

# Chapter 1800 Patent Cooperation Treaty

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## INTRODUCTION

This chapter is designed to be a guide for patent examiners in searching and examining applications filed under the Patent Cooperation Treaty (PCT). Applicants desiring additional information for filing international applications should obtain a copy of the PCT Applicant's Guide from the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.

The Articles and Regulations under the PCT are reproduced in Appendix T of this Manual and the Administrative Instructions are reproduced in Appendix AI of this Manual. The text of the *PCT Applicant's Guide*, the monthly *PCT Newsletter*, the weekly *PCT Gazette*, downloadable PCT forms, and additional information about the processing of international applications are available from WIPO's website ([www.wipo.int/pct](http://www.wipo.int/pct)).

PCT applications are processed by the International Application Processing Division within the U.S. Patent and Trademark Office.

## 1801 Basic Patent Cooperation Treaty (PCT) Principles [R-2]

### MAJOR CONCEPTS OF THE PCT

The Patent Cooperation Treaty (PCT) enables the U.S. applicant to file one application, "an international application," in a standardized format in English in the U.S. Receiving Office (the U.S. Patent and Trademark Office), and have that application acknowledged as a regular national >or regional< filing in as many \*\*>Contracting States< to the PCT as the applicant "designates" or "elects," that is, names, as countries >or regions< in which patent protection is desired. >(For international applications filed on or after January 1, 2004, the filing of an international application will automatically constitute the designation of all contracting countries to the PCT on that filing date.)< In the same manner, the PCT enables foreign applicants to file a PCT international application, designating the United States of America, in their home language in their home patent office and have the application acknowledged as a regular U.S. national filing. The PCT also provides for \*\*>an international search report and written opinion (for international applications filed on or after January 1, 2004) that are established normally at 16 months from the priority date,< and publication >of the international application< after 18 months from the priority date. Upon payment of national fees and the furnishing of any required translation, usually 30 months after the filing of any priority application for the invention, or the international filing date if no priority is claimed, the application will be subjected to national procedures for granting of patents in each of the designated countries. For \*>any< countries >remaining< whose national laws are not compatible with the 30 month period set forth in PCT Article 22(1), the filing of a demand for an international preliminary examination electing such countries within 19 months from the priority date will result in an extension of the period for entering the national stage to 30 months from the priority date. >An up-to-date list of such countries may be found on WIPO's web site ([www.wipo.int/pct/en/index.html](http://www.wipo.int/pct/en/index.html)).< A brief description of the basic flow under the PCT is provided in MPEP § 1842.

The PCT offers an alternative route to filing patent applications directly in the patent offices of those

countries which are *>Contracting States<* of the PCT. It does not preclude taking advantage of the priority rights and other advantages provided under the Paris Convention and the WTO administered Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Agreement). The PCT provides an additional and optional foreign filing route to patent applicants.

The filing, search and publication procedures are provided for in Chapter I of the PCT. Additional procedures for a preliminary examination of PCT international applications are provided for in optional PCT Chapter II.

In most instances a national U.S. application *\** is filed first. An international application for the same subject matter will then be filed subsequently within the priority year provided by the Paris Convention and the priority benefit of the U.S. national application filing date will be claimed.

### RECEIVING OFFICE (RO)

The international application (IA) must be filed in the prescribed receiving Office (RO) (PCT Article 10). The United States Patent and Trademark Office will act as a receiving Office for United States residents and nationals (35 U.S.C. 361(a)). Under PCT Rule 19.1(a)(iii), the International Bureau of the World Intellectual Property Organization will also act as a Receiving Office for U.S. residents and nationals. The receiving Office functions as the filing and formalities review organization for international applications. International applications must contain upon filing the designation of at least one *>Contracting State<* in which patent protection is desired and must meet certain standards for completeness and formality (PCT Articles 11(1) and 14(1)).

Where a priority claim is made, the date of the earlier filed national application is used as the date for determining the timing of international processing, including the various transmittals, the payment of certain international and national fees, and publication of the application. Where no priority claim is made, the international filing date will be considered to be the "priority date" for timing purposes (PCT Article 2(xi)).

The international application is subject to the payment of certain fees *\*\** within 1 month *\*\*>*from the date of filing<. The receiving Office will grant an

international filing date to the application, collect fees, handle informalities by direct communication with the applicant, and monitor all corrections (35 U.S.C. 361(d)). By 13 months from the priority date, the receiving Office should prepare and transmit a copy of the international application, called the search copy (SC), to the International Searching Authority (ISA); and forward the original, called the record copy (RC), to the International Bureau (IB) (PCT Rules 22.1 and 23). A second copy of the international application, the home copy (HC), remains in the receiving Office (PCT Article 12(1)). Once the receiving Office has transmitted copies of the application, the International Searching Authority becomes the focus of international processing.

### INTERNATIONAL SEARCHING AUTHORITY (ISA)

The basic *>functions<* of the International Searching Authority (ISA) *>are<* to conduct a prior art search of inventions claimed in international applications; it does this by searching in at least the minimum documentation defined by the Treaty (PCT Articles 15 and 16 and PCT Rule 34)>, and for international applications filed on or after January 1, 2004, to issue a written opinion (PCT Rule 43<sup>bis</sup>) which will normally be considered to be the first written opinion of the International Preliminary Examining Authority where international preliminary examination is demanded. See PCT Rule 66.1<sup>bis</sup><.

For most applications filed with the United States Receiving Office, the applicant may choose (in the Request form) either the U.S. Patent and Trademark Office or the European Patent Office to act as the International Searching Authority. However, the European Patent Office *\*\*>*may not be< competent to act as an International Searching Authority for certain applications filed by nationals or residents of the United States. See MPEP § 1840.01 for a discussion of applications and subject matter that will not be searched by the European Patent Office. The International Searching Authority is also responsible for checking the content of the title and abstract (PCT Rules 37.2 and 38.2).

An international search report (ISR)>, and for international applications filed on or after January 1, 2004, a written opinion,< will normally be issued by the International Searching Authority within 3 months

from the receipt of the search copy (usually about 16 months after the priority date) (PCT Rule 42). Copies of the international search report and prior art cited will be sent to the applicant by the ISA (PCT Rules 43 and 44.1). The international search report will contain a listing of documents found to be relevant and will identify the claims in the application to which they are pertinent. In applications filed on or after January 1, 2004, the ISA will normally issue a written opinion as to whether each claim appears to satisfy the PCT Article 33 criteria of “novelty,” “inventive step,” and “industrially applicable.” The written opinion may also indicate defects in the form or content of the international application under the PCT articles and regulations, as well as any observations the ISA wishes to make on the clarity of the claims, the description, and the drawings, or on the question of whether the claims are fully supported by the description.

Once the international search report and written opinion are established, the ISA transmits one copy of each to the applicant and the International Bureau, and international processing continues before the International Bureau.

### **INTERNATIONAL BUREAU (IB)**

The basic functions of the International Bureau (IB) are to maintain the master file of all international applications and to act as the publisher and central coordinating body under the Treaty. The World Intellectual Property Organization (WIPO) in Geneva, Switzerland performs the duties of the International Bureau.

If the applicant has not filed a certified copy of the priority document in the receiving Office with the international application, or requested upon filing that the receiving Office prepare and transmit to the International Bureau a copy of the prior U.S. national application, the priority of which is claimed, the applicant must submit such a document directly to the International Bureau or the receiving Office not later than 16 months after the priority date (PCT Rule 17). The request (Form PCT/RO/101) contains a box which can be checked requesting that the receiving Office prepare the certified copy. This is only possible, of course, if the receiving Office is a part of the same national Office where the priority application was filed.

The applicant has normally 2 months from the date of transmittal of the international search report to amend the claims by filing an amendment and may file a brief statement explaining the amendment directly with the International Bureau (PCT Article 19 and PCT Rule 46). The International Bureau will then normally publish the international application along with the search report and any amended claims at the expiration of 18 months from the priority date (PCT Article 21). The written opinion, on the other hand, will not be made publicly available until the expiration of 30 months from the priority date. See PCT Rule 44<sup>ter</sup>. The international publication is in pamphlet form with a front page containing bibliographical data, the abstract, and a figure of the drawing (PCT Rule 48). The pamphlet also contains the search report and any amendments to the claims submitted by the applicant. If the application is published in a language other than English, the search report and abstract are also published in English. The International Bureau publishes a *PCT Gazette* in the French and English languages which contains information similar to that on the front pages of published international applications, as well as various indexes and announcements (PCT Rule 86). The International Bureau also transmits copies of the international application to all the designated Offices (PCT Article 20 and PCT Rule 47).

### **DESIGNATED OFFICE (DO) and ELECTED OFFICE (EO)**

The designated Office is the national Office (for example, the USPTO) acting for the state or region designated under Chapter I. Similarly, the elected Office is the national Office acting for the state or region elected under Chapter II.

PCT Article 22(1) was amended, effective April 1, 2002, to specify that a copy of the international application, a translation thereof (as prescribed), and the national fee are due to the designated Office not later than at the expiration of 30 months from the priority date. Accordingly, the time period for filing the copy of the international application, the translation, and the fee under PCT Article 22 is now the same as the 30 month time period set forth in PCT Article 39. The USPTO has adopted the 30 month time limit set forth in PCT Article 22(1). However, not all Contracting States have changed their national laws for

consistency with PCT Article 22(1) as amended. Accordingly, if no “Demand” for international preliminary examination has been filed within 19 months of the priority date, the applicant may be required to complete the requirements for entering the national stage within 20 months from the priority date of the international application in some national or regional offices. When entering the national stage following Chapter I, the applicant has the right to amend the application within the time limit set forth in PCT Rule 52.1. After this time limit has expired (PCT Article 28 and PCT Rule 52), each designated Office will make its own determination as to the patentability of the application based upon its own specific national or regional laws (PCT Article 27(5)).

If the applicant desires to obtain the benefit of delaying the entry into the national stage until 30 months from the priority date in one or more countries \*\*>where< the 30 month time limit set forth in PCT Article 22(1) as amended >does not apply<, a Demand for international preliminary examination must be filed with an appropriate International Preliminary Examining Authority within 19 months of the priority date. Those states in which the Chapter II procedure is desired must be “elected” in the Demand. >For international applications filed on or after January 1, 2004, the applicant should file the demand with the competent International Preliminary Examining Authority (IPEA) before the expiration of the later of the following time limits: (A) three months from the date of transmittal to the applicant of the international search report and written opinion under PCT Rule 43<sup>bis</sup>.1, or of the declaration referred to in PCT Article 17(2)(a); or (B) 22 months from the priority date of the international application. However, applicant may still desire to file the demand by 19 months from the priority date for those countries that have not yet adopted PCT Article 22(1) as amended.<

The original Demand is forwarded to the International Bureau by the \*\*>IPEA<. The International Bureau then notifies the various elected Offices that the applicant has entered Chapter II >and sends a copy of any amendments filed under PCT Article 19 and any statement explaining the amendments to the IPEA. See PCT Rule 62. In applications filed on or after January 1, 2004, the International Bureau also sends the IPEA a copy of the written opinion established by the International Searching Authority unless

the International Searching Authority is also acting as IPEA. See PCT Rule 62.1(i)<.

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### **INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA)**

The International Preliminary Examining Authority (IPEA) normally starts the examination process when it is in possession of the demand, the amount due, and if the applicant is required to furnish a translation under PCT Rule 55.2, that translation and either the international search report (and the written opinion established under PCT Rule 43<sup>bis</sup>.1 if the international application has a filing date on or after January 1, 2004) or a notice of the declaration by the International Searching Authority (ISA) that no international search report will be established. However, for international applications having an international filing date on or after January 1, 2004, the IPEA shall not start the international preliminary examination before the expiration of the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date unless the applicant expressly requests an earlier start, with the exception of the situations provided for in PCT Rule 69.1(b)-(e).

The written opinion of the ISA is usually considered the first written opinion of the IPEA unless the IPEA has notified the International Bureau that written opinions established by specified International Searching Authorities shall not be considered a written opinion for this purpose. See PCT Rule 66.1<sup>bis</sup>. Also, the IPEA may, at its discretion issue further written opinions provided sufficient time is available. See PCT Rule 66.4.

The IPEA establishes the international preliminary examination report (entitled “international preliminary report on patentability” for applications having an international filing date on or after January 1, 2004),< which presents the examiner’s final position as to whether each claim is “novel,” involves “inventive step,” and is “industrially applicable” by 28 months from the priority date. A copy of the international preliminary examination report is sent to the applicant and to the International Bureau. The International Bureau then communicates a copy of the

international preliminary examination report to each elected Office.

The applicant must complete the requirements for entering the national stage by the expiration of 30 months from the priority date to avoid any question of withdrawal of the application as to that elected Office, however, some elected Offices provide a longer period to complete the requirements.

A listing of all national and regional offices, and the corresponding time limits for entering the national stage after PCT Chapter I and PCT Chapter II, may be found on WIPO's web site at: <http://www.wipo.int/pct/en/index.html>.

## 1802 PCT Definitions [R-1]

The PCT contains definitions in PCT Article 2 and in PCT Rule 2, which are found in MPEP Appendix T. Additional definitions are in 35 U.S.C. 351, found in MPEP Appendix L, in 37 CFR 1.9 and 1.401, found in MPEP Appendix R, and in PCT Administrative Instructions Section 101, found in MPEP Appendix AI.

## 1803 Reservations Under the PCT Taken by the United States of America

The United States of America had originally declared that it was not bound by Chapter II (PCT Article 64 (1)), but withdrew that reservation on July 1, 1987.

It has also declared that, as far as the United States of America is concerned, international publication is not required (PCT Article 64 (3)). Accordingly, under PCT Article 64(3)(b), if the United States is the only PCT Contracting State designated in an international application, the international application will not be published by the International Bureau (IB) at 18 months. Even though the United States Patent and Trademark Office has begun pre-grant publication under 35 U.S.C. 122(b), the United States has not removed its reservation under PCT Article 64(3) because not all United States patent applications are published. See 35 U.S.C. 122(b)(2). The application will, however, be published under 35 U.S.C. 122(b) if it enters the national stage in the United States. It will be published again if it is allowed to issue as a United States patent.

The United States of America also made a reservation under PCT Article 64(4) which relates to the

prior art effective date of a U.S. patent issuing from an international application. See 35 U.S.C. 102(e) and 363.

The above reservations under PCT Article 64(3) and (4) are still in effect.

The U.S. Receiving Office continues to accept applications only in English. See 35 U.S.C. 361(c). PCT Rules 20.4(c), 26.3<sup>ter</sup>(a) and 26.3<sup>ter</sup>(c) permit an international filing date to be accorded even though portions of an international application are in a language not acceptable to the Receiving Office. PCT Rules 20.4(c), 26.3<sup>ter</sup>(a) and 26.3<sup>ter</sup>(c) are not compatible with the national law applied by the United States Patent and Trademark Office (USPTO) as Receiving Office. Thus, the USPTO has taken a reservation on adherence to these Rules pursuant to PCT Rules 20.4(d), 26.3<sup>ter</sup>(b) and 26.3<sup>ter</sup>(d). As a result, PCT Rules 20.4(c), 26.3<sup>ter</sup>(a) and 26.3<sup>ter</sup>(c) shall not apply to the USPTO as Receiving Office for as long as the aforementioned incompatibility exists.

Also, PCT Rules 49.5(c<sup>bis</sup>) and 49.5(k) continue not to be compatible with the national law applied by the USPTO as a Designated Office. See 35 U.S.C. 371(c)(2). As a result, PCT Rules 49.5(c<sup>bis</sup>) and 49.5(k) shall not apply to the USPTO as Designated Office for as long as the aforementioned incompatibility exists. See the International Bureau's notice published in *PCT Gazette* No. 07/1992.

## 1805 Where To File an International Application [R-2]

35 U.S.C. 361. *Receiving Office.*

(a) The Patent and Trademark Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agreement made between the United States and another country, the Patent and Trademark Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

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See 37 CFR 1.421 - 1.423 as to who can file an international application.

Only if at least one of the applicants is a resident or national of the United States of America may an international application be filed in the United States Receiving Office (PCT Article 9(1) and (3), PCT Rules 19.1 and 19.2, 35 U.S.C. 361(a) and 37 CFR

1.412(a), 1.421). The concepts of residence and nationality are defined in PCT Rule 18.1. For the purpose of filing an international application, the applicant may be either the inventor or the successor in title of the inventor (assignee or owner). However, the laws of the various designated States regarding the requirements for applicants must also be considered when filing an international application. For example, the patent law of the United States of America requires that, for the purposes of designating the United States of America, the applicant(s) must be the inventor(s) (35 U.S.C. 373, PCT Article 27(3)).

The United States Receiving Office is located in Crystal Plaza, Building 2, 8th floor, 2011 South Clark Place, Arlington, Virginia. International applications and related papers may be deposited directly with the United States Receiving Office or be mailed to: \*\*>Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450<. It should be noted that the “Express Mail” provisions of 37 CFR 1.10 apply to the filing of all applications and papers filed in the U.S. Patent and Trademark Office, including PCT international applications and related papers and fees. It should be further noted, however, that PCT international applications and papers relating to international applications are specifically excluded from the Certificate of Mailing or Transmission procedures under 37 CFR 1.8. \*\*>See MPEP § 1834.< If 37 CFR 1.8 is improperly used, the date to be accorded the paper will be the date of actual receipt in the Office unless the receipt date falls on a Saturday, Sunday, or Federal holiday in which case the date of receipt will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday (37 CFR 1.6).

Irrespective of the Certification practice under 37 CFR 1.8(a), facsimile transmission (without the benefit of the certificate under 37 CFR 1.8(a)) may be used to submit certain papers in international applications. However, facsimile transmission may not be used for the filing of an international application, the filing of drawings under 37 CFR 1.437, or the filing of a copy of the international application, and the basic national fee to enter the U.S. national stage under 35 U.S.C. 371. See 37 CFR 1.6(d)(3) and (4), 1.8(a)(2)(i)(D), and 1.8(a)(2)(i)(F). The Demand for international preliminary examination may be filed by facsimile transmission. See MPEP § 1834.01.

The United States Receiving Office staff is available to offer guidance on PCT requirements and procedures. See MPEP § 1730 for information on contacting the staff and other available means for obtaining information.

**WARNING** - although the United States patent law at 35 U.S.C. 21(a) authorizes the \*>Director< to prescribe by rule that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service, PCT Rule 20.1(a) provides for marking the “date of actual receipt on the request.” Although the “Express Mail” provisions under 37 CFR 1.10 have not been contested to date regarding PCT applications, applicants should be aware of a possible different interpretation by foreign authorities.

PCT Rule 19.4 provides for transmittal of an international application to the International Bureau as Receiving Office in certain instances. For example, when the international application is filed with the United States Receiving Office and the language in which the international application is filed is not accepted by the United States Receiving Office, or if the applicant does not have the requisite residence or nationality, the application may be forwarded to the International Bureau for processing in its capacity as a Receiving Office. See 37 CFR 1.412(c)(6). The Receiving Office of the International Bureau will consider the international application to be received as of the date accorded by the United States Receiving Office. This practice will avoid the loss of a filing date in those instances where the United States Receiving Office is not competent to act, but where the international application indicates an applicant to be a national or resident of a PCT Contracting state or is in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office. Of course, where questions arise regarding residence or nationality, i.e., the U.S. is not clearly competent, the application will be forwarded to the International Bureau as Receiving Office. Note, where no residence or nationality is indicated, the U.S. is not competent, and the application will be forwarded to the International Bureau as Receiving Office so long as the necessary fee is paid. The fee is an amount equal to the transmittal fee.



If all of the applicants are indicated to be residents or nationals of non-PCT Contracting States, PCT Rule 19.4 does not apply, and the application is denied an international filing date.

**1807 Agent or Common Representative and General Power of Attorney [R-2]**

*37 CFR 1.455. Representation in international applications.*

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4, 8 and 90 and § 10.10). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b) and (c)).

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(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by applicant, in the Demand form, signed by applicant, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.<

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in section 108 of the Administrative Instructions.

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*PCT Rule 90.  
Agents and Common Representatives*

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*90.4.Manner of Appointment of Agent or Common Representative*

(a) The appointment of an agent shall be effected by the applicant signing the request, the demand, or a separate power of attorney. Where there are two or more applicants, the appointment of a common agent or common representative shall be effected by

each applicant signing, at his choice, the request, the demand or a separate power of attorney.

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (c), or (d)(ii), it shall be submitted to the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

(c) If the separate power of attorney is not signed, or if the required separate power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered nonexistent unless the defect is corrected.

(d) Subject to paragraph (e), any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply.

(e) Where the agent or the common representative submits any notice of withdrawal referred to in Rules 90<sup>bis</sup>.1 to 90<sup>bis</sup>.4, the requirement under paragraph (b) for a separate power of attorney shall not be waived under paragraph (d).

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Where an appointment of an agent or common representative is effected by a separate power of attorney, that power of attorney must be submitted to either the receiving Office or the International Bureau. However, a power of attorney appointing an agent or sub-agent to represent the applicant specifically before the International Searching Authority or the International Preliminary Examining Authority must be submitted directly to that Authority. >See PCT Rule 90.4(b).<

**“GENERAL” POWER OF ATTORNEY**

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*PCT Rule 90.  
Agents and Common Representatives*

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*90.5.General Power of Attorney*

(a) Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand, or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:

(i) the general power of attorney has been deposited in accordance with paragraph (b), and

(ii) a copy of it is attached to the request, the demand or the separate notice, as the case may be; that copy need not be signed.

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (c), or (d)(ii), it shall be deposited with the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

(c) Any receiving Office, any International Searching Authority and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 to the receiving Office, the International Searching Authority or the International Preliminary Examining Authority, a copy of the general power of attorney shall be submitted to that Office or Authority.

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“General” powers of attorney are recognized for the purpose of filing and prosecuting an international application before the international authorities. \*\*>See PCT Rule 90.5.<

Any general power of attorney must be filed with the receiving Office if the appointment was for the purposes of the international phase generally, or with the International Searching Authority or International Preliminary Examining Authority if the appointment was specifically to represent the applicant before that Authority. The appointment will then be effective in relation to any particular application filed by that applicant provided that the general power of attorney is referred to in the request, the Demand or a separate notice, and that a copy of the general power of attorney is attached to that request, Demand or separate notice. That copy of the signed original need not, itself, be separately signed. \*\*

### >WAIVER OF REQUIREMENT FOR A POWER OF ATTORNEY

Pursuant to new PCT Rules 90.4(d) and 90.5(c), which are applicable to international applications having an international filing date on or after January 1, 2004, the receiving Office, International Bureau, International Searching Authority and International Preliminary Examining Authority may waive the requirement for a separate power of attorney or copy of the general power of attorney in all cases except

with respect to notice of withdrawals under PCT Rule 90<sup>bis</sup> (i.e., notices withdrawing international applications, designations, priority claims, demands or elections). The USPTO, when acting in its capacity as a receiving Office, International Searching Authority, or International Preliminary Examining Authority, will in most cases waive the requirement for a separate power of attorney and copy of the general power of attorney in international applications having an international filing date on or after January 1, 2004. However, a separate power of attorney or copy of the general power of attorney may still be required in certain cases, e.g., where an agent’s authority to act on behalf of the applicant is in doubt.

Model power of attorney and general power of attorney forms are available online from WIPO’s web site ([www.wipo.int/pct/en/index.html](http://www.wipo.int/pct/en/index.html)).<

## 1808 Change in or Revocation of the Appointment of an Agent or a Common Representative [R-2]

*PCT Rule 90.*

*Agents and Common Representatives*

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### 90.6.Revocation and Renunciation

(a) Any appointment of an agent or common representative may be revoked by the persons who made the appointment or by their successors in title, in which case any appointment of a subagent under Rule 90.1(d) by that agent shall also be considered as revoked. Any appointment of a subagent under Rule 90.1(d) may also be revoked by the applicant concerned.

(b) The appointment of an agent under Rule 90.1(a) shall, unless otherwise indicated, have the effect of revoking any earlier appointment of an agent made under that Rule.

(c) The appointment of a common representative shall, unless otherwise indicated, have the effect of revoking any earlier appointment of a common representative.

(d) An agent or a common representative may renounce his appointment by a notification signed by him.

(e) Rule 90.4(b) and (c) shall apply, *mutatis mutandis*, to a document containing a revocation or renunciation under this Rule.

### 37 CFR 1.455. Representation in international applications.

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4, 8 and 90 and § 10.10). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one

applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b) and (c)).

\*\*>

(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by applicant, in the Demand form, signed by applicant, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.<

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in section 108 of the Administrative Instructions.

The appointment of an agent or a common representative can be revoked. The document containing the revocation must be signed by the persons who made the appointment or by their successors in title. The appointment of a sub-agent may also be revoked by the applicant concerned. If the appointment of an agent is revoked, any appointment of a sub-agent by that agent is also considered revoked.

The appointment of an agent for the international phase in general automatically has the effect, unless otherwise indicated, of revoking any earlier appointment of an agent. The appointment of a common representative similarly has the effect, unless otherwise indicated, of revoking any earlier appointment of a common representative.

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Renunciation of an appointment may be made by means of a notification signed by the agent or common representative. \*\* The applicant is informed of the renunciation by the International Bureau.

>The rules for signing and submission of a power of attorney set forth in PCT Rule 90.4(b) and (c) also apply to a revocation or renunciation of an appointment. See PCT Rule 90.6(e).<

U.S. attorneys or agents wishing to withdraw from representation in international applications may request to do so. To expedite the handling of requests for permission to withdraw as attorney, the request

should be submitted \*\* to \*>Mail Stop< PCT and should indicate the present mailing addresses of the attorney who is withdrawing and of the applicant. Because the United States Patent and Trademark Office (USPTO) does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of another.

The USPTO usually requires that there be at least 30 days between approval of withdrawal and the expiration date of a time response period so that the applicant will have sufficient time to obtain other representation or take other action. If less than 30 days remains in a running response period, a request to withdraw is normally disapproved.

For withdrawal of attorney or agent in the national stage, see MPEP § 402.06.

## 1810 Filing Date Requirements [R-2]

### *PCT Article 11.*

#### *Filing Date and Effects of the International Application*

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:

(i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,

(ii) the international application is in the prescribed language,

(iii) the international application contains at least the following elements:

(a) an indication that it is intended as an international application,

(b) the designation of at least one Contracting State,

(c) the name of the applicant, as prescribed,

(d) a part which on the face of it appears to be a description,

(e) a part which on the face of it appears to be a claim or claims.

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#### *35 U.S.C. 363. International application designating the United States: Effect.*

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

#### *35 U.S.C. 373. Improper Applicant.*

An international application designating the United States, shall not be accepted by the Patent and Trademark Office for the

national stage if it was filed by anyone not qualified under chapter 11 of this title to be an applicant for the purpose of filing a national application in the United States. Such international applications shall not serve as the basis for the benefit of an earlier filing date under section 120 of this title in a subsequently filed application, but may serve as the basis for a claim of the right of priority under subsections (a) through (d) of section 119 of this title, if the United States was not the sole country designated in such international application.

*37 CFR 1.431. International application requirements.*

(a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). (PCT Art. 3(2) and Section 207 of the Administrative Instructions.)

(b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:

(1) At least one applicant is a United States resident or national and the papers filed at the time of receipt of the international application so indicate (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

(2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).

\*\*>

(3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):

(i) An indication that it is intended as an international application (PCT Rule 4.2);

(ii) The designation of at least one Contracting State of the International Patent Cooperation Union (§ 1.432);

(iii) The name of the applicant, as prescribed (note §§ 1.421-1.423);

(iv) A part which on the face of it appears to be a description; and

(v) A part which on the face of it appears to be a claim.

(c) Payment of the international filing fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. The international filing, transmittal, and search fee payable is the international filing, transmittal, and search fee in effect on the receipt date of the international application.

(1) If the international filing, transmittal and search fees are not paid within one month from the date of receipt of the international application and prior to the sending of a notice of deficiency which imposes a late payment fee, applicant will be notified and given one month within which to pay the deficient fees plus the late payment fee. Subject to paragraph (c)(2) of this section, the late payment fee will be equal to the greater of:

(i) Fifty percent of the amount of the deficient fees; or

(ii) An amount equal to the transmittal fee.

(2) The late payment fee shall not exceed an amount equal to fifty percent of the international filing fee not taking into

account any fee for each sheet of the international application in excess of thirty sheets (PCT Rule 16<sup>bis</sup>).

(3) The one-month time limit set pursuant to paragraph (c) of this section to pay deficient fees may not be extended.

(d) If the payment needed to cover the transmittal fee, the international filing fee, the search fee, and the late payment fee pursuant to paragraph (c) of this section is not timely made in accordance with PCT Rule 16<sup>bis</sup>.1(e), the Receiving Office will declare the international application withdrawn under PCT Article 14(3)(a).<

## THE “INTERNATIONAL FILING DATE”

An international filing date is accorded \*\*>to the earliest date on which the requirements under PCT Article 11(1) were satisfied. If the requirements under PCT Article 11(1) are not satisfied as of the date of initial receipt of the international application papers, the receiving Office will invite applicant to correct the deficiency within a set time limit. See PCT Article 11(2) and PCT Rule 20.6. In such case, the international filing date will be the date on which a timely filed correction is received by the receiving Office. If the defect under PCT Article 11(1) is not timely corrected, the receiving Office will promptly notify the applicant that the application is not and will not be treated as an international application. See PCT Rule 20.7.< Where all the sheets pertaining to the same international application are not received on the same day by the receiving Office, in most instances, the date of receipt of the application will be amended to reflect the date on which the last missing sheets were received. As an amended date of receipt may cause the priority claim to be forfeited, applicants should assure that all sheets of the application are deposited with the receiving Office on the same day. For particulars see PCT Rule 20.2.

An all too common occurrence is that applicants will file an international application in the U.S. Receiving Office and no applicant has a U.S. residence or nationality. Applicants are cautioned to be sure that at least one applicant is a resident or national of the U.S. before filing in the U.S. Receiving Office. Where no applicant indicated on the request papers is a resident or national of the United States, the USPTO is not a competent receiving Office for the international application under PCT Rule 19.1(a). Nonetheless, the date the international application was filed in the USPTO will not be lost as a filing date for the international application if at least one applicant is a

resident or national of any PCT Contracting State. Under PCT Rule 19.4, the USPTO will receive the application on behalf of the International Bureau as receiving Office (PCT Rule 19.4(a)) and, upon payment of a fee equal to the transmittal fee, the USPTO will promptly transmit the international application to the International Bureau under PCT Rule 19.4(b). However, if all of the applicants are indicated to be both residents and nationals of non-PCT Contracting States, PCT Rule 19.4 does not apply, and the application is denied an international filing date.

The USPTO is also not competent to receive international applications that are not in the English language and, upon payment of a fee equal to the transmittal fee, the USPTO will forward such applications to the International Bureau under PCT Rule 19.4 provided they are in a language accepted by the International Bureau as receiving Office.

A discussion of PCT Rule 19.4 is also included in MPEP § 1805.

## 1812 Elements of the International Application [R-2]

### *PCT Article 3.*

#### *The International Application*

(1) Applications for the protection of inventions in any of the Contracting States may be filed as international applications under this Treaty.

(2) An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.

(3) The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought.

(4) The international application shall:

- (i) be in a prescribed language;
- (ii) comply with the prescribed physical requirements;
- (iii) comply with the prescribed requirement of unity of invention;
- (iv) be subject to the payment of the prescribed fees.

Any international application must contain the following elements: request, description, claim or claims, abstract and one or more drawings (where drawings are necessary for the understanding of the invention (PCT Article 3(2) and PCT Article 7(2)). The elements of the international application are to be arranged in the following order: the request, the description (other than any sequence listing part thereof), the claims, the abstract, the drawings, and the sequence listing part of the description (where applicable) (Administrative Instructions Section 207(a)). All the sheets contained in the international application must be numbered in consecutive Arabic numerals by using the following separate series of numbers: a first series applying to the request; a second series to the description, claims and abstract; a third series to the drawings (where applicable); and a further series to the sequence listing part of the description (where applicable) (PCT Rule 11.7 and Administrative Instructions Section 207(b)). Only one copy of the international application need be filed in the United States Receiving Office (37 CFR 1.433(a)). The request is made on a standardized form (Form PCT/RO/101), copies of which can be obtained from the USPTO or online from WIPO's web site ([www.wipo.int/pct/en/index.html](http://www.wipo.int/pct/en/index.html)). The "Request" form can also be presented as a computer printout prepared using the PCT-SAFE software. This software can be downloaded from the PCT-SAFE web site ([www.wipo.int/pct-safe](http://www.wipo.int/pct-safe)). The details of a computer generated Request form are provided in Administrative Instructions Section 102<sup>bis</sup>.

## 1817 PCT Member States [R-2]

An updated list of PCT Contracting States is available from WIPO's web site ([www.wipo.int/pct/guide/en/gdvol1/annexes/annexa/ax\\_a.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexa/ax_a.pdf)). The following list of PCT Contracting States was updated at the time of publication of the MPEP:

State	Ratification, Accession or Declaration	Date of Ratification, Accession or Declaration	Date From Which State May Be Designated
(1) Central African Republic <sup>o</sup>	Accession	15 September 1971	01 June 1978
(2) Senegal <sup>o</sup>	Ratification	08 March 1972	01 June 1978
(3) Madagascar	Ratification	27 March 1972	01 June 1978
(4) Malawi	Accession	16 May 1972	01 June 1978
(5) Cameroon <sup>o</sup>	Accession	15 March 1973	01 June 1978
(6) Chad <sup>o</sup>	Accession	12 February 1974	01 June 1978
(7) Togo <sup>o</sup>	Ratification	28 January 1975	01 June 1978
(8) Gabon <sup>o</sup>	Accession	06 March 1975	01 June 1978
(9) United States of America	Ratification	26 November 1975	01 June 1978
(10) Germany <sup>oo</sup>	Ratification	19 July 1976	01 June 1978
(11) Congo <sup>o</sup>	Accession	08 August 1977	01 June 1978
(12) Switzerland <sup>oo</sup>	Ratification	14 September 1977	01 June 1978
(13) United Kingdom <sup>oo</sup>	Ratification	24 October 1977	01 June 1978
(14) France <sup>oo</sup>	Ratification	25 November 1977	01 June 1978
(15) Russian Federation	Ratification	29 December 1977	01 June 1978
(16) Brazil	Ratification	09 January 1978	01 June 1978
(17) Luxembourg <sup>oo</sup>	Ratification	31 January 1978	01 June 1978
(18) Sweden <sup>oo</sup>	Ratification	17 February 1978	01 June 1978
(19) Japan	Ratification	01 July 1978	01 October 1978
(20) Denmark <sup>oo</sup>	Ratification	01 September 1978	01 December 1978
(21) Austria <sup>oo</sup>	Ratification	23 January 1979	23 April 1979
(22) Monaco <sup>oo</sup>	Ratification	22 March 1979	22 June 1979
(23) Netherlands <sup>oo</sup>	Ratification	10 April 1979	10 July 1979
(24) Romania <sup>oo</sup>	Ratification	23 April 1979	23 July 1979
(25) Norway	Ratification	01 October 1979	01 January 1980
(26) Liechtenstein <sup>oo</sup>	Accession	19 December 1979	19 March 1980

State	Ratification, Accession or Declaration	Date of Ratification, Accession or Declaration	Date From Which State May Be Designated
(27) Australia	Accession	31 December 1979	31 March 1980
(28) Hungary °°	Ratification	27 March 1980	27 June 1980
(29) Democratic People's Republic of Korea (North Korea )	Accession	08 April 1980	08 July 1980
(30) Finland°°	Ratification	01 July 1980	01 October 1980
(31) Belgium°°	Ratification	14 September 1981	14 December 1981
(32) Sri Lanka	Accession	26 November 1981	26 February 1982
(33) Mauritania°	Accession	13 January 1983	13 April 1983
(34) Sudan	Accession	16 January 1984	16 April 1984
(35) Bulgaria °°	Accession	21 February 1984	21 May 1984
(36) Republic of Korea (South Korea)	Accession	10 May 1984	10 August 1984
(37) Mali°	Accession	19 July 1984	19 October 1984
(38) Barbados	Accession	12 December 1984	12 March 1985
(39) Italy°°	Ratification	28 December 1984	28 March 1985
(40) Benin°	Accession	26 November 1986	26 February 1987
(41) Burkina Faso°	Accession	21 December 1988	21 March 1989
(42) Spain°°	Accession	16 August 1989	16 November 1989
(43) Canada	Ratification	02 October 1989	02 January 1990
(44) Greece°°	Accession	09 July 1990	09 October 1990
(45) Poland>°°<	Accession	25 September 1990	25 December 1990
(46) Côte d'Ivoire°	Ratification	31 January 1991	30 April 1991
(47) Guinea°	Accession	27 February 1991	27 May 1991
(48) Mongolia	Accession	27 February 1991	27 May 1991
(49) Czech Republic °°	Declaration	18 December 1992	01 January 1993
(50) Ireland°°	Ratification	01 May 1992	01 August 1992
(51) Portugal°°	Accession	24 August 1992	24 November 1992
(52 ) New Zealand	Accession	01 September 1992	01 December 1992

State	Ratification, Accession or Declaration	Date of Ratification, Accession or Declaration	Date From Which State May Be Designated
(53) Ukraine	Declaration	21 September 1992	25 December 1991
(54) Viet Nam	Accession	10 December 1992	10 March 1993
(55) Slovakia °°	Declaration	30 December 1992	01 January 1993
(56) Niger°	Accession	21 December 1992	21 March 1993
(57) Kazakhstan	Declaration	16 February 1993	25 December 1991
(58) Belarus	Declaration	14 April 1993	25 December 1991
(59) Latvia	Accession	07 June 1993	07 September 1993
(60) Uzbekistan	Declaration	18 August 1993	25 December 1991
(61) China	Accession	01 October 1993	01 January 1994
(62) Slovenia °°	Accession	01 December 1993	01 March 1994
(63) Trinidad and Tobago	Accession	10 December 1993	10 March 1994
(64) Georgia	Declaration	18 January 1994	25 December 1991
(65) Kyrgyzstan	Declaration	14 February 1994	25 December 1991
(66) Republic of Moldova	Declaration	14 February 1994	25 December 1991
(67) Tajikistan	Declaration	14 February 1994	25 December 1991
(68) Kenya	Accession	08 March 1994	08 June 1994
(69) Lithuania	Accession	05 April 1994	05 July 1994
(70) Armenia	Declaration	17 May 1994	25 December 1991
(71) Estonia °°	Accession	24 May 1994	24 August 1994
(72) Liberia	Accession	27 May 1994	27 August 1994
(73) Swaziland	Accession	20 June 1994	20 September 1994
(74) Mexico	Accession	01 October 1994	01 January 1995
(75) Uganda	Accession	09 November 1994	09 February 1995
(76) Singapore	Accession	23 November 1994	23 February 1995
(77) Iceland	Accession	23 December 1994	23 March 1995
(78) Turkmenistan	Declaration	01 March 1995	25 December 1991
(79) The former Yugoslov Republic of Macedonia	Accession	10 May 1995	10 August 1995



State	Ratification, Accession or Declaration	Date of Ratification, Accession or Declaration	Date From Which State May Be Designated
(80) Albania	Accession	04 July 1995	04 October 1995
(81) Lesotho	Accession	21 July 1995	21 October 1995
(82) Azerbaijan	Accession	25 September 1995	25 December 1995
(83) Turkey <sup>oo</sup>	Accession	01 October 1995	01 January 1996
(84) Israel	Ratification	01 March 1996	01 June 1996
(85) Cuba	Accession	16 April 1996	16 July 1996
(86) Saint Lucia	Accession	30 May 1996	30 August 1996
(87) Bosnia and Herzegovina	Accession	07 June 1996	07 September 1996
(88) *>Serbia and Montenegro<	Ratification	01 November 1996	01 February 1997
(89) Ghana	Accession	26 November 1996	16 February 1997
(90) Zimbabwe	Accession	11 March 1997	11 June 1997
(91) Sierra Leone	Accession	17 March 1997	17 June 1997
(92) Indonesia	Accession	05 June 1997	05 September 1997
(93) Gambia	Accession	09 September 1997	09 December 1997
(94) Guinea-Bissau <sup>o</sup>	Accession	12 September 1997	12 December 1997
(95) Cyprus <sup>oo</sup>	Accession	01 January 1998	01 April 1998
(96) Croatia	Accession	01 April 1998	01 July 1998
(97) Grenada	Accession	22 June 1998	22 September 1998
(98) India	Accession	07 September 1998	07 December 1998
(99) United Arab Emirates	Accession	10 December 1998	10 March 1999
(100) South Africa	Accession	16 December 1998	16 March 1999
(101) Costa Rica	Accession	03 May 1999	03 August 1999
(102) Dominica	Accession	07 May 1999	07 August 1999
(103) United Republic of Tanzania	Accession	14 June 1999	14 September 1999
(104) Morocco	Accession	08 July 1999	08 October 1999
(105) Algeria	Ratification	08 December 1999	08 March 2000
(106) Antigua and Barbuda	Accession	17 December 1999	17 March 2000

State	Ratification, Accession or Declaration	Date of Ratification, Accession or Declaration	Date From Which State May Be Designated
(107) Mozambique	Accession	18 February 2000	18 May 2000
(108) Belize	Accession	17 March 2000	17 June 2000
(109) Colombia	Accession	29 November 2000	28 February 2001
(110) Ecuador	Accession	07 February 2001	07 May 2001
(111) Equatorial Guinea <sup>o</sup>	Accession	17 April 2001	17 July 2001
(112) Philippines	Ratification	17 May 2001	17 August 2001
(113) Oman	Accession	26 July 2001	26 October 2001
(114) Zambia	Accession	15 August 2001	15 November 2001
(115) Tunisia	Accession	10 September 2001	10 December 2001
(116) Saint Vincent and the Grenadines	Accession	06 May 2002	06 August 2002
(117) Seychelles	Accession	07 August 2002	07 November 2002
(118) Nicaragua	Accession	06 December 2002	06 March 2003
>(119) Papua New Guinea	Accession	14 March 2003	14 June 2003
(120) Syrian Arab Republic	Accession	26 March 2003	26 June 2003
(121) Egypt	Ratification	06 June 2003	06 September 2003
(122) Botswana	Accession	30 July 2003	30 October 2003
(123) Namibia	Accession	01 October 2003	01 January 2004<
<p><sup>o</sup>Members of Africa Intellectual Property Organization (OAPI) regional patent system. Only regional patent protection is available for OAPI member states. A designation of any state is an indication that all OAPI states have been designated. Note: only one designation fee is due regardless of the number of OAPI member states designated.</p>			
<p><sup>oo</sup>Members of European Patent Convention (EPC) regional patent system. Either national patents or European patents for member States are available through PCT, except for Belgium, Cyprus, France, Greece, Ireland, Italy, Monaco, Netherlands, and Slovenia, for which only European patents are available if the PCT is used. Note: only one PCT designation fee is due if European patent protection is sought for one, several, or all EPC member countries.</p>			

State	Ratification, Accession or Declaration	Date of Ratification, Accession or Declaration	Date From Which State May Be Designated
<p>The following states are members of African Regional Industrial Property Organization (ARIPO) regional patent system and are Contracting States of both the Harare Protocol and the PCT: (4) Malawi, (34) Sudan, (68) Kenya, (73) Swaziland, (75) Uganda, (81) Lesotho, (89) Ghana, (90) Zimbabwe, (91) Sierra Leone, (93) Gambia, (103) United Republic of Tanzania, (107) Mozambique, (114) Zambia, and (122) Botswana. Note that with the accession of Botswana to the PCT, all 14 States party to the Harare Protocol are now also Contracting States of the PCT. State (73) Swaziland can only be designated for the purposes of an ARIPO patent and not for the purposes of a national patent. All other PCT Contracting States which are also party to the Harare Protocol can be designated either for a national or an ARIPO patent, or both a national and an ARIPO patent.</p>			
<p>The following states are members of the Eurasian Patent Organization (EAPO) regional patent system: (15) Russian Federation, (57) Kazakhstan, (58) Belarus, (65) Kyrgyzstan, (66) Republic of Moldova, (67) Tajikistan, (70) Armenia, (78) Turkmenistan, and (82) Azerbaijan. All PCT Contracting States which are also party to the Eurasian Patent Convention can be designated either for a national or a Eurasian patent, or both a national and a Eurasian patent. Note, however, that it is not possible to designate only some of these States for a Eurasian patent and that any designation of one or more States for a Eurasian patent will be treated as a designation of all the States which are party to both the Convention and the PCT for a Eurasian patent.</p>			

### **1817.01 >Designation of States in International Applications Having an International Filing Date On or After January 1, 2004 [R-2]**

[Note: The regulations under the PCT were changed effective January 1, 2004. A corresponding change was made to Title 37 of the Code of Federal Regulations. See *January 2004 Revision of Patent Cooperation Treaty Application Procedure*, 68 FR 59881 (Oct. 20, 2003), 1276 O.G. 6 (Nov. 11, 2003). All international applications having an international filing date before January 1, 2004, will continue to be processed under the procedures in effect on the international filing date. For the designation of states in international applications having an international filing date before January 1, 2004, see MPEP § 1817.01(a) for the information that previously appeared in this section].

*37 CFR 1.432. Designation of States by filing an international application.*

The filing of an international application request shall constitute:

(a) The designation of all Contracting States that are bound by the Treaty on the international filing date;

(b) An indication that the international application is, in respect of each designated State to which PCT Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State; and

(c) An indication that the international application is, in respect of each designated State to which PCT Article 45(1) applies, for the grant of a regional patent and also, unless PCT Article 45(2) applies, a national patent.

For international applications having an international filing date on or after January 1, 2004, the filing of an international application request constitutes: (A) the designation of all Contracting States that are bound by the Treaty on the international filing date; (B) an indication that the international application is, in respect of each designated State to which PCT Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State; and (C) an indication that the international application is, in respect of each designated State to which PCT Article 45(1) applies, for the grant of a regional patent and also, unless PCT Article 45(2) applies, a national patent. See 37 CFR 1.432 and PCT Rule 4.9. This automatic indication of all designations and all types of protection possible overcomes a pit-

fall in the designation system in effect for applications having an international filing prior to January 1, 2004, where applicants inadvertently omitted a designation or type of protection and failed to timely satisfy the requirements under former PCT Rule 4.9(b) to perfect a precautionary designation.

### **APPLICANT FOR PURPOSES OF EACH DESIGNATION**

Where there is but a single applicant, the right to file an international application and to designate Contracting States or regions exists if the applicant is a resident or national of a PCT Contracting State. The applicant can be an individual, corporate entity or other concern. In the case where there are several applicants who are different for different designated states, the right to file an international application and to designate Contracting States or regions exists if at least one of them is a resident or national of a Contracting State. If entry into the U.S. national phase is desired, inventors must be indicated as applicants at least for purposes of the United States.

### **1817.01(a) < Designation of States and Precautionary Designations >in International Applications Having an International Filing Date Before January 1, 2004< [R-2]**

[Note: For the designation of States in applications having an international filing date on or after January 1, 2004, see MPEP § 1817.01.]

*Former<*

*37 CFR 1.432. Designation of States and payment of designation and confirmation fees.*

(a) The designation of States including an indication that applicant wishes to obtain a regional patent, where applicable, shall appear in the Request upon filing and must be indicated as set forth in PCT Rule 4.9 and section 115 of the Administrative Instructions. Applicant must specify at least one national or regional designation on filing of the international application for a filing date to be granted.

(b) If the fees necessary to cover all the national and regional designations specified in the Request are not paid by the applicant within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date, applicant will be notified and given one month within which to pay the deficient designation fees plus a late payment fee. The late payment fee shall be equal to the greater of fifty percent of the

amount of the deficient fees up to a maximum amount equal to the basic fee, or an amount equal to the transmittal fee (PCT Rule 16<sup>bis</sup>). The one-month time limit set in the notification of deficient designation fees may not be extended. Failure to timely pay at least one designation fee will result in the withdrawal of the international application.

(1) The one designation fee must be paid:

(i) Within one year from the priority date;

(ii) Within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date; or

(iii) With the late payment fee defined in this paragraph within the time set in the notification of the deficient designation fees or in accordance with PCT Rule 16<sup>bis</sup>.1(e).

(2) If after a notification of deficient designation fees the applicant makes timely payment, but the amount paid is not sufficient to cover the late payment fee and all designation fees, the Receiving Office will, after allocating payment for the basic, search, transmittal and late payment fees, allocate the amount paid in accordance with PCT Rule 16<sup>bis</sup>.1(c) and withdraw the unpaid designations. The notification of deficient designation fees pursuant to this paragraph may be made simultaneously with any notification pursuant to § 1.431(c).

(c) The amount payable for the designation fee set forth in paragraph (b) is:

(1) The designation fee in effect on the filing date of the international application, if such fee is paid in full within one month from the date of receipt of the international application;

(2) The designation fee in effect on the date such fee is paid in full, if such fee is paid in full later than one month from the date of receipt of the international application but within one year from the priority date;

(3) The designation fee in effect on the date one year from the priority date, if the fee was due one year from the priority date, and such fee is paid in full later than one month from the date of receipt of the international application and later than one year from the priority date; or

(4) The designation fee in effect on the international filing date, if the fee was due one month from the international filing date and after one year from the priority date, and such fee is paid in full later than one month from the date of receipt of the international application and later than one year from the priority date.

(d) On filing the international application, in addition to specifying at least one national or regional designation under PCT Rule 4.9(a), applicant may also indicate under PCT Rule 4.9(b) that all other designations permitted under the Treaty are made.

(1) Indication of other designations permitted by the Treaty under PCT Rule 4.9(b) must be made in a statement on the Request that any designation made under this paragraph is subject to confirmation (PCT Rule 4.9(c)) not later than the expiration of 15 months from the priority date by:

(i) Filing a written notice with the United States Receiving Office specifying the national and/or regional designations being confirmed;

(ii) Paying the designation fee for each designation being confirmed; and

(iii) Paying the confirmation fee specified in § 1.445(a)(4).

(2) Unconfirmed designations will be considered withdrawn. If the amount submitted is not sufficient to cover the designation fee and the confirmation fee for each designation being confirmed, the Receiving Office will allocate the amount paid in accordance with any priority of designations specified by applicant. If applicant does not specify any priority of designations, the allocation of the amount paid will be made in accordance with PCT Rule 16<sup>bis</sup>.1(c).

The designation of States is the indication, in Box No. V of the request (except in the last sub-box of that Box), of the specific regional patents, national patents, and/or other kinds of protection the applicant is seeking. Specific designations for the purpose of obtaining national and regional patents are effected by indicating each Contracting State or region concerned. On the printed form, this is accomplished by marking the appropriate check-boxes next to the names of the States or regions. For detailed instructions regarding “specific” designations, see the “Notes to the Request Form (PCT/RO/101),” available from WIPO’s website at [www.wipo.int/pct/en/index.html](http://www.wipo.int/pct/en/index.html).

All designations must be made in the international application on filing; none may be added later. However, there is a safety net designed to protect applicants who make mistakes or omissions among the specific designations, by way of making a precautionary designation of all other States which have not been specifically designated in the Request whose designation would be permitted under the Treaty.

In addition to specific designations described above, the applicant may, under PCT Rule 4.9(b), indicate in the request that all designations which would be permitted under the PCT are also made, provided that at least one specific designation is made and that the request also contains a statement relating to the confirmation of any precautionary designations so made. That statement must declare that any such designation is subject to confirmation (as provided in Rule 4.9(c)), and that any such designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.

Precautionary designations are effected in practice by including the necessary statement in the last sub-box of Box No. V of the request (the statement is set out in the printed request form). Since the precaution-

ary designations are designed particularly to enable applicants to correct omissions and mistakes in the original list of specific designations, it is strongly recommended that applicants make the precautionary designations indication (by leaving the pre-printed statement in the printed form, if that form is used) unless there is a particular reason for doing otherwise. The request form makes provision for the applicant to omit designations if that is desired. It should be noted that no fees are payable in respect of precautionary designations except where the applicant later decides to confirm them.

Precautionary designations will be regarded as withdrawn by the applicant unless they are confirmed, but the applicant is not obliged to confirm them. The precautionary designation procedure enables the applicant to make, in the request, all designations permitted by the PCT in addition to those made specifically. For this purpose, the request must also contain a statement that any precautionary designations so made are subject to confirmation as provided in Rule 4.9(c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit. Noting that the confirmation of designations is entirely at the applicant's discretion, no notification is sent to the applicant reminding him or her that the time limit for confirming precautionary designations is about to expire. Applicants are cautioned that in order for the confirmation of a designation of the U.S. to be valid, the inventor must have been named in the application papers as filed, 37 CFR 1.421(b).

#### **APPLICANT FOR PURPOSES OF EACH DESIGNATION**

Where there is but a single applicant, the right to file an international application and to designate contracting states or regions exists if the applicant is a resident or national of a contracting state. The applicant can be an individual, corporate entity or other concern. If the United States is to be designated, it is particularly important to note that the applicant must also be the inventor.

In the case where there are several applicants who are different for different designated states, the right to file an international application and to designate contracting states or regions exists if at least one of

them is a resident or national of a contracting state. If the United States is to be designated, it is important to note that the applicant must also be the inventor. If the inventor is not also the applicant, the designation of the United States is invalid.

#### **1817.02 Continuation or Continuation-in-Part Indication in the Request [R-2]**

*PCT Rule 4.  
The Request (Contents)*

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##### *4.11.Reference to Earlier Search, Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

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(iv) the applicant intends to make an indication under Rule 49<sup>bis</sup>.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or indicate the relevant parent application or parent patent or other parent grant.

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The Supplemental Box of the request form should be used where the applicant has an earlier pending United States nonprovisional application or international application designating the U.S. and wishes the later filed international application to be treated as a continuation or continuation-in-part of such earlier application. To properly identify the parent application, the specific reference must identify the parent application by application number and indicate the relationship to the parent application (i.e., "continuation" or "continuation-in-part"). The specific reference must also indicate the filing date of the parent application if the parent application is an international application. See 37 CFR 1.78(a).

Identification of the parent application in the request does not relieve applicants from having to perfect the benefit claim upon entry into the U.S. national stage by including a proper claim in an application data sheet or in the first sentence of the speci-

cation (see 37 CFR 1.78(a)(2)). However, inclusion of a proper reference to the parent application in the international phase does provide certain benefits to applicants, e.g., where applicant chooses to file a continuing application claiming benefit under 35 U.S.C. 365(c) to the international application (i.e., a bypass application) rather than entering the U.S. national phase under 35 U.S.C. 371.<

**1819 Earlier International or International-Type Search [R-2]**

*PCT Rule 4.  
Request (Contents)*

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*\*\*>4.11.Reference to Earlier Search, Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

(i) an international or international-type search has been requested on an application under Article 15(5);

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the request shall so indicate and shall, as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or indicate the relevant parent application or parent patent or other parent grant.

\*\*\*\*\*

*37 CFR 1.445. International application filing, processing and search fees.*

(a) The following fees and charges for international applications are established by the Director under the authority of 35 U.S.C. 376:

\*\*\*\*\*

(2) A search fee (see 35 U.S.C. 361(d)and PCT Rule 16):

(i) If a corresponding prior United States National application filed under 35 U.S.C. 111(a) with the filing fee under § 1.16(a) has been filed and the corresponding prior United States National application is identified by application number, if known, or if the application number is not known by the filing date, title, and name of applicant(and preferably the application docket number), in the international application or accompanying papers at the time of filing the international application.....\$300.00

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Certain International Searching Authorities refund part or all of the international search fee or reduce the amount of the international search fee where the international search can be based wholly or partly on an earlier search (whether an international, international-type, or other search) made by them. The United States provides for a reduced search fee where there is a corresponding prior U.S. \* nonprovisional application >and such application is adequately identified in the international application or accompanying papers at the time of filing the international application. Applicants must identify the prior nonprovisional application by the U.S. application number or, if such number is not yet known, by filing date, title, and name of applicant (and preferably the application docket number). See 37 CFR 1.445(a)(2)(i)<.

Where the earlier search by the International Searching Authority was made in relation to a national, regional (for instance, European) or international application, that application must be identified in >the request. Applicants should identify the application in< Box No. VII of the request by an indication of the country of filing (or the European Patent Office), and the number and filing date of that application. \*\* Where the earlier search was made independently of a patent granting procedure (for instance, a standard search by the European Patent Office), a reference must be made to the date of the request for that search and the number given to the request by the International Searching Authority.

The United States Patent and Trademark Office performs an international-type search on all U.S. national applications filed on and after 1 June 1978. No specific request by the applicant is required and no number identifying the international-type search is assigned by the Office. \*\*>See 37 CFR 1.104(a)(3).<

**1820 Signature of Applicant [R-2]**

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*PCT Article 14.  
Certain Defects in the International Application*

(1)(a)The receiving Office shall check whether the international application contains any of the following defects, that is to say

(i) it is not signed as provided in the Regulations;

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*PCT Rule 4.  
The Request (Contents)*

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*4.15. Signature*

(a) Subject to paragraph (b), the request shall be signed by the applicant or, if there is more than one applicant, by all of them.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.

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*PCT Rule 26.*

*Checking by, and Correcting Before, the Receiving Office  
of Certain Elements of the International Application*

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*26.2<sup>bis</sup>. Checking of Requirements Under Article 14(1)(a)(i)  
and (ii)*

(a) For the purposes of Article 14(1)(a)(i), if there is more than one applicant, it shall be sufficient that the request be signed by one of them.

(b) For the purposes of Article 14(1)(a)(ii), if there is more than one applicant, it shall be sufficient that the indications required under Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who is entitled according to Rule 19.1 to file the international application with the receiving Office.<

**SIGNATURE OF APPLICANT OR AGENT**

\*>Pursuant to PCT Rule 4.15, the< international application must be signed in Box No. IX of the request by the applicant, or, where there are two or more applicants, by all of them. \*\*>However, under new PCT Rule 26.2<sup>bis</sup>, which is applicable to international applications having an international filing date on or after January 1, 2004, it is sufficient for purposes of PCT Article 14(1)(a)(i) that the application is signed by only one of the applicants. Thus, for international applications having an international filing date on or after January 1, 2004, the United States Receiving Office will not issue an invitation to applicants to furnish missing signatures where the request

is signed by at least one of the applicants. Notwithstanding PCT Rule 26.2<sup>bis</sup>, any designated/elected office, in accordance with its national law, can still require confirmation of the international application by the signature of any applicant for such state who has not signed the request. PCT Rule 51<sup>bis</sup>(a)(vi).< Pursuant to 37 CFR 1.4(d), the request filed may be either an original, or a copy thereof. \*\*

The international application may be signed by an agent\*\*>.

For international applications having an international filing date on or after January 1, 2004, the requirement for the submission of a separate power of attorney may be waived by the receiving Office. The United States Receiving Office will, in most cases, waive the requirement for a separate power of attorney. See MPEP § 1807.

If the international application has an international filing date before January 1, 2004, then< the agent must be appointed as such by the applicant in a separate power of attorney signed by the applicant. If there are two or more applicants, the request may be signed by an agent on behalf of all or only some of them; in that case the agent must be appointed as such in one or more powers of attorney signed by the applicants on whose behalf the agent signs the application. Where a power of attorney appointing an agent who signs an international application >having an international filing date prior to January 1, 2004< is missing, the signature is treated as missing until the power of attorney is submitted.

The signature should be executed in black indelible ink. The name of each person signing the international application should be indicated (preferably typewritten) next to the signature. Where a person signs on behalf of a legal entity (an organization such as a corporation, university, nonprofit organization, or governmental agency), his or her name and the capacity in which he or she signs should be indicated. Proof of the person's authority to sign on behalf of the legal entity will be required if that person does not possess apparent authority to sign on behalf of the legal entity >and that person has not submitted a statement that he or she is authorized to sign on behalf of the legal entity (discussed below)<. An officer (President, Vice-President, Secretary, Treasurer, Chief Executive Officer, Chief Operating Officer or Chief Financial Officer) of an organization is presumed to have



authority to sign on behalf of that organization. The signature of the chairman of the board is also acceptable, but not the signature of an individual director. Variations of these titles (such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors) are acceptable. \*>In general, a< person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the organization is not presumed to be an officer or to have the authority to sign on behalf of the organization. >However, an exception is made with respect to foreign juristic applicants. This is because in foreign countries, a person who holds the title “Manager” or “Director” is normally an officer or the equivalent thereof; therefore, those terms are generally acceptable as indicating proper persons to sign applications for foreign applicants. However, titles such as “Manager of Patents,” suggesting narrowly limited duties, are not acceptable.< An attorney does not generally have apparent authority to sign on behalf of an organization.

Proof that a person has the authority to sign on behalf of a legal entity may take the form of a copy of a resolution of the board of directors, a provision of the bylaws, or a copy of a paper properly delegating authority to that person to sign the international application on behalf of the legal entity.

It is \* acceptable to have a person sign the international application on behalf of a legal entity if that person submits a statement that the person has the authority to sign the international application on behalf of the legal entity. This statement should be on a separate paper and must not appear on the Request (or Demand) form itself. The statement must include a clause such as “The undersigned (whose title is supplied below) is empowered to sign the Request on behalf of the applicant.”

\*\*>The international application can be filed without applicant’s signature on the request. The lack of any required signature on the request< is a correctable defect under PCT Article 14(1)(a)(i) and (b), and can be remedied by filing a copy of the request (or, where the request has been signed by an agent, of a power of attorney) duly signed by the applicant within the time limit fixed by the receiving Office for the correction of this defect.

## **APPLICANT INVENTOR UNAVAILABLE OR UNWILLING TO SIGN THE INTERNATIONAL APPLICATION \*\***

\*\* PCT Rule 4.15(b) >provides< that, where an applicant inventor for the designation of \*\*>of a State whose national law requires that national applications be filed by the inventor (the United States of America is the only Contracting State to have such a requirement in its national law)< refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant inventor if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned. \*\*>The significance of PCT Rule 4.15(b) has been greatly diminished with respect to international applications having an international filing date on or after January 1, 2004, in light of new PCT Rule 26.2<sup>bis</sup>(a), which provides that where there is more than one applicant, the signature requirements for purposes of PCT Article 14(1)(a)(i) will be considered to have been satisfied if the request is signed by one of the applicants.

For international applications having an international filing date prior to January 1, 2004, if the requisite statement under PCT Rule 4.15(b)< is furnished to the satisfaction of the receiving Office, the international application complies with the requirements of PCT Article 14(1)(a)(i) for the purposes of all designated States (including the United States of America) without adverse consequences in the international phase. However, additional proofs may be required by the United States Patent and Trademark Office after entry into the national phase if the required oath or declaration by the inventor is not signed by all the applicant inventors.

\*\*

## **\* INVENTOR DECEASED**

*37 CFR 1.422. When the inventor is dead.*

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may file an international application which designates the United States of America.

