

# ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

(as in force from April 1, 1995)

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# MANUAL OF PATENT EXAMINING PROCEDURE

## PART 1

### INSTRUCTIONS RELATING TO GENERAL MATTERS

#### Section 101

##### Abbreviated Expressions and Interpretation

- (a) In these Administrative Instructions:
- (i) "Treaty" means the Patent Cooperation Treaty;
  - (ii) "Regulations" means the Regulations under the Treaty;
  - (iii) "Article" means an Article of the Treaty;
  - (iv) "Rule" means a Rule of the Regulations;
  - (v) "International Bureau" means the International Bureau as defined in Article 2(xix) of the Treaty;
  - (vi) "International Authorities" means the receiving Offices, the International Searching Authorities, the International Preliminary Examining Authorities, and the International Bureau;
  - (vii) "Annex" means an Annex to these Administrative Instructions, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used;
  - (viii) "Form" means a Form contained in Annex A;
  - (ix) "WIPO Standard" means a Standard established by the World Intellectual Property Organization;
  - (x) "Director General" means the Director General as defined in Article 2(xx) of the Treaty.

(b) The Annexes are part of these Administrative Instructions.

<sup>2</sup> Annex A is published separately by the World Intellectual Property Organization.

#### Section 102

##### Use of the Forms

(a) Subject to paragraphs (b) to (i) and Sections 103 and 114, the International Authorities shall use, or require the use of, the mandatory Forms specified below:

(i) Forms for use by the applicant:

PCT/RO/101 (request Form)

PCT/IPEA/401 (demand Form)

(ii) Forms for use by the receiving Offices:

PCT/RO/103	PCT/RO/113	PCT/RO/133
PCT/RO/104	PCT/RO/115	PCT/RO/136
PCT/RO/105	PCT/RO/116	PCT/RO/137
PCT/RO/106	PCT/RO/117	PCT/RO/139
PCT/RO/107	PCT/RO/118	PCT/RO/143
PCT/RO/109	PCT/RO/121	PCT/RO/147
PCT/RO/111	PCT/RO/123	
PCT/RO/112	PCT/RO/126	

(iii) Forms for use by the International Searching Authorities:

PCT/ISA/201	PCT/ISA/209	PCT/ISA/219
PCT/ISA/202	PCT/ISA/210	PCT/ISA/220
PCT/ISA/203	PCT/ISA/212	PCT/ISA/225
PCT/ISA/205	PCT/ISA/217	PCT/ISA/228
PCT/ISA/206	PCT/ISA/218	

(iv) Forms for use by the International Bureau:

PCT/IB/301	PCT/IB/320	PCT/IB/344
PCT/IB/302	PCT/IB/321	PCT/IB/345
PCT/IB/304	PCT/IB/323	PCT/IB/346
PCT/IB/305	PCT/IB/324	PCT/IB/349
PCT/IB/306	PCT/IB/325	PCT/IB/350
PCT/IB/307	PCT/IB/329	PCT/IB/351
PCT/IB/308	PCT/IB/331	PCT/IB/352
PCT/IB/310	PCT/IB/332	PCT/IB/353
PCT/IB/313	PCT/IB/333	PCT/IB/354
PCT/IB/314	PCT/IB/334	PCT/IB/355
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PCT/IB/316	PCT/IB/336	PCT/IB/357
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(v) Forms for use by the International Preliminary Examining Authorities:

PCT/IPEA/402	PCT/IPEA/409	PCT/IPEA/420
PCT/IPEA/404	PCT/IPEA/412	PCT/IPEA/425
PCT/IPEA/405	PCT/IPEA/414	PCT/IPEA/431
PCT/IPEA/407	PCT/IPEA/415	PCT/IPEA/437
PCT/IPEA/408	PCT/IPEA/416	PCT/IPEA/439.

(b) Slight variations in layout necessary in view of the printing of the Forms referred to in paragraph (a) in various languages are permitted.

(c) Slight variations in layout in the Forms referred to in paragraph (a)(ii) to (v) are permitted to the extent necessary to meet the particular office requirements of the International Authorities, in particular, in view of the production of the Forms by computer or of the use of window envelopes.

(d) Where the receiving Office, the International Searching Authority and/or the International Preliminary Examining Authority are each part of the same Office, the obligation to use the Forms referred to in paragraph (a) does not extend to communications within that same Office.

(e) The annexes to Forms PCT/RO/106, PCT/RO/118, PCT/ISA/201, PCT/ISA/205, PCT/ISA/206, PCT/ISA/210, PCT/ISA/219, PCT/IB/313, PCT/IB/336, PCT/IPEA/404, PCT/IPEA/405, and PCT/IPEA/415 may be omitted in cases where they are not used.

(f) The notes attached to Forms PCT/RO/101 (request Form) and PCT/IPEA/401 (demand Form) shall be distributed by the International Authorities concerned together with the printed versions of those Forms. The notes attached to Form PCT/ISA/220 shall accompany the Form when sent to the applicant.

(g) The use of Forms other than those referred to in paragraph (a) is optional.

(h) Where the request or the demand is presented as a computer print-out, such print-out shall be prepared as follows:

(i) the layout and contents of the request and the demand when presented as computer print-outs shall correspond to the format of Forms PCT/RO/101 (request Form) and PCT/IPEA/401 (demand Form) (the

printed Forms), with the same information being presented on the corresponding pages;

(ii) all boxes shall be drawn by solid lines; double lines may be presented as single lines;

(iii) the box numbers and box titles shall be included even where no information is supplied therein;

(iv) the boxes for use by the International Authorities shall be at least as large as those on the printed Forms;

(v) all other boxes shall be within one cm in size of those on the printed Forms;

(vi) all text shall be 9 points or larger in size;

(vii) titles and other information shall be clearly distinguished;

(viii) explanatory notes presented in italics on the printed Forms may be omitted.

(i) Other formats permitted for the presentation of the request and the demand as computer print-outs may be determined by the Director General. Any such format shall be published in the Gazette.

### Section 103

#### Languages of the Forms Used by International Authorities

(a) The language of the Forms used by any receiving Office shall be the same as the language in which the international application is filed, provided that the receiving Office may, in its communications to the applicant, use the Forms in any other language being one of its official languages.

(b) Subject to Section 104(b), the language or languages of the Forms to be used by any International Searching Authority shall be specified in the applicable agreement referred to in Article 16(3)(b).

(c) Subject to Section 104(b), the language or languages of the Forms to be used by any International Preliminary Examining Authority shall be specified in the applicable agreement referred to in Article 32(3).

(d) The language of any Form used by the International Bureau shall be English where the language of the international application is English, and it shall be French where the language of the international application is French. Where the language of the international

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application is neither English nor French, the language of any Form used by the International Bureau in its communications to any other International Authority shall be English or French according to the wishes of such Authority, and in its communications to the applicant it shall be English or French according to the wishes of the applicant.

### Section 104

#### Language of Correspondence in Cases Not Covered by Rule 92.2

(a) The language of any letter from the applicant to the receiving Office shall be the same as the language of the international application to which such letter relates. However, the receiving Office may expressly authorize the use of any other language.

(b) The language of any letter to the International Bureau shall be English where the language of the international application is English, and it shall be French where the language of the international application is French. Where the language of the international application is neither English nor French, the language of any letter to the International Bureau shall be English or French, provided that any copy, sent to the International Bureau as a notification addressed to it, of a Form sent to the applicant by the receiving Office, the International Searching Authority or the International Preliminary Examining Authority, does not require translation into English or French.

### Section 105

#### Identification of International Application with Two or More Applicants

Where any international application indicates two or more applicants, it shall be sufficient, for the purpose of identifying that application, to indicate, in any Form or correspondence relating to such application, the name of the applicant first named in the request. The provisions of the first sentence of this Section do not apply to the demand or to a notice effecting later elections.

### Section 106

#### Change of Common Representative

Where a change is recorded under Rule 92<sup>bis</sup>.1(a) in the person of an applicant who was considered to be

the common representative under Rule 90.2(b), the new applicant shall be considered to be the common representative under Rule 90.2(b) if he is entitled according to Rule 19.1 to file an international application with the receiving Office.

### Section 107

#### Identification of International Authorities and of Designated and Elected Offices

(a) Whenever the nature of any communication from or to the applicant, from or to any International Authority or, before national processing or examination has started, from or to any designated or elected Office so permits, any International Authority or any designated or elected Office may be indicated in the communication by the two-letter code referred to in Section 115.

(b) The indication of a receiving Office, an International Searching Authority, an International Preliminary Examining Authority or a designated or elected Office shall be preceded by the letters "RO," "ISA," "IPEA," "DO," or "EO," respectively, followed by a slant (e.g., "RO/JP," "ISA/US," "IPEA/SE," "DO/EP," "EO/AU").

### Section 108

#### Correspondence Intended for the Applicant

(a) For the purpose of this Section, where there are two or more agents whose appointments are in force, "first mentioned agent" means the agent first mentioned in the document containing the appointments or, where the appointments are contained in two or more documents, in that which was filed first.

(b) Where a sole applicant has appointed an agent or agents under Rule 90.1(a), correspondence intended for the applicant from the International Authorities shall, subject to paragraph (d), be addressed to the agent or, where applicable, to the first mentioned agent.

(c) Where there are two or more applicants, correspondence intended for the applicants from the International Authorities shall, subject to paragraph (d), be addressed:

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(i) if no common agent has been appointed under Rule 90.1—to the common representative or, where applicable, to his agent or first mentioned agent; or

(ii) if the applicants have appointed a common agent or common agents under Rule 90.1(a)—to that common agent or, where applicable, to the first mentioned common agent.

(d) Where an agent has or agents have been appointed under Rule 90.1(b), (c) or (d)(ii), paragraphs (b) and (c) shall apply to correspondence intended for the applicant relating to the procedure before the International Searching Authority or the International Preliminary Examining Authority, as the case may be, as if those paragraphs referred to the agent or agents so appointed.

### Section 109

#### File Reference

(a) Where any document submitted by the applicant contains an indication of a file reference, that reference shall not exceed twelve characters in length and may be composed of either letters of the Latin alphabet or Arabic numerals, or both.

(b) Correspondence from International Authorities intended for the applicant shall indicate any such file reference.

### Section 110

#### Dates

Any date in the international application, or used in any correspondence emanating from International Authorities relating to the international application, shall be indicated by the Arabic number of the day, by the name of the month, and by the Arabic number of the year. The receiving Office, where the applicant has not done so, or the International Bureau, where the applicant has not done so and the receiving Office fails to do so, shall, after, above, or below any date indicated by the applicant in the request, repeat the date, in parenthesis, by indicating it by two-digit Arabic numerals each for the number of the day, for the number of the month and for the last two numbers of the year, in that order and with a period, slant, or hyphen after the digit pairs of the day and of the month (for example, "05 March 1992

(05.03.92)", "05 March 1992 (05/03/92)", or "05 March 1992 (05-03-92)").

### Section 111

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### Section 112

#### Ceasing of Effect under Articles 24(1)(iii) and 39(2), Review under Article 25(2) and Maintaining of Effect under Articles 24(2) and 39(3)

(a) Each national Office shall, in its capacity as designated Office, notify the International Bureau once a year of:

(i) the number of international applications in respect of which, during the preceding calendar year, the time limit applicable under Article 22 has expired;

(ii) the number of international applications in respect of which, during the preceding calendar year, the requirements provided for in Article 22 have not been complied with before the expiration of the time limit applicable under that Article, with the consequence that the effects of the international applications concerned have ceased under Article 24(1)(iii).

