claims, the description and the drawings of an international application under Article 34(2)(b) by dividing the corpus of the international application internally into two or more separate parts, each containing the description, claims and drawings of the international application corresponding to a divisional application which would proceed as such into the national phase.

29. Following such an internal division of the international application, the international preliminary report on patentability under Chapter II would also be “internally” divided into corresponding different parts, provided that all additional search and preliminary examination fees have been paid.

30. Following such an internal division during the international preliminary examination procedure, the applicant would have “ready-made” divisional applications with which to proceed into the national phase. While that result could be achieved by proceeding into the national phase with the internally divided initial international application, to be followed by its division separately during the procedure before each national Office, it would be simpler to enable the initial international application to proceed into the national phase, from the outset, as separated divisional applications. Each such divisional application would be associated with the “divided” international preliminary report on patentability under Chapter II.

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

[Annex I follows]

ANNEXI

POSSIBLE REVISION OF THE PCT (TREATY):  
DIVISIONAL INTERNATIONAL APPLICATIONS

Article 17 bis

Divisional International Applications

An international application (“initial international application”) may, as provided in the Regulations, be divided into one or more divisional applications (“divisional international applications”) in accordance with Article 4 G of the Paris Convention for the Protection of Industrial Property. A divisional international application shall, notwithstanding Article 11, preserve as its international filing date the international filing date of the initial international application and the benefit of the right to priority, if any.

[COMMENT: See paragraph 11 of the Introduction to this document. Modeled after Article 4 G of the Paris Convention. Consequential amendments of other Articles may be required, such as Articles 2 (Definitions), 8 (Claiming Priority) and 11 (Filing Date and Effect of International Application), and Articles concerning the international search procedure, international publication and communication to designated Offices, the international preliminary examination procedure and national phase entry.]

[Annex II follows]

ANNEXII

POSSIBLE AMENDMENTS OF THE REGULATIONS:  
DIVISIONAL INTERNATIONAL APPLICATIONS

Rule 30 bis

Divisional International Applications

30bis.1 Filing of Divisional International Applications

(a) The applicant may, subject to these Regulations, divide the international application (“initial international application”) by filing with the competent receiving Office one or more divisional applications as international applications (“divisional international applications”).

(b) A divisional international application may be filed where the International Searching Authority has made a finding of lack of unity of invention in relation to the initial international application or on the initiative of the applicant.

[COMMENT: See Article 4 G of the Paris Convention.]

30bis.2 International Filing Date; Right of Priority

A divisional international application shall preserve as its international filing date the international filing date of the initial international application and the benefit of the right of priority, if any, as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property, provided that:

*[Rule 30bis.2, continued]*

[COMMENT: See paragraph 15 of the Introduction to this document and Article 4 G of the Paris Convention.]

(i) the divisional international application is received by the receiving Office before the expiration of the applicable time limit under Rule 54bis.1 for making a demand in respect of the initial international application;

[COMMENT: See paragraphs 15(b) and 19 of the Introduction to this document.]

(ii) the initial international application is pending on the date of receipt of the divisional international application by the receiving Office;

[COMMENT: See paragraph 17 of the Introduction to this document.]

(iii) the disclosure in the divisional international application does not go beyond the disclosure in the initial international application as filed.

[COMMENT: See paragraph 15(a) of the Introduction to this document.]

[Annex III follows]

ANNEX III

POSSIBLE AMENDMENTS OF THE REGULATIONS:

“INTERNAL” DIVISION OF INTERNATIONAL APPLICATIONS  
DURING THE INTERNATIONAL PHASE

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**Rule 66**<sup>1</sup>

**Procedure Before the**

**International Preliminary Examining Authority**

66.1 [No change]

66.2 *First Written Opinion of the International Preliminary Examining Authority*

(a) If the International Preliminary Examining Authority

(i) to (v) [No change]

(vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination in respect of that claim, ~~or~~

(vii) considers that a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, or

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<sup>1</sup> The “present” text shown is that of Rule 66 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

*[Rule 66.2(a), continued]*

(viii) considers that, where an amendment which internally divides the international application into two or more separate parts has been submitted in accordance with Rule 68.6, one or more of the claims contained in one of those parts defines matter for which protection is sought in another of those parts,

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

[COMMENT: See paragraph 25(c) of the Introduction to this document.]

