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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT

Second Session
Geneva, March 9 to 13, 1992

REVISION OF THE INTERNATIONAL PRELIMINARY
EXAMINATION GUIDELINES

Memorandum prepared by the International Bureau

1. Following the discussions and recommendations made at the first session of the Meeting of International Authorities under the PCT (MIA) , which took place from January 15 to 19, 1990, the International Bureau has prepared a modified draft of revised PCT Preliminary Examination Guidelines, contained in document PCT/GL/3 Prov. That document was sent on November 29, 1990, with Circular C. PCT 399, to the International Preliminary Examining Authorities for comments, together with the revised proposals of the European Patent Office (EPO) for modification of the Guidelines (see paragraph 75 of the report of the first session, document PCT/MIA/1/8).
2. The Annex to this document contains a copy of Circular C. PCT 399 and replies received by the International Bureau from the Austrian Patent Office, the Australian Patent Office, the United Kingdom Patent Office, the Japanese Patent Office, the Swedish Patent Office and the United States Patent and Trademark Office in reply to that Circular.
3. On the basis of comments and proposals received from the International Preliminary Examining Authorities, in particular those received in reply to the said Circular, and taking into account the amendments to the PCT Regulations which will enter into force on July 1, 1992, the International Bureau has prepared a modified draft of revised PCT Preliminary Examination Guidelines for further discussion by the International Authorities. That draft is contained in document PCT/GL/3 Prov. Rev. 1. All proposals and suggestions which seemed likely to be generally acceptable have been incorporated in the modified draft

of the revised Guidelines. Any point not taken into account may be brought up for discussion during the Meeting by the interested Authority.

4. It should be noted that Chapter VII of the revised Guidelines, dealing with the tasks of the International Preliminary Examining Authorities in relation to formal requirements, is not included in document PCT/GL/3 Prov. Rev. 1. A revision of Chapter VII will be contained in a separate document.

[Annex follows]

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2.

C. PCT 399
211

November 29, 1990

It should be noted that references in the margin to PCT Articles and Rules and to Sections of the PCT Administrative Instructions have not yet been inserted into the draft revised Guidelines. This will be done at a later stage.

It would be appreciated if any comments on the draft revised Guidelines and on the proposals of the EPO could be received before April 1, 1991.

November 29, 1990

C. PCT 399
211

Sir, Madam,

This circular is addressed to your Office in its capacity as International Preliminary Examining Authority under the Patent Cooperation Treaty (PCT) for the purpose of consultations in respect of the revision of the PCT Preliminary Examination Guidelines (document PCT/INT/6).

Following the discussions and recommendations made at the Meeting of International Authorities under the PCT which took place from January 15 to 19, 1990, draft revised Guidelines have been prepared and are enclosed herewith as document PCT/GL/3 Prov. A vertical line in the margin identifies the passages modified as a result of the discussions at the Meeting (see paragraphs 58 to 76 of the report on that meeting, document PCT/MIA/I/8). Minor changes of an editorial nature are not marked.

It is recalled that the European Patent Office (EPO) agreed at the Meeting to reconsider those of its proposed modifications which did not meet with immediate approval by the Meeting. These proposals have therefore not been incorporated in the draft. The EPO, after reconsideration of its proposals, has now submitted, together with explanatory notes, a revised proposal for modification of the Guidelines. The EPO's new proposals are also enclosed herewith, as an appendix to this Circular, for consideration by the other International Preliminary Examining Authorities.

Sincerely yours,


A. Schäfers
Deputy Director General

Enclosures: Appendix
Document PCT/GL/3 Prov.

PCT/MIA/II/3

ANNEX

Appendix to Circular C. PCT 399 of November 29, 1990

European Patent
Office

September 1990

guidelines for the PCT preliminary examination and for European substantive examination from the offset, the aim being to ensure a harmonised interpretation of the concerned provisions. It would therefore be desirable for the IPEAs to retain as much of that harmonised practice as possible.

Revised proposals of the
European Patent Office
relating to the revision
of Chapter II PCT
Examination Guidelines

3. In the following pages, the current and amended proposed texts appear on the even pages while the reasons appear on the uneven pages.

Moreover, amended and new paragraphs appear together consecutively.

Introduction

1. Reference is made to Document PCT/MIA/II/8, (Report of the first meeting of International Authorities under the PCT, Geneva, 15-19 January 1990), paragraphs 73 to 76.

It was agreed that the EPO will reconsider those of its proposals for amending and complementing the International Preliminary Guidelines which did not meet with immediate approval and where appropriate resubmit those amendments which deserve in its opinion additional thoughts of the International Authorities.

2. The present document contains those paragraphs which the EPO submits for further consideration.

The EPO wishes to point out that the EPC and PCT harmonised provisions on substantive law resulted in almost identical

- 4 -
Chapter II-4.17

Present version

The object of the proposal is to positively indicate that references in international applications to other documents may relate to the background art as well as to the disclosure of the invention. As far as the background art is concerned no substantive change is proposed.

The essential modification only relates to the disclosure of the invention, and tries to take account of the present practice, i.e. references of this kind are frequently found not only in national applications but also in international applications.