\*\*>A legal representative of a deceased inventor may be indicated in the international application as an applicant for the purposes of the United States. In such case, the indication in the request (in Box II or

III, as appropriate) for the legal representative should be made as follows: SMITH, Alfred, legal representative of JONES, Bernard (deceased), followed by indications of the address, nationality and residence of the legal representative. The legal representative should be indicated as an “applicant only” except where the legal representative is also an inventor, in which case the legal representative should be indicated as an “applicant and inventor.” The name of the deceased inventor should also appear in a separate box (in Box III) with the indication of “deceased” (e.g., “JONES, Bernard (deceased)”) and identified as an “inventor only” and not as an applicant.<

## 1821 The Request [R-2]

A general overview of certain aspects of the request follows.

37 CFR 1.434. *The request.*

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(a) The request shall be made on a standardized form (PCT Rules 3 and 4). Copies of printed Request forms are available from the United States Patent and Trademark Office. Letters requesting printed forms should be marked “Mail Stop PCT.”<

(b) The Check List portion of the Request form should indicate each document accompanying the international application on filing.

(c) All information, for example, addresses, names of States and dates, shall be indicated in the Request as required by PCT Rule 4 and Administrative Instructions 110 and 201.

\*\*>

(d) For the purposes of the designation of the United States of America, an international application shall include:

(1) The name of the inventor; and;

(2) A reference to any prior-filed national application or international application designating the United States of America, if the benefit of the filing date for the prior-filed application is to be claimed.

(e) An international application may also include in the Request a declaration of the inventors as provided for in PCT Rule 4.17(iv).<

The request must either be made on a printed form to be filled in with the required indications or be presented as a computer printout complying with the Administrative Instructions. Any prospective applicant may obtain copies of the printed request form, free of charge, from the receiving Office with which he/she plans to file his/her international application\*\*. >Applicants may obtain an English language request form from the United States Patent and Trademark Office using the following address: Mail Stop PCT,

Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Forms may also be obtained from the World Intellectual Property Organization (WIPO) web site ([www.wipo.int/pct/en/forms/index.htm](http://www.wipo.int/pct/en/forms/index.htm)).< Details of the requirements for the request if presented as a computer printout are set out in Administrative Instructions Section 102<sup>bis</sup>.

As provided in Administrative Instructions Section 102<sup>bis</sup>(c), reduced fees are payable in respect of an international application containing the request in PCT-EASY format filed, together with a PCT-EASY diskette, with a receiving Office which, under paragraph (a), accepts the filing of such international applications. \*\*>To prepare a request in PCT-EASY format and the PCT-EASY diskette, applicants must use PCT-SAFE software, which is available for downloading at WIPO’s web site ([www.wipo.int/pct-safe](http://www.wipo.int/pct-safe)). For technical support and assistance with the software, the web site also provides contact information for the PCT-SAFE Help Desk.<

The request contains a petition for the international application to be processed according to the PCT and must also contain certain indications. It must contain the title of the invention. It must identify the applicant \*\* and the agent (if any), and must contain the designation of at least one Contracting State. \*\*>For international applications having an international filing date on or after January 1, 2004, the filing of an international application request constitutes the designation of all Contracting States that are bound by the PCT on the international filing date. See MPEP § 1817.01. The request must contain an indication of any wish of the applicants to obtain a European patent rather than, or in addition to, a national patent in respect of a designated State.

The request may not contain any matter that is not specified in PCT Rules 4.1 to 4.17 or permitted under PCT Rule 4.18(a) by the Administrative Instructions. Any additional material will be deleted *ex officio*. See PCT Rule 4.18(b) and Administrative Instructions Section 303.<

## DATES

Each date appearing in the international application or in any correspondence must be indicated by the Arabic number of the day, the name of the month and the Arabic number of the year, in that order. In the request, after, below or above that indication, the date

should be repeated in parentheses with a two-digit Arabic numeral each for the number of the day \*\*>and for the number of the month and followed by the number of the year in four digits, in that order and separated by periods, slashes or hyphens after the digit pairs of the day and of the month, for example, “20 March 2004 (20.03.2004),” “20 March 2004 (20/03/2004),” or “20 March 2004 (20-03-2004).” See Administrative Instructions Section 110.<

### **SUPPLEMENTAL BOX**

This box is used for any material which cannot be placed in one of the previous boxes because of space limitations. The supplemental information placed in this box should be clearly entitled with the Box number from which it is continued, e.g., “Continuation of Box No. IV.”

### **FILE REFERENCE**

The applicant or his/her agent may indicate a file reference in the box provided for \*>this< purpose on the first sheet of the request form, on each page of the other elements of the international application, on the first sheet of the demand form, and in any other correspondence relating to the international application. PCT Rule 11.6(f) indicates that the file reference may be included in the top margin of the sheets of the international application. As provided in Administrative Instructions Section 109, the file reference may be composed either of letters of the Latin alphabet or Arabic numerals, or both. It may not exceed 12 characters >including spaces. If the file reference exceeds 12 characters, the receiving Office may *ex officio* truncate the reference number to 12 characters and notify the applicant<. The receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority (International Authorities) will use the file reference in correspondence with the applicant. \*\*

### **TITLE OF INVENTION**

The Request must contain the title of the invention; the title must be short (preferably 2 to 7 words) and precise (PCT Rule 4.3). The title in Box No. I of the Request is considered to be the title of the application. The title appearing on the first page of the description (PCT Rule 5.1(a)) and on the page containing the

abstract should be consistent with the title indicated in Box No. I of the Request form.

A title should not be changed by the examiner merely because it contains words which are not considered descriptive of the invention. Words, for example, such as “improved” or “improvement of” are acceptable. If the title is otherwise not descriptive of the invention, a change to a more descriptive title should be made and the applicant informed thereof in the search report.

Where the title is missing or is inconsistent with the title in the description, the receiving Office invites the applicant to correct the missing or inconsistent title.

### **APPLICANT**

Any resident or national of a Contracting State may file an international application. Where there are two or more applicants, at least one of them must be a national or a resident of a PCT Contracting State.

The question whether an applicant is a resident or national of a Contracting State depends on the national law of that State and is decided by the receiving Office. Also, possession of a real and effective industrial or commercial establishment in a Contracting State may be considered residence in that State, and a legal entity constituted according to the national law of a Contracting State is considered a national of that State.

The applicant must be identified by the indication of his/her name and address and by marking next to that indication, the check-box “This person is also inventor” in Box No. II, or “applicant and inventor” in Box No. III, where the applicant is also the inventor or one of the inventors, or the check-box “applicant only” where the applicant is not the inventor or one of the inventors. Where the applicant is a corporation or other legal entity (that is, not a natural person), the check-box “applicant only” must be marked. The applicant’s nationality and residence must also be indicated.

### **NAMES**

The names of a natural person must be indicated by the family name followed by the given name(s). Academic degrees or titles or other indications which are not part of the person’s name must be omitted. The family name should preferably be written in capital letters.

The name of a legal entity must be indicated by its full official designation (preferably in capital letters).

## ADDRESSES

Addresses must be indicated in such a way as to satisfy the requirements for prompt postal delivery at the address indicated and must consist of all the relevant administrative units up to and including the house number (if any). The address must also include the country.

### 1823 The Description [R-2]

*PCT Article 5.  
The Description*

The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

*PCT Rule 5.  
The Description*

#### 5.1. Manner of the Description

(a) The description shall first state the title of the invention as appearing in the request and shall:

(i) specify the technical field to which the invention relates;

(ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such art;

(iii) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;

(iv) briefly describe the figures in the drawings, if any;

(v) set forth at least the best mode contemplated by the applicant for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; where the national law of the designated State does not require the description of the best mode but is satisfied with the description of any mode (whether it is the best contemplated or not), failure to describe the best mode contemplated shall have no effect in that State;

\*\*>

(vi) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry and the way in which it can be made and used, or, if it can only be used, the way in which it can be used; the term "industry" is to be understood in its broadest sense as in the Paris Convention for the Protection of Industrial Property.<

(b) The manner and order specified in paragraph (a) shall be followed except when, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economic presentation.

(c) Subject to the provisions of paragraph (b), each of the parts referred to in paragraph (a) shall preferably be preceded by an appropriate heading as suggested in the Administrative Instructions.

*PCT Administrative Instruction Section 204.  
Headings of the Parts of the Description*

The headings of the parts of the description 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";

(vii) for matter referred to in Rule 5.2(a), "Sequence Listing";

(viii) for matter referred to in Rule 5.2(b), "Sequence Listing Free Text."

*PCT Administrative Instruction Section 209.  
Indications as to Deposited Biological Material on a Separate Sheet*

(a) To the extent that any indication with respect to deposited biological material is not contained in the description, 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 Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the Mexican Institute of Industrial Property, and the Turkish Patent Institute as designated Offices, 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.<

#### 37 CFR 1.435. The description.

(a) The application must meet the requirements as to the content and form of the description set forth in PCT Rules 5, 9, 10, and 11 and sections 204 and 208 of the Administrative Instructions.

(b) In international applications designating the United States the description must contain upon filing an indication of the best mode contemplated by the inventor for carrying out the claimed invention.

The description must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. It must start with the title of the invention as appearing in Box No. I of the request. PCT Rule 5 contains detailed requirements as to the manner and order of the description, which, generally, should be in six parts. Those parts should have the following headings: “Technical Field,” “Background Art,” “Disclosure of Invention,” “Brief Description of Drawings,” “Best Mode for Carrying Out the Invention” or, where appropriate, “Mode(s) for Carrying Out the Invention,” “Industrial Applicability,” “Sequence Listing,” and “Sequence Listing Free Text,” where applicable.

The details required for the disclosure of the invention so that it can be carried out by a person skilled in the art depend on the practice of the national Offices. It is therefore recommended that due account be taken of national practice in the United States of America when the description is drafted.

The need to amend the description during the national phase may thus be avoided.

This applies likewise to the need to indicate the “best mode for carrying out the invention.” If at least one of the designated Offices requires the indication of the best mode (for instance, the United States Patent and Trademark Office), that best mode must be indicated in the description.

A description drafted with due regard to what is said in these provisions will be accepted by all the designated Offices. It might require more care than the drafting of a national patent application, but certainly much less effort than the drafting of multiple applications, which is necessary where the PCT route is not used for filing in several countries.

## 1823.01 Reference to Deposited Biological Material [R-2]

### *PCT Rule 13<sup>bis</sup>.*

#### *Inventions Relating to Biological Material*

##### *13<sup>bis</sup>.1. Definition*

For the purposes of this Rule, “reference to deposited biological material” means particulars given in an international application with respect to the deposit of a biological material with a depositary institution or to the biological material so deposited.

##### *13<sup>bis</sup>.2. References (General)*

Any reference to deposited biological material shall be made in accordance with this Rule and, if so made, shall be considered as satisfying the requirements of the national law of each designated State.

##### *13<sup>bis</sup>.3. References: Contents; Failure to Include Reference or Indication*

(a) A reference to deposited biological material shall indicate:

(i) the name and address of the depositary institution with which the deposit was made;

(ii) the date of deposit of the biological material with that institution;

(iii) the accession number given to the deposit by that institution; and

(iv) any additional matter of which the International Bureau has been notified pursuant to Rule 13<sup>bis</sup>.7(a)(i), provided that the requirement to indicate that matter was published in the Gazette in accordance with Rule 13<sup>bis</sup>.7(c) at least two months before the filing of the international application.

(b) Failure to include a reference to deposited biological material or failure to include, in a reference to deposited biological material, an indication in accordance with paragraph (a), shall have no consequence in any designated State whose national law does not require such reference or such indication in a national application.

##### *13<sup>bis</sup>.4. References: Time Limit for Furnishing Indications*

(a) Subject to paragraphs (b) and (c), if any of the indications referred to in Rule 13<sup>bis</sup>.3(a) is not included in a reference to deposited biological material in the international application as filed but is furnished to the International Bureau:

(i) within 16 months from the priority date, the indication shall be considered by any designated Office to have been furnished in time;

(ii) after the expiration of 16 months from the priority date, the indication shall be considered by any designated Office to have been furnished on the last day of that time limit if it reaches the International Bureau before the technical preparations for international publication have been completed.

(b) If the national law applicable by a designated Office so requires in respect of national applications, that Office may require that any of the indications referred to in Rule 13<sup>bis</sup>.3(a) be furnished earlier than 16 months from the priority date, provided that the International Bureau has been notified of such requirement pursuant to Rule 13<sup>bis</sup>.7(a)(ii) and has published such requirement in the Gazette in accordance with Rule 13<sup>bis</sup>.7(c) at least two months before the filing of the international application.

(c) Where the applicant makes a request for early publication under Article 21(2)(b), any designated Office may consider any indication not furnished before the technical preparations for international publication have been completed as not having been furnished in time.

(d) The International Bureau shall notify the applicant of the date on which it received any indication furnished under paragraph (a), and

(i) if the indication was received before the technical preparations for international publication have been completed, indicate that date, and include the relevant data from the indication, in the pamphlet published under Rule 48;

(ii) if the indication was received after the technical preparations for international publication have been completed, notify that date and the relevant data from the indication to the designated Offices.

*13<sup>bis</sup>.5. References and Indications for the Purposes of One or More Designated States; Different Deposits for Different Designated States; Deposits with Depositary Institutions Other Than Those Notified*

(a) A reference to deposited biological material shall be considered to be made for the purposes of all designated States, unless it is expressly made for the purposes of certain of the designated States only; the same applies to the indications included in the reference.

(b) References to different deposits of the biological material may be made for different designated States.

(c) Any designated Office may disregard a deposit made with a depositary institution other than one notified by it under Rule 13<sup>bis</sup>.7(b).

*13<sup>bis</sup>.6. Furnishing of Samples*

Pursuant to Articles 23 and 40, no furnishing of samples of the deposited biological material to which a reference is made in an international application shall, except with the authorization of the applicant, take place before the expiration of the applicable time limits after which national processing may start under the said Articles. However, where the applicant performs the acts referred to in Articles 22 or 39 after international publication but before the expiration of the said time limits, the furnishing of samples of the deposited biological material may take place, once the said acts have been performed. Notwithstanding the previous provision, the furnishing of samples of the deposited biological material may take place under the national law applicable by any designated Office as soon as, under that law, the international publication has the effects of the compulsory national publication of an unexamined national application.

*13<sup>bis</sup>.7. National Requirements: Notification and Publication*

(a) Any national Office may notify the International Bureau of any requirement of the national law:

(i) that any matter specified in the notification, in addition to those referred to in Rule 13<sup>bis</sup>.3(a)(i), (ii) and (iii), is required to be included in a reference to deposited biological material in a national application;

(ii) that one or more of the indications referred to in Rule 13<sup>bis</sup>.3(a) are required to be included in a national application as

filed or are required to be furnished at a time specified in the notification which is earlier than 16 months after the priority date.

(b) Each national Office shall notify the International Bureau of the depositary institutions with which the national law permits deposits of biological materials to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.

(c) The International Bureau shall promptly publish in the Gazette requirements notified to it under paragraph (a) and information notified to it under paragraph (b).

*PCT Administrative Instruction Section 209.  
Indications as to Deposited Biological Material on a Separate Sheet*

(a) To the extent that any indication with respect to deposited biological material is not contained in the description, 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 Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the Mexican Institute of Industrial Property, and the Turkish Patent Institute as designated Offices, 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.<

**REFERENCES TO DEPOSITED BIOLOGICAL MATERIAL IN THE CASE OF MICROBIOLOGICAL INVENTIONS**

The PCT does not require the inclusion of a reference to a biological material and/or to its deposit with a depositary institution in an international application; it merely prescribes the contents of any “reference to deposited biological material” (defined as “particulars given... with respect to the deposit of biological material... or to the biological material so deposited”) which is included in an international application, and when such a reference must be furnished. It follows that the applicant may see a need to make such a reference only when it is required for the purpose of disclosing the invention claimed in the international application in a manner sufficient for the invention to be carried out by a person skilled in the art that is, when the law of at least one of the designated States provides for the making, for this purpose, of a reference to a deposited biological material if the invention involves the use of a biological material that is not available to the public. Any reference to a deposited biological material furnished separately from the

description will be included in the pamphlet containing the published international application.

A reference to a deposited biological material made in accordance with the requirements of the PCT must be regarded by each of the designated Offices as satisfying the requirements of the national law applicable in that Office with regard to the contents of such references and the time for furnishing them.

A reference may be made for the purposes of all designated States or for one or only some of the designated States. A reference is considered to be made for the purpose of all designated States unless it is expressly made for certain designated States only. References to different deposits may be made for the purposes of different designated States.

There are two kinds of indication which may have to be given with regard to the deposit of the biological material, namely:

(A) indications specified in the PCT Regulations themselves; and

(B) additional indications by the national (or regional) Office of (or acting for) a State designated in the international application and which have been published in the *PCT Gazette*; these additional indications may relate not only to the deposit of the biological material but also to the biological material itself.

The indications in the first category are:

- (1) the name and address of the depository institution with which the deposit was made;
- (2) the date of the deposit with that institution; and
- (3) the accession number given to the deposit by that institution.

U.S. requirements include the name and address of the depository institution at the time of filing, the date of the deposit or a statement that the deposit was made on or before the priority date of the international application and, to the extent possible, a taxonomic description of the biological material. See Annex L of the PCT Applicant's Guide.

The national laws of some of the national (or regional) Offices require that, besides indications concerning the deposit of a biological material, an indication be given concerning the biological material itself, such as, for example, a short description of its characteristics, at least to the extent that this information is available to the applicant. These requirements must be met in the case of international applications for which

any such Office is a designated Office, provided that the requirements have been published in the *PCT Gazette*. Annex L of the PCT Applicant's Guide indicates, for each of the national (or regional) Offices, the requirements (if any) of this kind which have been published.

If any indication is not included in a reference to a deposited biological material contained in the international application as filed, it may be furnished to the International Bureau within 16 months after the priority date unless the International Bureau has been notified (and, at least 2 months prior to the filing of the international application, it has published in the *PCT Gazette*) that the national law requires the indication to be furnished earlier. However, if the applicant makes a request for early publication, all indications should be furnished by the time the request is made, since any designated Office may regard any indication not furnished when the request is made as not having been furnished in time.

No check is made in the international phase to determine whether a reference has been furnished within the prescribed time limit. However, the International Bureau notifies the designated Offices of the date(s) on which indications, not included in the international application as filed, were furnished to it. Those dates are also mentioned in the pamphlet containing the published international application. Failure to include a reference to a deposited biological material (or any indication required in such a reference) in the international application as filed, or failure to furnish it (or the indication) within the prescribed time limit, has no consequence if the national law does not require the reference (or indication) to be furnished in a national application. Where there is a consequence, it is the same as that which applies under the national law.

To the extent that indications relating to the deposit of a biological material are not given in the description, because they are furnished later, they may be given in the "optional sheet" provided for that purpose. If the sheet is submitted when the international application is filed, a reference to it should be made in the check list contained on the last sheet of the request form. Should >Israel,< Japan>, Korea, Mexico, or Turkey< be designated, such a sheet must, if used, be included as one of the sheets of the description at the time of filing; otherwise the indications given in it

will not be taken into account by the respective patent offices of those designated States in the national phase. If the sheet is furnished to the International Bureau later, it must be enclosed with a letter.

Each national (or regional) Office whose national law provides for deposits of biological material for the purposes of patent procedure notifies the International Bureau of the depositary institutions with which the national law permits such deposits to be made. Information on the institutions notified by each of those Offices is published by the International Bureau in the *PCT Gazette*.

A reference to a deposit cannot be disregarded by a designated Office for reasons pertaining to the institution with which the biological material was deposited if the deposit referred to is one made with a depositary institution notified by that Office. Thus, by consulting the *PCT Gazette* or Annex L of the PCT Applicant's Guide, the applicant can be sure that he has deposited the biological material with an institution which will be accepted by the designated Office.

International Searching Authorities and International Preliminary Examining Authorities are not expected to request access to deposited biological material. However, in order to retain the possibility of access to a deposited biological material referred to in an international application which is being searched or examined by such an Authority, the PCT provides that the Authorities may, if they fulfill certain conditions, ask for samples. Thus, an Authority may only ask for samples if it has notified the International Bureau (in a general notification) that it may require samples and the International Bureau has published the notification in the *PCT Gazette*. The only Authority which has made such a notification (and thus the only Authority which may request samples) is the Japan Patent Office. If a sample is asked for, the request is directed to the applicant, who then becomes responsible for making the necessary arrangements for the sample to be provided.

The furnishing of samples of a deposit of a biological material to third persons is governed by the national laws applicable in the designated Offices. PCT Rule 13<sup>bis</sup>.6(b), however, provides for the delay-

ing of any furnishing of samples under the national law applicable in each of the designated (or elected) Offices until the start of the national phase, subject to the ending of this "delaying effect" brought about by the occurrence of either of the following two events:

(A) the applicant has, after international publication of the international application, taken the steps necessary to enter the national phase before the designated Office.

(B) international publication of the international application has been effected, and that publication has the same effects, under the national law applicable in the designated Office, as the compulsory national publication of an unexamined national application (in other words, the international application has qualified for the grant of "provisional protection").

## 1823.02 Nucleotide and/or Amino Acid Sequence Listings, and Tables Related to Sequence Listings [R-2]

*PCT Rule 5.*

*The Description*

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### 5.2. Nucleotide and/or Amino Acid Sequence Disclosure

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing complying with the standard prescribed by the Administrative Instructions and presented as a separate part of the description in accordance with that standard.

(b) Where the sequence listing part of the description contains any free text as defined in the standard provided for in the Administrative Instructions, that free text shall also appear in the main part of the description in the language thereof.

*PCT Rule 13<sup>ter</sup>.*

*Nucleotide and/or Amino Acid Sequence Listings*

### 13<sup>ter</sup>.1. Sequence Listing for International Authorities

(a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:



(i) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing complying with that standard;

(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.

(b) *[Deleted]*

(c) If the applicant does not comply with an invitation under paragraph (a) within the time limit fixed in the invitation, the International Searching Authority shall not be required to search the international application to the extent that such noncompliance has the result that a meaningful search cannot be carried out.

(d) Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to file the required correction. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

(e) Paragraphs (a) and (c) shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

(f) Any sequence listing not contained in the international application as filed shall not, subject to Article 34, form part of the international application.

### *13<sup>ter</sup>.2.Sequence Listing for Designated Office*

Once the processing of the international application has started before a designated Office, Rule 13<sup>ter</sup>.1(a) shall apply *mutatis mutandis* to the procedure before that Office. No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

#### *PCT Administrative Instruction Section 208.*

##### *Sequence Listings*

Any nucleotide and/or amino acid sequence listing ("sequence listing") filed as part of the international application, or furnished together with the international application or subsequently (whether in printed form or computer readable form), shall comply with Annex C.

## **I. REQUIREMENTS FOR SEQUENCE LISTINGS**

Where an international application discloses one or more nucleotide and/or amino acid sequences, the description must contain a sequence listing complying with the standard specified in the Administrative

Instructions. The standard is set forth in detail in Annex C - Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in International Patent Applications Under the PCT. The standard allows the applicant to draw up a single sequence listing which is acceptable to all receiving Offices, International Searching and Preliminary Examining Authorities for the purposes of the international phase, and to all designated and elected Offices for the purposes of the national phase. The International Searching Authority and the International Preliminary Examining Authority may, in some cases, invite the applicant to furnish a listing complying with that standard. The applicant may also be invited to furnish a listing in a computer readable form provided for in the PCT Administrative Instructions. It is advisable for the applicant to submit a listing of the sequence in computer readable form, if such a listing is required by the competent International Searching Authority or International Preliminary Examining Authority, together with the international application rather than to wait for an invitation by the International Searching Authority or International Preliminary Examining Authority.

The computer readable form is not mandatory in international applications to be searched by the United States International Searching Authority or examined by the United States International Preliminary Examining Authority. However, if a computer readable form of a sequence listing is not provided, a search or examination will be performed only to the extent possible in the absence of the computer readable form. The U.S. sequence rules (37 CFR 1.821 - 1.825) and the PCT sequence requirements are substantively consistent. In this regard, full compliance with the requirements of the U.S. rules will ensure compliance with the applicable PCT requirements. For a detailed discussion of the U.S. sequence rules, see MPEP § 2420 - § 2421.04. Note that the European Patent Office (EPO) is not a competent International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA) for many international applications directed to the field of biotechnology and filed by residents or nationals of the United States. See MPEP §§ 1840.01 and 1865.01.

## II. QUALIFYING FOR POTENTIALLY REDUCED BASIC FEE BY FILING SEQUENCE LISTING AND/OR TABLES ON COMPACT DISC RATHER THAN ON PAPER

*PCT Administrative Instruction Section 801.*

*Filing of International Applications Containing Sequence Listings and/or Tables*

(a) Pursuant to Rules 89<sup>bis</sup> and 89<sup>ter</sup>, where an international application contains disclosure of one or more nucleotide and/or amino acid sequence listings ("sequence listings"), the receiving Office may, if it is prepared to do so, accept that the sequence listing part of the description, as referred to in Rule 5.2(a) and/or any table related to the sequence listing(s) ("sequence listings and/or tables"), be filed, at the option of the applicant:

(i) only on an electronic medium in the computer readable form referred to in Section 802; or

(ii) both on an electronic medium in that computer readable form and on paper in the written form referred to in Section 802;

provided that the other elements of the international application are filed as otherwise provided for under the Regulations and these Instructions.

(b) Any receiving Office which is prepared to accept the filing in computer readable form of the sequence listings and/or tables under paragraph (a) shall notify the International Bureau accordingly. The notification shall specify the electronic media on which the receiving Office will accept such filings. The International Bureau shall promptly publish any such information in the Gazette.

(c) A receiving Office which has not made a notification under paragraph (b) may nevertheless decide in a particular case to accept an international application the sequence listings and/or tables of which are filed with it under paragraph (a).

(d) Where the sequence listings and/or tables are filed in computer readable form under paragraph (a) but not on an electronic medium specified by the receiving Office under paragraph (b), that Office shall, under Article 14(1)(a)(v), invite the applicant to furnish to it replacement sequence listings and/or tables on an electronic medium specified under paragraph (b).

(e) Where an international application containing sequence listings and/or tables in computer readable form is filed under paragraph (a) with a receiving Office which is not prepared, under paragraph (b) or (c), to accept such filings, Section 333(b) and (c) shall apply.

Part 8 of the Administrative Instructions became effective January 11, 2001. Under Administrative Instructions Section 801(a), applicants may file the nucleotide and/or amino acid sequence listing part of the description of an international application on an electronic medium in computer readable form with certain receiving Offices. As of September 6, 2002,

Part 8 of the Administrative Instructions was expanded to include tables related to sequence listings. At the present time, the United States Receiving Office (RO/US) has not notified the International Bureau (IB) under Administrative Instructions Section 801(b) that it will be generally accepting the filing of international applications under Administrative Instructions Section 801(a). The RO/US will, however, accept such applications in a particular case pursuant to Administrative Instructions Section 801(c), provided that applicant follows the Guidelines set forth below in subsection II. A.

*PCT Administrative Instruction Section 803.*

*\*\*>Calculation of International Filing Fee for International Applications Containing Sequence Listings and/or Tables*

Where sequence listings and/or tables are filed in electronic form under Section 801(a), the international filing fee payable in respect of that application shall include the following two components:

(i) a basic component calculated as provided in the Schedule of Fees in respect of all pages filed on paper (that is, all pages of the request, description (excluding sequence listings and/or tables if also filed on paper), claims, abstract and drawings), and

(ii) an additional component, in respect of the sequence listings and/or tables, equal to 400 times the fee per sheet as referred to in item 1 of the Schedule of Fees, regardless of the actual length of the sequence listings and/or tables filed in computer readable form and regardless of the fact that sequence listings and/or tables may have been filed both in written form and in computer readable form.<

Applicants will usually achieve a significant fee savings by filing international applications under Administrative Instructions Section 801(a) in situations where the sequence listings and/or tables consume over four hundred (400) combined pages. The potentially reduced *>*international filing< fee described in Administrative Instructions Section 803 is available to applications filed pursuant to the Guidelines below. Applicants who do not wish to file under Administrative Instructions Section 801(a) may submit the sequence listing part and any related tables under conventional filing procedures but will not be eligible for the potentially reduced *>*international filing< fee described in Administrative Instructions Section 803.

When filing an international application under Administrative Instructions Section 801(a) in the RO/US, applicant should not submit a paper copy of the

Sequence Listing part and/or tables. If both a sequence listing part and a tables part are filed under Administrative Instructions Section 801(a), the sequence listing part and the tables part must not be filed on the same electronic medium. With specific regard to tables, only tables which are related to sequence listings, as referred to in PCT Rule 5.2(a), are covered under Part 8 of the Administrative Instructions. Currently, other types of table data may not be filed on electronic media.

**A. Guidelines on Qualifying for Potentially Reduced \*>International Filing< Fee Under PCT Administrative Instructions Section 803**

**1. What To Submit**

The applicant is required to submit a complete copy of the international application, wherein the sequence listing part and/or tables part of the application is submitted on electronic media rather than on paper. The application is to be accompanied by a transmittal letter entitled "Compact Disc Transmittal Sheet For Submission Of Sequence Listing and/or Tables To the United States Receiving Office Under PCT Administrative Instructions - Part 8."

**(a) Complete International Application With Sequence Listing Part and/or Tables Part on Electronic Media**

Applicant shall submit a paper copy of the complete international application, with the exception that the sequence listing part and/or tables part is provided on electronic media rather than on paper. Four (4) copies of the sequence listing part and/or three (3) copies of the tables part are to be included with the application, each copy on an electronic medium or set of electronic media if additional capacity is needed. One copy of the sequence listing part, called the "computer readable form" (CRF) copy required by the Administrative Instructions (see Annex C of the Administrative Instructions, paragraphs 39-46), may be submitted on any acceptable medium under 37 CFR 1.824(c), although compact disc (CD) media is preferred. All other copies must be submitted only on CD media as specified below:

(1) CD-R

Type: 120mm Compact Disc Recordable

Specification: ISO 9660, 650MB; or

(2) CD-ROM

Type: ISO/IEC 10149:1995, 120mm Compact Disc Read Only Memory

Specification: ISO 9660, 650MB

Each electronic medium shall be enclosed in a hard protective case within a padded envelope. If a sequence listing file is included, the four (4) sequence listing part copies shall be labeled as follows:

- (1) "COPY 1 – SEQUENCE LISTING PART"
- (2) "COPY 2 – SEQUENCE LISTING PART"
- (3) "COPY 3 – SEQUENCE LISTING PART"
- (4) "CRF"

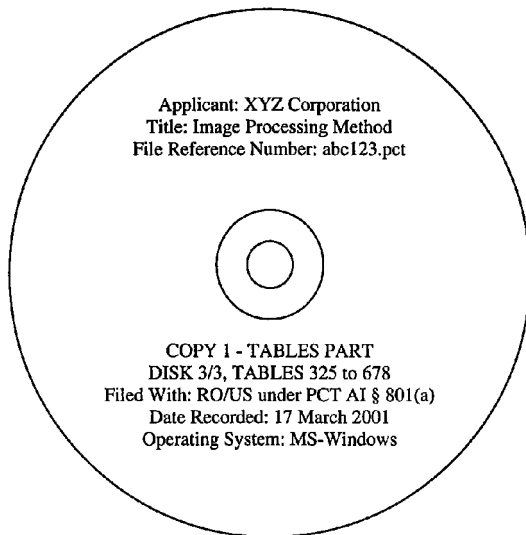
If tables file(s) are included, the three (3) tables part copies shall be labeled as follows:

- (1) "COPY 1 – TABLES PART"
- (2) "COPY 2 – TABLES PART"
- (3) "COPY 3 – TABLES PART"

Additionally, the labeling shall contain the following information:

- (1) Name of Applicant
- (2) Title of Invention
- (3) Applicant's or Agent's File Reference Number
- (4) Date of Recording
- (5) Computer Operating System Used
- (6) Name of the Competent Authority (i.e. the RO/US)
- (7) Indication that the sequence listing part and/or tables part is being filed under Administrative Instructions Section 801(a)
- (8) If the sequence listing file and/or tables file(s) consumes more than one CD, an indication such as "DISK 1/3", "DISK 2/3", and "DISK 3/3"
- (9) For a CD containing tables, an indication such as "TABLES 1 to 450"

Examples of properly labeled electronic media appear below.



**Important Notes:**

The electronic medium itself must be neatly labeled with the required information. Labeling of the protective case is recommended, but not required. Sequence listings or tables submitted for correction, rectification, or amendment must satisfy the additional labeling requirements of Administrative Instructions Section 802(d).

Each CD shall contain either: (1) only a sequence listing part or (2) only a tables part. A sequence listing part and a tables part must not reside together on the same CD. Furthermore, each file in the tables part

must have a file name which indicates the name of the table contained therein, e.g., “table-1.txt”, “table-2.txt”, etc. In addition, no programs or any explanatory files shall appear on any CD.

The sequence listing file and/or tables file(s) must be in compliance with the American Standard Code for Information Interchange (ASCII) and formatted in accordance with Administrative Instructions Annex C, paragraph 41 and Administrative Instructions Annex C-<sup>bis</sup>. No copy protection or encryption techniques are permitted. File compression is acceptable for the sequence listing part, so long as the compressed file is in a self-extracting format and uses the compression method described in Administrative Instructions Part 7, Annex F, Section 4.1.1. File Compression is not permitted for the tables part.

**(b) Compact Disc Transmittal Sheet for Submission of Sequence Listing and/or Tables to the United States Receiving Office Under PCT Administrative Instructions - Part 8.**

If applicant desires for an application to be accepted pursuant to Administrative Instructions Section 801(c), the application must be submitted with a document entitled “Compact Disc Transmittal Sheet For Submission Of Sequence Listing and/or Tables To The United States Receiving Office Under PCT Administrative Instructions - Part 8.” This document is available as a PDF sheet that may be downloaded from <http://www.uspto.gov/web/offices/pac/dapps/pct/part8translett.pdf>. The PDF sheet includes the following information:

- (1) Name of Applicant
- (2) Applicant’s or Agent’s File Reference Number
- (3) Title of Invention
- (4) Name of Sequence Listing File and/or Tables File(s) (as per CD directory)
- (5) Size of Sequence Listing File and/or Tables File(s) (in bytes or kilobytes as per CD directory)
- (6) Date of Sequence Listing File and/or Tables File(s) (as per CD directory)
- (7) Statement that the four (4) submitted copies of the Sequence Listing Part and/or three (3) submitted copies of the Tables Part are identical
- (8) Contact information

- (a) Name of Contact
- (b) Telephone Number
- (c) Facsimile Number
- (9) Signature of Applicant, Agent, or Common Representative

Important Note: The “Compact Disc Transmittal Sheet For Submission Of Sequence Listing and/or Tables To The United States Receiving Office Under PCT Administrative Instructions - Part 8” is separate

and apart from any other transmittal letter. The Transmittal Sheet requirement cannot be satisfied by incorporating the above information into any other document. A sample copy of a “Compact Disc Transmittal Sheet for Submission of Sequence Listing To the United States Receiving Office Under PCT Administrative Instructions - Part 8” is reproduced on the following page.

<b>COMPACT DISC TRANSMITTAL SHEET FOR SUBMISSION OF SEQUENCE LISTING AND/OR TABLES TO THE UNITED STATES RECEIVING OFFICE UNDER PCT ADMINISTRATIVE INSTRUCTIONS - PART 8</b>	
<i>For Receiving Office Use Only</i>	<i>For Receiving Office Use Only</i>
<i>For Receiving Office Use Only</i>	<b>International Application Number</b> <i>For Receiving Office Use Only</i>
Date of transmission back to applicant	Date of receipt in RO/US <span style="float: right;"># CDs recvd.</span>

<b>INTERNATIONAL APPLICATION DATA</b>
Applicant: _____
File Reference: _____
Title: _____

<b>APPLICANT'S CONTACT INFORMATION</b>
Name of Contact: _____
Telephone Number: _____
Facsimile Number: _____

<b>SEQUENCE LISTING FILE</b>
Name of File (as per CD directory): _____
Size of File (in bytes or kilobytes): _____
Date of File (as per CD directory): _____

<b>TABLES FILE(S) (use continuation box below if necessary)</b>
Name of File(s) (as per CD directory): _____
Size of File(s) (in bytes or kilobytes): _____
Date of File(s) (as per CD directory): _____

<b>STATEMENT</b>
I hereby certify that the four copies of the sequence listing part and/or the three copies of the tables part submitted herewith are identical.
Name of Person Signing: _____
Signature of Applicant, Agent, or Common Representative: _____

<b>CONTINUATION OF TABLES FILE(S) (attach additional sheets if necessary)</b>

This sheet offers a sample or suggested format for a Compact Disc Transmittal Sheet For Submission Of Sequence Listing and/or Tables To The United States Receiving Office Under PCT Administrative Instructions - Part 8. This sample sheet is not an OMB officially approved form.

**2. Where To Submit****(a) United States Postal Service (Express Mail, Priority Mail, First Class Mail, etc.)**

If deposited with the United States Postal Service, the entire international application, including all applicable items set forth in MPEP § 1823.02 paragraph \*>II.A.1.< above, should be addressed to:

\*\*>Mail Stop PCT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450<

**(b) Federal Express, United Parcel Service, or Other Delivery Service**

If deposited with a private delivery service, the entire international application, including all applicable items set forth in MPEP § 1823.02 paragraph I.A.1. above, should be addressed to:

U.S. Patent and Trademark Office

2011 South Clark Place

Customer Window, Box PCT

Crystal Plaza Two, Lobby, Room 1B03

Arlington, VA 22202

**(c) Hand-Carried**

If hand-carried directly to the USPTO, the entire international application, including all applicable items set forth in MPEP § 1823.02 paragraph \*>II.A.1.< above, should be delivered to either location specified below:

Customer Window, \*>Mail Stop< PCT

2011 South Clark Place

Crystal Plaza Two, Lobby, Room 1B03

Arlington, VA 22202

OR

PCT Operations Receptionist

2011 South Clark Place

Crystal Plaza Two - 8<sup>th</sup> Floor

Arlington, VA 22202

**1824 The Claims [R-1]**

*PCT Article 6.*

*The Claims*

The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description.

*PCT Rule 6.*

*The Claims*

**6.1. Number and Numbering of Claims**

(a) The number of the claims shall be reasonable in consideration of the nature of the invention claimed.

(b) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(c) The method of numbering in the case of the amendment of claims shall be governed by the Administrative Instructions.

**6.2. References to Other Parts of the International Application**

(a) Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings. In particular, they shall not rely on such references as: "as described in part ... of the description," or "as illustrated in figure ... of the drawings."

(b) Where the international application contains drawings, the technical features mentioned in the claims shall preferably be followed by the reference signs relating to such features. When used, the reference signs shall preferably be placed between parentheses. If inclusion of reference signs does not particularly facilitate quicker understanding of a claim, it should not be made. Reference signs may be removed by a designated Office for the purposes of publication by such Office.

**6.3. Manner of Claiming**

(a) The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.

(b) Whenever appropriate, claims shall contain:

(i) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,

(ii) a characterizing portion - preceded by the words "characterized in that," "characterized by," "wherein the improvement comprises," or any other words to the same effect - stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.

(c) Where the national law of the designated State does not require the manner of claiming provided for in paragraph (b), failure to use that manner of claiming shall have no effect in that State provided the manner of claiming actually used satisfies the national law of that State.

#### 6.4. *Dependent Claims*

(a) Any claim which includes all the features of one or more other claims (claim in dependent form, hereinafter referred to as “dependent claim”) shall do so by a reference, if possible at the beginning, to the other claim or claims and shall then state the additional features claimed. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such claims in the alternative only. Multiple dependent claims shall not serve as a basis for any other multiple dependent claim. Where the national law of the national Office acting as International Searching Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the preceding two sentences, failure to use that manner of claiming may result in an indication under Article 17(2)(b) in the international search report. Failure to use the said manner of claiming shall have no effect in a designated State if the manner of claiming actually used satisfies the national law of that State.

(b) Any dependent claim shall be construed as including all the limitations contained in the claim to which it refers or, if the dependent claim is a multiple dependent claim, all the limitations contained in the particular claim in relation to which it is considered.

(c) All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most practical way possible.

#### 6.5. *Utility Models*

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 6.1 to 6.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.

#### *PCT Administrative Instruction 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 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.

filed.

#### *37 CFR 1.436. The claims.*

The requirements as to the content and format of claims are set forth in PCT Art. 6 and PCT Rules 6, 9, 10 and 11 and shall be adhered to. The number of the claims shall be reasonable, considering the nature of the invention claimed.

The claim or claims must “define the matter for which protection is sought.” Claims must be clear and concise. They must be fully supported by the description. PCT Rule 6 contains detailed requirements as to the number and numbering of claims, the extent to which any claim may refer to other parts of the international application, the manner of claiming, and dependent claims. As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought (“the characterizing portion”).

The physical requirements for the claims are the same as those for the description. Note that the claims must commence on a new sheet.

The procedure for rectification of obvious errors is explained in MPEP § 1836. The omission of an entire sheet of the claims cannot be rectified without affecting the international filing date. It is recommended that a request for rectification of obvious errors in the claims be made only if the error is liable to affect the international search; otherwise, the rectification should be made by amending the claims.

The claims can be amended during the international phase under PCT Article 19 on receipt of the international search report, during international preliminary examination if the applicant has filed a Demand, and during the national phase.

Multiple dependent claims are permitted in international applications before the United States Patent and Trademark Office as an International Searching and International Preliminary Examining Authority or as a Designated or Elected Office, if they are in the alternative only and do not serve as a basis for any other multiple dependent claim (PCT Rule 6.4(a), 35 U.S.C. 112). The claims, being an element of the application, should start on a new page (PCT Rule 11.4). Page numbers \*\* must not be placed in the margins (PCT



Rule 11.7(b)). Line numbers should appear in the right half of the left margin (PCT Rule 11.8(b)). Paragraph numbers (e.g., paragraph numbers complying with 37 CFR 1.52(b)(6)) are acceptable provided they are not placed in the margins. See PCT Rule 11.6(e).

The number of claims shall be reasonable, considering the nature of the invention claimed (37 CFR 1.436).

## 1825 The Drawings

### *PCT Article 7.*

#### *The Drawings*

(1) Subject to the provisions of paragraph (2)(ii), drawings shall be required when they are necessary for the understanding of the invention.

(2) Where, without being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings:

(i) the applicant may include such drawings in the international application when filed.

(ii) any designated Office may require that the applicant file such drawings with it within the prescribed time limit.

### *PCT Rule 7.*

#### *The Drawings*

##### *7.1. Flow Sheets and Diagrams*

Flow sheets and diagrams are considered drawings.

##### *7.2. Time Limit*

The time limit referred to in Article 7(2)(ii) shall be reasonable under the circumstances of the case and shall, in no case, be shorter than two months from the date of the written invitation requiring the filing of drawings or additional drawings under the said provision.

### *PCT Rule 11.*

#### *Physical Requirements of the International Application*

\*\*\*\*\*

##### *11.5. Size of Sheets*

The size of the sheets shall be A4 (29.7 cm x 21 cm). However, any receiving Office may accept international applications on sheets of other sizes provided that the record copy, as transmitted to the International Bureau, and, if the competent International Searching Authority so desires, the search copy, shall be of A4 size.

##### *11.6. Margins*

\*\*\*\*\*

(c) On sheets containing drawings, the surface usable shall not exceed 26.2 cm x 17.0 cm. The sheets shall not contain frames around the usable or used surface. The minimum margins shall be as follows:

- top: 2.5 cm
- left side: 2.5 cm
- right side: 1.5 cm
- bottom: 1.0 cm

\*\*\*\*\*

##### *11.11. Words in Drawings*

(a) The drawings shall not contain text matter, except a single word or words, when absolutely indispensable, such as "water," "steam," "open," "closed," "section on AB," and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords indispensable for understanding.

(b) Any words used shall be so placed that, if translated, they may be pasted over without interfering with any lines of the drawings.

\*\*\*\*\*

##### *11.13. Special Requirements for Drawings*

(a) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colorings.

(b) Cross-sections shall be indicated by oblique hatching which should not impede the clear reading of the reference signs and leading lines.

(c) The scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty.

(d) When, in exceptional cases, the scale is given on a drawing, it shall be represented graphically.

(e) All numbers, letters and reference lines, appearing on the drawings, shall be simple and clear. Brackets, circles or inverted commas shall not be used in association with numbers and letters.

(f) All lines in the drawings shall, ordinarily, be drawn with the aid of drafting instruments.

(g) Each element of each figure shall be in proper proportion to each of the other elements in the figure, except where the use of a different proportion is indispensable for the clarity of the figure.

(h) The height of the numbers and letters shall not be less than 0.32 cm. For the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used.

(i) The same sheet of drawings may contain several figures. Where figures on two or more sheets form in effect a single complete figure, the figures on the several sheets shall be so arranged that the complete figure can be assembled without concealing any part of any of the figures appearing on the various sheets.

(j) The different figures shall be arranged on a sheet or sheets without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not

arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet.

(k) The different figures shall be numbered in Arabic numerals consecutively and independently of the numbering of the sheets.

(l) Reference signs not mentioned in the description shall not appear in the drawings, and vice versa.

(m) The same features, when denoted by reference signs, shall, throughout the international application, be denoted by the same signs.

(n) If the drawings contain a large number of reference signs, it is strongly recommended to attach a separate sheet listing all reference signs and the features denoted by them.

\*\*\*\*\*

### 37 CFR 1.437. *The drawings.*

(a) Subject to paragraph (b) of this section, when drawings are necessary for the understanding of the invention, or are mentioned in the description, they must be part of an international application as originally filed in the United States Receiving Office in order to maintain the international filing date during the national stage (PCT Art. 7).

(b) Drawings missing from the application upon filing will be accepted if such drawings are received within 30 days of the date of first receipt of the incomplete papers. If the missing drawings are received within the 30-day period, the international filing date shall be the date on which such drawings are received. If such drawings are not timely received, all references to drawings in the international application shall be considered non-existent (PCT Art. 14(2), Administrative Instruction 310).

(c) The physical requirements for drawings are set forth in PCT Rule 11 and shall be adhered to.

The international application must contain drawings when they are necessary for the understanding of the invention. Moreover where, without drawings being actually necessary for the understanding of the invention, its nature admits of illustration by drawings, the applicant may include such drawings and any designated Office may require the applicant to file such drawings during the national phase. Flow sheets and diagrams are considered drawings. "Guidelines for Drawings Under the Patent Cooperation Treaty," published in the *PCT Gazette* (No. 7/1978), may be obtained, in English and French, from the International Bureau.

Drawings must be presented on one or more separate sheets. They may not be included in the description, the claims or the abstract. They may not contain text matter, except a single word or words when absolutely indispensable. Note that if the drawings contain text matter not in English but in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office, the international application

will be transmitted to the International Bureau for processing in its capacity as a Receiving Office. See 37 CFR 1.412(c)(6)(ii). If the drawings contain text matter not in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office, the application will be denied an international filing date.

All lines in the drawings must, ordinarily, be drawn with the aid of a drafting instrument and must be executed in black, uniformly thick and well-defined lines. PCT Rules 11.10 to 11.13 contain detailed requirements as to further physical requirements of drawings. Drawings newly executed according to national standards may not be required during the national phase if the drawings filed with the international application comply with PCT Rule 11. The examiner may require new drawings where the drawings which were accepted during the international phase did not comply with PCT Rule 11. A file reference may be indicated in the upper left corner on each sheet of the drawings as for the description.

All of the figures constituting the drawings must be grouped together on a sheet or sheets without waste of space, preferably in an upright position and clearly separated from each other. Where the drawings or tables cannot be presented satisfactorily in an upright position, they may be placed sideways, with the tops of the drawings or tables on the left-hand side of the sheet.

The usable surface of sheets (which must be of A4 size) must not exceed 26.2 cm x 17.0 cm. The sheets must not contain frames around the usable surface. The minimum margins which must be observed are: top and left side: 2.5 cm; right side: 1.5 cm; bottom: 1.0 cm.

All sheets of drawings must be numbered in the center of either the top or the bottom of each sheet but not in the margin in numbers larger than those used as reference signs in order to avoid confusion with the latter. For drawings, a separate series of page numbers is to be used. The number of each sheet of the drawings must consist of two Arabic numerals separated by an oblique stroke, the first being the sheet number and the second being the total number of sheets of drawings. For example, "2/5" would be used for the second sheet of drawings where there are five in all.

Different figures on the sheets of drawings must be numbered in Arabic numerals consecutively and inde-

pendently of the numbering of the sheets and, if possible, in the order in which they appear. This numbering should be preceded by the expression "Fig."

The PCT makes no provision for photographs. Nevertheless, they are allowed by the International Bureau where it is impossible to present in a drawing what is to be shown (for instance, crystalline structures). Where, exceptionally, photographs are submitted, they must be on sheets of A4 size, they must be black and white, and they must respect the minimum margins and admit of direct reproduction. Color photographs are not accepted.

The procedure for rectification of obvious errors in the drawings is explained in MPEP § 1836. The omission of an entire sheet of drawings cannot be rectified without affecting the international filing date. Changes other than the rectification of obvious errors are considered amendments.

The drawings can be amended during the international phase only if the applicant files a Demand for international preliminary examination. The drawings can also be amended during the national phase.

If drawings are referred to in an international application and are not found in the search copy file, the examiner should refer the application to a Special Program Examiner in his or her Technology Center. See Administrative Instructions Section 310.

## 1826 The Abstract

### *PCT Rule 8.*

#### *The Abstract*

##### *8.1. Contents and Form of the Abstract*

(a) The abstract shall consist of the following:

(i) a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;

(ii) where applicable, the chemical formula which, among all the formulae contained in the international application, best characterizes the invention.

(b) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English).

(c) The abstract shall not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

(d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, placed between parentheses.

##### *8.2. Figure*

(a) If the applicant fails to make the indication referred to in Rule 3.3(a)(iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall, subject to paragraph (b), indicate the figure or figures which should accompany the abstract when the latter is published by the International Bureau. In such case, the abstract shall be accompanied by the figure or figures so indicated by the International Searching Authority. Otherwise, the abstract shall, subject to paragraph (b), be accompanied by the figure or figures suggested by the applicant.

(b) If the International Searching Authority finds that none of the figures of the drawings is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, the abstract, when published by the International Bureau, shall not be accompanied by any figure of the drawings even where the applicant has made a suggestion under Rule 3.3(a)(iii).

##### *8.3. Guiding Principles in Drafting*

The abstract shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art, especially by assisting the scientist, engineer or researcher in formulating an opinion on whether there is a need for consulting the international application itself.

##### *37 CFR 1.438. The abstract.*

(a) Requirements as to the content and form of the abstract are set forth in PCT Rule 8, and shall be adhered to.

(b) Lack of an abstract upon filing of an international application will not affect the granting of a filing date. However, failure to furnish an abstract within one month from the date of the notification by the Receiving Office will result in the international application being declared withdrawn.

The abstract must consist of a summary of the disclosure as contained in the description, the claims and any drawings. Where applicable, it must also contain the most characteristic chemical formula. The abstract must be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). National practice (see MPEP § 608.01(b)) also provides a maximum of 150 words for the abstract. See 37 CFR 1.72(b). The PCT range of 50 - 150 words is not absolute but publication problems could result when the PCT limit is increased beyond the 150 word limit. Maintaining the PCT upper limit is encouraged. As a rule of thumb, it can be said that the volume of the text of the abstract, including one of the figures from the drawings (if

any), should not exceed what can be accommodated on an A4 sheet of typewritten matter, 1 1/2 spaced. The abstract of the international application as filed must begin on a new sheet following the claims (Administrative Instructions Section 207). The other physical requirements must correspond to those for the description. The abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art. These and other requirements concerning the abstract are spelled out in detail in PCT Rule 8. Useful guidance can be obtained from the “Guidelines for the Preparation of Abstracts Under the Patent Cooperation Treaty,” published in the *PCT Gazette* (No. 5/1978). Those Guidelines may be obtained, in English and French, from the International Bureau.

The abstract should be primarily related to what is new in the art to which the invention pertains. Phrases should not be used which are implicit, (for instance, “the invention relates to...”), and statements on the alleged merits or value of the invention are not allowed.

Where the receiving Office finds that the abstract is missing, it invites the applicant to furnish it within a time limit fixed in the invitation. The international application is considered withdrawn if no abstract is furnished to the receiving Office within the time limit fixed. Where the receiving Office has not invited the applicant to furnish an abstract, the International Searching Authority establishes one. The same applies where the abstract does not comply with the requirements outlined in the preceding paragraphs. Where the abstract is established by the International Searching Authority, the applicant may submit comments on it within 1 month from the date of mailing of the international search report, (PCT Rule 38.2(b)).

## SUMMARY OF ABSTRACT REQUIREMENTS

Preferably 50-150 words. Should contain:

- (A) Indication of field of invention.
- (B) Clear indication of the technical problem.
- (C) Gist of invention’s solution of the problem.
- (D) Principal use or uses of the invention.
- (E) Reference numbers of the main technical features placed between parentheses.

(F) Where applicable, chemical formula which best characterizes the invention.

Should not contain:

- (A) Superfluous language.
- (B) Legal phraseology such as “said” and “means.”
- (C) Statements of alleged merit or speculative application.
- (D) Prohibited items as defined in PCT Rule 9.

## 1827 Fees [R-2]

A complete list of Patent Cooperation Treaty fee amounts which are to be paid to the United States Patent and Trademark Office, for both the national and international stages, can be found at the beginning of each weekly issue of the *Official Gazette* of the United States Patent and Trademark Office and on the >Office of< PCT Legal \*>Administration< page of the USPTO web site (see MPEP § 1730). Applicants are urged to refer to this list before submitting any fees to the USPTO.

Pursuant to PCT Rules 14.1(c), \*>15.4<, and 16.1(f), the \*>international filing<, transmittal, and search fee payable is the \*>international filing<, transmittal, and search fee in effect on the \*>receipt< date of the international application. See 37 CFR 1.431(c).

## 1828 Priority Claim and Document [R-2]

An applicant who claims the priority of one or more earlier national>, regional< or international applications for the same invention must indicate on the Request, at the time of filing, the country in or for which it was filed, the date of filing, and the application number. See PCT Article 8 and PCT Rule 4.10 for priority claim particulars and PCT Rule 90<sup>bis</sup>.3 for withdrawal of priority claims. Note that under PCT Rule 4.10, an applicant may claim the priority of an application filed in or for a State which is a Member of the World Trade Organization (WTO), even if that State is not party to the Paris Convention for the Protection of Industrial Property (Paris Convention). However, a PCT Contracting State that is not a Member of the WTO would not be obliged to recognize the effects of such a priority claim.

Effective July 1, 1998, applicant may correct or add a priority claim by a notice submitted to the Receiving Office or the International Bureau within 16 months from the priority date, or where the priority date is changed, within 16 months from the priority date so changed, whichever period expires first, provided that a notice correcting or adding a priority claim may in any event be submitted until the expiration of 4 months from the international filing date. PCT Rule 26<sup>bis</sup>.1 and 37 CFR 1.451 and 1.465.

Under the PCT procedure, the applicant may file the certified copy of the earlier filed national application together with the international application in the receiving Office for transmittal with the record copy, or alternatively the certified copy may be submitted by the applicant to the International Bureau or the receiving Office not later than 16 months from the priority date or, if the applicant has requested early processing in any designated Office, not later than the time such processing or examination is requested. The International Bureau will normally furnish copies of the certified copy to the various designated Offices so that the applicant will not normally be required to submit certified copies to each designated Office.

For use of the priority document in a U.S. national application which entered the national stage from an international application after compliance with 35 U.S.C. 371, see MPEP §1893.03(c).

### **1830 International Application Transmittal Letter [R-2]**

A PCT international application transmittal letter, Form PTO-1382, is available free of charge for applicants to use when filing PCT international applications >and related documents< with the United States Receiving Office. The form is intended to simplify the filing of PCT international applications >and related documents< by providing a one-page letter which covers the most common \*\*>submissions< of applicants. Specifically covered are:

\*\*>

- (A) A new international application;
- (B) A response to an invitation from the United States Receiving Office;
- (C) A request for rectification under PCT Rule 91;

- (D) A petition; and
- (E) A sequence listing diskette.<

### **1832 License Request for Foreign Filing Under the PCT**

A license for foreign filing is not required to file an international application in the United States Receiving Office but may be required before the applicant or the U.S. Receiving Office can forward a copy of the international application to a foreign patent office, the International Bureau or other foreign authority (35 U.S.C. 368, 37 CFR 5.1 and 5.11). A foreign filing license to permit transmittal to a foreign office or international authority is not required if the international application does not disclose subject matter in addition to that disclosed in a prior U.S. national application filed more than 6 months prior to the filing of the international application (37 CFR 5.11(a)). In all other instances (direct foreign filings outside the PCT or filings in a foreign receiving Office), the applicant should petition for a license for foreign filing (37 CFR 5.12) and if appropriate, identify any additional subject matter in the international application which was not in the earlier U.S. national application (37 CFR 5.14 (c)). This request and disclosure information may be supplied on the PCT international application transmittal letter, Form PTO-1382.

If no petition or request for a foreign filing license is included in the international application, and it is clear that a license is required because of the designation of foreign countries and the time at which the Record Copy must be transmitted, it is current Office practice to construe the filing of such an international application to include a request for a foreign filing license. If the license can be granted, it will be issued without further correspondence. If no license can be issued, or further information is required, applicant will be contacted. The automatic request for a foreign filing license does not apply to the filing of a foreign application outside the PCT.

### **EFFECT OF SECRECY ORDER**

If a secrecy order is applied to an international application, the application will not be forwarded to the International Bureau as long as the secrecy order remains in effect (PCT Article 27(8) and 35 U.S.C. 368). If the secrecy order remains in effect, the international application will be declared with-

drawn (abandoned) because the Record Copy of the international application was not received in time by the International Bureau (37 CFR 5.3(d), PCT Article 12(3), and PCT Rule 22.3). It is, however, possible to prevent abandonment as to the United States of America if it has been designated, by fulfilling the requirements of 35 U.S.C. 371(c).

## 1834 Correspondence [R-2]

### *PCT Rule 92. Correspondence*

#### *92.1. Need for Letter and for Signature*

(a) Any paper submitted by the applicant in the course of the international procedure provided for in the Treaty and these Regulations, other than the international application itself, shall, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates. The letter shall be signed by the applicant.

(b) If the requirements provided for in paragraph (a) are not complied with, the applicant shall be informed as to the non-compliance and invited to remedy the omission within a time limit fixed in the invitation. The time limit so fixed shall be reasonable in the circumstances; even where the time limit so fixed expires later than the time limit applying to the furnishing of the paper (or even if the latter time limit has already expired), it shall not be less than 10 days and not more than one month from the mailing of the invitation. If the omission is remedied within the time limit fixed in the invitation, the omission shall be disregarded; otherwise, the applicant shall be informed that the paper has been disregarded.

(c) Where non-compliance with the requirements provided for in paragraph (a) has been overlooked and the paper taken into account in the international procedure, the non-compliance shall be disregarded.

#### *92.2. Languages*

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

(b) Any letter from the applicant to the International Searching Authority or the International Preliminary Examining Authority may be in a language other than that of the international application, provided the said Authority authorizes the use of such language.

(c) *[Deleted]*

(d) Any letter from the applicant to the International Bureau shall be in English or French.

(e) Any letter or notification from the International Bureau to the applicant or to any national Office shall be in English or French.

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### *PCT Administrative Instruction 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.

## **NOTIFICATION UNDER PCT RULE 92.1(b) OF DEFECTS WITH REGARD TO CORRESPONDENCE**

If the Office finds that papers, other than the international application itself, are not accompanied by a letter identifying the international application to which they relate, or are accompanied by an unsigned letter, or are furnished in the form of an unsigned letter, it notifies the applicant and invites him or her to remedy the omission. The Office disregards the said papers or letter if the omission is not remedied within the time limit fixed in the invitation (PCT Rule 92.1(b)). If the omission has been overlooked and the paper taken into account, the omission is disregarded.

## **CORRESPONDENCE ADDRESS**

Where there is a sole applicant without an agent in an international application, correspondence will be sent to the applicant at his or her indicated address; or, if he or she has appointed one or more agents, to that agent or the first-mentioned of those agents; or, if he or she has not appointed an agent but has indicated a special address for notifications, at that special address.

Where there are two or more applicants who have appointed one or more common agents, correspondence will be addressed to that agent or the first-mentioned of those agents. Where no common agent has been appointed, correspondence will be addressed to the common representative (either the appointed common representative or the applicant who is considered to be the common representative (PCT Rule 90.2) at the indicated address; or, if the common representative has appointed one or more agents, to that agent or the first-mentioned of those agents; or, if the common representative has not appointed an agent but has indi-

cated a special address for notifications, at that address.

### FILING OF CORRESPONDENCE BY MAIL

The “Express Mail” procedure set forth at 37 CFR 1.10 applies to papers filed with the U.S. Patent and Trademark Office (USPTO) in international applications. Accordingly, papers filed with the USPTO in international applications will be accorded by the USPTO the date of deposit with the United States Postal Service as shown on the “date-in” on the “Express Mail” mailing label as the date of filing in the USPTO if the provisions of 37 CFR 1.10 are complied with. See MPEP § 513.

If there is a question regarding the date of deposit, the Express Mail provisions of 37 CFR 1.10(c)-(e) require, in addition to using the “Express Mail Post Office to Addressee” service, an indication of the “Express Mail” mailing label number on each paper or fee. In situations wherein the correspondence includes several papers directed to the same application (for example, Request, description, claims, abstract, drawings, and other papers) the correspondence may be submitted with a cover or transmittal letter, which should itemize the papers. The cover or transmittal letter must have the “Express Mail” mailing label number thereon.

The certificate of mailing by first class mail procedure set forth at 37 CFR 1.8 differs from the 37 CFR 1.10 Express Mail procedure. See 37 CFR 1.8(a)(2)(i)(D) and (E). It is important to understand that the 37 CFR 1.8 certificate of mailing procedure CANNOT be used for filing any papers during the international stage if the date of deposit is desired. If the 37 CFR 1.8 certificate of mailing procedure is used, the paper and/or fee will be accorded the date of receipt in the USPTO unless the receipt date falls on a Saturday, Sunday, or Federal holiday in which case the date of receipt will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday (37 CFR 1.6(a)(1)). Accordingly, the certificate of mailing procedures of 37 CFR 1.8 are not available to have a submission during the international stage considered as timely filed if the submission is not physically received at the USPTO on or before the due date.

### 1834.01 Use of Telegraph, Teleprinter, Facsimile Machine [R-1]

PCT Rule 92.4 provides that a national Office may receive documents by telegraph, teleprinter, or facsimile machine. However, the United States Patent and Trademark Office has not informed the International Bureau that it accepts such submissions other than facsimile transmissions. Accordingly, applicants may not currently file papers in international applications with the United States Patent and Trademark Office via telegraph or teleprinter.

Generally, any paper may be filed by facsimile transmission with certain exceptions which are identified in 37 CFR 1.6(d). It should be noted that a facsimile transmission of a document is not permitted and, if submitted, will not be accorded a date of receipt if the document is:

- (A) Required by statute to be certified;
- (B) A drawing submitted under 37 CFR 1.437;
- (C) An international application for patent; or
- (D) A copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.495(b).

