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ORGANIZACION MUNDIAL  
DE LA PROPIEDAD INTELECTUAL



ORGANISATION MONDIALE  
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المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ  
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

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Le Bureau international de l'Organisation Mondiale de la Propriété  
./ Intellectuelle (OMPI) présente ses compliments et a l'honneur de transmettre  
ci-joint le rapport (document PCT/MIA/7/5) de la septième session de la Réunion  
des administrations internationales du PCT, qui s'est tenue à Genève du  
10 au 14 février 2003.

Comme la langue de travail de la session était l'anglais, le rapport est  
disponible seulement en anglais.

À la fois le rapport et les documents de travail sont disponibles sur le site  
Internet de l'OMPI (voir <http://www.wipo.int/pct/en/meetings>).

Le 12 mars 2003

Pièce jointe : document PCT/MIA/7/5

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

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

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PCT**

**Seventh Session  
Geneva, February 10 to 14, 2003**

REPORT

*adopted by the Meeting*

## INTRODUCTION

1. The Meeting of International Authorities under the PCT (hereinafter referred to as “the Meeting”) held its seventh session in Geneva from February 10 to 14, 2003.
2. The following eleven International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Canadian Intellectual Property Office, the European Patent Office, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the Russian Agency for Patents and Trademarks, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in the Annex to this report.

## OPENING OF THE SESSION

4. Mr. Francis Gurry, Assistant Director General, WIPO, on behalf of the Director General, opened the session and welcomed the participants.

## ELECTION OF A CHAIR

5. The Meeting unanimously elected Mr. Philip Thomas (WIPO) as Chair.

## ADOPTION OF THE AGENDA

6. The Meeting adopted the agenda contained in document PCT/MIA/7/1.

## CONTENTS OF THIS REPORT

7. The Meeting agreed that this report<sup>1</sup> would contain the principal conclusions reached at the session rather than a record of the discussion in its entirety.

## PCT MINIMUM DOCUMENTATION

8. Discussions were based on document PCT/MIA/7/3.
9. The Meeting noted the endorsement by the Assembly of the PCT Union, at its 31st (18th extraordinary) session in September-October 2002, of the recommendation of the PCT Committee for Technical Cooperation (PCT/CTC), adopted at its 20th session in September-October 2002, that the Meeting undertake a study of the composition of the PCT minimum documentation and make recommendations to PCT/CTC on proposed modifications of Rule 34 and proposed mechanisms for reviewing and maintaining the non-patent literature part of the PCT minimum documentation (see document PCT/CTC/20/5, paragraph 10, and document PCT/A/31/10, paragraph 75).
10. The Meeting considered the reasons behind the proposed integration of traditional knowledge documentation into searchable prior art, as had been expressed by the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (“the Intergovernmental Committee”) (see document WIPO/GRTKF/IC/2/16, paragraph 154), and agreed that this could significantly improve the quality of international searches in areas where traditional knowledge documentation represents a rich source of information. The Meeting agreed in principle that traditional knowledge documentation should be included in the non-patent literature part of the PCT minimum documentation.
11. The Meeting took note of the Non-Exhaustive Inventory of Traditional Knowledge-Related Periodicals prepared by the Secretariat (see the Annex to document PCT/MIA/7/3). It was agreed that an appropriate selection of periodicals from the inventory should be made with a view to including periodicals containing articles with descriptions of disclosed traditional knowledge to a sufficiently practical or technical level that they would be of relevance to patent examiners carrying out prior art searches, but several Authorities

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<sup>1</sup> References in this report to “Articles,” “Rules,” “Sections” and “Forms” are, respectively, unless otherwise indicated, to those of the Patent Cooperation Treaty (PCT), the Regulations under the PCT (“the Regulations”), the Administrative Instructions under the PCT (“the Administrative Instructions”) and the Forms annexed to the Administrative Instructions. References to “Chapter I” and “Chapter II” are to those of the PCT. References to the “Working Group” are to the Working Group on Reform of the PCT.

delegations noted that their technical experts had not had sufficient time to review the inventory in detail.

12. The Meeting agreed that the criteria shown in the following non-exhaustive list should be used in the selection of appropriate periodicals from the inventory:

- (i) sufficient description of technical content so as to qualify as prior art, including ability to ascertain prior art date;
- (ii) practicable access to periodicals, including their availability in electronic form;
- (iii) availability of an English text of articles or, at least, of English-language abstracts;
- (iv) the range of fields of technology covered by periodicals;
- (v) geographical context of periodicals; and
- (vi) access conditions applicable to periodicals, including cost and text searchability.

13. The Meeting agreed to revisit this matter at its next session. In order to compile comprehensive material for its consideration, the Secretariat was requested to issue a circular to the members of PCT/CTC inviting them to evaluate the Inventory and to suggest a selection of appropriate periodicals from the Inventory, or other traditional knowledge-related periodicals. The members of PCT/CTC should also be invited to investigate alternative ways for providing access to traditional knowledge documentation, for example, by using databases that exclusively or partly contained relevant traditional knowledge data.

14. The Secretariat briefed the Meeting about ongoing initiatives by WIPO Member States and traditional knowledge holders to make disclosed traditional knowledge available in digital form as searchable non-patent literature, as well as developments concerning databases of patent documents relating to traditional knowledge. The Meeting was also informed that the Intergovernmental Committee had established a Portal of Online Databases for such initiatives and felt that this could provide an appropriate format to facilitate electronic access to periodicals and other information resources about disclosed traditional knowledge. The Meeting agreed that the expansion of the PCT minimum documentation to include traditional knowledge documentation should be coordinated with, and take into account, these initiatives. In view of the interest expressed in ensuring practical access to such material for search purposes, one possibility would be to create, in the context of the PCT, a similar but distinct portal specifically for international searches, which may, for instance, give access to any relevant on-line periodicals included within the PCT minimum documentation as well as other related traditional knowledge information.

15. The Meeting noted that the study requested by PCT/CTC should also cover the Non-Exhaustive Inventory of Traditional Knowledge-Related Databases compiled by the Secretariat (see Annex II of document WIPO/GRTKF/IC/3/6).

16. The Meeting agreed that no changes appeared to be needed to Rule 34.1(b)(iii), at least for the time being, in relation to the inclusion of traditional knowledge in the PCT minimum documentation.

17. The Meeting agreed that the issue of reviewing and increasing the efficiency of use of the non-patent literature part of the PCT minimum documentation should be further addressed at future sessions, and invited the Secretariat to brief the Intergovernmental Committee at its next meeting about the ongoing work of the Meeting and of PCT/CTC in relation to the inclusion of traditional knowledge in the PCT minimum documentation.

## PROPOSED REVISED PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

### *General*

18. Discussions were based on documents PCT/MIA/7/2, 2 Add.1, 2 Add.2 and 2 Add.3.

19. The Meeting thanked the United States Patent and Trademark Office for the enormous amount of work done in preparing the draft PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) provided in document PCT/MIA/7/2. It was hoped that this would allow the various Authorities to reach a common understanding on both procedural and substantive aspects of their work under the PCT. It was very important to work towards a common approach wherever possible for the benefit of the system as a whole. It was, however, recognized that this might not be feasible in some areas in the time available and that flexible language might sometimes be required to accommodate different practices and perspectives. It was recognized that some aspects of the Guidelines would require revision in the light of work being undertaken in other forums, such as the PCT quality framework virtual task force.

20. The Meeting gratefully accepted the offer of the United States Patent and Trademark Office to prepare a revised draft of the Guidelines, taking into account the discussion at the present session, to be considered by the Meeting at its next session. Revised drafts would be provided to the Secretariat by that Office for posting on the PCT/MIA electronic forum on WIPO’s website, and Authorities were requested to comment on the drafts via that forum.