(b) Each national Office shall, in its capacity as elected Office, notify the International Bureau once a year of:

(i) the number of international applications in respect of which, during the preceding calendar year, the time limit applicable under Article 39(1) has expired;

(ii) the number of international applications in respect of which, during the preceding calendar year, the requirements provided for in Article 39(1) have not been complied with before the expiration of the time limit applicable under that Article, with the consequence that the effects of the international applications concerned have ceased under Article 39(3).

(c) Where, under Article 25(2), the designated Office decides that the refusal, declaration, or finding referred to in Article 25(1) was not justified, it shall promptly notify the International Bureau that it will treat the international application as if the error or omission referred to in Article 25(2) had not occurred. The notification shall preferably contain the reasons for the decision of the designated Office.

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(d) Where, under Article 24(2) or under Article 39(3), the designated or elected Office maintains the effect provided for in Article 11(3), it shall promptly notify the International Bureau accordingly. The notification shall preferably contain the reasons for the decision of the designated or elected Office.

### Section 113

#### Special Fees Payable to the International Bureau

(a) The special publication fee provided for in Rule 48.4 shall be 200 Swiss francs.

(b) The special fee provided for in Rule 91.1(f) shall be payable to the International Bureau and shall be 50 Swiss francs plus 12 Swiss francs for each sheet in excess of one. Where that fee has not been paid before the time of the completion of the technical preparations for international publication, the request for rectification shall not be published. Where the last sentence of Rule 91.1(f) applies and the said fee has not been paid before the time of the communication of the international application under Article 20, a copy of the request for rectification shall not be included in that communication.

### Section 114

#### Electronic Transmission of Notices

Where the Treaty, the Regulations, or these Administrative Instructions provide for a notification or other communication to be transmitted by one national Office or intergovernmental organization to another, that notification or communication, except where otherwise provided, may, where so agreed by both the sender and the receiver, be transmitted by electronic means or in electronic form.

### Section 115

#### Indications of States, Territories, and Intergovernmental Organizations

The indication of a State, territory, or intergovernmental organization shall be made either by its full name, by a generally accepted short title which, if the indications are in English or French, shall be as appears in WIPO Standard ST.3 (Recommended Standard Two-Letter Code for the Representation of Countries, and of Other Entities and International Organizations Issuing or Registering Industrial Property Titles), or by the two-letter code as appears in that Standard.<sup>3</sup>

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<sup>3</sup> Published in the WIPO Handbook on Industrial Property Information and Documentation.



# PCT ADMINISTRATIVE INSTRUCTIONS

## PART 2

### INSTRUCTIONS RELATING TO THE INTERNATIONAL APPLICATION

#### Section 201

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#### Section 202

##### Kind of Protection

(a) Where the applicant wishes his application to be treated in any designated State as an application not for a patent but for the grant of another kind of protection referred to in Article 43, he shall make the indication in the request referred to in Rule 4.12(a) by inserting the words "inventor's certificate," "utility certificate," "utility model" (or "petty patent" for Australia), "patent of addition," "certificate of addition," "inventor's certificate of addition" or "utility certificate of addition," or their equivalent in the language of the international application, immediately after the indication of the said State.

(b) Where, in respect of a designated State which provides for the granting of a patent and of a utility model, the applicant is seeking two kinds of protection under Article 44, he shall make the indication referred to in Rule 4.12(b) by inserting, immediately after the indication of that State and in the language of the international application, the words "and utility model."

#### Section 203

##### Different Applicants for Different Designated States

(a) Different applicants may be indicated for different States designated for a regional patent.

(b) Where a particular State has been designated for both a national patent and a regional patent, the same applicant or applicants shall be indicated for both designations.

#### Section 204

##### Headings of the Parts of the Description

The headings referred to in Rule 5.1(c) should be as follows:

(i) for matter referred to in Rule 5.1(a)(i), "Technical Field";

(ii) for matter referred to in Rule 5.1(a)(ii), "Background Art";

(iii) for matter referred to in Rule 5.1(a)(iii), "Disclosure of Invention";

(iv) for matter referred to in Rule 5.1(a)(iv), "Brief Description of Drawings";

(v) for matter referred to in Rule 5.1(a)(v), "Best Mode for Carrying Out the Invention," or, where appropriate, "Mode (s) for Carrying Out the Invention";

(vi) for matter referred to in Rule 5.1(a)(vi), "Industrial Applicability."

#### Section 205

##### Numbering and Identification of Claims Upon Amendment

(a) Amendments to the claims under Article 19 or Article 34(2)(b) may be made either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed. All the claims appearing on a replacement sheet shall be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims shall be required. In all cases where claims are renumbered, they shall be renumbered consecutively.

(b) The applicant shall, in the letter referred to in the second and third sentences of Rule 46.5(a) or in the second and fourth sentences of Rule 66.8(a), indicate the differences between the claims as filed and the claims as amended. He shall, in particular, indicate in the

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said letter, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether:

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

### Section 206

#### Unity of Invention

The determination by the International Searching Authority, the International Preliminary Examining Authority and the designated and elected Offices whether an international application complies with the requirement of unity of invention under Rule 13 shall be made in accordance with Annex B.

### Section 207

#### Arrangement of Elements and Numbering of Sheets of the International Application

(a) In effecting the sequential numbering of the sheets of the international application in accordance with Rule 11.7, the elements of the international application shall be placed in the following order: the request, the description, the claims, the abstract, the drawings.

(b) The sequential numbering of the sheets shall be effected by using three separate series of numbering:

(i) the first series applying to the request only and commencing with the first sheet of the request,

(ii) the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and

(iii) the third series being applicable to the sheets of the drawings only and commencing with the first sheet of

the drawings; the number of each sheet of the drawings shall consist of two Arabic numerals separated by a slant, the first being the sheet number and the second being the total number of sheets of drawings (for example, 1/3, 2/3, 3/3).

### Section 208

#### Sequence Listings

(a) Any nucleotide and/or amino acid sequence listing ("sequence listing") shall be presented in a format complying with WIPO Standard ST.23 (Recommendation for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications and in Published Patent Documents).<sup>4</sup>

(b) Any machine readable form of a sequence listing shall comply with the required format in accordance with Annex C.

(c) Any sequence listing not forming part of the international application shall, when furnished, be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed.

(d) Sheets of a sequence listing in printed form not forming part of the international application shall be sequentially numbered in a series separate from that used in numbering the sheets of the international application; the number of each sheet shall preferably consist of two Arabic numerals separated by a slant, the first being the sheet number and the second being the total number of such sheets (for example, 1/3, 2/3, 3/3).

### Section 209

#### Indications as to Deposited Microorganisms on a Separate Sheet

(a) To the extent that any indication with respect to a deposited microorganism is not contained in the de-

<sup>4</sup> Published in the WIPO Handbook on Industrial Property Information and Disclosure.

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scription, it may be given on a separate sheet. Where any such indication is so given, it shall preferably be on Form PCT/RO/134 and, if furnished at the time of filing, the said Form shall, subject to paragraph (b), preferably be attached to the request and referred to in the check list referred to in Rule 3.3(a)(ii).

(b) For the purposes of the Japanese Patent Office when Japan is designated, paragraph (a) applies only to the extent that the said Form or sheet is included as one of the sheets of the description of the international application at the time of filing.

### Section 210

#### Calculation of Designation Fee for the Purposes of National and Regional Patents

designation of the same Contracting State with an indication of the wish to obtain a regional patent and the national law of the Contracting State does not contain a provision referred to in Article 45(2), the designation fees shall be calculated on the basis that a separate fee is payable in respect of the designation of the Contracting State in addition to the designation fee payable in respect of that Contracting State as a Contracting State or as one of a group of Contracting States for which a regional patent is sought.

PART 3

INSTRUCTIONS RELATING TO THE RECEIVING OFFICE

Section 301

**Notification of Receipt of Purported International Application**

Before the determination under Article 11(1), the receiving Office may notify the applicant of the receipt of the purported international application. The notification should indicate the date of actual receipt and the international application number of the purported international application referred to in Section 307 as well as, where useful for purposes of identification, the title of the invention.

Section 302

**Priority Claim Considered Not To Have Been Made**

Where, owing to failure to meet the requirements of Rule 4.10(b), the priority claim is, for the purposes of the procedure under the Treaty, considered not to have been made, the receiving Office shall indicate that fact in the international application by enclosing the portion of the request which provides for the information concerning the priority claim (or, where the priorities of several earlier applications are claimed and not all those priority claims are considered not to have been made, the relevant portion) within square brackets and entering, in the margin, the words "NOT TO BE CONSIDERED FOR PCT PROCEDURE" or their equivalent in the language of publication of the international application, and shall notify the applicant accordingly. If copies of the international application have already been sent to the International Bureau and the International Searching Authority, the receiving Office shall also notify that Bureau and that Authority.

Section 303

**Deletion of Additional Matter in the Request**

Where, under Rule 4.17(b), the receiving Office deletes *ex officio* any matter contained in the request, it shall do so by enclosing such matter within square brackets and entering, in the margin, the words "DELETED

BY RO" or their equivalent in the language of publication of the international application, and shall notify the applicant accordingly. If copies of the international application have already been sent to the International Bureau and the International Searching Authority, the receiving Office shall also notify that Bureau and that Authority.

Section 304

**Invitation to Pay Fees Before Date on Which They Are Due**

(a) If the receiving Office finds, before the date on which they are due, that the transmittal fee, the basic fee (including any supplement per sheet over 30) or the search fee are lacking in whole or in part, it may invite the applicant to pay the missing amounts within one month from the date of receipt of the international application.

(b) If the receiving Office finds, before the date on which they are due, that the designation fees for designations made under Rule 4.9(a) are lacking in whole or in part, it may invite the applicant to pay the missing amount within one year from the priority date or within one month from the date of receipt of the international application, whichever expires later.

(c) If the receiving Office finds that the applicant filed a written notice under Rule 4.9(b), but failed to pay the designation fees and/or the confirmation fee under Rule 4.9(c)(ii) or that the amount paid is not sufficient, it may invite the applicant to pay the missing amount within 15 months from the priority date.

Section 305

**Identifying the Copies of the International Application**

(a) Where, under Rule 11.1(a), the international application has been filed in one copy, the receiving Office shall, after preparing under Rule 21.1(a) the additional copies required under Article 12(1), mark,

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(i) the words "RECORD COPY" in the upper left-hand corner of the first page of the original copy,

(ii) in the same space on one additional copy, the words "SEARCH COPY", and

(iii) in the same space on the other such copy, the words "HOME COPY,"

or their equivalent in the language of publication of the international application.

(b) Where, under Rule 11.1(b), the international application has been filed in more than one copy, the receiving Office shall choose the copy most suitable for reproduction purposes, and mark the words "RECORD COPY," or their equivalent in the language of publication of the international application, in the upper left-hand corner of its first page. After verifying the identity of any additional copies and, if applicable, preparing under Rule 21.1(b) the home copy, it shall mark, in the upper left-hand corner of the first page of one such copy, the words "SEARCH COPY," and, in the same space on the other such copy, the words "HOME COPY," or their equivalent in the language of publication of the international application.

### Section 306

#### Delayed Transmittal of Search Copy

Where the search copy will be transmitted to the International Searching Authority after the date on which the record copy is transmitted to the International Bureau, the receiving Office shall notify the International Bureau. The notification may be made by marking a check-box provided for this purpose on the request.

