

C. PCT 1414

May 9, 2014

Madam,  
Sir,

*Proposed modifications of PCT International Search and Preliminary Examination Guidelines*

This Circular is addressed to your Office in its capacity as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT) for the purpose of consultation on proposed modifications to the PCT International Search and Preliminary Examination Guidelines (“the Guidelines”). It is also addressed to certain non-governmental organizations representing users of the PCT system.

The main purpose of the proposed modifications is to implement the amendments to the Regulations under the PCT adopted by the Assembly of the PCT Union at its Forty-fourth (19<sup>th</sup> Ordinary) Session (see document PCT/A/44/5) and which will enter into force on July 1, 2014. It is recalled that the amendments to the Regulations include two aspects, namely: (1) making the written opinion of the International Searching Authority (WO/ISA) publicly available from the date of international publication (see Rule 44~~ter~~ (deleted) and Rule 94.1(b)) and (2) requiring the International Preliminary Examining Authority to conduct a top-up search subject to certain exceptions (see Rules 66.1~~ter~~ and 70.2(f)). Moreover, in the same session, it was agreed that any informal comments on the WO/ISA submitted by the applicant will be made publicly available at the same time as the WO/ISA, but the International Preliminary Report on Patentability (Chapter I) will continue to be made available in accordance with the current practice.

The proposed modifications in Chapters 1 and 2 of the Guidelines (paragraph 1.11(d), the flowchart at the end of Chapter 1; paragraphs 2.15(a), 2.16, 2.17 and 2.18) are concerned with the first aspect of the rule amendments, while those in Chapters 3, 17 and 19 (new paragraph 3.15.01, paragraph 3.21, new paragraph 17.24.01, paragraphs 19.11 and 19.12, new paragraphs 19.12.01 to 19.12.05, paragraphs 19.15 and 19.16) are concerned with the second aspect.

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Certain editorial changes are also suggested (paragraph 1.01). It should be noted that, with respect to implementation of the top-up search, due account has been taken of the relevant discussions in the Sixth Session of the PCT Working Group and the Twenty-first Session of the Meeting of International Authorities under the PCT.

./ The detailed proposed modifications to the Guidelines are set out in the Annex to this Circular, in which additions and deletions are shown, respectively, by underlining and striking-through of the text concerned. Certain paragraphs that are not proposed to be amended have been included for ease of reference.

*Comments on the proposed modifications to the Guidelines*

Your Office is invited to provide comments, if any, to the International Bureau by June 2, 2014, preferably by fax to (+41 22) 910 00 30 or by email to: [pct.legal@wipo.int](mailto:pct.legal@wipo.int).

Yours sincerely,



James Pooley  
Deputy Director General

Enclosure: Annex – Proposed modifications of the PCT International Search and Preliminary Examination Guidelines

## **Proposed modifications to the PCT International Search and Preliminary Examination Guidelines**

### **Chapter 1 Introduction**

#### **Purpose and Status of These Guidelines**

1.01 These Guidelines give instructions as to the practice to be followed by Authorities during the international search and examination procedures. ~~The Guidelines have been revised to incorporate the changes resulting from the amendments to the Regulations under the Patent Cooperation Treaty (PCT) adopted by the Assembly in September 2002, the main change relating to the procedure before the International Searching and Preliminary Examining Authorities being that the establishment of an examiner's written opinion is incorporated into the international search procedure.~~

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#### **Overview of International Application Process**

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##### *The International Phase*

[.....]

1.11 The international phase in turn includes a number of groups of actions which are distinct in nature, though they may in practice overlap slightly in timing:

(a) Filing of the international application with an appropriate receiving Office: this includes a "request" (a petition that the international application be processed according to the Treaty, together with certain data concerning matters such as the applicant, inventor, any agent and formal details about the application, such as the title and any priority claims), a description, one or more claims, one or more drawings (where required) and an abstract;

(b) Certain procedural checks are carried out, an international filing date is accorded and copies of the application are sent to the International Bureau (the record copy) and the International Searching Authority (the search copy);

(c) An international search by the International Searching Authority: this includes a search for earlier disclosures relevant to the novelty and inventive step of the claimed invention and the establishment of an international search report and a written opinion on novelty, inventive step and industrial application, normally at 16 months from the priority date, as detailed later in this document. (See chapter 2 and Parts IV and V);