Facsimile transmission may be used to submit substitute sheets (other than drawings), extensions of time, power of attorney, fee authorizations (other than the basic national fee), confirmation of precautionary designations, Demands, response to written opinions, oaths or declarations, petitions, and translations in international applications.

A Certificate of Transmission may be used as provided in 37 CFR 1.8(a)(1) except in the instances specifically excluded in 37 CFR 1.8(a)(2). Note particularly that the Certificate of Transmission cannot be used for the filing of an international application for patent or correspondence in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Preliminary Examining Authority. Guidelines for facsimile transmission are clearly set forth in 37 CFR 1.6(d) and should be read before transmitting by facsimile machine.

A signature on a document received via facsimile in a permitted situation is acceptable as a proper signature. See PCT Rule 92.4(b) and 37 CFR 1.4(d)(1)(ii).

The receipt date of a document transmitted via facsimile is the date in the USPTO on which the transmission is completed, unless the receipt date is a Saturday, Sunday, or Federal holiday in which case the date of receipt will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday (37 CFR 1.6(a)(3)). See 37 CFR 1.6(d). Where a document is illegible or part of the document is not received, the document will be treated as not received to the extent that it is illegible or the transmission failed. See PCT Rule 92.4(c).

## 1834.02 Irregularities in the Mail Service

### *PCT Rule 82.*

#### *Irregularities in the Mail Service*

##### *82.1. Delay or Loss in Mail*

(a) Any interested party may offer evidence that he has mailed the document or letter five days prior to the expiration of the time limit. Except in cases where surface mail normally arrives at its destination within two days of mailing, or where no airmail service is available, such evidence may be offered only if the mailing was by airmail. In any case, evidence may be offered only if the mailing was by mail registered by the postal authorities.

(b) If the mailing, in accordance with paragraph (a), of a document or letter is proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, or, if the document or letter is lost in the mail, substitution for it of a new copy shall be permitted, provided that the interested party proves to the satisfaction of the said Office or organization that the document or letter offered in substitution is identical with the document or letter lost.

(c) In the cases provided for in paragraph (b), evidence of mailing within the prescribed time limit, and, where the document or letter was lost, the substitute document or letter as well as the evidence concerning its identity with the document or letter lost shall be submitted within one month after the date on which the interested party noticed or with due diligence should have noticed the delay or the loss, and in no case later than six months after the expiration of the time limit applicable in the given case.

(d) Any national Office or intergovernmental organization which has notified the International Bureau that it will do so shall, where a delivery service other than the postal authorities is used to mail a document or letter, apply the provisions of paragraphs (a) to (c) as if the delivery service was a postal authority. In such a case, the last sentence of paragraph (a) shall not apply but evidence may be offered only if details of the mailing were recorded by the delivery service at the time of mailing. The notification may contain an indication that it applies only to mailings using specified delivery services or delivery services which satisfy spec-

ified criteria. The International Bureau shall publish the information so notified in the Gazette.

(e) Any national Office or intergovernmental organization may proceed under paragraph (d):

(i) even if, where applicable, the delivery service used was not one of those specified, or did not satisfy the criteria specified, in the relevant notification under paragraph (d), or

(ii) even if that Office or organization has not sent to the International Bureau a notification under paragraph (d).

##### *82.2. Interruption in the Mail Service*

(a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.

(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organization that he effected the mailing within five days after the mail service was resumed. The provisions of Rule 82.1(c) shall apply *mutatis mutandis*.

## **DELAY OR LOSS IN MAIL**

Delay or loss in the mail shall be excused when it is proven to the satisfaction of the receiving Office that the concerned letter or document was mailed at least five days before the expiration of the time limit. The mailing must have been by registered air mail or, where surface mail would normally arrive at the destination concerned within two days of mailing, by registered surface mail (PCT Rule 82.1(a) to (c)). PCT Rule 82 contains detailed provisions governing the situation where a letter arrives late or gets lost due to irregularities in the mail service, for example, because the mail service was interrupted due to a strike. The provisions operate to excuse failure to meet a time limit for filing a document for up to six months after the expiration of the time limit concerned, provided that the document was mailed at least five days before the expiration of the time limit. In order to take advantage of these provisions, the mailing must have been by registered airmail or, where surface mail would normally arrive at the destination concerned within two days of mailing, by registered surface mail. Evidence is required to satisfy the Office, and a substitute document must be filed promptly—see PCT Rule 82.1(b) and (c) for details.



## INTERRUPTION IN MAIL SERVICE

The provisions of PCT Rule 82.1(c) apply *mutatis mutandis* for interruptions in the mail service caused by war, revolution, civil disorder, strike, natural calamity or other like reasons (PCT Rule 82.2).

Special provisions also apply to mail interruptions caused by war, revolution, civil disorder, strike, natural calamity or other like reasons—see PCT Rule 82.2 for details.

See PCT Rule 80.5 for guidance on periods which expire on a non-working day.

## 1836 Rectification of Obvious Errors [R-2]

*PCT Rule 91.*

*Obvious Errors in Documents*

### 91.1. Rectification

(a) Subject to paragraphs (b) to (g<sup>quater</sup>), obvious errors in the international application or other papers submitted by the applicant may be rectified.

(b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.

(c) Omissions of entire elements or sheets of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be an obvious error may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g<sup>quater</sup>). Rule 26.4 shall apply *mutatis mutandis* to the manner in which rectifications shall be requested.

(e) No rectification shall be made except with the express authorization:

- (i) of the receiving Office if the error is in the request,
- (ii) of the International Searching Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority,
- (iii) of the International Preliminary Examining Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority, and
- (iv) of the International Bureau if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

(f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The

authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (g<sup>bis</sup>), (g<sup>ter</sup>), or (g<sup>quater</sup>) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification together with the international application. A copy of the request for rectification shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

(g) The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g<sup>bis</sup>), (g<sup>ter</sup>), and (g<sup>quater</sup>), be effective:

(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;

(ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;

(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.

(g<sup>bis</sup>) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.

(g<sup>ter</sup>) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.

(g<sup>quater</sup>) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.

Obvious errors in the international application or other papers submitted by the applicant may generally be rectified under PCT Rule 91, if the rectification is authorized, as required, within the applicable time limit. Any such rectification is free of charge. The omission of entire sheets of the description cannot be rectified, even if resulting from inattention at the stage of copying or assembling sheets.

Applicants often attempt to rely upon the priority application to establish a basis for obvious error. The priority document (application) cannot be used to support obvious error corrections. The rectification is obvious only in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification. \*\*>Examples of obvious errors that are rectifiable include linguistic errors, spelling errors and grammatical errors so long as the meaning of the disclosure does not change upon entry of the rectification. Changes to chemical or mathematical formulas would not generally be rectifiable unless they would be common knowledge to anyone.< A missing chemical formula or missing line of text would not be considered >to be an< obvious error subject to rectification. \*\*

Rectifications must be authorized:

\*\*>

(A) by the Receiving Office if the error is in the request;

(B) by the International Searching Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority;

(C) by the International Preliminary Examining Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority and if a demand for Chapter II examination has been filed in the application;

(D) by the International Bureau if the error is in any paper submitted to it other than the international application or amendments or corrections to the application.<

The request for rectification must be addressed to the authority competent to authorize the rectification. It must be filed in time for the rectification to be authorized and for notification of the authorization to reach the International Bureau before the expiration of the applicable time limit, namely:

(A) Where the authorization is given by the Receiving Office or the International Searching Authority its notification must reach the International Bureau before the expiration of 17 months from the priority date (or later, before the technical preparations for international publication have been completed);

(B) Where the authorization is given by the International Preliminary Examining Authority it must be given before the establishment of the international preliminary examination report;

(C) Where the authorization is given by the International Bureau it must be given before the expiration of 17 months from the priority date (or later, >but< before the technical preparations for international publication have been completed)

\*\* The International Searching Authority informs the applicant of the decision by use of Form PCT/ISA/217, while the International Preliminary Examining Authority informs the applicant of the decision >regarding the authorization or refusal to authorize the rectification of obvious errors< by use of Form PCT/IPEA/412.

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## 1840 The International Searching Authority [R-2]

35 U.S.C. 362. *International Searching Authority and International Preliminary Examining Authority.*

(a) The Patent and Trademark Office may act as an International Searching Authority and International Preliminary Examining Authority with respect to international applications in accordance with the terms and conditions of an agreement which may be concluded with the International Bureau, and may discharge all duties required of such Authorities, including the collection of handling fees and their transmittal to the International Bureau.

(b) The handling fee, preliminary examination fee, and any additional fees due for international preliminary examination shall be paid within such time as may be fixed by the Director.

37 CFR 1.413. *The United States International Searching Authority.*

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(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Searching Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Director, in accordance with the agreement between the Patent and Trademark Office and the International Bureau (PCT Art. 16(3)(b)).<

(b) The Patent and Trademark Office, when acting as an International Searching Authority, will be identified by the full title "United States International Searching Authority" or by the abbreviation "ISA/US."

(c) The major functions of the International Searching Authority include:

- (1) Approving or establishing the title and abstract;
- (2) Considering the matter of unity of invention;

\*\*>

(3) Conducting international and international-type searches and preparing international and international-type search reports (PCT Art. 15, 17 and 18, and PCT Rules 25, 33 to 45 and 47), and issuing declarations that no international search report will be established (PCT Article 17(2)(a));

(4) Preparing written opinions of the International Searching Authority in accordance with PCT Rule 43<sup>bis</sup> (when necessary); and

(5) Transmitting the international search report and the written opinion of the International Searching Authority to the applicant and the International Bureau.<

The United States Patent and Trademark Office >(USPTO)< agreed to and was appointed by the PCT Assembly, to act as an International Searching Authority. As such an Authority, \*\*>the primary functions are to establish (1) international search reports and (2) for international applications having an international filing date on or after January 1, 2004, written opinions. See PCT Article 16 and PCT Rule 43<sup>bis</sup><.

Pursuant to an agreement concluded with the International Bureau, the USPTO, as an International Searching Authority, agreed to conduct international searches and prepare international search reports >and written opinions of the International Searching Authority<, for, in addition to the United States of America, Barbados, Brazil, India, Israel, Mexico, New Zealand, the Philippines, Saint Lucia, South Africa, and Trinidad and Tobago. The agreement stipulated the English language and specified that the subject matter to be searched is that which is searched or examined in United States national applications.

#### **TRANSMITTAL OF THE SEARCH COPY TO THE INTERNATIONAL SEARCHING AUTHORITY**

The “search copy” is transmitted by the Receiving Office to the International Searching Authority (PCT Article 12(1)), the details of the transmittal are provided in PCT Rule 23.

#### **THE MAIN PROCEDURAL STEPS IN THE INTERNATIONAL SEARCHING AUTHORITY**

The main procedural steps that any international application goes through in the International Searching Authority are (1) the making of the international search (PCT Article 15), \* (2) the preparing of the international search report (PCT Article 18 and PCT

Rule 43) >and (3) for international applications having an international filing date on or after January 1, 2004, the preparing of a written opinion of the International Searching Authority (PCT Rule 43<sup>bis</sup>)<.

#### **COMPETENT INTERNATIONAL SEARCHING AUTHORITY**

In respect of international applications filed with the U.S. Receiving Office, the United States International Searching Authority, which is the Examining Corps of the \*\*>USPTO<, is competent to carry out the international search (PCT Article 16, PCT Rules 35 and 36, 35 U.S.C. 362 and 37 CFR 1.413).

The European Patent Office \*\*>may also be< competent to carry out the international search (PCT Article 16, PCT Rules 35 and 36) for international applications filed with the U.S. Receiving Office\*\*. See MPEP § 1840.01 >for specific limitations regarding the competency of the EPO as an International Searching Authority for applications filed by U.S. nationals or residents in the USPTO or in the International Bureau (IB) as receiving Office<.

#### **MATTERS TO BE CONSIDERED WHEN CHOOSING AN INTERNATIONAL SEARCHING AUTHORITY**

Choosing The European Patent Office (EPO) as an International Searching Authority could be advantageous to United States applicants who designate countries for European Regional patent protection in PCT International applications for the following reasons:

(A) Claims may be amended according to EPO search results before entering the European \*\*>regional phase<.

(B) The EPO search fee need not be paid upon entering the European \*\*>regional phase<.

(C) The EPO search results may be available for use in a >corresponding< U.S. \* >nonprovisional< application.

(D) The EPO international search may be obtained without the need for a European professional representative.

(E) The \*\*>EPO< search could provide the U.S. applicant with the benefit of a European art search (which may be different from applicant’s own or the USPTO’s search) before it is necessary to enter the \*\*>EPO< or other designated Offices.

Some disadvantages of choosing the European Patent Office to conduct the international search are the following:

(A) The EPO may not be competent to perform the international search if the application was filed by a national or resident of the U.S. and contains one or more claims relating to the fields of biotechnology or business methods. See MPEP § 1840.01.

(B) The EPO will not search any application to the extent that it considers that the international application relates to subject matter set forth in PCT Rule 39.1. See MPEP § 1840.01 and § 1843.02.

(C) Additional mailing time to and from the EPO Searching Authority may shorten the time for applicants to respond to various invitations from the EPO such as for comments on abstracts and payments of additional search fees as well as for PCT Article 19 amendments to the claims after issuance of the international search report and, for international applications filed on or after January 1, 2004, the written opinion established by the International Searching Authority.

(D) There may be more difficulty in solving any procedural problems between the applicant and the EPO than with the USPTO due to physical distance and time differences.

The PCT Applicant's Guide provides helpful information for communications with the European Patent Office.

### 1840.01 The European Patent Office as an International Searching Authority [R-2]

Since October 1, 1982, the European Patent Office (EPO) has been available as an International Searching Authority for PCT applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office (USPTO) as receiving Office or in the International Bureau (IB) as receiving Office. The choice of International Searching Authority, either the EPO or the USPTO, must be made by the applicant on filing the international application. The EPO has expressed the following limitations concerning its competency to act as an International Searching Authority. For updates or possible changes to these limitations, applicants should consult the PCT News-

letter which is available in electronic form from the web site of the World Intellectual Property Organization ([www.wipo.int/pct/en/newslett/index.htm](http://www.wipo.int/pct/en/newslett/index.htm)).

#### I. SUBJECT MATTER THAT WILL NOT BE SEARCHED BY THE EPO

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##### A. *Field of Biotechnology*

The EPO is not a competent authority within the meaning of PCT Article 16(3)(b), and will not carry out an international search in respect of any international application filed on or after March 1, 2002 and before January 1, 2004 if the application: (A) was filed with the USPTO as receiving Office by a national or resident of the U.S.; or (B) was filed with the IB as receiving Office by a national or resident of the U.S. (provided the application did not also identify as an applicant at its time of filing a national or resident of a European Patent Convention (EPC) Contracting State), where such application contains one or more claims relating to the field of biotechnology as defined by the following units of the International Patent Classification:<

C 12 M	Apparatus for enzymology or microbiology
C 12 N	Micro-organisms or enzymes; compositions thereof
C 12 P	Fermentation or enzyme-using processes to synthesise a desired chemical compound or composition or to separate optical isomers from a racemic mixture
C 12 Q	Measuring or testing processes involving enzymes or micro-organisms; compositions or test papers therefor; processes of preparing such compositions; condition-responsive control in microbiological or enzymological processes
C 07 K	Peptides

- G 01 N 33/50 Chemical analysis of biological material, e.g. blood, urine; testing (including subdivisions) involving biospecific ligand binding methods; immunological testing
- A 61 K 39 Medicinal preparations containing antigens or antibodies
- A 61 K 48 Medicinal preparations containing genetic material which is inserted into cells of the living body to treat genetic diseases; Gene therapy
- A 01 H New plants or processes for obtaining them; plant reproduction by tissue culture techniques

For information, U.S. classes covering the corresponding subject matter are listed below:

- 424 Drug, bio-affecting and body treating compositions
- 435 Chemistry: molecular biology and microbiology
- 436 Chemistry: analytical and immunological testing
- 514 Drug, bio-affecting and body treating compositions
- 530 Chemistry: natural resins or derivatives; peptides or proteins; lignins or reaction products thereof
- 536 Organic compounds—part of the class 532-570 series
- 800 Multicellular living organisms and unmodified parts thereof

930 Peptide or protein sequence

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**B. Field of Business Methods**

The EPO is not a competent authority within the meaning of PCT Article 16(3)(b) and will not carry out an international search in respect of any international application filed on or after March 1, 2002 if the application: (A) is filed with the USPTO as receiving Office by a national or resident of the U.S.; or (B) is filed with the IB as receiving Office by a national or resident of the U.S. (provided the application does not also identify as an applicant at its time of filing a national or resident of an EPC Contracting State), where such application contains one or more claims relating to the field of business methods as defined by the following units of the International Patent Classification:<

- G 06 F 17/60 Digital computing or data processing equipment or methods, specially adapted for specific functions: administrative, commercial, managerial, supervisory or forecasting purposes. To the extent that the application falls under above mentioned subgroup but does not relate to business methods the EPO' s competence is not affected.

For information, the U.S. class covering the corresponding subject matter is listed below:

- 705 Data processing: financial, business practice, management, or cost/price determination

The U.S. Receiving Office will forward all international applications to the EPO as ISA if so indicated by the applicant and the EPO will perform a competence check on the search copy. Where the EPO finds that it was indicated as the ISA but the application falls under the limitations indicated above, the EPO will *ex officio* change the ISA from EPO to the USPTO and will inform the applicant, the International Bureau and the USPTO accordingly. The EPO will transfer moneys received as the search fee as well as the search copy to the USPTO.

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**C. < Declaration Under PCT Article 17(2)(a)(i)**

It should be noted that even when the European Patent Office is a competent International Searching Authority (for example, if one or more applicants is a resident or national of an EPC contracting state and the application was filed with the International Bureau as receiving Office), the EPO nonetheless will not search, by virtue of PCT Article 17(2)(a)(i), any international application to the extent that it considers

that the international application relates to subject matter set forth in PCT Rule 39.1. \*\*

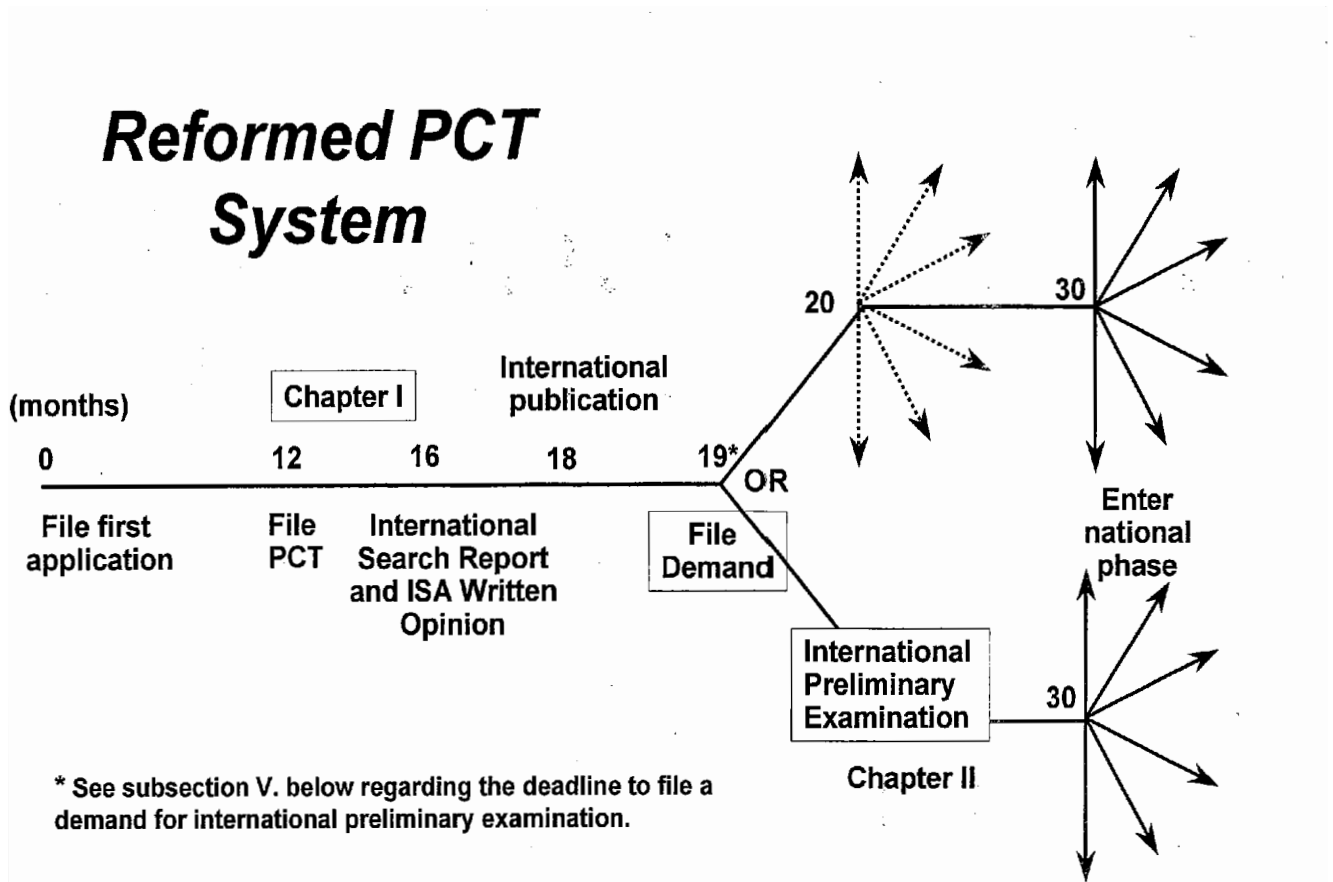
**II. FEES FOR SERVICES OF THE ISA/EP**

The international search fee for the European Patent Office must be paid to the \*\*>USPTO< as a Receiving Office \*>within< one month from the time of filing the international application. The search fee for the European Patent Office is announced weekly in the *Official Gazette* in United States dollars. The search fee will change as costs and exchange rates require. If exchange rates fluctuate significantly, the fee may change frequently. Notice of changes will be published in the *Official Gazette* shortly before the effective date of any change.

If the European Patent Office as the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in PCT Rule 13, the European Patent Office will invite applicants to timely pay directly to it an additional search fee in Euros for each additional invention.

1842 Basic Flow Under the PCT [R-2]

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## I. MEASURING TIME LIMITS UNDER THE PCT

Time limits under the PCT are measured from the “priority date” of the application. The priority date for the purposes of computing time limits is defined in PCT Article 2(xi). Where an international application does not contain any priority claim under PCT Article 8, the international filing date is considered to be the priority date.

## II. INTERNATIONAL FILING DATE

An international application under the Patent Cooperation Treaty is generally filed within 12 months after the filing of the first application directed to the same subject matter, so that priority may be claimed under PCT Article 8 and Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property. PCT Article 11 specifies the elements required for an international application to be accorded an international filing date.

## III. ESTABLISHMENT OF THE INTERNATIONAL SEARCH REPORT >AND WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY<

As provided in PCT Rule 42 >and PCT Rule 43<sup>bis</sup><, the time limit for establishing the international search report (or a declaration that no international search report will be established) >and, for international applications having an international filing date on or after January 1, 2004, the written opinion,< is three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later.

## IV. INTERNATIONAL PUBLICATION

Under PCT Article 21, the international publication of the international application by the International Bureau shall be effected promptly after the expiration of 18 months from the priority date of that application.

## V. DEADLINE FOR FILING THE DEMAND

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### A. *International Applications Having a Filing Date On or After January 1, 2004*

International preliminary examination is optional, but if a demand for international preliminary examination is filed in an international application having an international filing date on or after January 1, 2004, it must be filed prior to the expiration of whichever of the following periods expires later: (A) three months from the date of transmittal to the applicant of the international search report and the written opinion; or (B) 22 months from the priority date. Otherwise the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare. See PCT Rule 54. In order to take advantage of a national phase entry time limit of at least 30 months from the priority date in relation to all States designated in the international application, it may be necessary to file a demand before the expiration of 19 months from the priority date. See subsection VI.A., below.

### B. *International Applications Having a Filing Date Before January 1, 2004*<

International Preliminary Examination is optional, and a Demand for International Preliminary Examination may be filed at any time. However, in order to take advantage of a national phase entry time limit of at least 30 months from the priority date in relation to all States designated in the international application, it may be necessary to file a demand before the expiration of 19 months from the priority date. >See subsection VI.A., below.<

## VI. DEADLINE FOR FILING COPY, TRANSLATION, AND FEE IN NATIONAL STAGE OFFICES

A listing of all national and regional offices, and the corresponding time limits for entering the national stage following PCT Chapter I and PCT Chapter II, may be found on WIPO’s web site at: <http://www.wipo.int/pct/en/index.html>.



### A. *National Stage Entry Following PCT Chapter I*

PCT Article 22(1) was amended, effective April 1, 2002, to specify that the national stage requirements are due not later than at the expiration of 30 months from the priority date if no demand has been filed. Prior to April 1, 2002, PCT Article 22(1) specified that these requirements were due not later than at the expiration of 20 months from the priority date. See <http://www.wipo.int/pct/en/index.html> for a list of the Contracting States that have not yet changed their national laws to adopt the 30 month period now set forth in PCT Article 22(1).

### B. *National Stage Entry Following PCT Chapter II*

If the election of a Contracting State has been effected by filing a demand prior to the expiration of the 19th month from the priority date, the provisions of Article 39 apply rather than the provisions of Article 22. The deadline for filing the national stage requirements under PCT Article 39(a) is 30 months from the priority date, but any national law may fix time limits which expire later than the time limit provided in PCT Article 39(a). See PCT Article 39(b) and the list of time limits found on WIPO's web site at <http://www.wipo.int/pct/en/index.html>.

## 1843 The International Search [R-2]

### *PCT Article 17.*

#### *Procedure before the International Searching Authority*

(1) Procedure before the International Searching Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.

(2)(a) If the International Searching Authority considers:

(i) that the international application relates to a subject matter which the International Searching Authority is not required, under the Regulations, to search, and in the particular case decides not to search, or

(ii) that the description, the claims, or the drawings, fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out, the said Authority shall so declare and shall notify the applicant and the International Bureau that no international search report will be established.

(b) If any of the situations referred to in subparagraph (a) is found to exist in connection with certain claims only, the international search report shall so indicate in respect of such claims,

whereas, for the other claims, the said report shall be established as provided in Article 18.

(3)(a) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant to pay additional fees. The International Searching Authority shall establish the international search report on those parts of the international application which relate to the invention first mentioned in the claims (main invention) and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to inventions in respect of which the said fees were paid.

(b) The national law of any designated State may provide that, where the national Office of the State finds the invitation, referred to in subparagraph (a), of the International Searching Authority justified and where the applicant has not paid all additional fees, those parts of the international application which consequently have not been searched shall, as far as effects in the State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.

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### *PCT Rule 43<sup>bis</sup>.*

#### *Written Opinion of the International Searching Authority*

#### *43<sup>bis</sup>.1. Written Opinion*

(a) Subject to Rule 69.1(b<sup>bis</sup>), the International Searching Authority shall, at the same time as it establishes the international search report, establish a written opinion as to:

(i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;

(ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

(c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under Rule 66.1<sup>bis</sup>(a) but subject to Rule 66.1<sup>bis</sup>(b), be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a), in which case the applicant is invited to submit to that Authority, before the expiration of the time limit under Rule 54<sup>bis</sup>.1(a), a written reply together, where appropriate, with amendments.

The international search is a thorough, high quality search of the most relevant resources. Upon completion of the international search an international search

report is established. The report provides information on the relevant prior art to the applicant, the public, the designated Offices, and the International Preliminary Examining Authority.<

PCT Article 15 describes the objective of the international search, i.e., to uncover relevant prior art, and also describes the international-type search. It should be noted generally that an international-type search is performed on all U.S. national applications filed after June 1, 1978.

\*\*>Some major amendments to the PCT Rules became effective January 1, 2004. One of the consequences of these amendments is that for all international applications having an international filing date on or after January 1, 2004, and subject to PCT Rule 69.1(b-bis), the International Searching Authority establishes a written opinion of the International Searching Authority at the same time it establishes either the international search report or the declaration of non-establishment of the international search report under PCT Article 17(2)(a). (For applications having an international filing date prior to January 1, 2004, the International Searching Authority establishes an international search report but does not establish a written opinion.) The written opinion indicates whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable. The written opinion also indicates any defects in the form or content of the international application under the PCT Articles or Regulations. In addition, the written opinion includes any observations that the International Searching Authority wishes to make on the clarity of the claims, the description, and the drawings, or on the question of whether the claims are fully supported by the description.<

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## **1843.01 Prior Art for Chapter I Processing [R-2]**

### *PCT Rule 33.*

#### *Relevant Prior Art for the International Search*

##### *33.1.Relevant Prior Art for the International Search*

(a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not

new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

(b) When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

(c) Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

##### *33.2.Fields to Be Covered by the International Search*

(a) The international search shall cover all those technical fields, and shall be carried out on the basis of all those search files, which may contain material pertinent to the invention.

(b) Consequently, not only shall the art in which the invention is classifiable be searched but also analogous arts regardless of where classified.

(c) The question what arts are, in any given case, to be regarded as analogous shall be considered in the light of what appears to be the necessary essential function or use of the invention and not only the specific functions expressly indicated in the international application.

(d) The international search shall embrace all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features, even though, in its specifics, the invention as described in the international application is different.

##### *33.3.Orientation of the International Search*

(a) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed.

(b) In so far as possible and reasonable, the international search shall cover the entire subject matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended.

### *PCT Rule 64.*

#### *Prior Art for International Preliminary Examination*

##### *64.1.Prior Art*

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations)

shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) For the purposes of paragraph (a), the relevant date will be:

(i) subject to item (ii), the international filing date of the international application under international preliminary examination;

(ii) where the international application under international preliminary examination validly claims the priority of an earlier application, the filing date of such earlier application.

#### 64.2. *Non-Written Disclosures*

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means (“non-written disclosure”) before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the non-written disclosure shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.

#### 64.3. *Certain Published Documents*

In cases where any application or any patent which would constitute prior art for the purposes of Article 33(2) and (3) had it been published prior to the relevant date referred to in Rule 64.1 was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in Rule 70.10.

The objective of the international search is to discover relevant prior art (PCT Article 15(2)). “Prior art” consists of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations); it is relevant in respect of the international application if it is capable of being of assistance in determining that the claimed invention is or is not new and that the claimed invention does or does not involve an inventive step (i.e., that it is or is not obvious), and if the making available to the public occurred prior to the international filing date for the purposes of the international search report and prior to the earliest validly claimed priority date for the purposes of the written opinion of the International Searching Authority. For further details, see PCT Rules 33, 43<sup>bis</sup>.1(b) and 64.

A written disclosure, that is, a document, is regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain access to the content of the document and to acquire possession of the content of the document, and there was no bar of confidentiality restricting the use or dissemination of knowledge gained thereby. Where the document only provides the month or the year, but not the specific date, which the document was made available to the public, the content of the document is presumed to have been made available to the public on the last day of that month or that year, respectively, unless evidence is provided to prove otherwise.

Prior art disclosure on the Internet or on an on-line database is considered in the same manner as other forms of written disclosure. Information disclosed on the Internet or an on-line database is considered to be publicly available as of the date the disclosure was publicly posted. Where the examiner obtains an electronic document that establishes the publication date for the Internet disclosure, he/she should make a printout of this document, which must mention both the URL of the relevant Internet disclosure and the date of publication of that relevant Internet disclosure. The examiner must then cite this printout in the international search report as an “L” document and cite the relevant Internet disclosure according to the relevance of its content (“X”, “Y”, “A”) and according to the date as established (“X”, “Y”, “A”, “P,X”, “P,Y”, “P,A”, “E”, etc.). See MPEP § 1844.01 under the heading “DOCUMENTS CONSIDERED TO BE RELEVANT.” Where the examiner is unable to establish the publication date of the relevant Internet disclosure and it is relevant to the inventive step and/or novelty of the claimed invention, he/she should cite it in the international search report as a category “L” document for those claims which it would have affected if it were published in time, giving the date the document was printed out as its publication date.

Examiners are also encouraged to cite prior art that might be of assistance in determining whether other requirements are fulfilled, such as sufficient support of the claims by the description and industrial applicability. The examiner should also note any documents that may be of importance for other reasons, such as documents putting doubt upon the validity of any priority claimed, documents contributing to a better or

more correct understanding of the claimed invention, and documents illustrating the technological background, but the examiner should not spend time in searching for these documents, nor the consideration of such matters unless there is a special reason for doing so in a particular case. Documents which do not qualify as prior art because they post-date the claimed invention may nevertheless be cited to show a universal fact, such as characteristics or properties of a material, or a specific scientific fact, or to show the level of ordinary skill in the art. Furthermore, examiners must recognize that different designated Offices may have different definitions of what is the effective date of prior art. Accordingly, when performing the search, examiners should be mindful to pick out and select for citation, where appropriate, prior art which may be relevant in offices other than the one in which they are situated. However, the examiner need not expand the search beyond the standard search parameters to discover such art. Where the search has been performed and such potentially relevant prior art has been identified, examiners are encouraged to, for example, cite all relevant art published prior to the international filing date even if that art and the international application under consideration have common applicants and/or inventors. As such, if the examiner is basing the international search on a prior search performed in a prior related U.S. national application, it may be necessary for the examiner to review the prior art published within the time period of the one year preceding the filing date of the prior U.S. application for any written disclosures based on the applicant's own work that may have been published within that time period. Any such documents are considered prior art in an international application and are cited on the international search report even though they do not meet the definition of prior art in the prior U.S. national application. A further objective of the international search is to avoid, or at least minimize, additional searching at the national stage.

The international search is made on the basis of the claims, with due regard to the description and the drawings (if any) contained in the international application (PCT Article 15(3)) and should cover the entire subject matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (PCT Rule 33.3(b)).

The relevant date for the purpose of considering prior art for the purposes of establishment of the written opinion of the International Searching Authority is defined in PCT Rule 64.1(b) as the international filing date or, where the international application contains a valid claim for priority, that date of priority.

In establishment of the written opinion, when determining whether there is inventive step, account should be taken of what the applicant acknowledges in his/her description as known. Such admissions should be regarded as correct and used when considering whether the claimed invention lacks novelty and/or inventive step where appropriate.

A nonwritten disclosure such as an oral disclosure, use, exhibition or other means of disclosure is not relevant prior art for the purposes of the international search unless it is substantiated by a written disclosure made available to the public prior to the international filing date and it is the written disclosure which constitutes the prior art. However, if the date on which the written disclosure was made available to the public was on or after the filing date of the international application under consideration, the search report should separately mention that fact and the date on which the written disclosure was available, even though such a written disclosure does not meet the definition of relevant prior art in the international phase, so long as the non-written disclosure was made available to the public on a date prior to the international filing date since such a non-written disclosure may be considered to be prior art under national law in the national phase. See PCT Rules 33.1(b), 64.2 and 70.9.<

#### **DOCUMENTS >AND DATABASES< SEARCHED BY THE INTERNATIONAL SEARCHING AUTHORITY**

The International Searching Authority must endeavor to discover as much of the relevant prior art as its facilities permit (PCT Article 15(4)), and, in any case, must consult the so-called "minimum documentation" (PCT Rule 34).

\*\*>Even though completeness should be the ultimate goal of the international search, this goal may at times be difficult to obtain, because of such factors as text search limitations and the inevitable imperfections of any classification system and its implementation. The examiner therefore consults the appropriate

minimum documentation and the most relevant search resources for the technology, including databases listed in the U.S. Search Guidance index (available through the USPTO Intranet web site), and organizes the search effort and utilizes the search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as art that fully anticipates any claims.

When conducting the search, it may be necessary to make use of the Internet as a search tool. Where the international application has not yet been published at the time of the search, there exists the danger that search terms used in the search on non-secure Internet search engines or in databases available on the Internet may be observed by third parties. Accordingly, all web sites must be treated as non-secure unless the Office has a commercial arrangement with a service provider in order to maintain confidentiality and a secure connection to that web site. Consequently, extreme caution must be exercised when using the Internet as a search tool where (as in most cases) the international application has not yet been published. Where a relevant database is accessible via the Internet, but an alternative secure connection to the same database is accessible, the secure connection must be used. Where no secure connection to a database on the Internet is available, the search may be conducted on the Internet using generalized search terms representing combinations of features that relate to the claimed invention, which have already been shown to exist in the state of the art.

## 1843.02 < Certain Subject Matter Need Not Be Searched [R-2]

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*PCT Rule 39.*

*Subject Matter under Article 17(2)(a)(i)*

### 39.1. Definition

No International Searching Authority shall be required to search an international application if, and to the extent to which, its subject matter is any of the following:

- (i) scientific and mathematical theories,
- (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than micro-biological processes and the products of such processes,

- (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,
- (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
- (v) mere presentations of information,
- (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

*PCT Rule 66.*

*Procedure Before the International Preliminary Examining Authority*

### 66.1. Basis of the International Preliminary Examination

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(e) Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

*PCT Rule 67.*

*Subject Matter Under Article 34(4)(a)(i)*

### 67.1. Definition

No International Preliminary Examining Authority shall be required to carry out an international preliminary examination on an international application if, and to the extent to which, its subject matter is any of the following:

- (i) scientific and mathematical theories,
- (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than micro-biological processes and the products of such processes,
- (iii) schemes, rules, or methods of doing business, performing purely mental acts, or playing games,
- (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
- (v) mere presentations of information,
- (vi) computer programs to the extent that the International Preliminary Examining Authority is not equipped to carry out an international preliminary examination concerning such programs.<

The USPTO has declared that it will search and examine, in international applications, all subject matter searched and examined in U.S. national applications. However under PCT \*>Rules< 39, >43<sup>bis</sup>.1(b), 66.1(e) and 67.1,< no International Searching Authority is required to perform an international search >or to establish a written opinion concerning novelty, inventive step and industrial applicability< where the international application relates to any of the following subject matters:

- (A) Scientific and mathematical theories;

(B) Plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes;

(C) Schemes, rules or methods of doing business, performing purely mental acts or playing games;

(D) Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods;

(E) Mere presentation of information; and

(F) Computer programs to the extent \*\* the said Authority is not equipped to search prior art \*\*>concerning such programs<.

>See PCT Rule 39. In addition, the examiner is not required to search the international application, to the extent that a meaningful search cannot be carried out, in certain cases where a nucleotide and/or amino acid sequence listing is not furnished in accordance with the prescribed standard or in a computer readable form. See Administrative Instructions Section 513(c). However, the U.S. Patent and Trademark Office has declared that it will search and examine all subject matter searched and examined in U.S. national applications.<

The applicant considering the filing of an international application may be well advised not to file one if the subject matter of the application falls into one of the above mentioned areas. If he or she still does file, the International Searching Authority may declare that it will not establish an international search report. Accordingly, applicant should take into consideration which International Searching Authority (e.g., European Patent Office) he or she selects to conduct the international search. It is to be noted, nevertheless, that the lack of the international search report in such case will not have, in itself, any influence on the validity of the international application and the latter's processing will continue, including its communication to the designated Offices.

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### **1843.03 < No Search Required if Claims Are Unclear [R-2]**

If the International Searching Authority considers that the description, the claims, or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried

out, it may declare that it will not establish a search report (PCT Article 17(2)(a)(ii)). \*\*>Further, for applications having an international filing date on or after January 1, 2004, if the International Searching Authority considers that the description, claims, or drawings are so unclear, or the claims are so inadequately supported by the description that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness), or industrial applicability of the claimed invention, the Authority shall not go into these issues in its written opinion with regard to the claims so affected (PCT Rules 43<sup>bis</sup>.1(b) and 67). For example, the examiner may determine that a meaningful search cannot be carried out or that no meaningful opinion can be formed in certain cases where a nucleotide and/or amino acid sequence listing is not furnished in accordance with the prescribed standard or in a computer readable form. See Administrative Instructions Section 513(c) and MPEP § 1848. Further, the examiner may determine that a meaningful search cannot be carried out or that no meaningful opinion can be formed for improper multiple dependent claims (see PCT Rule 6.4(a)).<

>

### **1843.04 Procedure for Claims Not Required To Be Searched and for Claims That Are Unclear [R-2]**

The International Searching Authority (ISA) may declare that a meaningful search cannot be carried out with respect to some of the claims only and/or that only certain claims relate to subject matter which the ISA is not required to and has decided not to search. Where only some of the claims will not be searched, the ISA searches the remaining claims of the international application. Any unsearched claims and the reasons why those claims have not been searched are indicated in Box II of the international search report (Form PCT/ISA/210).

If the examiner determines that none of the claims will be searched, the examiner declares that no search report will be established using form PCT/ISA/203. The lack of the international search report will not, in itself, have any influence on the validity of the international application and the latter's processing will continue, including its communication to the designated Offices.

If the international application cites a document that is not published or otherwise not accessible to the ISA and the document appears essential to a correct understanding of the invention to the extent that a meaningful international search would not be possible without knowledge of the content of that document, the ISA may postpone the search and request that the applicant first provide first a copy of the document, if possible to do so within the time limits for the preparation of the international search report of the ISA under the PCT. If no copy of the document is received, the ISA should first attempt to carry out the international search and then, if necessary, indicate that no meaningful search could be carried out in total or that the search needed to be restricted.

For international applications having an international filing date on or after January 1, 2004, and subject to PCT Rule 69.1(b-*bis*), the ISA establishes the written opinion of the International Searching Authority (Form PCT/ISA/237) at the same time it establishes either the international search report (Form PCT/ISA/210) or the declaration of non-establishment of the international search report (Form PCT/ISA/203). However, if the ISA determines that for any or all claims (A) the international application relates to subject matter for which it is not required to establish a written opinion concerning novelty, inventive step and industrial applicability, (B) the description, claims, or drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step, or industrial applicability, of the claimed invention, or (C) the subject matter of the claims relates to inventions for which no international search report will be established, the ISA indicates, in Box III of the written opinion of the International Searching Authority (Form PCT/ISA/237), that no opinion with regard to novelty, inventive step or industrial applicability will be established with regard to those claims. In most instances it will be sufficient for the examiner to (A) indicate that no international search report has been established for the relevant claims as the reason for not establishing an opinion on novelty, inventive step, and industrial applicability and (B) refer to the international search report or declaration of non-establishment of the international search report for further details.<

&gt;

### **1843.05 Time Limit for Establishing the International Search Report and the Written Opinion of the International Searching Authority [R-2]**

Publication of the international application occurs at 18 months from the earliest priority date or, where there is no priority date, 18 months from the international filing date. The international search report is subject to international publication. The written opinion is not published but is made available to the public after the expiration of 30 months from the priority date. See PCT Rule 44<sup>ter</sup>. The Office goal is to have the search report and, if the application has an international filing date on or after January 1, 2004, the written opinion, mailed in sufficient time to reach the International Bureau by the end of 16 months from the priority date or 9 months from the filing date if no priority claim is made. This is necessary since the technical preparations for publication are completed by 17.5 months from the earliest priority date. In view of the treaty mandated publication and the time needed for technical preparation, the Office sets time periods for completion of the search report and the written opinion which will ensure sufficient time to complete internal processing and review and achieve receipt of the search report and the written opinion at the International Bureau by the 16th month from the priority date. See PCT Rule 42.1 and 43<sup>bis</sup>.1(a).

Thus, as a matter of practice, each Technology Center tends to set its internal time period for completion of the search report and the written opinion to meet the time limits set by the International Application Processing Division. The International Application Processing Division sets its time for completion to ensure adequate time for review, corrections (where necessary) and mailing.

The date of transmittal of the search report becomes critical for applicants since it starts the 2 month period for submission of amendments to the claims under PCT Article 19. See PCT Rule 46.1.

The Patent Cooperation Treaty is extremely date sensitive and for that reason, examiners are encouraged to complete the international search and prepare the search report, and in applications having an inter-

national filing date filed on or after January 1, 2004, the written opinion, promptly after receipt. Monitoring and tracking procedures have been devised to minimize the risk of late search reports and written opinions and/or date of transmission thereof.<

## 1844 The International Search Report [R-2]

*PCT Article 18.*

*The International Search Report*

(1) The international search report shall be established within the prescribed time limit and in the prescribed form.

(2) The international search report shall, as soon as it has been established, be transmitted by the International Searching Authority to the applicant and the International Bureau.

(3) The international search report or the declaration referred to in Article 17(2)(a) shall be translated as provided in the Regulations. The translations shall be prepared by or under the responsibility of the International Bureau.

The results of the international search **\*\*>are<** recorded in the international search report (Form PCT/ISA/210), which>, together with the written opinion of the International Searching Authority (Form PCT/ISA/237) for applications having an international filing date on or after January 1, 2004,< is transmitted with Form PCT/ISA/220**\*\***. The search report will be published by the International Bureau and>, together with the written opinion of the International Searching Authority,< will serve as a basis for examination of the international application by the designated Offices and the International Preliminary **>Examining<** Authority.

**\*\***

The search report >is only for the purpose of identifying prior art and< should not contain any expressions of opinion, reasoning, argument or explanation as to any cited prior art. **\*\*>**However, in applications having an international filing date on or after January 1, 2004, such comments should be included in the written opinion of the International Searching Authority.<

The printed international search report form (Form PCT/ISA/210) to be transmitted to the applicant and to the International Bureau contains two main sheets (“first sheet” and “second sheet”) to be used for all searches. These two main sheets are intended for recording the important features of the search such as the fields searched and for citing documents revealed

by the search. The printed international search report form also contains **>five<** optional continuation sheets for use where necessary. **\*\*>**They are the: “continuation of first sheet (1),” “continuation of first sheet (2),” “continuation of first sheet (3),” “continuation of second sheet” and “patent family annex,” respectively.< The patent family annex sheet is not currently used by the United States International Searching Authority since patent family information is not readily available to the examiner. The “continuation of first sheet (1)” is to be used only >when the international application includes a nucleotide and/or amino acid sequence and indicates the basis on which the international search was carried out, since the relevant listings or related tables may be filed or furnished at different times and in different forms. The “continuation of first sheet (2)” is used where< an indication is made on the first sheet that claims were found unsearchable (item **>2<**) and/or unity of invention is lacking (item **>3<**). The relevant indications must then be made on that continuation sheet. The “continuation of first sheet (**>3<**)” is to contain the text of the abstract where an abstract or an amended abstract has been established by the International Searching Authority (item 5) and an indication to that effect is made on the first sheet. The “continuation of second sheet” is to be used where the space on the second sheet is insufficient for the citation of documents. **\*\*>**The form also includes an< “extra sheet” >which< may be used whenever additional space is required to complete information from the other sheets.

It is to be noted that only the “second sheet”, the “continuation of second sheet” (if any)**\*\*>**, the “continuation of first sheet (2)” (if any), and the “extra sheet” (if any), as well as any separate sheet with information on members of patent families, will be the subject of international publication, as the “first sheet,” “continuation of first sheet (1)” (if any), and the “continuation of first sheet (3)” (if any)< contain only information which will already appear on the front page of the pamphlet >(PCT Rule 48.2(v))<.

**\*\***

## CONTENTS OF THE INTERNATIONAL SEARCH REPORT

The international search report (PCT Rule 43) contains, among other things, the citations of the docu-



ments considered to be relevant (PCT Rule 43.5 and Administrative Instructions Section 503), the classification of the subject matter of the invention (PCT Rule 43.3 and Administrative Instructions Section 504) and an indication of the fields searched (PCT Rule 43.6). Citations of particular relevance must be specially indicated (Administrative Instructions Section 505); citations of certain specific categories of documents are also indicated (Administrative Instructions Section 507); citations which are not relevant to all the claims must be cited in relation to the claim or claims to which they are relevant (Administrative Instructions Section 508); if only certain passages of the cited document are particularly relevant, they must be identified, for example, by indicating the page, the column or the lines, where the passage appears.

### **1844.01 \*\*>Preparing < the International Search Report >(Form PCT/ISA/210)< [R-2]**

#### **>TOTAL NUMBER OF SHEETS**

The first sheet of the international search report indicates the total number of sheets in the report. The correct number is entered, not including sheets that have not been filled-in (blank sheets). The number of sheets only includes the number of sheets from Form PCT/ISA/210.

#### **NUCLEOTIDE AND/OR AMINO ACID SEQUENCE LISTINGS AND RELATED TABLES**

Where the application discloses any nucleotide and/or amino acid sequence, box 1.b of the first sheet is checked and Box No. I (appearing on “continuation of first sheet (1)”) indicates the format (that is, whether in paper copy or computer readable form) and status (that is whether filed with the international application or later, for purposes of search) of the sequence listing, and any related tables.

#### **RESTRICTION OF THE SUBJECT OF THE INTERNATIONAL SEARCH**

The report indicates whether the search was restricted or not for any of the reasons indicated

below. If any such restrictions are applied, the claims in respect of which a search has not been carried out are identified and the reasons for this are indicated. The four categories where such restrictions may arise are:

(A) claims drawn to subject matter not required to be searched by the International Searching Authority (see MPEP § 1843.02);

(B) claims in respect of which a meaningful search cannot be carried out (see MPEP § 1843.03);

(C) multiple dependent claims which do not comply with PCT Rule 6.4(a) (see MPEP § 1843.03);

(D) lack of unity of invention (see MPEP § 1850).

Where claims are not searched for any of the reasons identified in (A)-(C) above, box 2 of the first sheet of the international search report is checked. In addition, Box No. II of the international search report (on “continuation of first sheet (2)”) is completed, giving the details.

Where lack of unity has been found (see MPEP § 1850), box 3 of the first sheet of the international search report is checked. In addition, Box No. III of the international search report (on “continuation of first sheet (2)”) is completed, irrespective of whether an invitation to pay additional search fees has issued. The search report indicates the separate inventions claimed in the application, whether additional search fees were requested and paid, and which claims were searched. It also indicates whether any additional search fees were accompanied by a protest.

#### **TITLE, ABSTRACT, AND FIGURE FOR PUBLICATION**

The international application must contain an abstract and a title. The examiner considers the abstract (together with the title of the invention and the figure of the drawings to be published with the abstract) in relation to the requirements of the Regulations under the PCT. The examiner indicates approval or amendment of the text of the abstract, the title of the invention, and the selection of the figure that is to accompany the abstract in items 4 to 6 of the first sheet of the international search report.

**A. Title***PCT Rule 4.  
The Request (Contents)*

\*\*\*\*\*

**4.3. Title of the Invention**

The title of the invention shall be short (preferably from two to seven words when in English or translated into English) and precise.

\*\*\*\*\*

*PCT Rule 37.  
Missing or Defective Title***37.1. Lack of Title**

If the international application does not contain a title and the receiving Office has notified the International Searching Authority that it has invited the applicant to correct such defect, the International Searching Authority shall proceed with the international search unless and until it receives notification that the said application is considered withdrawn.

**37.2. Establishment of Title**

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with Rule 4.3, it shall itself establish a title. Such title shall be established in the language in which the international application is to be published or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

The title must be short and precise (preferably from two to seven words in English or when translated into English). Furthermore, the title should clearly and concisely state the technical designation of the invention. In this regard the following should be taken into account:

(A) personal names or trade names or similar terms of non-technical nature which do not serve to identify the invention should not be used;

(B) the abbreviation “etc.,” being vague, should not be used and should be replaced by an indication of what it is intended to cover;

(C) titles such as “Method,” “Apparatus,” “Chemical Compounds” alone or similar vague titles do not clearly state the technical designation of the invention and should not be used.

In general, the examiner is required to draft a new title if the applicant failed to provide a title or if the title is deficient because it does not comply with the requirements of PCT Rule 4.3. The examiner is not required to gain the applicant’s approval of the new title established by the examiner.

**B. Abstract and Figure for Publication***PCT Rule 8.  
The Abstract***8.1. Contents and Form of the Abstract**

(a) The abstract shall consist of the following:

(i) a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;

(ii) where applicable, the chemical formula which, among all the formulae contained in the international application, best characterizes the invention.

(b) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English).

(c) The abstract shall not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

(d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, placed between parentheses.

**8.2. Figure**

(a) If the applicant fails to make the indication referred to in Rule 3.3(a)(iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall, subject to paragraph (b), indicate the figure or figures which should accompany the abstract when the latter is published by the International Bureau. In such case, the abstract shall be accompanied by the figure or figures so indicated by the International Searching Authority. Otherwise, the abstract shall, subject to paragraph (b), be accompanied by the figure or figures suggested by the applicant.

(b) If the International Searching Authority finds that none of the figures of the drawings is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, the abstract, when published by the International Bureau, shall not be accompanied by any figure of the drawings even where the applicant has made a suggestion under Rule 3.3(a)(iii).

*PCT Rule 38.**Missing or Defective Abstract**38.1.Lack of Abstract*

If the international application does not contain an abstract and the receiving Office has notified the International Searching Authority that it has invited the applicant to correct such defect, the International Searching Authority shall proceed with the international search unless and until it receives notification that the said application is considered withdrawn.

*38.2.Establishment of Abstract*

(a) If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is to be published or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

(b) The applicant may, within one month from the date of mailing of the international search report, submit comments on the abstract established by the International Searching Authority. Where that Authority amends the abstract established by it, it shall notify the amendment to the International Bureau.

In general, the examiner will have to establish a new abstract if the applicant did not provide an abstract or if the abstract does not comply with PCT Rule 8. In determining the definitive contents of the abstract, or establishing the text of the abstract anew where it is missing, the examiner should take into consideration the fact that the abstract is merely for use as technical information and, in particular, must not be used for the purpose of interpreting the scope of the protection sought. The abstract constitutes an efficient instrument for the purpose of assisting the scientist, engineer, or researcher in searching in the particular technical field and should in particular make it possible to assess whether there is need for consulting the international application itself. WIPO guidelines for the preparation of abstracts are found in WIPO Standard ST.12/A, which is available from WIPO's web site ([www.wipo.int/scit/en/standards/standards.htm](http://www.wipo.int/scit/en/standards/standards.htm)).

In considering the adequacy of the applicant's abstract and figure, because of practical difficulties experienced by the International Bureau with publica-

tion, examiners should have particular regard to the following:

(A) It is important that the abstract be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). Within this constraint the abstract must provide a summary of the technical information about the disclosure as contained in the description, claims, and drawings. It should be drafted so as to serve as an efficient scanning tool for searching purposes in the art.

(B) Phrases should not be used which can be implied, such as "This disclosure concerns," "The invention defined by this disclosure," and "This invention relates to."

(C) Only one figure should normally be selected unless this would lead to inadequate disclosure. The inclusion of more than two figures should not be considered except in extreme circumstances where necessary information cannot be otherwise conveyed. Where none of the figures is considered useful for the understanding of the invention (even where the applicant has suggested a figure), no figure should be selected.

(D) Abstracts may be incomprehensible if the numerals of the selected figure(s) do not correspond with those in the abstract. Thus, this should be avoided.

(E) An absence of reference numbers on the figures must be accepted as the examiner has no mechanism to initiate their addition.

(F) Each main technical feature mentioned in the abstract and illustrated by a drawing should be followed by a reference sign, placed between parentheses.

If the examiner establishes a new abstract, the applicant can only comment on the new abstract after it has been established in the international search report. The applicant is allowed one month from the date of mailing of the international search report to respond to the examiner's abstract in the report. If the applicant does comment, the examiner takes the applicant's comments into consideration. It is not necessary for the examiner to reply to the applicant's comments even if adverse. If the examiner decides to amend the abstract established in the international search report, the International Bureau and the applicant are notified using Form PCT/ISA/205. See PCT

Rule 38.2(b) and Administrative Instructions Section 515.

When indicating the figure to be published, the applicant's suggestion is found in Box IX of the request Form (PCT/RO/101). Where none of the figures is considered useful for the understanding of the abstract, this is indicated at the appropriate box (item 6 of the first sheet of Form PCT/ISA/210). When no drawings accompany the application, none of the boxes are checked. It is not recommended to select more than one figure; however, if it is necessary to do so then the wording of the form should be changed to reflect the change from single case to plural case. For example, "figure" is changed to "figures", "is" to "are" and No. "to Nos.".

### CLASSIFICATION OF SUBJECT MATTER

The International Searching Authority assigns obligatory International Patent Classification (IPC) symbols in accordance with the rules as set forth in the Guide to the IPC and in the IPC itself (using the edition of the IPC in force at the time), whereby the technical subject of the invention of the application is identified. The International Searching Authority then records the International Patent Classification in Box A of the second sheet of the international search report. The IPC Guide can be accessed via the Patent Examiner's Toolkit under Classification Tools or via WIPO's web site ([www.wipo.int](http://www.wipo.int)).

### RECORDING THE SEARCH

The examiner records the search history in Box B of the second sheet of the international search report. In recording the search history of the international search, the examiner lists the classification identification of the fields searched. Examiners are also encouraged to record the search history in sufficient detail to allow examiners of national stage applications to fully interpret and rely upon the international search. This includes recording the details of any patent and non-patent literature searches as well as searches conducted on the Internet.

Where the international search report is entirely or partly based on a previous search made for an application relating to a similar subject, the previous application number and the relevant search history consulted for this previous search is, where appropriate, identified as having been consulted for the international

application in question, except in those instances where the details of an earlier search cannot be ascertained, or whenever it is impractical to record the full details of the earlier search. In the later case, a summary of the earlier search should be included. Where the previous application has been published, this information is recorded in the international search report.

### DOCUMENTS CONSIDERED TO BE RELEVANT

The completion of Box C of the second sheet of the international search report can be considered as having three components. These are: (A) the citation category; (B) the citation of the document together with identification of the relevant passages where appropriate; and (C) the identification of relevant claim numbers. The citation of multiple documents showing the same inventive elements should be kept to a minimum. Further, when citing a document, the examiner should clearly indicate which portions of the document are most relevant.

#### A. *Citation Category*

Documents which are cited are given a category indication by way of an alphabetic character, details of which are given in Administrative Instructions Sections 505 and 507 and below. The categories for citations are also explained under the "documents considered to be relevant" section of the report. A category should always be indicated for each document cited. Where needed, combinations of different categories are possible.

#### 1. **Particularly Relevant Documents**

Where a document cited in the international search report is particularly relevant, it is indicated by the letters "X" or "Y". Category "X" is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel or where a document is such that when considered in light of common general knowledge, a claimed invention cannot be considered to involve an inventive step. 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 documents of the same category,

such combination being obvious to a person skilled in the art.

## 2. Documents Defining the State of the Art and Not Prejudicing Novelty or Inventive Step

Where a document cited in the international search report represents state of the art and is not prejudicial to the novelty or inventive step of the claimed invention, it is indicated by the letter “A”.

## 3. Documents Which Refer to a Non-Written Disclosure

Where a document cited in the international search report refers to a non-written disclosure referred to in PCT Rule 33.1(b), the letter “O” is entered. Examples of such disclosures include conference proceedings. The document category “O” is always accompanied by a symbol indicating the relevance of the document, for example: “O,X”, “O,Y”, or “O,A”.

## 4. Intermediate Documents

Documents published on dates falling between the date of filing of the application being searched and the date of priority claimed, or the earliest priority if there is more than one (see PCT Article 2(xi)(b)), are denoted by the letter “P”. The letter “P” is also given to a document published on the very day of the earliest date of priority of the patent application under consideration. The document category “P” is always accompanied by a symbol indicating the relevance of the document, for example: “P,X”, “P,Y”, or “P,A”.

## 5. Documents Relating to the Theory or Principle Underlying the Invention

Where any document cited in the search report is a document that may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it is indicated by the letter “T”.

## 6. Potentially Conflicting Patent Documents

Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date) but published on or later than that date and the content of which would constitute prior art relevant to novelty (PCT Article

33(2)) is indicated by the letter “E” (see Administrative Instructions Section 507(b) and PCT Rule 33.1(c)).

## 7. Documents Cited in the Application

When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, such documents may be identified on the search report by the wording “cited in the application” under the cited document.

## 8. Documents Cited for Other Reasons

Where in the search report any document is cited for reasons other than those referred to in the foregoing paragraphs (in particular as evidence), for example:

(A) a document which may throw doubt on a priority claim (Article 4(C)(4) of the Paris Convention), or

(B) a document cited to establish the publication date of another citation,

the document is indicated by the letter “L”. Brief reasons for citing the document should be given. Documents of this type need not be indicated as relevant to any particular claims. However, where the evidence that they provide relates only to certain claims (for example the “L” document cited in the search report may invalidate the priority in respect of certain claims and not others), then the citation of the document should refer to those claims.

### B. Relationship Between Documents and Claims

Each citation should include a reference to the claims to which it relates (see Administrative Instructions Section 508). If necessary, various relevant parts of the document cited should each be related to the claims in like manner (with the exception of “L” documents and “A” documents). It is also possible for the same document to represent a different category with respect to different claims. For example:

WO1990/001867 A (WIDEGREN LARS (SE)) 8  
March 1990 (08-03-1990), figures 1 and 2

X 1  
Y 2-5  
A 6-10

The above example means that Figures 1 and 2 of the cited document disclose subject matter which

prejudices the novelty or inventive step of claim 1, which prejudices the inventive step of claims 2-5 when combined with another document cited in the search report, and which represents non-prejudicial state of the art for the subject matter of claims 6-10.

### **C. Citation of the Documents**

Identification of any document should be made according to WIPO Standard ST.14 (see Administrative Instructions Section 503). For “A” citations it is not necessary to indicate the relevant claims unless there is good reason to do so; for example where there is a clear lack of unity *a priori* (see MPEP § 1850) and the citation is relevant only to a particular claim or group of claims or when the claims meet the criteria of novelty, inventive step, and industrial applicability under PCT Article 33(2) to (4) and the “A” category citations represent the most relevant prior art. The box on the second sheet of Form PCT/ISA/210 entitled “Further documents listed are in the continuation of Box C” is checked if a continuation sheet is used to list additional documents that will not fit in the space provided in Box C.

### **FINALIZATION OF THE SEARCH REPORT**

The identification of the International Searching Authority which established the international search report and the date of actual completion, that is, the

date on which the report was drawn up are indicated at the bottom of the second sheet of the international search report. This information is generated automatically by the OACS software when preparing the international search report. The international search report will be accompanied by a transmittal letter (Form PCT/ISA/220) indicating the date the search report was mailed to the applicant. The mailing date is important for the computation of the time limit for filing amendments to the claims under PCT Article 19. See MPEP § 1853.

Pursuant to PCT Rule 43.8, the international search report must indicate the name of the officer of the International Searching Authority responsible for the report, i.e., the “authorized officer.” An “authorized officer” is the person who actually performed the search work and prepared the search report, or another person who was responsible for supervising the search. See Administrative Instructions Section 514. Thus, an examiner need not have signatory authority in order to be named as an authorized officer on the search report. However, the “file copy” of the search report must be signed by an examiner having at least partial signatory authority.

The international search report should be mailed within 3 months of receipt of the search copy or within 9 months from the priority date, whichever is later.