21. A summary of the conclusions reached, and of certain comments made, at the session is set out in the following paragraphs.

### *Structure of the Guidelines*

22. The Meeting noted that, whereas the majority of the Guidelines was directed to substantive examination work, some parts, including the whole of Chapter 9, dealt exclusively with formalities matters, and that it might be desirable to separate such matters from the substantive issues, either by establishing a separate part of the Guidelines or perhaps in an entirely separate document. The European Patent Office offered to draft a concrete proposal which would draw together formalities matters relating to both international search and international preliminary examination.

23. The Secretariat noted that the Receiving Office Guidelines would also require some amendment as a result of the introduction of the enhanced international search and international preliminary examination system and suggested that, in the long term, it would consider producing a consolidated set of formalities guidelines covering all stages of the international procedure.

*Electronic Filing and Processing*

24. The Meeting noted that many references within the Guidelines (for example paragraph 9.37) were specific to paper-based processing and did not fit well with electronic document handling. With the introduction and increasing use of electronic filing and processing of international applications, it would be necessary, at some future stage, to review the Guidelines to see what changes needed to be made.

*Addressee of Guidelines*

25. The Meeting agreed that the text of the Guidelines should be reviewed, in the course of redrafting, to see whether certain passages could be more oriented towards giving practical guidance to examiners, although it was recognized that there was a need for the Guidelines to include general explanations of concepts and indications of what an international application was supposed to contain, for the benefit of applicants and practitioners consistent with paragraph 1.02, in addition to instructions to examiners as to the taking of objections.

*Chapter 1 (Introduction and Overview)*

26. The introductory comments in paragraphs 1.03 to 1.04 raised the question of the status of the Guidelines. The Meeting agreed that there was no reason to depart from the conclusion reached during the sixth session (see document PCT/MIA/VI/16, paragraphs 11 to 14), which had been incorporated into the present PCT International Search Guidelines at paragraph I-2 and the PCT International Preliminary Examination Guidelines at paragraphs I-3.1 to I-3.3, and that the content of those existing paragraphs should be included in the revised draft.

27. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 1.05*: The reference to “five parts and an annex” at line 4 will need to be updated to reflect the final numbers.

(b) *Paragraph 1.08*: At line 8 it is necessary to make clear that the written opinion referred to at this point is that established under Rule 43*bis*.

(c) *Paragraph 1.10(b)*: The reference to “16 months” should be reviewed in the light of the fact that this is the normal, practical result, rather than the strict definition in the Regulations (which is considered elsewhere).

*Chapter 2 (Overview of the International Search Stage)*

28. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 2.05*: Rule 23.1 should be mentioned here, since this paragraph deals with the transmittal of the search copy from the receiving Office to the International Searching Authority.

(b) *Paragraph 2.10(b)*: The use of the term “determine” in relation to unity of invention (cf. “discover” in paragraph 2.10(f) in relation to the international search itself) should be revised to be consistent with the requirements of Article 17(3) and Rule 40.

(c) *Paragraph 2.10(d)*: Rule 16.3 should be mentioned in this paragraph. It should be made clear that refunds are available in the case that they have been requested by using the relevant box on the demand form, identifying the earlier searched application. The wording should be changed to read “to determine whether *to use* the results....., and to *consequently* authorize ...”

(d) *Paragraph 2.13*: The word “established” should read “transmitted” for consistency with Rule 44.1.

(e) *Paragraph 2.14*: This paragraph should be revised to reflect the fact that further search fees can be paid either without protest or under protest.

(f) *Paragraph 2.15(b)*: Rule 46.4 should be mentioned in this paragraph. It should be made clear that the statement explaining amendments under Article 19(1) is optional.

(g) *Paragraph 2.16*: Rule 44<sup>ter</sup>.1 should be mentioned in this paragraph.

(h) *Paragraph 2.17*: It should be made clear that, if the applicant files amendments under Article 19 after a written opinion by the International Searching Authority but does not file a demand for preliminary examination, the international preliminary report on patentability (Chapter I) will be established without taking these amendments into consideration (Rule 44<sup>bis</sup>).

(i) *Paragraph 2.18*: The reference to Article 23(3) should read Article 23(2).

(j) *Paragraph 2.19*: It was recalled that the question of copyright and copies of citations was under consideration by the Working Group (see document PCT/R/WG/3/5, paragraph 63), and a drafting note should be included to that effect as a reminder that further changes may be needed at a later stage.

(k) *Paragraph 2.21*: The question was raised of whether the requirement of producing a written opinion in conjunction with the international search report meant that an equivalent opinion was required when producing an international-type search under Article 15(5). It was unanimously agreed that it did not. However it was desirable to refer specifically to Article 15(5) rather than merely Article 15 in this paragraph.

### *Chapter 3 (Overview of the International Preliminary Examination Stage)*

29. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 3.04*: The reference at line 3 to “Phase I” should be amended to read “Chapter I.”

(b) *Paragraph 3.04 and throughout*: It was noted that the report under Chapter II could be referred to as either the “international preliminary examination report” or the “international preliminary report on patentability (Chapter II).” Either was valid, but it was desirable to use terminology consistently.

(c) *Paragraph 3.08:* It may be desirable to include a reference to the WIPO website's list of the remaining reservations.

(d) *Paragraph 3.15:* Delete "if practicable."

(e) *Paragraph 3.18:* A drafting note should be included, reminding of the need to review whether this paragraph is required, depending on whether any Authorities make a relevant notification.

(f) *Paragraph 3.21:* The reference to the number of opinions issued needs to be brought into line with the result of the discussion in connection with Chapter 10.

(g) *Paragraph 3.22:* Consideration should be given to the importance of establishing the report prior to the normal time for entry into the national phase and the possible effects if the report is established after this time (recognizing that this is ultimately a question of national law).

(h) *Paragraph 3.24:* The reference to transmittal of the reports to the elected Offices, rather than establishment of the report is not strictly correct and should be reviewed, noting the differences between Rule 44ter and Article 38 for international preliminary reports on patentability Chapters I and II respectively.

(i) *Paragraph 3.25:* A reference should be made to communication on request.

(j) *Paragraph 3.28:* A drafting note referring to copyright issues should be included, similar to that for paragraph 2.19 above.

#### *Chapter 4 (The International Search)*

30. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) The duplication between Chapters 2 and 4 (particularly the more general parts) should be reviewed.

(b) *Paragraph 4.01:* While this was considered to be a statement of objective, rather than of how the objective should be achieved, a reference to the PCT minimum documentation should be considered.

(c) *Paragraphs 4.02 and 4.52:* In paragraph 4.02, insert "In order to establish the written opinion of the International Searching Authority" at the beginning and replace "perform searching" with "cite."

(d) *Paragraphs 4.04 and 4.07:* Delete the square brackets and retain the text. In paragraph 4.07, replace "can be dated and are indexed" with "are retrievable."

(e) *Paragraphs 4.05 to 4.07:* These paragraphs describe prior art and the relationship with Chapter 14 should be reviewed. Paragraph 4.07 should include a cross-reference to paragraph 14.13.

(f) *Paragraph 4.17:* This paragraph should be made consistent with Rule 33.3(b).



(g) *Paragraphs 4.18 and 4.24 (and elsewhere more generally)*: It would be desirable to find different or extra examples which will be meaningful to examiners in all fields of technology, rather than matters such as pipe clamps, which require some knowledge of a specific art.

(h) *Paragraph 4.20*: Add a reference to the possibility of contacting the applicant.

(i) *Paragraph 4.23*: The final sentence contained many caveats and consequently did not give clear, general advice. Suggestions were requested from Authorities for alternative wordings.