For international applications the proposed version thus specifies how the examiner should proceed to enable a prosecution of these applications.

The objection that the proposal would not comply with Article 5 PCT is in the opinion of the EPO based on a too narrow interpretation of Article 5. If this Article would be interpreted as meaning the description alone (i.e. without any references to other documents) the consequence could be a rejection of all applications including such references, since the reference would have to be deleted possibly leading to an insufficient disclosure and in the extreme case to a loss of the whole application. Such an adverse effect is certainly not intended in Article 5 PCT and furthermore cannot be seen to be within the spirit of PCT.

Proposed version
Replace lines 1-14 (1-36)1)
"References...date" by
the following:

References in international applications to other documents may relate either to the background art or to part of the disclosure of the invention.

Where the reference relates to the background art, it may be in the application as originally filed or introduced at a later date (see II. 4.4 and 4.5).

Where the reference relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus) then, it is to be taken into account in respect of Article 5, it must be in the application as originally filed and clearly identify the document referred to in such a manner that the document can be easily retrieved. If matter in the document referred to is essential to satisfy the requirements of Article 5, at least a summary of this matter should be incorporated expressis verbis in the description, because the patent specification should, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document.

Proposed version

4.17 References to previously (i.e. before the international filing date) published material including patent applications and specifications of granted patents, text books and periodicals are allowable and often desirable (see Chapter II, paragraph 4.4) to explain the background art. A reference to an unpublished previously filed application (i.e. not published before the international filing date) describing background art should not be regarded as being part of the disclosure, unless the application referred to is made available to the public on or before the publication date of the international application. The reference to such an application describing background art made available to the public on or before the publication date of the international application may be replaced by the actual text referred to and may be taken into account by the examiner. Similarly, references to text books and periodicals are allowable under the same conditions if it can be proved that the content thereof was fixed prior to the international filing date.

In the case of any document made available to the public later than the publication date of the international application or not to be published at all (e.g. an application withdrawn before publication), the examiner should not take into account the reference to that document for the purposes of international preliminary examination. It should be noted, however, that this....

1) The first mentioned figures refer to the text as published in Doc. PCT/INT/6 while the second mentioned figures refer to the present one.

Chapter III.4.7(b)

ad Chapter III-4.7(b):

The object of the new paragraph is to clearly set out how claims for products defined in terms of a process should be interpreted.

Since such a claim is to be construed as a claim to the product as such it follows that the process is no limitation but only a suitable means of fully defining the product. To emphasise that the product as such is protected (i.e. even if it is the result of a different process) the expression "obtainable" is therefore used.

The reason for avoiding "obtained by" is that it would imply that the specific process must be used; it would be an unnecessary delimiting feature.

Present version

Proposed version

4.7b Claims for products defined in terms of a process of manufacture are admissible only if the products as such are, *inter alia*, new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process. A claim defining a product in terms of a process is to be construed as a claim to the product as such and the claim should preferably take the form "Product X obtainable by process Y", or any wording equivalent thereto, rather than "Product X obtained by process Y".

Chapter III.4.8(a)

ad Chapter III-4.8(a):

The object of the new paragraph is to give a clear guidance as regards the interpretation and meaning of a specific type of claims, i.e. claims for an apparatus trying to define the apparatus by reference to its use.

The present Guidelines do not comprise any reference to this type of claims.

The proposed text, which is believed to be self-explanatory, can be seen as an appropriate measure for achieving a uniform and harmonised practice.

Present version

Proposed version

4.8a Where a claim for an apparatus seeks to define the invention by reference to features of the use to which the apparatus is to be put, a lack of clarity can result. For example, a claim reading "A box for storing magnetic tape cassettes on end, characterised in that the stored cassettes project beyond the upper edges of the box to facilitate removal" is unclear since, though directed to a box, it defines not a box per se but its relationship to cassettes. Such a claim must either make clear the size of the box, if desired by defining the size of the cassettes, or must be directed to a combination of box and cassettes, e.g. "A storage box containing magnetic tape cassettes on end...".

Chapter III.6.6

ad Chapter III-6.6:

The object of the new paragraph is to create a basis for a procedure which is apparently already practice; namely to allow amendments of the description so that it includes subject-matter which was originally only disclosed in a claim.

The opinion that the proposal would not comply with Article 6 PCT (the claims shall be fully supported by the description) cannot be shared by the EPO, since such an interpretation of Article 6 appears too narrow and would furthermore lead to unacceptable results.

Take for instance an application where the description includes a repetition of the claims but one feature has erroneously been omitted. Based on the afore-mentioned narrow interpretation such a claim would not be allowed since it is not supported. On the other hand, a deletion of the said feature from the claim (to make it consistent with the description) could easily result in an unacceptable claim broadening and finally to a rejection of the entire application.

Compare also cases where features in the claim (dependent claims) are only derivable from the drawing not however explicitly specified in the description.

These examples are believed to show that not the narrow interpretation but rather the one set out in the proposal was intended with Article 6.