\*\*

## PATENT COOPERATION TREATY

## PCT

## INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference CMC-123-PCT	<b>FOR FURTHER ACTION</b>	see Form PCT/ISA/220 as well as, where applicable, item 5 below.
International application No. PCT/US04/00150	International filing date ( <i>day/month/year</i> ) 05 January 2004 (05.01.2004)	(Earliest) Priority Date ( <i>day/month/year</i> ) 06 January 2003 (06.01.2003)
Applicant ACME FASTENER CORPORATION		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 4 sheets.

It is also accompanied by a copy of each prior art document cited in this report.

## 1. Basis of the report

a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

The international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b.  With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

2.  **Certain claims were found unsearchable** (see Box No. II)

3.  **Unity of invention is lacking** (see Box No. III)

4. With regard to the **title**,

the text is approved as submitted by the applicant.

the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

the text is approved as submitted by the applicant.

the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the **drawings**,

a. the figure of the **drawings** to be published with the abstract is Figure No. 3

as suggested by the applicant.

as selected by this Authority, because the applicant failed to suggest a figure.

as selected by this Authority, because this figure better characterizes the invention.

b.  none of the figures is to be published with the abstract.

Form PCT/ISA/210 (first sheet) (January 2004)

<b>INTERNATIONAL SEARCH REPORT</b>		International application No. PCT/US04/00150
<b>Box No. II Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)</b>		
This international search report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:		
1. <input type="checkbox"/>	Claims Nos.: because they relate to subject matter not required to be searched by this Authority, namely:	
2. <input type="checkbox"/>	Claims Nos.: because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:	
3. <input type="checkbox"/>	Claims Nos.: because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).	
<b>Box No. III Observations where unity of invention is lacking (Continuation of item 3 of first sheet)</b>		
This International Searching Authority found multiple inventions in this international application, as follows:		
See Extra Sheet		
1. <input checked="" type="checkbox"/>	As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.	
2. <input type="checkbox"/>	As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.	
3. <input type="checkbox"/>	As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:	
4. <input type="checkbox"/>	No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:	
<b>Remark on Protest</b>	<input type="checkbox"/>	The additional search fees were accompanied by the applicant's protest.
	<input checked="" type="checkbox"/>	No protest accompanied the payment of additional search fees.

Form PCT/ISA/210 (continuation of first sheet (2)) (January 2004)



**INTERNATIONAL SEARCH REPORT**

International application No.

PCT/US04/00150

<p><b>A. CLASSIFICATION OF SUBJECT MATTER</b>                  IPC(7) : B25C 5/06                  US CL : 227/8, 121                  According to International Patent Classification (IPC) or to both national classification and IPC</p>																				
<p><b>B. FIELDS SEARCHED</b></p> <p>Minimum documentation searched (classification system followed by classification symbols)                  U.S. : 227/8, 120, 121, 123, 125, 127, 128, 131</p> <p>Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched</p> <p>Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)</p>																				
<p><b>C. DOCUMENTS CONSIDERED TO BE RELEVANT</b></p> <table border="1"> <thead> <tr> <th>Category*</th> <th>Citation of document, with indication, where appropriate, of the relevant passages</th> <th>Relevant to claim No.</th> </tr> </thead> <tbody> <tr> <td>X</td> <td>US 4,573,621 A (NOVAK et al) 08 March 1983 (08.03.1983), col 1, ln 65 - col 2, ln 5</td> <td>1 and 2</td> </tr> <tr> <td>Y</td> <td>figure 3</td> <td>3 and 5 - 15</td> </tr> <tr> <td>A</td> <td></td> <td>4 and 16 -20</td> </tr> <tr> <td>Y</td> <td>US 4,183,453 A (BARRETT et al) 15 January 1980 (15.01.1980), col 6, ln 34 - col 7, ln 7 and figures 5 - 7</td> <td>3 and 5 - 10</td> </tr> <tr> <td>Y</td> <td>US 3,041,614 A (D'HAEM et al) 03 July 1962 (03.07.1962), col 4, ln 76 - col 5, ln 23</td> <td>11 - 15</td> </tr> </tbody> </table>			Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.	X	US 4,573,621 A (NOVAK et al) 08 March 1983 (08.03.1983), col 1, ln 65 - col 2, ln 5	1 and 2	Y	figure 3	3 and 5 - 15	A		4 and 16 -20	Y	US 4,183,453 A (BARRETT et al) 15 January 1980 (15.01.1980), col 6, ln 34 - col 7, ln 7 and figures 5 - 7	3 and 5 - 10	Y	US 3,041,614 A (D'HAEM et al) 03 July 1962 (03.07.1962), col 4, ln 76 - col 5, ln 23	11 - 15
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<p><input type="checkbox"/> Further documents are listed in the continuation of Box C.      <input type="checkbox"/> See patent family annex.</p>																				
<p>* Special categories of cited documents:</p> <table border="0"> <tr> <td>"A" document defining the general state of the art which is not considered to be of particular relevance</td> <td>"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention</td> </tr> <tr> <td>"E" earlier application or patent published on or after the international filing date</td> <td>"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone</td> </tr> <tr> <td>"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)</td> <td>"Y" document of particular relevance; the 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</td> </tr> <tr> <td>"O" document referring to an oral disclosure, use, exhibition or other means</td> <td>"&amp;" document member of the same patent family</td> </tr> <tr> <td>"P" document published prior to the international filing date but later than the priority date claimed</td> <td></td> </tr> </table>			"A" document defining the general state of the art which is not considered to be of particular relevance	"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention	"E" earlier application or patent published on or after the international filing date	"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone	"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"Y" document of particular relevance; the 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	"O" document referring to an oral disclosure, use, exhibition or other means	"&" document member of the same patent family	"P" document published prior to the international filing date but later than the priority date claimed									
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"P" document published prior to the international filing date but later than the priority date claimed																				
<p>Date of the actual completion of the international search                  05 March 2004 (05.03.2004)</p>		<p>Date of mailing of the international search report  <b>06 APR 2004</b></p>																		
<p>Name and mailing address of the ISA/US                  Mail Stop PCT, Attn: ISA/US                  Commissioner for Patents                  P.O. Box 1450                  Alexandria, Virginia 22313-1450                  Facsimile No. (703)305-3230</p>		<p>Authorized officer                  Paul A. Bell                  Telephone No. 703-308-3543</p>																		

Form PCT/ISA/210 (second sheet) (January 2004)

## INTERNATIONAL SEARCH REPORT

International application No. PCT/US04/00150
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This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In order for all inventions to be searched, the appropriate additional search fees must be paid.

Group I, claim(s) 1 - 2, drawn to an electromagnetic fastener driver with a safety interlock to prevent firing of the tool without the fastener output channel being pressed against a work piece.

Group II, claim(s) 3 and 5, drawn to an electromagnetic fastener driver with means to prevent the feeding of a fastener while the tool is being actuated.

Group III, claim(s) 6 - 10, drawn to an electromagnetic fastener driver with a control means to provide for multiple driving strokes to be delivered to the same fastener with a single actuation of the tool.

Group IV, claim(s) 11 - 15, drawn to an electromagnetic fastener driver with a fastener jam clearance feature.

Group V, claim(s) 4 and 16 - 20, drawn to an electromagnetic fastener driver with means to hold the fastener magazine in a predetermined position.

The inventions listed as Groups I - V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of the Group I invention is the safety interlock to prevent firing of the tool without the fastener output channel being pressed against a work piece. The special technical feature of the Group II invention is the means to prevent the feeding of a fastener while the tool is being actuated. The special technical feature of the Group III invention is the control means to provide for multiple driving strokes to be delivered to the same fastener with a single actuation of the tool. The special technical feature of the Group IV invention is the fastener jam clearance feature. The special technical feature of the Group V invention is the means to hold the fastener magazine in a predetermined position. None of these special technical features are common to the other groups, nor do they correspond to a special technical feature in the other groups. Therefore, unity of invention is lacking.

&gt;

## 1845 Written Opinion of the International Searching Authority [R-2]

*PCT Rule 43<sup>bis</sup>.*

*Written Opinion of the International Searching Authority*

### *43<sup>bis</sup>.1. Written Opinion*

(a) Subject to Rule 69.1(b<sup>bis</sup>), the International Searching Authority shall, at the same time as it establishes the international search report, establish a written opinion as to:

(i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;

(ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

(c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under Rule 66.1<sup>bis</sup>(a) but subject to Rule 66.1<sup>bis</sup>(b), be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a), in which case the applicant is invited to submit to that Authority, before the expiration of the time limit under Rule 54<sup>bis</sup>.1(a), a written reply together, where appropriate, with amendments.

For international applications having an international filing date on or after January 1, 2004, the examiner is required, in most instances, to establish a written opinion on novelty, inventive step, and industrial applicability of the claimed invention at the same time he/she establishes the international search report. The international search report and written opinion together serve to inform the International Preliminary Examining Authority of the documents and arguments necessary to complete the relevant assessments if international preliminary examination is demanded, and to inform the designated Offices of information that may be relevant to examination in the national phase. (The written opinion is transmitted to the designated offices in the form of an international preliminary report on patentability if no international preliminary examination report is established under Chapter II of the PCT). A written opinion of the Inter-

national Searching Authority is not required in the limited instance where a demand for international preliminary examination and required fees (PCT Rule 69.1(a)) have been filed with the United States International Preliminary Examining Authority and the examiner considers all the conditions of PCT Article 34(2)(c)(i) to (iii) to be fulfilled. In this limited instance, a positive international preliminary examination report may be issued. See PCT Rule 69.1(b<sup>bis</sup>)).

The applicant must be notified in the written opinion of the defects found in the application. The examiner is further required to fully state the reasons for his/her opinion (PCT Rule 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)).<

&gt;

## 1845.01 Preparing the Written Opinion of the International Searching Authority (Form PCT/ISA/237) [R-2]

### BOX NO. I. — BASIS OF OPINION

When completing Box I, item 1, of Form PCT/ISA/237, the examiner must indicate whether or not the opinion has been established on the basis of the international application in the language in which it was filed. If a translation was furnished for the purpose of the search, this must be indicated. With respect to Box I, item 2 of Form PCT/ISA/237, if the opinion has been based on a nucleotide and/or amino acid sequence disclosed and necessary to the claimed invention, the examiner must indicate the type of material (e.g., a sequence listing and/or tables related thereto), the format of the material (e.g., in written format and/or in computer readable form) and the time of filing/furnishing (e.g., contained in the international application as filed, filed together with the international application in computer readable form and/or furnished subsequently to this Authority for the purposes of the search). If more than one version or copy of the sequence listing and/or table relating thereto is filed, the examiner must indicate whether the applicant has provided the required statement indicating that the information in the subsequent or additional copies are identical to that in the applica-

tion as filed or does not go beyond the application as filed.

### **BOX NO. II. — PRIORITY**

Box II of Form PCT/ISA/237 is to inform applicant of the status of a request for priority. Where one or more citations of the international search report were published after the earliest priority date, the validity of that earliest priority date requires checking. Where the priority document is one which is in the records of the ISA, it should be obtained from those records. If a copy of the priority document is not available before preparation of the written opinion of the ISA because it has not yet been provided by the applicant, and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, the written opinion of the ISA may be established as if the priority had been validly claimed.

If the examiner needs a copy of a foreign priority document, the copy will be supplied on request to the International Bureau (IB) unless the IB has not yet received the priority document, in which case the examiner may invite the applicant to furnish such a copy. See PCT Rule 66.7(a). The examiner may consult with his or her SPRE regarding requesting a copy of the priority document from the IB. If the priority document is not in English, the examiner may invite the applicant to furnish a translation of the priority document within two months of the invitation. See PCT Rule 66.7(b). Box II, item 3, “Additional Observations” may be used to invite applicant to supply a copy of the priority document and/or translation. Preparation of the written opinion by the International Searching Authority should not be delayed to await a response to the invitation. The written opinion of the ISA will ordinarily be established as if the priority claim had been validly claimed even though the copy and/or translation has not been furnished. However, failure to timely furnish a copy of the priority document and/or translation may result in any further written opinion or international preliminary examination report of the International Preliminary Examining Authority being established as if the priority had not been claimed.

If applicant fails to furnish a copy or translation of the earlier application, whose priority has been claimed, check item No. 1 and then check the first box of the subsection if applicant failed to furnish a copy of the earlier application whose priority has been claimed, and check the second box of the subsection if applicant failed to furnish a translation of the earlier application whose priority has been claimed.

When the claim for priority has been found invalid (e.g., the claimed priority date is more than one year prior to the international filing date and the notification under PCT Rule 26<sup>bis</sup>.2(b) has been provided or all claims are directed to inventions which were not described and enabled by the earlier application), check item No. 2 in Box II and indicate why the claim for priority has been found invalid following item No. 3 “Additional observations”.

### **BOX NO. III. — NON-ESTABLISHMENT OF OPINION ON NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY**

Box III of Form PCT/ISA/237 is intended to cover situations where some or all claims of an application are so unclear or inadequately supported by the description that the question of novelty, inventive step (nonobviousness), and industrial applicability cannot be considered, or where the international application or claims thereof relate to subject matter for which it is not required to establish a written opinion concerning novelty, inventive step and industrial applicability, or where no international search report has been established for the claims.

If some or all of the claims of an application relate to subject matter for which it is not required to establish a written opinion concerning novelty, inventive step and industrial applicability, check the appropriate box, indicate which claims relate to that subject matter and specify the reasons.

If some or all of the claims of an application are so unclear that no meaningful opinion could be formed, check the appropriate box, indicate which claims are unclear and specify the reasons.

If some or all of the claims are so inadequately supported by the description that no meaningful opinion could be formed, check the appropriate box.

If no international search report has been established for certain claims, check the appropriate box and indicate the claim numbers.

If the nucleotide and/or amino acid sequence listing does not comply with Annex C of the Administrative Instructions, the examiner must indicate whether the written form and/or the computer readable form is not in compliance and the reason for the non-compliance. Further, if tables related to the sequence listing are included as part of the international application, and these tables fail to comply with the technical requirements of Annex C of the Administrative Instructions, the examiner must indicate this in Box III.

#### **BOX NO. IV. — LACK OF UNITY OF INVENTION**

Box IV of Form PCT/ISA/237 should be used by the examiner to notify applicant that lack of unity has been found.

If, in response to a lack of unity of invention, applicant paid additional fees for additional inventions, the examiner should check the first box under subsection 1.

If the additional fees were paid under protest, the examiner should check the second box under subsection 1.

If applicant neither restricted nor paid additional fees in reply to the lack of unity of invention, the examiner should check the third box under subsection 1.

Subsection 2 of Box IV is to be completed if the examiner determines that unity of invention is lacking but chooses not to invite the applicant to restrict or pay additional fees.

If a lack of unity exists, the examiner would mark the second box under subsection 3. However, since the reasons for the lack of unity have already been set forth on the simultaneously issued international search report, the examiner can simply state that the reason the requirement of unity of invention is not complied with is set forth in the international search report. The first box under subsection 3 would never be marked.

Subsection 4 is used by the examiner to indicate which parts of the application form the basis of the opinion after the lack of unity of invention has been explained.

#### **BOX NO. V. — REASONED STATEMENT WITH REGARD TO NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY OF CLAIMS**

In Box V of Form PCT/ISA/237, the examiner must list in summary form all claims with regard to the criteria of novelty (N), inventive step (IS), and industrial applicability (IA). For definitions of novelty, inventive step, and industrial applicability see MPEP §§ 1878.01(a)(1), 1878.01(a)(2), and 1878.01(a)(3), respectively.

Box V is the main purpose of the written opinion. All claims without fatal defects are treated on the merits in Box V as to novelty, inventive step (nonobviousness) and industrial applicability.

The treatment of claims in Box V is similar in format to an Office action in a U.S. national patent application except that the words “rejection” and “patentability” are never used in a written opinion. On the international level, all written opinions are non-binding and a patent does not issue; what does issue is an international preliminary examination report (IPER), which is nonbinding on the elected States.

Examiner statements in Box V can be positive or negative. If the claims define over the prior art and meet the test of novelty, inventive step (nonobviousness) and industrial applicability, a statement equivalent to detailed reasons for allowance in a corresponding U.S. national application should be provided, indicating how the claims meet the tests of novelty, inventive step and industrial applicability. Form paragraphs 18.04 and 18.04.01 may be used for this purpose.

##### *¶ 18.04 Meets Novelty and Inventive Step*

Claim [1] the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest [2].

##### **Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and insert the verb --meet-- or --meets--, as appropriate.
2. In bracket 2, insert the details of the claimed subject matter that render it unobvious over the prior art.
3. If the claims also meet the industrial applicability criteria set out in PCT Article 33(4), this form paragraph should be followed by form paragraph 18.04.01.
4. If the claims do not meet the industrial applicability criteria set out in PCT Article 33(4), this form paragraph should be followed by form paragraph 18.03.

*¶ 18.04.01 Meets Industrial Applicability*

Claim [1] the criteria set out in PCT Article 33(4), and thus [2] industrial applicability because the subject matter claimed can be made or used in industry.

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --meet-- or -- meets--, as appropriate.
2. In bracket 2, insert --have-- or --has--, as appropriate.
3. If the claims meet all of the requirements of PCT Article 33(2)-(4), use form paragraph 18.04 before this form paragraph to provide positive statements for novelty and inventive step under PCT Article 33(2)-(3).
4. If the claims have industrial applicability but lack novelty and inventive step, use this form paragraph and additionally use form paragraph 18.01.
5. If the claims have industrial applicability and novelty but lack inventive step, use this form paragraph and additionally use one or more of form paragraphs 18.02, 18.02.01 and 18.02.02, as appropriate.
6. If the claims do not have industrial applicability, use form paragraph 18.03 instead of this form paragraph.

If, on the other hand, it is the opinion of the examiner that some or all claims lack novelty, inventive step, or industrial applicability, specific reasons must be given similar to those used in U.S. national applications. If the claims lack inventive step over a combination of references, the reasons must explain why one of ordinary skill in the art would have been motivated to combine the teachings of the applied references.

Form paragraphs 18.01, 18.02, 18.02.01, 18.02.02, and 18.03 may be used, as appropriate, to explain the negative statements listed in Box V.

*¶ 18.01 Lacks Novelty*

Claim [1] novelty under PCT Article 33(2) as being anticipated by [2].

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of prior art relied upon.

*¶ 18.02 Lacks Inventive Step - One Reference*

Claim [1] an inventive step under PCT Article 33(3) as being obvious over [2]. [3]

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of prior art relied upon.
3. In bracket 3, add reasoning.

*¶ 18.02.01 Lacks Inventive Step - Two References*

Claim [1] an inventive step under PCT Article 33(3) as being obvious over [2] in view of [3]. [4]

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of PRIMARY prior art relied upon.
3. In bracket 3, insert name of SECONDARY prior art relied upon.
4. In bracket 4, add reasoning.

*¶ 18.02.02 Lacks Inventive Step - Additional Reference*

Claim [1] an inventive step under PCT Article 33(3) as being obvious over the prior art as applied in the immediately preceding paragraph and further in view of [2]. [3]

**Examiner Note:**

1. This form paragraph may follow either 18.02 or 18.02.01.
2. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
3. In bracket 2, insert name of additional prior art relied upon.
4. In bracket 3, add reasoning.

*¶ 18.03 Lacks Industrial Applicability*

Claim [1] industrial applicability as defined by PCT Article 33(4). [2]

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, add reasoning.

Examiners are encouraged to indicate any amendments which applicant could present which would avoid a negative statement in the international preliminary examination report in the event that applicant chooses to file a demand.

**BOX NO. VI. — CERTAIN DOCUMENTS CITED**

Since all documents cited at the time of establishment of the written opinion will be listed on the simultaneously established search report, there is no need to also list them on the written opinion, and as such this item should be left blank.

**BOX NO. VII. — CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION**

In Box VII of Form PCT/ISA/237, defects in the form and content of the international application are identified.

Examples of defects that would be listed in Box VII are:

(A) Informalities such as misplaced and/or omitted drawing numerals, misspelled words, grammatical errors, etc.

(B) Improper multiple-dependent claims (PCT Rule 6.4) if not indicated under Box III.

The following form paragraphs are used in Box VII of PCT/ISA/237, "Certain defects in the international application," for noting technical defects.

*¶ 18.08 Drawing Objections - Defects*

The drawings are objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or content thereof: [1]

**Examiner Note:**

In bracket 1, insert identification of defects in drawings.

*¶ 18.08.01 Drawing Is Required*

The subject matter of this application admits of illustration by drawing to facilitate understanding of the invention. Applicant is required under PCT Article 7(1) to furnish a drawing.

*¶ 18.09 Description Defective*

The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof: [1]

**Examiner Note:**

In bracket 1, insert the technical problem, e.g., misspelled word.

*¶ 18.10 Claims Defective*

Claim [1] objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or contents thereof: [2]

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, identify the technical deficiency.

**BOX NO. VIII. — CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION**

In Box VIII, the examiner notifies the applicant of observations made as to the clarity of the claims, the description, the drawings, or on the question whether the claims are fully supported by the description.

If the claims, the description, or the drawings are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the question of novelty, inventive step (nonobviousness) or industrial applicability, the appli-

cant is so informed in Box III. See PCT Article 34(4)(a)(ii). Reasons for the examiner's opinion that the claims, description and drawings, etc., lack clarity must also be provided.

If the above situation is found to exist in certain claims only, the provisions of PCT Article 34(4)(a)(ii) shall apply to those claims only.

If the lack of clarity of the claims, the description, or the drawings is of such a nature that it is possible to form a meaningful opinion on the claimed subject matter, then it is required that the examiner consider the claims and render a written opinion on novelty, inventive step, and industrial applicability in Box V.

Since the claims of an international application are not subject to a rejection on either art or indefiniteness consistent with U.S. practice, observations by the examiner with regard to clarity of the claims, the description and the drawings will be treated in the form of an objection in the written opinion in Box VIII.

The following form paragraphs may be used in Box VIII, "Certain observations on the international application," of Form PCT/ISA/237 for noting objections which are substantive rather than merely technical in nature.

*¶ 18.11 Drawing Objections - Lack Clarity*

The drawings are objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 7 because: [1]

**Examiner Note:**

In bracket 1, insert reasons why the drawings lack clarity, e.g., inaccurate showing.

*¶ 18.12.01 Claims Objectionable - Inadequate Written Description*

Claim [1] objected to as lacking clarity under PCT Rule 66.2(a)(v) because the claim [2] not fully supported by the description. The application, as originally filed, did not describe: [3]

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --is-- or --are--, as appropriate.
2. In bracket 2, pluralize "claim" if needed, and insert the verb --is-- or --are--.
3. In bracket 3, identify subject matter not described in the application as filed.

*¶ 18.13.01 Claims Objectionable - Non-Enabling Disclosure*

Claim [1] objected to as lacking clarity under PCT Rule 66.2(a)(v) because the claim [2] not fully supported by the description. The description does not disclose the claimed inven-

tion in a manner sufficiently clear and complete for the claimed invention to be carried out by a person skilled in the art because: [3]

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, pluralize “claim” if needed, insert the verb --is-- or --are--.
3. In bracket 3, identify the claimed subject matter that is not enabled and explain why it is not enabled.

*¶ 18.14.01 Claims Objectionable - Lack of Best Mode*

Claim [1] objected to under PCT Rule 66.2(a)(v) because the claim [2] not fully supported by the description. The description fails to set forth the best mode contemplated by the applicant for carrying out the claimed invention as required by PCT Rule 5.1(a)(v) because: [3].

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, pluralize “claim” if needed, and insert the appropriate verb --is-- or --are--.
3. In bracket 3, insert the objection and reasons.

*¶ 18.15 Claims Objectionable - Indefiniteness*

Claim [1] objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because claim [2] indefinite for the following reason(s): [3]

**Examiner Note:**

1. In brackets 1 and 2, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 3, insert reasons.

**TIME TO REPLY**

If, in response to the written opinion of the International Searching Authority (Form PCT/ISA/237), applicant wishes to file a demand and amendments and/or arguments, the time period for response is 3 months from the mailing of the international search report and the written opinion or before the expiration of 22 months from the priority date, whichever expires later.

**AUTHORIZED OFFICER**

Pursuant to PCT Rules 43<sup>bis</sup>.1 and 70.14, the written opinion of the International Searching Authority must indicate the name of the officer of the International Searching Authority responsible for the written opinion, i.e., the “authorized officer.” An “authorized officer” is the person who actually performed the search work and prepared the search report and the written opinion, or another person who was responsible for supervising the search and the establishment of the written opinion. See Administrative Instructions Section 514. Thus, an examiner need not have signatory authority in order to be named as an authorized officer on the written opinion. However, the “file copy” of the written opinion must be signed by an examiner having at least partial signatory authority.



PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:  
John J. Smith  
220 Jefferson Davis Highway  
Arlington, VA 22202-0234

**PCT**

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Applicant's or agent's file reference		Date of mailing (day/month/year) <b>06 APR 2004</b>
CMC-123-PCT		<b>FOR FURTHER ACTION</b> See paragraph 2 below
International application No.	International filing date (day/month/year)	Priority date (day/month/year)
PCT/US04/00150	05 January 2004 (05.01.2004)	06 January 2003 (06.01.2003)
International Patent Classification (IPC) or both national classification and IPC		
IPC(7): B25C 5/06 and US Cl.: 227/8		
Applicant		
ACME FASTENER CORPORATION		

1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703)305-3230	Authorized officer Paul A. Bell  Telephone No. 703-308-3543
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Form PCT/ISA/237 (cover sheet) (January 2004)

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US04/00150

**Box No. I    Basis of this opinion**

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. **type of material**

- a sequence listing  
 table(s) related to the sequence listing

b. **format of material**

- in written format  
 in computer readable form

c. **time of filing/furnishing**

- contained in the international application as filed.  
 filed together with the international application in computer readable form.  
 furnished subsequently to this Authority for the purposes of search.

3.  In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. **Additional comments:**

Form PCT/ISA/237 (Box No. I) (January 2004)

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITYInternational application No.  
PCT/US04/00150

## Box No. IV Lack of unity of invention

1.  In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has:
- paid additional fees
  - paid additional fees under protest
  - not paid additional fees
2.  This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
- complied with
  - not complied with for the following reasons:  
See the lack of unity section of the International Search Report (Form PCT/ISA/210)
4. Consequently, this opinion has been established in respect of the following parts of the international application:
- all parts
  - the parts relating to claims Nos. \_\_\_\_\_

Form PCT/ISA/237 (Box No. IV) (January 2004)

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US04/00150

**Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**I. Statement**

Novelty (N)	Claims <u>3 - 20</u>	YES
	Claims <u>1 and 2</u>	NO
Inventive Step (IS)	Claims <u>4 and 16 - 20</u>	YES
	Claims <u>1 - 3 and 5 - 15</u>	NO
Industrial Applicability (IA)	Claims <u>1 - 20</u>	YES
	Claims <u>NONE</u>	NO

**2. Citations and explanations**

See the Supplemental Box

Form PCT/ISA/237 (Box No. V) (January 2004)

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/US04/00150

**Box No. VII Certain defects in the international application**

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

The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof: It is noted that the word "stpales" at line 15 of page 9 is misspelled .

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/US04/00150

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.  
Continuation of:

2. CITATIONS AND EXPLANATIONS

Claims 1 and 2 lack novelty under PCT Article 33(2) as being anticipated by Novak et al. Novak et al. teaches the claimed electromagnetic fastener tool 10 with a housing 12 having a fastener magazine assembly 18 mounted thereon with the magazine assembly having a fastener output channel. The magazine assembly 18 is pivoted between a first position wherein the tool can not be actuated and a second position wherein a fastener may be driven from the tool (note figure 3 and column 1, line 65 through column 2, line 5). The magazine assembly 18 is moved from the first position to the second position by placing the fastener output channel firmly against a work piece. As shown in figure 3 and described at column 4, lines 6 - 49, the magazine assembly 18 and the trigger button 24 are coupled by a safety mechanism 62. This safety mechanism has a sliding rod 64 with the lower end of the rod 64 being attached to the top of channel 48 of the magazine assembly such that rod 64 moves with the magazine assembly. When the magazine assembly 18 is placed on a work piece, it rotates into the second position and pushes rod 64 upward. The upper portion of rod 64 has a spring 74 which includes a cam surface 76, a curved surface 78 and a bottom edge 81. Bottom edge 81 of spring 74 is normally positioned adjacent flange 86 of trigger button 24 and blocks upward movement of the trigger button. Thus, the trigger button may not be depressed (moved upwards) to fire the tool until the bottom edge of spring 74 is moved away from flange 86. This is accomplished by the interaction of curved surface 78 of spring 74 with a corresponding curved surface 82 fixed to the housing 12. When rod 64 moves upward, spring 74 is bent away from trigger button 24 by the interaction of curved surfaces 78 and 82. Thus, placing the fastener output channel of the magazine assembly 18 against a work piece moves bottom edge 81 of spring 74 out of its blocking position adjacent flange 86 of trigger button 24 and permits the tool to be fired.

Claims 3 and 5 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. in view of Barrett et al. Novak et al. does not teach the claimed mechanical means for blocking the feeding of a fastener from the magazine while the magazine assembly is in the second position (pressed against the work piece). Barrett et al. teaches such a blocking means. Note figures 5 - 7 and column 6, lines 34 - column 7, line 7. The Barrett et al. blocking means is interconnected with the trigger switch 40 such that when the trigger is depressed to fire the tool and drive a fastener from the magazine output channel, a clamp 48 is depressed onto the top of the second fastener in the fastener stick in magazine 42. Forward movement of the second fastener into the magazine output channel is thus prevented as long as trigger switch 40 remains depressed. When the trigger switch is released, clamp 48 moves away from the fastener stick and a fastener can be fed into the magazine output channel. Since the provision of such a blocking means is known as a desirable feature for solenoid actuated fastener driving tools because they are notorious for needing multiple strokes of the driver to properly drive a fastener, it would have been obvious to one of ordinary skill in this art to provide such a blocking means in the Novak et al. solenoid actuated tool. Note the teaching in Barrett et al. from column 2, line 40 through column 5, line 10 regarding the need for multiple driving strokes.

Claims 6 - 10 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. in view of Barrett et al. Novak et al. does not teach the claimed electronic control means to provide multiple blows from the driver to a single fastener. Barrett et al. discloses a control means which provides for multiple blows by the driver 32 on the fastener for each actuation of the trigger. Barrett et al. teaches at column 1, lines 40 - 49 that it is advantageous to operate solenoid actuated fastener drivers in this manner because such tools may require two or more blows from the driver to properly drive the fastener an adequate depth into the work piece. In view of this known teaching, it would have been obvious to one of ordinary skill in this art to provide the Novak et al. tool with the claimed control means to provide a predetermined plurality of driving strokes to a single fastener.

Claims 11 - 15 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. in view of D'Haem et al. Novak et al. does not teach the provision of an anti-jam means to clear jammed fasteners from the fastener output channel. The claims call for the fastener output channel to be formed with a removable cover plate to permit clearing the tool in the event of a fastener jam. D'Haem teaches that it is well-known in this art that fastener jams are a problem and that some means is desirable to clear them. D'Haem teaches the use of a removable cover plate to allow clearing the tool as claimed (see column 4, line 76 - column 5, line 23). In view of this teaching, it would have been obvious to one of ordinary skill in this art to provide the claimed anti-jam feature in the Novak et al. tool.

Claims 4 and 16 - 20 meet the criteria set out in PCT Article 33(2) - (3) because the prior art does not teach or fairly suggest the claimed means to hold the fastener magazine in the second position as claimed in claim 4.

Claims 1 - 20 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

&gt;

**1845.02 Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or the Declaration (Form PCT/ISA/220) [R-2]**

The examiner completes the Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or Declaration (Form PCT/ISA/220) upon completion of the International Search Report (Form PCT/ISA/210) or the Declaration of Non-Establishment of the International Search Report (Form PCT/ISA/203) and, for applications filed on or after January 1, 2004, completion of the Written Opinion of the International Searching Authority (Form PCT/ISA/237). The Form PCT/ISA/220 serves as a cover letter for the PCT/ISA/210 or PCT/ISA/203 and for the PCT/ISA/237.

When processing an application having an international filing date filed prior to January 1, 2004, the examiner should make sure the Form PCT/ISA/220 being issued is the version of the form dated April 2002 and entitled "Notification of Transmittal of the International Search Report or the Declaration."

**ADDRESS FOR CORRESPONDENCE**

The address for correspondence is taken from the request (Form PCT/ISA/101). When an agent represents the applicant, the address for correspondence is listed in Box No. IV of the PCT request Form. For applicants processing their own applications, the address for correspondence may be listed in Box No. II of the request Form. However, where PALM or the correspondence on file shows any changes in the applicant or address for correspondence effected under PCT Rule 92<sup>bis</sup>, the later address is used.

**APPLICANT**

When there is more than one applicant in respect of the international application, only the first mentioned of these on the request Form is indicated in the international search report. Other applicants, if any, are indicated by the words "et al" following the first applicant's name. The first mentioned applicant is indicated in Box No. II of the request Form, a second applicant is listed in Box No. III; further applicants are listed on the continuation sheet if there are more than two applicants. Company names are written in capital letters; for personal names the family name is given first in capital letters and the given names are in mixed case. This helps to identify the family name.

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL SEARCH REPORT AND  
THE WRITTEN OPINION OF THE INTERNATIONAL  
SEARCHING AUTHORITY, OR THE DECLARATION

(PCT Rule 44.1)

<p>To:</p> <p>John J. Smith 220 Jefferson Davis Highway Arlington, Virginia 22202-0234</p>	<p>Date of mailing (day/month/year) <b>06 APR 2004</b></p>
<p>Applicant's or agent's file reference CMC-123-PCT</p>	<p><b>FOR FURTHER ACTION</b> See paragraphs 1 and 4 below</p>
<p>International application No. PCT/US04/00150</p>	<p>International filing date (day/month/year) 05 January 2004 (05.01.2004)</p>
<p>Applicant ACME FASTENER CORPORATION</p>	

1.  The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.

**Filing of amendments and statement under Article 19:**  
The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

**When?** The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

**Where?** Directly to the International Bureau of WIPO, 34 chemin des Colombettes  
1211 Geneva 20, Switzerland, Facsimile No.: +41 22 740 14 35

**For more detailed instructions,** see the notes on the accompanying sheet.

2.  The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.

3.  **With regard to the protest against payment of (an) additional fee(s) under Rule 40.2,** the applicant is notified that:

the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Reminders**  
Shortly after the expiration of **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

The applicant may submit comments on an informal basis on the written opinion of the International Searching Authority to the International Bureau. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.

Within **19 months** from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until **30 months** from the priority date (in some Offices even later); otherwise, the applicant must, within **20 months** from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of **30 months** (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

<p>Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230</p>	<p>Authorized officer Paul A. Bell Telephone No. 703-308-3543</p>
--	---

Form PCT/ISA/220 (January 2004)

(See notes on accompanying sheet)



### NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

### INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report and the written opinion of the International Searching Authority, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only (see *PCT Applicant's Guide*, Volume I/A, Annexes B1 and B2).

The attention of the applicant is drawn to the fact that amendments to the claims under Article 19 are not allowed where the International Searching Authority has declared, under Article 17(2), that no international search report would be established (see *PCT Applicant's Guide*, Volume I/A, paragraph 296).

#### What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

**When ?** Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

#### Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

**How ?** 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.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Section 205(b)).

**The amendments must be made in the language in which the international application is to be published.**

#### What documents must/may accompany the amendments ?

##### Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

**The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.**

**NOTES TO FORM PCT/ISA/220 (continued)**

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, 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.

**The following examples illustrate the manner in which amendments must be explained in the accompanying letter:**

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:  
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:  
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:  
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or  
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:  
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

**"Statement under Article 19(1)" (Rule 46.4)**

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

**It must be in the language in which the international application is to be published.**

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

**Consequence if a demand for international preliminary examination has already been filed**

If, at the time of filing any amendments and any accompanying statement, under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the time of filing the amendments (and any statement) with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments (and of any statement) and, where required, a translation of such amendments for the procedure before that Authority (see Rules 55.3(a) and 62.2, first sentence). For further information, see the Notes to the demand form (PCT/IPEA/401).

If a demand for international preliminary examination is made, the written opinion of the International Searching Authority will, except in certain cases where the International Preliminary Examining Authority did not act as International Searching Authority and where it has notified the International Bureau under Rule 66.1*bis*(b), be considered to be a written opinion of the International Preliminary Examining Authority. If a demand is made, the applicant may submit to the International Preliminary Examining Authority a reply to the written opinion together, where appropriate, with amendments before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later (Rule 43*bis*.1(c)).

**Consequence with regard to translation of the international application for entry into the national phase**

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see the *PCT Applicant's Guide*, Volume II.

## 1846 Sections of the Articles, Regulations, and Administrative Instructions Under the PCT Relevant to the International Searching Authority [R-2]

PCT Articles 15 - 20 (Appendix T);  
PCT Rules 33 - 47 (Appendix T); and  
Administrative Instructions Sections 501 - 518  
(Appendix AI).

## 1847 Refund of International Search Fee [R-2]

*37 CFR 1.446. Refund of international application filing and processing fees.*

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or treaty and its regulations, may be refunded. A mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested and will not notify the payor of such amounts. If the payor or party requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer, the Office may use the banking information provided on the payment instrument to make any refund by electronic funds transfer.

(b) Any request for refund under paragraph (a) of this section must be filed within two years from the date the fee was paid. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization under § 1.25(b), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

\*\*>

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Director or the Director's designee acting under PCT Rule 40.2(c).<

(d) The international and search fees will be refunded if no international filing date is accorded or if the application is withdrawn before transmittal of the record copy to the International Bureau (PCT Rules 15.6 and 16.2). The search fee will be refunded if the application is withdrawn before transmittal of the search copy to the International Searching Authority. The transmittal fee will not be refunded.

(e) The handling fee (§ 1.482(b)) will be refunded (PCT Rule 57.6) only if:

(1) The Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau, or

(2) The Demand is considered not to have been submitted (PCT Rule 54.4(a)).

Although 37 CFR 1.446(a) indicates that a "mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee," 37 CFR 1.446(d) and (e) contain exceptions to this general statement.

According to 37 CFR 1.446(d), the search fee will be refunded if no international filing date is accorded or if the application is withdrawn before the search copy is transmitted to the International Searching Authority. The transmittal fee will not be refunded.

According to 37 CFR 1.446(e), the handling fee will be refunded if the Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau.

Refund of the supplemental search fee will be made if the applicant is successful in a protest (filed pursuant to 37 CFR 1.477) to a holding of lack of unity of invention. The supplemental search fee must be paid and be accompanied by (1) a protest and (2) a request for refund of the supplemental search fee.

Any request for refund of the search fee made after the search copy has been transmitted to the International Searching Authority must be directed to the International Searching Authority and not to the Receiving Office. This is clearly necessary where applicant has chosen the European Patent Office as the International Searching Authority.

## 1848 Sequence Listings and Tables Related to Sequence Listings [R-2]

*PCT Rule 13<sup>ter</sup>.*

*Nucleotide and/or Amino Acid Sequence Listings*

*13<sup>ter</sup>.1. Sequence Listing for International Authorities*

(a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:

(i) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing complying with that standard;

(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.

(b) *[Deleted]*

(c) If the applicant does not comply with an invitation under paragraph (a) within the time limit fixed in the invitation, the International Searching Authority shall not be required to search the international application to the extent that such noncompliance has the result that a meaningful search cannot be carried out.

(d) Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to file the required correction. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

(e) Paragraphs (a) and (c) shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

(f) Any sequence listing not contained in the international application as filed shall not, subject to Article 34, form part of the international application.

*PCT Administrative Instruction Section 513.*  
*Sequence Listings*

(a) Where the International Searching Authority receives a correction of a defect under Rule 13<sup>ter</sup>.1(d), 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 13<sup>ter</sup>.1(d))" or their equivalent in the language of publication of the international application;

(iii) indelibly mark on the letter containing the correction, 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, when the correction 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 search report is based on a sequence listing that was not contained in the international application as filed but was furnished subsequently to the International Searching 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 of any sequence listing in printed form which was not contained in the international application as filed but was furnished subsequently to that Authority, the words "SUBSEQUENTLY FURNISHED SEQUENCE LISTING" or their equivalent in the language of publication of the international application.

(e) The International Searching Authority shall keep in its files:

(i) any sequence listing in printed form which was not contained in the international application as filed but was furnished subsequently to that Authority; and

(ii) any sequence listing in computer readable form.

Where an international application contains disclosure of a nucleotide and/or amino acid sequence, the description must contain a listing of the sequence complying with the standard specified in Annex C of the Administrative Instructions. See MPEP § 1823.02. If the International Searching Authority finds that an international application contains such a disclosure but that the description does not include such a listing or that the listing included does not comply with that standard, the International Searching Authority may invite the applicant to furnish a listing complying with that standard.

If the International Searching Authority finds that a sequence listing is not in a computer readable form provided for in the Administrative Instructions, it may invite the applicant to furnish a listing to it in such a form.

An invitation from the International Searching Authority to furnish a sequence listing complying with the standard specified in the Administrative Instructions, will specify a time limit for complying with the invitation. Any sequence listing furnished by the applicant in response to the invitation must 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. If the applicant does not comply within that time limit, the search undertaken by the International Searching Authority may be restricted.

If the applicant wishes to include such a listing in the text of the description itself, appropriate amendments may be made later under PCT Article 34, provided that the applicant files a Demand for international preliminary examination.

The United States Receiving Office has not notified the International Bureau under Administrative Instructions Section 801(b) that it is prepared to accept the filing in computer readable form (CRF) of the sequence listing and/or any *\*>tables<* related to the sequence listing of international applications under Administrative Instructions Section 801(a). However, Administrative Instructions Section 801(c) permits a receiving Office that has not notified the IB

under Administrative Instructions Section 801(b) to decide in a particular case to accept such sequence listing filings. The RO/US will accept applications where the sequence listing and/or table is filed using CD-R or CD-ROM as the electronic medium, and where no paper copy of the sequence listing part is submitted. The application must be filed in accordance with the Guidelines set forth in MPEP § 1823.02, subsection II. A in order to be accepted. There may be a significant cost savings if such a submission is accepted. If accepted under the USPTO's Guidelines, the electronic submission counts as 400 sheets in addition to the actual number of sheets of the Request, description excluding the sequence listing part thereof, claims, abstract and drawings. Four copies of the electronic submission of the sequence listing are required. One copy goes to the IB as part of the Record copy; the second copy becomes part of the Home copy; the third copy becomes part of the Search copy; and the fourth copy goes to the Scientific and Technical Information Center (STIC) as the CRF. Three copies of the electronic submission of any table related to the sequence listing are required. One copy goes to the IB as part of the record copy; the second copy becomes part of the home copy; the third copy becomes part of the search copy. See MPEP § 1823.02.

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## 1850 Unity of Invention Before the International Searching Authority [R-2]

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### *PCT Rule 13. Unity of Invention*

#### *13.1. Requirement*

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

#### *13.2. Circumstances in Which the Requirement of Unity of Invention Is To Be Considered Fulfilled*

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

#### *13.3. Determination of Unity of Invention Not Affected Manner of Claiming*

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

#### *13.4. Dependent Claims*

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

#### *13.5. Utility Models*

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 13.1 to 13.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.<

### *PCT Rule 40.*

#### *Lack of Unity of Invention (International Search)*

#### *40.1. Invitation to Pay*

The invitation to pay additional fees provided for in Article 17(3)(a) shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention and shall indicate the amount to be paid.

#### *40.2. Additional Fees*

(a) The amount of the additional fee due for searching under Article 17(3)(a) shall be determined by the competent International Searching Authority.

(b) The additional fee due for searching under Article 17(3)(a) shall be payable direct to the International Searching Authority.

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protest shall be examined by a three-member board or other special instance of the International Searching Authority or any competent higher authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

(d) The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person who made the decision which is the subject of the protest.

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three-member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.

#### 40.3. Time Limit

The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant’s address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.

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#### 37 CFR 1.475. Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

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#### THE REQUIREMENT FOR “UNITY OF INVENTION”

Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (PCT Article 3(4)(iii) and 17(3)(a), PCT Rule 3.1, and 37 CFR 1.475). Observance of this requirement is checked by the International Searching Authority and may be relevant in the national (or regional) phase.

The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of 37 CFR 1.141(b)(2) as applied to unity of invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression “specifically designed” as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change was made in restric-

tion practice in United States national applications filed under 35 U.S.C. 111 outside the PCT.

In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.

PCT Rule 13.2, as it was modified effective July 1, 1992, no longer specifies the combinations of categories of invention which are considered to have unity of invention. Those categories, which now appear as a part of **\*\*>**Chapter 10 of the International Search and Preliminary Examination Guidelines, may be obtained from WIPO's website ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm)). The categories of invention in former PCT Rule 13.2 have been replaced< with a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined 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 based on the contents of the claims as interpreted in light of the description and drawings. **\*\*>**Chapter 10 of the International Search and Preliminary Examination Guidelines< also contains examples concerning unity of invention.

**\*\*>**

## **DETERMINATION OF "UNITY OF INVENTION"**

An international application should relate to only one invention or, if there is more than one invention, 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 (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical rela-

tionship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in PCT 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).

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

Lack of unity of invention may be directly evident "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then

clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant.

From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. However, the International Searching Authority or the International Preliminary Examining Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the international search to certain classification groups.<

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 \*->one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (PCT Rule 6.4). The examiner should bear in mind that a claim may also contain a reference to another claim even if it is not a dependent claim as defined in PCT Rule 6.4. One example of this is a claim referring to a claim of a different category (for example, “Apparatus for carrying out the process of Claim 1 ...,” or “Process for the manufacture of the product of Claim 1 ...”). Similarly, a claim to one part referring to another cooperating part, for example, “plug for cooperation with the socket of Claim 1 ...”) is not a dependent claim.<

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. >For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner such that it avoids the prior art, while claim 2 is for a “turbine rotor blade as claimed in claim 1” and produced from alloy Z. Then no objection under PCT

Rule 13 arises either because alloy Z was new and its composition was not obvious and thus the alloy itself already contains the essential features of an independent possibly later patentable invention, or because, although alloy Z was not new, its application in respect of turbine rotor blades was not obvious, and thus represents an independent invention in conjunction with turbine rotor blades. As another example, suppose that the main claim defines a process avoiding the prior art for the preparation of a product A starting from a product B and the second claim reads: “Process according to claim 1 characterized by producing B by a reaction using the product C.” In this case, too, no objection arises under PCT Rule 13, whether or not the process for preparation of B from C is novel and inventive, since claim 2 contains all the features of claim 1.< Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art>, provided the genus claim is directed only to alternatives of a similar nature and the species falls entirely within the genus. To determine if a genus claim is directed only to alternatives “of a similar nature,” see subsection “B. Markush Practice” under “ILLUSTRATIONS OF PARTICULAR SITUATIONS” below.< 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.

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.

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.

>Alternative forms of an invention may be claimed either in a plurality of independent claims, or in a sin-



gle claim. In the latter case, the presence of the independent alternatives may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether there is unity of invention. Accordingly, lack of unity of invention may exist within a single claim. Where the claim contains distinct embodiments that are not linked by a single general inventive concept, the objection as to lack of unity of invention should be raised. PCT Rule 13.3 does not prevent an Authority 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.

Objection of lack of unity of invention does not normally arise if the combination of a number of individual elements is claimed in a single claim (as opposed to distinct embodiments as discussed in the paragraph immediately above), even if these elements seem unrelated when considered individually.<

#### **\*ILLUSTRATIONS OF PARTICULAR SITUATIONS**

There are three particular situations for which the method for determining unity of invention contained in PCT Rule 13.2 is explained in greater detail:

(A) Combinations of different categories of claims;

(B) So-called “Markush practice”; and

(C) Intermediate and final products.

Principles for the interpretation of the method contained in PCT 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 PCT Rule 13.2.

Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out \*>in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO’s web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm))<.

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#### **A. < Combinations of Different Categories of Claims**

The method for determining unity of invention under PCT 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:

(A) 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

(B) 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

(C) 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 \*\*>.

A< process is specially adapted for the manufacture of a product if it inherently results in the product and \* 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.

>More extensive combinations than those set forth above should be looked at carefully to ensure that the requirements of both PCT Rule 13 (unity of invention) and PCT Article 6 (conciseness of claims) are satisfied. In particular, while a single set of independent claims according to one of (A), (B), or (C) above is always permissible, it does not require the International Authority to accept a plurality of such sets which could arise by combining the provisions of PCT Rule 13.3 (which provides that the determination of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim), with the provisions set out above (thus resulting in a set based on each of a number of independent claims in the same category under PCT Rule 13.3). The proliferation of claims arising from a combined effect of this kind should be accepted only exceptionally. For example, independent claims are permissible for two related articles such as a transmitter and receiver; however, it does not follow that an applicant may include also, in the one international application, four additional independent claims: two for a process for the manufacture of the transmitter and the receiver, respectively, and two for use of the transmitter and receiver, respectively.

A single general inventive concept must link the claims in the various categories and in this connection the wording above should be carefully noted. The link between product and process in (A) is that the process must be “specially adapted for the manufacture of” the product. Similarly, in (B), the apparatus or means claimed must be “specifically designed for” carrying out the process. Likewise, in (C), the process must be “specially adapted for the manufacture of” the product and the apparatus must be “specifically designed for” carrying out the process. In combinations (A) and (C), the emphasis is on, and the essence of the invention should primarily reside in, the product, whereas in combination (B) the emphasis is on, and the invention should primarily reside in, the process. (See Examples in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO’s web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm)))<

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### **B. < “Markush Practice”**

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

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.

In paragraph (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>, and the common structure is essential to the common property or activity<. The structural element may be a single component or a combination of individual components linked together.

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

The fact that the alternatives of a Markush grouping can be differently classified \*>should< not, taken

alone, be considered to be justification for a finding of a lack of unity of invention.

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 should be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised. (See Examples in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO's web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm))).

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### C. *Intermediate and Final Products*

The situation involving intermediate and final products is also governed by PCT Rule 13.2.

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.

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.

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 must 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.

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.

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.

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.

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.

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. (See Examples in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO's web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm))).

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### SEARCH OF ADDITIONAL INVENTIONS WITHOUT PAYMENT OF FEES

If little or no additional search effort is required, reasons of economy may make it advisable for the examiner, while making the search for the main invention, to search at the same time, despite the non-payment of additional fees, one or more additional inventions in the classification units consulted for the main invention. The international search for such additional inventions will then have to be completed in any further classification units which may be rele-

vant, when the additional search fees have been paid. This situation may occur when the lack of unity of invention is found either “*a priori*” or “*a posteriori*.”

When the examiner finds lack of unity of invention, normally, the applicant is invited to pay fees for the search of additional inventions. In exceptional circumstances, however, the examiner may be able to establish both an international search (and for international applications having a filing date on or after January 1, 2004, a written opinion) covering more than one invention with negligible additional work, in particular, when the inventions are conceptually very close. In those cases, the examiner may decide to complete the international search (and where applicable, the written opinion of the International Searching Authority) for the additional invention(s) together with that for the invention first mentioned. For international applications having a filing date on or after January 1, 2004, in considering the amount of work involved, the examiner should take into account the time needed to create the written opinion as well as that needed to perform the search, since even when the additional work with regard to the search is negligible, the opposite may be the case for the written opinion of the International Searching Authority and therefore justify requesting the additional fees. If it is considered that the total additional work does not justify requesting additional fees, all results are included in the international search report without inviting the applicant to pay an additional search fee in respect of the additional inventions searched but stating the finding of lack of unity of invention.

#### **INVITATION TO PAY ADDITIONAL FEES<**

The search fee which the applicant is required to pay is intended to compensate the International Searching Authority for carrying out an international search \*\*>(and for international applications having a filing date on or after January 1, 2004, for preparing a written opinion)<, but only where the international application meets the “requirement of unity of invention”. That means that the international application must relate to only one invention or must relate to a group of inventions which are so linked as to form a single general inventive concept (PCT Articles 3(4)(iii) and 17(3)(a)>.<

If the International Searching Authority finds that the international application does not comply with the

requirement of unity of invention, the applicant will be \*\*>informed of the lack of unity of invention by a communication preceding the issuance of the international search report (and for international applications having a filing date on or after January 1, 2004, a written opinion of the International Searching Authority), which contains an invitation to pay additional search fees. (Form PCT/ISA/206 or USPTO/299 (telephone practice), see below). This invitation specifies the reasons the international application is not considered to comply with the requirement of unity of invention, identifies the separate inventions, and indicates the number of additional search fees and the amount to be paid (PCT Rules 40.1, 40.2(a) and (b)). The International Searching Authority cannot consider the application withdrawn for lack of unity of invention, nor invite the applicant to amend the claims, but informs the applicant that, if the international search report is to be drawn up in respect of those inventions present other than the first mentioned, then the additional fees must be paid within a stipulated period.< Such additional fees are payable directly to the International Searching Authority which is conducting the search, either the United States Patent and Trademark Office or European Patent Office, within the time limit fixed, which must not be shorter than 15 days, if the applicant’s address is in the same country as the International Searching Authority; or 30 days, if applicant’s address is in a country different than the country of the International Searching Authority; and not longer than 45 days from the date of the invitation (PCT Rule 40.3). The search fee amounts for the U.S. and the European Patent Office are found in each weekly edition of the *Official Gazette*.

\*\*>In the invitation to pay additional fees, the International Searching Authority should set out a logically presented, technical reasoning containing the basic considerations behind the finding of lack of unity (PCT Rule 40.1 ).

Since these payments must take place within a period to be set by the International Searching Authority so as to enable the observation of the time limit for establishing the international search report set by PCT Rule 42, the International Searching Authority should endeavor to ensure that international searches be made as early as possible after the receipt of the search copy. The International Searching

Authority finally draws up the international search report (and for international applications having a filing date on or after January 1, 2004, the written opinion of the International Searching Authority)< on those parts of international application which relate to the “main invention,” that is, the invention or the group of inventions so linked as to form a single general inventive concept first mentioned in the claims (PCT Article 17(3)(a)). Moreover, the international search report >(and for international applications having a filing date on or after January 1, 2004, the written opinion of the International Searching Authority)< will be established also on those parts of the international application which relate to any invention (or any group of inventions so linked as to form a single general inventive concept) in respect of which the applicant has paid any additional fee within the prescribed time limits.

\*\*

Where, within the prescribed time limit, the applicant does not pay any additional fees or only pays some of the additional fees indicated, certain parts of the international application will consequently not be searched. The lack of an international search report in respect of such parts of the international application will, in itself, have no influence on the validity of the international application and processing of the international application will continue, both in the international and in the national (regional) phases. The unsearched claims, upon entry into the national stage, will be considered by the examiner and may be the subject of a holding of lack of unity of invention.

\*\*>

#### **PREPARATION OF THE INVITATION TO PAY ADDITIONAL FEES**

Form PCT/ISA/206 is used to invite the applicant to pay additional search fees. In the space provided on form PCT/ISA/206, the examiner should indicate the number of inventions claimed in the international application covering which particular claims and explain why the international application is not considered to comply with the requirements of unity of invention. The examiner should then indicate the total amount of additional fees required for the search of all claimed inventions.

In the box provided at the top of the form, the time limit for response is set according to PCT Rule 40.3, which must not be shorter than 15 days, if the applicant’s address is in the same country as the International Searching Authority; or 30 days, if applicant’s address is in a country different than the country of the International Searching Authority; and not longer than 45 days from the date of the invitation. Extensions of time are not permitted.

Since the space provided on Form PCT/ISA/206 is limited, supplemental attachment sheets, supplied by the examiner, with reference back to the specific section, should be incorporated whenever necessary.<

#### **AUTHORIZED OFFICER**

Form PCT/IPEA/206 must be signed by an examiner with at least partial signatory authority.

#### **>TELEPHONIC UNITY PRACTICE**

Telephone practice may be used to allow applicants to pay additional fees if

(A) Applicant or applicant’s legal representative has a USPTO deposit account,

(B) Applicant or the legal representative orally agrees to charge the additional fees to the account, and

(C) A complete record of the telephone conversation is included with the international search report including:

- (1) Examiner’s name;
- (2) Authorizing attorney’s name;
- (3) Date of conversation;
- (4) Inventions for which additional fees paid;

and

(5) Deposit account number and amount to be charged.

When the telephone practice is used in making lack of unity requirements, it is critical that the examiner orally inform applicant that there is no right to protest the holding of lack of unity of invention for any group of invention(s) for which no additional search fee has been paid.

The examiner must further orally advise applicant that any protest to the holding of lack of unity or the amount of additional fee required must be filed in writing no later than 15 days from the mailing date of the international search report. The examiner should

fill in the information on Form USPTO/299 “Chapter I PCT Telephone Memorandum for Lack of Unity” as a record of the telephonic holding of lack of unity.

If the applicant or the legal representative or agent refuses to either restrict the claims to one invention or authorize payment of additional fees over the telephone, or if applicant does not have a deposit account, the examiner should send a written invitation using the Chapter I form, PCT/ISA/206.

If a written invitation is required, the examiner should, if possible, submit the written invitation to the TC for review and mailing within 7 days from the date the international application is charged to the examiner.

## FORM PARAGRAPHS FOR LACK OF UNITY IN INTERNATIONAL APPLICATIONS

### ¶ 18.05 *Heading for Lack of Unity Action (Not Involving Species)*

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In order for all inventions to be examined, the appropriate additional examination fees must be paid.

#### **Examiner Note:**

Begin all Lack of Unity actions with this heading.

### ¶ 18.06 *Lack of Unity - Three Groups of Claims*

Group [1], claim(s) [2], drawn to [3].

Group [4], claim(s) [5], drawn to [6].

Group [7], claim(s) [8], drawn to [9].

#### **Examiner Note:**

1. In brackets 1, 4 and 7, insert Roman numerals for each Group.
2. In brackets 2, 5 and 8, insert respective claim numbers.
3. In brackets 3, 6 and 9, insert respective names of grouped inventions.

### ¶ 18.06.01 *Lack of Unity - Two (or Additional) Groups of Claims*

Group [1], claim(s) [2], drawn to [3].

Group [4], claim(s) [5], drawn to [6].

#### **Examiner Note:**

This form paragraph may be used alone or following form paragraph 18.06.

### ¶ 18.06.02 *Lack of Unity - One Additional Group of Claims*

Group [1], claim [2], drawn to [3].

#### **Examiner Note:**

This form paragraph may be used following either form paragraph 18.06 or 18.06.01.

### ¶ 18.07 *Lack of Unity - Reasons Why Inventions Lack Unity*

The inventions listed as Groups [1] do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: [2]

#### **Examiner Note:**

1. In bracket 1, insert appropriate Roman numerals for Groups involved.
2. In bracket 2, insert reasoning.

### ¶ 18.16 *Lack of Unity - Species - Heading*

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In order for more than one species to be examined, the appropriate additional examination fees must be paid. The species are as follows:

[1]

#### **Examiner Note:**

In bracket 1, list each species by Fig. No. or embodiment.

### ¶ 18.17 *Lack of Unity - Species - Correspondence of the Claims to the Species*

The claims are deemed to correspond to the species listed above in the following manner:

[1]

The following claim(s) are generic: [2]

#### **Examiner Note:**

1. This form paragraph is to be used immediately following 18.16.
2. In bracket 1, for each species, list the claims, e.g., Fig.1 - claims 1, 3 and 6.
3. In bracket 2, identify each generic claim by number or insert the word --NONE--.

### ¶ 18.18 *Lack of Unity - Species - Reasons Why Unity Is Lacking*

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: [1]

#### **Examiner Note:**

1. This form paragraph is to be used immediately following form paragraph 18.17.
2. In bracket 1, insert reasoning.

## PROTEST PROCEDURE

*PCT Administrative Instruction 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.

*37 CFR 1.477. Protest to lack of unity of invention before the International Searching Authority.*

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international search report when forwarded to the Designated Offices may notify the International Searching Authority to that effect any time prior to the issuance of the international search report. Thereafter, such notification should be directed to the International Bureau (PCT Rule 40.2(c)).

The applicant may protest the allegation of lack of unity of invention or that the number of required additional fees is excessive and request a refund of the additional fee(s) paid. If, and to the extent that, the International Searching Authority finds the protest justified, the fee(s) are refunded (PCT Rule 40.2(c)). (The additional search fees must be paid for any protest to be considered.)

Protest of allegation of lack of unity is in the form of a reasoned statement accompanying payment of the additional fee, explaining why the applicant believes that the requirements of unity of invention are fulfilled and fully taking into account the reasons indicated in the invitation to pay additional fees issued by the International Searching Authority. Any such protest filed with the U.S. International Searching Authority will be decided by a Technology Center Director (MPEP § 1002.02(c) item (2)). To the extent

applicant's protest is found to be justified, total or partial reimbursement of the additional fee will be made. On the request of the applicant, the text of both the protest and the decision thereon is sent to the designated Offices together with the international search report (37 CFR 1.477(c)).

## NOTIFICATION OF DECISION ON PROTEST

Form PCT/ISA/212 is used by the Technology Center (TC) to inform the applicant of the decision regarding applicant's protest on the payment of additional fees concerning unity of invention. The TC checks the appropriate box, i.e., 1 or 2. If box 2 is checked, a clear and concise explanation as to why the protest concerning the unity of invention was found to be unjustified must be given. Since the space is limited, supplemental attachment sheet(s) should be incorporated whenever necessary.

## AUTHORIZED OFFICER

Form PCT/ISA/212 must be signed by a TC Director. See MPEP § 1002.02 (c), item (2).<

## UNITY OF INVENTION - NUCLEOTIDE SEQUENCES

Under 37 CFR 1.475 and 1.499 *et seq.*, when claims do not comply with the requirement of unity of invention, i.e., when the claimed subject matter does not involve "one or more of the same or corresponding special technical features," 37 CFR 1.475(a), an additional fee is required to maintain the claims in the same application. 37 CFR 1.476 (b).

The \*>USPTO< has decided *sua sponte* to partially waive 37 CFR 1.475 and 1.499 *et seq.* to permit applicants to claim up to ten (10) nucleotide sequences that do not have the same or corresponding special technical feature without the payment of an additional fee. The PCT permits inventions that lack unity of invention to be maintained in the same international application for payment of additional fees. Thus, in international applications, for each group for which applicant has paid additional international search and/or preliminary examination fees, the USPTO has determined that up to four (4) such additional sequences per group is a reasonable number for examination. Further, claims directed to the selected sequences will be examined with claims drawn to any sequence combinations which have a common techni-

cal feature with the selected sequences. Nucleotide sequences encoding the same protein are considered to satisfy the unity of invention standard and will continue to be examined together.

