

WIPO



PCT/MIA/II/4
ORIGINAL: English
DATE: January 27, 1992

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

DRAFT OF PROPOSED MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS
OF INTEREST TO THE INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITIES

prepared by the International Bureau

1. Attached is a draft of Parts 5 and 6 of the Administrative Instructions relating to the International Searching Authorities and the International Preliminary Examining Authorities, respectively, as well as a draft of new Annex H (Instructions Concerning Unity of Invention) and of new Annex I (Format for Nucleotide and/or Amino Acid Sequences in Machine Readable Form). These drafts are being forwarded prior to the completion of the drafts of the other Parts of the Administrative Instructions for a review at the Meeting of the International Authorities under the PCT and for the consultations required under Rule 89. 2 (a).
2. Proposed deletions to the Administrative Instructions are indicated between brackets and are also struck-through. Proposed additions are indicated by underlining. Lines in the margin indicate that a proposed change exists in that line. Comments indicating the reasons for a proposed change or that there is no proposed change are indicated between angle brackets. These comments will not be part of the Administrative Instructions when promulgated but are added in this document for information.
3. It is understood that the Sections of the Administrative Instructions may be reordered and renumbered before final promulgation.

[Proposed Parts 5 and 6 and Annexes H and I
of the Administrative Instructions follow]

DRAFT
ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

TABLE OF CONTENTS

Part 1: Instructions Relating to General Matters (Not included)

Part 2: Instructions Relating to the International Application (Not included)

Part 3: Instructions Relating to the Receiving Office (Not included)

Part 4: Instructions Relating to the International Bureau (Not included)

Part 5: Instructions Relating to the International Searching Authority

Section 501	Corrections Submitted to the International Searching Authority Concerning Expressions, etc., Not To Be Used in the International Application
Section 502	Protest Against Payment of Additional Fee <u>for Searching an Additional Invention</u> and Decision Thereon
Section 503	Method of Identifying Documents Cited in the International Search Report
Section 504	Classification of the Subject Matter of the International Application
Section 505	Indication of Citations of Particular Relevance in the International Search Report
Section 506	Comments on Draft Translation of the International Application
Section 507	Manner of Indicating Certain Special Categories of Documents Cited in the International Search Report
Section 508	Manner of Indicating the Claims to Which the Documents Cited in the International Search Report Are Relevant
Section 509	Procedure Where Information Is Received <u>That an Invitation to Pay the Search Fee under Rule 16bis Has Been Sent to the Applicant</u> under Section 320(b)}
Section 510	Refund of Search Fee in Case of Withdrawal <u>of International Application</u>
Section 511	Rectifications <u>of Obvious Errors</u> under Rule 91.1
Section 512	<u>Notifications Concerning Representation</u>
Section 513	<u>Sequence Listings in Machine Readable Form</u>
Section 514	<u>Authorized Officer</u>
Section 515	<u>Amendment of Established Abstract in Response to Applicant's Comments</u>

Part 6: Instructions Relating to the International Preliminary Examining Authority

Section 601	<u>Notice to Applicant of Filing of Demand After the Expiration of 19 Months From the Priority Date [Deleted]</u>
Section 602	<u>Processing of Amendments by the International Preliminary Examining Authority [under Rule 66.8(a)]</u>
Section 603	<u>Transmittal of Protest Against Payment of Additional Fee for Examining an Additional Invention and Decision Thereon</u>
Section 604	<u>Guidelines for Explanations Contained in the International Preliminary Examination Report</u>
Section 605	<u>File To Be Used for International Preliminary Examination</u>
Section 606	<u>Cancellation of Elections</u>
<u>Section 606bis</u>	<u>Procedure in Case of an Election of a State Considered Not to Have Been Made</u>
Section 607	<u>Rectifications of Obvious Errors under Rule 91.1</u>
<u>Section 608</u>	<u>Notifications Concerning Representation</u>
<u>Section 609</u>	<u>Withdrawal by Applicant under Rules 90bis.1, 90bis.2 or 90bis.3</u>
<u>Section 610</u>	<u>Sequence Listings in Machine Readable Form</u>
<u>Section 611</u>	<u>Method of Identification of Documents in the International Preliminary Examination Report</u>
<u>Section 612</u>	<u>Authorized Officer</u>
<u>Section 613</u>	<u>Invitation for Refund of Fees under Rule 57.6 or 58.3</u>

Annex A: Names of States, Territories and Intergovernmental Organizations (Not included)

Annex B: Code for Identifying States, Territories and Intergovernmental Organizations (Not included)

Annex C: [Deleted]

Annex D: Information from Pamphlet Front Page To Be Included in the Gazette under Rule 86.1(i) (Not included)

Annex E: Information To Be Published in the Gazette under Rule 86.1(v) (Not included)

Annex F: Forms (Not included)

Annex G: Format for Computer Generated Forms (Not included)

Annex H: Instructions Concerning Unity of Invention

Annex I: Format for Nucleotide and/or Amino Acid Sequences in Machine Readable Form

INDEX (Not included)