### Section 307

#### System of Numbering International Applications

(a) Papers purporting to be an international application under Rule 20.1(a) shall be marked with the international application number, consisting of the letters "PCT," a slant, the two-letter code referred to in Section 115, indicating the receiving Office, a two-digit indication of the last two numbers of the year in which

such papers were first received, a slant, and a five-digit number, allotted in sequential order corresponding to the order in which the international applications are received (e.g., "PCT/SE78/00001" ). Where the International Bureau acts, pursuant to Rule 19.1(b), as receiving Office for a national Office, the two-letter code indicating the national Office for which the International Bureau acts as receiving Office shall be used.

(b) If a negative determination is made under Rule 20.7 or a declaration is made under Article 14(4), the letters "PCT" shall be deleted by the receiving Office from the indication of the international application number on any papers marked previously with that number, and the said number shall be used without such letters in any future correspondence relating to the purported international application.

### Section 308

#### Marking of the Sheets of the International Application

The receiving Office shall indelibly mark the international application number referred to in Section 307 in the upper right-hand corner of each sheet of each copy of the purported international application.

### Section 309

#### Procedure in the Case of Later Submitted Sheets

(a) The receiving Office shall indelibly mark any sheet received on a date later than the date on which sheets were first received with the date on which it received that sheet, inserted immediately below the international application number referred to in Section 307.

(b) The receiving Office shall, in the case of later submitted sheets received within the time limits referred to in Rule 20.2(a)(i) and (ii):

(i) effect the required correction of the international filing date, or, where no international filing date has yet been accorded, of the date of receipt of the purported international application;

(ii) notify the applicant of the correction effected under item (i), above;

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(iii) where transmittals under Article 12(1) have already been made, notify the International Bureau and the International Searching Authority of any correction effected under item (i), above, by transmitting a copy of the corrected first and last sheets of the request, and forward the later submitted sheets to the said Bureau and a copy thereof to the said Authority;

(iv) where transmittals under Article 12(1) have not yet been made, attach the later submitted sheets to the record copy and a copy thereof to the search copy.

(c) The receiving Office shall, in the case of later submitted sheets received after the expiration of the time limit referred to in Rule 20.2(a)(i):

(i) notify the applicant of that fact and of the date of receipt of the later submitted sheets;

(ii) where transmittals under Article 12(1) have already been made, forward the later submitted sheets to the International Bureau with the indication on the bottom of each sheet of the words: "NOT TO BE TAKEN INTO CONSIDERATION FOR THE PURPOSES OF INTERNATIONAL PROCESSING" or their equivalent in the language of publication of the international application;

(iii) where transmittals under Article 12(1) have not yet been made, attach the later submitted sheets to the record copy with the indication referred to in item (ii).

(d) The receiving Office shall, in the case of later submitted sheets received after the expiration of the time limit referred to in Rule 20.2(a)(ii), proceed as provided in Rule 20.7, unless the applicant has, within the said time limit, complied with the invitation under Article 11(2)(a) so that an international filing date can be accorded; in the latter case, the receiving Office shall proceed as provided in paragraph (c)(i) to (iii).

### Section 310

#### Procedure in the Case of Missing Drawings

(a) Where the international application refers to drawings which in fact are not included in that applica-

tion, the receiving Office shall make the indication referred to in Rule 26.6(a) by marking a check-box provided for this purpose on the request.

(b) Section 309(a) shall apply also in the case of drawings received by the receiving Office on a date later than the date on which sheets were first received by that Office.

(c) The receiving Office shall, in the case of missing drawings received within the time limit referred to in Rule 20.2(a)(iii):

(i) effect the required correction of the international filing date, or, where no international filing date has yet been accorded, of the date of receipt of the purported international application, and delete the indication made under paragraph (a), above;

(ii) notify the applicant of the correction effected under item (i), above;

(iii) where transmittals under Article 12(1) have already been made, notify the International Bureau and the International Searching Authority of any correction effected under item (i), above, by transmitting a copy of the corrected first and last sheets of the request, and forward the later submitted drawings to the said Bureau and a copy thereof to the said Authority;

(iv) where transmittals under Article 12(1) have not yet been made, attach the later submitted drawings to the record copy and a copy thereof to the search copy.

(d) The receiving Office shall, in the case of missing drawings received after the expiration of the time limit referred to in Rule 20.2(a)(iii):

(i) notify the applicant of the fact and of the date of receipt of the later submitted drawings;

(ii) where transmittals under Article 12(1) have already been made, forward the later submitted drawings to the International Bureau with the indication on the bottom of each drawing of the words: "NOT TO BE TAKEN INTO CONSIDERATION (PCT Art. 14(2), 2nd sentence)" or their equivalent in the language of publication of the international application;

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(iii) where transmittals under Article 12(1) have not yet been made, attach the later submitted drawings to the record copy with the indication referred to in item (ii).

### Section 311

#### Renumbering in the Case of Deletion, Substitution or Addition of Sheets of the International Application

(a) The receiving Office shall, subject to Section 207, sequentially renumber the sheets of the international application when necessitated by the addition of any new sheet, the deletion of entire sheets, a change in the order of the sheets, or any other reason.

(b) The sheets of the international application shall be provisionally renumbered in the following manner:

(i) when a sheet is deleted, the receiving Office shall either include a blank sheet with the same number and with the word "DELETED," or its equivalent in the language of publication of the international application, below the number, or insert, in brackets, below the number of the following sheet, the number of the deleted sheet with the word "DELETED" or its equivalent in the language of publication of the international application;

(ii) when one or more sheets are added, each sheet shall be identified by the number of the preceding sheet followed by a slant and then by another Arabic numeral such that the additional sheets are numbered consecutively, starting always with number one for the first sheet added after an unchanged sheet (e.g., 10/1, 15/1, 15/2, 15/3, etc.); when later additions of sheets to an existing series of added sheets are necessary, an extra numeral shall be used for identifying the further additions (e.g., 15/1, 15/1/1, 15/1/2, 15/2, etc.).

(iii) [Deleted]

(c) In the cases mentioned in paragraph (b), it is recommended that the receiving Office should write, below the number of the last sheet, the total number of the sheets of the international application followed by the words "TOTAL OF SHEETS" or their equivalent in the language of publication of the international application. It is further recommended that, at the bottom of

any last sheet added, the words "LAST ADDED SHEET" or their equivalent in the language of publication of the international application should be inserted.

### Section 312

#### Notification of Decision Not To Issue Declaration that the International Application Is Considered Withdrawn

Where the receiving Office, after having notified the applicant under Rule 29.4 of its intent to issue a declaration under Article 14(4), decides not to issue such a declaration, it shall notify the applicant accordingly.

### Section 313

#### Documents Filed with the International Application; Manner of Marking the Necessary Annotations in the Check List

(a) Any power of attorney, any priority document, any fee calculation sheet, and any separate sheet referred to in Section 209(a) containing indications as to deposited microorganisms, filed with the international application shall accompany the record copy; any other document referred to in Rule 3.3(a)(ii) shall be sent only at the specific request of the International Bureau. If any document which is indicated in the check list as accompanying the international application is not, in fact, filed at the latest by the time the record copy leaves the receiving Office, that Office shall so note on the check list and the said indication shall be considered as if it had not been made.

(b) Where, under Rule 3.3(b), the receiving Office itself completes the check list, that Office shall enter, in the margin, the words "COMPLETED BY RO" or their equivalent in the language of publication of the international application. Where only some of the indications are completed by the receiving Office, the said words and each indication completed by that Office shall be identified by an asterisk.

(c) Where a sequence listing in machine readable form, or a sequence listing in printed form not forming part of the international application, is furnished to the

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receiving Office, it shall be transmitted to the International Searching Authority together with the search copy. Where such a sequence listing is received by the receiving Office after the transmittal of the search copy, the sequence listing shall be promptly transmitted to the International Searching Authority.

### Section 314

#### Correction or Cancellation of a Priority Claim under Rule 4.10

(a) Where, in reply to an invitation by the receiving Office to correct or cancel a priority claim under Rule 4.10(d), the applicant corrects the erroneously indicated filing date of any earlier application, the receiving Office shall enter the corrected date in the request, draw a line through the previously entered date while still leaving it legible, and enter, in the margin, the letters "RO."

(b) Where, under Rule 4.10(d), the receiving Office cancels the declaration claiming priority made under Article 8(1), that Office shall enclose the indication on the request which contains the information concerning the priority claim (or, where the priorities of several earlier applications are claimed and not all those priority claims are cancelled, the relevant part of the indication) within square brackets, shall draw a line between the square brackets while still leaving the indication or the relevant part legible and shall enter, in the margin, the words "CANCELLED ON REQUEST OF APPLICANT" or "CANCELLED EX OFFICIO BY RO", as the case may be, or their equivalent in the language of publication of the international application.

(c) The applicant and, if copies of the international application have already been sent to the International Bureau and the International Searching Authority, that Bureau and that Authority shall be notified by the receiving Office of any correction or cancellation of a priority claim effected under Rule 4.10(d) by the receiving Office.

(d) Paragraphs (a) and (c) shall apply *mutatis mutandis* to the correction of an obvious error under Rule 4.10(b).

### Section 315

#### Notification Concerning Confirmation of Designation

Where a designation made under Rule 4.9(b) has been confirmed under Rule 4.9(c), the receiving Office shall promptly notify the applicant and the International Bureau.

### Section 316

#### Procedure in the Case Where the International Application Lacks the Prescribed Signature

Where, under Article 14(1)(a)(i), the receiving Office finds that the international application is defective in that it lacks the prescribed signature, that Office shall send to the applicant, together with the invitation to correct under Article 14(1)(b), a copy of the relevant sheet of the request part of the international application. The applicant shall, within the prescribed time limit, return said copy after affixing thereto the prescribed signature.

### Section 317

[Deleted]

### Section 318

#### Cancellation of Designations of Non-Contracting States

The receiving Office shall cancel *ex officio* the designation of any State which is not a Contracting State, shall enclose that designation within square brackets, shall draw a line between the square brackets while still leaving the designation legible, shall enter, in the margin, the words "CANCELLED EX OFFICIO BY RO" or their equivalent in the language of publication of the international application, and shall promptly notify the applicant accordingly. If the record copy has already been sent to the International Bureau, the receiving Office shall also notify that Bureau.



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### Section 319

#### Later Indication of Priority Application Number

Where the application number of the earlier application referred to in Rule 4.10(c) (priority application number) is furnished to the receiving Office, that Office shall enter the said number on the request or, where the record copy has already been sent to the International Bureau, promptly notify that Bureau of the said number, and shall notify the International Bureau of the date on which it received the said number.

### Section 320

#### Invitation to Pay Fees under Rule 16<sup>bis</sup>.1(a) and (b)

(a) If invitations to pay fees are required to be issued by the receiving Office under both paragraph (a) and paragraph (b) of Rule 16<sup>bis</sup>.1, those invitations may be issued as separate invitations unless the due dates for the fees concerned are less than 15 days apart, in which case those invitations shall preferably be issued as a single invitation.

(b) Where the receiving Office requires the payment of the late payment fee under Rule 16<sup>bis</sup>.2, it shall calculate the amount of that fee on the basis of the total amount of the fees due referred to in the invitation under paragraph (a).

(c) When issuing an invitation under paragraph (a), the receiving Office shall, if it received moneys from the applicant before the due date, inform the applicant of the fees to which those moneys have been applied.

### Section 321

#### Application of Moneys Received by the Receiving Office in Certain Cases

(a) The receiving Office shall, to the extent that it has received instructions from the applicant as to the fees to which it shall apply moneys received by it from the applicant, apply those moneys accordingly.