(b) to (e) [No change]

66.3 to 66.9 [No change]

**Rule 68**

**Lack of Unity of Invention (International Preliminary Examination)**

68.1 to 68.5 [No change]

68.6 *Internal Division of International Application*

[Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied and chooses to invite the applicant under Rule 68.2, or on the applicant's own initiative, the applicant may internally divide the international application by submitting, in accordance with Rule 66.1(b), an amendment under Article 34 which divides the description, claims and drawings of the international application into two or more separate parts as follows:]

(i) a main part containing the description, drawings and claims relating to the main invention;

(ii) one or more additional parts, each containing the description, claims and drawings relating to an invention additional to the main invention.

[COMMENT: See paragraphs 26 to 30 of the Introduction to this document.]



**Rule 70<sup>2</sup>**

**The International Preliminary Examination Report**

70.1 to 70.11 [No change]

70.12 *Mention of Certain Defects and Other Matters*

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) [No change]

(ii) the international application calls for any of the observations referred to in Rule 66.2(a)(v) or (viii), it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;

[COMMENT: See paragraph 25(c) of the Introduction to this document and Rule 66.2 as proposed to be amended, above.]

(iii) and (iv) [No change]

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<sup>2</sup> The “present” text shown is that of Rule 70 as amended by the Assembly on October 1, 2002 (see document PC T/A/31/10) and due to enter into force on January 1, 2004.

70.13 ~~Remarks Concerning Unity of Invention~~

(a) If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a)), or on the main invention only (Article 34(3)(c)), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chosen to invite the applicant to restrict the claims or to pay additional fees.

(b) Where the applicant has:

(i) submitted an amendment which divides the description, claims and drawings of the international application into a main part and one or more additional parts in accordance with Rule 68.6; and

(ii) paid additional fees for the international preliminary examination;

the report shall also be divided into a main part and as many additional parts as additional fees for the international preliminary examination have been paid; both the main part and each additional part shall comply with the requirements of Rule 70.

[COMMENT: See paragraphs 26 to 30 of the Introduction to this document.]

70.14 to 70.17 [No change]

**Rule 78 bis**

**Internally Divided International Application to Proceed as**

**Separate Divisional Applications Before Elected Offices**

*78bis.1 Separate Divisional Applications*

Where the applicant has, under Rule 68.6, internally divided the international application (“initial international application”) into two or more separate parts, the applicant may choose to proceed with [any of] those separate parts as separate applications so far as the procedure before any elected Office is concerned, specifying that those separate applications are to be considered as divisional applications of the initial international application, and the elected Offices shall proceed accordingly .

[COMMENT: See paragraph 30 of the Introduction to this document.]

[Annex IV follows]

ANNEXIV

EXCERPTS FROM THE  
1968 DRAFT TREATY (PCT) AND THE  
1968 DRAFT REGULATIONS UNDER THE PCT

**Article 11**  
**Filing Date and Effects of the International Application**

(1) The Receiving Offices shall accord as the international filing date the date of receipt of the international application, provided that, at the time of receipt, that Office has found that:

(i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the Receiving Office,

(ii) the application is in the prescribed language,

(iii) the subject of the application is not obviously outside the purview of this Treaty as defined in the Regulations, and

(iv) at the time of receipt, the application contained at least the following elements:

(a) an indication that the application is intended as an international application,

(b) the name of the applicant,

(c) a part which on the face of it appears to be a description,

(d) a part which on the face of it appears to be a claim or claims.

(2) Any international application fulfilling the requirements of paragraph (1) shall have the effect of a regular national application in each designated State as of the international filing date.

(3) Any international application fulfilling the requirements listed in items (i) to (iv) of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

**Article 17**  
**Procedure Before the Searching Authority**

(1) [...]

(2) [...]