(j) *Paragraph 4.31*: The words “such situations should be apparent” should be made more direct, indicating that the examiner should state the objection.

(k) *Paragraph 4.31*: The square brackets should be deleted and the text between them retained.

(l) *Paragraph 4.33*: There is no guidance on what to do in the event that the applicant refuses to correct the international application voluntarily to remove matter contrary to public order. Suggestions were requested from Authorities who had any experience of such events either under the PCT or comparable national provisions.

(m) *Paragraph 4.36*: It is extremely rare to require an applicant to provide a copy of a document that is unavailable to the Authority but required before a meaningful international search was possible. Nevertheless at least one Authority had occasionally found it necessary to use such a procedure and consequently it was agreed to retain this paragraph.

(n) *Paragraph 4.37*: This should be redrafted to provide that the abstract may be considered prior to or after the search, since the examiner may feel that he understands the invention better afterwards.

(o) *Paragraph 4.51*: In the third line, change “should also endeavor to discover ...” to read “be encouraged to cite.”

(p) *Paragraph 4.57*: Some Authorities objected to any obligation to retain the search history on the file (see Rule 43.6) (see also paragraphs 6.55 and 6.58). However it was suggested that it may be desirable to redraft the paragraph to make clear that Authorities may require their examiners to do so, rather than it being the choice of each individual examiner. The questions of whether requiring such a search history would bolster confidence in the quality of the search and whether the history would be meaningful (or whether it might in some cases be positively misleading) should be considered separately at a later time.

(q) *Paragraph 4.59*: The term “types of expression” is not an example of a “specific claim type” and should be replaced by a better example.

(r) *Paragraph 4.62*: The word “references” should be replaced by “prior art documents” and the term “non-statutory” should be replaced by “matter excluded under Article 17(2)(a)(i).” The term “statutory subject matter” should be revised accordingly.

(s) *Paragraph 4.69*: Should refer to the written opinion as well as the search report.

*Chapter 5 (“Reserved”)*

31. It was clarified that this Chapter was not reserved for further material, but was simply a discontinuity in the numbering, which would be corrected before finalization of the Guidelines, but probably not in the next draft, since this might complicate revision marking.

*Chapter 6 (International Search Report)*

32. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 6.04:* It was felt that a new heading was required above this paragraph. In addition the word “Chapter” in line 1 might be replaced by “the following paragraphs” or the like.

(b) *Paragraph 6.07:* A drafting comment should be added to remind of the need to review in the light of new forms, particularly if computer-generated forms are introduced (though this is not likely to be before the current revision must come into force).

(c) *Paragraph 6.19:* In the second line, after “mentioned of those” add “on the request form” to clarify where the applicant’s name is mentioned.

(d) *Paragraph 6.20:* This should contain an exhaustive list of the subjects which may be excluded from search and examination (see Rules 39 and 67).

(e) *Paragraphs 6.36 to 6.48:* These paragraphs covered the same subjects as paragraphs 8.01 to 8.07. The duplication should be reviewed; one Authority expressed a preference for the version of the explanation of procedure provided in these paragraphs over that in Chapter 8.

(f) *Paragraph 6.37:* Redraft to differentiate between Rules 37 and 38.

(g) *Paragraph 6.39(c):* Change the first sentence to read “only one figure should normally be selected. The ....”

(h) *Paragraph 6.39(d):* In the second line, change “text” to “abstract.”

(i) *Paragraph 6.46:* This wording could be replaced by wording taken from the European Patent Office’s Guidelines, which is more complete (EPC Guidelines, A-III 7.1, adapted to the PCT procedure) as follows:

*“Title of the invention.* According to Rule 4.3 PCT, the title must be short and precise (preferably from two to seven words in English or when translated into English). Furthermore, the title should clearly and concisely state the technical designation of the invention and should exclude all fancy names. In this regard the following should be taken into account:

(a) personal or trade names, fancy names, the word “patent” or similar terms of a non-technical nature which do not serve to identify the invention should not be used;

(b) the abbreviation “etc.,” being vague, should not be used and should be replaced by an indication of what it is intended to cover;

(c) titles such as “Method,” “Apparatus,” “Chemical Compounds” alone or similar vague titles do not clearly state the technical designation of the invention.”

This section should also clarify that the International Searching Authority may change a deficient title at its own discretion according to Rule 37.2.

- (j) *Paragraph 6.47*: Make any necessary changes in view of new paragraph 6.46.
- (k) *Paragraphs 6.53 to 6.61*: See comments on paragraph 4.57 above.
- (l) *Paragraphs 6.55 and 6.58*: See comments on paragraph 4.57 above.
- (m) *Paragraph 6.64(a)*: Place the text in square brackets for reconsideration.
- (n) *Paragraph 6.64(b)*: Omit this paragraph.
- (o) *Paragraph 6.64(c)*: Redraft to address relying on the closest prior art without the citation of duplicate prior art.
- (p) *Paragraph 6.64(d)*: Omit this paragraph.
- (q) *Paragraph 6.64(e)*: Redraft to make it clear what the examiner is relying on (abstract or whole document).
- (r) *Paragraph 6.64(f)*: Omit this paragraph.
- (s) *Paragraph 6.65*: Omit this paragraph.
- (t) *Paragraphs 6.67 to 6.93*: Redraft in view of comments in document PCT/MIA/7/2 Add.1 and those mentioned in the following five paragraphs.
- (u) *Paragraph 6.71*: Consideration should be given to an explicit statement that documents may be cited as category X if they call into question the inventive step of a claim when considered in the light of common general knowledge.
- (v) *Paragraph 6.73*: Further drafting is required to clarify that if any alternative, taken as a whole, within the scope of the claim would have been obvious, then the claim lacks inventive step, rather than that the whole breadth of the claim must be obvious for such an objection.
- (w) *Paragraphs 6.75 and 6.81*: It may be desirable to note that where a single document is cited as suggesting a lack of inventive step, that document would normally be listed as category X.
- (x) *Paragraph 6.76*: Redrafting was required to clarify that “as a whole” related to each dependent claim as read together with the claims from which it depends, rather than all dependent claims being read together as a whole.

(y) *Paragraph 6.85*: It was agreed that the Guidelines were not the appropriate place to define a new symbol – this should be raised with the Standing Committee on Information Technologies (SCIT). It was agreed that the paragraph should remain in square brackets for the moment as a reminder of the issue, but be marked with a drafting note to make clear that it was not intended to introduce it until the proper process had been completed. It was also noted that the intention was to provide a manner of marking a category of documents which were known to the examiner, not to introduce an obligation to extend the search. It was also noted that “D” was not a good symbol since it already has a specific, different meaning in European practice (relating to a document cited by the applicant in the description).

(z) *Paragraph 6.105*: Omit this paragraph.

(aa) *Paragraph 6.107*: A drafting note should be included to remind of the consideration being given to copyright in citations in other forums, as noted above in respect of paragraph 2.19.

(bb) *Paragraphs 6.109 to 6.114*: Some concern was expressed at including details of the reissue of search reports in the Guidelines, since this is done by the Authorities as a service, not an obligation. There was general agreement that there were times when all Authorities would agree that reissue was appropriate and that this could be mentioned in the Guidelines, but that there should be no implication of an obligation and that much of the detail of internal practice was a matter for the individual Authorities and not relevant to these Guidelines. Consideration might be given to referring to “replacement” search reports, rather than reissues, noting that any second search report would be a replacement. Redraft these paragraphs to provide that any second (optional) search report should be a replacement of that first issued.