Present version

Proposed version

6.6 Where subject-matter is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention (see II.4.6).

Chapter IV.2.4b

ad Chapter IV-2.4(b):

The object of the amendment is to give a more complete indication of what is to be understood by "microbiological process or the products thereof". When further considering the increasing number of applications in this specific field the extended explanation appears even more important.

While the first paragraph of the proposal appeared to be acceptable by the meeting this was not immediately the case for the second paragraph.

The second paragraph deals with the specific problem of repeatability and is in the opinion of the EPO only a logical and preferred complement to the first paragraph.

With respect to the proposed reference to Chapter II.4.11, dealing with reproducible results, a corresponding cross-reference in II.4.11 would also seem appropriate.

Present version

(b) Plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes. The question whether a process is "essentially biological" is one of degree depending on the extent to which there is technical intervention by man in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would not be excluded. For example, a method of selectively breeding horses involving merely selecting for breeding and bringing together those animals having certain characteristics would be essentially biological. However, a method of pruning a tree would not be essentially biological since, although a biological process is involved, the essence of the claimed invention is technical; the same could apply to a method of treating a plant characterised by the application of a growth-stimulating substance or radiation.

The exclusion referred to above does not apply to microbiological processes or the products thereof. International preliminary examination should be conducted not only for processes involving microorganisms, but also for microorganisms themselves (as well as inanimate products) when produced by a microbiological process.

Proposed version

After "radiation" in line 13 (34) replace the following sentences by:

The treatment of soil by technical means to suppress or promote the growth of plants is also not excluded. The exclusion referred to above does not apply to microbiological processes or the products thereof. The term "microbiological process" is to be interpreted as covering not only industrial processes using microorganisms but also processes for producing microorganisms, e.g. by genetic engineering. The product of a microbiological process may also be subject to an international preliminary examination (product claim). Propagation of the microorganism itself is to be construed as a microbiological process for the purposes of Rule 67.1(ii); consequently, the microorganism can be protected per se as it is a product obtained by a microbiological process. The term micro-organism covers plasmids and viruses also.

In the case of microbiological processes, particular regard should be had to the requirement of repeatability referred to in II.4.1.1. As for microorganisms deposited under the terms of Rule 13 bis repeatability is assured by the possibility of taking samples and there is thus no need to indicate another process for the production of the micro-organism.

ad Chapter IV-7.1.2:

The object of the amendment, which is considerably extended compared with the present wording, is to give a guidance for arriving at a well-defined acceptable novelty concept. The proposal could thus lead to uniform and harmonised conditions when determining whether a claim is novel or not. This cannot be said about the present wording which is so general that it would cover even diverging interpretations.

Chapter IV.7.2

Present version

7.2 A document takes away the novelty of any subject-matter explicitly contained in the document

Proposed version

Replace by:

7.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the documents; this is a matter of obviousness.

ad Chapter IV-7.3:
Chapter IV.7.3

The observations set out with respect to Chapter IV.7.32 are fully acceptable.

Regarding the main object of the proposal is to establish a harmonised procedure.

Present version

7.3 A prior document should be construed only in the light of knowledge available at the time the document was published and excluding any knowledge subsequently discovered (see Chapter IV, paragraph 8.3).

Proposed version

Replace by:

7.3 In determining novelty, a prior document should be read as it would have been read by a person skilled in the art on the effective date of the document. By "effective" date is meant the publication date in the case of a previously published document.

However, it should be noted that a chemical compound, the name or formula of which was mentioned in a document, is not considered as known unless the information in the document, together, where appropriate, with knowledge generally available on the effective date of the document, enable it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.

ad Chapter IV-8.6:

The object of the addition is to clarify the meaning of "the skilled person in the art", and thus arrive at a harmonised procedure (cf. also the two preceding proposals).

The present version is silent as to the significance of "in the art".

The proposal tries to explain that under certain circumstances the person skilled in the art is not necessarily the specialist in the field to which the invention directly belongs, but could also be the specialist of a related technical field.

This difference is important and possibly decisive when addressing inventive step.

While this interpretation is not excluded by the present version a positive statement to this effect seems suitable.

Chapter IV.8.6

Present version

8.6 The person skilled in the art should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything in the "prior art", in particular, the documents cited in the international search report, and to have had at his disposal the normal means and capacity for routine experimentation.

There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, than a single person. This may apply, e.g. in certain advanced technologies such as computers or telephone systems and in highly specialised processes such as the commercial production of integrated circuits or of complex chemical substances.

Proposed version

Add after "experimentation" in line 5 (14):

If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability.



**Australian
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A. Schäfers
Deputy Director General
WIPO
34 Chemin des Colombettes
1211 Geneva 20
SWITZERLAND

Dear Mr. A. Schäfers,

**SUBJECT : REVISION OF THE PCT PRELIMINARY EXAMINATION GUIDELINES and
REVISED PROPOSALS OF THE EUROPEAN PATENT OFFICE RELATING TO
THE REVISION OF CHAPTER II PCT EXAMINATION GUIDELINES.**

Thank you for your circular C.PCT 399/211 of November 29, 1990 on
this subject asking me for my comments.

