

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

**Thirty-First Session
Beijing, October 16 and 17, 2024**

PROPOSED MODIFICATIONS REGARDING BOXES VII AND VIII OF PCT/ISA/237

Document prepared by the China National Intellectual Property Administration

SUMMARY

1. On the basis of the four priority items determined at the thirtieth session of the Meeting of International Authorities, the China National Intellectual Property Administration (CNIPA) would like to propose modifications to one of the priority items, regarding Boxes VII and VIII of PCT/ISA/237.

BACKGROUND

2. According to the discussion at the thirtieth session of the Meeting of International Authorities in 2023, the Authorities agreed to discuss the four priority items for Proposal to Promote the Improvement of the International Search Report and the Written Opinion (see paragraph 31 of document PCT/MIA/30/10). The CNIPA invited the Authorities to provide guidelines and examples for filling in Boxes VII and VIII of PCT/ISA/237 as well as examination practices and proposed improvement on the other three priority items. Seven Authorities provided feedback: IP Australia, the Canadian Intellectual Property Office, the European Patent Office, the Japan Patent Office, the Spanish Patent and Trademark Office, the Intellectual Property Office of Singapore and the United States Patent and Trademark Office. On the basis of the relevant clauses of the PCT Regulations and the PCT International Search and Preliminary Examination Guidelines, and taking into account the feedback from the Authorities, the CNIPA proposes the following modifications to Boxes VII and VIII of PCT/ISA/237.

CURRENT REGULATIONS AND FORM REGARDING BOXES VII AND VIII

CURRENT REGULATIONS

3. Rule 70.12 (Mention of Certain Defects and Other Matters) in the PCT Regulations serves as the legal basis for filling in of Boxes VII and VIII of the Written Opinion of the International Searching Authority, the Written Opinion of the International Preliminary Examining Authority, and the International Preliminary Examination Report on Patentability. Furthermore, paragraph 17.49 of the PCT International Search and Preliminary Examination Guidelines specifies the filling requirements for Box VII (Certain defects in the international application), and paragraph 17.50 specifies the filling requirements for Box VIII (Certain observations on the international application).

TITLE AND DESCRIPTION OF BOXES VII AND VIII

4. The title of Box VII is “Certain defects in the international application”, and the description in the blank field for filling is “The following defects in the form or contents of the international application have been noted”.

5. The title of Box VIII is “Certain observations on the international application”, and the description in the blank field for filling is “The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made”.

PROPOSED MODIFICATIONS TO BOXES VII AND VIII OF PCT/ISA/237

6. The regulations for filling in Boxes VII and VIII of PCT/ISA/237 in the PCT International Search and Preliminary Examination Guidelines are clear, and the practices of the Authorities are consistent. In Box VII, formality defects should be indicated, for example, claims relying on references to the description or drawings (Rule 6.2(a)), a multiple dependent claim serving as a basis for other multiple dependent claims (Rule 6.4(a)), and spelling or grammar mistakes. In Box VIII, substantive observations should be indicated, for example, the clarity of the claims, the description and the drawings, or whether the claims are fully supported by the description, etc. Based on this, it infers that the issues raised in the feedback of the survey, which was conducted through PCT Circulars C. PCT 1607 and C. PCT 1608 in 2020, are mainly due to insufficient guidance for filling in Boxes VII and VIII of PCT/ISA/237, which makes it difficult for examiners to distinguish the differences between the two Boxes based solely on the current descriptions.

CONTENT OF MODIFICATIONS

7. In order to facilitate examiners of the Authorities to fill in Boxes VII and VIII, and improve the quality of the written opinions, and facilitate the use by PCT users and the public, the CNIPA proposes the following two options:

Option I (Annexes I and II): Presenting specific defects via checkbox, which can be checked by the examiner when filling in Boxes VII and VIII of PCT/ISA/237. Specifically, the defects in Box VII do not comply with Rule 6.2(a) or Rule 6.4(a) of the PCT Regulations, while Box VIII lists the defects of the claims pursuant to Article 6 of the PCT, and the description or drawings pursuant to Article 5 of the PCT.

Option II: Providing the descriptions listed in the checkbox of Option I in the form of standardized clauses.

8. It should be noted that Boxes VII and VIII of the Written Opinion of the International Preliminary Examining Authority (PCT/IPEA/408) and the International Preliminary Report on Patentability (PCT/IPEA/409) are the same as Boxes VII and VIII of PCT/ISA/237, and it is suggested to make same modifications to these forms.

9. *The International Authorities are invited to comment on:*

(i) *the proposed Option I and Option II in paragraph 7 above; and*

(ii) *if Option I is preferred, the proposed modifications to Box VII in Annex I (applicable to PCT/ISA/237, PCT/IPEA/408 and PCT/IPEA/409) and Box VIII in Annex II (applicable to PCT/ISA/237, PCT/IPEA/408 and PCT/IPEA/409).*

[Annexes follow]

PROPOSED MODIFICATIONS TO BOX NO. VII¹

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

Claims Nos. _____ rely on references to the description or drawings, and thus do not comply with PCT Rule 6.2(a):

Multiple dependent claims Nos. _____ refer to a precedent multiple dependent claim, and thus do not comply with PCT Rule 6.4(a).

Other defects are as follows:

[Annex II follows]

¹ Added and deleted parts are indicated respectively by underline and strikethrough in relevant text.

PROPOSED MODIFICATIONS TO BOX NO. VIII²

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claims Nos. _____ are lack of clarity pursuant to PCT Article 6 for the following reason(s):

The search and written opinion with regard to the above claims are therefore made on the following reasonable expectation:

The description _____ /drawings _____ are lack of clarity pursuant to PCT Article 5 for the following reason(s):

The search and written opinion are therefore made on the following reasonable expectation:

Claims Nos. _____ are not fully supported by the description pursuant to PCT Article 6 for the following reason(s):

The search and written opinion with regard to the above claims are therefore made on the following reasonable expectation:

Other observations are as follows:

[End of Annex II and of document]

² Added and deleted parts are indicated respectively by underline and strikethrough in relevant text.