#### *Chapter 7 (Classification of International Applications)*

33. It was pointed out that a large part of this Chapter is a summary of matter which appears in the Guide to the International Patent Classification (IPC). It was questioned whether it might be better simply to provide a reference to that Guide.

34. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 7.02*: The relationship between this paragraph and paragraph 6.53 should be examined. They were generally felt not to be inconsistent, but the phrase “all such classifications should be assigned” may require further knowledge of the rules of the IPC to reconcile easily with the statement “non-obligatory IPC symbols do not need to be applied.”

(b) *Paragraph 7.03*: The need for all relevant classifications could be expressed more simply, without reference to main groups within subclasses.

#### *Chapter 8 (Errors and Deficiencies Checked at the Search Stage)*

35. A significant overlap between this and Chapter 6 was noted. It may be desirable for the two chapters to be merged.

*Chapter 9 (Preliminary Procedure on Receipt of the Demand)*

36. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraphs 9.02 and 9.12:* In line 12 of paragraph 9.02, change “is not in conformance” to “does not comply” and in line 4 of paragraph 9.12 change “in conformance” to “does not comply.”

(b) *Paragraph 9.07:* It may be worth noting that there are no current reservations in respect of Chapter II so that this paragraph is not operative at the time that the Guidelines are established, but it was not appropriate to delete it entirely.

(c) *Paragraphs 9.08 and 9.15:* The significance of the references to 19 months should be clarified, indicating that failure to notify the applicant quickly may result in loss of rights in States where a notification in respect of the modification to Article 22(1) is still in force.

(d) *Paragraph 9.10:* It should be clarified that it is only necessary to check that new applicants are entitled to file the demand if the change under Rule 92*bis* is recorded by the International Bureau prior to the demand being filed.

(e) *Paragraph 9.20:* In line 2, “(preferably by facsimile transmission)” should be deleted.

(f) *Paragraphs 9.22, 9.28, 9.29 and 9.34:* Update required to reflect amended Rule 90.4, whereby Authorities are not required to call for a power of attorney and also need not routinely forward this to the International Bureau. It may also be necessary to note the new provisions in relation to withdrawal of the international application. IP Australia offered to draft new text.

(g) *Paragraph 9.36 (and possibly elsewhere):* Update required to reflect new Rule 60.1*ter*, whereby when there are several applicants it is sufficient for the demand to be signed by any one applicant.

(h) *Paragraph 9.58:* In line 6, change “the file will not be forwarded to the examiner” to “examination will not start” since whether or not to forward a file should be left to internal practice.

(i) *Paragraph 9.59:* Needs review for consistency with Rule 53.9(a)(ii). This rule specifically refers to the case where Article 34 amendments “reverse” (the term used as opposed to “cancel”) Article 19 amendments.

(j) *Paragraph 9.64:* Consider whether the word “or” at the beginning of line 5 should read “and/or” to take account of the different possible ways in which an abstract might come to be established.

*Chapter 10 (Examination Procedure Before the International Preliminary Examining Authority)*

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

37. See paragraphs 10.14 and 10.15 of the draft revised Guidelines.

38. The Meeting noted that the Treaty and Regulations did not impose any obligation on the International Preliminary Examining Authority under Chapter II to establish any further written opinion beyond the first, although the possibility that such further opinion(s) might be issued was envisaged. That position was equally true under the existing Regulations (under which the first written opinion was established under Chapter II by the International Preliminary Examining Authority) and under the Regulations as amended with effect from January 1, 2004 (under which the first written opinion would, subject to the exception provided by Rule 66.1*bis*(b), be that established under Chapter I by the International Searching Authority). There was some discussion, however, about the extent to which the Guidelines should indicate whether, and in what circumstances, the International Preliminary Examining Authority should exercise its discretion to establish a further written opinion.

39. It was noted that the amended provisions relating to the International Searching Authority did not, unlike the existing provisions relating to the International Preliminary Examining Authority, give the applicant the opportunity of having amendments or arguments considered by the International Searching Authority in establishing the first written opinion, although it was pointed out by one Authority that such opportunity was, under the present provisions, seldom taken advantage of by applicants in practice. It was also noted that the amended provisions did not, of course, affect the applicant's right to submit amendments or arguments under Article 34, and that such amendments or arguments would be taken into account by the International Preliminary Examining Authority in establishing the international preliminary examination report or, where appropriate, in issuing a further written opinion.

40. Certain Authorities expressed the view that there were circumstances in which the issuance of a further written opinion should be encouraged by the Guidelines, provided that there was sufficient time available, that the applicant was making a real effort to meet the examiner's objections and that the Authority had adequate resources, and felt that the wording of the present Guidelines relating to international preliminary examination (see paragraph VI-6.3) was preferable to the revised draft. The value of the international phase of the PCT procedure to applicants and elected Offices, particularly smaller Offices, which relied on the results of the international preliminary examination procedure would be reduced, it was felt, if examiners were not encouraged to issue further written opinions, since more outstanding objections would then remain to be resolved in the national phase. Such an approach was felt to be inconsistent with the objective of making the PCT a more useful tool in the obtaining and granting of patent protection internationally, and would increase costs and work for applicants and Offices. The comments by the International Federation of Industrial Property Attorneys (FICPI) that were reproduced in document PCT/MIA/7/2 Add.2 were noted.

41. Other Authorities believed that the revised Guidelines should not restrict the discretion of the International Preliminary Examining Authority, noting that the Regulations did not make the issuance of a further written opinion obligatory in any circumstances. It was noted that the draft revised Guidelines made it clear that the International Preliminary Examining Authority remained at liberty to issue further written opinions where appropriate.

42. A majority of the Authorities which took the floor considered that the current draft of paragraphs 10.14 and 10.15 was acceptable, subject to amendment of the words “need not be required” at line 1 of paragraph 10.14 to read “is not required” and deletion of the word “only” at line 7 of paragraph 10.15 (which amendments were, in themselves, generally agreed), but it was noted that it was open to Authorities to propose alternative texts which might form an acceptable compromise in future revised drafts.

– *Other Matters*

43. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 10.03*: References to “technical character” were not necessary in this context. Delete the bracketed text.

(b) *Paragraph 10.04*: Consideration should be given to the location of this paragraph and to a change of emphasis, providing guidance to examiners.

(c) *Paragraph 10.08*: In line 4 after “search report” add “and the written opinion established under Rule 43bis.1.”

(d) *Paragraph 10.11*: Change the last sentence to read: “If the application complies with PCT Article 34(2)(c), the Authority need not issue a written opinion but may establish the international preliminary examination report directly.”

(e) *Paragraph 10.12*: In line 2, change “should” to “would normally.” In line 7, add “should” before “study.”

(f) *Paragraph 10.13*: Redrafting with inclusion of items from Rule 66.2.

(g) *Paragraph 10.14*: In the first line replace “need not be required” with “is not required.”

(h) *Paragraph 10.15*: In the 4th line from the bottom delete “only.”

(i) *Paragraph 10.16*: The procedure as to lack of unity of invention should be dealt with in Chapter 12.

(j) *Paragraph 10.19*: For consistency with Rule 66.2(c), the words “, where appropriate,” should be inserted in front of “the amendments” in line 2.

(k) *Paragraph 10.21*: Rewrite the last line to read “The examiner may also consider whether outstanding issues would best be resolved by a further written opinion, a telephone discussion or an interview.”

(l) *Paragraph 10.23*: Redraft to indicate that the examiner should comment briefly on those arguments considered to be relevant.

(m) *Paragraph 10.26*: Delete.

(n) *Paragraph 10.27:* Amend the wording “there is no restriction on resuming...” to “International preliminary examination may exceptionally be resumed after a report...”

(o) *Paragraph 10.34:* Should be amended to make clear that interlineations are acceptable only at the discretion of the Authority and not as of right for the applicant.