REVISION OF GUIDELINES

- CHAPTER III. paragraph 4.5** - The last sentence in this paragraph should be removed in view of the new paragraph 4.5b.
- CHAPTER VI. paragraph 4.10** - If "whichever time limit expires later" is inserted between "date" and ")" in line 12, I think the time limit referred to would be more clearly defined.
- CHAPTER VII. paragraph 8.2** - The time limit in this paragraph is too short.
With a new PCT application, the IB allows, generally, about one month from the date of receipt to dispatch the record copy to the IB (see PCT rule 22).
I feel that the time limit for the demand could be similar.

Wien, am 26. März 1991
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Mr. A. Schäfers
Deputy Director General
WIPO

34, Chemin des Colombettes
CH-1211 Genève 20

Re: Circular PCT 399

Dear Mr. Schäfers,

I have the honor to inform you that the Austrian Patent Office fairly agrees with the draft revision of the 'Guidelines for International Preliminary Examination' as contained in document PCT/GI/3 Prov.. Furthermore we have no objections against the proposal of the European Patent Office which is enclosed to said circular as an appendix.

Sincerely yours,

F. Sothé
Presidential Department II
Austrian Patent Office



REVISED EPO PROPOSAL

We agree with the EPO proposal.

Yours sincerely,

Geoff Baker
A/Deputy Commissioner
22 March, 1991

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Date 4 April 1991

Dear Mr Bartels

DRAFT REVISION OF PCT PRELIMINARY EXAMINATION GUIDELINES

I attach, as an annex prepared by Peter Eggington, comments on the revised Guidelines and on the EPO proposals. I regret I have just missed the date of 1 April 1991 given by A Schäfers in his letter of 29 November 1990.

Yours sincerely

B G HARDEN
Head of Legal Division
Patents Branch

A: Draft Revision.

1. Certain amendments made as a result of proposals from the EPO use wording more appropriate to national/regional examination practice since it suggests that the applicant can require amendment whereas the reality is that the applicant is not obliged to make any amendment in the international phase. It was agreed at the meeting of International Authorities under the PCT (15-19 January, 1990) that such wording should be modified but time did not allow details to be agreed. At one point (III, 4.5a), the proposed wording does not seem clear. The following modifications are suggested:-

II, 4.4, line 9: replace "should be required" by "should be invited"
line 14: replace "should require" by "should invite the inclusion of".

II, 4.6, line 14: replace "should not insist on" by "should not require".

II, 4.8, last sentence: replace by "The reverse situation ought not to occur. i.e., all reference numbers or signs used in the description or claims ought also to appear on the drawings."

III, 2.3a, last line: replace "should not be insisted on." by "need not be required."

III, 4.5a, last sentence: replace by "However, objection should be raised if such words as "about" prevent the invention from being unambiguously distinguished from the prior art with respect to novelty and inventive step."

IV, 2.4 (f), line 8: replace "should not be examined" by "need not be examined".

IV, 2.5, line 13: replace "surgery should not" by "surgery need not",
line 20: after "excluded" insert "from examination".
last line: to read "cosmetic surgery may thus be excluded from examination."

VI, 7.9, line 3: replace "unallowable" by "objectionable".

2. Certain amendments agreed at the meeting as a result of objections from delegates do not appear to have been made. These are:-

II, 4.6: delete from "To meet...."(line 3) to "sufficient." (line 10).
line 11 "paragraph 4.8(i)" should read "paragraph 8.4(i)"

VI, 7.12a: delete "(for example, the advantage mentioned in paragraph 7.12 of this Chapter)".

However, apart from the correction of the paragraph number in II, 4.6, the UK does not have strong feelings about these amendments and if other offices raise no objection we do not require the deletions.

The amendment made to III, 4.8 is not that originally put forward in PCT/MIA/1/4, page 21, column 19. This seems to be an error in transcription (cf. paragraph 4.9).

3. The section dealing with lack of unity of invention (VI, 5.5-5.9) will require reconsideration in the light of amendments to Rules 66, 68 and 70. It may also be necessary to look again at the sections in Chapter VI which deal with completing the forms if the forms are to be changed; these sections may also require some augmentation. Alternatively a separate section on completing the written opinion and IPE report forms may be desirable with examples of completed forms.

4. Minor matters. Some amendment indication lines have been omitted at II, 4.8 (lines 7-9); II, 4.14a; VI, 3.1 (line 16) (there may be others) and a parenthesis closure has been omitted at IV, 1.2a (i) after "application".

B: EPO proposals.

1. II, 4.17. The only objection to this proposal is that it deletes some matter which is considered useful. It is therefore suggested that the "proposed version" should replace lines 1-4. "References.....art." only and not lines 1-14. It is also suggested that in the final sentence of the proposed version, the wording "matter should be incorporated" be changed to "matter ought to be incorporated". The word "if" has been omitted from before "it is to be taken into account".

2. III, 4.7(b). The UK cannot agree to this proposal since we construe the wording "when obtained by process" as limiting and introducing novelty even if the compound per se is known. The proposal is therefore one based on EPO practice and not applicable in the international phase. Moreover we cannot agree with any proposal which gives apparent authority to the examiner suggesting a particular form of wording.