(b) Where the receiving Office receives moneys from the applicant which, together with any other moneys so received, are not sufficient to cover in full the transmittal fee (if any), the international fee and the

search fee (if any), the receiving Office shall, to the extent that it has not received instructions from the applicant as to the fees to which it shall apply the moneys which are available for the purpose, apply those moneys in payment, successively, of the fees set out below to the extent that they are due and unpaid and in the order in which they appear below:

(i) the transmittal fee;

(ii) the basic fee part of the international fee;

(iii) the search fee;

(iv) the designation fee part of the international fee for designations made under Rule 4.9(a).

(c) Where, pursuant to paragraph (b), the receiving Office allocates moneys in payment of the designation fees to cover designations made under Rule 4.9(a), it shall apply them to those fees as follows:

(i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly but, if the amount received is insufficient to cover the designations indicated, it shall be applied in the order chosen by the applicant in indicating the designations;

(ii) to the extent that the applicant has not given the indications referred to in item (i), the amount, or the balance thereof, shall be applied to the designations in the order in which they appear in the request part of the international application;

(iii) where the designation of a State is for the purposes of a regional patent, and provided that the required designation fee is, under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.

(d) Where the receiving Office receives moneys from the applicant in response to an invitation under Rule 16<sup>bis</sup>.1 which are not sufficient to cover all the unpaid fees, including, where required, the late payment fee under Rule 16<sup>bis</sup>.2, the moneys shall be applied in the order referred to in paragraphs (b) and (c) to as many of the fees due, including any late payment fee, as can be covered.

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### Section 323

#### Transmittal of Priority Documents

(e) Where, pursuant to Rule 15.5(b), the receiving Office allocates moneys in payment of fees under Rule 15.5(a) in respect of the confirmation under Rule 4.9(c) of designations made under Rule 4.9(b), the receiving Office shall apply those moneys as follows:

(i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly, but, if the amount is insufficient to cover the designations indicated, it shall be applied to the designations in the order chosen by the applicant in indicating the designations;

(ii) to the extent that the applicant has not given the indications referred to in item (i), the amount, or the balance thereof, shall be applied to the designations in the order in which they appear in the notice containing the confirmation;

(iii) where the designation of a State is for the purposes of a regional patent, and provided that the required designation fee is, under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.

(f) When allocating moneys as provided in paragraph (e), both the designation fee and the confirmation fee must be covered in respect of each designation.

(g) Where moneys have been applied by the receiving Office in accordance with indications given by the applicant as mentioned in paragraph (c)(i) or (e)(i), the receiving Office shall inform the International Bureau as to the effect of the said indications, preferably by sending the International Bureau a copy of any relevant written communication received from the applicant.

### Section 322

#### Invitation to Submit a Request for Refund of the Search Fee

The receiving Office may, before making a refund of the search fee under Rule 16.2, first invite the applicant to submit a request for the refund.

(a) Any priority document which is submitted to the receiving Office shall be transmitted by that Office to the International Bureau together with the record copy or, if received after the record copy has been sent to the International Bureau, promptly after having been received by that Office.

(b) Where the applicant has requested the receiving Office to transmit a priority document under Rule 17.1(b), the receiving Office shall, promptly after receipt of a request for transmittal of the priority document and, where applicable, the payment of the fee referred to in that Rule, transmit the priority document to the International Bureau. Where such request for transmittal has been made but the required fee has not been paid, the receiving Office shall promptly notify the applicant that the request under Rule 17.1(b) will be considered not to have been made unless the fee is paid within 16 months from the priority date or, in the case referred to in Article 23(2), not later than at the time the processing or examination of the international application is requested.

(c) When transmitting a priority document, the receiving Office shall notify the International Bureau of the date on which it received the priority document or the request for transmittal thereof under Rule 17.1(b).

(d) Where a request under Rule 17.1(b) to transmit the priority document has been considered not to have been made, the receiving Office shall promptly inform the International Bureau. Where the receiving Office fails to inform the International Bureau accordingly within 17 months from the priority date, the receiving Office shall prepare and transmit the priority document to the International Bureau even though the required fee has not been paid by the applicant.

## PCT ADMINISTRATIVE INSTRUCTIONS

### Section 324

#### Copy of Notification of the International Application Number and the International Filing Date under Rule 20.5(c)

The copy, sent to the International Bureau, of the notification of the international application number and the international filing date under Rule 20.5(c) shall also include, if the priority of an earlier application is claimed in the international application, the date of filing—as indicated in the international application—of that earlier application. If the priority of several earlier applications is claimed, the earliest filing date shall be indicated.

### Section 325

#### Corrections of Defects under Rule 26.4(a), Rectifications of Obvious Errors under Rules 4.10(b) and 91.1, and Corrections under Rule 9.2

(a) Where the receiving Office receives a correction of defects under Rule 26.4(a), makes a correction of an obvious error under Rule 4.10(b) or authorizes a rectification of an obvious error 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 that sheet was received;

(ii) indelibly mark, in the middle of the bottom margin of each replacement sheet, the words “SUBSTITUTE SHEET (RULE 26)” (where the replacement sheet contains a correction of defects under Rule 26) or “RECTIFIED SHEET” (where the replacement sheet contains the rectification of an obvious error) or their equivalent in the language of publication of the international application;

(iii) indelibly mark on the letter containing the correction or 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 correction or rectification or, when the

correction or 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) subject to item (vi), promptly transmit any letter and any replacement sheet to the International Bureau, and a copy thereof to the International Searching Authority;

(vi) where transmittals under Article 12(1) have not yet been made, transmit any letter and any replacement sheet to the International Bureau together with the record copy and, except where the international application is considered withdrawn and Rule 29.1(a)(iii) applies, a copy of the said letter or replacement sheet to the International Searching Authority together with the search copy. The record copy and the search copy shall contain any replaced sheet.

(b) Where the receiving Office refuses to authorize the rectification of an obvious error under Rule 91.1 or correction of an obvious error under Rule 4.10(b), 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. If the record copy has not yet been sent to the International Bureau, any letter and any proposed replacement sheet shall be transmitted together with the record copy.

(c) Where the receiving Office receives corrections aimed at complying with Rule 9.1, paragraphs (a) and (b) shall apply *mutatis mutandis*, provided that, where a sheet is marked as indicated in paragraph (a)(ii), the words “SUBSTITUTE SHEET (RULE 9.2)” shall be used.

### Section 326

#### Withdrawal by Applicant Under Rule 90<sup>bis</sup>.1, 90<sup>bis</sup>.2 or 90<sup>bis</sup>.3

(a) The receiving Office shall promptly transmit to the International Bureau any notice from the applicant effecting withdrawal of the international application under Rule 90<sup>bis</sup>.1, of a designation under Rule 90<sup>bis</sup>.2 or of a priority claim under Rule 90<sup>bis</sup>.3 which has been filed with it together with an indication of the date of receipt of the notice. If the record copy has not yet been

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sent to the International Bureau, the receiving Office shall transmit the said notice together with the record copy.

(b) If the search copy has already been sent to the International Searching Authority and the international application is withdrawn under Rule 90<sup>bis</sup>.1 or a priority claim is withdrawn under Rule 90<sup>bis</sup>.3, the receiving Office shall promptly transmit a copy of the notice effecting withdrawal to the International Searching Authority.

(c) If the search copy has not yet been sent to the International Searching Authority and the international application is withdrawn under Rule 90<sup>bis</sup>.1, the receiving Office shall not send the search copy to the International Searching Authority and shall, subject to Section 322, refund the search fee to the applicant unless it has already been transferred to the International Searching Authority. If the search fee has already been transferred to the International Searching Authority, the receiving Office shall send a copy of the request and of the notice effecting withdrawal to that Authority.

(d) If the search copy has not yet been sent to the International Searching Authority and a priority claim is withdrawn under Rule 90<sup>bis</sup>.3, the receiving Office shall transmit a copy of the notice effecting withdrawal to the International Searching Authority together with the search copy.

### Section 327

#### *Ex officio* Correction of Request by the Receiving Office

(a) Where the record copy has not yet been sent to the International Bureau and the request requires correction because it contains an inconsistency or a minor defect such as noncompliance with the requirement for indications under Section 115, the receiving Office may correct the request *ex officio*. If the receiving Office does so, it shall notify the applicant accordingly.

(b) When making a correction under paragraph (a), the receiving Office shall enter, in the margin, the letters "RO." Where any matter is to be deleted, the receiving Office shall enclose such matter within square brackets and shall draw a line between the square brackets

while still leaving the deleted matter legible. Where any matter is to be replaced, both the first and second sentences of this paragraph shall apply.

(c) The receiving Office shall check the number of characters of the file reference, if any, and shall delete any characters beyond the number permitted by Section 109.

### Section 328

#### Notifications Concerning Representation

(a) Where a power of attorney or a document containing the revocation or renunciation of an appointment is submitted to the receiving Office and the record and search copies have already been transmitted, the receiving Office shall immediately notify the International Bureau and the International Searching Authority by sending them a copy of the power of attorney or document and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92<sup>bis</sup>.1(a)(ii).

(b) If the record copy and/or search copy have not yet been transmitted by the receiving Office, a copy of the power of attorney or document containing the revocation or renunciation of an appointment shall be transmitted by the receiving Office with the record copy and/or search copy.

### Section 329

#### Correction of Indications Concerning the Applicant's Residence or Nationality

Where, in response to an invitation to correct a defect under Article 11(1)(i), evidence is submitted indicating to the satisfaction of the receiving Office that, in fact, the applicant had, on the date on which the international application was actually received, the right to file an international application with that receiving Office, the invitation shall be considered to be an invitation to correct a defect under Article 14(1)(a)(ii) and Rule 4.5 in the prescribed indications concerning the applicant's residence and/or nationality, and the applicant may correct those indications accordingly. If such correction is made, no defect shall be considered to exist under Article 11(1)(i).

## PCT ADMINISTRATIVE INSTRUCTIONS

### Section 330

#### **Transmittal of Record Copy Prevented or Delayed by National Security Prescriptions**

(a) Where prescriptions concerning national security prevent the transmittal of the record copy by the receiving Office to the International Bureau under Rule 22.1(a), the receiving Office shall notify the applicant and the International Bureau accordingly.

(b) The notifications under paragraph (a) shall be sent before the expiration of 13 months from the priority date. Where the receiving Office believes that national security clearance is imminent, it may postpone the sending of the notifications, but shall send them before the expiration of 17 months from the priority date if no clearance has been given by that time.

### Section 331

#### **Receipt of Confirmation Copy**

Where, subject to Rule 92.4, the receiving Office receives an international application by facsimile machine transmission and subsequently receives the original of that international application, it shall mark such original with the words "CONFIRMATION COPY" or their equivalent in the language of publication of the international application on the bottom of the first page of the request and on the first page of the description. The marking under Section 325 is not required in such a case. The international application as received by facsimile machine transmission shall constitute the record copy. The confirmation copy shall be transmitted to the International Bureau in addition to the record copy.

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## PART 4

### INSTRUCTIONS RELATING TO THE INTERNATIONAL BUREAU

#### Section 401

##### Marking of the Sheets of the Record Copy

(a) The International Bureau shall, upon receipt of the record copy, mark the date of receipt of the record copy in the appropriate space on the request.

(b) If the receiving Office has failed to mark any sheet as provided in Sections 311 and 325, the marking which has not been made may be inserted by the International Bureau.