(p) *Paragraph 10.36:* Should be amended to make clear that an Authority may, if it wishes, accept a change of language of correspondence without a formal request being made by the applicant.

(q) *Paragraph 10.39:* There was general agreement that “will not” should be deleted. It was felt by most Authorities that the rule was appropriate since the question of added matter was simply the opinion of the examiner and the relevant sheets should be available for elected Offices to form their own conclusions in the national phase. Nevertheless, it was noted that it may be desirable to introduce a new stamp for amended pages, to distinguish those which are considered to contain additional subject matter.

(r) *Paragraph 10.40:* There was broad agreement that the first text in square brackets should be removed, leaving the second option. However, one Authority was unfamiliar with the test of “not expressly or inherently presented” and might need to return to this after further study.

(s) *Paragraph 10.53:* A reference should be made in the final sentence to optional Form PCT/IPEA/428, which Authorities may use to record informal communications with the applicant.

(t) *Paragraphs 10.62 to 10.63:* These paragraphs should be combined, removing the redundancy within them. Item (iii) of paragraph 10.63 could only apply where the International Searching Authority and the International Preliminary Examining Authority were the same and may be too much a matter of internal practice to be relevant to the Guidelines.

(u) *Paragraphs 10.62 to 10.70:* These paragraphs relate to administrative matters and consideration should be given to moving them to a separate part dealing with more procedural and administrative matters.

(v) *Paragraph 10.67:* Amendment is required to take into account Rule 73.2, whereby the international preliminary examination report is communicated to elected Offices only after 30 months from the priority date, except where the applicant has made an express request to an elected Office under Article 40(2). It was agreed that, under Rule 94.2, there is no obligation for International Preliminary Examining Authorities to provide copies to third parties.

#### *Chapter 11 (Amendments)*

44. *Paragraph 11.02* requires amendment to make clear that, under Rule 66.4*bis*, an applicant may file amendments up until the International Preliminary Examining Authority has begun to draw up the international preliminary examination report, even if this is outside the time limit for reply set under Rule 66.2(d).



*Chapter 12 (Content of Written Opinions and the International Preliminary Examination Report)*

45. The European Patent Office presented a proposal in document PCT/MIA/7/2 Add.3, splitting the content of Chapter 12 into separate chapters for the written opinion of the International Searching Authority and those of the International Preliminary Examining Authority. It was explained that the main reason for this was to highlight that, while it was important to maintain common standards between the different stages, there were inevitably differences resulting from the time at which the actions were performed (particularly in the areas of considering priority, unity of invention and the fact that amendments cannot have been filed prior to the international search).

46. Advantages were seen both in maintaining the current approach of dealing with all written opinions and the international preliminary examination report in a single chapter and with dividing matters to allow the points relevant to only one stage or the other to be presented more clearly. Either way, the European Patent Office's proposal was extremely useful since it made clear the areas where the differences needed to be considered.

47. It was agreed that the United States Patent and Trademark Office should review the issues which were raised by the European Patent Office's paper and make a new proposal reflecting their view of the best way to present these matters.

48. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 12.02*: Add a reference to new Rule 43*bis*.1(a)(ii). Amend "which may be in the application" to "insofar as checked by the Authority."

(b) *Paragraph 12.04*: Clarify which time limit applies: Article 19(1)/Rule 46, Rule 66 or Rule 43*bis*.

(c) *Paragraph 12.13*: The word "almost" in the second line should be deleted unless an example of a case can be found where the written opinion of the International Searching Authority would be drawn up other than on the basis of the application as filed. The status of sequence listings filed for search purposes, which under Rule 13*ter* do not form part of the international application, should be corrected. The United States Patent and Trademark Office should consider adding a clarification that corrections are considered to be part of the application as filed.

(d) *Paragraph 12.22*: Amend the words following "sequence listings" in line 1 to read "one or more of the following indications must be given with respect to the sequence listing on which the examination is based: (i) ..."

(e) *Paragraph 12.24*: Further clarification is required of the appropriate manner of presenting the basis of the opinion in the case where amendments are considered to go beyond the original disclosure. The Secretariat may also suggest to the Working Group that Rule 70.2(c) be clarified.

(f) *Paragraph 12.27(b):*

(i) Requires updating to reflect amended Rule 66.7, whereby Authorities may not request copies of priority documents which are available to them through a digital library.

(ii) Requires updating to take into account the establishment of written opinions of the International Searching Authority when the priority document is not available, but there is still time for the applicant to provide it. There was a difference of opinion on whether the opinion should in this case make the assumption that the priority is valid (which is true in a large majority of cases) or that it is not valid (in which case detailed reports would be made on the possible relevance of “P” category documents, which may not be relevant if priority is later found to be valid, but which would give more complete information at an early stage in the event that the priority was not valid). It was noted that the international search report would always be established using the categories based on the claimed priority date and that this did not have to be consistent with the written opinion, where the validity of the priority is, where possible, taken into account. It was also noted that, if the priority claim was presumed to be valid, this may result in a misleading positive opinion of the International Searching Authority and misleading positive international preliminary report on patentability (Chapter I), which could have a negative effect on parties relying on such opinions and reports. It was agreed that the United States Patent and Trademark Office would consider the matter further, noting that the contents of the opinion form could be amended to take this possibility more readily into account, and attempt to find a suitable solution.

(g) *Paragraph 12.30:* Refer also to the International Searching Authority.

(h) *Paragraph 12.48:* Add the words “insofar as checked by the International Searching Authority.”

(i) *Paragraphs 12.51 to 12.52:* Require an appropriate heading, for example “Form of objection.”

(j) *Paragraph 12.54:* In line 2, change “should” to “must.”

(k) *Paragraph 12.61:* There is a difference between the requirements of Article 17(1), whereby the first invention is to be searched, and of Article 34(3)(c), whereby what appears to be the main invention should be examined. It was agreed that the practical result of Rules 66.1(e) and 68.5 was that the international search report and written opinions would invariably cover the same inventions. This should be clarified.

(l) *Paragraph 12.63:* Clarify the term “improper amendment.”

### *Chapter 13 (Claims)*

49. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraphs 13.05 to 13.06:* These paragraphs refer to the first written opinion inviting the applicant to adopt the two-part formulation. Noting that the first written opinion is (normally) the written opinion of the International Searching Authority, it was agreed that it was quite appropriate for the International Searching Authority to invite the applicant to take a particular action. Even if no demand is filed, the applicant may find it useful to follow up

the advice in amendments to the claims under Article 19 or else during proceedings in the national phase.

(b) *Paragraph 13.05:* It was suggested that the statement in the penultimate sentence “if ... the applicant does not follow the invitation, the examiner should not pursue the matter further” raised the question of whether it was worth raising such an objection at all. It was felt that since the particular claim formulation was a requirement of the Rules at least an initial comment should be made. It was suggested that there may be some variation in practice in this area and that the Guidelines should more clearly indicate what was common to all Authorities and where it was possible for practice to vary. Delete the final sentence (“See paragraph 13.20”).

(c) *Paragraph 13.08:* The final sentence should be redrafted to remove the implication that an Authority may in some cases be obliged to require the two part formulation. Where an Authority does, however, apply Rule 6.3(b), this sentence is appropriate.

(d) *Paragraph 13.13:* Consider returning to the original language of paragraph III-3.2 of the International Preliminary Examination Guidelines.

(e) *Paragraph 13.14:* Adopt the second bracketed option in the text.