PART 5

**INSTRUCTIONS RELATING TO THE
INTERNATIONAL SEARCHING AUTHORITY**

Section 501

**Corrections Submitted to the International Searching Authority Concerning Expressions, etc.,
Not To Be Used in the International Application**

Where the applicant submits corrections to the International Searching Authority aimed at complying with ~~[the prescription of]~~ Rule 9.1, Section 511 shall apply *mutatis mutandis* ~~[that Authority shall transmit copies of such corrections to the receiving Office and the International Bureau].~~

<Wording added to clarify in this Section the manner of the procedure for corrections.>

Section 502

Protest Against Payment of Additional Fee for Searching an Additional Invention and Decision Thereon

The International Searching Authority shall transmit to the applicant, preferably at the latest together with the international search report, any decision which it has taken under Rule 40.2(c) on the protest of the applicant against the payment of the additional fee for searching an additional invention. At the same time, it shall transmit to the International Bureau a copy of both the protest and the decision thereon, as well as any request by the applicant to forward the texts of both the protest and the decision thereon to any of the designated Offices.

<Amended to take into account situation where the decision on protest cannot be taken before the transmittal of the search report and to clearly indicate type of additional fee referred to.>

Section 503

Method of Identifying Documents Cited in the International Search Report

Identification of any document cited in the international search report referred to in Rule 43.5(b) shall be made by indicating the following elements in the order in which they are listed:

(a) In the case of a [any] patent document (patent documents being patents within the meaning of Article 2(ii) as well as published applications relating thereto):

(i) the Office that issued the document, by the two-letter code as in Annex B;

(ii) the kind of document, by the appropriate symbols as in the WIPO Standard ST.16, Recommendation for the Inclusion of References Cited in [Code for Identification of Different Kinds of] Patent Documents as indicated on the original document, or if not indicated on that document, as provided in Standard ST. 16.*

(iii) the number of the document as given to it by the Office that issued it (for Japanese patent documents the indication of the year of the reign of the Emperor must precede the serial number of the patent document);

(iv) the name of the patentee or applicant (in capital letters, where appropriate abbreviated);

(v) the date of publication of the cited patent document as indicated thereon; and

* Published in WIPO Handbook on Industrial Property [Patent] Information and Documentation, Volume 1, Part 3, Standards-ST.16.

(vi) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

(The following example illustrates the citation of a patent document according to paragraph (a), above:

JP, B, 50-14535 (NCR CORPORATION) published 28 May 1975 (28.05.75), see column 4, lines 3 to 27.

(b) In the case of a a [~~any~~] book or other separately issued publication:

(i) the name of the author;

(ii) the title (including, where applicable, the number of the edition and/or volume);

(iii) the year of publication (when this coincides with the year of the international application or of the priority claim, the International Searching Authority shall endeavor to determine the month and, if necessary, the day of publication and to indicate these data in the international search report);

(iv) the name of the publisher (in the case of company publications, the name and postal address of the company);

(v) as far as available, the place of publication (where only the location of the publisher appears on the book or other separately issued publication, then that location shall be indicated as the place of publication); and

(vi) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

(The following example illustrates the citation of a book or other separately issued publication according to paragraph (b), above:

H. WALTON, "Microwave Quantum Theory," Volume 2, published 1973, by Sweet and Maxwell (London), see pages 138 to 192, especially pages 146 to 148.)

(c) In the case of an [~~any~~] article published in a periodical or other serial publication:

(i) the title of the periodical or other serial publication;

(ii) the number of the volume and the date of the issue in which the article appears;

(iii) as far as available, the place of publication (where only the location of the publisher appears in the periodical or other serial publication, then that location shall be indicated as the place of publication);

(iv) the author and the title of the article and the number of the page both on which the article starts and ends; and

(v) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

(The following example illustrates the citation of an article published in a periodical or other serial publication according to paragraph (c), above:

IBM Technical Disclosure Bulletin, Volume 17, No. 5, issued October 1974 (Armonk, New York), J.G. Drop, "Integrated Circuit Personalization at the Module Level," see pages 1344 and 1345.)

(d) In the case of an abstract[s]:

(i) the identification of the document containing the abstract in the manner set forth in paragraphs (a), (b) and (c), respectively, depending upon whether the abstract is contained in a patent document, in a book or other separately issued publication, or in an article published in a periodical or other serial publication;

(ii) in the case where the abstract is not published together with the full text document which served as its basis, the identification of both abstract and full text document on the basis of whatever bibliographic data may be available in respect thereof [~~thereto~~].

(The following example illustrates the citation of an abstract according to paragraph (d)(ii), above:

Chemical Abstracts, Volume 75, No. 20, issued 15 November 1971 (15.11.71) (Columbus, Ohio, USA, D.I. Shetulov, "Surface Effects During Metal Fatigue," see page 163, column 1, the abstract No. 120718k, Fiz.-Khim. Mekh. Mater. 1971, 7(2), 7-11 (Russ).)