#### Section 402

##### Correction or Cancellation of a Priority Claim under Rule 4.10(d)

(a) Where, in reply to an invitation issued by the International Bureau to cancel or correct a priority claim under Rule 4.10(d), the applicant corrects the erroneously indicated filing date of any earlier application, the International Bureau shall enter the corrected date in the request, draw a line through the previously entered date while still leaving it legible, and enter, in the margin, the letters IB.

(b) Where, under Rule 4.10(d), the International Bureau cancels the declaration claiming priority made under Article 8(1), that Bureau shall enclose the indication on the request which contains the information concerning the priority claim (or, where the priorities of several earlier applications are claimed and not all those priority claims are cancelled, the relevant part of the indication) within square brackets, shall draw a line between the square brackets while still leaving the indication (or its relevant part) legible, and shall enter, in the margin, the words "CANCELLED ON REQUEST OF APPLICANT" or "CANCELLED EX OFFICIO BY IB," as the case may be, or their equivalent in French.

(c) The applicant, the receiving Office, and the International Searching Authority shall be notified by the International Bureau of any correction or cancella-

tion of a priority claim effected under Rule 4.10(d) by the International Bureau.

(d) Any designated Office which has been notified under Rule 24.2(b) of the receipt of the record copy shall be notified by the International Bureau of any correction or cancellation of a priority claim effected under Rule 4.10(d) by the receiving Office or the International Bureau.

#### Section 403

##### Transmittal of Protest Against Payment of Additional Fee and Decision Thereon Where International Application Is Considered To Lack Unity of Invention

Where, under Rules 40.2(c) or 68.3(c), the International Bureau receives a request from the applicant to forward to any designated or elected Office the texts of both the protest against payment of an additional fee as provided for in Articles 17(3)(a) and 34(3)(a) where the international application is considered to lack unity of invention and the decision thereon by the International Searching Authority or the International Preliminary Examining Authority, as the case may be, it shall proceed according to such request.

#### Section 404

##### International Publication Number of International Application

The International Bureau shall assign to each published international application an international publication number which shall be different from the international application number. The international publication number shall be used on the pamphlet and in the Gazette entry. It shall consist of the two-letter code WO followed by a two-digit designation of the last two numbers of the year of publication, a slant, and a serial number consisting of five digits (e.g., "WO78/12345").

#### Section 405

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## PCT ADMINISTRATIVE INSTRUCTIONS

### Section 406

#### Pamphlets

(a) Pamphlets referred to in Rule 48.1 shall be published on a given day of the week.

(b) All pamphlets shall be of A4 size and shall be reproduced *recto verso*, except that drawings shall be reproduced *recto* only.

(c) The form and particulars of the front page of each pamphlet shall be decided by the Director General.

### Section 407

#### The Gazette

(a) The Gazette referred to in Rule 86 shall be of A4 size and shall be reproduced *recto verso*.

(b) In addition to the contents specified in Rule 86, the Gazette shall contain, in respect of each published international application, the data indicated in Annex D.

(c) The information referred to in Rule 86.1(v) shall be that which is indicated in Annex E.

### Section 408

#### Priority Application Number

(a) If the application number of the earlier application referred to in Rule 4.10(c) (priority application number) is furnished within the prescribed time limit, the International Bureau shall enter the said number on the request, unless already done by the receiving Office under Section 319.

(b) If the priority application number is furnished after the expiration of the prescribed time limit, the International Bureau shall inform the applicant and the designated Offices of the date on which the said number was furnished. It shall indicate the said date in the international publication by including on the front page of the pamphlet next to the priority application number the words "FURNISHED LATE ON ... (date)," and the equivalent of such words in the language in which

the international application is published if that language is other than English.

(c) If the priority application number has not been furnished at the time of the completion of the technical preparations for international publication, the International Bureau shall indicate that fact by including on the front page of the pamphlet in the space provided for the priority application number the words "NOT FURNISHED" and the equivalent of such words in the language in which the international application is published if that language is other than English.

### Section 409

#### Notification of Priority Claim Considered Not To Have Been Made

Where the International Bureau notes that the receiving Office has failed to notify the applicant as provided in Section 302, it shall send a notification to the same effect to the applicant, the receiving Office, and the International Searching Authority.

### Section 410

#### Numbering of Sheets for the Purposes of International Publication; Procedure in Case of Missing Sheets or Drawings

(a) In the course of preparing the international application for international publication, the International Bureau shall sequentially renumber the sheets of the international application only when necessitated by the addition of any new sheet, the deletion of entire sheets or a change in the order of the sheets. Otherwise, the numbering provided under Section 207 shall be maintained.

(b) Where a sheet or a drawing has not been filed or is not to be taken into consideration for the purposes of international processing under Section 309(c) or Section 310(d), the International Bureau shall include an indication to that effect in the pamphlet.

# MANUAL OF PATENT EXAMINING PROCEDURE

## Section 411

### Receipt of Priority Document

(a) Subject to paragraph (b), the International Bureau shall record the date on which the priority document has been received by it and shall notify the applicant accordingly.

(b) Where the priority document has been received by the International Bureau from the receiving Office after the expiration of 16 months from the priority date, the date of receipt by the receiving Office of the priority document or of a request under Rule 17.1(b), as the case may be, shall be recorded as the date of receipt of the priority document.

(c) Where the date of receipt of the priority document is later than the expiration of 16 months from the priority date, the International Bureau shall promptly notify the applicant. The designated Offices shall be so notified together with the notification under Rule 47.1(a<sup>bis</sup>).

(d) Where the International Bureau has not received, before the expiration of 16 months from the priority date, the priority document or information that the applicant has made a request under Rule 17.1(b) for the receiving Office to transmit the priority document, the International Bureau shall promptly notify the applicant. The designated Offices shall be so notified together with the notification under Rule 47.1(a<sup>bis</sup>).

## Section 412

### Notification of Lack of Transmittal of Search Copy

If the International Bureau does not receive from the International Searching Authority a notification under Rule 25.1 within two months from the date of receipt of the record copy, the International Bureau shall remind the receiving Office to transmit the search copy to the International Searching Authority. A copy of the reminder shall be sent to the International Searching Authority.

## Section 413

### Corrections of Defects under Rule 26.4(a), Rectifications of Obvious Errors under Rules 4.10(b) and 91.1 and Corrections under Rule 9.2

(a) Where the International Bureau receives from the receiving Office a letter containing a correction of any defects under Rule 26.4(a), or a replacement sheet and the letter accompanying it, the International Bureau shall transfer the correction to the record copy, together with the indication of the date on which the receiving Office received the letter, or shall insert the replacement sheet in the record copy. Any letter and any replaced sheet shall be kept in the file of the international application.

(b) Paragraph (a) shall apply *mutatis mutandis* to rectifications of obvious errors authorized by the receiving Office or by the International Searching Authority under Rule 91.1, to corrections of obvious errors made by the receiving Office under Rule 4.10(b) and to corrections submitted by the applicant to the receiving Office or the International Searching Authority aimed at complying with the prescription of Rule 9.1 concerning certain expressions, drawings, statements, or other matter.

## Section 414

### Notification to the International Preliminary Examining Authority Where the International Application or the Designations of All Elected States Are Considered Withdrawn

If a demand has been submitted and the international application or the designations of all designated States which have been elected are considered withdrawn under Article 14(1), (3), or (4), the International Bureau shall promptly notify the International Preliminary Examining Authority, unless the international preliminary examination report has already issued.

## Section 415

### Notification of Withdrawal under Rule 90<sup>u</sup>.1, 90<sup>u</sup>.2, 90<sup>u</sup>.3 or 90<sup>u</sup>.4

(a) The fact of withdrawal by the applicant of the international application under Rule 90<sup>bis</sup>.1, of designations under Rule 90<sup>bis</sup>.2, or of a priority claim under Rule 90<sup>bis</sup>.3, together with the date on which the notice effecting withdrawal reached the International Bureau,



## PCT ADMINISTRATIVE INSTRUCTIONS

the International Preliminary Examining Authority or the receiving Office, shall be recorded by the International Bureau and promptly notified by it to the receiving Office, the applicant, the designated Offices affected by the withdrawal if they have already been notified of their designation and, where the withdrawal concerns the international application or a priority claim and where the international search report or the declaration referred to in Article 17(2)(a) has not yet issued, the International Searching Authority. However, where the withdrawal concerns the international application and where the notice effecting withdrawal was filed with the receiving Office before the sending of the record copy to the International Bureau, that Bureau shall send the notifications referred to in the preceding sentence and in Rule 24.2(a) to the receiving Office and the applicant only.

(b) If, at the time of the withdrawal of the international application under Rule 90<sup>bis</sup>.1, or of a priority claim under Rule 90<sup>bis</sup>.3, a demand has already been submitted and the international preliminary examination report has not yet issued, the International Bureau shall, unless the notice effecting withdrawal was submitted to the International Preliminary Examining Authority, promptly notify the fact of withdrawal to that Authority, together with the date on which the notice effecting withdrawal has reached the International Bureau or the receiving Office.

(c) The fact of withdrawal by the applicant of the demand or of one or more elections under Rule 90<sup>bis</sup>.4, together with the date on which the notice effecting withdrawal was, or was considered to have been, submitted to the International Bureau, shall be promptly notified by that Bureau:

(i) to the applicant,

(ii) to each elected Office affected by the withdrawal, except where it has not yet been notified of its election, and

(iii) in the case of withdrawal of the demand or of all elections, to the International Preliminary Examining Authority, unless the notice effecting withdrawal was submitted to that Authority.

### Section 416

#### Correction of Request in Record Copy

(a) Where the request requires correction as a consequence of the withdrawal of a designation or of a change made under Rule 92<sup>bis</sup>, the International Bureau shall make the necessary correction in the record copy and shall notify the applicant and the receiving Office accordingly.

(b) When making a correction under paragraph (a), the International Bureau shall enter, in the margin, the letters "IB." Where the correction involves the deletion or replacement of some matter, the International Bureau shall enclose such matter within square brackets and shall draw a line between the square brackets while still leaving the deleted or replaced matter legible.

### Section 417

#### Processing of Amendments under Article 19

(a) The International Bureau shall record the date on which, under Rule 46.1, any amendment made under Article 19 was received, shall notify the applicant of that date and indicate it in any publication or copy issued by it.

(b) The International Bureau shall mark, in the upper right-hand corner of each replacement sheet submitted under Rule 46.5(a), the international application number the date on which that sheet was received under Rule 46.1 and, in the middle of the bottom margin, the words "AMENDED SHEET (ARTICLE 19)." It shall keep in its files any replaced sheet, the letter accompanying the replacement sheet or sheets, and any letter referred to in the last sentence of Rule 46.5(a).

(c) The International Bureau shall insert any replacement sheet in the record copy and, in the case referred to in the last sentence of Rule 46.5(a), shall indicate the cancellations in the record copy.

(d) If, at the time when the demand is received by the International Bureau, the international search report has been established and no amendments under Article 19 have been made, the International Bureau shall inform the International Preliminary Examining Authority accordingly.

## MANUAL OF PATENT EXAMINING PROCEDURE

### Section 418

#### Notifications to Elected Offices Where the Demand or an Election Is Considered Not To Have Been Submitted or Made

Where, after any elected Office has been notified of its election under Article 31(7), the demand or the election is considered not to have been submitted or made, the International Bureau shall notify the said Office accordingly.

### Section 419

[Deleted]

### Section 420

#### Copy of International Application and International Search Report for the International Preliminary Examining Authority

Where the International Preliminary Examining Authority is not part of the same national Office or inter-governmental organization as the International Searching Authority, the International Bureau shall, promptly upon receipt of the international search report or, if the demand was received after the international search report, promptly upon receipt of the demand, send a copy of the international application and the international search report to the International Preliminary Examining Authority. In cases where, instead of the international search report, a declaration under Article 17(2)(a) was issued, references in the preceding sentence to the international search report shall be considered references to the said declaration.