3. III, 4.8a. While we can agree with the general principal underlying this proposal, the illustration used does not seem particularly good. A box for storing cassettes will be made and sold for storing a particular type of cassette which will be of standard size but there is no justification in requiring the applicant to limit his invention to one particular size of cassette since the invention can apply to any size of cassette. In these circumstances, merely using common sense



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March, 26, 1991

MR. A. Schäfers
Deputy Director General
World Intellectual Property Organization

Dear, Mr. A. Schäfers

I refer to your circular C.399/PCT 211 of 29 November 1990, requesting observations on the draft revised Guidelines (PCT/GL/3 Prov) and on the proposals of the EPO.

Our comments and proposed changes to these documents are attached.

With best regards.

Yours sincerely,

Kazuhiko Otsuka

Director General
First Examination
Department
Japanese Patent Office

and reading the words "for storing" as meaning "adapted for storing", the wording which the EPO maintain is not clear is considered by us to be eminently clear and we would suggest that any competent court would have no difficulty in deciding whether a particular box infringed such a claim or not. We also feel that a warning could be included that such limitations may not provide an effective novelty limitation. We therefore recommend adding after the first sentence "Care should also be taken to ensure that any such definition provides an effective limitation over prior art which may have a similar feature for a different purpose.". While we do not feel particularly strongly about the illustration used we could suggest the following alternative: "For example a claim reading "A bag having incorporated therein a pocket suitable for the insertion of an umbrella" is unclear since not only will the size and shape of the pocket depend on the umbrella but also the nature of some bags, eg a ladies handbag, may be such as to preclude the possibility of inserting an umbrella. Moreover such a bag may lack novelty over a bag containing a pocket designed to hold a quite different article. A pocket to hold a ladies handbag in a shopping bag might be of a sufficient size, even if a different shape, to accommodate an umbrella. Such a claim must either define the size and shape of the pocket or be directed to a combination of bag and umbrella".

4. III, 6.6. The UK does not encourage mere reference in the description to a claim as a basis for that claim and therefore we would prefer to see the second sentence of this proposal omitted.

5. IV, 2.4(b). The final section of the proposal "In the case of microbiological....micro-organisms" has no place in this paragraph since it has no relevance to Rule 67. It should be omitted. Otherwise we have no objection to this proposal.

6. IV, 7.2. We must object to the reference to "implicit" disclosure. Lack of novelty can only arise from an explicit disclosure. This and the particular illustration used do not accord with the final sentence of the proposal. While rubber may partially destroy novelty of elastic material generally it cannot destroy novelty as regards other specific elastic materials. We would therefore propose the omission of the wording "including any features implicit.....elastic material".

7. IV, 7.3. No comment.

8. IV, 8.6. No comment.

The JPO makes following comments on the draft proposed by International Bureau.

Following are the JPO's comments on the draft proposed by EPO

Chapter II

Chapter III

- 4.6 Disclosure of invention
The JPO proposes to delete the 3rd and 4th sentences.
Reason: Even if the subject matter of a dependant claim can be understood by the wording of the claim itself, it must be supported by the description.
(PCT Article 6)

- 6.6 The JPO proposes to delete the 2nd sentence.
Reason: Even if the subject matter of a dependant claim can be understood by the wording of the claim itself, it must be supported by the description.
(PCT Article 6)

Chapter III

Chapter IV

- 4.8 As it is found that the 6th sentence in 4.8 overlaps the 3rd sentence in 4.9, the JPO proposes to delete either one.
Chapter VII
3.2 Article 31(2) check
Not agreed (however, if the proposed amendment of R 54.2 is adopted by the PCT Assembly in the coming July, the proposed paragraph 3.2 will be just acceptable.)
Reason: The person entitled to make a demand under this paragraph includes persons other than the persons entitled to make such demand, as prescribed in A 31(2)(a) (i.e., a resident or national of a Contracting State bound by Chapter II and whose international application has been filed with the receiving Office of or acting for such State.).

- 7.2 The JPO proposes to delete the 2nd and 3rd sentences.
Reason: When considering novelty, a document must be interpreted to embrace equivalents of matters which are disclosed in the document, where it is well-known to a person skilled in the art that those are equivalent.
7.3 The JPO proposes to delete the 2nd sentence.
Reason: Where a chemical compound is described in a document and it is obvious that the compound exists, the document evidences the lack of novelty, even if the information in the document does not enable it to be prepared and separated.
In the international preliminary examination report, all documents which are useful for Elected Offices must be cited.

- 3.4 Article 31(2) check

Not agreed.
Reason: This is on the condition that the above requirements of the paragraph, with which the JPO does not agree, are fulfilled.

- 15.5 Invitation to correct
Proposed to be modified
(Form PCT/IPEA/407) should be inserted after "the International Bureau" and not after "the applicant" in the first sentence.
Reason: Since the same form as the communication to be sent to the applicant (Form PCT/IPEA/407) is used for the communication to the International Bureau too, the provisions should be made to that effect.