(d) International **P**ublication of the international application, the international search report, and Article 19 amendments (if any) by the International Bureau at 18 months from the priority date; the written opinion of the International Searching Authority will be made available to the public at the same time;

(e) Optionally, at the request of the applicant by filing a "demand" (Chapter II of the PCT), an international preliminary examination conducted by the International Preliminary Examining Authority, in which the examiner considers further the issues of novelty, inventive step and industrial application, taking into account any comments or amendments under Article 19 or 34 from the applicant, as detailed later in this document; this concludes with the establishment of an international preliminary examination report, which is

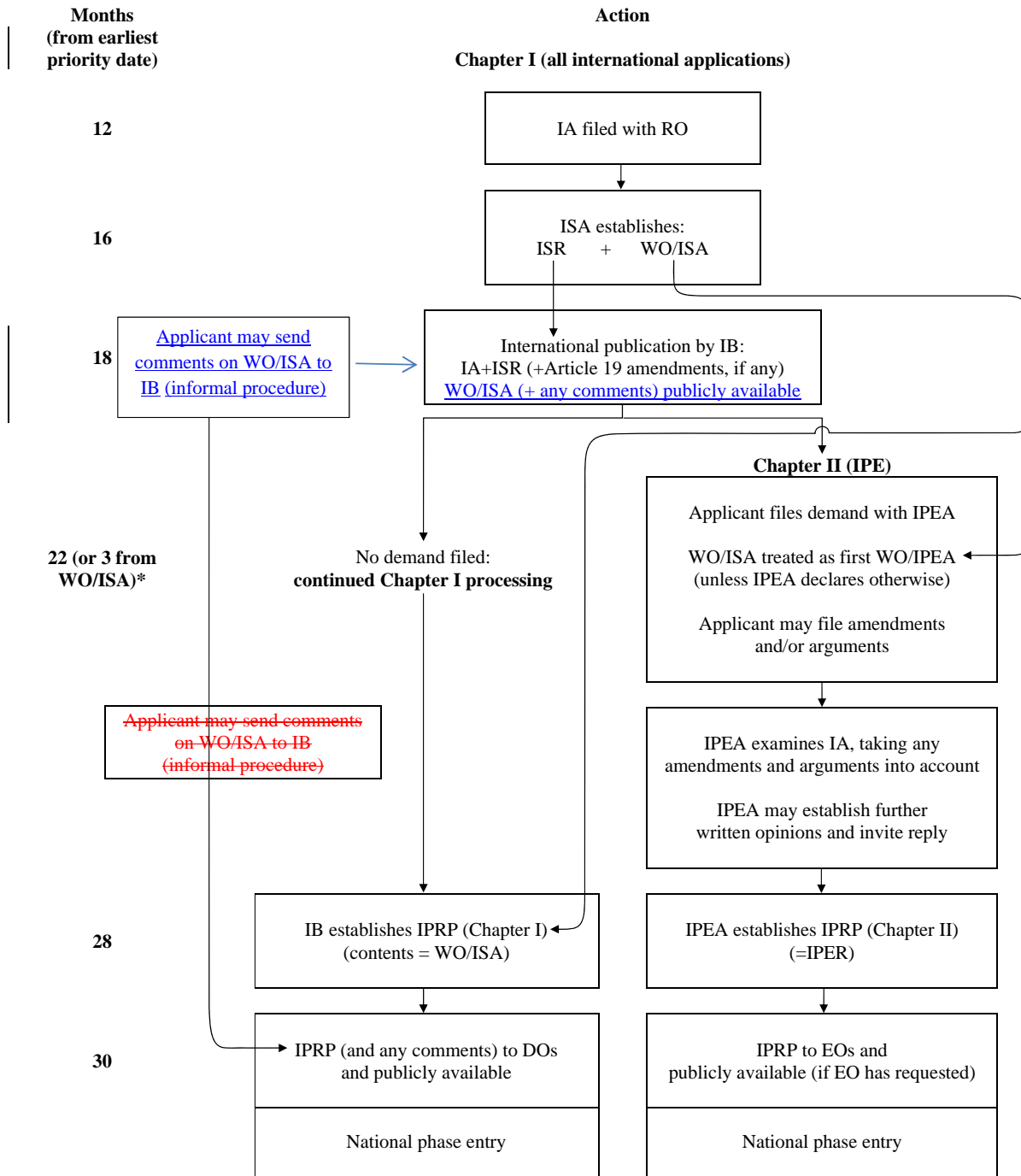
entitled “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)” (see chapter 17);

