

## **Meeting of International Authorities under the Patent Cooperation Treaty (PCT)**

**Twenty-Seventh Session  
Gatineau, February 6 and 7, 2020**

### **PROPOSAL ON THE HANDLING OF DRAWING INFORMALITIES IN INTERNATIONAL APPLICATIONS UNDER THE PCT**

*Document prepared by the United States Patent and Trademark Office*

#### **SUMMARY**

1. The United States Patent and Trademark Office (USPTO) seeks to improve the handling of drawing informalities in PCT applications. To do so, the USPTO proposes to more specifically define the process by which receiving Offices (ROs) evaluate drawings and partially revise Form PCT/RO/106. The RO/US receives a significant number of international applications with informal drawings, i.e., drawings that do not comply with the relevant provisions of PCT Rule 11. The invitation and correction procedure under PCT Rule 26 proves inefficient for both RO/US and applicants. Importantly, the process often does not result in the acceptance of replacement drawings that are in full compliance with the Regulations for the purpose of international processing, including international publication.

#### **BACKGROUND**

2. The RO/US issues approximately 16,000 Invitations to Correct Defects (Form PCT/RO/106) each year. That represents almost 30 per cent of the international applications filed in the RO/US annually. It is estimated that 80 per cent of those Invitations include indications in Annex C that the drawings do not comply with PCT Rule 11. The processing teams at the International Bureau informally estimate that only 50 per cent of international applications filed in the RO/US have drawings in compliance with the Regulations.

3. Although PCT Rule 26.3(a)(i) indicates that the RO only checks the international application for compliance with Rule 11 to the extent necessary for reasonably uniform publication, it is the practice of the RO/US to issue an Invitation to Correct Defects in all

instances where the drawings do not comply with PCT Rule 11. This practice is based on several factors. Firstly, there does not appear to be a clear definition of “reasonably uniform publication.” Secondly, the USPTO has considered it a service to applicants to identify these defects so they are aware that correction will be needed at some point and are not surprised by a requirement at the national or regional phase. Lastly, the USPTO was concerned about consistency with its national practice.

4. The consequence of this practice is that applicants typically respond under PCT Rule 26.4 with replacement sheets of drawings. These replacement sheets are often refused entry by the RO/US because they include changes that effectively require review by a patent examiner. For example, shading modifications, text modifications, legend changes, addition of cross-hatching, reference numeral modification and structural detail modification can effectively change the disclosure. Where the RO/US refuses entry of replacement drawing sheets and the USPTO is the International Searching Authority (ISA), the replacement drawings are considered under PCT Rule 91, Rectification of Obvious Mistakes. These replacement sheets are rarely accepted under Rule 91. In applying the Rule 91 analysis, the informal nature of the original drawings, or portions thereof, might be considered an obvious mistake. However, the correction offered, especially in the examples described above, rarely qualifies under the “nothing else could have been intended” analysis.

5. It should be noted that the RO/US only applies the consequence of withdrawal, as provided for in Rule 26.5, in extreme situations and has rarely withdrawn an international application for drawing informalities.

6. In the end, the process proves inefficient for both applicants and the RO/US and does not often result in the acceptance of Rule 11 compliant drawings.

## **DISCUSSION**

7. The USPTO would like to improve the process of handling drawing informalities. More specifically, the USPTO proposes to do so by: (1) specifically defining “reasonable uniform publication” or attributes associated therewith, and (2) considering changes to the Invitation to Correct Defects (Form PCT/RO/106) to provide more complete information to applicants.

8. In relation to specifically defining “reasonable uniform publication” or identifying attributes that are required for “reasonable uniform publication”, there has been discussion on the need for this previously.

9. The Report from the eleventh session of the Assembly of the PCT Union in 1984 indicated the following (see paragraph 31 of document PCTA/XI/9):

“31. When adopting the amendment to Rule 28.1(a), the Assembly agreed that the Guidelines for Receiving Offices for the Processing of International Applications under the PCT should be revised in order to better clarify the formality examination standards, in particular, the physical requirements for reasonably uniform international publication referred to in Rule 26.3, so that the cases of application of Rule 28.1 would decrease in the future.”

10. From the fourteenth session of the Meeting of International Authorities under the PCT in 2007, paragraph 7 of document MIA/14/6 indicated:

“7. The Guidelines provide no indication of which of the requirements of Rule 11 are particularly important to ensuring uniform publication or satisfactory reproduction and leave the matter to the judgement of the individual receiving Office.”

11. Additionally, there have been two Practical Advice articles on this topic in the PCT Newsletter. See PCT Newsletters No. 3/2016 and No. 5/2019.