<Proposed revision is to make Section more closely follow wording of current Standard ST.14.>

Section 504

Classification of the Subject Matter of the International Application

(a) Where the subject matter of the international application is such that classification thereof requires more than one classification symbol according to the principles to be followed in the application of the International Patent Classification to any given patent document, the international search report shall indicate all such symbols.

(b) Where any national classification system is used, the international search report may indicate all the applicable classification symbols also according to that system.

(c) Where the subject matter of the international application is classified both according to the International Patent Classification and to any national classification system, the international search report shall, wherever possible, indicate the corresponding symbols of both classifications opposite each other.

(d) The version of the International Patent Classification applicable at the time the international application is published under Article 21 shall be used whenever feasible.

<Reference added to use applicable version of International Patent Classifications.>

Section 505

Indication of Citations of Particular Relevance in the International Search Report

(a) Where any document cited in the international search report is of particular relevance, the special indication required by Rule 43.5(c) shall consist of the letter(s) "X" and/or "Y" placed next to the citation of the said document.

(b) Category "X" is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step.

(c) Category "Y" is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

<No Change.>

Section 506
Comments on Draft Translation of the International Application

(a) Where the applicant has made comments, within the time limits fixed by the International Searching Authority, on the draft translation prepared under the responsibility of the International Searching Authority referred to in Rule 48.3(b), that Authority shall notify the applicant whether it has changed the draft translation and, if so, of the changes it has made therein.

(b) Where the applicant submits comments on the draft translation prepared under the responsibility of the International Searching Authority after the expiration of the time limits fixed by the International Searching Authority, and that Authority changes the draft translation, it shall notify the applicant accordingly.

<Reference to preparation of translation by International Searching Authority added for clarity.>

Section 507
Manner of Indicating Certain Special Categories of Documents
Cited in the International Search Report

(a) Where any document cited in the international search report refers to an oral disclosure, use, exhibition, or other means referred to in Rule 33.1(b), the separate indication required by that Rule shall consist of the letter “O” placed next to the citation of the said document.

(b) Where any document cited in the international search report is a published application or patent as defined in Rule 33.1(c), the special mention required by that Rule shall consist of the letter “E” placed next to the citation of the said document.

(c) Where any document cited in the international search report is not considered to be of particular relevance requiring the use of categories “X” and/or “Y” as provided in Section 505 but defines the general state of the art, it shall be indicated by the letter “A” placed next to the citation of the said document.*

(d) Where any document cited in the international search report is a document whose publication date occurred earlier than the international filing date of the international application, but later than the priority date claimed in that application, it shall be indicated by the letter “P” next to the citation of the said document.

(e) Where any document cited in the international search report is a document whose publication date occurred after the filing date or the priority date of the international application and is not in conflict with the said application, but is cited for the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it shall be indicated by the letter “T” next to the citation of the document.

(f) Where in the international search report any document is cited for reasons other than those referred to in paragraphs (a) to (e), for example:

- a document which may throw doubt on a priority claim,**.
- a document cited to establish the publication date of another citation,***.

such document shall be indicated by the letter “L” next to the citation of the document and the reason for citing the document shall be given.

* (see III, 3.14 of the Guidelines for International Search to be Carried Out under the PCT).

** (see VI, 4.3 of the Guidelines for International Search to be Carried Out under the PCT).

*** (see VI, 6.2 of the Guidelines for International Search to be Carried Out under the PCT).

(g) Where a document is a member of a patent family****, it shall, whenever feasible, be mentioned in the international search report in addition to the one cited belonging as well to this family and should be preceded by the sign ampersand (&). Members of a patent family may also be mentioned on a separate sheet, provided that the family to which they belong shall be clearly identified and that any text matter on that sheet, if not in the English language, shall also be furnished to the International Bureau in English translation.

(h) A document whose contents have not been verified by the search examiner but are believed to be substantially identical with those of another document which the search examiner has inspected, may be cited in the international search report in the manner indicated for patent family members in the first sentence of paragraph (g)*****.

**** (see IV, 3.2 of the Guidelines for International Search to be Carried Out under the PCT).

***** (see VI, 5.2 of the Guidelines for International Search to be Carried Out under the PCT).

<Cross-reference added in paragraph (c) for clarifications

Section 508 Manner of Indicating the Claims to Which the Documents Cited in the International Search Report Are Relevant

(a) The claims to which cited documents are relevant shall be indicated by placing in the appropriate column of the international search report:

(i) where the cited document is relevant to one claim, the number of that claim; for example, (2) or (17);

(ii) where the cited document is relevant to two or more claims numbered in consecutive order, the number of the first and last claims of the series connected by a hyphen; for example, (1-15) or (2-3);

(iii) where the cited document is relevant to two or more claims that are not numbered in consecutive order, the number of each claim placed in ascending order and separated by a comma or commas; for example, (1,6) or (1,7,10);

(iv) where the cited document is relevant to more than one series of claims under (ii), above, or to claims of both categories (ii) and (iii), above, the series or individual claim numbers and series placed in ascending order using commas to separate the several series, or to separate the numbers of individual claims and each series of claims; for example, (1-6, 9-10, 12-15) or (1, 3-4, 6, 9-11).