(f) Issuance of an “international preliminary report on patentability” (Chapter I of the Patent Cooperation Treaty) by the International Bureau on behalf of the International Searching Authority if the applicant does not file a demand requesting examination of the international application in response to the written opinion as established by the International Searching Authority; the international preliminary report on patentability has the same content as the written opinion established by the International Searching Authority;

(g) Distribution by the International Bureau of documents to the designated Offices or elected Offices, including copies of the application, any amendments which have been filed and an international preliminary report on patentability, comprising either the contents of the written opinion by the International Searching Authority or, where established, the international preliminary examination report.

[.....]

**Flowchart of Typical International Application Processing**



- |      |   |         |   |
|------|---|---------|---|
| RO   | receiving Office                              | IA      | international application                         |
| IB   | International Bureau                          | ISR     | international search report                       |
| ISA  | International Searching Authority             | WO/ISA  | written opinion of the ISA                        |
| IPEA | International Preliminary Examining Authority | WO/IPEA | written opinion of the IPEA                       |
| DO   | designated Office                             | IPE     | international preliminary examination             |
| EO   | elected Office                                | IPRP    | international preliminary report on patentability |
|      |   | IPER    | international preliminary examination report      |

\* In practice, demand must be filed by 19 months for Article 22 transitional reservation countries

## Chapter 2 Overview of the International Search Stage

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### Options Open to the Applicant

2.15 In general, the applicant has the following options available following the receipt of the international search report and written opinion of the International Searching Authority:

(a) send (informal) comments on the written opinion of the International Searching Authority to the International Bureau, ~~will which~~ make these available ~~to designated Offices and~~ to the public ~~and to designated Offices at the same time that the written opinion becomes available (in the form of an international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty))~~; see paragraphs [2.17 to 2.18](#), below);

*Rule 46*

(b) submit to the International Bureau amendments of the claims under Article 19(1), optionally including a brief statement explaining the amendments;

*Articles 31, 34(2)(b); Rule 53*

(c) request international preliminary examination, including arguments and/or amendments which will be taken into account by the International Preliminary Examining Authority;

(d) withdraw the application under Rule 90bis; or

(e) take no further action in the international phase, instead waiting until it is necessary, or desired, to pursue the application before designated Offices.

### Further Processing of the International Search Report and Written Opinion

#### *Confidential Treatment*

*Article 30; Rules ~~44ter.1~~, 94.3*

2.16 Prior to the international publication of the international application, all matter pertaining to the application is confidential and may not, without the request or authorization of the applicant, be accessed by any person or authority, except for the transmissions of information specifically required by the Treaty and Regulations for the purposes of processing the application. ~~If no demand is filed:~~

~~(a) — the written opinion of the International Searching Authority;~~

~~(b) — any international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) (see paragraph 2.18, below);~~

~~(c) — any translation thereof; and~~

~~(d) — any comments on the written opinion of the International Searching Authority submitted by the applicant~~

~~all remain confidential until 30 months from the priority date unless authorized by the applicant.~~ If early processing is requested, the designated or elected Office may allow access to any documents which have been communicated to it to the extent provided by its national law, provided that the international application has been published.

**Publication of the Search Report and Making Available of the Written Opinion of the International Searching Authority**

*Article 21(3); Rules 48.2, ~~44ter~~*

2.17 When the international application is published by the International Bureau, the international search report is published with the pamphlet (or, if delayed, is published as a separate pamphlet as soon as possible afterwards) and becomes available to the public. The written opinion and any informal comments filed by the applicant will be made available to the public by the International Bureau at the same time, ~~on the other hand, remains confidential for the time being.~~

*Transmission and Making Available of the International Preliminary Report on Patentability When no Demand Is Filed*