(f) *Paragraph 13.20:* It was recognized that practice in relation to interpretation of claims was a fundamental matter, but that there were significant variations in practice. For a number of Authorities, claims were considered to stand alone and could only be interpreted using the description in certain very limited circumstances; for these Authorities, the text in the final square brackets was very important. Others felt that the description could be relevant, either in including specific definitions of terms used in the claims, or else more generally as to how the claims should be understood. It was agreed that harmonization of practice would not be possible at this stage and that the next draft should take this non-uniformity better into account.

(g) *Paragraph 13.21:* Guidance on interpretation of claims in the form “X when used in a process Y” would be useful. IP Australia offered to provide a draft text.

(h) *Paragraph 13.22:* The statements as to the limiting effect of the preamble are contradictory. Consider deleting second, third and fourth sentences.

(i) *Paragraph 13.24:* It was observed that the particular words considered in this paragraph may be interpreted in various ways under different national laws. Furthermore the situation described in sub-paragraph (a) was unusual; a more relevant type of claim is one where a feature usually existing in a type of apparatus is excluded. IP Australia offered to provide a draft text for such a situation.

(j) *Paragraphs 13.26 to 13.27:* Should be redrafted, particularly paragraph 13.26, to take into account differences in practice in relation to product by process claims. There is a difference in understanding over whether such claims relate to (and would be anticipated by) a product which has actually been produced by a process or to any product which has the same characteristics as one which had been produced by that process. Furthermore the question was raised of how to ascertain whether the result is inventive over the prior art – whether physical differences needed to be “significant” and whether differences of any nature

needed to be taken into account or only ones relevant to the alleged inventive effect. It was observed that product by process claims were originally used in cases where the characteristics of the product could only be described in that way, but were now used more widely. These claims should not be confused with protection for a product made by a patented process in accordance with Article 28.1(b) of the Agreement on Trade-Related Aspects of Intellectual Property Rights.

(k) *Paragraph 13.28:* Amend preceding title to “Product and Apparatus Limitations in Process Claims.” Add “and apparatus.”

(l) *Paragraph 13.30:* Should be redrafted to offer more advice to examiners.

(m) *Paragraph 13.31:* In the final sentence, the important matter is that the examiner is able to interpret the claim unambiguously, rather than that the claim exactly fits one of the “standard” categories.

(n) *Paragraphs 13.34 and 13.35:* These paragraphs should reflect how to interpret, or object to, claims during examination, rather than how it is desirable that they be drafted.

(o) *Paragraph 13.36:* A distinction should be drawn between claims where unusual parameters may be hiding a lack of novelty and those where the parameters used are the only effective way of defining the invention.

(p) *Paragraph 13.39:* The paragraph should indicate the inherent problem of trademarks: that they characterize the commercial origin of goods, not the properties relevant to the invention.

(q) *Paragraph 13.41:* In the bracketed paragraph insert “where this has been originally disclosed” after “or language.” The final sentence should provide advice to the examiner rather than to a person drafting the claims.

(r) *Paragraph 13.42:* Could provide better advice on the appropriate action for examiners.

(s) *Paragraphs 13.31 to 13.42:* It was agreed that the redrafted text for these paragraphs should take the European Patent Office’s draft text in document PCT/MIA/7/2 Add.3 into account, which appeared to address most of the issues noted in items (m) to (r) above.

(t) *Paragraphs 13.44 and 13.45:* Amend “description” to “disclosure” in the heading and in lines 1 and 3 of paragraph 13.45.

(u) *Paragraph 13.47:* Should be redrafted to make clear that it is not necessary to provide examples covering every possible variation within the scope of a claim.

(v) *Paragraph 13.48:* Delete “The nature of the claimed invention, i.e.” in line 1.

(w) *Paragraph 13.51:* Delete the words “in scope” in the heading.

(x) *Paragraph 13.52:* Since it provides a general rule, the contents of this paragraph may be better placed at the start of the section on support.

(y) *Paragraph 13.57*: Delete the words “acceptable and” in line 3. Reconsider how and where to deal with the concept of shifting the burden of proof to the applicant after the establishment of a *prima facie* case.

(z) *Paragraph 13.58*: A number of Authorities considered that “may” in the second line should be replaced by “will” since it is not possible for the description to be sufficient if a claim is too broad to be supported by it. This paragraph should be revised to take alternative practices into account. Add “(see paragraph 19.14)” at the end.

(aa) *Paragraph 13.59*: If subject matter from the claims is introduced into the description which thereby creates a contradiction or inconsistency, this will have to be resolved by amendment either of the claims or description.

(bb) *Paragraphs 13.61 to 13.62*: Add a definition of “biological material.” Redraft to reflect differences in practice, whereby before the European Patent Office a deposit is only relevant in order to remedy issues of enablement, whereas under the practice of the United States Patent and Trademark Office, the deposit may also be relevant to support.

#### *Chapter 14 (Prior Art)*

50. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 14.01*: The paragraph should be amended to clarify that an admission is not conclusive proof that the subject matter referred to is prior art. The applicant may rebut the presumption.

(b) *Paragraphs 14.05 and 14.07*: Should be reviewed following conclusions on the treatment of “P” category documents when the priority date cannot be established.

(c) *Paragraph 14.08*: Should remain as it stands – it was agreed that it was necessary for the international preliminary examination report to draw attention to the relevant published patent applications and patents.

(d) *Paragraph 14.10*: Any proposal for a new symbol will be referred to the Standing Committee on Information Technologies Standards and Documentation Working Group (see also item 32(y) above).

(e) *Paragraph 14.11*: Some concern was expressed at the idea of providing documents relevant to sufficiency as well as novelty and inventive step. It was also noted that the word “incorrect” at the end of the first sentence might be misleading. Noting the statement that the search should not specifically be extended to look for such matter, it was agreed that it was useful to provide evidence which had become known to the examiner on matters that he was required to comment on.

(f) *Paragraph 14.12*: It was questioned whether there was any difference in practice in respect of whether a document was prior art if not indexed.

(g) *Paragraph 14.13*: A new heading, such as “Disclosure on the Internet,” is required. To be redrafted in more general terms. The term “credibility” in particular requires further consideration.

#### *Chapter 15 (Novelty)*

51. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 15.01*: The words “persons of ordinary skill” should be replaced by “persons skilled in the art.”

(b) *Paragraph 15.02*:

(i) The reference to the “effective date” should be reviewed in view of the lack of agreement on whether the teaching of a document should be assessed for novelty purposes as it would have been understood when it was published, or on the priority date of the international application in the light of knowledge discovered in the meantime (see document SCP/8/9 Prov., paragraph 323, summarizing discussions of draft Rule 14(2) under the draft Substantive Patent Law Treaty (SPLT)).

(ii) The last sentence should be broadened to indicate that this principle is not limited specifically to chemical compounds.

(c) *Paragraph 15.03(iii)*: Add “in combination” after “disclosed.”

(d) *Paragraph 15.06*: Should be reviewed to indicate that the teaching of a second document incorporated by reference should only be considered to the extent indicated by that reference, though it is recognized that this may not be clear when the reference is not specific.

(e) *Paragraph 15.07*: Should be clarified in view of different understandings of anticipation: the majority of Authorities saw a claim which embraced a number alternatives as a single entity, which was anticipated if any one of the alternatives had been disclosed (though it was of course likely that it could be amended to overcome the novelty objection). One Authority however viewed such a claim as being notionally many claims relating to the individual alternatives and only those parts which had been disclosed were anticipated, rather than the claim as a whole.

(f) *Paragraph 15.10*: An amendment was suggested to indicate that where a claimed range overlaps with a previously disclosed range, there will normally be a lack of novelty. However it was agreed to leave the draft as it stands since the generality of the draft reflects the fact that the issue of ranges is difficult and case law on the subject varies significantly.