### Section 421

#### Invitation To Furnish a Copy of the Priority Document

Where a request for a copy of the application whose priority is claimed in the international application is made under Rule 66.7(a) by the International Preliminary Examining Authority before the International Bureau has received the priority document under Rule 17.1, the International Bureau shall, unless the applicable time limit referred to in Rule 17.1(a) has already expired, inform the applicant of such request and remind him of the requirements of Rule 17.1.

### Section 422

#### Notifications Concerning Changes Recorded under Rule 92<sup>bis</sup>.1

(a) The International Bureau shall give notifications concerning changes recorded by it under Rule 92<sup>bis</sup>.1(a), except changes which are the subject of notifications under Section 425:

(i) to the receiving Office;

(ii) as long as the international search report has not been established, to the International Searching Authority;

(iii) to the designated Offices, unless the change has been recorded after the expiration of the time limit referred to in Article 22(1) or unless the change can be duly reflected in the pamphlet used for the purposes of the communication of the international application under Article 20;

(iv) as long as the international preliminary examination report has not been established, to the International Preliminary Examining Authority;

(v) to the elected Offices, unless the change can be duly reflected in the pamphlet used for the purposes of the communication of the international application under Article 20;

(vi) to the applicant; where the change consists of a change in the person of the applicant, the notification shall be sent to the earlier applicant and the new applicant, provided that, where the earlier applicant and the new applicant are represented by the same agent, one notification only shall be sent to the said agent.

(b) Where Rule 92<sup>bis</sup>.1(b) applies, the International Bureau shall notify the applicant accordingly and, if the change was requested by the receiving Office, that Office.

### Section 423

#### Cancellation of Designations and Elections

(a) The International Bureau shall, if the receiving Office has failed to do so, cancel *ex officio* the designation of any State which is not a Contracting State, shall enclose that designation within square brackets, draw a line between the square brackets while still leaving the

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designation legible, enter, in the margin, the words "CANCELLED *EX OFFICIO*" BY IB or their equivalent in French, and notify the applicant and the receiving Office accordingly.

(b) The International Bureau shall cancel *ex officio*:

(i) the election, in the demand or in a notice effecting a later election, of any State which is not a designated State;

(ii) the election, in the demand, of any State not bound by Chapter II of the Treaty, if the International Preliminary Examining Authority has failed to do so;

(iii) the election, in a notice effecting a later election, of any State not bound by Chapter II of the Treaty.

(c) The International Bureau shall enclose the cancelled election within square brackets, draw a line between the square brackets while still leaving the election legible, enter, in the margin, the words "CANCELLED EX OFFICIO BY IB" or their equivalent in French, and notify the applicant and, if the election is in the demand, the International Preliminary Examining Authority accordingly.

### Section 424

[Deleted]

### Section 425

#### Notifications Concerning Representation

Where a power of attorney or a document containing the revocation or renunciation of an appointment is submitted to the International Bureau, the International Bureau shall immediately notify the receiving Office, the International Searching Authority and the International Preliminary Examining Authority by sending them a copy of the power of attorney or document and shall record a change in the indications concerning the agent or common representative under Rule 92<sup>bis</sup>. In the case of a renunciation of an appointment, the International Bureau shall also notify the applicant. Where the International Bureau receives a notification concerning representation under Section 328, it shall immediately notify

the International Preliminary Examining Authority accordingly.

### Section 426

#### Notification of Designation under Rule 24.2(b)

Each designated Office having notified the International Bureau under Rule 24.2(b) that it wishes to receive the notification under Rule 24.2(a) shall receive periodically, but at least once a month, a listing of the international applications containing the designation(s) of the State(s) for which that Office acts as a designated Office, including designations made under Rule 4.9(a) and those made under Rule 4.9(b) which have been confirmed under Rule 4.9(c). Such listing shall contain, in respect of each designation:

- (i) the international application number,
- (ii) the international filing date,
- (iii) the name of the applicant, and
- (iv) the earliest priority date claimed.

### Section 427

#### Publication of Notice of Confirmation of Designation

Where an international application has been published under Article 21(2)(b) before the confirmation of a designation under Rule 4.9(c), a notice of that confirmation shall be published in the Gazette.

### Section 428

#### Publication of Notice of Later Election

Where a later election is made before the expiration of 19 months from the priority date, a notice of that fact shall be published in the Gazette.

## MANUAL OF PATENT EXAMINING PROCEDURE

### Section 429

#### Notice of Extension

Where a request for extension of the effects of an international application to a successor State, made in accordance with Rule 32.1(c), is received by the International Bureau after technical preparations for international publication have been completed, a notice of this fact shall be published in the Gazette.

### Section 430

#### Notification of Designations under Rule 32 (Extensions)

Where the request for extension is made under Rule 32.1(c), the International Bureau shall promptly, but not before the international publication of the international application, effect the communication under Article 20 to the designated Office concerned, notify that Office under Rule 47.1(a<sup>bis</sup>), and notify it of the date of the receipt of the request for extension.

## 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 International Searching Authority receives corrections aimed at complying with Rule 9.1, Section 511 shall apply *mutatis mutandis*, provided that, where a sheet is marked as indicated in Section 511(a)(ii), the words "SUBSTITUTE SHEET (RULE 9.2)" shall be used.

#### Section 502

##### Transmittal of Protest Against Payment of Additional Fee and Decision Thereon Where International Application Is Considered To Lack Unity of Invention

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 payment of an additional fee where the international application is considered to lack unity of 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 the designated Offices.

#### Section 503

##### Method of Identifying Documents Cited in the International Search Report

Identification of any document cited in the international search report shall be as provided in WIPO Standard ST.14 (Recommendation for the Inclusions of References Cited in Patent Documents).<sup>5</sup>

<sup>5</sup> Published in the WIPO Handbook on Industrial Property Information and Documentation.

#### 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.

#### 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.

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(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.

### 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 as provided 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.

### 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.<sup>6</sup>

(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,<sup>7</sup>

— a document cited to establish the publication date of another citation,<sup>8</sup>  
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.

(g) Where a document is a member of a patent family,<sup>9</sup> 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

<sup>6</sup> See III.B.14 of the PCT Guidelines.

<sup>7</sup> See VI, 4.3 of the PCT Search Guidelines.

<sup>8</sup> See VI, 6.2 of the PCT Search Guidelines.

<sup>9</sup> See IV, 3.2 of the PCT Search Guidelines.

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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).<sup>10</sup>

**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, each relevant claim or group of claims shall be listed separately opposite each indicated category of relevance. Each category and each relevant claim or group of claims may be separated by a line.

*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 claims 11 and 12:*

<i>Category</i>	<i>Citation</i>	<i>Relevant to claim No.</i>
	GB, A 392,415 (JONES) 18 May 1933 (18.05.33)	
X	Fig.1	1-3
Y	page 3, lines 5-7	4
A	Fig.5, support 36	11-12

*[End of example]*

**Section 509**

[Deleted]

**Section 510**

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

(a) Where the international application is withdrawn or is considered withdrawn before the International Searching Authority has started the international search, that Authority shall, subject to paragraphs (b) and (c), refund the search fee to the applicant.

<sup>10</sup> See VI, 5.2 of the PCT Search Guidelines.

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(b) 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.

(c) The International Searching Authority may, before making a refund under paragraph (a), first invite the applicant to submit a request for the refund.

### 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 that sheet was received;

(ii) indelibly mark, in the middle of the bottom margin of each replacement sheet, the words "RECTIFIED SHEET (RULE 91)" 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.

### Section 512

#### Notifications Concerning Representation

Where a power of attorney or a document containing the revocation or 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 or document and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92<sup>bis</sup>.1(a)(ii).

### Section 513

#### Sequence Listings

(a) Where the International Searching Authority finds that an international application contains a disclosure of a nucleotide and/or amino acid sequence but the international application does not contain a listing of that sequence, that Authority may invite the applicant to furnish it with a sequence listing which is in compliance with Section 208.

(b) Where a sequence listing has been furnished separately from the international application to the International Searching Authority or transcribed by that Authority, the international search report shall so indicate.

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

(d) The International Searching Authority shall indelibly mark, in the upper right-hand corner of the first sheet, and preferably of all sheets, of any sequence listing in printed form not forming part of the international application, the words "SEPARATELY FURNISHED SEQUENCE LISTING."



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### **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 or another person who was responsible for supervising the search.

### **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).

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

Where the 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.

Section 602

Processing of Amendments by the International  
Preliminary Examining Authority

(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 that sheet was received;

(ii) indelibly mark, in the middle of the bottom margin of each replacement sheet, the words "AMENDED SHEET" or their equivalent in the language of the demand 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)(ii) relating to the numbering 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 a purported 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*.

Section 603

Transmittal of Protest Against Payment of Additional  
Fee and Decision Thereon Where International  
Application Is Considered To Lack Unity of Invention

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 an additional fee where the international application is considered to lack unity of 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 the elected Offices.

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, inven-

## PCT ADMINISTRATIVE INSTRUCTIONS

tive step (nonobviousness) 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 preferably in the form of short sentences.

### 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.

### 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 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, and shall notify the applicant accordingly.

### Section 606<sup>u</sup>

#### Procedure Where 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.

### 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*, provided that, where a sheet is marked as indicated in Section 602, the words "RECTIFIED SHEET (RULE 91)" shall be used.

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*.

### Section 608

#### Notifications Concerning Representation

Where a power of attorney or a document containing the revocation or 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 or document and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92<sup>bis</sup>.1(a)(ii).

### Section 609

#### Withdrawal by Applicant under Rule 90<sup>u</sup>.1, 90<sup>u</sup>.2, or 90<sup>u</sup>.3

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

### 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

## MANUAL OF PATENT EXAMINING PROCEDURE

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 C.

### Section 611

#### Method of Identification of Documents in the International Preliminary Examination Report

Any document cited in the international preliminary examination report which was not cited in the international search report shall be cited in the same form as required under Section 503 for international search reports. Any document cited in the international preliminary examination report which was previously cited in the international search report may be cited in a shortened form, provided that the document is unambiguous.

### 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 or another person who was responsible for supervising the examination.

### Section 613

#### Invitation to Submit a Request for Refund of Fees under Rule 57.6 or 58.3

The International Preliminary Examining Authority may, before making a refund under Rule 57.6 or 58.3, first invite the applicant to submit a request for the refund.

### Section 614

#### Evidence of Right to File Demand

Where a demand is considered as not having been made under Rule 61.1(b) by the International Preliminary Examining Authority because the applicant appeared, on the basis of the indication made in the demand, not to have the right to file a demand with that Authority under Rule 54 but evidence is submitted indicating to the satisfaction of the International Preliminary Examining Authority that in fact, an applicant had, on the date on which the demand was received, the right to file the demand with that Authority, the International Preliminary Examining Authority shall regard the requirements under Article 31(2)(a) as having been fulfilled on the date of actual receipt of the demand.

[Annexes follow]

## PCT ADMINISTRATIVE INSTRUCTIONS

### ANNEX A<sup>11</sup>

#### FORMS

[This Annex contains all the Forms for use by applicants and by the International Authorities, including those referred to in Section 102 of these Administrative Instructions; it consists of five Parts as follows:

**Part I: Forms Relating to the Receiving Office**

**Part II: Forms Relating to the International Searching Authority**

**Part III: Forms Relating to the International Bureau**

**Part IV: Forms Relating to the International Preliminary Examining Authority**

**Part V: Request and Demand Forms]**

[Annex B follows]

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<sup>11</sup>. Annex A is not reproduced here. Each Part is published separately by the World Intellectual Property Organization.