(b) Where different categories apply to the same document cited in an international search report in respect of different claims or groups of claims, the category for each relevant claim or group of claims shall be listed separately opposite each indicated category of relevance.

(The following example illustrates the situation where a document is of particular relevance under Section 505(b) as to claims 1 to 3 and under Section 505(c) as to claim 4, and indicates the general state of the art under Section 507(c) as to claim 11 and 12:

<u>Category</u>	<u>GB,A 392,415, (JONES) published 18 May 1933 (18.05.33)</u>	<u>Relevant to Claim No.</u>
<u>X</u>	<u>See Fig.1</u>	<u>1-3</u>
<u>Y</u>	<u>Note page 3, lines 5-7</u>	<u>4</u>
<u>A.</u>	<u>Note Fig.5, support 36</u>	<u>11 and 12)</u>

<Paragraph (b) added for completeness.>

Section 509**Procedure Where Information Is Received That an Invitation to Pay the Search Fee under Rule 16bis Has Been Sent to the Applicant [~~under Section 320(b)~~]**

Where, notwithstanding Rule 23.1(a), the search copy has been transmitted to the International Searching Authority before the payment of the search fee, but the International Searching Authority has received information [~~under Section 320(b)~~] that an invitation to pay the search fee under Rule 16bis has been sent to the applicant, the International Searching Authority [~~it~~] shall not proceed with the establishment and the transmittal of the international search report until it receives information from the receiving Office [~~International Bureau~~] that the amounts due to cover the search fee and the late payment fee [~~surcharge~~] have been paid by the applicant.

<Changes result from revision of Rules 16bis and 23.1(a).>

Section 510**Refund of Search Fee in Case of Withdrawal of International Application**

(a) Where the international application is withdrawn or is considered withdrawn [~~under Article 14(1), (3) or (4),~~] before the International Searching Authority has started the international search, that Authority shall, subject to paragraph (b), refund the search fee to the applicant [~~or, where the search fee was charged under Rule 16bis.1(a), to the International Bureau~~].

(b) The International Searching Authority shall be entitled, in cases where a fee paid to it shall be refunded, to first invite the applicant to make a request for a refund of a fee and to refund the fee only after receipt of a request from the applicant. [~~If the refund referred to in paragraph (a) is not compatible with the national law of the national Office acting as International Searching Authority and as long as it continues to be not compatible with that law, the International Searching Authority may abstain from refunding the search fee.~~]

<Paragraph (a) deletions to reflect revised Rule 16.2 wording. Paragraph (b) amended in view of agreement by Assembly at PCT/A/XVIII/9, paragraph 29.>

Section 511**Rectifications of Obvious Errors under Rule 91.1**

(a) Where the International Searching Authority authorizes a rectification under Rule 91.1, it shall:

(i) indelibly mark, in the upper right-hand corner of each replacement sheet, the international application number and the date on which it was received;

(ii) indelibly mark, in the middle of the bottom margin of each replacement sheet, the words "SUBSTITUTE SHEET" or their equivalent in the language of publication of the international application as well as an indication of the International Searching Authority as provided for in Section 107(b);

(iii) indelibly mark on the letter containing the rectification or accompanying any replacement sheet the date on which that letter was received;

(iv) keep in its files a copy of the letter containing the rectification or, when the rectification is contained in a replacement sheet, the replaced sheet, a copy of the letter accompanying the replacement sheet, and a copy of the replacement sheet;

(v) promptly transmit any letter and any replacement sheet to the International Bureau and a copy thereof to the receiving Office.

(b) Where the International Searching Authority refuses to authorize a rectification under Rule 91.1, it shall proceed as indicated under paragraph (a)(i),(iii) and (iv) and promptly transmit any letter and any proposed replacement sheet to the International Bureau [to (v)].

<Change in title made for clarity. Paragraph (a)(v) amended for completeness. The only proposed change in Section 107(b), which is cited in paragraph (a)(ii), is to change “IPEA/SU” to “IPEA/SE” since the IPEA/SU no longer exists.>

Section 512
Notifications Concerning Representation

Where a power of attorney, a document containing the revocation of an appointment or a notification of renunciation of an appointment is submitted to the International Searching Authority, that Authority shall immediately notify the International Bureau by sending it a copy of the power of attorney, document or notification, and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92bis.1(a)(ii).

<Exact copy of Section 512 appearing at PCT/CAL/IV/7, page 110,
and approved at PCT/CAL/IV/10, paragraph 51.>

Section 513
Sequence Listings in Machine Readable Form

(a) Where a nucleotide and/or amino acid sequence listing is required in machine readable form, it shall be furnished by the applicant in a format acceptable to the International Searching Authority in accordance with Annex I.

(b) Where a sequence listing has been furnished under Rule 13ter.1(a), the international search report shall so indicate.

(c) Where a meaningful international search cannot be carried out because a nucleotide and/or amino acid sequence listing is not available to the International Searching Authority in the required form, that Authority shall so state in the international search report.