(3)(a) If, in the opinion of the Searching Authority, the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant, at this option:

- (i) to restrict the claims, or
- (ii) depending on the invitation of the Searching Authority, to pay additional fees, or to divide the application, or both.

(b) [...]

### **Article 34** **Procedure Before the Preliminary Examining Authority**

(1) [...]

(2) [...]

(3) If, in the opinion of the Preliminary Examining Authority, the international application does not comply with the requirement of unity of invention as set forth in the Regulations, the said Authority may invite the applicant, at the latter's option, either to restrict the claims or to divide the application so as to comply with the requirement.

(4) [...]

### **Rule 37** **Lack of Unity of Invention (Search)**

#### *37.1 Invitation to Restrict, Divide or Pay*

(a) The invitation to restrict the claims or to divide the application provided for in Article 17(3)(a) shall specify at least one possibility of restriction or division which, in the opinion of the Searching Authority, would be in compliance with the applicable requirements.

(b) [...]

#### *37.2 [...]*

#### *37.3 Timelimit*

The timelimit provided for in Article 17(3)(b) shall be fixed, in each case, according to the circumstances of the case, by the Searching Authority; it shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

#### *37.4 [...]*

#### *37.5 Procedure in the Case of Dividing the Application*

(a) If the applicant chooses to divide the application, neither the description nor the drawings may be modified. They will remain the same for the parent application (that is, the international application as restricted) and the divisional applications.

(b) For the parent application, the applicant shall be required to specify the claims maintained or to file restricted claims, and to submit a new abstract when necessary.

(c) For each divisional application, the applicant shall be required to file a request, a claim or claims, and an abstract. The receiving Office shall, itself, attach to those papers a copy of the application in its original form, and the description and drawings (if any) thereof shall also be the description and drawings of each divisional application. The request of each divisional application shall identify the original application by its international application number and, where less than the totality of the description is relevant for the divisional application, a separate statement, submitted at the same time as the request, shall identify those portions of the description which are relevant.

(d) Each divisional application shall be treated as a new, independent international application, except that:

(i) the date of actual receipt of any divisional application by the receiving Office shall be certified by that Office on the record copy and on the search copy of such application;

(ii) the international filing date of the original application shall also be the international filing date of the divisional application, provided that the latter was filed with the receiving Office within the time limit fixed in Rule 37.3, and to the extent that it contains no new matter.

(e) If the parent application or any divisional application does not comply with the requirement of unity of invention, the Searching Authority shall proceed as provided in Article 17(3)(b).

37.6 [...]

### 37.7 *Voluntary Division*

(a) Subject to Rule 62.4, the applicant may divide the application on his own initiative any time before the expiration of the 16<sup>th</sup> month from the priority date. If the division takes place after the search report has been established, the communication of the search report and any publication thereof shall state that fact.

(b) The procedure provided for in Rule 37.5s shall apply also in the case of voluntary division.

## **Rule 62** **Lack of Unity of Invention (Preliminary Examination)**

### 62.1 *No Invitation to Restrict or Divide*

Where the Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to divide the application, it shall establish the preliminary examination report, subject to Article 34(4)(b), in respect of the entire application, but shall indicate, in the said report, that, in its opinion, the requirement of unity of invention is not fulfilled and shall briefly indicate the reasons for this opinion.

### 62.2 *Invitation to Restrict or Divide*

Where the Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at the latter's option, to restrict the claims or to divide the application, it shall specify at least one possibility of restriction or division which, in the opinion of the Preliminary Examining Authority, would be in compliance with the applicable requirement. It shall, at the same time, fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

### 62.3 *Procedure in the Case of Division*

If the applicant chooses to divide the application, the procedure provided for in Rule 37.5 shall apply with the exception of paragraph (e) of that Rule.

#### 62.3 *Voluntary Division*

(a) The applicant may divide the international application on his own initiative any time prior to the beginning of the preliminary examination but in no case after the expiration of the 16th month from the priority date.

(b) The procedure provided for in Rule 37.5, except paragraph (e) of that Rule, shall apply also in the case of voluntary division effected under paragraph (a).

[End of Annex IV and of document]