#### *Chapter 16 (Inventive Step)*

52. This chapter was recognized as an area where there are many different approaches worldwide. The draft needed to provide guidance which was detailed enough to allow examiners to apply common rules. However, there may be a need to establish an Annex to provide guidance where practices diverge.

53. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 16.01*: The word “any” in line 4 should be reviewed since many jurisdictions would not be so strict.

(b) *Paragraph 16.03*: Item (ii) should be amended to “the references must be considered as a whole and must prompt the skilled person into combining the teaching of the documents so as to arrive at the subject matter as claimed.” The European Patent Office offered to propose new language for item (iv).

(c) *Paragraph 16.08*: The European Patent Office had made comments in document PCT/MIA/7/2 Add.1.

(d) *Paragraph 16.12*: The term “specialist in that field” may be misleading in implying a higher level of knowledge than an “ordinary practitioner.”

(e) *Paragraphs 16.13 and 16.14*: Should be redrafted to make clear throughout that it is the teachings within documents which are being combined, rather than the documents as a whole.

(f) *Paragraph 16.15(a)(ii)*: The second sentence should be clarified to indicate better that the applicant’s recognition within the international application that an element is equivalent to another which had previously been used for a purpose does not mean that the use of this element instead of the other is obvious.

(g) *Paragraph 16.15(b)(ii)*: Add at the end “providing the means for overcoming the technical difficulties are defined in the claim.”

(h) *Paragraph 16.16*: One Authority suggested that “and” should be replaced by “and/or” in the sentence in square brackets. Another suggested that neither the suggestion nor the reasonable likelihood of success being found in the prior art were absolutely essential factors, though they were certainly highly relevant. The other Authorities which spoke considered that both were necessary. The United States Patent and Trademark Office offered to attempt to redraft the paragraph taking these differences of view into account.

#### *Chapter 17 (Industrial Applicability)*

54. The United States Patent and Trademark Office indicated that this chapter had been introduced because it was an area where the current Guidelines lacked any significant guidance. While the terminology used was largely derived from that Office’s practice, it was not believed that “utility” was different from “industrial applicability” and should be included at least as a manner of approaching this issue. It was pointed out that “industrial applicability” was the term used under the PCT and this should be used. It was acceptable to have a reference to utility, but the status of this should be clear. It was agreed that the chapter would be further redrafted and the results of the survey currently being undertaken by the Secretariat on national laws in this area would be considered.

*Chapter 18 (Priority)*

55. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 18.09*: An equivalent change to the term “directly and unambiguously” as in paragraph 15.01 in relation to novelty.

(b) *Paragraphs 18.12 and 18.17*: Should be updated to reflect amended Rule 17.1, allowing for the possibility of the priority document being available from a digital library.

*Chapter 19 (Content of the International Application (Other than the Claims))*

56. The European Patent Office’s proposed alternative to paragraph 19.14 from document PCT/MIA/7/2 Add.1 was agreed.

57. See also “Addressee of Guidelines,” paragraph 25, above.

*Chapter 20 (Exclusions From, and Limitations of, International Search and International Preliminary Examination)*

58. The general question was raised of whether it was necessary for an Authority to give an opinion on novelty and inventive step for claims which had been found to lack industrial applicability. It was suggested that this would depend on circumstances. Where a claim was framed in such a way that it was not considered to include an industrial application, but it could be seen how it might be amended to overcome this problem, then it would be desirable to include an opinion on novelty and inventive step. If the Authority could see no way in which this objection could be overcome then it may be appropriate not to perform a search or to establish an opinion as to novelty or inventive step. It was agreed that the next draft should include a paragraph on this subject, not necessarily in this chapter (possibly in Chapter 12).

59. The proposed amendments to paragraphs 20.01, 20.08, 20.10, 20.11 and 20.15 set out in document PCT/MIA/7/2 Add.1 were accepted, subject to the need for some redrafting.

60. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 20.04(c)*: The words “industrial applicability” in line 7 should be reviewed for consistency with the rest of the paragraph.

(b) *Paragraph 20.11*: The meaning of the words “on non-prior art grounds,” which appear in the final sentences explaining each of Examples 1 to 3, should be clarified (these words do not appear in the version of this paragraph noted in paragraph 59, above).

*Chapter 21 (Unity of Invention)*

61. The Meeting noted that there was as yet no common approach among Authorities as to how the PCT criteria for determining unity of invention should be applied (see Articles 17(3) and 34(3) and Rule 13). This was exemplified by discussion of paragraph 21.02 and a specific example concerning the question of whether support and sufficiency may be relevant to the existence of a “contribution over the prior art.” It was agreed that, for the foreseeable



future (and pending any developments in the context of consideration of the draft Substantive Patent Law Treaty by the WIPO Standing Committee on the Law of Patents), the Guidelines would need to reflect a range of different practices, and Chapter 21 should be revised accordingly.

62. The Meeting noted the outline of the practice of the European Patent Office set out in document PCT/MIA/7/2 Add.1, Annex II, and agreed that it would be useful if other Authorities were to provide similar outlines via the MIA electronic forum.

63. The question of how the different practices should appear in the Guidelines (for example, whether in the text of Chapter 21 or in one or more Annexes), remained to be determined. It was not clear at this stage how much agreement could be reached on a common core of practice or of how this might best be presented in the Guidelines. An overriding consideration was the need for each Authority be able to provide the Guidelines to its examiners as a practical and unambiguous work tool.

64. The Meeting agreed with the proposed relocation of examples illustrating unity of invention practice from the Administrative Instructions (Annex B, Part 2), where they currently appear, to the Guidelines.

65. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Paragraph 21.19:* IP Australia offered to provide further examples illustrating unity of invention practice in the area of biotechnology.

(b) *Paragraph 21.19, Examples 18 ff:* It would be desirable to include some non-chemical examples of “Markush practice.”

(c) *Paragraphs 21.26 to 21.30:* These paragraphs would need to be reviewed in the light of the Working Group’s intention to review the Regulations concerning the protest procedure in cases of findings of lack of unity of invention (see document PCT/R/WG/3/5, paragraphs 95 to 98).

#### *Chapter 22 (Rule 91 – Obvious Errors in Documents)*

66. The Meeting agreed that a Chapter dealing with the rectification of obvious errors under Rule 91 should be included in the Guidelines but, noting that the Working Group had requested that proposals for amendment of Rule 91 be submitted to it by the Secretariat, did not discuss the draft text of Chapter 22 in detail. Authorities were invited, in the meantime, to submit comments via the electronic forum on the existing text, particularly in relation to the matters covered in paragraphs 22.01 to 22.04.

67. The word “foreseen” at line 5 of paragraph 22.06 should be amended to “expected” equivalent to the amendment agreed to paragraph 10.49.

*Chapter 23 (Quality Assurance)**– Quality Standards and Quality Management*

68. The Meeting noted the conclusions of the Working Group as to how further work relating to the quality of international search and international preliminary examination should proceed (see document PCT/R/WG/3/5, paragraph 111):

“111. The Working Group agreed that work in this area should continue along the following two paths:

(a) The standards to which PCT search and examination should conform should be established in the PCT International Search and Preliminary Examination Guidelines. Work should continue on revision of those Guidelines, which would be needed by January 1, 2004, when the recently adopted enhanced international search and preliminary examination system came into effect.

(b) A “virtual” task force should be established to consider which of the other points noted above [in paragraphs 101 to 110], or in document PCT/R/WG/3/4, should be taken forward and how. The International Bureau would set up a page on its Web site, open to registration by any State or organization represented in the Working Group, with an electronic forum and mailing list to facilitate discussion. The work of the task force would be coordinated by the United Kingdom. The results of the work of the task force would be reported to the Working Group and to the Meeting of International Authorities, the first such report being requested by the end of April 2003.”