*Rule 44bis*

2.18 If no international preliminary examination report is to be established because the applicant did not file a demand for preliminary examination, or the demand has been withdrawn, the International Bureau will prepare a report, entitled “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” having the same contents as the written opinion. Note that even if the applicant filed any amendments under Article 19, the amendments will not be taken into consideration in the international preliminary report on patentability. Also, note that in certain circumstances as set forth in Rule 44bis.3(a) and (d), the International Bureau may translate the written opinion or report into English. Any such report and translation is communicated to designated Offices, who may then allow access to it, after 30 months from the priority date, or earlier if the applicant has requested early national processing of his application under Article 23(2). The report ~~or written opinion~~, together with any translation ~~may will~~ also be made available to the public by the International Bureau ~~or the International Searching Authority~~ after 30 months from the priority date.

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### Chapter 3 Overview of the International Preliminary Examination Stage

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#### **The International Preliminary Examination Process**

*Rule 66.1ter*

3.15.01 The International Preliminary Examining Authority normally carries out a top-up search at the start of the international preliminary examination process. The main objective of the top-up search is to discover relevant documents that became available for search after the establishment of the international search report. No top-up search is carried out if the Authority considers that such a search would serve no useful purpose (see paragraph 19.12.01).

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#### *Further Consideration*

*Rules 66.2, 66.4, 66.6*

3.21 Where the International Preliminary Examining Authority has carried out a top-up search and intends to raise objections based on prior art documents discovered in the top-up search, a further written opinion should be issued. In other cases, the International Preliminary Examining Authority may, at its discretion, issue further written opinions provided that sufficient time is available, that the applicant makes an effort to meet the examiner's objections and provided that the Authority has sufficient resources to provide such services. The Authority may also communicate informally with the applicant in writing, by telephone or by personal interview.

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**Chapter 17**  
**Content of Written Opinions and the International Preliminary Examination Report**

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**Content of the Opinion or Report**

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*Box No. I: Basis of the Written Opinion*

[.....]

– Top-up Searches

*Rule 70.2(f)*

17.24.01 With regard to top-up searches, the appropriate indication must be given in item 6 of Box No. I with respect to whether a top-up search has been carried out by the International Preliminary Examining Authority. Where it has carried out a top-up search, the examiner also indicates the date on which the top-up search was carried out and whether additional relevant prior art documents have been discovered during the top-up search.

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## Chapter 19

### Examination Procedure Before The International Preliminary Examining Authority

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#### First Stage of International Preliminary Examination

##### *General*

19.11 The examiner should consider if unity of invention exists. If the examiner finds that lack of unity exists, he may issue an invitation to restrict the claims to a single searched invention or subject to Rule 66.1(e) pay additional fees to examine additional inventions before [carrying out a top-up search](#) or the issuance of either a written opinion at the international preliminary examination stage or the international preliminary examination report. See chapter 10 for further details.

19.12 The international preliminary examination is carried out in accordance with Article 34 and Rule 66. A written opinion will normally have been established on the application by the International Searching Authority. Usually this is considered as the first written opinion of the International Preliminary Examining Authority (see paragraph 3.18 for the exceptions to this). The examiner performing the international preliminary examination, if he has not already done so during the international search, studies the description, the drawings (if any), and the claims of the international application, including any amendments and observations which may have been filed, and the documents describing the prior art as cited in the international search report. [He then determines whether to carry out a top-up search in accordance with Rule 66.1ter. Generally a top-up search is carried out.](#) He then determines whether a further written opinion (or a first written opinion in the exceptional case where a written opinion of the International Searching Authority has either not been prepared or else is not treated as the first written opinion of the International Preliminary Examining Authority) is required.

##### *Top-up Searches*

##### *Rule 66.1ter*

19.12.01 In general, the examiner should carry out a top-up search during the international preliminary examination process. However, when he considers that a top-up search would serve no useful purpose, he need not carry out such a search. This is the case, for example, when it is decided that the international application, in its entirety, relates to subject matter on which the International Preliminary Examining Authority is not required to carry out an international preliminary examination, or that the international application is so unclear or the claims are so inadequately supported by the description that no meaningful opinion can be formed on the novelty, inventive step, or industrial applicability, of the claimed invention (see paragraphs 17.29 to 17.33). The same applies when no international search report has been established for certain claims and it is thus decided not to carry out an international preliminary examination on these claims (see paragraph 17.34). Note, however, that when any of the above situations applies to only part of the claimed subject matter or where there is lack of unity of invention, a top-up search should still be carried out but may be restricted to those parts of the international application that are the subject of international preliminary examination. Another situation where a top-up search is considered to serve no useful purpose is when the examiner considers that the documents cited in the international search report are sufficient to demonstrate lack of novelty of the entire claimed subject matter.