ANNEX B

UNITY OF INVENTION

PART 1

INSTRUCTIONS CONCERNING UNITY OF INVENTION

(a) **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 general 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 and drawings (if any).

(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 fur-

ther 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 before the commencement of the international search. Where a search of the prior art is made, an initial determination of unity of invention, based on 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.

## PCT ADMINISTRATIVE INSTRUCTIONS

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.

Thus, 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.

Also 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 is 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

(B)(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

## MANUAL OF PATENT EXAMINING PROCEDURE

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.

(h) 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.



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(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 Searching or Preliminary Examining Authority or an 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 B, Part 2, follows]

# MANUAL OF PATENT EXAMINING PROCEDURE

## ANNEX B

### PART 2

#### EXAMPLES CONCERNING UNITY OF INVENTION

The application of the principles of unity of invention is illustrated by the following examples for guidance in particular cases.

##### I. CLAIMS IN DIFFERENT CATEGORIES

###### Example 1

**Claim 1:** A method of manufacturing chemical substance X.

**Claim 2:** Substance X.

**Claim 3:** The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

###### Example 2

**Claim 1:** A process of manufacture comprising steps A and B.

**Claim 2:** Apparatus specifically designed for carrying out step A.

**Claim 3:** Apparatus specifically designed for carrying out step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

###### Example 3

**Claim 1:** A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

**Claim 2:** A paint containing substance X.

**Claim 3:** An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A.

However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.

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### Example 4

**Claim 1:** Use of a family of compounds X as insecticides.

**Claim 2:** Compound X<sub>1</sub> belonging to family X.

Provided X<sub>1</sub> has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.

### Example 5

**Claim 1:** A process for treating textiles comprising spraying the material with a particular coating composition under special conditions (e.g., as to temperature, irradiation).

**Claim 2:** A textile material coated according to the process of claim 1.

**Claim 3:** A spraying machine for use in the process of claim 1 and characterized by a new nozzle arrangement providing a better distribution of the composition being sprayed.

The process according to claim 1 imparts unexpected properties to the product of claim 2.

The special technical feature in claim 1 is the use of special process conditions corresponding to what is made necessary by the choice of the particular coating. Unity exists between claims 1 and 2.

The spraying machine in claim 3 does not correspond to the above identified special technical feature. Unity does not exist between claim 3 and claims 1 and 2.

### Example 6

**Claim 1:** A fuel burner with tangential fuel inlets into a mixing chamber.

**Claim 2:** A process for making a fuel burner including the step of forming tangential fuel inlets into a mixing chamber.

**Claim 3:** A process for making a fuel burner including casting step A.

**Claim 4:** An apparatus for carrying out a process for making a fuel burner including feature X resulting in the formation of tangential fuel inlets.

**Claim 5:** An apparatus for carrying out a process for making a fuel burner including a protective housing B.

**Claim 6:** A process of manufacturing carbon black including the step of tangentially introducing fuel into a mixing chamber of a fuel burner.

Unity exists between claims 1, 2, 4, and 6. The special technical feature common to all the claims is the tangential fuel inlets. Claims 3 and 5 lack unity with claims 1, 2, 4, and 6 since claims 3 and 5 do not include the same or corresponding special technical feature as set forth in claims 1, 2, 4, and 6. Claims 3 and 5 would also lack unity with one another.

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### Example 7

**Claim 1:** A high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0–5.0; Cr=15–19; Mo=1–2; and the balance Fe having a thickness of between 0.5 and 2.0 mm and a 0.2% yield strength in excess of 50 kg/mm squared.

**Claim 2:** A method of producing a high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0–5.0; Cr=15–19; Mo=1–2; and the balance Fe, comprising the steps of:

hot rolling to a thickness between 2.0 and 5.0 mm;

annealing the hot rolled strip at 800–1000°C under substantially no oxidizing conditions;

cold rolling the strip to a thickness of between 0.5 and 2.0 mm; and final annealing the cold rolled strip at between 1120 and 1200°C for a period of 2–5 minutes.

Unity exists between product claim 1 and process claim 2. The special technical feature in the product claim is the 0.2% yield strength in excess of 50 kg/mm squared. The process steps in claim 2 inherently produce a ferritic stainless steel strip with a 0.2% yield strength in excess of 50 kg/mm squared. Even if this feature is not apparent from the wording of claim 2, it is clearly disclosed in the description. Therefore said process steps are the special technical feature which correspond to the limitation in the product claim directed to the same ferritic stainless steel with the claimed strength characteristics.

## II. CLAIMS IN THE SAME CATEGORY

### Example 8

**Claim 1:** Plug characterized by feature A.

**Claim 2:** Socket characterized by corresponding feature A.

Feature A is a special technical feature which is included in both claims 1 and 2 and therefore unity is present.

### Example 9

**Claim 1:** Transmitter provided with time axis expander for video signals.

**Claim 2:** Receiver provided with time axis compressor for video signals received.

**Claim 3:** Transmission equipment for video signals comprising a transmitter provided with time axis expander for video signals and a receiver provided with time axis compressor for video signals received.

The special technical features are in claim 1 the time axis expander, and in claim 2 the time axis compressor, which are corresponding technical features. Unity exists between claims 1 and 2. Claim 3 includes both special technical features and has unity with claims 1 and 2. The requirement for unity would still be met in the absence of the combination claim (claim 3).

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### Example 10

- Claim 1: Conveyor belt with feature A.
- Claim 2: Conveyor belt with feature B.
- Claim 3: Conveyor belt with features A + B.

Feature A is a special technical feature and feature B is another unrelated special technical feature. Unity exists between claims 1 and 3 or between claims 2 and 3, but not between claims 1 and 2.

### Example 11

- Claim 1: Control circuit A for a d.c. motor.
- Claim 2: Control circuit B for a d.c. motor.
- Claim 3: An apparatus including a d.c. motor with control circuit A.
- Claim 4: An apparatus including a d.c. motor with control circuit B.

Control circuit A is a special technical feature and control circuit B is another unrelated special technical feature. Unity exists between claims 1 and 3 or between claims 2 and 4, but not between claims 1 and 2 or 3 and 4.

### Example 12

- Claim 1: A display with features A + B.
- Claim 2: A display according to claim 1 with additional feature C.
- Claim 3: A display with features A + B with additional feature D.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is features A + B.

### Example 13

- Claim 1: Filament A for a lamp.
- Claim 2: Lamp B having filament A.
- Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is the filament A.

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### Example 14

**Claim 1:** A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disk element to be fastened to the protruding tip of the stem on the other side of skin.

**Claim 2:** An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the stem of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

### Example 15

**Claim 1:** Compound A.

**Claim 2:** An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

### Example 16

**Claim 1:** An insecticide composition comprising compound A (consisting of  $a_1, a_2 \dots$ ) and a carrier.

**Claim 2:** Compound  $a_1$ .

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance. There is nevertheless still unity between the subject matter of claims 1 and 2 provided  $a_1$  has the insecticidal activity which is also the special technical feature for compound A in claim 1.

### Example 17

**Claim 1:** Protein X

**Claim 2:** DNA sequence encoding protein X.

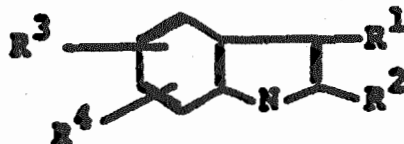
Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

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### III. MARKUSH PRACTICE

#### Example 18 — common structure:

Claim 1: A compound of the formula:



wherein  $R^1$  is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl;  $R^2$ – $R^2$  are methyl, benzyl, or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

#### Example 19 — common structure:

Claim 1: A compound of the formula:



wherein  $R_1$  is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl;  $Z$  is selected from the group consisting of oxygen (O), sulfur (S), imino (NH), and methylene ( $-\text{CH}_2-$ ). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group  $-\text{N}=\text{C}-\text{SCH}_3$  linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

MANUAL OF PATENT EXAMINING PROCEDURE

Example 20 — common structure

Claim 1: A compound of the formula:

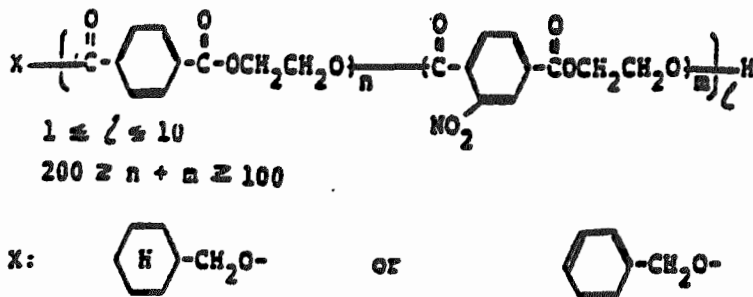


wherein R<sup>1</sup> is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S).

The compounds are useful as pharmaceuticals and contain the 1,3-thiazolyl substituent which provides greater penetrability of mammalian tissue which fact makes the compounds useful as relievers for headaches and as topical anti-inflammatory agents.

All compounds share a common chemical structure, the thiazole ring and the six atom heterocyclic compound bound to an imino group, which occupy a large portion of their structure. A six-membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

Example 21 — common structure:



All of the above copolymers have in common a thermal degradation resistance property, due to the reduced number of free COOH radicals by esterification with X of the end COOH radicals which cause thermal degradation. The chemical structures of the alternatives are considered to be technically closely interrelated to one another. A grouping in one claim is therefore allowed.



## PCT ADMINISTRATIVE INSTRUCTIONS

### Example 22 — common structure:



(polyhexamethyleneterephthalate)  
100 ≤ n ≤ 50



The compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephthalate with CH<sub>2</sub>O- has a thermal degradation resistant property, due to the reduced number of free COOH radicals which cause thermal degradation. In contrast, the compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephthalate with a vinyl compound containing a CH<sub>2</sub> = CH- CH<sub>2</sub>O- moiety serves as a raw material for a setting resin when mixed with unsaturated monomer and cured (addition reaction).

All esters covered by the claim do not have a property or activity in common. For example, the product obtained through esterification with the "CH<sub>2</sub> = CH" vinyl compound does not have a thermal degradation resistant property. The grouping in a single application is not allowed.

### Example 23 — No common structure:

**Claim 1:** A herbicidal composition consisting essentially of an effective amount of the mixture of A 2,4-D(2,4-dichloro-phenoxy acetic acid) and B a second herbicide selected from the group consisting of copper sulfate, sodium chlorate, ammonium sulfamate, sodium trichloroacetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid, diphenamid (an amide), ioxynil (nitrile), dinoseb (phenol), trifluralin (dinitroaniline), EPTC (thiocarbamate), and simazine (triazine) along with an inert carrier or diluent.

The different components under B must be members of a recognized class of compounds. Consequently in the present case a unity objection would be raised because the members of B are not recognized as a class of compounds, but, in fact, represent a plurality of classes which may be identified as follows:

- a) **inorganic salts:**
  - copper sulfate
  - sodium chlorate
  - ammonium sulfamate
- b) **organic salts and carboxylic acids:**
  - sodium trichloroacetate
  - dichloropropionic acid
  - 3-amino-2,5-dichlorobenzoic acid

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- c) **amides:**  
diphenamid
- d) **nitriles:**  
ioxynil
- e) **phenols:**  
dinoseb
- f) **amines:**  
trifluralin
- g) **heterocyclic:**  
simazine

### Example 24

**Claim 1:** Catalyst for vapor phase oxidation of hydrocarbons, which consists of (X) or (X + a).

In this example (X) oxidizes  $RCH_3$  into  $RCH_2OH$  and (X+a) oxidizes  $RCH_3$  further into  $RCOOH$ .