69. The Meeting noted that the electronic forum for the task force had been set up<sup>2</sup> and that a further discussion paper prepared by the United Kingdom Patent Office had been posted on it. It was agreed that Chapter 23 of the draft Guidelines should refer in an explanatory note to the work of the Working Group and the task force. The results of that work should also be taken into account in the future, when it became available, in the substantive text of the Chapter. In the meantime, the present text of paragraphs 23.07 and 23.08 should be omitted. It was noted that Authorities were, of course, free to take part in the work of the task force.

70. The Meeting noted that a clear distinction could not easily be drawn between matters relating to quality standards and those relating to quality management and assurance, and that both matters were of vital concern to the International Searching and Preliminary Examining Authorities in ensuring that their work met the expectations of users, including applicants, third parties, and designated and elected Offices.

71. Certain Authorities expressed the view that it would be appropriate for the Meeting to address quality management and assurance issues in parallel with the work of the task force; other Authorities believed that the Meeting should restrict its approach, for the time being, to quality standards.

72. The Japan Patent Office reserved its position on the contents of Chapter 23, stating its view that the Meeting was not the appropriate forum for consideration of quality management

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<sup>2</sup> See <http://www.wipo.int/pct/reform/qualityframework/en>.

and assurance issues and that the Meeting should await the results of the work of the task force on such issues before attempting to deal with them in the Guidelines.

73. IP Australia, while believing that a detailed discussion by the Meeting would be premature at this stage, said that the application of International Standard ISO 9000 could be not only possible but also desirable.

74. The European Patent Office, while welcoming a discussion on quality, expressed concern with one aspect of the United Kingdom's discussion paper, namely, its proposal that the quality of the work of the Authorities be subject to review by an independent (that is, external) body. The Office believed that the proposal would create practical difficulties and that the internal mechanisms for quality management and assurance would be more appropriate. The Swedish Patent and Registration Office, the United States Patent and Trademark Office, IP Australia, the Russian Agency for Patents and Trademarks, the Korean Intellectual Property Office, the Canadian Intellectual Property Office and the Spanish Patent and Trademark Office also expressed opposition to or concern about the proposal for external quality review.

75. The Meeting, noting that the first report on the work of the task force was to be available by the end of April 2003, agreed that consideration of that report be included on the agenda for the next session of the Meeting, to be held in May 2003, and that the United Kingdom Patent Office should be invited, in its capacity as task force coordinator, to attend the session for that agenda item for the purpose of presenting the report to the Meeting.

– *Other Matters*

76. The Meeting agreed that in further revising the draft Guidelines the following points should be taken into account:

(a) *Chapter title*: This should be amended to read "Standards for Quality Assurance."

(b) *Paragraph 23.06(i)*: The repetition of the word "reviews" should be reviewed.

*Annex A (International Search Documentation)*

*Annex B (Recommended Databases for Search in Various Fields)*

77. The Meeting agreed that such material had great attraction and warranted further consideration. Discussion focused on the proposal that the search documentation include databases as well as document collections. However, there was a preference for not including Annex B in the Guidelines given the rapidly changing nature of databases.

78. The United States Patent and Trademark Office explained that it was proposing the inclusion of database portals as an adjunct to the more traditional document collections (which themselves could, of course, be accessible in electronic form). The Meeting agreed that the idea should be further considered in relation to both practical and legal consequences. Particular thought needed to be given to the question whether database portals should be included as a part of the PCT minimum documentation, in which case there would be a formal obligation to consult them, or simply as a recommended tool to supplement the minimum documentation; in general, the latter approach appeared at this stage to have greater appeal.

79. The Meeting noted that any proposal to include database portals as part of the minimum documentation would, of course, need to be submitted to PCT/CTC.

#### FORMAT OF WRITTEN OPINIONS AND REPORTS UNDER PCT CHAPTERS I AND II

80. Discussions were based on documents PCT/MIA/7/4 and 4 Add.1, which concerned formats proposed by the European Patent Office for written opinion and report forms, including those needed for the implementation of the enhanced international search and preliminary examination system with effect from January 1, 2004.

81. The Secretariat outlined some of the work which was envisaged in the coming months, including consultation of Authorities and national Offices (in their capacity as designated and elected Offices), and also of user groups, as to the new and modified forms. The Meeting noted that questions relating to both the content and the format of the forms needed to be addressed.

82. The Meeting agreed that the new written opinion and report forms needed for the purposes of the procedure under Chapter I should conform as closely as possible in their content and format to those already in use for the purposes of Chapter II. If it was feasible, the corresponding forms under both Chapters should be identical except for their titles; this might be achieved, for example, by including in the forms references to both sets of the relevant Rules. In any event, it was noted that there would need to be some modification of the existing forms in addition to the introduction of the necessary new forms. Those modifications should be kept to the minimum necessary. It was noted that at least three months would be needed to enable Authorities to implement systems for producing opinions and reports using the new and modified forms.

83. The Meeting noted that certain of the existing procedures for international search and international preliminary examination would need to continue for a transitional period beyond January 1, 2004, in relation to international applications filed before that date. Use of the existing forms would probably need to be continued beyond that date, for up to 30 months, although it would be preferable if the new forms could also be made to meet the present requirements.

84. The Meeting agreed that formats in the existing box style would be needed for the new written opinion and report forms, pending agreement on the introduction of a new style of format such as that proposed in document PCT/MIA/7/4. When a new style of format had been agreed, it would be necessary for both styles to remain in use, as options for Authorities, for at least a transitional period.

85. The Secretariat informed the Meeting that the necessary XML DTDs for the new forms were being developed for inclusion in Annex F of the Administrative Instructions. The use of those DTDs would afford a degree of flexibility since written opinions and reports prepared in electronic form in accordance with them would be able to be represented on paper and on computer screens in a variety of different ways, depending on the purpose.

86. Several Authorities indicated that a two-column format similar to that suggested in document PCT/MIA/7/4 would be acceptable, but others indicated that they would prefer a single-column format. The European Patent Office agreed to prepare alternative proposals, including both single- and double-column formats, for consideration by the Meeting at its next session.

87. As to the timetable for the development and introduction of the new and modified forms needed for the enhanced international search and preliminary examination system, the Meeting agreed with the following proposals by the Secretariat:

(i) the Secretariat would send proposals (based on the present box style) for consultation with Authorities, national Offices and user groups at the beginning of April 2003, seeking comments by the end of May 2003; the proposals could therefore be discussed by the Meeting at its eighth session in May 2003;

(ii) the proposals would then be revised by the Secretariat, and near-final versions of the forms would be presented to the Meeting at its ninth session in July 2003;

(iii) any final changes needed would be made by the Secretariat and the final version of the forms would be promulgated before the end of September 2003.

88. Development of a new style of format would continue in parallel with the introduction of new and modified forms in the present box style format, and the Secretariat would undertake the necessary consultation on the new style of format when the proposals had been agreed upon by the meeting.

89. The Secretariat noted that a number of forms other than those for written opinions and reports were also affected by the changes to the Regulations coming into effect on January 1, 2004, but it was envisaged that consultation on those other forms would be undertaken separately from that relating to written opinions and reports.

#### NEXT SESSION

90. The Secretariat indicated that the eighth session of the Meeting was tentatively scheduled for May 5 to 9, 2003, in Washington, D.C., (at the invitation of the United States Patent and Trademark Office), and the ninth session for July 21 to 25, 2003, in Geneva.

*91. The Meeting unanimously adopted this report on February 14, 2003.*

[Annex follows]

ANNEX

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

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[End of Annex and of document]