- 16.3 R57.4 and 5 and 58.2 check (lack of payment of fees)
Not agreed (however, if the proposed amendment of R 54.2 is adopted by the PCT Assembly in the coming July, the proposed paragraph 16.3 will not be necessary.).

Reason: The paragraph is contradictory to R 57.4(c) (wherein it is prescribed that, in case of failure to pay the handling fee, the demand shall be considered as if it had not been submitted.).

- 18.3 Use of telegraph, teleprinter, etc.
- Form PCT/IPEA/407 -
Reason: It is proposed that the form (Form PCT/IPEA/407) used when the demand is considered as if it had not been submitted under R 60.1(c), should also be used in a case as in this paragraph.



1991-04-08

World Intellectual Property Organization
B. Bartels
Director
PCT Legal Division

Dear Mr. Bartels

Re: Response to Circulars PCT 399 and PCT 402

I would like to inform you that the Swedish Patent Office in its capacity as an International Preliminary Examining Authority

- i) has no objections to the Draft Revision of Guidelines for International Examination, PCT/GL/3 Prov. ii) can support the revised proposals of the European Patent Office relating to the revision of Chapter II PCT Examination Guidelines as set forth in Appendix to circular C. PCT 399.

Further I would also inform you that the Swedish Patent Office in its capacity as an International Searching Authority under PCT supports the proposal made by the EPO in Annex to circular C. PCT 402 of December 3, 1990.

Jan- Eric Bodin
Jan- Eric Bodin

910408.PCT



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

November 1, 1991

Dr. Arpad Bogsch
Director General
World Intellectual Property Organization
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Dear Dr. Bogsch:

This is in response to your letter of October 1, 1991, to Commissioner Manbeck regarding some PCT matters. In your letter you note that this Office had promised to furnish filled-in samples of an international preliminary examination report and that this Office had not responded to two PCT circular letters, Nos. 399 and 402.

Enclosed are samples of International preliminary examination reports, as filled-in by our PCT International Division.

As to PCT Circular No. 399 and the revised International Preliminary Examination Guidelines, the PCT International Division believes that the Guidelines should also speak to (i) the responsibility of an IPEA with respect to the examination of an invention searched by a different ISA where the invention would not be examined by the IPEA per Rule 67.1, (ii) the fact that a Demand filed later than 19 months from the priority date will be subjected to a preliminary examination but that the time for national stage entry is not extended to 30 months, (iii) the question of extensions of time to respond to a written opinion and informalities in the Demand, and (iv) what should be done with amendments received in response to the International preliminary examination report. The PCT International Division is studying the proposal of the European Patent Office (EPO) and comments on it will be offered in the near future.

In regard to PCT Circular No. 402, the PCT International Division finds the models of international search reports offered by the EPO to be generally acceptable but is further reviewing the language of the "Use of category symbols" paper accompanying the forms.

Sincerely,

Michael K. Kirk
Michael K. Kirk
Assistant Commissioner
for External Affairs

Enclosures

PATENT COOPERATION TREATY
INTERNATIONAL PRELIMINARY EXAMINATION REPORT

IDENTIFICATION OF THE INTERNATIONAL APPLICATION		Applicant's or Agent's File Reference
International Application No.	PCT/US87/00888	QC 123
Receiving Office	RO/US	International Filing Date
Applicant (Name)	COLUMBIA MARINE CORPORATION	Priority Date Claimed
		06 JULY 1987 (06.07.87)
		15 JULY 1986 (15.07.86)

1. AMENDMENTS AND/OR RECTIFICATIONS¹ - The amendments and/or rectifications made before the International Preliminary Examining Authority in relation to the claims, the description, or drawings in the above-identified international application are set forth in this report.

a. This report has been established on the basis of the following application documents:

<input type="checkbox"/> the application documents as filed	as originally filed
<input checked="" type="checkbox"/> description, pages 1-20	filed with your letter of _____
description, pages _____	filed with your letter of _____
description, pages _____	filed with your letter of _____
<input checked="" type="checkbox"/> claim(s) 4 and 5	as originally filed
claim(s) 9 and 10	filed with your letter of 15 FEBRUARY 1988
claim(s) 11 - 13	filed with your letter of 14 AUGUST 1988
claim(s) _____	filed with your letter of _____
<input checked="" type="checkbox"/> drawings, sheet(s) 1-4	as originally filed
drawings, sheet(s) _____	filed with your letter of _____

b. The amendments included in the amendment of the following sheets: PAGES 21 and 22

c. This report has been established on the basis of the amendments indicated on the same sheet from not been made, when, for the reasons indicated, they have been considered to go beyond the disclosures as filed.

2. PRIORITY²

a. This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:

- copy of the earlier application whose priority has been claimed.
- translation of the earlier application whose priority has been claimed.
- This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid.

Thus, for the purpose of this report, the international filing date indicated above is considered to be the relevant date.

¹Where amendments are announced in this report, a translation of those amendments should be furnished to the elected Office within the time limit applicable under PCT Article 80(1).