See MPEP § 803.04 for examples of nucleotide sequence claims impacted by this partial waiver of 37 CFR 1.475 and 1.499 *et seq.*

>Examples concerning Unity of Invention involving biotechnological inventions may be found in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the WIPO's web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm)).<

## 1851 Identification of Patent Documents [R-2]

The examiner, in completing the international search report as well as the \*\* written opinion and \*>international preliminary examination< report, is required to cite the references in accordance with the provisions of Administrative Instructions >Sections< 503 and 611 >and WIPO Standard ST.14<. These sections of the Administrative Instructions require reference citations to include, in addition to other information which is apparent from the forms which the examiner fills out, an indication of the two-letter country code of the country or entity issuing or publishing the document and the standard code for identifying the kind of patent document. The discussion which follows is limited to the identification of patent documents (and nonpatent publications) and a listing of the two-letter country codes for countries or other entities which issue or publish industrial property information.

The standard codes for identifying different kinds of patent documents are found in the "WIPO Handbook on Industrial Property Information and Documentation" - WIPO Standard ST.16 which is published by the World Intellectual Property Organization. The listing is extensive. The Special Program Examiners in each Technology Center (TC) have a complete copy of Standard ST.16. It is also accessible on WIPO's web site (<http://www.wipo.int/scit/en/>) under the heading "WIPO Standards and Other Documentation." Provided herein is an abbreviated version representing the countries and codes commonly used by the examiner in preparing search reports.

U.S. patents published before January 2, 2001, are Code A documents generally. Beginning with patents published on January 2, 2001, U.S. patents are Code B documents. Patent Application Publications, first published on March 15, 2001, are Code A documents. Reexamination certificates published before January 2, 2001, are Code B documents. Reexamination certificates published on or after January 2, 2001, are Code C documents. Tables providing a complete list of the kind codes of patents and other documents published by the USPTO are included in MPEP § 901.04(a). All nonpatent literature documents are Code N. Numerical designations are sometimes found on published documents along with the letter code designation. These should be used by the examiner only if such numerical designation is on the document. Numerical codes along with letter codes can be found, for example, on certain published patent documents such as the German Offenlegungsschrift and published international applications. If numerical designations are not provided, the examiner should use only the letter code designation.

The most commonly cited documents are patents and published patent applications. A guideline for the citation of such documents is listed below. The listing is indicated in the order in which the elements should be listed.

In the case of a patent or published patent application:

(A) The Office that issued the document, by the two letter code (WIPO Standard ST.3);

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

(C) The kind of document, by the appropriate symbols as indicated on the \* document \*\*>under< WIPO Standard ST.16 >or, if not indicated on that document, as provided in that Standard, if possible<;

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

(E) The date of publication of the cited patent document \*\*>or, in case of a corrected patent document, the date of issuance of the corrected patent document as referred to under INID code (48) of WIPO Standard ST.9 and, if provided on the document, the



supplementary correction code as referred to under INID code (15);

(F) Where applicable, the pages, columns, lines or paragraph numbers where the relevant passages appear, or the relevant figures of the drawings.

The following examples illustrate the citation of a patent document as indicated above:

\*\*JP 10-105775 A (NCR INTERNATIONAL INC.) 24 April 1998 (24.04.1998) paragraphs 26 to 30.

DE 3744403 A1 (JOSEK, A.) 29 August 1991 (29-08-1991), page 1, abstract.

US 5,635,683 A (MCDERMOTT, R. M. et al.) 03 June 1997 (03/06/1997), column 7, lines 21 to 40.

**STANDARD CODE FOR THE IDENTIFICATION OF DIFFERENT KINDS OF PATENT DOCUMENTS**

The Code, WIPO Standard ST.16, is subdivided into mutually exclusive groups of letters. The groups characterize patent documents, nonpatent literature documents (N), and restricted documents (X). Groups 1-7 comprise letters enabling identification of documents pertaining to different publication levels.

<u>Group 1</u>	Use for documents resulting from a patent application and being identified as the primary or major series ** (excluding the utility model documents of Group 2 and the special series of patent documents of Group 3, below)
A	First publication level
B	Second publication level
C	Third publication level

<u>Group 2</u>	Use for utility model documents having a numbering series other than the documents of Group 1
U	First publication level

<u>Group 2</u>	Use for utility model documents having a numbering series other than the documents of Group 1
Y	Second publication level
Z	Third publication level

<u>Group 3</u>	Use for * special series of patent document
M	Medicament patent documents (e.g., documents previously published by FR)
P	Plant patent documents (e.g., published by US)
S	Design patent documents (e.g., published by US)

<u>Group 4</u>	Use for special types of patent documents or documents derived from/relating to patent applications and not covered by Groups 1 to 3 above, as specified below:
L	Documents, not covered by letter code W, relating to patent documents and containing bibliographic information and only the text of an abstract and/or claim(s) and, where appropriate, a drawing.
R	Separately published search reports
T	Publication, for information or other purposes, of the translation of the whole or part of a patent document already published by another office or organization

<u>Group 4</u>	Use for special types of patent documents or documents derived from/relating to patent applications and not covered by Groups 1 to 3 above>, as specified below<:
W	Documents relating to utility model documents falling in Group 2 and containing bibliographic information and only the text of an abstract and/or claim(s) and, where appropriate, a drawing

<u>Group 5</u>	Use for series of patent documents not covered by Groups 1 to 4, above
E	First publication level
F	Second publication level
G	Third publication level

<u>Group 6</u>	Use for series of patent documents or documents derived from/relating to patent applications not covered by Groups 1 to 5 above, according to the special requirements of each industrial property office
H	
I	

<u>Group 7</u>	Other
N	Non-patent literature documents
X	Documents restricted to the internal use of industrial property offices

*List of Examples of Patent Documents, Previously and Currently Published, or Intended To Be Published, Divided According to Code*

CODE: A	Patent Documents Identified as Primary or Major Series — First Publication Level
EXAMPLES:	
Australia	Standard or petty patent application
Austria	Patent application (Aufgebot)
Belgium	Brevet d'invention/Uitvindingsoctrooi
Belgium	Brevet de perfectionnement/Verbeteringsoctrooi
Belgium	Demande de brevet d'invention/Uitvindingsoctrooiaanvraag
Brazil	Pedido de privilégio (Unexamined patent application for invention)
Bulgaria	Patentna zjavka predostavena za publicna inspektzija (Patent application made available to the public)
Canada	Patent (prior to October 1, 1989, under previous Patent Act)
Canada	Patent application laid open to public inspection under amended Patent Act, as of October 1, 1989)

CODE: A	Patent Documents Identified as Primary or Major Series — First Publication Level	CODE: A	Patent Documents Identified as Primary or Major Series — First Publication Level
China	Patent application published before the examination	France	Certificat d'utilité, première et unique publication
Cuba	Patent application	France	Certificat d'addition à un certificat d'utilité, première et unique publication
Czechoslovakia	Patent application	France	Demande de brevet d'invention, première publication
Czechoslovakia	Inventor's certificate application	France	Demande de certificat d'addition à un brevet d'invention, première publication
Czech Republic	*>Prihláška< Vynálezu (Application for the protection of an invention — patent)	France	Demande de certificat d'utilité, première publication
Denmark	Almindeligt tilgaengeligt patentansøgning	France	Demande de certificat d'addition à un certificat d'utilité, première publication
Egypt	Patent specification	France	Demande de certificat d'addition à un certificat d'utilité, première publication
European Patent - Office	Patent application published with search report	Germany	Offenlegungsschrift
European Patent Office	Patent application published without search report	Germany (document published by the Patent Office of the former GDR)	Patentschrift (Ausschliessungspatent), patent granted in accordance with paragraph 17.1 of the Patent Law of the former German Democratic Republic of October 27, 1983
European Patent Office	Separate publication of the search report	Germany (document published by the Patent Office of the former GDR)	Patentschrift (Wirtschaftspatent), patent granted in accordance with paragraph 17.1 of the Patent Law of the former German Democratic Republic of October 27, 1983
Finland	Julkiseksi tullut patentihakemus-Allmänt tillgänglig patentansökan		
France	Brevet d'invention (old law)		
France	Brevet d'invention première et unique publication		
France	Certificat d'addition à un brevet d'invention, première et unique publication		

CODE: A	Patent Documents Identified as Primary or Major Series — First Publication Level
Greece	Diploma evresitechnias
Greece	Etisi gia Diploma evresitechnias
Greece	Etisi gia Diploma tropopiisis
Hungary	Patent application
India	Patent specification
Ireland	Patent specification
Israel	Bakashah lepatent (Application of patent for invention)
Italy	Domanda di brevetto pubblicata
Japan	Kôkai tokkyo kôhō
Japan	Kôhyo tokkyo kôhō
Luxembourg	Brevet d'invention
Luxembourg	Certificat d'addition à un brevet d'invention
Malawi	Patent application
Mexico	Patent (Granted patent — according to old law)
Mexico	Patent application (according to new law)
Mongolia	Patent
Morocco	Brevet d'invention
Netherlands	Terinzagegelegging
New Zealand	Patent application
Norway	Alment tilgjengelige patentsöknader
OAPI	Brevet d'invention

CODE: A	Patent Documents Identified as Primary or Major Series — First Publication Level
Pakistan	Patent specification
Peru	Patente de invención
Philippines	Patent for invention
Poland	Opis zgłoszeniowy wynalazku
Portugal	Pedido de patente de invenção
Republic of Korea	Konggae t'ukho kongbo
Romania	Descrierea inventiei
Romania	Cerere de brevet de invente
Russian Federation	Zayavka na izobreteniyе (Published application for invention)
Slovakia	**>Prihláška Vynálezu< (Published application for invention)
Slovenia	Patent
Slovenia	Patent s *>skrajšanim< trajanjem (Short-term patent)
Soviet Union	Opisanie izobreteniya k patentu
Soviet Union	Opisanie izobreteniya k avtorskomu svidetelstvu
Spain	Patente de invención

CODE: A	Patent Documents Identified as Primary or Major Series — First Publication Level
Spain	Solicitud de patente con informe sobre el estado de la técnica (Patent application published with search report)
Spain	Solicitud de patente sin informe sobre el estado de la técnica (Patent application published without search report)
Sweden	Allmant tillgänglig patentansökan
Switzerland	Auslegeschrift/Fascicule de la demande/Fascicolo della domanda (Patent Application published and pertaining to the technical fields for which search and examination as to novelty are made)
Switzerland	Patentschrift/Fascicule du brevet/Fascicolo del brevetto (Patent published and pertaining to the technical fields for which neither search nor examination as to novelty are made)
Tunisia	Talab Baraat Ekhtiraâ
Turkey	Patent tarifnamesi
United Kingdom	Patent specification (old Law; not printed on documents)
United Kingdom	Patent application (new Law)

CODE: A	Patent Documents Identified as Primary or Major Series — First Publication Level
United States of America	Patent (published before January 2, 2001)
United States of America	Patent application publication (published beginning March 15, 2001)
World Intellectual Property Organization	International application published with or without the international search report
Yugoslavia	Patenta prijava koja se moze razgledati

CODE: B	Patent Documents Identified as Primary or Major Series -Second Publication Level
<b>EXAMPLES:</b>	
Australia	Accepted standard or petty patent
Austria	Patentschrift
Belgium	Brevet d'invention/Uitvindingsoctrooi
Brazil	Patente (granted patent of invention)
Canada	Reissue patent (prior to October 1, 1989, under previous Patent Act)
Cuba	Patente de invención
Czechoslovakia	Popis vynalezu k patentu
Czechoslovakia	Popis vynalezu k autor-skemu osvedceni

CODE: B	Patent Documents Identified as Primary or Major Series -Second Publication Level
Czech Republic	Patentovy spis (patent specification)
Denmark	Fremlaeggelsesskrift (old Law)
Denmark	Patentskrift
Denmark	Patentskrift (amended)
Finland	Kuulutusjulkaisu - Utläggningsskrift
France	Brevet d'invention, deuxième publication de l'invention
France	Certificat d'addition à un brevet d'invention, deuxième publication de l'invention
France	Certificat d'utilité, deuxième publication de l'invention
France	Certificat d'addition à un certificat d'utilité, deuxième publication de l'invention
Germany	Auslegeschrift
Germany (document published by the Patent Office of the former GDR)	Patentschrift (Ausschliessungspatent), patent granted in accordance with paragraph 18.1 of the Patent Law of the former German Democratic Republic of October 27, 1983

CODE: B	Patent Documents Identified as Primary or Major Series -Second Publication Level
Germany (document published by the Patent Office of the former GDR)	Patentschrift (Wirtschaftspatent), patent granted in accordance with paragraph 18.1 of the Patent Law of the former German Democratic Republic of October 27, 1983
Greece	Diploma evresitechnias (Patent of invention)
Greece	Diploma tropopiisis (Patent of addition)
Hungary	Szabadalmi leiras
Indonesia	Patent granted in accordance with article 61 of the Patent Law, Number 6 of 1989 Concerning Patents
Japan	Tokkyo kôhô
Netherlands	Openbaar gemaakte octrooiaanvraag
Norway	Utlegningskrift
Poland	Opis patentowy
Portugal	Patente de invenção (Granted patent of published application)
Republic of Korea	T'ukho kongbo
Spain	Patente de invención con informe sobre el estado de la técnica (Patent specification with search report)

CODE: B	Patent Documents Identified as Primary or Major Series -Second Publication Level
Spain	Patente de invención con examen previo (Patent specification published after examination)
Sweden	Utläggningsskrift
Switzerland	Patentschrift/Fascicule du brevet/Fascicolo del brevetto (Patent published and pertaining to the technical fields for which search and examination as to novelty are made)
United Kingdom	Amended patent specification (old Law)
United Kingdom	Patent specification (new Law)
United States of America	Reexamination certificate (published prior to January 2, 2001)
United States of America	Patent (published on or after January 2, 2001)

CODE: C	Patent Documents Identified as Primary or Major Series - Third Publication Level
EXAMPLES:	
Argentina	Patente de invención (Patent)

CODE: E	Patent Documents Identified as Series Other Than the Documents Coded A, B, C, U, Y, Z, M, P, S, T, W, L or R - First Publication Level
EXAMPLES:	
Canada	Reissue patent (under amended Patent Act, as of October 1, 1989)
France	Certificat d'addition à brevet d'invention (old Law)
Sweden	Patentskrift i ändrad lydelse (Amended patent specification)
United States of America	Reissue patent

CODE: H	Patent Documents Identified in Series According to Special Requirements of Individual Industrial Property Offices
EXAMPLES:	
United States of America	Statutory invention registration

CODE: M	Patent Documents Identified in Series According to Special Requirements of Individual Industrial Property Offices
EXAMPLES:	
France	Brevet spécial de médicament
France	Addition à un brevet spécial de médicament

CODE: P	Plant Patent Documents
EXAMPLES:	
United States of America	Plant patent
United States of America	Plant patent application publication

CODE: S	Design Patent Documents
EXAMPLES:	
Brazil	Pedido de privilégio (unexamined patent application for industrial model)
Russian Federation	Patent na promishlenni obrazets (Design patent)
United States of America	Design patent

CODE: U	Utility Model Documents Having a Numbering Series Other Than the Documents Coded A, B or C— First Publication Level
EXAMPLES:	
Austria	Gebrauchsmusterschrift (published with or without a search report)
Brazil	Pedido de privilégio (unexamined patent application for industrial model)
Bulgaria	Zajavka za polezni modeli predostavena za publichna inspektzija (Utility model application made available to the public)
Czech Republic	Uzity vzor (Utility model)
Denmark	Almindeligt tilgaengeligt brugsmodelansogning
Denmark	Brugsmodelskrift
Finland	Hyödyllisyysmalli-Nyttighetsmodell (Utility model)
Germany	Gebrauchsmuster
Greece	Etisi gia Pistopiitiko Ipodigmatos Chrisimotitas (Utility model application)
Hungary	Hasznalati minta leiras (Utility model specification)



CODE: U	Utility Model Documents Having a Numbering Series Other Than the Documents Coded A, B or C— First Publication Level
Japan	Kôkai jitsuyô shin-an kôhô (Published unexamined utility model application)
Japan	Tôroku jitsuyô shin-an kôhô (Published registered utility model application) (without substantive examination)
Mexico	Utility model
Poland	Opis zgłoszeniowy wzoru użytecznego
Portugal	Pedido de modelo de utilidade (Published application for a utility model)
Republic of Korea	Konggae shilyong shin-an kongbo
Russian Federation	Svidetelstvo na poleznuyu model (Certificate for utility model)
Slovakia	*>Úžitkovy< vzor (Utility model)
Spain	Solicitud de modelo de utilidad

CODE: Y	Utility Model Documents Having a Numbering Series Other Than the Documents Coded A, B or C— Second Publication Level
EXAMPLES:	
Brazil	Patente (granted patent of utility model)
Bulgaria	Opisanie na patent za polezen model (Description of a patent for utility model)
Denmark	Brugsmodelskrift
Denmark	Brugsmodelskrift (amended)
Greece	Pistopiitiko Ipodigmatos Chrisimotitas (Utility model)
Japan	Jitsuyô shin-an kôhô (Published examined utility model application)
Poland	Opis ochronny wzoru użytkowego
Portugal	Modelo de utilidade (Granted utility model)
Republic of Korea	Shilyong shin-an kongbo (Utility model specification)
Spain	Modelo de utilidad
**	

**Country Codes**

The two-letter country codes listed below are set forth in WIPO Standard ST.3, which is published in the “WIPO Handbook on Industrial Property Information and Documentation” and is accessible via the internet at the WIPO website ([\\*www.wipo.int/scit/en/standards/standards.htm](http://www.wipo.int/scit/en/standards/standards.htm)). WIPO Standard ST.3 provides, in Annex A, Section 1, a listing of two-letter country codes and/or organizational codes in alphabetic sequence of their short names for the states, other entities and intergovernmental organizations issuing or publishing industrial property documents. Codes for states or organizations that existed on January 1, 1978, but that no longer exist are provided in Annex B, Section 2. Annex B, Section 1 (not reproduced below) lists States for which the Codes have changed.

## Annex A, Section 1

List of States, Other Entities and Intergovernmental Organizations, in Alphabetic Sequence of Their Short Names, and Their Corresponding Codes	
Afghanistan	AF
African Intellectual Property Organization (OAPI)	OA
African Regional Industrial Property Organization (ARIPO)	AP
Albania	AL
Algeria	DZ
Andorra	AD
Angola	AO
Anguilla	AI
Antigua and Barbuda	AG
Argentina	AR
Armenia	AM
Aruba	AW
Australia	AU

Austria	AT
Azerbaijan	AZ
Bahamas	BS
Bahrain	BH
Bangladesh	BD
Barbados	BB
Belarus	BY
Belgium	BE
Belize	BZ
Benelux Trademark Office (BBM) and Benelux Designs Office (BBDM)	BX
Benin	BJ
Bermuda	BM
Bhutan	BT
Bolivia	BO
Bosnia and Herzegovina	BA
Botswana	BW
Bouvet Island	BV
Brazil	BR
Brunei Darussalam	BN
Bulgaria	BG
Burkina Faso	BF
Burundi	BI
Cambodia	KH
Cameroon	CM
Canada	CA
Cape Verde	CV
Cayman Islands	KY
Central African Republic	CF

Chad	TD	>European Community Plant Variety Office (CPVO )	QZ<
Chile	CL	European Community Trade-mark Office (See Office for Harmonization in the Internal Market)	*>EM<
China	CN	European Patent Office (EPO)	EP
Colombia	CO	Falkland Islands (Malvinas)	FK
Comoros	KM	Faroe Islands	FO
Congo	CG	Fiji	FJ
Cook Islands	CK	Finland	FI
Costa Rica	CR	France	FR
Côte d'Ivoire	CI	Gabon	GA
Croatia	HR	Gambia	GM
Cuba	CU	Georgia	GE
Cyprus	CY	Germany	DE
Czech Republic	CZ	Ghana	GH
Democratic People's Republic of Korea	KP	Gibraltar	GI
Democratic Republic of the Congo	CD	Greece	GR
Denmark	DK	Greenland	GL
Djibouti	DJ	Grenada	GD
Dominica	DM	Guatemala	GT
Dominican Republic	DO	Guinea	GN
East Timor	TP	Guinea-Bissau	GW
Ecuador	EC	Gulf Cooperation Council (see Patent Office of the Cooperation Council for the Arab States of the Gulf)	
Egypt	EG	Guyana	GY
El Salvador	SV	Haiti	HT
Equatorial Guinea	GQ	Holy See	VA
Eritrea	ER	Honduras	HN
Estonia	EE		
Ethiopia	ET		
Eurasian Patent Organization (EAPO)	EA		

Hong Kong (See The Hong Kong Special Administrative Region of The People's Republic of China)		Libya	LY
Hungary	HU	Liechtenstein	LI
Iceland	IS	Lithuania	LT
India	IN	Luxembourg	LU
Indonesia	ID	Macau	MO
International Bureau of the World Intellectual Property Organization (WIPO)	IB, WO	Madagascar	MG
Iran (Islamic Republic of)	IR	Malawi	MW
Iraq	IQ	Malaysia	MY
Ireland	IE	Maldives	MV
Israel	IL	Mali	ML
Italy	IT	Malta	MT
Jamaica	JM	Mauritania	MR
Japan	JP	Mauritius	MU
Jordan	JO	Mexico	MX
Kazakhstan	KZ	Monaco	MC
Kenya	KE	Mongolia	MN
Kiribati	KI	Montserrat	MS
Korea (See Democratic People's Republic of Korea; Republic of Korea)		Morocco	MA
Kuwait	KW	Mozambique	MZ
Kyrgyzstan	KG	Myanmar	MM
Laos	LA	Namibia	NA
Latvia	LV	Nauru	NR
Lebanon	LB	Nepal	NP
Lesotho	LS	Netherlands	NL
Liberia	LR	Netherlands Antilles	AN
		New Zealand	NZ
		Nicaragua	NI
		Niger	NE
		Nigeria	NG
		Northern Mariana Islands	MP

Norway	NO	Senegal	SN
Office for Harmonization in the Internal Market (Trade-marks and Designs) (OHIM)	EM	>Serbia and Montenegro	YU<
Oman	OM	Seychelles	SC
Pakistan	PK	Sierra Leone	SL
Palau	PW	Singapore	SG
Panama	PA	Slovakia	SK
Papua New Guinea	PG	Slovenia	SI
Paraguay	PY	Solomon Islands	SB
Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC)	GC	Somalia	SO
Peru	PE	South Africa	ZA
Philippines	PH	South Georgia and the South Sandwich Islands	GS
Poland	PL	Spain	ES
Portugal	PT	Sri Lanka	LK
Qatar	QA	Sudan	SD
Republic of Korea	KR	Suriname	SR
Republic of Moldova	MD	Swaziland	SZ
Romania	RO	Sweden	SE
Russian Federation	RU	Switzerland	CH
Rwanda	RW	Syria	SY
Saint Helena	SH	Taiwan, Province of China	TW
Saint Kitts and Nevis	KN	Tajikistan	TJ
Saint Lucia	LC	Tanzania (see United Republic of Tanzania)	
Saint Vincent and the Grenadines	VC	Thailand	TH
Samoa	WS	The Former Yugoslav Republic of Macedonia	MK
San Marino	SM	The Hong Kong Special Administrative Region of The People's Republic of China	HK
Sao Tome and Principe	ST	>Timor-Leste	TL<
Saudi Arabia	SA		

Togo	TG
Tonga	TO
Trinidad and Tobago	TT
Tunisia	TN
Turkey	TR
Turkmenistan	TM
Turks and Caicos Islands	TC
Tuvalu	TV
Uganda	UG
Ukraine	UA
United Arab Emirates	AE
United Kingdom	GB
United Republic of Tanzania	TZ
United States of America	US
Uruguay	UY
Uzbekistan	UZ
Vanuatu	VU
Vatican City State (See Holy See)	
Venezuela	VE
Viet Nam	VN
Virgin Islands (British)	VG
Western Sahara	EH
World Intellectual Property Organization (WIPO) (International Bureau of)	WO, IB
Yemen	YE
Yugoslavia	YU
Zambia	ZM
Zimbabwe	ZW
Annex B, Section 2	

List of States or Organizations That Existed on January 1, 1978, but That No Longer Exist

Czechoslovakia	CS
Democratic Yemen	SY/YD
German Democratic Republic	DL/DD
International Patent Institute	IB
Soviet Union	SU

**1852 International-Type Search***PCT Rule 41.**Earlier Search Other Than International Search**41.1. Obligation to Use Results; Refund of Fee*

If reference has been made in the request, in the form provided for in Rule 4.11, to an international-type search carried out under the conditions set out in Article 15(5) or to a search other than an international or international-type search, the International Searching Authority shall, to the extent possible, use the results of the said search in establishing the international search report on the international application. The International Searching Authority shall refund the search fee, to the extent and under the conditions provided for in the agreement under Article 16(3)(b) or in a communication addressed to and published in the Gazette by the International Bureau, if the international search report could wholly or partly be based on the results of the said search.

*37 CFR 1.104. Nature of examination.**(a) Examiner's action.*

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(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

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PCT Rule 41 provides that the applicant may request in a later filed international application that the report of the results of the international-type search, i.e., a search similar to an international search, but carried out on a national application (37 CFR 1.104(a)(3) and (a)(4)), be used in establishing an international search report on such international application. An international-type search is conducted on all U.S. national nonprovisional applications filed after June 1, 1978. Upon specific request, at the time of the examination of a U.S. national nonprovisional application and provided that the payment of the appropriate international-type search report fee has been made (37 CFR 1.21(e)) an international-type search report Form PCT/ISA/201 will also be prepared.

**1853 Amendment Under PCT Article 19***PCT Article 19.**Amendment of the Claims before the International Bureau*

(1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

(2) The amendments shall not go beyond the disclosure in the international application as filed.

(3) If the national law of any designated State permits amendments to go beyond the said disclosure, failure to comply with paragraph (2) shall have no consequence in that State.

*PCT Rule 46.**Amendment of Claims Before the International Bureau**46.1. Time Limit*

The time limit referred to in Article 19 shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later, provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

*46.2. Where to File*

Amendments made under Article 19 shall be filed directly with the International Bureau.

*46.3. Language of Amendments*

If the international application has been filed in a language other than the language in which it is published, any amendment made under Article 19 shall be in the language of publication.

*46.4. Statement*

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published and shall not exceed 500 words if in the English language or if translated into that language. The statement shall be identified as such by a heading, preferably by using the words "Statement under Article 19(1)" or their equivalent in the language of the statement.

(b) The statement shall contain no disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

#### 46.5. Form of Amendments

The applicant shall be required to submit a replacement sheet for every sheet of the claims which, on account of an amendment or amendments under Article 19, differs from the sheet originally filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.

#### 37 CFR 1.415. The International Bureau.

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Treaty and the Regulations (PCT Art. 2 (xix) and 35 U.S.C. 351(h)).

(b) The major functions of the International Bureau include:

- (1) Publishing of international applications and the International Gazette;
- (2) Transmitting copies of international applications to Designated Offices;
- (3) Storing and maintaining record copies; and
- (4) Transmitting information to authorities pertinent to the processing of specific international applications.

#### PCT Administrative Instruction 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 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.

The applicant has one opportunity to amend the claims only of the international application after issuance of the Search Report. The amendments to the claims must be filed directly with the International Bureau, usually within 2 months of the date of mailing of the Search Report. If the amendments to the

claims are timely received by the International Bureau, such amendments will be published as part of the pamphlet directly following the claims as filed. Article 19 offers applicants the opportunity to generally amend the claims before entering the designated Offices. The national laws of some designated Offices may grant provisional protection on the invention from the date of publication of the claims. Therefore, some applicants take advantage of the opportunity under Article 19 to polish the claims anticipating provisional protection. See PCT Rule 46.5.

## 1857 International Publication [R-2]

#### PCT Article 21.

##### International Publication

(1) The International Bureau shall publish international applications.

(2)(a) Subject to the exceptions provided for in subparagraph (b) and in Article 64(3), the international publication of the international application shall be effected promptly after the expiration of 18 months from the priority date of that application.

(b) The applicant may ask the International Bureau to publish his international application any time before the expiration of the time limit referred to in subparagraph (a). The International Bureau shall proceed accordingly, as provided in the Regulations.

(3) The international search report or the declaration referred to in Article 17(2)(a) shall be published as prescribed in the Regulations.

(4) The language and form of the international publication and other details are governed by the Regulations.

(5) There shall be no international publication if the international application is withdrawn or is considered withdrawn before the technical preparations for publication have been completed.

(6) If the international application contains expressions or drawings which, in the opinion of the International Bureau, are contrary to morality or public order, or if, in its opinion, the international application contains disparaging statements as defined in the Regulations, it may omit such expressions drawings, and statements, from its publications, indicating the place and number of words or drawings omitted, and furnishing, upon request, individual copies of the passages omitted.

#### PCT Article 29.

##### Effects of the International Publication

(1) As far as the protection of any rights of the applicant in a designated State is concerned, the effects, in that State, of the international publication of an international application shall, subject to the provisions of paragraphs (2) to (4), be the same as those which the national law of the designated State provides for the compulsory national publication of unexamined national applications as such.



(2) If the language in which the international publication has been effected is different from the language in which publications under the national law are effected in the designated State, the said national law may provide that the effects provided for in paragraph (1) shall be applicable only from such time as:

(i) a translation into the latter language has been published as provided by the national law, or

(ii) a translation into the latter language has been made available to the public, by laying open for public inspection as provided by the national law, or

(iii) a translation into the latter language has been transmitted by the applicant to the actual or prospective unauthorized user of the invention claimed in the international application, or

(iv) both the acts described in (i) and (iii), or both the acts described in (ii) and (iii), have taken place.

(3) The national law of any designated State may provide that, where the international publication has been effected, on the request of the applicant, before the expiration of 18 months from the priority date, the effects provided for in paragraph (1) shall be applicable only from the expiration of 18 months from the priority date.

(4) The national law of any designated State may provide that the effects provided for in paragraph (1) shall be applicable only from the date on which a copy of the international application as published under Article 21 has been received in the national Office of or acting for such State. The said Office shall publish the date of receipt in its gazette as soon as possible.

*PCT Administrative Instruction 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 four-digit indication of the year of publication, a slant, and a serial number consisting of six digits (e.g., "WO 2004/123456").<

*35 U.S.C. 374. Publication of international application.*

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in sections 102(e) and 154(d) of this title.

The publication of international applications currently occurs every Thursday. Under PCT Article 20 >and PCT Rules 47.1(a) and 93<sup>bis</sup>.1,< the International Bureau sends copies of published >international< applications to each of the designated Offices >that have requested to receive the published application< on the day of publication. Until October 1, 1995, as a PCT member country, the U.S. Patent and Trademark Office received copies of all published

international applications in printed form for inclusion in the examiner search files. The U.S. Patent and Trademark Office now receives the published international applications on CD-ROM disks and in other electronic formats. For information on obtaining copies of these applications, see MPEP § 901.05(c). \*\*>Published international application information is also available from< the *PCT Gazette*, which can be accessed electronically through The Intellectual Property Digital Library Web site (<http://ipdl.wipo.int/>) of the World Intellectual Property Organization. >In addition, published international applications may be obtained online from the European Patent Office web site (<http://ep.espacenet.com>).<

**PUBLICATION OF SEQUENCE LISTING AND/OR TABLES FILED IN ELECTRONIC FORM**

*PCT Administrative Instruction Section 805.*

*Publication and Communication of International Applications Containing Sequence Listings and/or Tables; Copies; Priority Documents*

(a) Notwithstanding Section 406, an international application containing sequence listings and/or tables may be published under Article 21, in whole or in part, in electronic form as determined by the Director General.

(b) Paragraph (a) shall apply *mutatis mutandis* in relation to:

(i) the communication of an international application under Article 20;

(ii) the furnishing of copies of an international application under Rules 87 and 94.1;

(iii) the furnishing under Rule 17.1, as a priority document, of a copy of an international application containing sequence listings and/or tables filed under Section 801(a);

(iv) the furnishing under Rules 17.2 and 66.7 of copies of a priority document.

As of August 2, 2001, WIPO began to publish sequence listing parts of the description on the Internet where the sequence listing was filed under PCT Administrative Instructions Section 801 as authorized by PCT Administrative Instructions Section 805(a). On September 6, 2002, the PCT Administrative Instructions were further amended to include electronic submissions of tables related to sequence listings. Sequence listing parts of the description and tables may be viewed and downloaded at <http://www.wipo.int/pct/en/sequences/index.htm>. Thus, an international application containing a sequence listing or table filed under Part 8 of the Administrative

Instructions comprises two elements published on the same day:

(A) a paper pamphlet including all parts of the application that were not filed in electronic format under Part 8 of the Administrative Instructions; and

(B) an electronic publication of the sequence listing and/or tables that were filed in electronic format under Part 8 of the Administrative Instructions.

Cross-references between the two elements are included for the sake of clarity. \*\*>The bibliographic page of a published international application filed under Administrative Instructions Section 801 includes the statement: “Published with sequence listing part of description published separately in electronic form and available upon request from the International Bureau.” Conversely, the electronic publication of the sequence listing part of the international application on WIPO’s web site ([www.wipo.int/pct/en/sequences/index.htm](http://www.wipo.int/pct/en/sequences/index.htm)) contains a link to the remainder of the published international application in the electronic *PCT Gazette*.

### 1857.01 Prior Art Effect of the International Publication [R-2]

*35 U.S.C. 374. Publication of international application.*

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in sections 102(e) and 154(d) of this title.

*35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.*

A person shall be entitled to a patent unless —

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(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was

published under Article 21(2) of such treaty in the English language; or

\*\*\*\*\*

An international >application< \*\* may be used as prior art as of its international filing date, or an earlier U.S. filing date for which \*\* benefit is properly claimed, under 35 U.S.C. 102(e) if the international application:

(A) was filed on or after November 29, 2000;

(B) designated the United States; and

(C) was published under PCT Article 21(2) in the English language.

If such an international application properly claims benefit >under 35 U.S.C. 119(e), 120, or 365(c)< to an earlier-filed U.S. >national< or international application >designating the U.S.< \*\*, the international application can be applied as prior art under 35 U.S.C. 102(e) as of the earlier filing date, assuming all the conditions of 35 U.S.C. 102(e), 119(e), 120, or 365(c) are met. Note, where the earlier application is >also< an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S. and had been published in English under PCT Article 21(2)) for the earlier international filing date to be a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).

If any of the above conditions have not been satisfied, the publication of the international application and the U.S. application publication of the national stage after compliance with 35 U.S.C. 371 may only be used as prior art as of its publication date under 35 U.S.C. 102(a) or (b). See MPEP § 706.02(a) and § 2136.03. A later filed U.S. application that properly claimed the benefit under 35 U.S.C. 120 or 365(c) of such an international application will have its own U.S. filing date for purposes of 35 U.S.C. 102(e). In addition, international applications, which: (1) were filed prior to November 29, 2000, (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a \*\* benefit claim for prior art purposes under 35 U.S.C. 102(e).

For more information, see MPEP § 706.02(a) and § 706.02(f)(1).

## 1859 Withdrawal of International Application, \* Designations, or Priority Claims < [R-2]

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### *PCT Rule 90<sup>bis</sup>. Withdrawals*

#### *90<sup>bis</sup>.1. Withdrawal of the International Application*

(a) The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(c) No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

#### *90<sup>bis</sup>.2. Withdrawal of Designations*

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90<sup>bis</sup>.4.

(b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.

(c) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90<sup>bis</sup>.1.

(d) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(e) No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

#### *90<sup>bis</sup>.3. Withdrawal of Priority Claims*

(a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date.

(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one or more or all of the priority claims.

(c) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change.

(e) In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

\*\*\*\*\*

#### *90<sup>bis</sup>.5. Signature*

(a) Any notice of withdrawal referred to in Rules 90<sup>bis</sup>.1 to 90<sup>bis</sup>.4 shall, subject to paragraph (b), be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, subject to paragraph (b), not be entitled to sign such a notice on behalf of the other applicants.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90<sup>bis</sup>.1 to 90<sup>bis</sup>.4 need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and.

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau, or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

(ii) in the case of a notice of withdrawal referred to in Rule 90<sup>bis</sup>.1(b), 90<sup>bis</sup>.2(d), or 90<sup>bis</sup>.3(c), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) in the case of a notice of withdrawal referred to in Rule 90<sup>bis</sup>.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with.

*90<sup>bis</sup>.6.Effect of Withdrawal*

(a) Withdrawal under Rule 90<sup>bis</sup> of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).

(b) Where the international application is withdrawn under Rule 90<sup>bis</sup>.1, the international processing of the international application shall be discontinued.

(c) Where the demand or all elections are withdrawn under Rule 90<sup>bis</sup>.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

*90<sup>bis</sup>.7.Faculty Under Article 37(4)(b)*

(a) Any Contracting State whose national law provides for what is described in the second part of Article 37(4)(b) shall notify the International Bureau in writing.

(b) The notification referred to in paragraph (a) shall be promptly published by the International Bureau in the Gazette, and shall have effect in respect of international applications filed more than one month after the date of such publication.

For a discussion of the withdrawal of the demand or of elections (PCT Rule 90<sup>bis</sup>.4), see MPEP § 1880.

Form PCT/IB/372 may be used by the applicant to make a withdrawal under any of PCT Rules 90<sup>bis</sup>.1, 90<sup>bis</sup>.2, 90<sup>bis</sup>.3, and 90<sup>bis</sup>.4. The form is available from WIPO's web site ([www.wipo.int/pct/en/forms/ib/ib372.pdf](http://www.wipo.int/pct/en/forms/ib/ib372.pdf)).

The applicant may withdraw the international application, the designation of any state, or a priority claim by a notice addressed to the International Bureau or to the receiving Office and received before the expiration of 30 months from the priority date. Where Article 39(1) applies, the notice may also be addressed to the International Preliminary Examining Authority. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. The provisions for waiver of a power of attorney set forth in PCT Rules 90.4(d) and 90.5(c) do not apply in the case of withdrawals under PCT Rule 90<sup>bis</sup>. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is considered to be the common representative may not sign such a notice on behalf of the other applicants. As to the case where an applicant inventor for the United States of America \*\* cannot be found or reached see PCT Rule 90<sup>bis</sup>.5(b).

The applicant may prevent international publication by withdrawing the international application, provided that the notice of withdrawal reaches the International Bureau before the completion of technical preparations for that publication. The notice of withdrawal may state that the withdrawal is to be effective only on the condition that international publication can still be prevented. In such a case the withdrawal is not effective if the condition on which it was made cannot be met that is, if the technical preparations for international publication have already been completed. \*\*

If all designations are withdrawn, the international application will be treated as withdrawn.

\*\*

Where the withdrawal of a priority claim causes a change in the priority date of the international application, any time limit which is computed from the original priority date and which has not yet expired—for example, the time limit before which processing in the national phase cannot start—is computed from the priority date resulting from the change. (It is not possible to extend the time limit concerned if it has already expired when the priority claim is withdrawn.) Thus, international publication may be postponed by withdrawing the priority claim prior to publication. However, if the notice of withdrawal reaches the International Bureau after the completion of the technical preparations for international publication, the International Bureau may proceed with the international publication on the basis of the time limit for international publication as computed from the original priority date.

## **1860 >International Preliminary Examination Procedure for Applications Having an International Filing Date On or After January 1, 2004 [R-2]**

[Note: The regulations under the PCT were changed effective January 1, 2004. A corresponding change was made to Title 37 of the Code of Federal Regulations. See *January 2004 Revision of Patent Cooperation Treaty Application Procedure*, 68 FR 59881 (Oct. 20, 2003), 1276 O.G. 6 (Nov. 11, 2003). All international applications having an international filing date before January 1, 2004,

**will continue to be processed under the procedures in effect on the international filing date. For the international preliminary examination procedure applicable to international applications having an international filing date before January 1 2004, see MPEP § 1860.01 for the information that previously appeared in this section].**

## **EXAMINATION PROCEDURE**

The international preliminary examination is to be carried out in accordance with PCT Article 34 and PCT Rule 66. After the demand is checked for compliance with PCT Rules 53-55, 57 and 58, the first step of the examiner is to study the description, the drawings (if any), the claims of the international application, the documents describing the prior art as cited in the international search report, and the written opinion established by the International Searching Authority.

A further written opinion is usually not mandatory where the written opinion of the International Searching Authority is treated as the first written opinion of the International Preliminary Examining Authority. The United States International Preliminary Examining Authority will treat any written opinion established by the United States International Searching Authority or the European Patent Office International Searching Authority as the first written opinion of the International Preliminary Examining Authority.

Assuming the written opinion of the International Searching Authority is treated as the first written opinion of the International Preliminary Examining Authority, as noted above, no further written opinion need be issued before the international preliminary examination report, even if there are objections outstanding. The examiner takes into consideration any comments or amendments made by the applicant when establishing the international preliminary examination report.

## **FURTHER WRITTEN OPINION SHOULD BE ISSUED**

A further written opinion should be prepared by the examiner if applicant files a response which includes a persuasive argument that the written opinion issued by the International Searching Authority was improper because of a negative opinion with respect to a lack of novelty, inventive step (non-obviousness)

or industrial applicability as described in PCT Article 33(2)-(4); and which results in the examiner considering any of the claims to lack novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2)-(4) based on new art not necessitated by any amendment.

Any further written opinion established by the International Preliminary Examining Authority should set forth, as applicable:

(A) Any defects in the international application as described in PCT Article 34(4) concerning subject matter which is not required to be examined or which is unclear or inadequately supported;

(B) Any negative findings with respect to any of the claims because of a lack of novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2)-(4);

(C) Any defects in the form or contents of the international application;

(D) Any finding by the examiner that an amendment goes beyond the disclosure in the international application as originally filed;

(E) Any observation which the examiner wishes to make on the clarity of the claims, the description, the drawings or to the question whether the claims are fully supported by the description (PCT Rule 66.2);

(F) Any decision by the examiner not to carry out the international preliminary examination on a claim for which no international search report was issued; or

(G) If the examiner considers that no acceptable nucleotide and/or amino acid sequence listing is available in a form that would allow a meaningful international preliminary examination to be carried out.

The further written opinion is prepared on Form PCT/IPEA/408 to notify applicant of the defects found in the international application. The examiner is further required to fully state the reasons for his/her opinion (PCT Rule 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)), normally setting a 2 month time limit for the reply.

The applicant may reply to the invitation by making amendments or, if applicant disagrees with the opinion of the examiner, by submitting arguments, as the case may be, or both.

The U.S. Rules of Practice pertaining to international preliminary examination of international appli-

cations permit a second written opinion in those cases where sufficient time is available. Normally only one written opinion will be issued. Any reply received after the expiration of the set time limit will not normally be considered in preparing the international preliminary examination report. In situations, however, where the examiner has requested an amendment or where a later amendment places the application in better condition for examination, the amendment may be considered by the examiner.

If the applicant does not reply to any further written opinion established by the International Preliminary Examining Authority within the set time period, the international preliminary examination report will be prepared after expiration of the time limit plus sufficient time to have any reply clear the Mail Center.

### **1860.01 < International Preliminary Examination >Procedure for Applications Having an International Filing Date Before January 1, 2004< [R-2]**

>[Note: For the international preliminary examination procedure applicable to international applications having an international filing date on or after January 1, 2004, see MPEP § 1860.]<

#### **EXAMINATION PROCEDURE**

The International Preliminary Examination is to be carried out in accordance with PCT Article 34 and PCT Rule 66. After the Demand is checked for compliance with PCT Rules 53 - 55, 57 and 58, the first step of the examiner is to study the description, the drawings (if any), and the claims of the international application and the documents describing the prior art as cited in the international search report.

A written opinion must be prepared if the examiner:

(A) Considers that the international application has any of the defects described in PCT Article 34(4) concerning subject matter which is not required to be examined or which is unclear or inadequately supported;

(B) Considers that the report should be negative with respect to any of the claims because of a lack of novelty, inventive step (non-obviousness) or indus-

trial applicability as described in PCT Article 33(2) - (4);

(C) Notices any defects in the form or contents of the international application;

(D) Considers that any amendment goes beyond the disclosure in the international application as originally filed;

(E) Wishes to make an observation on the clarity of the claims, the description, the drawings or to the question whether the claims are fully supported by the description (PCT Rule 66.2);

(F) Decides not to carry out the international preliminary examination on a claim for which no international search report was issued; or

(G) Considers that no acceptable amino acid sequence listing is available in a form that would allow a meaningful international preliminary examination to be carried out.

The written opinion is prepared on form PCT/IPEA/408 to notify applicant of the defects found in the international application. The examiner is further required to fully state the reasons for his/her opinion (PCT Rule 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)), normally setting a 2 month time limit for the reply.

The applicant may reply to the invitation by making amendments or, if applicant disagrees with the opinion of the examiner, by submitting arguments, as the case may be, or both.

The U.S. Rules of Practice pertaining to international preliminary examination of international applications permit a second written opinion in those cases where sufficient time is available. Normally only one written opinion will be issued. Any reply received after the expiration of the set time limit will not normally be considered in preparing the international preliminary examination report. In situations, however, where the examiner has requested an amendment or where a later amendment places the application in better condition for examination, the amendment may be considered by the examiner.

If the applicant does not reply to the written opinion within the set time period, the international preliminary examination report will be prepared after expiration of the time limit plus sufficient time to have any reply clear the Mail Center.

If, after initial examination of the international application, there is no negative statement or com-

ment to be made, then only the international preliminary examination report will issue without a written opinion having been issued.

\*\*

## 1862 Agreement With the International Bureau To Serve as an International Preliminary \*>Examining< Authority [R-2]

*PCT Article 32.*

### *The International Preliminary Examining Authority*

(1) International preliminary examination shall be carried out by the International Preliminary Examining Authority

(2) In the case of demands referred to in Article 31(2)(a), the receiving Office, and, in the case of demands referred to in Article 31(2)(b), the Assembly, shall, in accordance with the applicable agreement between the interested International Preliminary Examining Authority or Authorities and the International Bureau, specify the International Preliminary Examining Authority or Authorities competent for the preliminary examination.

(3) The provisions of Article 16(3) shall apply, *mutatis mutandis*, in respect of the International Preliminary Examining Authorities.

*PCT Article 34.*

### *Procedure before the International Preliminary Examining Authority*

(1) Procedure before the International Preliminary Examining Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.

\*\*\*\*\*

### *37 CFR 1.416. The United States International Preliminary Examining Authority.*

\*\*>

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Preliminary Examining Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Director, in accordance with agreement between the Patent and Trademark Office and the International Bureau.<

(b) The United States Patent and Trademark Office, when acting as an International Preliminary Examining Authority, will be identified by the full title "United States International Preliminary Examining Authority" or by the abbreviation "IPEA/US."

(c) The major functions of the International Preliminary Examining Authority include:

(1) Receiving and checking for defects in the Demand;

(2) Forwarding Demands in accordance with PCT Rule 59.3;

(3) Collecting the handling fee for the International Bureau and the preliminary examination fee for the United States International Preliminary Examining Authority;

(4) Informing applicant of receipt of the Demand;

(5) Considering the matter of unity of invention;

(6) Providing an international preliminary examination report which is a nonbinding opinion on the questions whether the claimed invention appears to be novel, to involve inventive step (to be nonobvious), and to be industrially applicable; and

(7) Transmitting the international preliminary examination report to applicant and the International Bureau.

An agreement was concluded between the United States Patent and Trademark Office (USPTO) and the International Bureau under which the USPTO agreed to serve as an International Preliminary Examining Authority for those applications filed in the USPTO as a Receiving Office and for those international applications filed in other receiving Offices for which the USPTO has served as an International Searching Authority.

The agreement is provided for in PCT Articles 32(2) & (3) and 34(1), and in PCT Rules 59.1, 63.1, 72.1, and 77.1(a). Authority is given in 35 U.S.C. 361(c), 362(a) & (b) and in 364(a). 37 CFR 1.416(a) and PCT Administrative Instructions Section 103(c) are also relevant.

## 1864 The Demand and Preparation for Filing of Demand [R-2]

*37 CFR 1.480. Demand for international preliminary examination.*

\*\*>

(a) On the filing of a proper Demand in an application for which the United States International Preliminary Examining Authority is competent and for which the fees have been paid, the international application shall be the subject of an international preliminary examination. The preliminary examination fee (§ 1.482(a)(1)) and the handling fee (§ 1.482(b)) shall be due within the applicable time limit set forth in PCT Rule 57.3.

(b) The Demand shall be made on a standardized form (PCT Rule 53). Copies of the printed Demand forms are available from the United States Patent and Trademark Office. Letters requesting printed Demand forms should be marked "Mail Stop PCT."

(c) Withdrawal of a proper Demand prior to the start of the international preliminary examination will entitle applicant to a refund of the preliminary examination fee minus the amount of the transmittal fee set forth in § 1.445(a)(1).

(d) The filing of a Demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7).

(e) Any Demand filed after the expiration of the applicable time limit set forth in PCT Rule 54<sup>bis</sup>.1(a) shall be considered as if it had not been submitted (PCT Rule 54<sup>bis</sup>.1(b)).<

Once applicant has **>**filed< an international application under Chapter I **>**of the PCT<, applicant has the right to file a demand for preliminary examination **>**under Chapter II of the Treaty<. The use of the term “Demand” distinguishes Chapter II from the “Request” under Chapter I. **>**It is not possible to file a demand unless a proper Chapter I “Request” for an international application has been filed. **>**Chapter I affords applicant the benefit of an international search, which includes an international search report and for international applications having an international filing date on or after January 1, 2004, a written opinion established by the International Searching Authority. The filing of a demand affords applicant examination of the application and allows applicant to file amendments to the description, claims and drawings to correct any defects, respond to any observations, or address negative findings with respect to any of the claims because of a lack of novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2)-(4) mentioned in the written opinion (Form PCT/ISA/237) established by the International Searching Authority. Thus, examination enables applicant to attempt to obtain a positive international preliminary examination report, which in some elected Offices is used as a basis for the issuance of a patent.<

The demand should be filed on **>**Form PCT/IPEA/401 along with the fee **>**calculation< sheet. For information on obtaining these forms free of charge, see MPEP § 1730.

## **1864.01 Amendments Filed **>**Under PCT Article 34< **>**[R-2]**

**>**

### *PCT Article 34.*

#### *Procedure Before the International Preliminary Examining Authority*

\*\*\*\*\*

(2)(b)The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary

examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.

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### *PCT Rule 66.*

#### *Procedure Before the International Preliminary Examining Authority*

\*\*\*\*\*

#### *66.8. Form of Amendments*

(a) Subject to paragraph (b), the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, the replacement sheet referred to in paragraph (a) may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

\*\*\*\*\*

#### *37 CFR 1.485. Amendments by applicant during international preliminary examination.*

(a) The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining Authority for reply to any notification under § 1.484(b) or to any written opinion. Any such amendments must:

(1) Be made by submitting a replacement sheet in compliance with PCT Rules 10 and 11.1 to 11.13 for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled; and

(2) Include a description of how the replacement sheet differs from the replaced sheet. Amendments that do not comply with PCT Rules 10 and 11.1 to 11.13 may not be entered.

(b) If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter

**>**Under PCT Article 34(2)(b), the applicant has a right to amend the claims, the description, and the drawings in the application before the International Preliminary Examining Authority (IPEA) before the international preliminary examination report is established. The amendment may be filed with the demand (PCT Article 34), within the period for reply to the



written opinion of the International Searching Authority (ISA), or within the period for reply to the written opinion of the IPEA.

See MPEP § 1871 or MPEP § 1871.01, as appropriate, regarding the processing of amendments filed prior to or at the start of international preliminary examination. See MPEP 1878.02 regarding amendments filed in reply to the written opinion of the ISA or IPEA. Amendments under PCT Article 34, like amendments under PCT Article 19 (see MPEP § 1853), may not include new matter and must be accompanied by a description of how the replacement sheet differs from the replaced sheet.<

## 1864.02 Applicant's Right To File a Demand

### *PCT Article 31.*

#### *Demand for International Preliminary Examination*

\*\*\*\*\*

(2)(a) Any applicant who is a resident or national, as defined in the Regulations, of a Contracting State bound by Chapter II, and whose international application has been filed with the receiving Office of or acting for such State, may make a demand for international preliminary examination.

\*\*\*\*\*

### *PCT Rule 54.*

#### *The Applicant Entitled to Make a Demand*

##### *54.1. Residence and Nationality*

(a) Subject to the provisions of paragraph (b), the residence or nationality of the applicant shall, for the purposes of Article 31(2), be determined according to Rule 18.1(a) and (b).

(b) The International Preliminary Examining Authority shall, in the circumstances specified in the Administrative Instructions, request the receiving Office or, where the international application was filed with the International Bureau as receiving Office, the national Office of, or acting for, the Contracting State concerned to decide the question whether the applicant is a resident or national of the Contracting State of which he claims to be a resident or national. The International Preliminary Examining Authority shall inform the applicant of any such request. The applicant shall have an opportunity to submit arguments directly to the Office concerned. The Office concerned shall decide the said question promptly.

##### *54.2. Right to Make a Demand*

The right to make a demand under Article 31(2) shall exist if the applicant making the demand or, if there are two or more applicants, at least one of them is a resident or national of a Contracting State bound by Chapter II and the international applica-

tion has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II.

(i) *[Deleted]*

(ii) *[Deleted]*

##### *54.3 International Applications Filed with the International Bureau as Receiving Office*

Where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), the International Bureau shall, for the purposes of Article 31(2)(a), be considered to be acting for the Contracting State of which the applicant is a resident or national.

##### *54.4. Applicant Not Entitled to Make a Demand*

If the applicant does not have the right to make a demand or, in the case of two or more applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.

If there is a sole applicant, he or she must be a resident or national of a Contracting State bound by Chapter II of the PCT. If there are two or more applicants, it is sufficient that one of them be a resident or national of a Contracting State bound by Chapter II, regardless of the elected State(s) for which each applicant is indicated. Only applicants for the elected States are required to be indicated in the Demand. The detailed requirements for the various indications required in connection with each applicant (name and address, telephone number, facsimile machine number or teleprinter address, nationality and residence) are the same as those required under PCT Rule 4 in connection with the Request. Note that any inventor who is not also an applicant is not indicated in the Demand.

If the recording of a change in the name or person has been requested under PCT Rule 92<sup>bis</sup>.1 before the Demand was filed, it is the applicant(s) of record at the time when the Demand is filed who must be indicated in the Demand.

## 1864.03 States Which May Be Elected [R-2]

### *PCT Article 31.*

#### *Demand for International Preliminary Examination*

\*\*\*\*\*

(4)(a) The demand shall indicate the Contracting State or States in which the applicant intends to use the results of the international preliminary examination ("elected States"). Additional Contracting States may be elected later. Election may relate only to Contracting States already designated under Article 4.

(b) Applicants referred to in paragraph (2)(a) may elect any Contracting State bound by Chapter II. Applicants referred to in paragraph (2)(b) may elect only such Contracting States bound by Chapter II as have declared that they are prepared to be elected by such applicants.

\*\*\*\*\*

>The filing of a demand on or after January 1, 2004, shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7). For demands filed before January 1, 2004, only those eligible states pursuant to PCT Article 31 indicated as being elected are elected.< Only PCT member states which have ratified or acceded to Chapter II and which were designated in the Request may be elected under Chapter II. The Assembly has taken no action to allow persons who are residents or nationals of a State not party to the PCT or not bound by Chapter II to make a Demand under Article 31(2)(b).

### 1864.04 Agent's Right To Act [R-2]

Any agent entitled to practice before the receiving Office where the international application was filed may represent the applicant before the international authorities (PCT Article 49).

If for any reason, the examiner needs to question the right of an attorney or agent to practice before the International Preliminary Examining Authority >(IPEA)<, the USPTO roster of registered attorneys and agents should be consulted. If the international application was filed with a receiving Office other than the United States, Form PCT/IPEA/410 may be used by the requesting IPEA to ask the receiving Office with which the international application was filed, whether the agent named in the international application has the right to practice before that Office.

The PCT Article and Regulations governing the right to practice are PCT Article 49 and PCT Rule 83.

### 1865 Filing of Demand [R-2]

*PCT Article 31.*

*Demand for International Preliminary Examination*

(1) On the demand of the applicant, his international application shall be the subject of an international preliminary examination as provided in the following provisions and the Regulations.

\*\*\*\*\*

(3) The demand for international preliminary examination shall be made separately from the international application. The demand shall contain the prescribed particulars and shall be in the prescribed language and form.

\*\*\*\*\*

(6)(a)The demand shall be submitted to the competent International Preliminary Examining Authority referred to in Article 32.

\*\*\*\*\*

Applicants should mail the Demand and appropriate fees directly to the International Preliminary Examining Authority >(IPEA)< they desire to prepare the International Preliminary Examination Report. United States applicants who have had the international search prepared by the European Patent Office >(EPO)< may also request the \*\*>EPO< to act as the \*\*>IPEA with some exceptions<. See MPEP § 1865.01.

Demands filed in the European Patent Office should be delivered to the European Patent Office Headquarters at Munich:

Location:

Erhardstr. 27  
D-80331 Munchen  
Germany

Mailing address:

D-80298 Munchen  
Germany

Demands filed in the United States Patent and Trademark Office should be addressed as follows:

Mailing address for delivery by the U.S. Postal Service:

\*\*>Mail Stop PCT  
Commissioner for Patents, Box PCT  
P.O. Box 1450  
Alexandria, VA 22313-1450<.

OR

If hand-carried directly to the USPTO PCT Operations Office:

>Mail Stop PCT<  
Commissioner for Patents\*\*  
2011 South Clark Place  
Crystal Plaza Two, 8th Floor Reception Area (PCT  
Operations)  
Arlington, VA 22202

The "Express Mail" provisions of 37 CFR 1.10 may be used to file a Demand under Chapter II in the USPTO. Applicants are advised that failure to comply with the provisions of 37 CFR 1.10 will result in the paper or fee being accorded the date of receipt and not the date of deposit. See MPEP § 513.

Demand for international preliminary examination may be submitted to the USPTO via facsimile. The Certificate of Mailing or Transmission practice under 37 CFR 1.8 CANNOT be used to file a Demand if the date of deposit is desired. If used, the date of the Demand will be the date of receipt in the USPTO. See MPEP § 513, § 1834, and § 1834.01.

All Demands filed in the USPTO must be in the English language.

PCT Rule 59.3 was amended July 1, 1998 to provide a safeguard in the case of a Demand filed with an International Preliminary Examining Authority which is not competent for the international preliminary examination of a particular international application. The USPTO \*->will< forward such a Demand to the International Bureau and the International Bureau will forward the Demand to a competent International Pre-

liminary Examining Authority pursuant to PCT Rule 59.3(c). The competent International Preliminary Examining Authority will process the Demand based on the date of receipt in the USPTO. See 37 CFR 1.416(c)(2).

### **CHOICE OF EXAMINING AUTHORITY**

\*\*>For most applications, U.S. residents and nationals may choose to have the international preliminary examination done by the EPO if the EPO served as the International Searching Authority (ISA). However, for certain applications including one or more claims directed to the field of biotechnology, the field of business methods or the field of telecommunication, the EPO will not act as a competent IPEA. See< MPEP § 1865.01.

The IPEA/US will serve as International Preliminary Examining Authority for U.S. residents and nationals if the U.S. or EPO served as ISA and the international application was filed in the U.S. Receiving Office or the International Bureau as receiving Office.

The IPEA/US will also serve as International Preliminary Examining Authority for residents or nationals of Barbados, Brazil, India, Israel, Mexico, New Zealand, the Philippines, Saint Lucia, South Africa, and Trinidad and Tobago if the U.S. was the International Searching Authority.

\*\*>

The demand must be filed directly with the competent International Preliminary Examining Authority or, if two or more Authorities are competent, with the one chosen by the applicant. The full name or two-letter code of that Authority may be indicated by the applicant on the line below:  
 IPEA/ US

**Rec'd PCT/PTO 24 FEB 2004**

**PCT**

**CHAPTER II**

**DEMAND**

under Article 31 of the Patent Cooperation Treaty:  
 The undersigned requests that the international application specified below be the subject of international preliminary examination according to the Patent Cooperation Treaty.

For International Preliminary Examining Authority use only

Identification of IPEA <u>/US</u>		Date of receipt of DEMAND <b>IPEA/US 24 FEB 2004 (24-02-04)</b>	
<b>Box No. I IDENTIFICATION OF THE INTERNATIONAL APPLICATION</b>		Applicant's or agent's file reference CMC-123-PCT	
International application No. PCT/US2004/000150	International filing date (day/month/year) 05 January 2004 (05.01.2004)	(Earliest) Priority date (day/month/year) 06 January 2003 (06.01.2003)	
Title of invention Electro-magnetic Fastener Driver			
<b>Box No. II APPLICANT(S)</b>			
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.) ACME FASTENER CORPORATION 300 Pratt Street Baltimore, Maryland 20726 United States of America		Telephone No. (410) 876-5432	Applicant's registration No. with the Office
		Facsimile No. (410) 876-5555	
		Teleprinter No.	
State (that is, country) of nationality: US		State (that is, country) of residence: US	
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.) JONES, Mary 1600 South Eads Street Arlington, Virginia 22202 United States of America			
State (that is, country) of nationality: US		State (that is, country) of residence: US	
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)			
State (that is, country) of nationality:		State (that is, country) of residence:	
<input type="checkbox"/> Further applicants are indicated on a continuation sheet.			

Form PCT/IPEA/401 (first sheet) (January 2004)

See Notes to the demand form

Sheet No. 2

International application No.  
PCT/US2004/000150

**Box No. III AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE**

The following person is  agent  common representative  
 and  has been appointed earlier and represents the applicant(s) also for international preliminary examination.  
 is hereby appointed and any earlier appointment of (an) agent(s)/common representative is hereby revoked.  
 is hereby appointed, specifically for the procedure before the International Preliminary Examining Authority, in addition to the agent(s)/common representative appointed earlier.

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

SMITH, John J.  
220 Jefferson Davis Highway  
Arlington, Virginia 22202-0234  
United States of America

Telephone No.  
(703) 557 3054

Facsimile No.  
(703) 557 3554

Teleprinter No.

Agent's registration No. with the Office  
77,777

Address for correspondence: Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.

**Box No. IV BASIS FOR INTERNATIONAL PRELIMINARY EXAMINATION**

**Statement concerning amendments:\***

1. The applicant wishes the international preliminary examination to start on the basis of:

- the international application as originally filed
- the description  as originally filed  
 as amended under Article 34
- the claims  as originally filed  
 as amended under Article 19 (together with any accompanying statement)  
 as amended under Article 34
- the drawings  as originally filed  
 as amended under Article 34

- 2.  The applicant wishes any amendment to the claims under Article 19 to be considered as reversed.
- 3.  The applicant wishes the start of the international preliminary examination to be postponed until the expiration of the applicable time limit under Rule 69.1(d).
- 4.  The applicant expressly wishes the international preliminary examination to start earlier than at the expiration of the applicable time limit under Rule 54bis.1(a).

\* Where no check-box is marked, international preliminary examination will start on the basis of the international application as originally filed or, where a copy of amendments to the claims under Article 19 and/or amendments of the international application under Article 34 are received by the International Preliminary Examining Authority before it has begun to draw up a written opinion or the international preliminary examination report, as so amended.