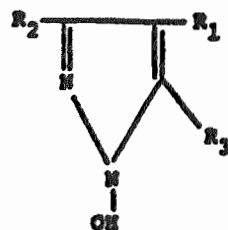
Both catalysts share a common component and a common activity as oxidation catalyst for  $RCH_3$ . With (X+a) the oxidation is more complete and goes until the carboxylic acid is formed but the activity still remains the same.

A Markush grouping is acceptable.

## IV. INTERMEDIATE/FINAL PRODUCTS

### Example 25

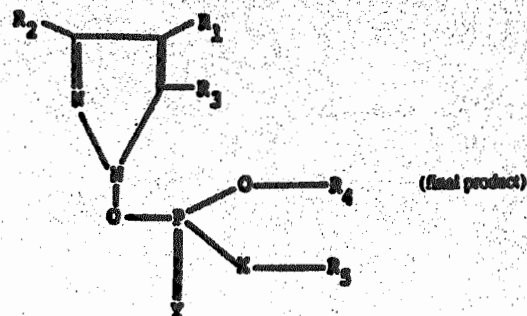
**Claim 1:**



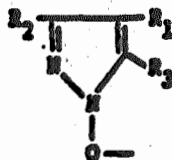
(intermediate)

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Claim 2:



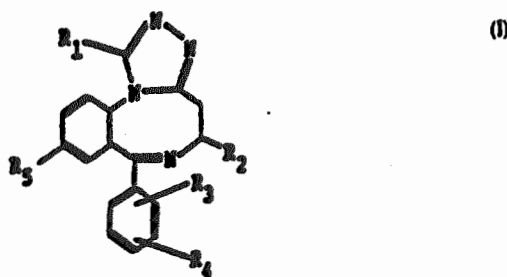
The chemical structures of the intermediate and final product are technically closely interrelated. The essential structural element incorporated into the final product is:



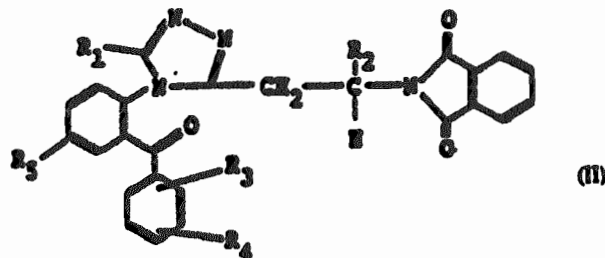
Therefore, unity exists between claims 1 and 2.

Example 26

Claim 1:



Claim 2:



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(II) is described as an intermediate to make (I). The closure mechanism is one well known in the art. Though the basic structures of compound (I) (final product) and compound (II) (intermediate) differ considerably, compound (II) is an open ring precursor to compound (I). Both compounds share a common essential structural element which is the linkage comprising the two phenyl rings and the triazole ring. The chemical structures of the two compounds are therefore considered to be technically closely interrelated.

The example therefore satisfies the requirement for unity of invention.

### Example 27

Claim 1: Amorphous polymer A (intermediate).

Claim 2: Crystalline polymer A (final product).

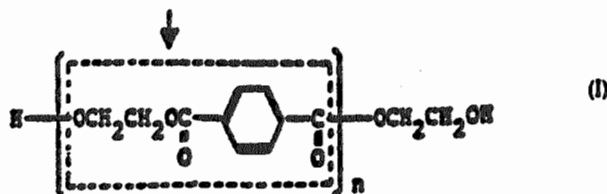
In this example a film of the amorphous polymer A is stretched to make it crystalline. Here unity exists because there is an intermediate final product relation in that amorphous polymer A is used as a starting product to prepare crystalline polymer A.

For purposes of further illustration, assume that the polymer A in this example is polyisoprene. Here the intermediate, amorphous polyisoprene, and the final product, crystalline polyisoprene, have the same chemical structure.

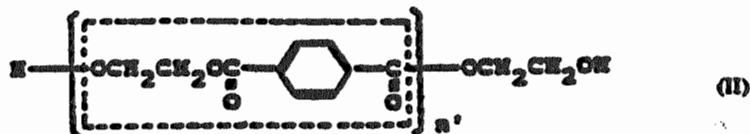
### Example 28

Claim 1: Polymeric compound useful as fiber material identified by the following general formula:

[repeating unit (X)]



Claim 2: Compound identified by the following general formula:  
(useful as intermediate for polymeric compound I)



(primary condensation product)

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The two inventions are in an intermediate and final product relationship.

Substance (II) is a raw material for substance (I).

Meanwhile, both compounds share an essential structural element (repeating unit (X)) and are technically closely interrelated. The intermediate and final products therefore satisfy the requirements for unity.

### Example 29

Claim 1: Novel compound having structure A (Intermediate).

Claim 2: Product prepared by reacting A with a substance X (Final Product).

### Example 30

Claim 1: Reaction product of A and B (Intermediate).

Claim 2: Product prepared by reacting the reaction product of A and B with substances X and Y (Final Product).

In examples 29 and 30 the chemical structure(s) of the intermediate and/or the final product is not known. In (29) the structure of the product of claim 2 (the final product) is not known. In (30) the structures of the products of claim 1 (the intermediate) and claim 2 (the final product) are unknown. Unity exists if there is evidence which would lead one to conclude that the characteristic of the final product which is the inventive feature in the case is due to the intermediate. For example, the purpose for using the intermediates in (29) or (30) is to modify certain properties of the final product. The evidence may be in the form of test data in the specification showing the effect of the intermediate on the final product. If no such evidence exists then there is no unity on the basis of an intermediate-final product relationship.

[Annex C follows]

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**ANNEX C**

**FORMAT FOR NUCLEOTIDE AND /OR AMINO ACID  
SEQUENCE LISTINGS IN MACHINE READABLE FORM**

**Australian Patent Office**

Machine readable form is not required.

OCR format is accepted and must comply with WIPO Standard ST.22.<sup>12</sup>

No requirement for electronic form but acceptable as follows:

**(a) Medium:**

**Diskette:**

5.25 inch, 360 Kb storage

5.25 inch, 1.2 Mb storage

3.5 inch, 720 Kb storage

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)**

**Austrian Patent Office**

Machine readable form is not required.

OCR format is accepted and must comply with WIPO Standard ST.22.<sup>12</sup>

**European Patent Office**

Machine readable form is not required but is recommended until January 1993, when it is expected to become mandatory.

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.

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<sup>12</sup> Published in the WIPO Handbook on Industrial Property Information and Documentation.

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### 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<sup>13</sup>, but the recommendation is not a statutory requirement.

#### 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

### Russian Patent Office

Machine readable form is not required.

### Swedish Patent Office

Machine readable form is not required.

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<sup>13</sup> Published in the WIPO Handbook on Industrial Property Information and Documentation.

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### United Kingdom Patent Office

Machine readable form is 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 1.821 to 1.825 of title 37, Code of Federal Regulations (37 CFR) relate to sequence listings submitted to the USPTO. Sections 1.824 and 1.825 which set forth the requirements for sequence listings in machine (computer) readable form 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 Section 1.821(e) shall contain a printable copy of the "Sequence Listing," as defined in Sections 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



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### (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 - 3.50 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 - 3.50 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/rmt0;lpr </dev/rmt0):

## MANUAL OF PATENT EXAMINING PROCEDURE

(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 handprinted 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 U.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" (Section 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 (Section 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.

[Annex D follows]

# PCT ADMINISTRATIVE INSTRUCTIONS

## ANNEX D

### INFORMATION FROM PAMPHLET FRONT PAGE TO BE INCLUDED IN THE GAZETTE UNDER RULE 86.1(i)

The following information shall be extracted from the front page of the pamphlet of each published international application and shall, in accordance with Rule 86.1(i), appear in the corresponding entry of the Gazette:

1. as to the international publication:

- 1.1 the international publication number
- 1.2 the date of the international publication
- 1.3 an indication whether the following items were published in the pamphlet:
  - 1.31 international search report
  - 1.32 declaration under Article 17(2)
  - 1.33 claims amended under Article 19(1)
  - 1.34 statement under Article 19(1)
  - 1.35 the essence of the comments by the applicant on the translation of the international application as referred to in Rule 48.3(b)
  - 1.36 request for rectification under the third sentence of Rule 91.1(f)
- 1.4 the language of publication of the international application

2. as to the international application:

- 2.1 the title of the invention
- 2.2 the symbol(s) of the International Patent Classification (IPC)
- 2.3 the international application number
- 2.4 the international filing date

3. as to any priority claim:

- 3.1 the application number of the earlier application
- 3.2 the date of the earlier application
- 3.3 the country in or for which the earlier application was filed

4. as to the applicant, inventor and agent:

- 4.1 their name(s)
- 4.2 their mailing address(es)

5. as to the designated States:

- 5.1 their names
- 5.2 the indication of any wish for a regional patent
- 5.3 the indication of kind of protection sought, unless a patent is sought

6. as to a statement concerning nonprejudicial disclosure or exception to lack of novelty:

- 6.1 the date of the disclosure
- 6.2 the place of the disclosure
- 6.3 the kind of the disclosure (e.g., exhibition, scientific publication, conference reports, etc.)
- 6.4 the title of the exhibition, publication or conference

## MANUAL OF PATENT EXAMINING PROCEDURE

7. as to any indication in relation to a deposited microorganism furnished under Rule 13<sup>bis</sup> separately from the description:

- 7.1 the fact that such indication is published
- 7.2 the date on which the International Bureau received such indication.

[Annex E follows]

## **PCT ADMINISTRATIVE INSTRUCTIONS**

### **ANNEX E**

#### **INFORMATION TO BE PUBLISHED IN THE GAZETTE UNDER RULE 86.1(v)**

1. **The time limits applicable under Articles 22 and 39 in respect of each Contracting State.**
2. **The list of the nonpatent literature agreed upon by the International Searching Authorities for inclusion in the minimum documentation.**
3. **The names of the national Offices which do not wish to receive copies under Article 13(2)(c).**
4. **The provisions of the national laws of Contracting States concerning international-type search.**
5. **The text of the agreements entered into between the International Bureau and the International Searching Authorities or the International Preliminary Examining Authorities.**
6. **The names of the national Offices which entirely or in part waived their rights to any communication under Article 20.**
7. **The names of the Contracting States which are bound by Chapter II of the PCT.**
8. **Index of concordance of international application numbers and international publication numbers, listed according to international application numbers.**
9. **Index of international publication numbers grouped according to designated States, including an indication of those States for which a "regional patent" is sought.**
10. **Index of applicants' names giving, for each name, the corresponding international publication number(s).**
11. **Index of international publication numbers, grouped according to the International Patent Classification symbols.**
12. **Indication of any subject matter that will not be searched or examined by the various International Searching and Preliminary Examining Authorities under Rules 39 and 67.**
13. **Requirements of designated and elected Offices under Rules 49.5 and 76.5 in relation to the furnishing of translations.**
14. **The names of those designated Offices wishing to receive notifications under Rule 24.2(b).**
15. **The dates defining the period referred to in Rule 32.1(b) during which the international application, whose effects may be extended to a successor State under Rule 32.1, must have been filed.**

# MANUAL OF PATENT EXAMINING PROCEDURE