<Paragraph (a) is in accordance with PCT/A/XVIII/9, paragraphs 26. Paragraph (b) in response to proposal at PCT/A/XVIII/9, paragraph 38, Paragraph (c) follows the concept in Rule 13ter.1(c).>

Section 514
Authorized Officer

The officer of the International Searching Authority responsible for the international search report, as referred to in Rule 43.8, means the person who actually performed the search work and prepared the search report.

<Section follows PCT Assembly decision at PCT/A/XVIII/9, paragraph 37.>

Section 515
Amendment of Established Abstract in Response to Applicant's Comments

The International Searching Authority shall inform the applicant and the International Bureau of any amendments made under Rule 38.2(b) to an abstract established by it under Rule 38.2(a).

<New Section to cover informing applicant and International Bureau of any later changes to the abstract.>

PART 6

**INSTRUCTIONS RELATING TO THE
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**

Section 601

Notice to Applicant of Filing of Demand After the Expiration of 19 Months From the Priority Date

~~[[Deleted]]~~

Where a demand is filed after the expiration of 19 months from the priority date, the International Preliminary Examining Authority shall promptly notify the applicant accordingly and direct his attention to the fact that the time limit under Article 39(1)(a) does not apply.

<In accordance with the PCT Assembly decision at PCT/A/XVIII/9, paragraph 53.>

Section 602

Processing of Amendments by the International Preliminary Examining Authority ~~under Rule 66.8(a)~~

(a) The International Preliminary Examining Authority shall:

(i) indelibly mark, in the upper right-hand corner of each replacement sheet submitted under Rule 66.8(a), the international application number and the date on which the replacement sheet ~~it~~ was received;

(ii) indelibly mark, in the middle of the bottom margin of each replacement sheet, the words “SUBSTITUTE SHEET” or their equivalent in the language of the demand ~~[publication of the international application]~~ as well as an indication of the International Preliminary Examining Authority as provided for in Section 107(b);

(iii) keep in its files any replaced sheet, the letter accompanying any replacement sheet, and any superseded replacement sheet or any letter referred to in the last sentence of Rule 66.8(a) as well as a copy of any replacement sheet which is annexed to the international preliminary examination report;

(iv) annex to the copy of the international preliminary examination report which is transmitted to the International Bureau any replacement sheet as provided for under Rule 70.16;

(v) annex to the copy of the international preliminary examination report which is transmitted to the applicant a copy of each replacement sheet as provided for under Rule 70.16.

(b) Section 311(b)(iii) relating to page numbers of replacement sheets shall apply when one or more sheets are added under Rule 66.8(a).

(c) Where the International Preliminary Examining Authority receives from the applicant a copy of an amendment under Article 19 submitted after the time limit set forth in Rule 46.1, the International Preliminary Examining Authority may consider such an amendment as an amendment under Article 34 in which case it shall inform the applicant accordingly.

(d) Where the International Preliminary Examining Authority receives a copy of an amendment under Article 19, paragraphs (a) and (b) shall apply *mutatis mutandis*.

<Paragraphs (c) and (d) added for completeness and clarity.
No change is proposed to Section 311 which is cited in paragraph (b).>

Section 603
Transmittal of Protest Against Payment of Additional Fee for
Examining an Additional Invention and Decision Thereon

The International Preliminary Examining Authority shall transmit to the applicant, preferably at the latest together with the international preliminary examination report, any decision which it has taken under Rule 68.3(c) on the protest of the applicant against payment of the additional fee for examining an additional invention. At the same time, it shall transmit to the International Bureau a copy of both the protest and the decision thereon, as well as any request by the applicant to forward the texts of both the protest and the decision thereon to any of the elected Offices.

<Purpose of additional fee added for clarity.>

Section 604
Guidelines for Explanations Contained in the
International Preliminary Examination Report

(a) Explanations under Rule 70.8 shall clearly point out to which of the three criteria of novelty, inventive step (non-obviousness) and industrial applicability referred to in Article 35(2), taken separately, any cited document is applicable and shall clearly describe, with reference to the cited documents, the reasons supporting the conclusion that any of the said criteria is or is not satisfied.

(b) Explanations under Article 35(2) shall be concise and in the form of short sentences.

<Paragraph (a) addition for clarity, Paragraph (b) added because Rule 70.8 requires the Administrative Instructions to specify form of explanation under Article 35(2).>

Section 605
File To Be Used for International Preliminary Examination

Where the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the same file shall serve the purposes of international search and international preliminary examination.

<No change.>

Section 606
Cancellation of Elections

The International Preliminary Examining Authority shall, if the election is in the demand, cancel *ex officio* the election of any State which is not a designated State or which is not bound by Chapter II of the Treaty, shall enclose that election within square brackets, shall draw a line between the square brackets while still leaving the election legible and shall enter, in the margin, the words “CANCELLED *EX OFFICIO* BY IPEA” or their equivalent in the language of the demand [~~publication of the international application~~], and shall notify the applicant accordingly.