19.12.02 A top-up search is normally carried out at the start of the international preliminary examination. In certain cases, it may be delayed to a later stage before the establishment of the international preliminary examination report.

*Rule 66.1ter*

19.12.03 The main objective of the top-up search is to discover any relevant documents referred to in Rule 64 which have become available to the International Preliminary Examining Authority for search subsequent to the date on which the international search report was established. The top-up search is primarily directed towards the earlier filed but later published patent applications or patents within the meaning of Rule 64.3. However, it should also be directed to normal prior art (Rule 64.1) or evidence of non-written disclosures (Rule 64.2) with the aim of discovering any such documents which had not been available to the International Search Authority because of delay in collecting the documents into its database and may, at the discretion of the examiner, be extended so as to cite relevant prior art regardless of when it was published.

19.12.04 The top-up search is generally conducted in the same way as the international search. Its scope does not normally extend beyond that of the international search. However, the final determination as to the exact scope of the top-up search is left to the examiner.

*Rules 66.1ter, 70.7, 70.10*

19.12.05 It should be noted that no specific search report will be established after a top-up search and that only documents of particular relevance discovered in the top-up search need to be indicated in the international preliminary examination report. If any document discovered in the top-up search is used to support any negative statement with respect to any of the claimed subject matter, it should be cited in Box No. V of the report (see paragraph 17.40), and any potentially conflicting patent document discovered should be cited in Box No. VI of the report (see paragraph 17.44). In addition, all documents discovered in the top-up search that are considered to be of particular relevance should preferably be separately listed in a Supplemental Box of the report, in the same manner as in the international search report.

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#### *Cases Where a Further Written Opinion May Be Issued*

19.15 Assuming that the written opinion of the International Searching Authority is treated as the first written opinion of the International Preliminary Examining Authority, as noted above no further written opinion need be issued before the international preliminary examination report, even if there are objections outstanding. However, where the applicant has made a credible attempt to overcome or rebut the objections in the written opinion of the International Searching Authority, but failed to satisfy the examiner that all the relevant criteria are met, a further written opinion may, at the discretion of the International Preliminary Examining Authority, be issued if there is sufficient time available to establish the international preliminary examination report prior to expiration of the time period set in Rule 69.2 for establishment of the international preliminary examination report. Where the International Preliminary Examining Authority has carried out a top-up search and intends to raise objections based on prior art documents discovered in the top-up search, a further written opinion should be issued if there is sufficient time available.

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### **Further Stage of International Preliminary Examination**

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*Rules 66.2, 66.4*

19.20 The examiner should be guided by the overriding principle that an international preliminary examination report should be established after as few written opinions as possible, and he should control the procedure with this always in mind. The PCT provides that the process of communicating with the applicant described in paragraph 19.12 may be repeated if the International Preliminary Examining Authority so wishes. Nevertheless, if it is clear that the applicant is not making any real effort to deal with the examiner's objections, either by amendments or by counter-arguments, then at the conclusion of the first written opinion stage the examiner should establish the international preliminary examination report (see paragraph 19.37). If the examiner has discovered any relevant documents in a top-up search and intends to raise new objections based on them, he should issue a second written opinion to notify the applicant accordingly, provided that there is sufficient time available to establish the international preliminary examination report before the expiration of the period set in Rule 69.2. If the examiner determines that the issuance of a second written opinion would facilitate the final resolution of significant issues, the examiner should consider the issuance of such written opinion. The examiner may consider issuing a second written opinion, if there are still objections that are required to be met, provided that there is sufficient time available for the establishment of the international preliminary examination report within the time limit set in the treaty, that the applicant is making a real effort to meet the examiner's objection and that the International Preliminary Examining Authority has adequate resources (see paragraphs 19.17 and 20.05). The examiner may also consider whether outstanding issues would best be resolved by a further written opinion, a telephone discussion or an interview.

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[End of Annex]