Language for the purposes of international preliminary examination: English

- which is the language in which the international application was filed.
- which is the language of a translation furnished for the purposes of international search.
- which is the language of publication of the international application.
- which is the language of the translation (to be) furnished for the purposes of international preliminary examination.

**Box No. V ELECTION OF STATES**

The filing of this demand constitutes the election of all Contracting States which are designated and are bound by Chapter II of the PCT.

Sheet No. . 3

International application No.  
PCT/US2004/000150

**Box No. VI CHECK LIST**

The demand is accompanied by the following elements, in the language referred to in Box No. IV, for the purposes of international preliminary examination:

- |  |   |       |        |
|--|---|-------|--------|
| 1. translation of international application                              | : | _____ | sheets |
| 2. amendments under Article 34   | : | 2     | sheets |
| 3. copy (or, where required, translation) of amendments under Article 19 | : | _____ | sheets |
| 4. copy (or, where required, translation) of statement under Article 19  | : | _____ | sheets |
| 5. letter  | : | 4     | sheets |
| 6. other (specify)   | : | _____ | sheets |

For International Preliminary Examining Authority use only  
received not received

- |                          |                          |
|--------------------------|--------------------------|
| <input type="checkbox"/> | <input type="checkbox"/> |
| <input type="checkbox"/> | <input type="checkbox"/> |
| <input type="checkbox"/> | <input type="checkbox"/> |
| <input type="checkbox"/> | <input type="checkbox"/> |
| <input type="checkbox"/> | <input type="checkbox"/> |
| <input type="checkbox"/> | <input type="checkbox"/> |

The demand is also accompanied by the item(s) marked below:

- |  |  |
|--|--|
| 1. <input checked="" type="checkbox"/> fee calculation sheet                             | 5. <input type="checkbox"/> statement explaining lack of signature                         |
| 2. <input type="checkbox"/> original separate power of attorney                          | 6. <input type="checkbox"/> sequence listing in computer readable form                     |
| 3. <input type="checkbox"/> original general power of attorney                           | 7. <input type="checkbox"/> tables in computer readable form related to a sequence listing |
| 4. <input type="checkbox"/> copy of general power of attorney; reference number, if any: | 8. <input type="checkbox"/> other (specify):   |

**Box No. VII SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE**

Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the demand).

*John J. Smith*  
John J. Smith

For International Preliminary Examining Authority use only

1. Date of actual receipt of DEMAND: <b>Rec'd PCT/PTO 24 FEB 2004</b> (24-02-04)	
2. Adjusted date of receipt of demand due to CORRECTIONS under Rule 60.1(b):	
3. <input type="checkbox"/> The date of receipt of the demand is AFTER the expiration of 19 months from the priority date and item 4 or 5, below, does not apply. <input type="checkbox"/> The applicant has been informed accordingly.	6. <input type="checkbox"/> The date of receipt of the demand is AFTER the expiration of the time limit under Rule 54bis.1(a) and item 7 or 8, below, does not apply.
4. <input type="checkbox"/> The date of receipt of the demand is WITHIN the time limit of 19 months from the priority date as extended by virtue of Rule 80.5.	7. <input type="checkbox"/> The date of receipt of the demand is WITHIN the time limit under Rule 54bis.1(a) as extended by virtue of Rule 80.5.
5. <input type="checkbox"/> Although the date of receipt of the demand is after the expiration of 19 months from the priority date, the delay in arrival is EXCUSED pursuant to Rule 82.	8. <input type="checkbox"/> Although the date of receipt of the demand is after the expiration of the time limit under Rule 54bis.1(a), the delay in arrival is EXCUSED pursuant to Rule 82.

For International Bureau use only

Demand received from IPEA on:

**CHAPTER II**

**PCT**

**FEE CALCULATION SHEET**

Annex to the Demand

International application No. <b>PCT/US2004/000150</b>	For International Preliminary Examining Authority use only <b>IPEA/US 24 FEB 2004</b> Date stamp of the IPEA (24-02-04)										
Applicant's or agent's file reference <b>CMC-123-PCT</b>											
Applicant <b>ACME FASTENER CORPORATION</b>											
<p align="center"><b>CALCULATION OF PRESCRIBED FEES</b></p>											
1. Preliminary examination fee .....	600 P										
2. Handling fee ( <i>Applicants from certain States are entitled to a reduction of 75% of the handling fee. Where the applicant is (or all applicants are) so entitled, the amount to be entered at H is 25% of the handling fee.</i> ) .....	162 H										
3. Total of prescribed fees Add the amounts entered at P and H and enter total in the TOTAL box .....	762 <hr/> TOTAL										
<p><b>MODE OF PAYMENT</b></p> <table style="width: 100%;"> <tr> <td><input checked="" type="checkbox"/> authorization to charge deposit account with the IPEA (see below)</td> <td><input type="checkbox"/> cash</td> </tr> <tr> <td><input type="checkbox"/> cheque</td> <td><input type="checkbox"/> revenue stamps</td> </tr> <tr> <td><input type="checkbox"/> postal money order</td> <td><input type="checkbox"/> coupons</td> </tr> <tr> <td><input type="checkbox"/> bank draft</td> <td><input type="checkbox"/> other (specify):</td> </tr> </table>		<input checked="" type="checkbox"/> authorization to charge deposit account with the IPEA (see below)	<input type="checkbox"/> cash	<input type="checkbox"/> cheque	<input type="checkbox"/> revenue stamps	<input type="checkbox"/> postal money order	<input type="checkbox"/> coupons	<input type="checkbox"/> bank draft	<input type="checkbox"/> other (specify):		
<input checked="" type="checkbox"/> authorization to charge deposit account with the IPEA (see below)	<input type="checkbox"/> cash										
<input type="checkbox"/> cheque	<input type="checkbox"/> revenue stamps										
<input type="checkbox"/> postal money order	<input type="checkbox"/> coupons										
<input type="checkbox"/> bank draft	<input type="checkbox"/> other (specify):										
<p><b>AUTHORIZATION TO CHARGE (OR CREDIT) DEPOSIT ACCOUNT</b>  <i>(This mode of payment may not be available at all IPEAs)</i></p> <table style="width: 100%;"> <tr> <td><input checked="" type="checkbox"/> Authorization to charge the total fees indicated above.</td> <td>IPEA/ <u>US</u></td> </tr> <tr> <td><input checked="" type="checkbox"/> <i>(This check-box may be marked only if the conditions for deposit accounts of the IPEA so permit)</i> Authorization to charge any deficiency or credit any overpayment in the total fees indicated above.</td> <td>Deposit Account No.: <u>12-3456</u></td> </tr> <tr> <td></td> <td>Date: <u>25 February 2004</u></td> </tr> <tr> <td></td> <td>Name: <u>John J. Smith</u></td> </tr> <tr> <td></td> <td>Signature: <u>John J. Smith</u></td> </tr> </table>		<input checked="" type="checkbox"/> Authorization to charge the total fees indicated above.	IPEA/ <u>US</u>	<input checked="" type="checkbox"/> <i>(This check-box may be marked only if the conditions for deposit accounts of the IPEA so permit)</i> Authorization to charge any deficiency or credit any overpayment in the total fees indicated above.	Deposit Account No.: <u>12-3456</u>		Date: <u>25 February 2004</u>		Name: <u>John J. Smith</u>		Signature: <u>John J. Smith</u>
<input checked="" type="checkbox"/> Authorization to charge the total fees indicated above.	IPEA/ <u>US</u>										
<input checked="" type="checkbox"/> <i>(This check-box may be marked only if the conditions for deposit accounts of the IPEA so permit)</i> Authorization to charge any deficiency or credit any overpayment in the total fees indicated above.	Deposit Account No.: <u>12-3456</u>										
	Date: <u>25 February 2004</u>										
	Name: <u>John J. Smith</u>										
	Signature: <u>John J. Smith</u>										

600.<sup>00</sup>

162.<sup>00</sup>

762.<sup>00</sup>

## 1865.01 The European Patent Office as an International Preliminary Examining Authority [R-2]

\*\*>The European Patent Office (EPO) has expressed the following limitations concerning its competency to act as an International Preliminary Examining Authority (IPEA). For updates or possible changes to these limitations, applicants should consult the PCT Newsletter which is available in electronic form from the web site ([www.wipo.int/pct/en/newslett/index.htm](http://www.wipo.int/pct/en/newslett/index.htm)) of the World Intellectual Property Organization.

### I. FIELD OF BIOTECHNOLOGY

The EPO is not a competent authority within the meaning of PCT Article 16(3)(b) and PCT Article 32(3), and will not carry out international preliminary examination in respect of any international application filed before January 1, 2004, where the corresponding demand was filed with the EPO on or after March 1, 2002, if the application: (A) was filed with the USPTO as receiving Office by a national or resident of the U.S.; or (B) was filed in the International Bureau (IB) as receiving Office by a national or resident of the U.S. (provided the application did not also identify as an applicant at its time of filing a national or resident of a European Patent Convention (EPC) Contracting State); where the application contains one or more claims relating to the field of biotechnology as defined by the following units of the International Patent Classification:<

C 12 M	Apparatus for enzymology or microbiology
C 12 N	Micro-organisms or enzymes; compositions thereof
C 12 P	Fermentation or enzyme-using processes to synthesise a desired chemical compound or composition or to separate optical isomers from a racemic mixture

C 12 Q	Measuring or testing processes involving enzymes or micro-organisms; compositions or test papers therefor; processes of preparing such compositions; condition-responsive control in microbiological or enzymological processes
C 07 K	Peptides
G 01 N 33/50 (including subdivisions)	Chemical analysis of biological material, e.g. blood, urine; testing involving biospecific ligand binding methods; immunological testing
A 61 K 39	Medicinal preparations containing antigens or antibodies
A 61 K 48	Medicinal preparations containing genetic material which is inserted into cells of the living body to treat genetic diseases; Gene therapy
A 01 H	New plants or processes for obtaining them; plant reproduction by tissue culture techniques

For information, U.S. classes covering the corresponding subject matter are listed below:

424	Drug, bio-affecting and body treating compositions
435	Chemistry: molecular biology and microbiology
436	Chemistry: analytical and immunological testing
514	Drug, bio-affecting and body treating compositions
530	Chemistry: natural resins or derivatives; peptides or proteins; lignins or reaction products thereof
536	Organic compounds—part of the class 532-570 series



800 Multicellular living organisms and unmodified parts thereof

930 Peptide or protein sequence

\*\*>

**II. FIELD OF BUSINESS METHODS**

The EPO is not a competent authority within the meaning of PCT Article 16(3)(b) and PCT Article 32(3), and will not carry out international preliminary examination in respect of any international application where the corresponding demand was filed with the EPO on or after March 1, 2002, if the application: (A) is filed with the USPTO as receiving Office by a national or resident of the U.S.; or (B) is filed in the IB as receiving Office by a national or resident of the U.S. (provided the application does not also identify as an applicant at its time of filing a national or resident of an EPC Contracting State); where the application contains one or more claims relating to the field of business methods as defined by the following units of the International Patent Classification:<

G 06 F 17/60 Digital computing or data processing equipment or methods, specially adapted for specific functions: administrative, commercial, managerial, supervisory or forecasting purposes. To the extent that the application falls under above mentioned subgroup but does not relate to business methods the EPO's competence is not affected.

For information, the U.S. class covering the corresponding subject matter is listed below:

705 Data processing: financial, business practice, management, or cost/price determination

\*\*>

**III. FIELD OF TELECOMMUNICATION**

The EPO is not a competent authority within the meaning of PCT Article 16(3)(b) and PCT Article 32(3), and will not carry out international preliminary examination in respect of any international application where the corresponding demand is filed with the EPO on or after March 1, 2002, and before July 1, 2004, where the application: (A) is filed with the USPTO as receiving Office by a national or resident of the U.S.; or (B) is filed in the IB as receiving Office by a national or resident of the U.S. (provided the application does not also identify as an applicant at its time of filing a national or resident of an EPC Contracting State); where the application contains one or more claims relating to the field of telecommunication as defined by the following unit of the International Patent Classification:<

H 04 Electric communication technique with the exception of H04N: Pictorial communication, e.g. television

For information, the U.S. classes covering the corresponding subject matter are listed below:

- 370 Multiplex communications
- 375 Pulse or digital communications
- 379 Telephonic communication
- 380 Cryptography
- 381 Electrical audio signal processing systems and devices
- 455 Telecommunications

Demands for international preliminary examination submitted to a non-competent authority are subject to PCT Rule 59.3. Applicants filing demands with the EPO in applications directed to the above subject matter will receive a notice from the EPO indicating that the demand is being forwarded to the IPEA/US under PCT Rule 59.3(f). Any fees paid by the applicant to

the EPO will be refunded to the applicant. Applicants have one month from the date of receipt of the demand transmitted to the IPEA under PCT Rule 59.3 to pay the handling fee (PCT Rule 57 and 37 CFR 1.482(b)) and the preliminary examination fee (PCT Rule 58 and 37 CFR 1.482(a)). See PCT Rules 57.3 and 58.1(b).

## 1866 Filling in of Headings on Chapter II Forms [R-2]

The examiner will encounter several different forms for use in the Chapter II preliminary examination phase and most of the forms will have the same "header" information to be provided.

The notes below list the common identifying information requested on the top of the first page of most of the forms:

Applicant's mailing address - this is usually the attorney's address taken from the file wrapper.

Applicant's or Agent's File Reference - this is the applicant's or agent's application reference (or docket number) which is composed of either letters or numbers, or both, provided this reference does not exceed twelve characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401. See Administrative Instructions Section 109.

International Application Number - this is the \*\* PCT application number as stamped and typed on the international application file wrapper and may also be found on the first page of the Demand, Form PCT/IPEA/401.

International Filing Date - this is the filing date printed on the international application file wrapper and may also be found on the first page of the Demand, Form PCT/IPEA/401.

Applicant (Name) - the first named applicant as set forth on the international application file wrapper and may also be found in box II of the Demand, Form PCT/IPEA/401.

## 1867 Preliminary Examination Fees [R-2]

37 CFR 1.481. *Payment of international preliminary examination fees.*

\*\*>

(a) The handling and preliminary examination fees shall be paid within the time period set in PCT Rule 57.3. The handling fee

or preliminary examination fee payable is the handling fee or preliminary examination fee in effect on the date of payment.<

(1) If the handling and preliminary fees are not paid within the time period set in PCT Rule 57.3, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of:

(i) Fifty percent of the amount of the deficient fees, but not exceeding an amount equal to double the handling fee; or

(ii) An amount equal to the handling fee (PCT Rule 58<sup>bis</sup>.2).

(2) The one-month time limit set in this paragraph to pay deficient fees may not be extended.

(b) If the payment needed to cover the handling and preliminary examination fees, pursuant to paragraph (a) of this section, is not timely made in accordance with PCT Rule 58<sup>bis</sup>.1(d), the United States International Preliminary Examination Authority will declare the Demand to be considered as if it had not been submitted.

The preliminary examination fee is for the benefit of the International Preliminary Examining Authority and the amount for the \*>USPTO< doing the preliminary examination is specified in 37 CFR 1.482. The fee is somewhat higher if the international search was performed by an authority other than the USPTO.

The handling fee is a fee for the benefit of the International Bureau and is collected by the International Preliminary Examining Authority. The amount of the handling fee is set out in the PCT schedule of fees which is annexed to the PCT Regulations.

The current amount of both the preliminary examination fee and the handling fee can be found in each weekly issue of the *Official Gazette*. Since supplements to the handling fee were deleted, no additional Chapter II fees are required other than any additional preliminary examination fee where additional inventions are determined to be present. The amount of this fee is also specified in 37 CFR 1.482 and in the weekly issues of the *Official Gazette*. See also PCT Rules 57 and 58.

The time limit for paying the preliminary examination fee and the handling fee is set forth in PCT Rules 57.3 and 58.1(b). >Effective January 1, 2004, for demands filed on or after January 1, 2004, 37 CFR 1.481(a) provides that the preliminary examination fee or handling fee payable is the preliminary examination fee or handling fee in effect on the date of payment. For demands filed before January 1, 2004, former< 37 CFR 1.481(a) provides that the preliminary examination fee or handling fee payable is the preliminary examination fee or handling fee in effect

on the date of receipt of the Demand in the United States International Preliminary Examining Authority. Effective July 1, 1998, PCT Rule 58bis.1(c) was added to consider the preliminary examination fee and handling fee to have been received before the expiration of the time limit set in PCT Rule 57.3 if the fees were submitted prior to the sending of an invitation to pay the fees.

Effective July 1, 1998, PCT Rule 58bis.1(a) was added to permit the International Preliminary Examining Authority to collect a late payment fee set forth in PCT Rule 58bis.2 if the fees for preliminary examination are not paid prior to the sending of the invitation to pay the fees. If the preliminary examination fee and handling fee are not paid within the time set in PCT Rule 57.3, applicants will be notified and given 1 month within which to pay the deficient fees plus a late payment fee equal to the greater of: (1) 50% of the amount of the deficient fees, but not exceeding an amount equal to double the handling fee; or (2) an amount equal to the handling fee. See 37 CFR 1.481(a)(1)(i) and (ii). The 1 month time limit set forth in 37 CFR 1.481(a)(1) to pay deficient fees may not be extended. See 37 CFR 1.481(a)(2).

If the payment needed to cover the preliminary examination fee and handling fee is not timely made in accordance with PCT Rule 58bis.1(d), the United States International Preliminary Examining Authority will declare the Demand to be considered as if it had not been submitted. In this regard, where the Authority sends a notification that the Demand is considered not to have been made and applicant's payment is received on the same date the notification is sent, the fee is considered to be late and the notification remains effective. The fee must antedate the notice in order for the notice not to be effective. See 37 CFR 1.481(b).

## 1868 Correction of Defects in the Demand [R-2]

*PCT Rule 60.*

*Certain Defects in the Demand or Elections*

### *60.1. Defects in the Demand*

\*\*>

(a) Subject to paragraphs (a<sup>bis</sup>) and (a<sup>ter</sup>), if the demand does not comply with the requirements specified in Rules 53.1,

53.2(a)(i) to (iii), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(a<sup>bis</sup>) For the purposes of Rule 53.4, if there are two or more applicants, it shall be sufficient that the indications referred to in Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who has the right according to Rule 54.2 to make a demand.

(a<sup>ter</sup>) For the purposes of Rule 53.8, if there are two or more applicants, it shall be sufficient that the demand be signed by one of them.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

(c) If the applicant does not comply with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(d) [Deleted]

(e) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs (a) to (c).<

(f) If the demand does not contain a statement concerning amendments, the International Preliminary Examining Authority shall proceed as provided for in Rules 66.1 and 69.1(a) or (b).

(g) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall invite the applicant to submit the amendments within a time limit fixed in the invitation and shall proceed as provided for in Rule 69.1(e).

\*\*

Defects in the Demand may be corrected. The type of correction determines whether the filing date of the Demand must be changed. The most common defects which result in the mailing of an invitation to correct are found in PCT Rules 53 and 55. If the applicant complies with the invitation, the Demand is considered as if it had been received on the actual filing date, i.e., the original date of receipt. See PCT Rule 60.1(b).

## 1869 Notification to International Bureau of Demand

*PCT Article 31.*

*Demand for International Preliminary Examination*

\*\*\*\*\*

(7) Each elected Office shall be notified of its election.

The International Preliminary Examining Authority, pursuant to PCT Rule 61, promptly notifies the International Bureau and the applicant of the filing of any Demand. The International Bureau in turn notifies each elected Office of their election and also notifies the applicant that such notification has been made.

## 1870 Priority Document and Translation Thereof [R-2]

*PCT Rule 66.*

*Procedure before the International Preliminary Examining Authority*

\*\*\*\*\*

### 66.7. Priority Document

\*\*>

(a) If the International Preliminary Examining Authority needs a copy of the earlier application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1, and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, the international preliminary examination report may be established as if the priority had not been claimed.<

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

\*\*\*\*\*

A copy of the priority document >and/or a translation thereof, if the priority document is not in

English< may be required by the examiner if necessary because of an intervening reference \*\*.

## 1871 >Processing Amendments Filed Under Article 19 and Article 34 Prior to or at the Start of International Preliminary Examination in International Applications Having an International Filing Date On or After January 1, 2004 [R-2]

[Note: The regulations under the PCT were changed effective January 1, 2004. Corresponding changes were made to Title 37 of the Code of Federal Regulations. See *January 2004 Revision of Patent Cooperation Treaty Application Procedure*, 68 FR 59881 (Oct. 20, 2003), 1276 O.G. 6 (Nov. 11, 2003). International applications filed before January 1, 2004, will continue to be processed under the procedures in effect on their international filing date. The discussion of the procedures in effect prior to January 1, 2004, has been moved from this section to newly added MPEP § 1871.01.]

*PCT Rule 62.*

*Copy of the Written Opinion by the International Searching Authority and of Amendments Under Article 19 for the International Preliminary Examining Authority*

### 62.1. Copy of Written Opinion by International Searching Authority and of Amendments Made Before the Demand Is Filed

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority.

(i) a copy of the written opinion established under Rule 43<sup>bis</sup>.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and

(ii) a copy of any amendment under Article 19, and any statement referred to in that Article, unless that Authority has indicated that it has already received such a copy.

### 62.2. Amendments Made After the Demand Is Filed

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments and any statement referred to in that Article. In any case, the International Bureau shall promptly transmit a copy of such amendments and statement to that Authority

*PCT Rule 62<sup>bis</sup>.**Translation for the International Preliminary Examining Authority of the Written Opinion of the International Searching Authority**62<sup>bis</sup>.1. Translation and Observations*

(a) Upon request of the International Preliminary Examining Authority, the written opinion established under Rule 43<sup>bis</sup>.1 shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau.

(b) The International Bureau shall transmit a copy of the translation to the International Preliminary Examining Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

(c) The applicant may make written observations as to the correctness of the translation and shall send a copy of the observations to the International Preliminary Examining Authority and to the International Bureau.

The documents making up the international application may include amendments of the claims filed by the applicant under PCT Article 19. Article 19 amendments are exclusively amendments to the claims and these amendments can only be made after the search report has been established. Article 19 amendments will be transmitted to the International Preliminary Examining Authority (IPEA) by the International Bureau. The International Bureau marks, in the upper right-hand corner of each replacement sheet submitted under PCT Article 19, the international application number, the date on which that sheet was received under PCT Article 19 and, in the middle of the bottom margin, the words "AMENDED SHEET (ARTICLE 19)." If a demand for international preliminary examination has already been submitted, the applicant should preferably, at the time he/she files the Article 19 amendments, also file a copy of the amendments with the IPEA.

The IPEA starts the international preliminary examination when it is in possession of the demand; the required fees; if the applicant is required to furnish a translation under PCT Rule 55.2, that translation; either the international search report or a notice of the declaration by the International Searching Authority under PCT Article 17(2)(a) that no international search report will be established; and the written opinion established under PCT Rule 43<sup>bis</sup>.1, provided that the IPEA shall not start the international preliminary examination before the expiration of the later of three

months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date unless the applicant expressly requests an earlier start, with the exception of the following situations:

(A) If the competent IPEA is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the IPEA so wishes, start at the same time as the international search, provided that the examination is not to be postponed according to the statement concerning PCT Article 19 amendments (PCT Rule 53.9(b));

(B) Where the statement concerning amendments contains an indication that amendments under PCT Article 19 are to be taken into account (PCT Rule 53.9(a)(i)), the IPEA does not start the international preliminary examination before it has received a copy of the amendments concerned. These will be transmitted to the IPEA by the International Bureau. The applicant should preferably, at the time he/she files the demand, also file a copy of the amendments with the IPEA;

(C) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (PCT Rule 53.9(b)), the IPEA does not start the international preliminary examination before:

(1) it has received a copy of any amendments made under PCT Article 19;

(2) it has received a notice from the applicant that he/she does not wish to make amendments under PCT Article 19; or

(3) the later of three months from the transmittal of the international search report and written opinion or of the declaration that no international search report will be established; or the expiration of 22 months from the priority date;

whichever occurs first;

(D) Where the statement concerning amendments contains an indication that amendments under PCT Article 34 are submitted with the demand (PCT Rule 53.9(c)) but no such amendments are, in fact, submitted, the IPEA does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invi-

tation referred to in PCT Rule 60.1(g) has expired, whichever occurs first.

The applicant has the right to amend the claims, the description, and the drawings, in the prescribed manner and before the start of international preliminary examination. The amendment must not go beyond the disclosure in the international application as filed. These amendments are referred to as PCT Article 34(2)(b) amendments. It should be noted that PCT Article 19 amendments are strictly amendments to the claims made during the Chapter I search phase while PCT Article 34(2)(b) amendments to the description, claims, and drawings are made during the Chapter II examination phase.

When amendments to the description, claims, or drawings are made under PCT Rule 66.8, they may be accompanied by an explanation. These amendments may have been submitted to avoid possible objections as to lack of novelty or lack of inventive step in view of the citations listed in the international search report and the observations on novelty, inventive step, and industrial applicability set forth in the written opinion established by the International Searching Authority; to meet any objections noted by the International Searching Authority under PCT Article 17(2)(a)(ii) (i.e., that all or at least some claims do not permit a meaningful search) or under PCT Rule 13 (i.e., that there is a lack of unity of invention); or to meet objections that may be raised for some other reason, e.g., to remedy some obscurity which the applicant himself/herself has noted in the original documents.

The amendments are made by the applicant of his/her own volition. This means that the applicant is not restricted to amendments necessary to remedy a defect in his/her international application. It does not, however, mean that the applicant should be regarded as free to amend in any way he/she chooses. Any amendment must not add subject matter which goes beyond the disclosure of the international application as originally filed. Furthermore, it should not itself cause the international application as amended to be objectionable under the PCT, e.g., the amendment should not introduce obscurity.

As a matter of policy and to ensure consistency in handling amendments filed under PCT Articles 19 and 34 of the PCT, the following guidelines for processing these amendments have been established:

(A) Any argument or amendment which complies with 37 CFR 1.485(a) will be considered;

(B) Amendments filed after the demand:

(1) will be considered if filed before the later of: three months from the transmittal of either the international search report or a notice of the declaration by the International Searching Authority under PCT Article 17(2)(a) that no international search report will be established, and the written opinion established under PCT Rule 43<sup>bis</sup>.1; or the expiration of 22 months from the priority date, unless the applicant expressly requests an earlier start to international preliminary examination,

(2) will be considered if filed before the application is docketed to the examiner,

(3) may be considered if filed after docketing. The examiner has discretion to consider such amendments if the examiner determines that the amendment places the application in better condition for examination or the examiner determines that the amendment should otherwise be entered;

(C) Amendments and/or arguments filed after expiration of the period for response to the written opinion:

(1) will be considered if the amendment was requested by the examiner,

(2) need not be taken into account for the purposes of a further written opinion or the international preliminary examination report if they are received after the examiner has begun to draw up that opinion or report. The applicant may file an amendment to the description, the claims and the drawings in the prescribed manner, even if this is outside the time period set for reply in PCT Rule 66.2(d). Since the examiner may begin to draw up the final report once the time period set for reply in PCT Rule 66.2(d) expires, amendments filed after the expiration of the time period set in for reply in PCT Rule 66.2(d) may or may not be considered. There may be situations where it is advisable, to the extent possible, to take such amendments or arguments into account, for example, where the international preliminary examination report has not yet been completed and it is readily apparent to the examiner that consideration of the late-filed response would result in the issuance of a favorable report.

It is expected, due to the relatively short time period for completion of preliminary examination,

that the Chapter II application will be taken up promptly after docketing to the examiner for preparation of either a further written opinion, if necessary, or the final report.

Amendments timely filed but misdirected or otherwise late reaching the examiner will be considered as in the case of regular domestic applications and may require a supplemental written opinion and/or final report.

Clearly, these guidelines offer the examiner flexibility. The examiner should be guided by the overriding principle that the international preliminary examination report (Form PCT/IPEA/409) should be established with as few written opinions as possible and resolution of as many issues as possible consistent with the goal of a timely and quality report.

See also Administrative Instructions Section 602 regarding processing of amendments by the IPEA.

**1871.01 < Processing Amendments Filed Under Article 19 and Article 34 Prior to or at the Start of International Preliminary Examination >in International Applications Having an International Filing Date Before January 1, 2004< [R-2]**

>[Note: If the international filing date is on or after January 1, 2004, the amendments are processed as indicated in MPEP § 1871 rather than as indicated in this section.]

*Former<*

*PCT Rule 62.*

*Copy of Amendments Under Article 19 for the International Preliminary Examining Authority*

*62.1. Amendments Made Before the Demand Is Filed*

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit a copy of any amendments under Article 19, and any statement referred to in that Article, to that Authority, unless that Authority has indicated that it has already received such a copy.

*62.2. Amendments Made After the Demand Is Filed*

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably,

at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments and any statement referred to in that Article. In any case, the International Bureau shall promptly transmit a copy of such amendments and statement to that Authority.

The documents making up the international application may include amendments of the claims filed by the applicant under PCT Article 19. PCT Article 19 amendments are exclusively amendments to the claims and these amendments can only be made after the search report has been established. PCT Article 19 amendments will be transmitted to the International Preliminary Examining Authority by the International Bureau. If a Demand for international preliminary examination has already been submitted, the applicant should preferably, at the time he files the PCT Article 19 amendments, also file a copy of the amendments with the International Preliminary Examining Authority. In the event that the time limit for filing amendments under PCT Article 19, as provided in PCT Rule 46.1, has not expired and the Demand includes a statement that the start of the international preliminary examination is to be postponed under PCT Rule 53.9(b), the international preliminary examination should not start before the examiner receives a copy of any amendments made under PCT Article 19 or a notice from the applicant that he does not wish to make amendments under PCT Article 19, or before the expiration of 20 months from the priority date, whichever occurs first.

The applicant has the right to amend the claims, the description, and the drawings, in the prescribed manner and before the start of international preliminary examination. The amendment must not go beyond the disclosure in the international application as filed. These amendments are referred to as PCT Article 34(2)(b) amendments. It should be noted that PCT Article 19 amendments are strictly amendments to the claims made during the Chapter I search phase while PCT Article 34(2)(b) amendments to the description, claims, and drawings are made during the Chapter II examination phase.

When amendments to the description, claims, or drawings are made under PCT Rule 66.8, they may be accompanied by an explanation. These amendments may have been submitted to avoid possible objections as to lack of novelty or lack of inventive step in view

of the citations listed in the international search report; to meet any objections noted by the International Searching Authority under PCT Article 17(2)(a)(ii) (i.e., that all or at least some claims do not permit a meaningful search) or under PCT Rule 13 (i.e., that there is a lack of unity of invention); or to meet objections that may be raised for some other reason, e.g., to remedy some obscurity which the applicant himself/herself has noted in the original documents.

The amendments are made by the applicant of his/her own volition. This means that the applicant is not restricted to amendments necessary to remedy a defect in his/her international application. It does not, however, mean that the applicant should be regarded as free to amend in any way he/she chooses. Any amendment must not add subject matter which goes beyond the disclosure of the international application as originally filed. Furthermore, it should not itself cause the international application as amended to be objectionable under the PCT, e.g., the amendment should not introduce obscurity.

As a matter of policy and to ensure consistency in handling amendments filed under PCT Articles 19 and 34 of the PCT, the following guidelines for processing these amendments have been established:

(A) Any amendment which complies with 37 CFR 1.485(a) will be considered;

(B) Amendments filed after the Demand

(1) will be considered if filed before the application is docketed to the examiner,

(2) may be considered if filed after docketing. The examiner has discretion to consider such amendments if the examiner determines that the amendment places the application in better condition for examination or the examiner determines that the amendment should otherwise be entered;

(C) Amendments filed after expiration of the period for response to the written opinion

(1) will be considered if the amendment was requested by the examiner,

(2) may be considered if the examiner determines that the amendment places the application in better condition for examination or the examiner determines that the amendment should otherwise be entered.

It is expected, due to the relatively short time period for completion of preliminary examination, that the Chapter II application will be taken up for preparation of the written opinion promptly after docketing to the examiner and taken up for preparation of the final report promptly after the time expires for response to the written opinion (i.e., after allowing for mail processing). The examiner is not obliged to consider amendments or arguments which are filed after he/she has taken up the case for preparation of the written opinion or the final report.

Amendments timely filed but misdirected or are otherwise late reaching the examiner will be considered as in the case of regular domestic applications and may require a supplemental written opinion and/or final report.

Clearly, these guidelines offer the examiner flexibility. The examiner should be guided by the overriding principle that the final report (the PCT/IPEA/409) should be established with as few written opinions as possible and resolution of as many issues as possible consistent with the goal of a timely and quality report.

See also Administrative Instructions Section 602 regarding processing of amendments by the International Preliminary Examining Authority.

## **1872 Transmittal of Demand to the Examining Corps**

*PCT Administrative Instruction 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.

When the PCT International Application Processing Division has finished processing of the papers and fees filed with a complete Demand, a copy of the Demand and other papers are forwarded to the appropriate Technology Center for examination. The documents will be placed in the Search Copy file wrapper before forwarding to the examiner.

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## 1874 Determination if International Preliminary Examination Is Required and Possible [R-2]

*PCT Article 34.*

*Procedure Before the International Preliminary Examining Authority*

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(4)(a) If the International Preliminary Examining Authority considers

(i) that the international application relates to a subject matter on which the International Preliminary Examining Authority is not required, under the Regulations, to carry out an international preliminary examination, and an international preliminary examination, and in the particular case decides not to carry out such examination, or

(ii) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness), or industrial applicability, of the claimed invention, the said authority shall not go into the questions referred to in Article 33(1) and shall inform the applicant of this opinion and the reasons therefor.

(b) If any of the situations referred to in subparagraph (a) is found to exist in, or in connection with, certain claims only, the provisions of that subparagraph shall apply only to the said claims.

There are instances where international preliminary examination is not required because of the nature of the subject matter claimed and also because the claims are so indefinite that no examination is possible. Such instances should seldom occur, especially since most problems of this nature would have already been discovered and indicated at the time of the international search.

If it is found that certain claims of an international application relate to subject matter for which no international preliminary examination is required, \*\*>check the appropriate box on a Form PCT/IPEA/408 in an application having an international filing date before January 1, 2004, or on a Form PCT/IPEA/408 or a Form PCT/IPEA/409, as appropriate, in an application having an international filing date on or after January 1, 2004 (see MPEP § 1860)<. It should be noted that subject matter which is normally examined under U.S. national procedure should also be examined as an International Preliminary Examining Authority.

The examiner should check the appropriate box if it is found that the description, claims or drawings are

so unclear, or the claims are so inadequately supported by the description that no opinion could be formed as to the novelty, inventive step (nonobviousness) and industrial applicability of the claimed invention.

Subject matter not searched under Chapter I will not be the subject of a preliminary examination under Chapter II. This is so even if claims which were not searched under Chapter I are modified to be acceptable for examination.

## 1875 Unity of Invention Before the International Preliminary Examining Authority [R-2]

*PCT Article 34.*

*Procedure before the International Preliminary Examining Authority*

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(3)(a) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it may invite the applicant, at his option, to restrict the claims so as to comply with the requirement or to pay additional fees.

\*\*\*\*\*

(c) If the applicant does not comply with the invitation referred to in subparagraph (a) within the prescribed time limit, the International Preliminary Examining Authority shall establish an international preliminary examination report on those parts of the international application which relate to what appears to be the main invention and shall indicate the relevant facts in the said report. The national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office.

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*37 CFR 1.488. Determination of unity of invention before the International Preliminary Examining Authority.*

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for reply, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary Examining Authority may raise the objection of lack of unity of invention.

The examiner will usually begin the preliminary examination by checking the international application for unity of invention. The international preliminary examination will only be directed to inventions which have been searched by the International Searching Authority. All claims directed to inventions which have not been searched by the International Searching Authority will not be considered by the International Preliminary Examining Authority. If the examiner in the International Preliminary Examining Authority finds lack of unity of invention in the claims to be examined, an invitation is normally prepared and sent to the applicant requesting the payment of additional fees or the restriction of the claims on Form PCT/IPEA/405. Such an invitation will include the identification of what the examiner considers to be the “main invention” which will be examined if no additional fees are paid or restriction is made by the applicant.

The procedure before the International Preliminary Examining Authority regarding lack of unity of invention is governed by PCT Article 34(3)(a) through (c), PCT Rule 68 (see also PCT Rule 70.13), and 37 CFR 1.475 and 1.488. It should be noted that

in most instances lack of unity of invention will have been noted and reported upon by the International Searching Authority which will have drawn up an international search report >(and for international applications having a filing date on or after January 1, 2004, a written opinion)< based on those parts of the international application relating to the invention, or unified linked group of inventions, first mentioned in the claims (“main invention”) >, unless the applicant has paid additional fees<. If the applicant has paid additional search fees, additional inventions would also have been searched. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority (37 CFR 1.488(b)(2)).

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If the examiner determines that unity of invention is lacking, there are two options:

(A) The examiner may conduct an international preliminary examination covering all the claimed and previously searched inventions and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees (PCT Rule 68.1), or

(B) The examiner may invite the applicant to restrict the claims, so as to comply with the requirement, or pay additional fees, pointing out the categories of invention found >using Form PCT/IPEA/405 or USPTO/499 (telephone practice). See MPEP § 1875.01<. The invitation to restrict or pay additional fees shall state the reasons for which the international application is considered as not complying with the requirement of unity of invention. (PCT Rule 68.2). Inventions not previously searched will not be considered or included in the invitation.

The written opinion, if any, and the international preliminary examination report must be established on all inventions for which examination fees have been paid.

If the applicant fails to reply to the invitation to restrict the claims or pay additional examination fees due to lack of unity of invention >(by not paying the additional fees or by not restricting the claims either sufficiently or at all)<, the written opinion>, if any,< and international preliminary examination report must be established on the claims directed to what appears to be the main invention (PCT Article 34(3)(c)). The

main invention, in case of doubt, is the first claimed invention for which an international search report has been issued by the International Searching Authority. The main invention, as viewed by the examiner, must be set forth on Form PCT/IPEA/405.

>If the applicant timely complies with the invitation to pay additional fees even under protest, or to restrict the claims, the examiner carries out international preliminary examination on those claimed inventions for which additional fees have been paid or to which the claims have been restricted. It should be noted that the national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office (PCT Article 34(3)(c)).< Whether or not the question of unity of invention has been raised by the International Searching Authority, it may be considered by the examiner when serving as an authorized officer of the International Preliminary Examining Authority. In the examiner's consideration, all documents cited by the International Searching Authority should be taken into account and any additional relevant documents considered. However, there are cases of lack of unity of invention, where, compared with the procedure of inviting the applicant to restrict the international application or pay additional fees (PCT Rule 68.2), little or no additional effort is involved in establishing the written opinion>, if any,< and the international preliminary examination report for the entire international application. Then reasons of economy may make it advisable for the examiner to use the option referred to in PCT Rule 68.1 by choosing not to invite the applicant to restrict the claims or to pay additional fees.

Unity of invention is defined by 37 CFR 1.475 which describes the circumstances in which the requirement of unity of invention is considered fulfilled.

### **1875.01 Preparation of Invitation Concerning Unity [R-2]**

The "Invitation to restrict or pay additional fees" Form PCT/IPEA/405 is used to invite the applicant, at his/her option, to restrict the claims to comply with

the requirements of unity of invention or to pay additional examination fees. In addition, the examiner must explain the reasons why the international application is not considered to comply with the requirement of unity of invention. The examiner must also specify, on Form PCT/IPEA/405, at least one group or groups of claims which, if elected, would comply with the requirement for unity of invention.

#### **INVITATION >TO RESTRICT OR PAY ADDITIONAL FEES<**

In the space provided on form PCT/IPEA/405, the examiner should identify the disclosed inventions by claim numerals and indicate which disclosed inventions are so linked as to form a single general inventive concept, thereby complying with the requirement of unity of invention. For example, claims to different categories of invention such as a product, claims to a process specifically adapted for the manufacture of the product and a claim for a use of the product would be considered related inventions which comply with the unity of invention requirement, whereas a claim to an apparatus for making the product in the same application would be considered a second invention for which additional fees would be required. The reasons for holding that unity of invention is lacking must be specified. See 37 CFR 1.475 and \*\*>Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO's web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm))<.

Also, the examiner should specify the main invention and claims directed thereto which will be examined if the applicant fails to restrict or pay additional fees. The main invention, in case of doubt, is the first claimed invention or related invention before the International Preliminary Examining Authority for which a search fee has been paid and an international search report has been prepared.

The examiner should indicate the total amount of additional fees required for examination of all claimed inventions.

In the box provided at the top of the form, the time limit for response is set according to PCT Rule 68.2, normally a 1 month time limit >(not shorter than one month but not longer than two months)<. Extensions of time are not permitted.

Since the space provided on Form PCT/IPEA/405 is limited, supplemental attachment sheets, supplied by the examiner, with reference back to the specific section, should be incorporated whenever necessary.

### AUTHORIZED OFFICER

Form PCT/IPEA/405 must be signed by an examiner with at least partial signatory authority.

### TELEPHONIC RESTRICTION PRACTICE

Telephone practice may be used \*\* to allow applicants to elect an invention to be examined or to pay additional fees \*\* if:

(A) \*\* >Applicant or applicant's legal representative has a USPTO< deposit account,

(B) Applicant or the legal representative or agent orally agrees to charge the additional fees to the account, and

(C) A complete record of the telephone conversation is included with the written opinion>, if any, or the international preliminary examination report,< including:

- (1) Examiner's name;
- (2) Authorizing attorney's name;
- (3) Date of conversation;
- (4) Invention elected and/or inventions for which additional fees paid; and

(5) Deposit account number and amount to be charged.

\*\*

When the telephone practice is used in making lack of unity requirements, it is critical that the examiner orally inform applicant that there is no right to protest the holding of lack of unity of invention for any group of invention(s) for which no additional examination fee has been paid.

The examiner must further orally advise applicant that any protest to the holding of lack of unity or the amount of additional fee required must be filed in writing no later than one month from the mailing date of the written opinion or the international preliminary examination report if the lack of unity holding is first mailed with the IPER because there was no written opinion. The examiner should fill in the information on Form USPTO/499 "Chapter II PCT Telephone Memorandum for Lack of Unity" as a record of the telephonic holding of lack of unity.

>If applicant refuses to either restrict the claims to one invention or authorize payment of additional fees, or if applicant does not have a deposit account, Form PCT/IPEA/405 should be prepared and mailed to applicant.

If a written invitation is required, the examiner should, if possible, submit that written invitation to the TC for review and mailing within 7 days from the date the international application is charged to the examiner.

See MPEP § 1850 for form paragraphs for lack of unity in international applications.<

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### 1875.02 Reply to Invitation Concerning Lack of Unity of Invention [R-2]

*PCT Administrative Instruction 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, at the latest together with the international preliminary examination report, any decision which it has taken under Rule 68.3(c) on the protest of the applicant against payment of the additional fee 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.

*37 CFR 1.489. Protest to lack of unity of invention before the International Preliminary Examining Authority.*

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Preliminary Examining Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both.

\*\*

(b) >Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.<

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international preliminary examination report when forwarded to the Elected Offices, may notify the International Preliminary Examining Authority to that effect any time prior to the issuance of the international preliminary examination report. Thereafter, such notification should be directed to the International Bureau.

Applicant may reply by paying some or all additional fees or by restricting the claims to one invention. If applicant makes no reply within the set time limit, the international preliminary examination will proceed on the basis of the main invention only.

If applicant has paid an additional fee or fees, a protest to the holding of lack of unity of invention may be filed with the International Preliminary Examining Authority.

#### **NOTIFICATION OF DECISION ON PROTEST**

Form PCT/IPEA/420 is used by the Technology Center (TC) to inform the applicant of the decision regarding applicant's protest on the payment of additional fees concerning unity of invention.

#### **NOTIFICATION**

The TC checks the appropriate box, i.e., 1 or 2. If box 2 is checked, a clear and concise explanation as to why the protest concerning the unity of invention was found to be unjustified must be given.

Since the space is limited, supplemental attachment sheet(s) should be incorporated whenever necessary.

#### **AUTHORIZED OFFICER**

Form PCT/IPEA/420 must be signed by a TC Director. See MPEP § 1002.02(\*>c<), >item (2)<.

### **1876 Notation of Errors and Informalities by the Examiner [R-2]**

*PCT Administrative Instruction 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.

Although the examiner is not responsible for discovering errors in the international application, if any errors come to the attention of the examiner, they \*>may< be noted and called to the applicant's attention. The examiner may invite applicant to rectify obvious errors using Form PCT/IPEA/411. Errors that are not obvious may be called to applicant's attention in \*>Box< VII of PCT/IPEA/408.

#### **AUTHORIZED OFFICER**

Form PCT/IPEA/408 and \*>Form PCT/IPEA/411< must be signed by an examiner having at least partial signatory authority.

### **1876.01 Request for Rectification and Notification of Action Thereon [R-2]**

#### **NOTIFICATION OF DECISION CONCERNING REQUEST FOR RECTIFICATION**

The rectification of obvious errors is governed by PCT Rules 91.1 and 66.5.

#### **NOTIFICATION**

If the applicant requests correction of any obvious errors in the international application or in any paper submitted to the International Preliminary Examining Authority, other than in the request, any acceptable correction should be authorized by using Form PCT/IPEA/412.

The procedure governing the rectification of obvious errors is set forth in PCT rules 91.1(d) and 26.4\*. Rectification may be made on the request of the applicant. Any rectification offered to the international preliminary examining authority may be stated in a letter addressed to the international preliminary examining authority if the rectification is of such a nature that it can be transferred from the letter to the international application without adversely affecting the clarity and direct reproducibility of the sheet on to which the rectification is to be transferred; otherwise, the applicant is required to submit a replacement sheet embodying the rectification and the letter accompanying the replacement sheet must draw attention to the differences between the replaced sheet and the replacement sheet.

The examiner after fully considering applicant's Request for Rectification of an obvious error, will notify applicant of the action taken on Form PCT/IPEA/412. Since the space provided is limited, supplemental sheet(s) should be incorporated whenever necessary.

#### **AUTHORIZED OFFICER**

Form PCT/IPEA/412 must be signed by an examiner having at least partial signatory authority.

## 1877 Nucleotide and/or Amino Acid Sequence Listings During the International Preliminary Examination

If the International Preliminary Examining Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but (A) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, or (B) applicant has not furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, the International Preliminary Examining Authority may request the applicant to furnish such sequence listing or listing in computer readable form in accordance with the Administrative Instructions. PCT Rule 13<sup>ter</sup>.1(e).

## 1878 >Preparation of the Written Opinion of the International Preliminary Examining Authority in International Applications Having an International Filing Date On or After January 1, 2004 [R-2]

[Note: The regulations under the PCT were changed effective January 1, 2004. Corresponding changes were made to Title 37 of the Code of Federal Regulations. See *January 2004 Revision of Patent Cooperation Treaty Application Procedure*, 68 FR 59881 (Oct. 20, 2003), 1276 O.G. 6 (Nov. 11, 2003). The discussion of the procedures in effect for international applications filed prior to January 1, 2004, has been moved from this section to newly added MPEP § 1878.01.]

### *PCT Article 34.*

#### *Procedure Before the International Preliminary Examining Authority*

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(2)(c) The applicant shall receive at least one written opinion from the International Preliminary Examining Authority unless such Authority considers that all of the following conditions are fulfilled:

(i) the invention satisfies the criteria set forth in Article 33(1),

(ii) the international application complies with the requirements of this Treaty and the Regulations in so far as checked by that Authority,

(iii) no observations are intended to be made under Article 35(2), last sentence.

\*\*\*\*\*

#### *37 CFR 1.484. Conduct of international preliminary examination.*

(a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves an inventive step (is non-obvious) and is industrially applicable.

(b) International preliminary examination will begin in accordance with PCT Rule 69.1.

(c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to reply.

(e) The written opinion established by the International Searching Authority under PCT Rule 43bis.1 shall be considered to be a written opinion of the United States International Preliminary Examining Authority for the purposes of paragraph (d) of this section.

(f) The International Preliminary Examining Authority may establish further written opinions under paragraph (d) of this section.

(g) If no written opinion under paragraph (d) of this section is necessary, or if no further written opinion under paragraph (f) of this section is to be established, or after any written opinion and the reply thereto or the expiration of the time limit for reply to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.

(h) An applicant will be permitted a personal or telephone interview with the examiner, which may be requested after the filing of a Demand, and must be conducted during the period between the establishment of the written opinion and the establishment of the international preliminary examination report. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant or, if not filed by applicant be made of record in the file by the examiner.

(i) If the application whose priority is claimed in the international application is in a language other than English, the United States International Preliminary Examining Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish an English translation of the priority document within two months from the date of the invitation. If the

translation is not furnished within that time limit, the international preliminary report may be established as if the priority had not been claimed.

*PCT Rule 66.*

*Procedure Before the International Preliminary Examining Authority*

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*66.1<sup>bis</sup> Written Opinion of the International Searching Authority*

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(a) Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43<sup>bis</sup>.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

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*66.4 Additional Opportunity for Submitting Amendments or Argument*

(a) If the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and Rules 66.2 and 66.3 shall apply.

\*\*\*\*\*

In applications having an international filing date on or after January 1, 2004, a written opinion must be prepared by the International Searching Authority at the same time the international search report is prepared. The United States International Preliminary Examining Authority (IPEA) will consider the written opinion of the International Searching Authority to be the first written opinion of the IPEA and as such in most instances no further written opinion need be issued by the U.S. examiner handling the international preliminary examination before establishment of the international preliminary examination report, even if there are objections outstanding. The examiner is to take into consideration any comments or amendments made by the applicant when he/she establishes the international preliminary examination report. However, a further written opinion must be prepared if applicant files a response which includes a persuasive argument that the written opinion issued by the International Searching Authority was improper because of a negative opinion with respect to a lack of novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2)-(4); and which results in the examiner considering any of the

claims to lack novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2)-(4) based on new art not necessitated by any amendment. Such a further written opinion should be established on the Written Opinion of the International Preliminary Examining Authority (Form PCT/IPEA/408).

**BOX NO. I. — BASIS OF OPINION**

Box I of the Form PCT/IPEA/408 should be filled out in accordance with the instructions for Box I of Form PCT/ISA/237 provided in MPEP § 1845.01.

Additionally, for the purpose of completing Box I, item 2, of Form PCT/IPEA/408, substitute and/or rectified sheets of the specification and drawings filed during Chapter I proceedings are considered to be originally filed/furnished pages and should be listed as originally filed/furnished pages. Only those amendments or rectifications to the specification and drawings filed on the date of demand or after the filing of a demand should be listed as pages “received by this Authority on\_\_\_\_\_.” Substitute and/or rectified sheets of claims filed during the Chapter I proceedings are also considered to be originally filed/furnished pages and should be listed as originally filed/furnished pages. However, amended sheets of claims filed under PCT Article 19 in response to the international search report are to be indicated as pages as amended (together with any statement) under PCT Article 19. The International Bureau (IB) marks, in the upper right-hand corner of each replacement sheet submitted under PCT Article 19, the international application number, the date on which that sheet was received under PCT Article 19 and, in the middle of the bottom margin, the words “AMENDED SHEET (ARTICLE 19).” See Administrative Instructions Section 417. Only those pages of claims filed on the date of demand or after the filing of a demand should be listed as pages “received by this Authority on\_\_\_\_\_.”

The examiner must also indicate, in Box I, item 3, if any of the amendments filed resulted in the cancellation of any pages of the description, any of the claims or drawings, or any pages of the sequence listing and/or any tables related to the sequence listing. If the examiner considers any of the amendments to go beyond the original disclosure, the examiner must point this out in Box I, item 4 and explain the reasons for this determination in the Supplemental Box.

**BOX NO. II. — PRIORITY**

Where the priority document is provided by the applicant in compliance with PCT Rule 17.1 after the preparation of the search report and the written opinion of the ISA, any written opinion of the IPEA and/or the international preliminary examination report should reconsider the validity of the priority claim. Where the priority document is a foreign document and it is not already in the file, the IPEA may request a copy of the document from the IB and, if necessary, a translation from the applicant. In the meantime, if the outcome of the examination requires the issuing of an opinion, that opinion should be issued without waiting to obtain the priority document and/or the translation. An appropriate comment should be made under the heading “Additional observations, if necessary” in Box II of the written opinion. If such a copy of the priority document and/or the translation is not available because of non-compliance by the applicant with PCT Rule 17.1 and/or PCT Rule 66.7 (b) within the relevant time period, and if the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, any written opinion of the IPEA and/or the IPER may be established as if the priority had not been claimed where there is a pertinent intervening reference. This is indicated by checking the appropriate boxes in item 1 of Box No. II in the opinion or report.

**BOX NO. III. — NON-ESTABLISHMENT OF OPINION ON NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY**

Box III of Form PCT/IPEA/408 is intended to cover situations where some or all claims of an application are so unclear or inadequately supported by the description that the question of novelty, inventive step (nonobviousness), and industrial applicability cannot be considered, or where the international application or claims thereof relate to subject matter which does not require international preliminary examination, or where no international search report has been established for the claims.

Box III of Form PCT/IPEA/408 should be filled out in accordance with the instructions for Box III of Form PCT/ISA/237 provided in MPEP § 1845.01.

**BOX NO. IV. — LACK OF UNITY OF INVENTION**

Box IV of Form PCT/IPEA/408 should be used by the examiner to notify applicant that lack of unity of invention has been found.

If in reply to an invitation to restrict, applicant restricted the claims to a particular group, check the first box under subsection 1. If applicant paid additional fees for examination of additional inventions, check the second box under subsection 1. If the additional fees were paid under protest, check the third box under subsection 1. If applicant neither restricted nor paid additional fees in reply to the objection of lack of unity of invention, check the fourth box under subsection 1.

Subsection 2 of Box IV is to be completed if the examiner determines that unity of invention is lacking but chooses not to invite the applicant to restrict or pay additional fees.

Subsection 3 of Box IV is to be completed to indicate which claims were the subject of international preliminary examination. If all claims are to be examined, check the first box under subsection 3. If only some of the claims were the subject of international preliminary examination, check the second box under subsection 3 and identify the claim numbers.

**BOX NO. V. — REASONED STATEMENT WITH REGARD TO NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY OF CLAIMS**

In Box V, the examiner must list in summary form all claims with regard to the criteria of novelty (N), inventive step (IS), and industrial applicability (IA), and should be filled out in accordance with the instructions for Box V of Form PCT/ISA/237 provided in MPEP § 1845.01.

In applications where the examiner has determined that an additional written opinion is required, the application should be searched by the examiner at least to the point of bringing the previous search up to date. Prior art discovered in a search and applied in a reasoned statement in Box V must be made of record in Box V. Prior art already cited on the international



search report need not again be cited on the written opinion or international preliminary examination report. The subsequently discovered prior art is to be cited in compliance with PCT Rule 43.5 and Administrative Instructions Section 503 using the same citation format used on the international search report. Two copies of each newly cited reference should be included in the PCT Chapter II file when it is sent to PCT Operations for the mailing of the form PCT/IPEA/408. One of the copies of the newly cited reference will be sent to the applicant and one copy will be retained in the Chapter II file.

#### **BOX NO. VI. — CERTAIN DOCUMENTS CITED**

Box VI provides a convenient manner of listing two different types of newly discovered documents which were not applied in Box V:

(A) Published documents - by the application number or patent number as well as the publication date, filing date and priority date; and

(B) Nonwritten disclosure - by the kind of disclosure, date of the disclosure and the date of the written disclosure referring to the nonwritten disclosure.

As with the newly cited art in Box V, the subsequently discovered prior art is to be cited in compliance with PCT Rule 43.5 and Administrative Instructions Section 503 using the same citation format used on the international search report. Two copies of each newly cited reference should be included in the PCT Chapter II file when it is sent to PCT Operations for the mailing of the Form PCT/IPEA/408. One of the copies of the newly cited reference will be sent to the applicant and one copy will be retained in the Chapter II file.

#### **BOX VII. — CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION**

In Box VII, defects in the form and content of the international application are identified. Box VII should be filled out in accordance with the instructions for Box No. VII of Form PCT/ISA/237 provided in MPEP § 1845.01.

#### **BOX NO. VIII. — CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION**

In Box VIII, the examiner notifies the applicant of observations made as to the clarity of the claims, the description, the drawings, or on the question whether the claims are fully supported by the description. Box VIII should be filled out in accordance with the instructions for Box VIII of Form PCT/ISA/237 provided in MPEP § 1845.01.

#### **TIME TO REPLY**

An invitation by the International Preliminary Examining Authority (IPEA) to applicant to reply to the examiner's written opinion will normally set a 2-month time limit for reply.

However, PCT Rule 69.2 sets forth time limits for the IPEA to establish the international preliminary examination report (IPER). Accordingly, in applications filed on or after January 1, 2004, a 1-month time limit should be set by the examiner in situations when a 2-month time limit would risk delaying the date of establishment of the IPER beyond:

(A) 28 months from the priority date; or

(B) 6 months from the time provided under PCT Rule 69.1 for the start of international preliminary examination; or

(C) 6 months from the date of receipt by the IPEA of the translation furnished under PCT Rule 55.2.

As a general rule, a 1-month time limit for reply to the written opinion should be set by the examiner if the written opinion (Form PCT/IPEA/408) has not been completed by the examiner within 24 months following the application's "priority date" as defined in PCT Article 2.

The United States rules pertaining to international preliminary examination of international applications do not provide for any extension of time to reply to a written opinion. See 37 CFR 1.484 (d)-(f) and MPEP § 1878.02.

#### **AUTHORIZED OFFICER**

Every written opinion must be signed by an examiner having at least partial signatory authority.

## 1878.01 < Preparation of the Written Opinion >in International Applications Having an International Filing Date Before January 1, 2004< [R-2]

>[Note: In international applications filed on or after January 1, 2004, the first written opinion is usually prepared by the International Searching Authority (see MPEP §§ 1845-1845.01), and a further written opinion may be prepared by the International Preliminary Examining Authority (see MPEP § 1878.)<

### *PCT Article 34.*

#### *Procedure Before the International Preliminary Examining Authority*

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(2)(c) The applicant shall receive at least one written opinion from the International Preliminary Examining Authority unless such Authority considers that all of the following conditions are fulfilled:

- (i) the invention satisfies the criteria set forth in Article 33(1),
- (ii) the international application complies with the requirements of this Treaty and the Regulations in so far as checked by that Authority,
- (iii) no observations are intended to be made under Article 35(2), last sentence.

\*\*\*\*\*

>Former<

#### *37 CFR 1.484. Conduct of international preliminary examination.*

(a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves an inventive step (is non-obvious) and is industrially applicable.

(b) International preliminary examination will begin promptly upon receipt of a proper Demand in an application for which the United States International Preliminary Examining Authority is competent, for which the fees for international preliminary examination (§ 1.482) have been paid, and which requests examination based on the application as filed or as amended by an amendment which has been received by the United States International Preliminary Examining Authority. Where a Demand requests examination based on a PCT Article 19 amendment which has not been received, examination may begin at 20 months without receipt of the PCT Article 19 amendment. Where a Demand requests examination based on a PCT Article 34 amendment which has not been received, applicant will be noti-

fied and given a time period within which to submit the amendment.

- (1) Examination will begin after the earliest of:
  - (i) Receipt of the amendment;
  - (ii) Receipt of applicant's statement that no amendment will be made; or
  - (iii) Expiration of the time period set in the notification.
- (2) No international preliminary examination report will be established prior to issuance of an international search report.
- (c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to reply.

(e) If no written opinion under paragraph (d) of this section is necessary, or after any written opinion and the reply thereto or the expiration of the time limit for reply to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.

(f) An applicant will be permitted a personal or telephone interview with the examiner, which must be conducted during the non-extendable time limit for reply by the applicant to a written opinion. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant as a part of the reply to the written opinion or, if applicant files no reply, be made of record in the file by the examiner.

(g) If the application whose priority is claimed in the international application is in a language other than English, the United States International Preliminary Examining Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish an English translation of the priority document within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

A written opinion must be prepared if the examiner:

- (A) Considers that the international application has any of the defects described in PCT Article 34(4);
- (B) Considers that the report should be negative with respect to any of the claims because of a lack of novelty, inventive step (non-obviousness) or industrial applicability;
- (C) Notices any defects in the form or contents of the international application under the PCT;

(D) Considers that any amendment goes beyond the disclosure in the international application as originally filed;

(E) Wishes to make an observation on the clarity of the claims, the description, the drawings or to question whether the claims are fully supported by the description;

(F) Decides not to carry out the international preliminary examination on a claim for which no international search report was issued; or

(G) Considers that no acceptable amino acid sequence listing is available in a form that would allow a meaningful international preliminary examination to be carried out.

The applicant must be notified on Form PCT/IPEA/408 of the defects found in the application. The examiner is further required to fully state the reasons for his/her opinion (PCT Rule 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)), setting a time limit for the reply of normally 2 months.

The examiner should insert the words "first" or "second", as the case may be, in the space provided on page 1 of the written opinion.

## ITEM I. BASIS OF OPINION

Applicant has two opportunities to amend the international application prior to international preliminary examination. Under PCT Article 19, the applicant is entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within 2 months of the mailing of the international search report. See PCT Rule 46.1. Applicant is also permitted to make amendments before the International Preliminary Examining Authority under PCT Article 34(2)(b) and PCT Rule 66.1. Any amendment, however, that does not accompany the filing of the Demand but is filed later may not be considered unless it reaches the examiner before he/she takes up the application for examination.

>When completing Box I, item 1, of Form PCT/IPEA/408, the examiner must indicate whether or not the opinion has been established on the basis of the international application in the language in which it was filed. If a translation was furnished for the purpose of the search, this must be indicated.< For the purpose of completing Box I, Item 1, \*\* substitute

and/or rectified sheets of the specification and drawings filed during Chapter I proceedings are considered to be originally filed pages/sheets and should be listed as originally filed pages/sheets. Only those amendments or rectifications to the specification and drawings filed on the date of Demand or after the filing of a Demand should be listed as later filed pages/sheets. Substitute and/or rectified sheets of claims filed during the Chapter I proceedings are also considered to be originally filed pages/sheets and should be listed as originally filed pages/sheets. However, amended sheets of claims filed under Article 19 in response to the international search report are to be indicated as pages/sheets as amended under Article 19. Only those amendments, or rectifications to the claims filed on the date of Demand or after the filing of a Demand should be listed as later filed pages/sheets. \*\*>The examiner must also indicate, in Box I, item 3, if any of the amendments filed resulted in the cancellation of any pages of the description, any of the claims or drawings, or any pages of the sequence listing and/or any tables related to the sequence listing. If the examiner considers any of the amendments to go beyond the original disclosure, the examiner must point this out in Box I, item 4 and explain the reasons for this determination in the Supplemental Box.<

## ITEM II. PRIORITY

Item II of Form PCT/IPEA/408 is to inform applicant of non-establishment of a request for priority.