<Change made to make instructions complete.>

Section 606bis

Procedure in Case of an Election of a State Considered Not to Have Been Made

Where under Rule 60.1(d), the election of a State is to be considered as if it had not been made, the International Preliminary Examining Authority shall indicate that fact in the demand by enclosing the election of that State within square brackets, drawing a line between the square brackets while still leaving the election legible, and entering in the margin the words “CONSIDERED NOT TO HAVE BEEN MADE” or their equivalent in the language of the demand.

<New Section added for completeness.>

Section 607

Rectifications of Obvious Errors under Rule 91.1

Where the International Preliminary Examining Authority authorizes a rectification of an obvious error under Rule 91.1, Rule 70.16 and Section 602(a) and (b) shall apply *mutatis mutandis*.

<Title and text amended to clarify type of rectification.>

Section 608

Notifications Concerning Representation

Where a power of attorney, a document containing the revocation of an appointment, or a notification of renunciation of an appointment, is submitted to the International Preliminary Examining Authority, that Authority shall immediately notify the International Bureau by sending it a copy of the power of attorney, document or notification, and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92bis.1(a)(ii).

<Exact copy of PCT/CAL/IV/7, page 110 as approved at PCT/CAL/IV/10, paragraph 51.>

Section 609

Withdrawal by Applicant under Rules 90bis.1, 90bis.2 or 90bis.3

The International Preliminary Examining Authority shall promptly transmit to the International Bureau any notice from the applicant effecting withdrawal of the international application, of a designation, or of a priority claim under Rules 90bis.1(b), 90bis.2(d) or 90bis.3(c). The International Preliminary Examining Authority shall mark the notice with the date on which it was received.

<Substantially a copy of PCT/CAL/IV/7, page 130 and with the changes agreed to and indicated at PCT/CAL/IV/10, paragraph 72.>

Section 610

Sequence Listings in Machine Readable Form

Where a nucleotide and/or amino acid sequence listing in machine readable form is not available from the International Searching Authority, the International Preliminary Examining Authority may request the applicant to supply it with such listing in a format acceptable to the International Preliminary Examining Authority in accordance with Annex I.

<Follows wording of Section 513 and Rule 13ter.1(e) and PCT Assembly position stated at PCT/A/XVIII/9, paragraph 26.>

Section 611

Method of Identification of Documents in the International Preliminary Examination Report

Documents shall be cited in the international preliminary examination report in the same form as required under Section 503 for international search reports.

<New Section for completeness of Instructions to International Preliminary Examining Authorities.>

Section 612

Authorized Officer

The officer of the International Preliminary Examining Authority responsible for the international preliminary examination report as referred to in Rule 70.14, means the person who actually performed the examination work and prepared the international preliminary examination report.

<Sets forth PCT Assembly decision at PCT/A/XVIII/9, paragraph 37.>

Section 613

Invitation for Refund of Fees under Rule 57.6 or 58.3

The International Preliminary Examining Authority shall be entitled, in cases where a fee paid to it shall be refunded, to first invite the applicant to make a request for a refund of a fee and to refund the fee only after receipt of a request from the applicant.

<New Section in view of agreement by the Assembly at PCT/A/XVIII/9, paragraph 29.>

[Annexes follow]

Annex H: Instructions Concerning Unity of Invention

Unity of invention. Rule 13.1 deals with the requirement of unity of invention and states the principle that an international application should relate to only one invention or, if there is more than one invention, that the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single inventive concept.

(b) **Technical Relationship.** Rule 13.2 defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding “special technical features.” The expression “special technical features” is defined in Rule 13(2) as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description.

(c) **Independent and Dependent Claims.** Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By “dependent” claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression “category of claim” referring to the classification of claims according to the subject matter of the invention claimed—for example, product, process, use or apparatus or means, etc.).

(i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

(ii) If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

(iii) This method for determining whether unity of invention exists is intended to be applied even without it being necessary to search the prior art. Where a search of the prior art is made, an initial determination of unity of invention, based the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

(d) Illustrations of Particular Situations. There are three particular situations for which the method for determining unity of invention contained in Rule 13.2 is explained in greater detail:

- (i) combinations of different categories of claims;
- (ii) so-called “Markush practice”; and
- (iii) intermediate and final products.

Principles for the interpretation of the method contained in Rule 13.2, in the context of each of those situations are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of Rule 13.2.

Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out below.

(e) Combinations of Different Categories of Claims. The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

A process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words “specially adapted” are not intended to imply that the product could not also be manufactured by a different process.

An apparatus or means shall be considered to be “specifically designed for carrying out” a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression “specifically designed” does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

(f) “Markush Practice.” The situation involving the so-called “Markush practice” wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

(i) When the Markush grouping are for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

(ii) In paragraph (f)(i)(B)(1), above, the words “significant structural element is shared by all of the alternatives” refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

(iii) In paragraph (f)(i)(B)(2), above, the words “recognized class of chemical compounds” mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

(iv) The fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

(v) When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised.