Form PCT/IPEA/annex (first sheet) (January 1988)

Page 2
PCT/US87/88888

3. UNITY OF INVENTION³ - The international application does not comply with the requirements of unity of invention.

a. In response to an invitation to modify or pay additional fees the applicant has:

- rejected the claims.
- paid additional fees.
- paid additional fees under protest. Where requested by the applicant, the text of the protest together with the decision when the protest is announced in this report.
- neither rejected nor paid additional fees.

b. No invitation has been issued. The applicant of this International Preliminary Examining Authority is that the international application does not comply with the requirements of unity of invention for the following reasons: (specify)

Consequently, the following parts of the international application were the subject of international preliminary examination in establishing the report:

- all parts.
- the parts relating to the rejected claims, and to claims Nos. _____.
- the parts relating to the main invention, that is claims Nos. 4, 5 and 9 to 13.

4. NON ESTABLISHMENT OF REPORT ON QUESTIONS OF NOVELTY, INVENTIVE STEP OR INDUSTRIAL APPLICABILITY⁴

The question of whether the claimed invention appears to be novel, to involve an inventive step or to be industrially applicable have not for the reasons indicated been given this in respect of:

- a. the entire international application
- b. claims Nos. _____ for the following reasons: _____
- said international application, or said claims Nos. _____ relate to the following subject matter which does not require an international preliminary examination: (specify)

- The description, claims, or drawings (specify particular elements) or said claims Nos. _____ are so unclear that no meaningful opinion could be formed.
- The claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed.
- Said claims Nos. _____ are dependent claims and are not defined in accordance with the second and third sentences of PCT Rule 8.4(a).

CLASSIFICATION OF SUBJECT MATTER (If several classifications apply, indicate all) According to International Patent Classification (IPC) or to both International Classification and IPC	
IPC(5) B 63 H 25/02 // B 63 H 25/04 U.S. CI 114/144C	
RELATIONS BETWEEN AS TO CLASS NUMBER, SERIAL OR PRIORITY OR INVENTIVE STEP (N) AND INDUSTRIAL APPLICABILITY AND CITATIONS / AND EXPLANATIONS / SUPPORTING EACH STATEMENT	
CLAIM NUMBER	STATEMENT (CRITERIA)
4, 5, 9, 10	<p>CITATIONS AND EXPLANATIONS</p> <p>Claims 4, 5, 9 and 10 meet the criteria of PCT Article 33(1) because the combination claimed consisting of a sailboat with a rudder positioned forward of the keel and a wind controlled vane electronically connecting the forward rudder and the wind vane to maintain course direction within 2 degrees of the desired course is not shown in the prior art.</p> <p>NEW CITATION US, A, 1,846,450 ROBINSON, 23 FEBRUARY 1932, (23.02.32) (See figures 2 and 4)</p>
11-13	<p>Claims 11-13 lack an inventive step under PCT Article 33(3) as being obvious over DAV in view of ROBINSON. To control the forward rudder of DAV with a wind vane located at the opposite end of the sailboat as in ROBINSON would not involve an inventive step.</p>

NON-PATENT DOCUMENTS *	
Date of Non-Written Disclosure	Date of Non-Written Disclosure
Date of Written Disclosure relating to the Non-Written Disclosure	Date of Non-Written Disclosure
CERTAIN PUBLISHED DOCUMENTS **	
Applicant/Patent	Priority Date (Valid Claim)
Date of Publication	Filing Date
CERTAIN DOCUMENTS ON THE INTERNATIONAL APPLICATION ***	
The following articles in the form or contents of the international application have been read: Page 5, line 8, "victor" should be "vector". In figure 2 of the drawings, the lead line for reference numeral 6 should be directed to the tiller rather than the boom.	
CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION **	
The following observations on the priority of the claims, description, and drawings or on the question whether the claims are fully supported by the description have been read:	
CERTIFICATION	
Date Claim Submitted	Date of Completion of the International Preliminary Examination Report
10 FEBRUARY 1988 (10.02.88)	10 OCTOBER 1988 (10.10.88)
International Preliminary Examining Authority	Signature of Authorized Officer
IEPA/US	STEPHEN DECATUR-Primary Examiner

STATUS OF INVENTION (Continued)

3. UNITY OF INVENTION* - The International application does not comply with the requirement of unity of invention.

a. In response to an invitation to amend or pay additional fees the applicant has:

- amended the claims.
- paid additional fees.
- paid additional fees under protest. Where requested by the applicant, the text of the protest together with the decision taken thereon are annexed to this report.
- neither amended nor paid additional fees.
- No invitation has been issued. The opinion of the International Preliminary Examining Authority is that the International application does not comply with the requirement of unity of invention for the following reasons, (specify)

b. Consequently, the following parts of the International application were the subject of International preliminary examination in finalizing the report:

- all parts.
- the parts relating to the restricted claims, that is claims Nos. _____
- the parts relating to the main invention, that is claims Nos. _____

4. NON-ESTABLISHMENT OF REPORT ON QUESTIONS OF NOVELTY, INVENTIVE STEP OR INDUSTRIAL APPLICABILITY*

The opinion of whether the claimed invention appears to be novel, to involve an inventive step or to be industrially applicable have not for the reasons indicated been given in respect of:

- a. the entire International application
- b. claims Nos. _____
for the following reasons:
 Said International applications, or said claims Nos. _____ relate to the following subject matter which does not require an International preliminary examination, (specify)

- The description, claims, or drawings (indicate particular drawings) of said claims Nos. _____ are an unclear and/or meaningless opinion could be formed.
- The claims, or said claims Nos. _____ are an inadequately supported by the description that no meaningful opinion could be formed.
- Said claims Nos. _____ are dependent claims and are not drafted in accordance with the second and third sentences of PCT Rule 6.7(b).