If applicant fails to furnish a copy or translation of the earlier application, whose priority has been claimed, within the time limit set by the examiner pursuant to PCT Rule 66.7, check box No. 1 and then check the first box of the subsection if applicant failed to furnish a copy of the earlier application whose priority has been claimed, and check the second box in the subsection if applicant failed to furnish a translation of the earlier application whose priority has been claimed.

When the claim for priority has been found invalid (e.g., the claimed priority date is more than one year prior to the international filing date and the notification under PCT Rule 4.10(d) has been provided or all claims are directed to inventions which were not described and enabled by the earlier application), check box No. 2 of Item II and indicate why the claim for priority has been found invalid following No. 3

“Additional observations”. The examiner is reminded that when some claims in an international application are directed to an invention which was disclosed in the earlier application, the priority claim is valid provided that a copy and/or translation of the earlier application have/has been filed and the filing date of the earlier application is one year or less from the filing date of the international application.

### **ITEM III. NON-ESTABLISHMENT OF OPINION ON NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY**

Item III of Form PCT/IPEA/408 is intended to cover situations where some or all claims of an application are so unclear or inadequately supported by the description that the question of novelty, inventive step (nonobviousness), and industrial applicability cannot be considered, or where the international application or claims thereof relate to subject matter which does not require international preliminary examination, or where no international search report has been established for the claims.

If some or all of the claims of an application relate to subject matter which does not require international preliminary examination, check the appropriate box, indicate which claims relate to that subject matter and specify the reasons.

If some or all of the claims of an application are so unclear that no meaningful opinion could be formed, check the appropriate box, indicate which claims are unclear and specify the reasons.

If some or all of the claims are so inadequately supported by the description that no meaningful opinion could be formed, check the appropriate box.

If no international search report has been established for certain claims, check the appropriate box and indicate the claim numbers.

### **ITEM IV. LACK OF UNITY OF INVENTION**

Item IV of Form PCT/IPEA/408 should be used by the examiner to notify applicant that lack of unity of invention has been found.

If in reply to an invitation to restrict, applicant restricted the claims to a particular group, check the first box under subsection 1.

If applicant paid additional fees for examination of additional invention, check the second box under subsection 1.

If the additional fees were paid under protest, check the third box under subsection 1.

If applicant neither restricted nor paid additional fees in reply to the objection of lack of unity of invention, check the fourth box under subsection 1.

Subsection 2 of Item IV is to be completed if the examiner determines that unity of invention is lacking but chooses not to invite the applicant to restrict or pay additional fees.

Subsection 3 of Item IV is to be completed to indicate which claims were the subject of international preliminary examination.

If all claims are to be examined, check the first box under subsection 3.

If only some of the claims were the subject of international preliminary examination, check the second box under subsection 3 and identify the claim numbers.

### **ITEM V. REASONED STATEMENT WITH REGARD TO NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY OF CLAIMS**

In Item V, the examiner must list in summary form all claims with regard to the criteria of novelty (N), inventive step (IS), and industrial applicability (IA).

Item V is the main purpose of the Written Opinion. All claims without fatal defects are treated on the merits in Item V as to novelty, inventive step (nonobviousness) and industrial applicability.

The treatment of claims in Item V is similar in format to an Office action in a U.S. national patent application except that the words “rejection” and “patentability” are never used in a written opinion. On the international level, all written opinions are non-binding and a patent does not issue; what does issue is an international preliminary examination report (IPER), which is nonbinding on the Elected States.

Examiner statements in Item V can be positive or negative. If the claims define over the prior art and meet the test of novelty, inventive step (nonobviousness) and industrial applicability, a statement equivalent to detailed reasons for allowance in a corresponding U.S. national application should be provided, indicating how the claims meet the tests of novelty, inventive step and industrial applicability.

Form paragraphs 18.04 and 18.04.01 may be used for this purpose.

*¶ 18.04 Meets Novelty and Inventive Step*

Claim [1] the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest [2].

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and insert the verb --meet-- or --meets--, as appropriate.
2. In bracket 2, insert the details of the claimed subject matter that render it unobvious over the prior art.
3. If the claims also meet the industrial applicability criteria set out in PCT Article 33(4), this form paragraph should be followed by form paragraph 18.04.01.
4. If the claims do not meet the industrial applicability criteria set out in PCT Article 33(4), this form paragraph should be followed by form paragraph 18.03.

*¶ 18.04.01 Meets Industrial Applicability*

Claim [1] the criteria set out in PCT Article 33(4), and thus [2] industrial applicability because the subject matter claimed can be made or used in industry.

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --meet-- or -- meets--, as appropriate.
2. In bracket 2, insert --have-- or --has--, as appropriate.
3. If the claims meet all of the requirements of PCT Article 33(2)-(4), use form paragraph 18.04 before this form paragraph to provide positive statements for novelty and inventive step under PCT Article 33(2)-(3).
4. If the claims have industrial applicability but lack novelty and inventive step, use this form paragraph and additionally use form paragraph 18.01.
5. If the claims have industrial applicability and novelty but lack inventive step, use this form paragraph and additionally use one or more of form paragraphs 18.02, 18.02.01 and 18.02.02, as appropriate.
6. If the claims do not have industrial applicability, use form paragraph 18.03 instead of this form paragraph.

If, on the other hand it is the opinion of the examiner that some or all claims lack novelty, inventive step, or industrial applicability, specific reasons must be given similar to those used in U.S. national applications. If the claims lack inventive step over a combination of references, the reasons must explain why one of ordinary skill in the art would have been motivated to combine the teachings of the applied references.

Form paragraphs 18.01, 18.02, 18.02.01, 18.02.02, and 18.03 may be used, as appropriate, to explain the negative statements listed in Item V.

*¶ 18.01 Lacks Novelty*

Claim [1] novelty under PCT Article 33(2) as being anticipated by [2].

**Examiner Note:**

1. In bracket 1, pluralize ‘claim’ if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of prior art relied upon.

*¶ 18.02 Lacks Inventive Step - One Reference*

Claim [1] an inventive step under PCT Article 33(3) as being obvious over [2]. [3]

**Examiner Note:**

1. In bracket 1, pluralize ‘claim’ if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of prior art relied upon.
3. In bracket 3, add reasoning.

*¶ 18.02.01 Lacks Inventive Step - Two References*

Claim [1] an inventive step under PCT Article 33(3) as being obvious over [2] in view of [3]. [4]

**Examiner Note:**

1. In bracket 1, pluralize ‘claim’ if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of PRIMARY prior art relied upon.
3. In bracket 3, insert name of SECONDARY prior art relied upon.
4. In bracket 4, add reasoning.

*¶ 18.02.02 Lacks Inventive Step - Additional Reference*

Claim [1] an inventive step under PCT Article 33(3) as being obvious over the prior art as applied in the immediately preceding paragraph and further in view of [2]. [3]

**Examiner Note:**

1. This form paragraph may follow either 18.02 or 18.02.01.
2. In bracket 1, pluralize ‘claim’ if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
3. In bracket 2, insert name of additional prior art relied upon.
4. In bracket 3, add reasoning.

*¶ 18.03 Lacks Industrial Applicability*

Claim [1] industrial applicability as defined by PCT Article 33(4). [2]

**Examiner Note:**

1. In bracket 1, pluralize ‘claim’ if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, add reasoning.

Examiners are encouraged to indicate any amendments which applicant could present which would avoid a negative statement in the international preliminary examination report.

All international applications where an examination has been demanded should be searched by the examiner at least to the point of bringing the previous search up to date. Prior art discovered in a search and applied in an Item V statement must be made of record in Item V. Prior art already cited on the international search report need not again be cited on the written opinion or international preliminary examination report. The subsequently discovered prior art is to be cited in compliance with PCT Rule 43.5 and Administrative Instructions Section 503 using the same citation format used on the international search report. Two copies of each newly cited reference should be included in the PCT Chapter II file when it is sent to PCT Operations for the mailing of the form PCT/IPEA/408. One of the copies of the newly cited reference will be sent to the applicant and one copy will be retained in the Chapter II file.

## ITEM VI. CERTAIN DOCUMENTS CITED

Item VI provides a convenient manner of listing two different types of documents:

(A) Published documents - by the application number or patent number as well as the publication date, filing date and priority date; and

(B) Nonwritten disclosure - by the kind of disclosure, date of the disclosure and the date of the written disclosure referring to the nonwritten disclosure.

## ITEM VII. CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION

In Item VII, defects in the form and content of the international application are identified.

Examples of defects that would be listed in Item VII are:

(A) Informalities such as misplaced and/or omitted drawing numerals, misspelled words, grammatical errors, etc.

(B) \*\* Improper multiple-dependent claims (PCT Rule 6.4) if not indicated under Item III.

The following form paragraphs are used in Box VII of PCT/IPEA/408 or PCT/IPEA/409 "Certain defects in the international application" for noting technical defects.

### ¶ 18.08 Drawing Objections - Defects

The drawings are objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or content thereof: [1]

#### Examiner Note:

In bracket 1, insert identification of defects in drawings.

### ¶ 18.08.01 Drawing Is Required

The subject matter of this application admits of illustration by drawing to facilitate understanding of the invention. Applicant is required under PCT Article 7(1) to furnish a drawing.

### ¶ 18.09 Description Defective

The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof: [1]

#### Examiner Note:

In bracket 1, insert the technical problem, e.g., misspelled word.

### ¶ 18.10 Claims Defective

Claim [1] objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or contents thereof: [2]

#### Examiner Note:

1. In bracket 1, pluralize 'claim' if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, identify the technical deficiency.

## ITEM VIII. CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION

In Item VIII, the examiner notifies the applicant of observations made as to the clarity of the claims, the description, the drawings, or on the question whether the claims are fully supported by the description.

If the claims, the description, or the drawings are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the question of novelty, inventive step (nonobviousness) or industrial applicability, the applicant is so informed in Item III (PCT Article 34(4)(a)(ii)). Reasons for the examiner's opinion that the claims, description and drawings, etc., lack clarity must also be provided.

If the above situation is found to exist in certain claims only, the provisions of PCT Article 34(4)(ii) shall apply to those claims only.

If the lack of clarity of the claims, the description, or the drawings is of such a nature that it is possible to form a meaningful opinion on the claimed subject matter, then it is required that the examiner consider the claims and render a written opinion on novelty,

inventive step, and industrial applicability in Item V of Form PCT/IPEA/408.

Since the claims of an international application are not subject to a rejection on either art or indefiniteness consistent with U.S. practice, observations by the examiner with regard to clarity of the claims, the description and the drawings will be treated in the form of an objection in the written opinion in Item VIII.

The following form paragraphs are used in Box VIII “Certain observations on the international application” of PCT/IPEA/408 and PCT/IPEA/409 for noting objections which are substantive rather than merely technical in nature.

*¶ 18.11 Drawing Objections - Lack Clarity*

The drawings are objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 7 because: [1]

**Examiner Note:**

In bracket 1, insert reasons why the drawings lack clarity, e.g., inaccurate showing.

*¶ 18.12.01 Claims Objectionable - Inadequate Written Description*

Claim [1] objected to as lacking clarity under PCT Rule 66.2(a)(v) because the claim [2] not fully supported by the description. The application, as originally filed, did not describe: [3]

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --is-- or --are--, as appropriate.
2. In bracket 2, pluralize “claim” if needed, and insert the verb -is- or --are--.
3. In bracket 3, identify subject matter not described in the application as filed.

*¶ 18.13.01 Claims Objectionable - Non-Enabling Disclosure*

Claim [1] objected to as lacking clarity under PCT Rule 66.2(a)(v) because the claim [2] not fully supported by the description. The description does not disclose the claimed invention in a manner sufficiently clear and complete for the claimed invention to be carried out by a person skilled in the art because: [3]

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, pluralize “claim” if needed, insert the verb --is-- or --are--.
3. In bracket 3, identify the claimed subject matter that is not enabled and explain why it is not enabled.

*¶ 18.14.01 Claims Objectionable - Lack of Best Mode*

Claim [1] objected to under PCT Rule 66.2(a)(v) because the claim [2] not fully supported by the description. The description fails to set forth the best mode contemplated by the applicant for carrying out the claimed invention as required by PCT Rule 5.1(a)(v) because: [3].

**Examiner Note:**

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, pluralize “claim” if needed, and insert the appropriate verb --is-- or --are--.
3. In bracket 3, insert the objection and reasons.

*¶ 18.15 Claims Objectionable - Indefiniteness*

Claim [1] objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because claim [2] indefinite for the following reason(s): [3]

**Examiner Note:**

1. In brackets 1 and 2, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 3, insert reasons.

**TIME TO REPLY**

An invitation by the International Preliminary Examining Authority (IPEA) to applicant to reply to the examiner’s written opinion will normally set a 2-month time limit for reply.

However, PCT Rule 69.2 sets forth time limits for the IPEA to establish the international preliminary examination report (IPER). Accordingly, a 1-month time limit should be set by the examiner in situations when a 2-month time limit would risk delaying the date of establishment of the IPER beyond:

- (A) 28 months from the priority date; or
- (B) 8 months from the date of payment of the handling fee referred to in PCT Rule 57.1 and the preliminary examination fee referred to in PCT Rule 58.1(a); or
- (C) 8 months from the date of receipt by the IPEA of the translation furnished under PCT Rule 55.2.

As a general rule, a 1-month time limit for reply to the written opinion should be set by the examiner if the written opinion (Form PCT/IPEA/408) has not been completed by the examiner within 24 months following the application’s “priority date” as defined in PCT Article 2.

The United States rules pertaining to international preliminary examination of international applications do not provide for any extension of time to reply to a first written opinion. See 37 CFR 1.484(d) and MPEP § 1878.02.

### AUTHORIZED OFFICER

Every written opinion must be signed by an examiner having at least partial signatory authority.

The first document prepared by the examiner in most international applications during the international preliminary examination proceedings will be the written opinion. Normally only in those international applications where all the formal matters are proper and the claims are directed to inventions which have novelty, inventive step and industrial applicability will an international preliminary examination report be established without a written opinion having been issued first.

### 1878.01(a) Prior Art \*\*>for Purposes of the Written Opinion and the International Preliminary Examination Report< [R-2]

*PCT Article 33.*

*The International Preliminary Examination*

\*\*\*\*\*

(6) The international preliminary examination shall take into consideration all the documents cited in the international search report. It may take into consideration any additional documents considered to be relevant in the particular case.

*PCT Rule 64.*

*Prior Art for International Preliminary Examination*

#### 64.1. Prior Art

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) For the purposes of paragraph (a), the relevant date will be:

(i) subject to item (ii), the international filing date of the international application under international preliminary examination;

(ii) where the international application under international preliminary examination validly claims the priority of an earlier application, the filing date of such earlier application.

#### 64.2. Non-Written Disclosures

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means ("non-written disclosure") before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the non-written disclosure shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.

#### 64.3. Certain Published Documents

In cases where any application or any patent which would constitute prior art for the purposes of Article 33(2) and (3) had it been published prior to the relevant date referred to in Rule 64.1 was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in Rule 70.10.

>The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43<sup>bis</sup>.1(b).<

The relevant date for the purpose of considering prior art is defined in PCT Rule 64.1(b) as the international filing date or, where the international application contains a valid claim for priority, that date of priority.

>When a potentially relevant document has been published between a claimed priority date of the application and its international filing date, the examiner is required to consider whether the claimed priority date is valid for the purposes of determining the "relevant date" of the claims in the international application. Note that if there is time left for the applicant to perfect, correct or add a priority claim but there is insufficient time for the examiner to make a proper determination as to whether the priority claim is valid, due to the need to issue a timely written opinion by the International Searching Authority, the "relevant date" for the purposes of the written opinion will be based on the claimed priority date. See Chapter 11 of the International Search and Preliminary Examination Guidelines, which may be obtained from WIPO's website ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm)).< In cases where any application or any



patent which would constitute prior art for the purpose of international preliminary examination as to novelty and inventive step (nonobviousness) was published on or after the relevant date of the international application under consideration but was filed earlier than the relevant date or claimed the priority of an earlier application which was filed prior to the relevant date, the published application or patent is not to be considered part of the prior art for the purpose of international preliminary examination as to novelty and inventive step. Nevertheless, these documents are to be listed on Form PCT/IPEA/409 under the heading "CERTAIN PUBLISHED DOCUMENTS".

In determining whether there is inventive step, account should be taken of what the applicant acknowledges in his/her description as known. Such acknowledged prior art should be regarded as correct and used during preliminary examination where appropriate.

For oral or nonwritten disclosure, see PCT Rules 64.2 and 70.9.

### **1878.01(a)(1) Novelty \*\*>for Purposes of the Written Opinion and the International Preliminary Examination Report< [R-2]**

Novelty is defined in PCT Article 33(2).

#### *PCT Article 33.*

##### *The International Preliminary Examination*

\*\*\*\*\*

(2) For the purposes of the international preliminary examination, a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.

\*\*\*\*\*

>The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43<sup>bis</sup>.1(b).<

### **1878.01(a)(2) Inventive Step \*\*>for Purposes of the Written Opinion and the International Preliminary Examination Report< [R-2]**

Inventive step is defined in PCT Article 33(3).

#### *PCT Article 33.*

##### *The International Preliminary Examination*

\*\*\*\*\*

(3) For purposes of the international preliminary examination, a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.

\*\*\*\*\*

#### *PCT Rule 65.*

##### *Inventive Step or Non-Obviousness*

#### *65.1.Approach to Prior Art*

For the purposes of Article 33(3), the international preliminary examination shall take into consideration the relation of any particular claim to the prior art as a whole. It shall take into consideration the claim's relation not only to individual documents or parts thereof taken separately but also its relation to combinations of such documents or parts of documents, where such combinations are obvious to a person skilled in the art.

#### *65.2.Relevant Date*

For the purposes of Article 33(3), the relevant date for the consideration of inventive step (non-obviousness) is the date prescribed in Rule 64.1.

>The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43<sup>bis</sup>.1(b).<

### **1878.01(a)(3) Industrial Applicability \*\*>for Purposes of the Written Opinion and the International Preliminary Examination Report< [R-2]**

Industrial applicability is defined in PCT Article 33(4).

#### *PCT Article 33.*

##### *The International Preliminary Examination*

\*\*\*\*\*

(4) For the purposes of the international preliminary examination, a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. "Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.

\*\*\*\*\*

>The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43<sup>bis</sup>.1(b).<

## 1878.02 Reply to the Written Opinion >of the ISA or IPEA< [R-2]

### *PCT Article 34.*

#### *Procedure Before the International Preliminary Examining Authority*

\*\*\*\*\*

\*\*>

(2)(d)< The applicant may respond to the written opinion.

\*\*\*\*\*

### *PCT Rule 66.*

#### *Procedure before the International Preliminary Examining Authority*

\*\*\*\*\*

#### *66.3. Formal Response to the International Preliminary Examining Authority*

(a) The applicant may respond to the invitation referred to in Rule 66.2(c) of the International Preliminary Examining Authority by making amendments or - if he disagrees with the opinion of that Authority - by submitting arguments, as the case may be, or do both.

(b) Any response shall be submitted directly to the International Preliminary Examining Authority.

\*\*\*\*\*

#### *66.5. Amendment*

Any change, other than the rectification of obvious errors, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

#### *66.6. Informal Communications with the Applicant*

The International Preliminary Examining Authority may, at any time, communicate informally, over the telephone, in writing, or through personal interviews, with the applicant. The said Authority shall, at its discretion, decide whether it wishes to grant more than one personal interview if so requested by the applicant, or whether it wishes to reply to any informal written communication from the applicant.

\*\*\*\*\*

#### *66.8. Form of Amendments*

(a) Subject to paragraph (b), the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the

sheet previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, the replacement sheet referred to in paragraph (a) may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

#### *66.9. Language of Amendments*

(a) Subject to paragraphs (b) and (c), if the international application has been filed in a language other than the language in which it is published, any amendment, as well as any letter referred to in Rule 66.8, shall be submitted in the language of publication.

(b) If the international preliminary examination is carried out, pursuant to rule 55.2, on the basis of a translation of the international application, any amendment, as well as any letter referred to in paragraph (a), shall be submitted in the language of that translation.

(c) Subject to Rule 55.3, if an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall, if practicable, having regard to the time limit for establishing the international preliminary examination report, invite the applicant to furnish the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances.

(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

#### *37 CFR 1.485. Amendments by applicant during international preliminary examination.*

(a) The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining Authority for reply to any notification under § 1.484(b) or to any written opinion. Any such amendments must:

(1) Be made by submitting a replacement sheet in compliance with PCT Rules 10 and 11.1 to 11.13 for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled; and

(2) Include a description of how the replacement sheet differs from the replaced sheet. Amendments that do not comply with PCT Rules 10 and 11.1 to 11.13 may not be entered

(b) If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter.

All amendments in reply to a written opinion must be received within the time limit set for reply in order to be assured of consideration in the international preliminary examination report. Amendments filed at or before expiration of the period for reply will be considered. Since the examiner will begin to draw up the final report rather promptly after the time period expires, amendments filed after expiration of the reply period may not be considered. >However, as indicated in MPEP § 1871, there may be situations where it is advisable, to the extent possible, to take such amendments or arguments into account, for example, where the international preliminary examination report has not yet been completed and it is readily apparent to the examiner that consideration of the late-filed response would result in the issuance of a favorable report.< In view of the short time period for completion of preliminary examination, applicants are strongly encouraged to file any amendments promptly. 37 CFR 1.484(d) does not allow for extensions of time to reply to a written opinion. The policy of not allowing extensions of time is to ensure that the USPTO can meet its treaty deadline for transmission of the final report.

Any change, other than the rectification of obvious errors in the claims, the description, or the drawings, including the cancellation of claims, omission of passages in the description or omission of certain drawings will be considered an amendment (PCT Rule 66.5). The Patent and Trademark Office when acting as the International Preliminary Examining Authority will not accept any non-English applications or amendments.

Any amendments to the claims, the description, and the drawings in reply to a written opinion must (1) be made by submitting a replacement sheet for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled and (2) include a description of how the replacement sheet differs from the replaced sheet in accordance with PCT Rule 66.8.

In the particular case where the amendment cancels claims, passages in the description or certain drawings resulting in the cancellation of an entire sheet, the

amendment must be submitted in the form of a letter cancelling the sheet (PCT Rule 66.8(a)).

Replacement sheets must be in typed form.

Any paper submitted by the applicant, if not in the form of a letter, must be accompanied by a letter signed by the applicant or agent (PCT Rule 92.1). The letter must draw attention to the differences between the replaced sheet and the replacement sheet.

The examiner should make sure that amendments filed in accordance with the PCT, which are necessary to correct any deficiencies notified to the applicant, do not go beyond the disclosure of the international application as filed, thus violating PCT Article 34(2)(b). In other words, no amendment should contain matter that cannot be substantiated by the application as originally filed. In a situation where new matter is introduced by amendment in reply to a written opinion, the international preliminary examination report will be established as if the amendment had not been made, and the report should so indicate. It shall also indicate the reasons why the amendment goes beyond the disclosure (PCT Rule 70.2(c)).

## INTERVIEWS

The examiner or applicant may, >after the filing of a demand and< during the time limit for reply to the written opinion, request a telephone or personal interview. Only one interview is a matter of right, whether by telephone or in person. Additional interviews may be authorized by the examiner in a particular international application where such additional interview may be helpful to advance the international preliminary examination procedure.

All interviews of substance must be made of record by using PCT/IPEA/428 Notice on Informal Communication with the Applicant.

When an interview is arranged, whether by telephone or in writing, and whether by the examiner or by the applicant, the matters for discussion should be stated.

The records of interviews or telephone conversations should indicate, where appropriate, whether a reply is due from the applicant or agent or whether the examiner wishes to issue an additional written opinion or establish the international preliminary examination report.

If the applicant desires to reply to the written opinion, such reply must be filed within the time limit set

for reply in order to assure consideration. No extensions to the time limit will be considered or granted. If no timely reply is received from the applicant, the international preliminary examination report will be established by the examiner, treating each claim substantially as it was treated in the written opinion. Replies to the written opinion which are not filed within the time limit set but which reach the examiner before the examiner takes up the application for preparation of the final report may be considered. Thus, only timely replies can be assured of consideration.

The applicant may reply to the invitation referred to in Rule 66.2(c) by making amendments or, if the applicant disagrees with the opinion of the authority, by submitting arguments, as the case may be, or both (PCT Rule 66.3).

If applicant does not reply to the written opinion, the international preliminary examination report will be prepared in time for forwarding to the International Division in finished form by 27 months from the priority date.

## **1879 Preparation of the International Preliminary Examination Report [R-2]**

### *PCT Article 35.*

#### *The International Preliminary Examination Report*

(1) The international preliminary examination report shall be established within the prescribed time limit and in the prescribed form.

(2) The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law. It shall state, subject to the provisions of paragraph (3), in relation to each claim, whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined for the purposes of the international preliminary examination in Article 33(1) to (4). The statement shall be accompanied by the citation of the documents believed to support the stated conclusion with such explanations as the circumstances of the case may require. The statement shall also be accompanied by such other observation as the Regulations provide for.

(3)(a) If, at the time of establishing the international preliminary examination report, the International Preliminary Examining Authority considers that any of the situations referred to in Article 34(4)(a) exists, that report shall state this opinion and the reasons therefor. It shall not contain any statement as provided in paragraph (2).

(b) If a situation under Article 34(4)(b) is found to exist, the international preliminary examination report shall, in relation

to the claims in question, contain the statement as provided in subparagraph (a), whereas, in relation to the other claims, it shall contain the statement as provided in paragraph (2).

### *PCT Administrative Instruction Section 604.*

#### *Guidelines for Explanations Contained in the International Preliminary Examination Report*

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

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

\*\*

The international preliminary examination report is established on Form PCT/IPEA/409.

The international preliminary examination report must be established within:

>For applications having an international filing date on or after January 1, 2004:

(A) 28 months from the priority date; or

(B) 6 months from the time provided under PCT Rule 69.1 for the start of international preliminary examination; or

(C) 6 months from the date of receipt by the IPEA of the translation furnished under PCT Rule 55.2 whichever expires last, as provided in PCT Rule 69.2.

For applications having an international filing date before January 1, 2004:<

(A) 28 months from the priority date; or

(B) 8 months from the date of payment of the fees referred to in PCT Rules 57.1 and 58.1(a); or

(C) 8 months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under PCT Rule 55.2, whichever expires last, as provided in PCT Rule 69.2.

To meet the 28-month date for establishing the report, Office practice is to complete internal processing by 27 months from the priority date in order to provide adequate time for reviewing, final processing and mailing. Thus, under normal circumstances, the applicant receives the report, at the latest, 2 months before national processing at the elected Offices may start. This ensures that he/she has time to consider whether, and in which elected Offices, he/she wants to

enter the national stage and to take the necessary action.

The international preliminary examination report contains, among other things, a statement (in the form of simple “yes” or “no”), in relation to each claim which has been examined, on whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability. The statement is, where appropriate, accompanied by the citation of relevant documents together with concise explanations pointing out the criteria to which the cited documents are applicable and giving reasons for the International Preliminary Examining Authority’s conclusions. Where applicable, the report also includes remarks relating to the question of unity of invention.

The international preliminary examination report identifies the basis on which it is established, that is, whether, and if so, which amendments have been taken into account. Replacement sheets containing amendments under PCT Article 19 and/or Article 34 which have been taken into account are attached as “annexes” to the international preliminary examination report. Amendments under PCT Article 19 which have been considered as reversed by an amendment under PCT Article 34 \*\* are not annexed to the report; neither are the letters which accompany replacement sheets.

>Superseded amendments are not normally included. However, if a first replacement sheet is acceptable and a second replacement sheet for the same numbered sheet contains subject matter that goes beyond the original disclosure of the application as filed, the second replacement sheet supersedes the first replacement sheet, but both the first and second replacement sheets shall be attached to the international preliminary examination report. In this case, the superseded replacement sheets are to be marked as provided in Administrative Instructions Section 602.< The international preliminary examination report may not express a view on the patentability of the invention. PCT Article 35(2) expressly states that “the international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law.”

## CLASSIFICATION OF SUBJECT MATTER

The classification of the subject matter shall be either (1) that given by the International Searching Authority under PCT Rule 43.3, if the examiner agrees with such classification, or (2) shall be that which the examiner considers to be correct, if the examiner does not agree with that classification. Both the International Patent Classification (IPC) and the U.S. classification should be given. This classification is placed on the first sheet of the report.

### \* >BOX NO.< I. BASIS OF REPORT

>When completing Box I, item 1, of Form PCT/IPEA/409, the examiner must indicate whether or not the report has been established on the basis of the international application in the language in which it was filed. If a translation was furnished for the purpose of the search, the publication or the examination, this must be indicated.< The international preliminary examination report will be established on the basis of any amendments, rectifications, priority and/or unity of invention holdings and shall answer the questions concerning novelty, inventive step, and industrial applicability for each of the claims under examination.

In completing Form PCT/IPEA/409, the examiner should first indicate any amendments and/or rectifications of obvious errors taken into account in establishing the international preliminary examination report. The amendments and/or rectifications should be indicated by references to the dates on which the amendments and/or rectifications were filed.

For the purpose of completing Box I, item 1, substitute and/or rectified sheets of the specification and drawings filed during Chapter I proceedings are considered to be originally filed pages/sheets and should be listed as originally filed pages/sheets. Only those amendments or rectifications to the specification and drawings filed on the date of Demand or after the filing of a Demand should be listed as later filed pages/sheets.

Substitute and/or rectified sheets of claims filed during the Chapter I proceedings are also considered to be originally filed claims and should be listed as originally filed claims. However, amended sheets of claims filed under Article 19 in response to the international search report are to be indicated as claims as amended under Article 19. Applicant’s submission of

a timely amendment to the claims alleged to be under Article 19 is accepted under Article 34 (not Article 19) unless the International Bureau has indicated the amendments were accepted under Article 19. Only those amendments, or rectifications to the claims filed on the date of Demand or after the filing of a Demand should be listed as later filed claims. \*\*

Amendments and/or rectifications filed but not taken into account in the establishment of the report (e.g., an amendment not taken into account because the amendment went beyond the disclosure of the international application as filed or a rectification that is not considered to be merely a correction of an obvious error) are then indicated separately. The replacement sheets (but not replacement sheets superseded by later replacement sheets) or letters cancelling sheets under PCT Rule 66.8(a) are included as an annex to the report.

>With respect to Box I, item 3, the examiner must indicate whether any amendments have resulted in the cancellation of pages of the description, claims, drawings, sequence listings or any tables related to sequence listings.

With respect to Box 1, item 4, the examiner must indicate whether any amendments to the description, claims, drawings, sequence listings or any tables related to sequence listing that are annexed to the report, have been treated as if they had not been made because they go beyond the disclosure as filed.<

The final report package when sent to the International Application Processing Division for mailing must include copies of all amendments and rectifications entered and any cover letters to those amendments.

#### \* >BOX NO.< II. PRIORITY

\*>Box 2< II of Form PCT/IPEA/409 is to inform applicant of non-establishment of a request for priority. If the report is established as if the priority claim contained in the Request of the international application had not been made, it shall so indicate. This will occur in the event that the applicant has failed to comply with the invitation to furnish either

(A) a copy of the earlier application whose priority is claimed, or

(B) a translation of the earlier application, or

(C) where the priority claim is found invalid, e.g., the claimed priority date is more than one year prior

to the international filing date (PCT Rule 17) or all claims are directed to inventions which were not described and enabled by the earlier application (PCT Rule 64.1), or

(D) where the priority claim has been withdrawn.

#### \* >BOX NO.< III. NON-ESTABLISHMENT OF OPINION WITH REGARD TO NOVELTY, INVENTIVE STEP OR INDUSTRIAL APPLICABILITY

Indications that a report has not been established on the questions of novelty, inventive step or industrial applicability, either as to some claims or as to all claims, are given in Item III on the Report. The examiner must specify that the report has not been established because:

(A) the application relates to subject matter which does not require international preliminary examination;

(B) the description, claims or drawings are so unclear that no meaningful opinion could be formed;

(C) the claims are so inadequately supported by the description that no meaningful opinion could be formed.

Where the report has not been established in relation to certain claims only, the claims affected must be specified.

>If the nucleotide and/or amino acid sequence listing, and/or tables related thereto, do not comply with the standard in Annex C of the Administrative Instructions, the examiner must indicate the reason for non-compliance.<

#### \* >BOX NO.< IV. LACK OF UNITY OF INVENTION

If the applicant has paid additional fees or has restricted the claims in response to an invitation to do so or if the applicant has failed to respond to the invitation to pay additional fees or restrict the claims, the international preliminary examination report shall so indicate. The examiner should indicate whether:

(A) the claims have been restricted;

(B) additional fees have been paid without protest;

(C) additional fees have been paid by the applicant under protest;

(D) the applicant has neither restricted the claims nor paid additional fees;

(E) the examiner was of the opinion that the international application did not comply with the requirement of unity of invention but decided not to issue an invitation to restrict the claims or pay additional fees.

In addition, if the examiner is examining less than all the claims, the examiner must indicate which parts of the international application were, and which parts were not, the subject of international preliminary examination.

In the case where additional fees were paid under protest, the text of the protest, together with the decision thereon, must be annexed to the report by International Application Processing Division IPEA personnel if the applicant has so requested.

Where an indication has been given under item (E) above, the examiner must also specify the reasons for which the international application was not considered as complying with the requirement of unity of invention.

**\* >BOX NO.< V. REASONED STATEMENT UNDER ARTICLE 35(2) WITH REGARD TO NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY; AND CITATIONS AND EXPLANATIONS SUPPORTING SUCH STATEMENT**

The examiner must indicate whether each claim appears to satisfy the criteria of novelty, inventive step (nonobviousness), and industrial applicability. The determination or statement should be made on each of the three criteria taken separately. The determination as to any criteria should be negative if the criteria as to the particular claim is not satisfied. The examiner should always cite documents believed to support any negative determination as to novelty and inventive step. Any negative holding as to lack of industrial applicability must be fully explained. See the >furthur< discussion \*>in< MPEP § \*\*>1845.01 relating to Box No. V of Form PCT/ISA/237<. The citation of documents should be in accordance with Administrative Instructions Sections 503 and 611. The procedure is the same as the procedure for search report citations. Explanations should clearly indicate, with reference to the cited documents, the reasons supporting the conclusions that any of the said criteria is or is not satisfied, unless the statement is positive

and the reason for citing any document is easy to understand when consulting the document. If only certain passages of the cited documents are relevant, the examiner should identify them, for example, by indicating the page, column, or the lines where such passages appear. Preferably, a reasoned statement should be provided in all instances.

**\* >BOX NO.< VI. CERTAIN DOCUMENTS CITED**

If the examiner has discovered, or the international search report has cited, a relevant document which refers to a nonwritten disclosure, and the document was only published on or after the relevant date of the international application, the examiner must indicate on the international preliminary examination report:

(A) the date on which the document was made available to the public;

(B) the date on which the non-written public disclosure occurred.

The examiner should also identify any published application or patent and should provide for each such published application or patent the following indications:

(A) its date of publication;

(B) its filing date, and its claimed priority date (if any).

The Report may also indicate that, in the opinion of the International Preliminary Examining Authority, the priority date of the document cited has not been validly claimed (PCT Rule 70.10).

Guidelines explaining to the examiner the manner of indicating certain special categories of documents as well as the manner of indicating the claims to which the documents cited in such report are relevant are set forth in Administrative Instructions Sections 507(c), (d), and (e) and 508.

**\* >BOX NO.< VII. CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION**

If, in the opinion of the examiner, defects existing in the form or contents of the international application have not been suitably solved at the prescribed time limit for establishing the international preliminary examination report, the examiner may include this opinion in the report, and if included, must also

indicate the reasons therefor. See the >further< discussion \*in< MPEP § \*\*>1845.01 relating to Box No. VII of Form PCT/ISA/237.

#### **\*\* >BOX NO. VIII.< CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION**

If, in the opinion of the examiner, the clarity of claims, the description, and the drawings, or the question as to whether the claims are fully supported by the description have not been suitably solved at the prescribed time limit for establishing the international preliminary examination report, the examiner may include this opinion in the report, and if included, must also indicate the reasons therefor. See the >further< discussion \*in< MPEP § \*\*>1845.01 relating to Box No. VIII of Form PCT/ISA/237.

#### **FINALIZATION OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

The date on which the report was completed and the name and mailing address of the International Pre-

liminary Examining Authority are indicated on the cover sheet (Form PCT/IPEA/416) of the international preliminary examination report. This information is generated automatically by the OACS software when preparing the report. In addition, the date on which the demand for international preliminary examination was submitted and the name of the authorized officer responsible for the report must be indicated. Pursuant to Administrative Instructions Section 612, an “authorized officer” is 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. Thus, an examiner need not have signatory authority in order to be named as an authorized officer on the examination report. However, the “file copy” of the international preliminary examination report must be signed by a primary examiner.



\*\*

PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

**PCT**

NOTIFICATION OF TRANSMITTAL OF  
INTERNATIONAL PRELIMINARY  
REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)

(PCT Rule 71.1)

To:

John J. Smith  
220 Jefferson Davis Highway  
Arlington, Virginia 22202-0234

Date of mailing  
(day/month/year) **04 MAY 2004**

Applicant's or agent's file reference  
CMC-123-PCT

**IMPORTANT NOTIFICATION**

International application No.  
PCT/US04/00150

International filing date (day/month/year)  
05 January 2004 (05.01.2004)

Priority date (day/month/year)  
06 January 2003 (06.01.2003)

Applicant  
ACME FASTENER CORPORATION

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**  
The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).  
Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.  
For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the *PCT Applicant's Guide*.  
The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the IPEA/ US  
Mail Stop PCT, Attn: IPEA/US  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450  
Facsimile No. (703)305-3230

Authorized officer **Paul A. Bell**  
Paul A. Bell  
Telephone No. 703-308-3543

Form PCT/IPEA/416 (January 2004)

## PATENT COOPERATION TREATY

## PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference CMC-123-PCT	<b>FOR FURTHER ACTION</b>	See Form PCT/IPEA/416
International application No. PCT/US04/00150	International filing date ( <i>day/month/year</i> ) 05 January 2004 (05.01.2004)	Priority date ( <i>day/month/year</i> ) 06 January 2003 (06.01.2003)
International Patent Classification (IPC) or national classification and IPC  IPC(7): B25C 5/06 and US Cl.: 227/8		
Applicant ACME FASTENER CORPORATION		
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>6</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> (<i>sent to the applicant and to the International Bureau</i>) a total of <u>2</u> sheets, as follows:</p> <p style="margin-left: 40px;"><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p style="margin-left: 40px;"><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (<i>sent to the International Bureau only</i>) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p> <p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input checked="" type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input checked="" type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>		
Date of submission of the demand	Date of completion of this report  21 April 2004 (21.04.2004)	
Name and mailing address of the IPEA/ US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703)305-3230	Authorized officer  <i>Paul A. Bell</i> Paul A. Bell Telephone No. 703-308-3543	

Form PCT/IPEA/409 (cover sheet) (January 2004)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.  
PCT/US04/00150

Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

- This report is based on translations from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of:
  - international search (under Rules 12.3 and 23.1(b))
  - publication of the international application (under Rule 12.4)
  - international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the **elements** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

- the international application as originally filed/furnished
- the description:
  - pages 1 - 10 \_\_\_\_\_ as originally filed/furnished
  - pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
  - pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- the claims:
  - pages \_\_\_\_\_ as originally filed/furnished
  - pages\* \_\_\_\_\_ as amended (together with any statement) under Article 19
  - pages\* 11 and 12 \_\_\_\_\_ received by this Authority on 24 February 2004 (25.02.2004)
  - pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- the drawings:
  - pages 1/2 - 2/2 \_\_\_\_\_ as originally filed/furnished
  - pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
  - pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.

3.  The amendments have resulted in the cancellation of:

- the description, pages \_\_\_\_\_
- the claims, Nos. 4 \_\_\_\_\_
- the drawings, sheets/figs \_\_\_\_\_
- the sequence listing (*specify*): \_\_\_\_\_
- any table(s) related to sequence listing (*specify*): \_\_\_\_\_

4.  This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- the description, pages \_\_\_\_\_
- the claims, Nos. \_\_\_\_\_
- the drawings, sheets/figs \_\_\_\_\_
- the sequence listing (*specify*): \_\_\_\_\_
- any table(s) related to sequence listing (*specify*): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/US04/00150

## Box No. IV Lack of unity of invention

1.  In response to the invitation to restrict or pay additional fees the applicant has:
- restricted the claims.
- paid additional fees.
- paid additional fees under protest.
- neither restricted nor paid additional fees.
2.  This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is:
- complied with.
- not complied with for the following reasons:
- This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In order for all inventions to be examined, the appropriate additional examination fees must be paid.
- Group I, claim(s) 1 - 3, 5 and 16 - 20 drawn to an electromagnetic fastener driver with means to hold the fastener magazine in a predetermined position.
- Group II, claim(s) 6 - 10, drawn to an electromagnetic fastener driver with a control means to provide for multiple driving strokes to be delivered to the same fastener with a single actuation of the tool.
- Group III, claim(s) 11 - 15, drawn to an electromagnetic fastener driver with a fastener jam clearance feature.
- The inventions listed as Groups I - III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of the Group I invention is the claimed means to hold the fastener magazine in a predetermined position. The special technical feature of the Group II invention is the claimed control means to provide for multiple driving strokes to be delivered to the same fastener with a single actuation of the tool. The special technical feature of the Group III invention is the claimed fastener jam clearance feature. None of these special technical features are common to the other groups, nor do they correspond to a special technical feature in the other groups. Therefore, unity of invention is lacking.
4. Consequently, this report has been established in respect of the following parts of the international application:
- all parts.
- the parts relating to claims Nos. \_\_\_\_\_

Form PCT/IPEA/409 (Box No. IV) (January 2004)

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

International application No.  
PCT/US04/00150

**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Claims	<u>1 - 3 and 5 - 20</u>	YES
	Claims	<u>NONE</u>	NO
Inventive step (IS)	Claims	<u>1 - 3, 5 and 16 - 20</u>	YES
	Claims	<u>6 - 15</u>	NO
Industrial applicability (IA)	Claims	<u>1 - 3 and 5 - 20</u>	YES
	Claims	<u>NONE</u>	NO

2. Citations and explanations (Rule 70.7)

Please see Supplemental Box

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

International application No.

PCT/US04/00150

**Box No. VII Certain defects in the international application**

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

The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof:  
It is noted that the word "stpaes" at line 15 of page 9 is misspelled.

Form PCT/IPEA/409 (Box No. VII) (January 2004)

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/US04/00150

**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

## 2. Citations and Explanations

Claims 6 - 10 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. in view of Barrett et al. Novak et al. teaches an electromagnetic fastener tool 10 with a housing 12 having a fastener magazine assembly 18 mounted thereon with the magazine assembly having a fastener output channel. The magazine assembly 18 is pivoted between a first position wherein the tool can not be actuated and a second position wherein a fastener may be driven from the tool (note figure 3 and column 1, line 65 through column 2, line 5). The magazine assembly 18 is moved from the first position to the second position by placing the fastener output channel firmly against a work piece. As shown in figure 3 and described at column 4, lines 6 - 49, the magazine assembly 18 and the trigger button 24 are coupled by a safety mechanism 62. This safety mechanism has a sliding rod 64 with the lower end of the rod 64 being attached to the top of channel 48 of the magazine assembly such that rod 64 moves with the magazine assembly. When magazine assembly 18 is placed on a work piece, it rotates into the second position and pushes rod 64 upward. The upper portion of rod 64 has a spring 74 which includes a cam surface 76, a curved surface 78 and a bottom edge 81. Bottom edge 81 of spring 74 is normally positioned adjacent flange 86 of trigger button 24 and blocks upward movement of the trigger button. Thus, the trigger button may not be depressed (moved upward) to fire the tool until the bottom edge 81 of spring 74 is moved away from flange 86. This is accomplished by the interaction of curved surface 78 of spring 74 with a corresponding curved surface 82 fixed to the housing 12. When rod 64 moves upward, spring 74 is bent away from trigger button 24 by the interaction of curved surfaces 78 and 82. Thus, placing the fastener output channel of the magazine assembly 18 against a work piece moves bottom surface 81 of spring 74 out of its blocking position adjacent flange 86 of trigger button 24 and permits the tool to be fired. Novak et al. does not teach the claimed electronic control means to provide multiple blows from the driver to a single fastener. Barrett et al. discloses a control means which provides for multiple blows by the driver 32 on the fastener for each actuation of the trigger. Barrett et al. teaches at column 1, lines 40 - 49 that it is advantageous to operate solenoid actuated fastener drivers in this manner because these tools may require two or more blows from the driver to properly drive the fastener an adequate depth into the work piece. In view of this known teaching, it would have been obvious to one of ordinary skill in this art to provide the Novak et al. tool with the claimed control means to provide a predetermined plurality of driving strokes to a single fastener.

Claims 11 - 15 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. in view of D'Haem et al. Novak et al. does not teach the provision of an anti-jam means to clear jammed fasteners from the fastener output channel. The claims call for the fastener output channel to be formed with a removable cover plate to permit clearing the tool in the event of a fastener jam. D'Haem et al. teaches the use of a removable cover plate to allow clearing the tool as claimed (see column 4, line 76 - column 5, line 23). In view of this teaching, it would have been obvious to one of ordinary skill in this art to provide the claimed anti-jam feature in the Novak et al. tool.

Claims 1 - 3, 5, and 16 - 20 meet the criteria set out in PCT Article 33(2) - (3), because the prior art does not teach or fairly suggest the means to hold the fastener magazine in the second position as claimed.

Claims 1 - 3 and 5 - 20 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

## 1879.01 > Time Limit for Preparing Report in International Applications Having an International Filing Date On or After January 1, 2004 [R-2]

[Note: The regulations under the PCT were changed effective January 1, 2004 and corresponding changes were made to Title 37 of the Code of Federal Regulations. See *January 2004 Revision of Patent Cooperation Treaty Application Procedure*, 68 FR 59881 (Oct. 20, 2003), 1276 O.G. 6 (Nov. 11, 2003). The discussion of the procedures in effect for applications filed prior to January 1, 2004 has been moved from this section to newly added MPEP § 1879.01(a).]

### *PCT Rule 69.*

#### *Start of and Time Limit for International Preliminary Examination*

##### *69.1. Start of International Preliminary Examination*

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:

- (i) the demand;
- (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including where applicable, the late payment fee under Rule 58<sup>bis</sup>.2; and
- (iii) either the international search report and the written opinion established under Rule 43<sup>bis</sup>.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established;

provided that the International Preliminary Examining Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54<sup>bis</sup>.1(a) unless the applicant expressly requests an earlier start.

(b) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes and subject to paragraphs (d) and (e), start at the same time as the international search.

(b<sup>bis</sup>) Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organi-

zation need not, in its capacity as International Searching Authority, establish a written opinion under Rule 43<sup>bis</sup>.1

(c) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:

- (i) it has received a copy of any amendments made under Article 19;
- (ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19; or
- (iii) the expiration of the applicable time limit under Rule 54<sup>bis</sup>.1(a).

(e) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.

##### *69.2. Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

- (i) 28 months from the priority date; or
- (ii) six months from the time provided under Rule 69.1 for the start of the international preliminary examination; or
- (iii) six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2.

PCT Rule 69.2 was amended as reproduced above for applications having an international filing date on or after January 1, 2004. The time limit for preparing the international preliminary examination report is 28 months from the priority date, or 6 months from the time provided under PCT Rule 69.1 for the start of the international preliminary examination, or 6 months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under PCT Rule 55.2, whichever expires first. This time limit is 27 months internally to ensure sufficient time to process, review and mail the report in sufficient time to reach the International Bureau by 28 months from the earliest priority date.



### 1879.01(a) < Time Limit for Preparing Report >in International Application Having an International Filing Date Before January 1, 2004< [R-2]

>[Note: For international applications filed on or after January 1, 2004, see MPEP § 1879.01.]

Former<

*PCT Rule 69.*

*Start of and Time Limit for International Preliminary Examination*  
>(as amended July 1, 1998)<

#### 69.1.Start of International Preliminary Examination

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession both of the demand and of either the international search report or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established.

(b) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes and subject to paragraph (d), start at the same time as the international search.

(c) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before

(i) it has received a copy of any amendments made under Article 19,

(ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19, or

(iii) the expiration of 20 months from the priority date, whichever occurs first.

(e) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.

#### 69.2.Time Limit for International Preliminary Examination

The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date, or

(ii) eight months from the date of payment of the fees referred to in Rules 57.1 and 58.1(a), or

(iii) eight months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2, whichever expires last.

\*\*>For international applications having an international filing date before January 1, 2004, the period for preparing the IPER is set forth in former PCT Rule 69.2 (as amended July 1, 1998)<. The time limit for preparing the international preliminary examination report is 28 months from the priority date, or 8 months from the date of payment of the fees referred to in PCT Rules 57.1 and 58.1(a), or 8 months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under PCT Rule 55.2, whichever expires first. This time limit is 27 months internally to ensure sufficient time to process, review and mail the report in sufficient time to reach the International Bureau by 28 months from the earliest priority date.

### 1879.02 Transmittal of the International Preliminary Examination Report

*PCT Article 36.*

*Transmittal, Translation, and Communication of the International Preliminary Examination Report*

(1) The international preliminary examination report, together with the prescribed annexes, shall be transmitted to the applicant and to the International Bureau.

\*\*\*\*\*

*PCT Rule 71.*

*Transmittal of the International Preliminary Examination Report*

#### 71.1.Recipients

The International Preliminary Examining Authority shall, on the same day, transmit one copy of the international preliminary examination report and its annexes, if any, to the International Bureau, and one copy to the applicant.

#### 71.2.Copies of Cited Documents

(a) The request under Article 36(4) may be presented any time during seven years from the international filing date of the international application to which the report relates.

(b) The International Preliminary Examining Authority may require that the party (applicant or elected Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be provided for in the agreements referred to in Article 32(2) between the International Preliminary Examining Authorities and the International Bureau.

(c) *[Deleted]*

(d) Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

The international preliminary examination report is transmitted to the International Bureau using a transmittal Form PCT/IPEA/416. Every effort is made to ensure that the transmittal is effected in sufficient time to reach the International Bureau before the expiration of the time limit set in PCT Rule 69.2.

### AUTHORIZED OFFICER

Form PCT/IPEA/416 must be signed by a primary examiner.

### 1879.03 Translations [R-2]

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#### *PCT Article 36.*

#### *Transmittal, Translation, and Communication of the International Preliminary Examination Report*

\*\*\*\*\*

(2)(a) The international preliminary examination report and its annexes shall be translated into the prescribed languages.

(b) Any translation of the said report shall be prepared by or under the responsibility of the International Bureau, whereas any translation of the said annexes shall be prepared by the applicant.

\*\*\*\*\*

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#### *PCT Rule 70.*

#### *International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)*

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#### *70.17 Languages of the Report and the Annexes*

The report and any annex shall be in the language in which the international application to which they relate is published, or, if the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, in the language of that translation.<

#### *PCT Rule 72.*

\*\*>*Translation of the International Preliminary Examination Report and of the Written Opinion of the International Searching Authority*<

#### *72.1. Languages*

(a) Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office, be translated into English.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

#### *72.2. Copy of Translation for the Applicant*

The International Bureau shall transmit a copy of the translation referred to in Rule 72.1(a) of the international preliminary examination report to the applicant at the same time as it communicates such translation to the interested elected Office or Offices.

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#### *72.2<sup>bis</sup>. Translation of the Written Opinion of the International Searching Authority Established Under Rule 43<sup>bis</sup>.1*

In the case referred to in Rule 73.2(b)(ii), the written opinion established by the International Searching Authority under Rule 43<sup>bis</sup>.1 shall, upon request of the elected Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the elected Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

#### *72.3. Observations on the Translation*

The applicant may make written observations as to the correctness of the translation of the international preliminary examination report or of the written opinion established by the International Searching Authority under Rule 43<sup>bis</sup>.1 and shall send a copy of the observations to each of the interested elected Offices and to the International Bureau.<

The >written opinion established by the International Searching Authority and the< international preliminary examination report and any annexes are established in Chinese, English, French, German, Japanese, Russian or Spanish, if the international application was filed in one of those languages or translated into one of those languages. See PCT Rules 48.3(b), 55.2 and 70.17. Each elected State may require that >the written opinion and/or< the report, if it is not in (one of) the official language(s) of its national Office, be translated into English. See PCT Rule 72.1(a). In that case, the translation of the body of the >written opinion and/or< report is prepared by >the< International Bureau, which transmits copies to the applicant

and to each interested elected Office. If any elected Office requires a translation of annexes to the report, the preparation and furnishing of that translation is the responsibility of the applicant. See PCT Article 36(2)(b).

The U.S. requires the final report and the annexes thereto to be in English. Translation of the annexes for national stage purposes is required pursuant to 35 U.S.C. 371(c)(5) and 37 CFR 1.495(e). Failure to timely provide such translation results in cancellation of the annexes.

## 1879.04 Confidential Nature of the Report [R-2]

### *PCT Article 38.*

#### *Confidential Nature of the International Preliminary Examination*

(1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4) to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

(2) Subject to the provisions of paragraph (1) and Articles 36(1) and (3) and 37(3)(b), neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, give information on the issuance or non-issuance of an international preliminary examination report and on the withdrawal or non-withdrawal of the demand or of any election.

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### *PCT Rule 44<sup>ter</sup>.*

#### *Confidential Nature of Written Opinion, Report, Translation and Observations*

(a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:

(i) to the written opinion established under Rule 43<sup>bis</sup>.1, to any translation thereof prepared under Rule 44<sup>bis</sup>.3(d) or to any written observations on such translation sent by the applicant under Rule 44<sup>bis</sup>.4;

(ii) if a report is issued under Rule 44<sup>bis</sup>.1, to that report, to any translation of it prepared under Rule 44<sup>bis</sup>.3(b) or to any written observations on that translation sent by the applicant under Rule 44<sup>bis</sup>.4.

(b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.<

### *37 CFR 1.11. Files open to the public.*

(a) The specification, drawings, and all papers relating to the file of an abandoned published application, except if a redacted copy of the application was used for the patent application publication, a patent, or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). See § 2.27 for trademark files.

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### *37 CFR 1.14. Patent applications preserved in confidence.*

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(g) *International applications.* (1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see § 1.19(b)), if:

(i) With respect to the Home Copy (the copy of the international application kept by the Office in its capacity as the Receiving Office, see PCT Article 12(1)), the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy (the copy of an international application kept by the Office in its capacity as the International Searching Authority, see PCT Article 12(1)), the U.S. acted as the International Searching Authority, except for the written opinion of the International Searching Authority which shall not be available until the expiration of thirty months from the priority date; or

(iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be permitted in accordance with PCT Articles 30 and 38 and PCT Rules 44<sup>ter</sup>.1, 94.2

and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (a) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (a)(1)(i) through (a)(1)(vi) and (g)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

(h) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

(1) The fee set forth in § 1.17(h); and

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

For a discussion of the availability of copies of documents from international application files and/or access to international application files, see MPEP § 110.<

## 1880 Withdrawal of Demand or Election [R-2]

### *PCT Article 37.*

#### *Withdrawal of Demand or Election*

(1) The applicant may withdraw any or all elections.

(2) If the election of all elected States is withdrawn, the demand shall be considered withdrawn.

(3)(a) Any withdrawal shall be notified to the International Bureau.

(b) The elected Office concerned and the International Preliminary Examining Authority concerned shall be notified accordingly by the International Bureau.

(4)(a) Subject to the provisions of subparagraph (b), withdrawal of the demand or of the election of a Contracting State shall, unless the national law of that State provides otherwise, be considered to be withdrawal of the international application as far as that State is concerned.

(b) Withdrawal of the demand or of the election shall not be considered to be withdrawal of the international application if such withdrawal is effected prior to the expiration of the applicable time limit under Article 22; however, any Contracting State may provide in its national law that the aforesaid shall apply only if its national Office has received, within the said time limit, a

copy of the international application, together with a translation (as prescribed), and the national fee.

### *PCT Rule 90<sup>bis</sup>. Withdrawals*

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#### *90<sup>bis</sup>.4. Withdrawal of the Demand, or of Elections*

(a) The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.

(c) If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

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### *PCT Administrative Instruction Section 606. Cancellation of Elections*

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(a) The International Preliminary Examining Authority shall cancel *ex officio*:

(i) the election of any State which is not a designated State;

(ii) the election of any State not bound by Chapter II of the Treaty.

(b) The International Preliminary Examining Authority 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.

Any withdrawal of the demand or any election must be sent to the International Bureau or to the International Preliminary Examining Authority<. Withdrawal, if timely, is effective upon receipt by the International Bureau >or the International Preliminary Examining Authority. Pursuant to PCT Rule 90<sup>bis</sup>.5, the withdrawal must be signed by all of the applicants, except as provided in PCT Rule 90<sup>bis</sup>.5(b) in the case where an applicant/inventor for the United States could not be found or reached after diligent effort and the withdrawal is signed by at least one applicant. Pursuant to PCT Rules 90.4(e) and 90.5(d), the requirement for a separate power of attorney or a copy of the general power of attorney shall not be waived in cases of withdrawal.<

**1881 Receipt of Notice of Election >and Preliminary Examination Report< by the >United States< Patent and Trademark Office [R-2]**

*PCT Rule 61.*

*Notification of the Demand and Elections*

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*61.2. Notification to the Elected Offices*

(a) The notification provided for in Article 31(7) shall be effected by the International Bureau.

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(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed) and the date of receipt by the International Preliminary Examining Authority of the demand.<

(c) The notification shall be sent to the elected Office together with the communication provided for in Article 20. Elections effected after such communication shall be notified promptly after they have been made.

\*\*>

(d) Where the applicant makes an express request to an elected Office under Article 40(2) prior to the international publication of the international application, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect the communication provided for in Article 20 to that Office.<

*61.3. Information for the Applicant*

The International Bureau shall inform the applicant in writing of the notification referred to in Rule 61.2 and of the elected Offices notified under Article 31(7).

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All notices of election are received by the >Office of< PCT \*\*>Operations< from the International Bureau. The >Office of< PCT \*\*>Operations< prepares the appropriate records of the election and places the paper in storage with the communicated copy of the international application until the national stage is entered. >The international preliminary examination report received by the USPTO will also be included in the national stage file. The international preliminary examination report is communicated to the elected Offices by the International Bureau.<

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**1893 National Stage (U.S. National Application Filed Under 35 U.S.C. 371) [R-2]**

*37 CFR 1.9. Definitions.*

(a)(1) A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

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Thus, there are three types of U.S. national applications: a national stage application under the PCT (an application which entered the national stage in the U.S. from an international application after compliance with 35 U.S.C. 371), a regular domestic national application filed under 35 U.S.C. 111(a), and a provisional application filed under 35 U.S.C. 111(b).

An applicant who uses the Patent Cooperation Treaty gains the benefit of:<

(A) a delay in the time when papers must be submitted to the national offices;

(B) an international search (to judge the level of the relevant prior art) >and, for international applications filed on or after January 1, 2004, a written opinion on the question of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable< before having to expend resources for filing fees, translations and other costs;

(C) a delay in the expenditure of fees;

(D) additional time for research;

(E) additional time to evaluate financial, marketing, commercial and other considerations>; and

(F) the option of obtaining international preliminary examination<.

The time delay is, however, the benefit most often recognized as primary. Ultimately, applicant might choose to submit the national stage application. The national stage is unique compared to a domestic national application in that

(A) it is submitted later (i.e., normally 30 months or more from a claimed priority date as compared to 12 months for a domestic application claiming priority).

(B) the status of the prior art is generally known before the national stage begins and this is not necessarily so in a domestic national application.

(C) if the filing of an international application is to be taken into account in determining the patentability or validity of any application for patent or granted patent, then special provisions apply. See MPEP § 1895.01, subsection (E) and MPEP § 1896.

### IDENTIFICATION OF THE NATIONAL STAGE APPLICATION

Once an international application enters the U.S. national phase (“national stage application”) has been accorded a U.S. application number (the two digit series code followed by a six digit serial number), that number should be used whenever papers or other communications are directed to the USPTO regarding the national stage application. See 37 CFR 1.5 (a). The national stage application is tracked through the Patent Application Locating and Monitoring (PALM) system by the eight digit U.S. application number. Therefore, processing is expedited if the U.S. application number is indicated. The international application number, international filing date, and the national stage entry date under 35 U.S.C. 371 (if such has been accorded) should also be included, as such would also be helpful for identification purposes and can be used to cross-check a possibly erroneous U.S. application number.

### 1893.01 Commencement and Entry [R-1]

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#### 35 U.S.C. 371. National stage: Commencement.

(a) Receipt from the International Bureau of copies of international applications with any amendments to the claims, international search reports, and international preliminary examination reports including any annexes thereto may be required in the case of international applications designating or electing the United States.

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty.

(c) The applicant shall file in the Patent and Trademark Office —

(1) the national fee provided in section 41(a) of this title;

(2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;

(3) amendments, if any, to the claims in the international application, made under article 19 of the treaty, unless such amendments have been communicated to the Patent and Trademark Office by the International Bureau, and a translation into the English language if such amendments were made in another language;

(4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants;

(5) a translation into the English language of any annexes to the international preliminary examination report, if such annexes were made in another language.

(d) The requirement with respect to the national fee referred to in subsection (c)(1), the translation referred to in subsection (c)(2), and the oath or declaration referred to in subsection (c)(4) of this section shall be complied with by the date of the commencement of the national stage or by such later time as may be fixed by the Director. The copy of the international application referred to in subsection (c)(2) shall be submitted by the date of the commencement of the national stage. Failure to comply with these requirements shall be regarded as abandonment of the application by the parties thereof, unless it be shown to the satisfaction of the Director that such failure to comply was unavoidable. The payment of a surcharge may be required as a condition of accepting the national fee referred to in subsection (c)(1) or the oath or declaration referred to in subsection (c)(4) of this section if these requirements are not met by the date of the commencement of the national stage. The requirements of subsection (c)(3) of this section shall be complied with by the date of the commencement of the national stage, and failure to do so shall be regarded as a cancellation of the amendments to the claims in the international application made under article 19 of the treaty. The requirement of subsection (c)(5) shall be complied with at such time as may be fixed by the Director and failure to do so shall be regarded as cancellation of the amendments made under article 34 (2)(b) of the treaty.

(e) After an international application has entered the national stage, no patent may be granted or refused thereon before the expiration of the applicable time limit under article 28 or article 41 of the treaty, except with the express consent of the applicant. The applicant may present amendments to the specification, claims, and drawings of the application after the national stage has commenced.

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with.

*37 CFR 1.491. National stage commencement and entry.*

(a) Subject to 35 U.S.C. 371(f), the national stage shall commence with the expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a).

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c) within the period set in \*\* § 1.495.

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit, as stated in 35 U.S.C. 371(b) and 37 CFR 1.491(a).

Entry into the national stage occurs upon completion of certain acts, as stated in 37 CFR 1.491(b).