## PROPOSAL

12. The USPTO proposes to amend the sections titled “HOW TO CORRECT THE DEFECTS” and “ATTENTION” on the first sheet of Form PCT/RO/106, as set forth in the Annex to this document. The proposed changes attempt to inform applicants of the scope of corrections that may be accepted so applicants can better decide under what provisions of the PCT the corrections should be made. The small change to the “ATTENTION” section simply attempts to reflect the practice of receiving Offices as defined in PCT Rule 26.5.

13. Further, the USPTO proposes to identify specific attributes that are required for reasonably uniform international publication referred to in Rule 26.3. The Receiving Office Guidelines do not provide any indication as to which of the requirements of Rule 11 are particularly important to ensure reasonable uniform international publication or satisfactory reproduction and leaves the matter to the judgement of the individual receiving Offices.

14. The USPTO proposes the following attributes that define the requirement for reasonably uniform international publication:

- (a) Each sheet of drawings shall be in an upright position (i.e., portrait orientation).
- (b) Drawings shall be executed in sufficiently dense and dark lines such that all details can be distinguished, the drawings admit of direct reproduction, and all details will be distinguishable if reproduced at two-thirds scale.
- (c) Drawings shall be of satisfactory scale and distinctness in their graphical execution such that all details can be distinguished, the drawings admit of direct reproduction, and all details will be distinguishable if reproduced at two-thirds scale.
- (d) The height of the numbers and letters shall generally be not less than 0.32cm such that all details can be distinguished, the drawings admit of direct reproduction, and all details will be distinguishable if reproduced at two-thirds scale.

15. These attributes have been identified from PCT Rule 11 and are intended to ensure that the drawings are of sufficient quality as to be reproducible and distinguishable to the extent necessary to convey the disclosure of the application.

16. In practice, receiving Office staff would review the drawings in relation to these attributes to determine if the drawings are sufficient to ensure reasonably uniform publication. Where the drawings are not in condition for reasonably uniform publication, the receiving Office staff would review for compliance with all the requirements of PCT Rule 11 and issue Form PCT/RO/106 identifying all defects.

*17. The Meeting is invited to comment on:*

*(i) the proposed amendment to Form PCT/RO/106 in the Annex to this document; and*

*(ii) the attributes required for reasonably uniform publication.*

[Annex follows]

Annex

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

To:	<h1 style="margin: 0;">PCT</h1> <p style="margin: 0;">INVITATION TO CORRECT DEFECTS IN THE INTERNATIONAL APPLICATION</p> <p style="margin: 0;">(PCT Articles 3(4)(i) and 14(1) and Rule 26)</p>
	Date of mailing <i>(day/month/year)</i>
Applicant's or agent's file reference	<b>REPLY DUE</b> within <b>TWO MONTHS</b> from the above date of mailing
International application No.	International filing date <i>(day/month/year)</i>
Applicant	

1.  The applicant is hereby invited, within the time limit indicated above, to correct, in the international application as filed, the defects specified on the attached:

Annex A

Annex B1 (*text matter of the international application as filed*)

Annex C1 (*drawings of the international application as filed*)

2.  The applicant is hereby invited, within the time limit indicated above, to correct, in the translation of the international application furnished under Rule 12.3 or 12.4, the defects specified on the attached:

Annex A

Annex B2 (*text matter of the translation of the international application*)

Annex C2 (*drawings of the translation of the international application*)

Additional observations (if necessary):

**HOW TO CORRECT THE DEFECTS?**

Except where the defect is in the request, any correction must be submitted by filing a replacement sheet embodying the correction and a letter accompanying the replacement sheet, which shall draw attention to the difference between the replaced sheet and the replacement sheet. For a defect in the request, a correction may simply be stated in a letter if it is of such a nature that the correction can be transferred clearly onto the request record copy (Rule 26.4). It should be noted that some corrections may go beyond what is permissible under Rule 26. That is, some corrections may effectively constitute an amendment to the international application and therefore extend beyond compliance with Rule 11 and Article 14. In such situations, the applicant should consider making such corrections under Rule 91, Rectification of Obvious Mistakes, or as an amendment under Article 19 and/or Article 34.

**ATTENTION**

Failure to correct the defects may result in the international application being considered withdrawn by this receiving Office (see Rule 26.5 for further details).

A copy of this Invitation and any attachments has been sent to the International Bureau

and the International Searching Authority.

Name and mailing address of the receiving Office	Authorized officer
Facsimile No.	Telephone No.