(g) **Intermediate and Final Products.** The situation involving intermediate and final products is also governed by Rule 13.2.

(i) The term “intermediate” is intended to mean intermediate or starting products. Such products have the ability to be used to produce final products through a physical or chemical change in which the intermediate loses its identity.

(ii) Unity of invention shall be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

(A) the intermediate and final products have the same essential structural element, in that:

(1) the basic chemical structures of the intermediate and the final products are the same, or

(2) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(B) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

(iii) Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known—for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there shall be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

(iv) It is possible to accept in a single international application different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

(v) The intermediate and final products shall not be separated, in the process leading from one to the other, by an intermediate which is not new.

(vi) If the same international application claims different intermediates for different structural parts of the final product, unity shall not be regarded as being present between the intermediates.

(vii) If the intermediate and final products are families of compounds, each intermediate compound shall correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

(g) As long as unity of invention can be recognized applying the above interpretations, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities shall not affect the decision on unity of invention.

(i) Rule 13.3 requires that the determination of the existence of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

(j) Rule 13.3 is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in Rule 13.2) remains the same regardless of the form of claim used.

(k) Rule 13.3 does not prevent an International Authority or Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Authority or Office.

Annex I: Format for Nucleotide and/or Amino Acid Sequences in Machine Readable Form

Austrian Patent Office

Machine readable form not required

OCR format is accepted and must comply with WIPO Standard ST.22.

Australian Patent Office

Machine readable form not required

OCR format is accepted and must comply with WIPO Standard ST.22.

No requirement for electronic form but acceptable as follows:

(a) medium

Diskette - 5.25 inch, 360 Kb storage

Diskette - 5.25 inch, 1.2 Mb storage

Diskette - 3.50 inch, 720 Kb storage

Diskette - 3.5 inch, 1.44 Mb storage

Magnetic tape: 0.5 inch, up to 2400 feet

Density: 1600 or 6250 bits per inch, 9 track;

Format: raw, unblocked;

(b) character codes

ASCII

(c) computer hardware and operating systems configuration

Computer: IBM PC/XT/AT, IBM PS/2 or compatibles;

Operating system: PC-DOS or MS-DOS (Versions 2.1 or above)

European Patent Office

Machine readable form not required but recommended.

Any printed form of a sequence listing is accepted; in addition to paper, diskettes are welcome. Diskettes shall be in ASCII character code in DOS operating system. "Patentin" software program may be used.

Japanese Patent Office

The Japanese Patent Office (JPO) recommends that a listing of sequence in an electronic form application shall be recorded as code data complying with WIPO standard ST. 23 but the recommendation is not a statutory requirement. The JPO also accepts the applications including a listing of the sequence which is recorded as facsimile-mode data.

requirements for electronic form:

(a) medium

floppy disk

8 inches both-sided double density (2d) (JIS X6201)

5.25 inches high density (2HD) (JIS X6211)

3.5 inches high density (2HD) (JIS 6223)

on-line

ISDN (64kb/s)

Digital Data Exchange of Packet (9600b/s)

(b) character codes

Code of Japanese graphic character set for information interchange (JIS X 0208-1983)

(c) computer hardware and operating systems configuration

Not specified, but in accordance with the JPO's electronic application standards

(d) computer software

Not specified, but in accordance with the JPO's electronic application standards

(e) other requirements

floppy disk application:

File specification for Japanese Documents Interchange (JIS X4004-1988)

On-line application:

OSI & CCITT T.73

Swedish Patent Office

Machine readable form not required

United Kingdom Patent Office

Machine readable form not required

United States Patent and Trademark Office (USPTO)

A sequence listing is required for all disclosures of sequence information in which the sequence has four or more amino acids or ten or more nucleotides. Branched sequences and those including D-amino acids are excluded from the rules.

The USPTO has not adopted the use of an OCR format and it is not expected that such a format will be adopted by the USPTO.

Sections 1.824 and 1.825 of title 37, Code of Federal Regulations (37 CFR) set forth the requirements of the USPTO. They are reproduced below:

37 CFR 1.824 Form and format for nucleotide and/or amino acid sequence submissions in computer readable form.

(a) The computer readable form required by §1.821(e) shall contain a printable copy of the "Sequence Listing," as defined in §§1.821(c), 1.822 and 1.823, recorded as a single file on either a diskette or a magnetic tape. The computer readable form shall be encoded and formatted such that a printed copy of the "Sequence Listing" may be recreated using the print commands of the computer/operating-system configuration specified in paragraph (f) of this section.

(b) The file in paragraph (a) of this section shall be encoded in a subset of the American Standard Code for Information Interchange (ASCII). This subset shall consist of all the printable ASCII characters including the ASCII space character plus line termination, pagination and end-of-file characters associated with the computer/operating-system configurations specified in paragraph (f) of this section. No other characters shall be allowed.

(c) The computer readable form may be created by any means, such as word processors, nucleotide/amino acid sequence editors or other custom computer programs, however, it shall be readable by one of the computer/operating-system configurations specified in paragraph (f) of this section, and shall conform to the specifications in paragraphs (a) and (b) of this section.