Form PCT/MIA/II/3 (January 1989) See note on accompanying sheet

Applicant or Agent's File Reference
PCT-426B

IDENTIFICATION OF THE INTERNATIONAL APPLICATION

International Application No. **PCT/US89/99999**
International Filing Date **18 DECEMBER 1989 (18.12.89)**
Priority Date Claimed **14 DECEMBER 1988 (14.12.88)**

Receiving Office **RO/US**

Applicant (Name) **AJAX FOUNDRY CORPORATION**

BASE OF REPORT

1. AMENDMENTS AND/OR RECTIFICATIONS* - The amendments and/or rectifications made below the International Preliminary Examining Authority in respect of the claims, the description, and/or drawings in the above-identified International application are annexed to this report.

a. This report has been established on the basis of the following application documents:

<input type="checkbox"/> the application documents as filed	as originally filed	18 DECEMBER 1989
<input checked="" type="checkbox"/> description, pages 1-16	filed with your letter of	16 JUNE 1990
description, pages 17-18	filed with your letter of	_____
description, pages 4-11	filed with your letter of	29 JANUARY 1991
claim(s) 1/1-2	filed with your letter of	_____
claim(s) 1/1-2	filed with your letter of	18 DECEMBER 1989
drawings, sheets 1/1-2	filed with your letter of	_____
drawings, sheets 1/1-2	filed with your letter of	18 DECEMBER 1989

b. The amendments related to the consolidation of the following sheets: _____

c. This report has been established as if the amendments indicated on the same sheet have not been made, since, for the reasons indicated, they have been considered to go beyond the disclosure as filed.

2. PRIORITY*

a. This report has been established as if no priority has been claimed due to the failure to furnish within the prescribed time limit the requested copy of the earlier application whose priority has been claimed.

b. The priority of the earlier application whose validity has been established.

c. This report has been established as if no priority has been claimed due to the fact that the priority claim has been found invalid.

Thus, for the purpose of this report, the International filing date indicated above is considered to be the relevant date.

* Where requirement sheets are annexed to this report, a translation of these requirement sheets must be furnished to the relevant Office within the time limit applicable under PCT Article 36(1).

Form PCT/MIA/II/3 (January 1989) See note on accompanying sheet

CLASSIFICATION OF SUBJECT MATTER (if several classifications apply, indicate all) According to International Patent Classification (IPC) or in both National Classification and IPC IPC(5) B23K 5/12 U.S. Cl. 228/100	
REASONED STATEMENT AS TO CLAIMS MEETING CRITERIA OF INVENTIVITY OR INVENTIVE STEP (A) AND INDUSTRIAL APPLICABILITY AND CLARITY AND SUPPORTING EACH STATEMENT	
CLAIM NUMBER	STATEMENT CRITERIA
4-11	NO(W) NO(IS)
4-11	YES(IA)
CITATIONS AND EXPLANATIONS	
<p>Claims 4-11 appear to lack novelty or an inventive step in view of the prior art citation to Smith. Each of the claimed features are either clearly shown by Smith or obvious in view of the suggestion by Smith that the use of equivalent materials for valding is common practice. With regard to claims 6 and 9, note the observation below.</p> <p>The claims (insofar as claims 6 and 9 are understood) satisfy the criteria of article 31(4).</p>	

Form PCT/US89/99999 (January 1989)

INVENTOR INFORMATION (SEE P. 1)		Date of National Classification (indicate in the National Classification)		Date of International Classification	
Name of Inventor (Indicate)	Address of Inventor (Indicate)	Date of Publication	Filing Date	Priority Date (Valid Claim)	Priority Date (Valid Claim)
CERTAIN PUBLISHED DOCUMENTS*					
CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION**					
The following defects in the form or contents of the International application have been noted:					
<p>CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION**</p> <p>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 have been noted:</p> <p>Claim 9 is improperly dependent on two multiple dependent claims, note PCT Rule 6.4(g).</p> <p>With regard to claim 6, the cooperation of elements 14 and 36 is not clear and it is not described in the description, note PCT Article 6.</p>					
CERTIFICATION					
Date Examined Submitted	16 JULY 1990 (16.07.90)	Date of Completion of the International Preliminary Examination Report	12 MARCH 1991 (12.03.91)		
International Preliminary Examining Authority	EP/EA/US	Signature of Authorized Officer	THOMAS REYNOLDS/C.D. 10-30-91		

Form PCT/US89/99999 (January 1989)