(d) The entire printable copy of the "Sequence Listing" shall be contained within one file on a single diskette or magnetic tape unless it is shown to the satisfaction of the Commissioner that it is not practical or possible to submit the entire printable copy of the "Sequence Listing" within one file on a single diskette or magnetic tape.

(e) The submitted diskette or tape shall be write-protected such as by covering or uncovering diskette holes, removing diskette write tabs or removing tape write rings.

(f) As set forth in paragraph (c), above, any means may be used to create the computer readable form, as long as the following conditions are satisfied. A submitted diskette shall be readable on one of the computer/operating-system configurations described in paragraphs (1) through (3), below. A submitted tape shall satisfy the format specifications described in paragraph (4), below.

(1) Computer: IBM PC/XT/AT, IBM PS/2 or compatibles

Operating system: PC-DOS or MS-DOS (Versions 2.1 or above)

Line Terminator: ASCII Carriage Return plus ASCII Line Feed

Pagination: ASCII Form Feed or Series of Line Terminators

End-of-File: ASCII SUB (Ctrl-Z)

Media:

Diskette - 5.25 inch, 360 Kb storage

Diskette - 5.25 inch, 1.2 Mb storage

Diskette - 3.50 inch, 720 Kb storage

Diskette - 3.5 inch, 1.44 Mb storage

Print Command: PRINT filename.extension;

(2) Computer: IBM PC/XT/AT, IBM PS/2 or compatibles

Operating system: Xenix

Line Terminator: ASCII Carriage Return

Pagination: ASCII Form Feed or Series of Line Terminators

End of-File: None

Media:

Diskette - 5.25 inch, 360 Kb storage

Diskette - 5.25 inch, 1.2 Mb storage

Diskette - 3.50 inch, 720 Kb storage

Diskette - 3.5 inch, 1.44 Mb storage

Print Command; lpr filename;

(3) Computer: Apple Macintosh

Operating System: Macintosh

Macintosh File Type: text with line termination

Line Terminator: Pre-defined by text type file

Pagination: Pre-defined by text type file

End-of-file: Pre-defined by text type file

Media

Diskette - 3.50 inch, 400 Kb storage

Diskette - 3.50 inch, 800 Kb storage

Diskette - 3.50 inch, 1.4 Mb storage

Print Command: Use PRINT command from any Macintosh Application that processes text files, such as MacWrite or TeachText;

(4) Magnetic tape: 0.5 inch, up to 2400 feet

Density: 1600 or 6250 bits per inch, 9 track

Format: raw, unblocked

Line Terminator: ASCII Carriage Return plus optional ASCII Line Feed

Pagination: ASCII Form Feed or Series of Line Terminators

Print Command (Unix shell version given here as sample response

- mt/dev/rmtO;lpr</dev/rmt0)

(g) Computer readable forms that are submitted to the Office will not be returned to the applicant.

(h) All computer readable forms shall have a label permanently affixed thereto on which has been hand printed or typed, a description of the format of the computer readable form as well as the name of the applicant, the title of the invention, the date on which the data were recorded on the computer readable form and the name and type of computer and operating system which generated the files on the computer readable form. If all of this information can not be printed on a label affixed to the computer readable form, by reason of size or otherwise, the label shall include the name of the applicant and the title of the invention and a reference number, and the additional information may be provided on a container for the computer readable form with the name of the applicant, the title of the invention, the reference number and the additional information affixed to the container. If the computer readable form is submitted after the date of filing under 35 U.S.C. 111, after the date of entry in the national stage under 35 S.C. 371 or after the time of filing, in the United States Receiving Office, an international application under the PCT, the labels mentioned herein must also include the date of the application and the application number, including series code and serial number.

37 CFR 1.825 Amendments to or replacement of sequence listing and computer readable copy thereof.

(a) Any amendment to the paper copy of the "Sequence Listing" (§1.821(c)) must be made by the submission of substitute sheets. Amendments must be accompanied by a statement that indicates support for the amendment in the application, as filed, and a statement that the substitute sheets include no new matter. Such a statement must be a verified statement if made by a person not registered to practice before the Office.

(b) Any amendment to the paper copy of the "Sequence Listing," in accordance with paragraph (a) of this section, must be accompanied by a substitute copy of the computer readable form (§1.821(e)) including all previously submitted data with the amendment incorporated therein, accompanied by a statement that the copy in computer readable form is the same as the substitute copy of the "Sequence Listing." Such a statement must be a verified statement if made by a person not registered to practice before the Office.

(c) Any appropriate amendments to the "Sequence Listing" in a patent, e.g., by reason of reissue or certificate of correction, must comply with the requirements of paragraphs (a) and (b) of this section.

(d) If, upon receipt, the computer readable form is found to be damaged or unreadable, applicant must provide, within such time as set by the Commissioner, a substitute copy of the data in computer readable form accompanied by a statement that the substitute data is identical to that originally filed. Such a statement must be a verified statement if made by a person not registered to practice before the Office.