### 1893.01(a) Entry via the U.S. Designated or Elected Office [R-2]

#### *PCT Article 2. Definitions*

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(xiii)“designated Office” means the national Office of or acting for the State designated by the applicant under Chapter I of this Treaty;

(xiv)“elected Office” means the national Office of or acting for the State elected by the applicant under Chapter II of this Treaty;

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#### *37 CFR 1.414. The United States Patent and Trademark Office as a Designated Office or Elected Office.*

(a) The United States Patent and Trademark Office will act as a Designated Office or Elected Office for international applications in which the United States of America has been designated or elected as a State in which patent protection is desired.

(b) The United States Patent and Trademark Office, when acting as a Designated Office or Elected Office during international processing will be identified by the full title “United States Designated Office” or by the abbreviation “DO/US” or by the full title “United States Elected Office” or by the abbreviation “EO/US.”

(c) The major functions of the United States Designated Office or Elected Office in respect to international applications in which the United States of America has been designated or elected, include:

(1) Receiving various notifications throughout the international stage and

(2) Accepting for national stage examination international applications which satisfy the requirements of 35 U.S.C. 371.

An international application designating the U.S. will enter the national stage via the U.S. Designated Office unless a Demand electing the U.S. is filed

under PCT Article 31 whereupon entry will be via the U.S. Elected Office. The procedure for entry is as prescribed in 37 CFR 1.495.

#### *37 CFR 1.495. Entering the national stage in the United States of America.*

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)).

\*\*>

(c) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date but omits either a translation of the international application, as filed, into the English language, if the international application was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2)), or the oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26<sup>ter</sup>.1, applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of thirty months after the priority date. A “Sequence Listing” need not be translated if the “Sequence Listing” complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).<

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of thirty months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of thirty months from the priority date will be considered to be canceled.

(e) A translation into English of any annexes to an international preliminary examination report (if applicable), if the

annexes were made in another language, must be furnished not later than the expiration of thirty months from the priority date. Translations of the annexes which are not received by the expiration of thirty months from the priority date may be submitted within any period set pursuant to paragraph (c) of this section accompanied by the processing fee set forth in § 1.492(f). Annexes for which translations are not timely received will be considered canceled.

(f) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

\*\*>

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).<

(h) An international application becomes abandoned as to the United States thirty months from the priority date if the requirements of paragraph (b) of this section have not been complied with within thirty months from the priority date. If the requirements of paragraph (b) of this section are complied with within thirty months from the priority date but either of any required translation of the international application as filed or the oath or declaration are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

### **1893.01(a)(1) Submissions Required by 30 Months from the Priority Date [R-2]**

To begin entry into the national stage, applicant is required to comply with 37 CFR 1.495(b) within 30 months from the priority date. Thus, applicant must pay the basic national fee on or before 30 months from the priority date and be sure that a copy of the international application has been received by the U.S. Designated or Elected Office prior to expiration of 30 months from the priority date. \*\*>Where the international application was filed with the United States Receiving Office as the competent receiving Office, the copy of the international application referred to in 37 CFR 1.495(b) is not required.< Payment of the basic national fee will indicate applicant's intention to enter the national stage and will provide a U.S. correspondence address in most instances.

Facsimile transmission is not acceptable for submission of the basic national fee and/or the copy of the international application. See 37 CFR 1.6(d).

Likewise, the certificate of mailing procedures of 37 CFR 1.8 do not apply to the filing of the copy of the international application and payment of the basic national fee. See 37 CFR 1.8(a)(2)(i)(F).

Applicants cannot pay the basic national fee with a surcharge after the 30 month deadline. Failure to pay the basic national fee within 30 months from the priority date will result in abandonment of the application. The time for payment of the basic fee is not extendable.

Similarly, the copy of the international application \* required \* >under 37 CFR 1.495(b) must< be provided within 30 months from the priority date >to avoid abandonment<. A copy of the international application is provided to the U.S. Designated or Elected Office by the International Bureau (the copy is ordinarily received shortly after publication at about 18 months from the priority date). The International Bureau also mails a confirmation (Form \*>PCT/IB/308)< to applicant upon which applicant can rely that the copy has been provided. >This confirmation constitutes conclusive evidence of transmission of the international application.< See PCT Rule 47.1(c). The copy >of the international application< is placed in a file to await applicant's submission of the basic national fee and other national stage requirements.

If the basic national fee has been paid >and the copy of the international application (if required) has been received< by expiration of 30 months from the priority date>,< but the required oath >or< declaration or translation has not been filed within 30 months from the priority date, \*\* the Office will send applicant a \*>Notification of Missing Requirements (Form PCT/DO/EO/905) identifying any deficiency< and provide a period of time to \*>correct< the deficiency as set forth in 37 CFR 1.495(c). The time period usually set is 2 months from the date of the notification by the Office or 32 months from the priority date, whichever is later. This period may be extended for up to 5 additional months pursuant to the provisions of 37 CFR 1.136(a). \*\*>Failure to timely file the proper reply to the notification will result in abandonment of the national stage application.

For further information regarding the oath or declaration required under 35 U.S.C. 371(c)(4) and 37 CFR 1.497 for entry into the U.S. national phase, see MPEP § 1893.01(e).



For further information regarding the translation required under 35 U.S.C. 371(c)(2) and 37 CFR 1.495(c), see MPEP § 1893.01(d).<

### **1893.01(a)(2) Article 19 Amendment (Filed With the International Bureau) [R-2]**

The >claims of an< international application may be amended under >PCT< Article 19 after issuance of the search report. >The description and drawings may not be amended under PCT Article 19.< The amendment is forwarded to the U.S. Designated Office by the International Bureau for inclusion in the U.S. national stage application. Article 19 amendments which were made in English will be entered by substituting each page of amendment for the corresponding English language page of claims of the international application. If the Article 19 amendments were made in a language other than English, applicant must provide an English translation for the U.S. national stage application. The >Article 19 amendment(s) and the< English translation of the amendment(s) must be \*>received by the Office< by 30 months from the priority date, \*>unless applicant has requested early processing of the national stage application under 35 U.S.C. 371(f), in which case the amendment(s) under PCT Article 19 and the English translation of the amendment(s) must be filed by the time applicant has submitted the basic national fee, an oath or declaration in compliance with 37 CFR 1.497(a)-(b), and any required translation of the international application if such time is earlier than 30 months from the priority date. Otherwise,< the amendment(s) will be considered to be canceled, 35 U.S.C. 371(d). \*\* If such >canceled< amendments are desired, they \*>must< be offered under 37 CFR 1.121 as a preliminary amendment or a responsive amendment under 37 CFR 1.111.

Applicants entering the national stage in the U.S. are encouraged to submit an amendment in accordance with 37 CFR 1.121 rather than an English translation of an Article 19 amendment. Sometimes when an Article 19 amendment is translated into English, it cannot be entered. That is, each page of an Article 19 amendment must be entered by substituting a page of amendment for the corresponding page of claims of the international application. After translation of a

page, the translated page may no longer correspond to a page of the claims of the international application such that the amendment is capable of entry by substituting the page of English translation (of the amendment) for the corresponding page of claims of the international application without leaving an inconsistency. Where applicant chooses to submit an English translation of the Article 19 amendment, applicant should check to be sure that the English translation can be entered by substituting the pages of translation for corresponding pages of the claims of the international application without leaving an inconsistency. If entry of the page of translation causes inconsistencies in the claims of the international application the translation will not be entered. For example, if the translation of the originally filed application has a page which begins with claim 1 and ends with a first part of claim 2 with the remainder of claim 2 on the next page then translation of the Article 19 amendment to only claim 1 must include a substitute page or pages beginning with the changes to claim 1 and ending with the last of the exact same first part of claim 2. This enables the original translated first page of claims to be replaced by the translation of the amendment without changing the subsequent unamended page(s). Alternatively, applicant may submit a preliminary amendment in accordance with 37 CFR 1.121.

### **1893.01(a)(3) Article 34 Amendments (Filed with the International Preliminary Examining Authority) [R-2]**

\*\*>Amendments to the international application that were properly made under PCT Article 34 during the international preliminary examination phase (i.e., Chapter II) will be annexed by the International Preliminary Examining Authority to the international preliminary examination report (IPER) and communicated to the elected Offices. See PCT Article 36, PCT Rule 70.16, and MPEP § 1893.03(e). If these annexes are in English, they will normally be entered into the U.S. national stage application by the Office absent a clear instruction by the applicant that the annexes are not to be entered. However, if entry of the replacement sheets will result in an obvious inconsistency in the description, claims or drawings of the international application, then the annexes will not be

entered. If the annexes are in a foreign language, a proper translation of the annexes must be furnished to the Office not later than the expiration of 30 months from the priority date, unless a period has been set pursuant to 37 CFR 1.495(c) to furnish an oath or declaration or English translation of the international application, in which case the translations of the annexes, accompanied by the processing fee set forth in 37 CFR 1.492(f), may be submitted within the period set pursuant to 37 CFR 1.495(c). See 37 CFR 1.495(e). Annexes for which translations are not timely received will be considered canceled. Amendments made under PCT Article 34 to the international application after commencement and entry into the U.S. national phase (see MPEP § 1893.01) will not be considered in a U.S. national stage application. However, applicants may still amend the U.S. national stage application by way of a preliminary amendment submitted in accordance with 37 CFR 1.115 and 37 CFR 1.121.

Where an English translation of the annexes is provided, the translation must be such that the translation of the originally filed application can be changed by replacing the originally filed application page(s) (of translation) with substitute page(s) of translation of the annex. Thus, applicant should check to be sure that the English translation can be entered by substituting the pages of translation for corresponding pages of the claims of the international application without leaving an inconsistency. If entry of the page of translation causes inconsistencies in the specification or claims of the international application the translation will not be entered. Non-entry of the annexes will be indicated on the “NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495” (Form PCT/DO/EO/903). For example, if the translation of the originally filed application has a page which begins with claim 1 and ends with a first part of claim 2 with the remainder of claim 2 on the next page then translation of the annex to only claim 1 must include a substitute page or pages beginning with the changes to claim 1 and ending with the last of the exact same first part of claim 2. This enables the original translated first page of claims to be replaced by the translation of the annex without changing the subsequent unamended page(s). Alternatively applicant may submit a preliminary amendment in accordance with 37 CFR 1.121.

The fact that an amendment made to the international application during the international phase was entered in the national stage application does not necessarily mean that the amendment is proper. Specifically, amendments are not permitted to introduce “new matter” into the application. See PCT Article 34(2)(b). Where it is determined that such amendments introduce new matter into the application, then the examiner should proceed as in the case of regular U.S. national applications filed under 35 U.S.C. 111(a) by requiring removal of the new matter and making any necessary rejections to the claims. See MPEP § 608.04 and § 2163.06.

### 1893.01(c) Fees [R-2]

Because the national stage fees are subject to change, applicants and examiners should always consult the *Official Gazette* for the current fee listing.

Fees under 37 CFR 1.16 relate to national applications under 35 U.S.C. 111(a), and not to international applications entering the national stage under 35 U.S.C. 371. National stage fees are specifically provided for in 37 CFR 1.492. However, an authorization to charge fees under 37 CFR 1.16 in an international application entering the national stage under 35 U.S.C. 371 will be treated as an authorization to charge fees under 37 CFR 1.492. See 37 CFR 1.25(b). Accordingly, applications will not be held abandoned if an authorization to charge fees under 37 CFR 1.16 has been provided instead of an authorization to charge fees under 37 CFR 1.492.

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(b)-(c) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(d). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608.

### 1893.01(d) Translation [R-2]

Applicants entering the national stage in the U.S. are required to file an English translation of the international application if the international application was filed in another language and was not pub-

lished under PCT Article 21(2) in English. 35 U.S.C. 371(c)(2) and 37 CFR 1.495(c). A “Sequence Listing” need not be translated if the “Sequence Listing” complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b). See 37 CFR 1.495(c). The translation must be a translation of the international application as filed or with any changes which have been properly accepted under PCT Rule 26 or any rectifications which have been properly accepted under PCT Rule 91. A translation of less than all of the international application (e.g., a translation that fails to include a translation of text contained in the drawings or a translation that includes a translation of claims amended under PCT Article 19 or 34 but does not include a translation of the original claims) is unacceptable. In addition, a translation that includes modifications other than changes that have been properly accepted under PCT Rule 26 or 91 (e.g., a translation that includes headings that were not present in the international application as originally filed) is unacceptable. A translation of words contained in the drawings must be furnished either in the form of new drawings or in the form of a copy of the original drawings with the translation pasted on the original text matter. See PCT Rule 49.5(d).

Amendments, even those considered to be minor or to not include new matter, may not be incorporated into the translation. If an amendment to the international application as filed is desired for the national stage, it may be submitted in accordance with 37 CFR 1.121. An amendment filed under 37 CFR 1.121 should be submitted within 1 month after completion of the 35 U.S.C. 371(c) requirements and entry into the national stage. See 37 CFR 1.496(a). If applicant has timely paid the basic national fee and submitted the copy of the international application but the translation is missing or is defective, a Notification of Missing Requirements (PCT/DO/EO/905) will be sent to applicant setting a period to correct any missing or defective requirements. The time period is 32 months from the priority date or 2 months from the date of the notice, whichever expires later. The time period may be extended for up to five additional months as provided in 37 CFR 1.136(a). A processing fee is required for accepting a translation after 30 months from the priority date. See 37 CFR 1.492(f).

Pursuant to PCT Rule 48.3(c), if the international application is published in a language other than

English, the publication shall include an English translation of the title of the invention, the abstract, and any text matter pertaining to the figure or figures accompanying the abstract. The translations shall be prepared under the responsibility of the International Bureau.

A translation of the international application as filed and identified as provided in 37 CFR 1.417 submitted for the purpose of obtaining provisional rights pursuant to 35 U.S.C. 154(d)(4) can be relied on to fulfill the translation requirement under 35 U.S.C. 371(c)(2) in a national stage application. See 37 CFR 1.495(g).

### 1893.01(e) Oath/Declaration [R-2]

*37 CFR 1.497. Oath or declaration under 35 U.S.C. 371(c)(4).*

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26<sup>ter</sup>.1, he or she must file an oath or declaration that:

- (1) Is executed in accordance with either §§ 1.66 or 1.68;
- (2) Identifies the specification to which it is directed;
- (3) Identifies each inventor and the country of citizenship of each inventor; and
- (4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b)(1) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or §1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

(c) Subject to paragraph (f) of this section, if the oath or declaration meets the requirements of paragraphs (a) and (b) of this section, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and § 1.495(c). However, if the oath or declaration does not also meet the requirements of § 1.63, a supplemental oath or declaration in compliance with § 1.63 or an application data sheet will be required in accordance with § 1.67.

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration

which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and

(4) Any new oath or declaration required by paragraph (f) of this section.

(e) The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(f) A new oath or declaration in accordance with this section must be filed to satisfy 35 U.S.C. 371(c)(4) if the declaration was filed under PCT Rule 4.17(iv), and:

(1) There was a change in the international filing date pursuant to PCT Rule 20.2 after the declaration was executed; or

(2) A change in the inventive entity was effected under PCT Rule 92bis after the declaration was executed and no declaration which sets forth and is executed by the inventive entity as so changed has been filed in the application.

(g) If a priority claim has been corrected or added pursuant to PCT Rule 26<sup>bis</sup> during the international stage after the declaration of inventorship was executed in the international application under PCT Rule 4.17(iv), applicant will be required to submit either a new oath or declaration or an application data sheet as set forth in § 1.76 correctly identifying the application upon which priority is claimed.

Applicants entering the national stage in the U.S. are required to file an oath or declaration of the inventor in accordance with 37 CFR 1.497(a) and (b). If the basic national fee and copy of the international application has been received by the expiration of 30 months from the priority date, but the required oath or declaration has not been filed, the Office will send applicant a Notification of Missing Requirements (Form PCT/DO/EO/905) setting a time period to correct any missing or defective requirements and to submit the surcharge fee required under 37 CFR 1.492(e) unless previously paid. The time period is 32 months from the priority date or 2 months from the date of the notice, whichever expires later. The time period may be extended for up to five additional months as provided in 37 CFR 1.136(a). Failure to timely file the required oath or declaration will result in abandonment of the application.

An oath or declaration satisfying the requirements of 37 CFR 1.497(a)-(b) will be sufficient for the pur-

poses of entering the U.S. national phase. However, if the oath or declaration fails to also comply with the additional requirements for oaths and declarations set forth in 37 CFR 1.63, applicants will need to submit a supplemental oath or declaration, or an application data sheet where permitted under 37 CFR 1.63(c), to correct the deficiency. See 37 CFR 1.497(c).

In general, the requirement for an oath or declaration in compliance with 37 CFR 1.497(a)-(b) will have been previously satisfied if a declaration in compliance with PCT Rule 4.17 (iv) and executed by all the inventors was submitted within the time limits provided in PCT Rule 26<sup>ter</sup>.1 in the international phase. However, if the inventorship was changed in the international application under PCT Rule 92<sup>bis</sup> such that the inventorship identified in the PCT Rule 4.17(iv) declaration no longer corresponds to that of the international application (see 37 CFR 1.41(a)(4)), then a new oath or declaration in accordance with 37 CFR 1.497(a)-(b) will be required to enter the national stage. See 37 CFR 1.497(f)(2). Similarly, a new oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required where the PCT Rule 4.17(iv) declaration was executed prior to a change in the international filing date pursuant to PCT Rule 20.2. See 37 CFR 1.497(f)(1). In addition, where a priority claim has been corrected or added pursuant to PCT Rule 26<sup>bis</sup> after execution of the PCT Rule 4.17(iv) declaration, then a supplemental oath or declaration, or an application data sheet, identifying the correct priority claim will be required. See 37 CFR 1.497(g).

## CORRECTION OF INVENTORSHIP

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92<sup>bis</sup>. See 37 CFR 1.41(a)(4). Accordingly, an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied. These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive inten-

tion on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).<

If an inventor refuses to execute the oath or declaration or \*\*>cannot be found or reached after diligent effort<, applicant must file an oath or declaration and a petition in accordance with 37 CFR 1.47. >See 37 CFR 1.497(b) and MPEP § 409.03.< Similarly, where an inventor is deceased or legally incapacitated, an oath or declaration in accordance with the provisions of 37 CFR 1.42 or 1.43 must be provided. \*\*>See 37 CFR 1.497(b) and MPEP § 409.01 and § 409.02.

Where there has been no change of inventorship but the name of an inventor indicated in the international application is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. See MPEP § 605.04(c).<

### 1893.02 Abandonment [R-1]

If the requirements of 35 U.S.C. 371(c) are not complied with by the time period set in \*\* 37 CFR 1.495(b) and (c), \*\* the application is considered to be abandoned, see \*\* 37 CFR 1.495(h).

Examiners and applicants should be aware that sometimes papers filed for the national stage are deficient and abandonment results. For example, if the fee submitted does not include at least the amount of the basic national fee that is due, the application becomes abandoned.

Applicant may file a petition to revive an abandoned application in accordance with the provisions of 37 CFR 1.137. See MPEP § 711.03(c).

### 1893.03 Prosecution of U.S. National Stage Applications Before the Examiner [R-2]

*37 CFR 1.496. Examination of international applications in the national stage.*

(a) International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date on which such requirements were met. However, unless an express request for early processing has been filed under 35 U.S.C. 371(f), no action may be taken prior to one month after entry into the national stage.

(b) A national stage application filed under 35 U.S.C. 371 may have paid therein the basic national fee as set forth in § 1.492(a)(4) if it contains, or is amended to contain, at the time of entry into the national stage, only claims which have been indicated in an international preliminary examination report prepared by the United States Patent and Trademark Office as satisfying the criteria of PCT Article 33(1)-(4) as to novelty, inventive step and industrial applicability. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid may be amended subsequent to the date of entry into the national stage only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid will be taken up out of order.

An international application which enters the national stage will be forwarded to the appropriate Technology Center (TC) for examination in turn based on the 35 U.S.C. 371(c) date of the application. As set forth in 37 CFR 1.496(b), if an application includes only claims which have been indicated in an IPER prepared by the USPTO to satisfy the criteria of PCT Article 33(1)-(4), the application qualifies for the reduced basic national fee set forth in 37 CFR 1.492(a)(4). Applications in which the reduced basic national fee has been paid will be taken up out of order by the examiner. See MPEP § 708 for a discussion of the order of examination of applications by examiners.

Once the national stage application has been taken up by the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that:

(A) the international filing date is the date to keep in mind when searching the prior art; and

(B) unity of invention proceeds as under 37 CFR 1.475.

>In addition, the International Publication Number and the Publication Date MUST be in the national stage application if the application is allowed. The International Publication Number and the Publication date can be found in the WIPO Publication block on the DO/US Worksheet. If the Publication Number and the Publication date are not found on the worksheet or if the worksheet is missing, the information may be taken either from the International Publication or the *PCT Gazette* page. The examiner should ensure that the International Publication Number and the Publication date are in one of these three locations before the application is sent to Office of Patent Publication.<

### 1893.03(a) How To Identify That an Application Is a U.S. National Stage Application [R-2]

Applicant's initially deposited application must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. See 37 CFR 1.495(g). Otherwise, unless the submission is clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4) for the purpose of obtaining provisional rights, the application will be treated as an application filed under 35 U.S.C. 111(a). See 37 CFR 1.417.

That is, if applicant wishes the application to be filed under 35 U.S.C. 111(a), applicant's originally filed application papers need indicate simply that the papers are for a new U.S. patent application. If, however, applicant is submitting papers for entry into the national stage of a PCT application, or to establish an effective date for provisional rights resulting from the filing of a PCT application under 35 U.S.C. 154(d), applicant must so state. Examination of the original application papers occurs in either the Office of Initial Patent Examination or in the National Stage Processing Division of the Office of PCT Operations where it is determined whether applicant has asked that the papers be treated as a submission to enter the national stage under 35 U.S.C. 371. If the application is accepted for entry into the national stage, the National Stage Processing Division will mail Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 and will stamp the face of the file with an indication that the application is "filed under 35 U.S.C. 371." Accordingly, the key indicators which reflect that an application is an application which entered the national stage from an international application after compliance with 35 U.S.C. 371 are:

(A) The file face indication of "filed under 35 U.S.C. 371";

(B) PALM will indicate that the application is a national stage application (e.g., under "Continuity Data");

(C) The Form PCT/DO/EO/903 indicating acceptance of the application as a national stage application which has met the requirements of 35 U.S.C. 371; and

\*>

(D) Applicant's statement (or the equivalent) in the originally filed application papers that the application is a submission to enter the national stage under 35 U.S.C. 371. Applicants who use transmittal Form PCT/DO/EO/1390 will, in the absence of conflicting instructions, satisfy the requirement for such a statement since the form includes an indication that the application is a national stage submission under 35 U.S.C. 371.

Initially, the examiner should inspect the face of the file wrapper (if not an IFW) and/or PALM for an indication that it was submitted under 35 U.S.C. 371 and should also check the application papers for the presence of Form PCT/DO/EO/903. If neither of these indications are present the application may, in the absence of evidence to the contrary (there is an indication in the originally filed application papers that processing as a national stage is desired), be treated as a filing under 35 U.S.C. 111(a). Thus, if both indications are present, the application should be treated as a submission under 35 U.S.C. 371. If the application is not an IFW and the face of the file wrapper does not indicate "filed under 35 U.S.C. 371," but a properly completed Form PCT/DO/EO/903 is in the file, the examiner should complete the face of the file by adding "filed under 35 U.S.C. 371" in the upper left margin thereof. The examiner should initial and date this change. If the file wrapper does not include a properly completed Form PCT/DO/EO/903 but the face of the file indicates "filed under 35 U.S.C. 371," the application should be returned to the National Stage Processing Division of the Office of PCT Operations for certification that the application has been accepted for the national stage.

In accordance with the notice at 1077 O.G. 13 (14 April 1987), if the applicant files a U.S. national application and clearly identifies in the accompanying oath or declaration the specification to which it is directed by referring to a particular international application by PCT Application Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application, then the application will be accepted as submitted under 35 U.S.C. 371. Merely claiming priority of an international (PCT)

application in an oath or declaration will not serve to indicate a \*>submission< under 35 U.S.C. 371. Also, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a). \*\*>A conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. 371, a “Utility

Patent Application Transmittal” (Form PTO/SB/05) or includes a benefit claim under 35 U.S.C. 120 to the international application. Applications that have been processed under 35 U.S.C. 371 and later found by the examiner to contain conflicting instructions should be forwarded to the Office of PCT Legal Administration for resolution.<

\*\*&gt;



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1459  
 Alexandria, Virginia 22313-1459  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/611,687	John Smith	00000

INTERNATIONAL APPLICATION NO.

PCT/BR02/33313

I.A. FILING DATE

PRIORITY DATE

01/01/2003

12/28/2002

John Smith  
 212 Main Street  
 Anytown, PA 12345

CONFIRMATION NO. 1271

371 ACCEPTANCE LETTER



\*OC00000009879118\*

Date Mailed: 02/19/2004

**NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.495**

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as a Designated / Elected Office (37 CFR 1.495), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

The United States Application Number assigned to the application is shown above and the relevant dates are:

11/01/200311/01/2003

DATE OF RECEIPT OF 35 U.S.C. 371(c)(1), (c)(2)  
 and (c)(4) REQUIREMENTS

DATE OF COMPLETION OF ALL 35 U.S.C. 371  
 REQUIREMENTS

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE APPEARING ON THE FILING RECEIPT AS THE " FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363). Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

The following items have been received:

- Indication of Small Entity Status
- Copy of the International Application filed on 11/01/2003
- English Translation of the IA filed on 11/01/2003
- Copy of the International Search Report filed on 11/01/2003
- Copy of IPE Report filed on 11/01/2003
- Copy of Annexes to the IPE filed on 11/01/2003
- Copy of Article 19 Amendments filed on 11/01/2003
- Preliminary Amendments filed on 11/01/2003
- Information Disclosure Statements filed on 11/01/2003
- Biochemical Sequence Diskette filed on 11/01/2003
- Oath or Declaration filed on 11/01/2003
- Biochemical Sequence Listing filed on 11/01/2003
- Small Entity Statement filed on 11/01/2003
- Request for Immediate Examination filed on 11/01/2003
- Copy of references cited in ISR filed on 11/01/2003



- U.S. Basic National Fees filed on 11/01/2003
- Substitute Specification filed on 11/01/2003
- Assignment filed on 11/01/2003
- Priority Documents filed on 11/01/2003
- Power of Attorney filed on 11/01/2003

The following defects have been observed:

- The translations of Annexes are canceled since the translations were not submitted prior to 30 months from the priority date.

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Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

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TAMALA D HOLLAND  
Telephone: (703) 305-5483

PART 1 - ATTORNEY/APPLICANT COPY

FORM PCT/DO/EO/903 (371 Acceptance Notice)

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## 1893.03(b) The Filing Date of a U.S. National Stage Application [R-2]

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application. Specifically, 35 U.S.C. 363 provides that

An international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

Similarly, PCT Article 11(3) provides that

...an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

37 CFR 1.496(a), first sentence, reads “International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date on which such requirements were met.” Thus, when the file wrapper label or PALM bib-data sheet \*and filing receipt are printed, the information is read from the PALM data base and the information printed in the filing date box is the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements rather than the actual international filing date.

\*The NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903), a copy of which is reproduced in MPEP § 1893.03(a), indicates the date of receipt of the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements, and it also indicates the date of completion of all 35 U.S.C. 371 requirements, which is further explained below.

The “Application Filing Date” field formerly displayed in \*\*PAIR\*\* was changed to “Filing or 371(c) Date” to clearly indicate that for international applications that enter the national stage under 35 U.S.C. 371, the information displayed in this field

is the date of receipt of the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements. Applicants are quite often confused as to the true filing date and will ask for corrected filing receipts thinking that the information thereon is wrong. This explanation should offer some clarity. For most legal purposes, the filing date is the PCT international filing date. Exceptions to this general rule include the following:

(A) Availability as a prior art reference under former 35 U.S.C. 102(e) (prior to the amendment by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999))). If a U.S. patent issued from an international application filed prior to November 29, 2000, the international application was not considered to have been filed in the United States for prior art purposes under 35 U.S.C. 102(e) and PCT Article 64(4)(a) until the date the application fulfilled the requirements of 35 U.S.C. 371(c) (1), (2), and (4).

(B) Availability as a prior art reference under 35 U.S.C. 102(e) as amended by the AIPA, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)). If an international application was filed on or after November 29, 2000, but did not designate the U.S. or was not published in English under PCT Article 21(2), the international filing date is not treated as a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). See MPEP § 706.02(a) and § 2136.03.

(C) Patent term adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) when the USPTO has failed to issue a patent within three years of the “actual filing date” of an application. In this situation, the “actual filing date” is the date the national stage commenced under 35 U.S.C. 371(b) or (f). See MPEP § 2730.

>The “Date of Completion of all 35 U.S.C. 371 Requirements” included on the NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) is relevant for purposes of patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1) when the USPTO has failed to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the

requirements under 35 U.S.C. 371 were fulfilled. This date is the latest of:

(A) the date of submission of the basic national fee;

(B) the date of submission or communication of the copy of the international application;

(C) the date of submission of the translation of the international application if the international application is not in the English language;

(D) the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371 (c)(4) (see 37 CFR 1.497(c) for an explanation of when an oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4));

(E) the earlier of 30 months from the priority date or the date of request for early processing under 35 U.S.C. 371(f) if requested prior to 30 months from the priority date (Form PCT/DO/EO/903 will indicate the date early processing was requested);

(F) if a request for early processing has not been requested prior to 30 months from the priority date, the date of submission of any translation of the annexes to the international preliminary examination report if the annexes are filed within the time period set in a Notice of Missing Requirements (Form PCT/DO/EO/905) requiring either a translation of the international application or an oath or declaration; and

(G) the date of submission of any surcharge for submitting the oath or declaration later than 30 months from the priority date.<

### **1893.03(c) The Priority Date, Priority Claim, and Priority Papers for a U.S. National Stage Application [R-2]**

A U.S. national stage application **\*\*>**may be entitled to: (A) a right of priority under 35 U.S.C. 119(a) and 365(b) based on a prior foreign application or international application designating at least one country other than the United States; and (B) the benefit of an earlier filed U.S. national application or international application designating the United States pursuant to 35 U.S.C. 119(e) or 35 U.S.C. 120 and 365(c).

### **RIGHT OF< PRIORITY \* UNDER 35 U.S.C. 119(a) and 365(b)**

**\*\*>**Pursuant to 35 U.S.C. 365(b)< a U.S. national stage application **\*\*>**shall be entitled to a right of priority based on a prior foreign application or international application designating at least one country other than the United States in accordance with the conditions and requirements of< 35 U.S.C. 119(a) and **\*\*>**the treaty and the PCT regulations. See in particular PCT Article 8 and PCT Rules 4.10 and 26<sup>bis</sup>. To obtain priority in the U.S. national stage application to such applications, the priority must have been timely claimed in the international stage of the international application. See 37 CFR 1.55(a)(1)(ii). If priority< was properly claimed in the international stage of the international application, the claim for priority is acknowledged and the national stage application file is checked to see if the file contains a copy of the certified copy of the priority document submitted to the International Bureau.

If the **\*\*** priority claim in the national stage application is to an application, the priority of which was not claimed in the international stage of the international application, the claim for priority must be denied for failing to meet the requirements of the Patent Cooperation Treaty, specifically PCT Rule 4.10.

For a comparison with 35 U.S.C. 119(a)-(d) priority claims in a national application filed under 35 U.S.C. 111(a), see MPEP § 1895.01.

### **THE CERTIFIED COPY**

The requirement in PCT Rule 17 for a certified copy of the foreign priority application is normally fulfilled by applicant providing a certified copy to the receiving Office or to the International Bureau within 16 months from the priority date. Subsequently, the International Bureau forwards a photocopy of the certified priority document when it forwards a copy of the international application (shortly after publication at 18 months from the priority date) to each Designated Office. The copy from the International Bureau is placed in the U.S. national stage file. The International Bureau stamps the face of the photocopy of the certified priority document with an indication that the certified priority document was received at the International Bureau. The stamped copy of the priority document sent to the U.S. Patent and Trademark

Office from the International Bureau is acceptable to establish that applicant has filed a certified copy of the priority document. The examiner should acknowledge in the next Office action that the certified copy of the foreign priority document has been filed. Note

the example of an acceptable priority document with the stamp (box) in the upper right hand section indicating receipt by the International Bureau (WIPO) on 30 November 1992 and the stamped term "PRIORITY DOCUMENT."

REPUBLIQUE FRANÇAISE

INSTITUT NATIONAL DE LA PROPRIÉTÉ INDUSTRIELLE

PRIORITY DOCUMENT

REC'D 3 0 NOV 1992

WIPO PCT

# BREVETS D'INVENTION

## CERTIFICATS D'UTILITÉ CERTIFICATS D'ADDITION

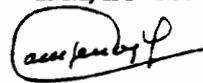
### Copie officielle

Le Directeur général de l'Institut national de la propriété industrielle certifie que le document ci-annexé est la copie certifiée conforme, d'une demande de titre de propriété industrielle déposée à l'Institut.

Fait à Paris le 7 SEP. 1992

Pour le Directeur général de l'Institut  
national de la propriété industrielle

Le Chef de Division



Yves CAMPENON



26bis, rue de Lénine 75800 PARIS Cédex 08  
Tél. (1) 42 94 52 52 Télex 290 368 INPI PAR Télécopie (1) 42 93 59 30  
Établissement public national créé par la loi n° 51-444 du 19 avril 1951

BA 267/141190

If applicant has not forwarded a certified copy of the priority application in time for the International Bureau to forward it to the U.S. Designated Office with the copy of the international application, then applicant will have to provide a certified copy of the priority document during the national stage to fulfill the requirement of 37 CFR 1.55(a)(2).

**\*>BENEFIT< CLAIM UNDER 35 U.S.C. 119(e), OR 120 AND 365(c)**

A national stage application may include a \*>benefit< claim under 35 U.S.C. 119(e), or 120 and 365(c) to a prior U.S. national application or under 35 U.S.C. 120 and 365(c) to a prior international application designating the U.S. The conditions for according benefit under 35 U.S.C. 120 are as described in MPEP § 201.07, § 201.08, and § 201.11 and are similar regardless of whether the U.S. national application is a national stage application submitted under 35 U.S.C. 371 or a national application filed under 35 U.S.C. 111(a).

The conditions for according benefit under 35 U.S.C. 119(e) are also similar for national stage applications and applications filed under 35 U.S.C. 111(a), and the conditions are described in MPEP § 201.11.

In order for a national stage application (of international application “X”) to obtain benefit under 35 U.S.C. 119(e) of a prior U.S. provisional application, the national stage application must comply with the requirements set forth in 37 CFR 1.78(a)(4) through 37 CFR 1.78(a)(6). Public Law 106-113 amended 35 U.S.C. 119(e) to eliminate the copendency requirement for a nonprovisional application claiming benefit of a provisional application. 35 U.S.C. 119(e)(2) as amended became effective on November 29, 1999 and applies to provisional applications filed on or after June 8, 1995. 37 CFR 1.78(a)(4) requires that the prior provisional application must be entitled to a filing date as set forth in 37 CFR 1.53(c), and the basic filing fee set forth in 37 CFR 1.16(k) must be paid on the provisional application within the time period set forth in 37 CFR 1.53(g). Additionally, the provisional application must name as an inventor at least one inventor named in the later filed international application “X” and disclose the named inventor’s invention claimed in at least one claim of the national stage application in the

manner provided by the first paragraph of 35 U.S.C. 112. The national stage application must contain a reference to the provisional application (either in an application data sheet (37 CFR 1.76) or in the first sentence of the specification), identifying it as a provisional application, and including the provisional application number (series code and serial number). The required reference to the earlier provisional application must be submitted within the time period provided by 37 CFR 1.78(a)(5)(ii). This time period is not extendable. >However, if the entire delay, between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed, was unintentional, a petition under 37 CFR 1.78(a)(6) may be filed to accept the delayed claim.< If the provisional application was filed in a language other than English, the provisional application or the national stage application must contain an English-language translation of the non-English language provisional application and a statement that the translation is accurate. If the translation and statement that the translation is accurate were not previously filed in the provisional application or in the later-filed national stage application, applicant will be notified and given a period of time within which to file an English-language translation and a statement that the translation is accurate. Failure to timely reply to such a notice will result in abandonment of the national stage application. See 37 CFR 1.78(a)(5)(iv).

In order for a national stage application (of international application “X”) to obtain benefit under 35 U.S.C. 120 and 365(c) of a prior filed copending nonprovisional application or prior filed copending international application designating the United States of America, the national stage application must comply with the requirements set forth in 37 CFR 1.78(a)(1) through 37 CFR 1.78(a)(3). The prior nonprovisional application or international application must name as an inventor at least one inventor named in the later filed international application “X” and disclose the named inventor’s invention claimed in at least one claim of the national stage application in the manner provided by the first paragraph of 35 U.S.C. 112. The national stage application must contain a reference to the prior nonprovisional or international application (either in an application data sheet (37 CFR 1.76) or in the first sentence of the specification), identifying it by application number (series

code and serial number) or international application number and international filing date and indicating the relationship of the applications. The required reference to the earlier filed application must be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior-filed application. This time period is not extendable and failure to timely submit the required reference to the earlier application will be considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. See 37 CFR 1.78(a)(2)(ii). However, if the entire delay, between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed, was unintentional, a petition under 37 CFR 1.78(a)(3) may be filed to accept the delayed claim.

A prior filed nonprovisional application is copending with the national stage application if the prior U.S. national application was pending on the international filing date of the national stage application.

A prior international application designating the United States of America is copending with the national stage application if the prior international application was not abandoned or withdrawn on the international filing date of international application "X."

Note: a national stage application submitted under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. See also MPEP § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a benefit claim >under 35 U.S.C. 120< in the national stage to the international application is inappropriate >and may result in the submission being treated as an application filed under 35 U.S.C. 111(a). See MPEP § 1893.03(a)<. Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage.

For a comparison with 35 U.S.C. 120 benefit claims in a national application filed under 35 U.S.C. 111(a), see MPEP § 1895.

### **1893.03(d) Unity of Invention [R-2]**

*37 CFR 1.499. Unity of invention during the national stage*

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

PCT Rule 13 was amended effective July 1, 1992. 37 CFR 1.475 was amended effective May 1, 1993 to correspond to PCT Rule 13.

Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371. Restriction practice continues to apply to U.S. national applications filed under 35 U.S.C. 111(a), even if the application filed under 35 U.S.C. 111(a) claims >benefit under 35 U.S.C. 120 and 365(c)< to an earlier international application >designating the United States< or to an earlier U.S. national stage application submitted under 35 U.S.C. 371.

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. >See MPEP § 1850 for a detailed discussion of Unity of Invention.< The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that

involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. Note also >the< examples \*\* contained in \*\*>Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO's web site ([www.wipo.int/pct/en/texts/gdlines.htm](http://www.wipo.int/pct/en/texts/gdlines.htm))<.

A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process.

An apparatus or means is specifically designed for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process. The expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor does it imply that the process could not be carried out using an alternative apparatus or means.

Note: the determination regarding unity of invention is made without regard to whether a group of inventions is claimed in separate claims or as alternatives within a single claim. The basic criteria for unity of invention are the same, regardless of the manner in which applicant chooses to draft a claim or claims.

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## FORM PARAGRAPHS FOR LACK OF UNITY IN NATIONAL STAGE APPLICATIONS

### ¶ 18.19 National Stage Restriction in 35 U.S.C. 371 Applications

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

#### Examiner Note:

1. This form paragraph is to be used when making a restriction requirement in an application filed under the provisions of 35 U.S.C. 371.
2. This form paragraph is to be followed by form paragraphs 18.06 through 18.06.02, as appropriate, and by form paragraph 18.07.

### ¶ 18.20 National Stage Election of Species in 35 U.S.C. 371 Applications

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

[1]

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

#### Examiner Note:

1. This form paragraph is to be used when making an election of species requirement in an application filed under the provisions of 35 U.S.C. 371.
2. In bracket 1, list each species by Fig. No. or embodiment.
3. This form paragraph is to be followed by form paragraphs 18.17 and 18.18.

### ¶ 18.21 National Stage Election by Original Presentation in 35 U.S.C. 371 Applications

Newly submitted claim [1] directed to an invention that lacks unity with the invention originally claimed for the following reasons: [2]

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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### **1893.03(e) Papers Received from the International Bureau and Placed in a U.S. National Stage Application File [R-2]**

The national stage application includes papers forwarded by the International Bureau and papers from applicant. Some of the papers from the International Bureau are identified in this section with a brief note as to their importance to the national stage application. The examiner should review each such paper and the important aspect indicated.

#### **THE PAMPHLET**

The Pamphlet includes

(A) a cover page with the applicant/inventor data, the application data (\*>application< number, filing date, etc.) and the Abstract (and, if appropriate, a figure of drawing),

(B) the description, claims and drawing parts of the international application, and

(C) the search report (Form PCT/ISA/210).

The cover page is important as a source of the correct application data, most importantly the filing date and priority date accorded to the international application. If the pamphlet is published in English, \*\*>the< Office will use the description, claims, abstract and drawings as published in the pamphlet for the U.S. national stage \*>application< under 35 U.S.C. 371. The description, claims and drawing parts of the international application reflect the application subject matter on the international filing date and are important for comparison with any amendments to check for new matter. The search report reflects the International Searching Authority's opinion regarding the prior art.

When the international application is published as the pamphlet, the abstract is reproduced on the cover page of the publication, even though it appears on a separate sheet of the international application in accordance with PCT Rule 11.4(a). Thus the requirement of 37 CFR 1.52(b) that the abstract "commence on a separate >physical< sheet >or electronic page<" does not apply to the copy of the application (pamphlet) communicated to the designated Offices by the International Bureau under PCT Article 20. Accordingly, it is improper for the examiner of the U.S.

national stage application to require the applicant to provide an abstract commencing on a separate sheet if the abstract does not appear on a separate sheet in the pamphlet. Unless the abstract is properly amended under the U.S. rules during national stage processing, the abstract that appears on the cover page of the pamphlet will be the abstract published by the USPTO under 35 U.S.C. 122(b) and in any U.S. patent issuing from the application.

>In addition, the Office will normally use the title of the invention indicated on the cover page of the publication as the title of the national stage application that will appear on the filing receipt. The cover page will include an English translation of the title if the international application was published in a foreign language. See PCT Rule 48.3(c). Applicants desiring to have the filing receipt reflect a title that is different than the English language title appearing on the cover page must submit either a preliminary amendment amending the title or an application data sheet (37 CFR 1.76) with the desired title. Filing receipts are mailed shortly after the mailing of the NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903).<

#### **THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT \*\*>AND THE INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (CHAPTER I AND II)**

When an international preliminary examination is performed by an International Preliminary Examining Authority (IPEA), an international preliminary examination report (IPER) is prepared on Form PCT/IPEA/409 by the IPEA and sent to the elected Offices. This report reflects the IPEA's non-binding opinion regarding novelty, inventive step and industrial applicability. For international applications filed on or after January 1, 2004, the IPER bears the title "International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)".

If the applicant did not timely file a demand for international preliminary examination with the IPEA, and the international application has a filing date on or after January 1, 2004, then an "International Preliminary Report on Patentability (Chapter I of the Patent Cooperation Treaty)" reflecting the International Searching Authority's (ISA's) non-binding

opinion regarding novelty, inventive step and industrial applicability is sent to the designated Offices.

The examiner may adopt any portion or all of the report on patentability of the IPEA or ISA upon consideration in the national stage so long as it is consistent with U.S. practice. The first Office action on the merits should indicate the report on patentability of the IPEA or ISA has been considered by the examiner. The indication may be a mere acknowledgement.

The IPER may include annexes, i.e., amendments to the international application that were made during the international phase. See MPEP § 1893.01(a)(3). These annexes will be placed in the U.S. national stage application file. Consequently, if the international application has been extensively amended during the international stage, there may be a number of different copies of the description, claims and drawings present in the national stage application file. The IPER may be consulted in Box No. I “Basis of the report” to determine what pages the report was based upon. Using the IPER as a roadmap of what happened during Chapter II examination will help determine which version should be examined.

Original sheets, substitute sheets, and rectified sheets included as part of the application examined under Chapter II are listed in the IPER as pages “originally filed/furnished.” Replacement sheets showing amendments made under PCT Article 19 or 34 and considered during Chapter II are also listed. See MPEP § 1879. If the IPER was established in a language other than English, the International Bureau will translate the IPER into English. However, the International Bureau will not translate the annexes to the IPER into English. Unless proper and timely translations are furnished by the applicant, foreign language annexes will be considered canceled. See MPEP § 1893.01(a)(3). All replacement sheets in the international application are marked with the international application number and the date of receipt in the upper right-hand corner. Replacement sheets that contain changes in format only and are accepted by the receiving Office are marked as “SUBSTITUTE SHEET” at the bottom of the page. Replacement sheets that contain a rectification of an obvious error and are accepted by either the ISA or the IPEA are marked as “RECTIFIED SHEET” at the bottom of the

page. Additionally, replacement sheets to the claims submitted to the International Bureau as Article 19 Amendments will be marked as “AMENDED SHEET (Article 19)” at the bottom of the page. Furthermore, replacement sheets to the description, claims and drawings submitted to the IPEA as Article 34 Amendments will be marked as “AMENDED SHEET” at the bottom of the page. The IPER will indicate in “Box No. I Basis of the Report” that replacement sheets submitted under either PCT Article 19 or 34 have been considered and will indicate the date they were received and the replacement sheets will be annexed to the IPER. The NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) should also be consulted, as it will indicate if the annexes or their translation have not been entered. A sample copy of the form has been reproduced at the end of MPEP § 1893.03(a). Additionally, if the annexes have been entered, the National Stage Processing Division of the Office of PCT Operations will write in pencil on any original sheet(s) or translations thereof that were replaced, “Replaced by Article 34 Amendment” and on the amended sheet(s) or translations thereof,” Article 34.”<

## THE PRIORITY DOCUMENT

See the discussion in MPEP § 1893.03(c).

## NOTIFICATION OF WITHDRAWAL

If the national stage application papers include an indication that the international application or US designation has been withdrawn, then the application should be brought to the attention of the Office of PCT Legal Administration to determine whether the withdrawal occurred prior to completion of the requirements under 35 U.S.C. 371(c). If the withdrawal occurred prior to completion of the requirements under 35 U.S.C. 371(c), then entry into the U.S. national stage is prohibited. See 35 U.S.C. 366. The indication of withdrawal may appear on a Notification of Withdrawal (PCT/IB/307 or PCT/RO/136), a Notification that International Application Considered to Be Withdrawn (Form PCT/RO/117), or other notification.

### **1893.03(f) Drawings and PCT Rule 11 [R-2]**

The drawings for the national stage application must comply with PCT Rule 11. The copy of the drawings provided by the International Bureau has already been checked and should be in compliance with PCT Rule 11. Accordingly, the drawing provided by the International Bureau >(see MPEP § 1893.03(e)< should be acceptable. The USPTO may not impose requirements beyond those imposed by the Patent Cooperation Treaty (e.g., PCT Rule 11). However, the examiner does \* have the authority to require new \*\* drawings if the drawings were published without meeting all requirements under the PCT for drawings. \*\*

### **1893.03(g) Information Disclosure Statement in a National Stage Application [R-2]**

An extensive discussion of Information Disclosure Statement practice is to be found in MPEP § 609. Although not specifically stated therein, the duty to disclose information material to patentability as defined in 37 CFR 1.56 is placed on individuals associated with the filing and prosecution of a national stage application in the same manner as for a domestic national application. The \*\*>averment< with respect to the duty under 37 CFR 1.56 >required under 37 CFR 1.63(b)(3) in an oath or declaration is applicable to oaths and declarations filed in U.S. national stage applications. See 37 CFR 1.497(c)<.

When an international application is filed under the Patent Cooperation Treaty (PCT), prior art documents may be cited by the examiner in the international search report and/or the international preliminary examination report. It is desirable for the U.S. examiner to consider the documents cited in the international application when examining the U.S. national stage application or when examining an application filed under 35 U.S.C. 111(a) which claims the benefit of the international application under 35 U.S.C. 365(a) or (c).

As a result of an agreement among the European Patent Office (EPO), Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO), copies of documents cited in the international search report issued by any one of these Inter-

national Searching Authority Offices generally are being sent to the other Offices when designated in the international application. Accordingly, in many national stage applications where the international search was conducted by the EPO, JPO, or USPTO, copies of the documents cited in the international search report are made available to the examiner in the national stage application.

When all the requirements for a national stage application have been completed, applicant is notified (Form PCT/DO/EO/903) of the acceptance of the application under 35 U.S.C. 371, including an itemized list of the items received. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form. See form paragraphs 6.53, 6.54, and 6.55 (reproduced in MPEP § 609). Otherwise, applicant must follow the procedure set forth in 37 CFR 1.97 and 1.98 in order to ensure that the examiner considers the documents cited in the international search report.

This practice applies only to documents cited in the international search report relative to a national stage application filed under 35 U.S.C. 371. It does not apply to documents cited in an international preliminary examination report that are not cited in the search report. It does not apply to applications filed under 35 U.S.C. 111(a) claiming the benefit of an international application filing date.

### **1895 A Continuation>, Divisional,< or Continuation-in-Part Application of a PCT Application Designating the United States [R-2]**

It is possible to file a U.S. national application under 35 U.S.C. 111(a) during the pendency (prior to the abandonment) of an international application which designates the United States without completing the requirements for entering the national stage

under 35 U.S.C. 371(c). The ability to take such action is based on provisions of the United States patent law. 35 U.S.C. 363 provides that “[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office....” 35 U.S.C. 371(d) indicates that failure to timely comply with the requirements of 35 U.S.C. 371(c) “shall be regarded as abandonment... by the parties thereof....” It is therefore clear that an international application which designates the United States has the effect of a pending U.S. application from the international application filing date until its abandonment as to the United States. The first sentence of 35 U.S.C. 365(c) specifically provides that “[i]n accordance with the conditions and requirements of section 120 of this title,... a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States.” The condition of 35 U.S.C. 120 relating to the time of filing requires the later application to be filed before the patenting or abandonment of or termination of proceedings on the first application. The filing of continuations \*\* of an international (PCT) application designating the U.S. was used primarily in instances where there was difficulty in obtaining a signed oath or declaration by the expiration of the time for entry into the national stage. Because these continuation \*\* applications historically resulted from a need to bypass the requirements of 35 U.S.C. 371, they became known as “bypass” applications. Since applicants are now notified of missing or defective oaths or declarations and/or translations, and are given a time period to respond which is extendable under 37 CFR 1.136(a), the use of this practice >with respect to continuation applications< has diminished.

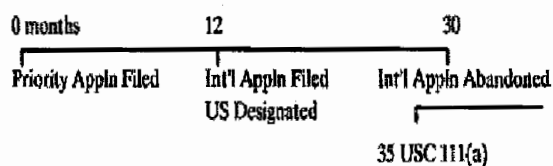
\*\*>Continuation-in-part applications are generally filed in instances where applicants seek to add matter to the disclosure which is not supported by the disclosure of the international application as originally filed, as new matter may not be added to a U.S. national stage application. See 37 CFR 1.121(f).<

## 1895.01 Handling of and Considerations in the Handling of \*\* Continuations>, Divisions,< and Continuations-In-Part of \* PCT \*>Applications< [R-2]

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Rather than \*\*>submitting< national stage application >papers under 35 U.S.C. 371<, a continuing application (i.e., continuation, C-I-P, or division) under 35 U.S.C. 111(a) of the international >(PCT)< application may be filed. Pursuant to 35 U.S.C. 365(c), a regular national application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) (not under 37 CFR 1.53(d) or former 37 CFR 1.60 or 1.62) may claim benefit of the filing date of an international application which designates the United States.

A typical time line involving a continuing application filed during the pendency of an international application is illustrated as follows:



\*\*>To obtain benefit under 35 U.S.C. 120 and 365(c) of a prior international application designating the U.S., the continuing application must:

(A) include a specific reference to the prior international application (either in the application data sheet (37 CFR 1.76) or in the first sentence of the specification),

(B) be copending with the prior international application, and

(C) have at least one inventor in common with the prior international application.

With regard to (A), the specific reference to the international application required under 35 U.S.C. 120 and 365(c) must either be contained in the first sentence of the specification or included in an application data sheet. 37 CFR 1.78(a)(2)(iii). The specific reference must identify the parent international application by international application number and inter-

national filing date and indicate the relationship of the applications (i.e., continuation, continuation-in-part, or division). See 37 CFR 1.78(a)(2)(i) and MPEP § 201.11. An example of an appropriate first sentence of the specification is, for example, “This is a continuation of International Application PCT/EP2004/000000, with an international filing date of January 5, 2004, now abandoned.” The required reference must be submitted within the time period provided by 37 CFR 1.78(a)(5)(ii). This time period is not extendable. A certified copy of the international application (and an English translation) of the international application may be required by the examiner to perfect the claim for benefit under 35 U.S.C. 120 and 365(c) if the international application did not originate in the United States and such is necessary, for example, where an intervening reference is found and applied in a rejection of one or more claims. If the international application was published by the International Bureau pursuant to PCT Article 21, then a certified copy would not normally be necessary.

If benefit under 35 U.S.C. 119(e), 120 and 365(c) is also being claimed to an earlier filed national application (or international application designating the U.S.) via an intermediate international application designating the U.S., the examiner must examine the intermediate international application to see if it contains a proper reference to the earlier application. The reference will usually be included on the cover page of the published international application and/or may appear in the first sentence of the description of the published application. A lack of a proper reference in the published international application does not necessarily mean that a proper reference is not contained in the second international application. Accordingly, the examiner may need to inspect the Home Copy of the international application (if the USPTO was the receiving Office) to determine whether the requirements under 37 CFR 1.78(a) have been satisfied. For example, the Home Copy file may contain a proper reference in a separate paper or a decision granting a petition to accept a late benefit claim may be present in the application file. See MPEP § 201.11(a).

With regard to (B), a U.S. national application is considered copending with a prior international application designating the U.S. if the international application was pending on the filing date of the U.S. national application. Generally, except in cases where

the international application has been withdrawn (either generally or as to the United States), an international application becomes abandoned as to the United States upon expiration of 30 months from the priority date (i.e., the priority date claimed in the international application or, if no priority is claimed, the international filing date) unless a proper submission under 35 U.S.C. 371 to enter the U.S. national phase is filed prior to the expiration of this 30-month period. See MPEP § 1893.01(a)(1) and § 1893.02. However, if the international application is one where the 20-month period from the priority date expired before April 1, 2002, then it was necessary to file a demand electing the United States prior to the expiration of 19 months from the priority date in order to extend the international phase to 30 months from the priority date. If such a demand was not timely filed, then under former 37 CFR 1.494, such an international application became abandoned at the expiration of 20 months from the priority date unless a proper submission under 35 U.S.C. 371 to enter the U.S. national phase was made prior to the expiration of 20 months from the priority date. Accordingly, if the international application is not subject to the filing of a demand in order to delay entry into the U.S. national phase to 30 months from the priority date, then a national application filed prior to the expiration of this 30 month period will be copending with the international application unless the international application was withdrawn, either generally or as to the United States, prior to the filing of the national application. To determine whether the application was withdrawn, the examiner must either review the Home Copy of the international application file (if the USPTO was the receiving Office), or require applicant to certify that the international application was not withdrawn or considered to be withdrawn, either generally or as to the United States, prior to the filing date of the national application claiming benefit under 35 U.S.C. 120 and 365(c) to such international application. If the national application claiming benefit to the international application was filed after the expiration of this 30-month period, then there will be no copendency in the absence of a timely and proper submission to enter the U.S. national phase under 35 U.S.C. 371. The existence of a national stage application may be checked through PALM and the records of the national stage application should be consulted to ver-

ify copendency. Additionally, if the 20-month period from the priority date of the international application expired before April 1, 2002 and the national application claiming benefit under 35 U.S.C. 120 and 365(c) was filed later than 20 months from the priority date of the international application, the applicant may be required to submit proof of the filing of a demand electing the United States within 19 months from the priority date. This proof may be in the form of a copy of the “Notification of Receipt of Demand by Competent International Preliminary Examining Authority” (Form PCT/IPEA/402) showing the demand was received prior to the expiration of 19 months from the priority date, and a copy of the “Notification Concerning Elected Offices Notified of Their Election” (Form PCT/IB/332) showing the election of the United States. If the parent international application was not copending (i.e., abandoned or withdrawn), benefit under 35 U.S.C. 120 is not possible.

With regard to (C), inventors will normally be identified on the cover page of the published international application. In addition, such information is indicated in the *PCT Gazette*, which is available in electronic form from WIPO’s web site ([www.wipo.int/pct/en/index.html](http://www.wipo.int/pct/en/index.html)).

#### **PRIORITY CLAIMS UNDER 35 U.S.C. 119(a)-(d)**

A claim for foreign priority under 35 U.S.C. 119 (a)-(d) must be made in the continuing application in order to obtain the benefit of the filing date of the prior filed foreign application. This is true regardless of whether such a claim was made in the parent international application. A foreign priority claim is proper in the continuing application if the foreign application was filed within 12 months prior to the filing of the continuing application or within 12 months prior to the international filing date of the parent international application. In addition, the required claim must be made within the time period set forth in 37 CFR 1.55 (a)(1). This time period is not extendable. See MPEP § 201.14. A certified copy of any foreign priority document must be provided by the applicant unless the parent international application has entered the national stage under 35 U.S.C. 371 and the national stage application contains a photocopy of the priority document from the International Bureau. See MPEP § 1893.03(c). In such case, the applicant, in the con-

tinuing application, may state that the priority document is contained in the national stage application.

For a discussion of U.S. national applications filed under 35 U.S.C. 111(a) having foreign priority claims under 35 U.S.C. 119(a)-(d) and 365(a) to a prior international application designating at least one country other than the United States, see MPEP § 201.13(b).<

#### **1896 The Differences Between a National Application Filed Under 35 U.S.C. 111(a) and a National Stage Application Submitted Under 35 U.S.C. 371 [R-2]**

The following section describes the differences between a U.S. national application filed under 35 U.S.C. 111(a), including those claiming benefit of a PCT application under 35 U.S.C. 120 (a **continuation**), **division**,< or a **continuation-in-part** of a PCT application), and a U.S. **national stage application** (submitted under 35 U.S.C. 371).

*Chart of Some Common Differences*

	National Applications (filed under 35 U.S.C. 111(a))	National Stage Applications (submitted under 35 U.S.C. 371)
Filing Date	Deposit date in USPTO of specification, claim and any necessary drawing	International filing date of PCT application
Date application was “filed in the United States” for prior art purposes under 35 U.S.C. 102(e)	See MPEP § 706.02(f)(1)	See MPEP §§ 706.02(f)(1), 1857.01, and 1895.01

	National Applications (filed under 35 U.S.C. 111(a))	National Stage Applications (submitted under 35 U.S.C. 371)
35 U.S.C. 119(a)-(d) Priority Requirement	Claim & certified copy provided by applicant	Copy of certified copy provided by WIPO, claim by applicant
Unity of Invention	U.S. restriction practice	Unity of invention practice under 37 CFR 1.499
Filing Fees	37 CFR 1.16	37 CFR 1.492
Reference to Application in Declaration	Attached application, U.S. Application No., etc.	Same as in a 35 U.S.C. 111(a) filing or may refer to the international application
Copendency with International Application	Applicant provides proof	Not an issue

The differences between a national application filed under 35 U.S.C. 111(a) and a national application submitted under 35 U.S.C. 371 are often subtle, but the differences are important.

**I. FILING DATE**

The filing date of a 35 U.S.C. 111(a) application is the date when the USPTO receives a specification >as prescribed by 35 U.S.C. 112 containing a description and at least one< claim, and any >required< drawings. See 37 CFR 1.53(b).

The filing date of a PCT international application is the date applicant satisfies Article 11 requirements, i.e., includes a >description, a claim, names at least one applicant who is a resident or national of a PCT Contracting State, filed in the prescribed language, and designates at least one Contracting State. See

MPEP § 1810. By virtue of 35 U.S.C. 363, the U.S. filing date of an international application that designates the United States is, for most legal purposes, the international filing date. See MPEP § 1893.03(b).<

**II. EFFECTIVE DATE AS A REFERENCE**

A reference under 35 U.S.C. 102(e) must be a U.S. patent, a U.S. application publication (35 U.S.C. 122(b)), or a WIPO publication of an international application under PCT Article 21(2).

***References That Did Not Result From, Nor Claimed Benefit of, an International Application***

The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper priority or benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly support(s) the subject matter used to make the rejection. See MPEP § 706.02(a).

***References That Resulted From, or Claimed Benefit of, an International Application***

If a reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(A) If the international application meets the following three conditions:

- (1) an international filing date on or after November 29, 2000;
- (2) designated the United States; and
- (3) published under PCT Article 21(2) in English,

the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). If such an international application properly claims benefit to an earlier-filed U.S. or international application, or priority to an earlier-filed U.S. provisional application, apply the reference under 35 U.S.C. 102(e) as of the earlier filing date, assuming all the conditions of 35 U.S.C. 102(e), 119(e), 120, or 365(c) are met. Note, where the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S., and had been published in English under PCT Article 21(2))

for the earlier international filing date to be a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).

(B) If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). In this situation, do **not** apply under 35 U.S.C. 102(e) the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

(C) If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments:

(1) For U.S. patents, apply the reference under 35 U.S.C. 102(e) as of the earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) or the filing date of the later-filed U.S. application that claimed the benefit of the international application;

(2) For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b);

(3) For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an international application filed prior to November 29, 2000, apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

Examiners should be aware that although a publication of, or a U.S. patent issued from, an international application may not have a 35 U.S.C. 102(e) date at all, or may have a 35 U.S.C. 102(e) date that is after the effective filing date of the application being examined (so it is not “prior art”, the corresponding WIPO

publication of an international application may have an earlier 35 U.S.C. 102(a) or (b) date.

### III. 35 U.S.C. 119(a)-(d) >AND 365(b)< PRIORITY REQUIREMENTS

The certified copy of the foreign priority application must be provided to the Office by applicant in a U.S. national application filed under 35 U.S.C. 111(a). Where applicant filed an international application claiming priority to an earlier filed national application, the certified copy of the priority application **\*\*>may<** be provided to the International Bureau by applicant during the international stage. The International Bureau (WIPO) then sends a copy of the certified copy of the priority application to each designated office for inclusion in the national stage application. A U.S. national stage application filed under 35 U.S.C. 371 will have a photocopy of the priority document with the first page stamped by the International Bureau to indicate that it is a priority document received by WIPO and the date of such receipt. Such a photocopy is acceptable in a U.S. national stage application to establish that applicant has filed a certified copy of the priority document. If the photocopy is missing from the national stage application file, either the document has been misplaced or it was not provided due to a defect in priority during the international stage. If the priority claim was not in accordance with PCT Rule 4.10 or the priority document was not provided in accordance with PCT Rule 17, the photocopy of the priority document will not have been provided by the International Bureau. >If a copy of the foreign priority document is not in the national stage application file but applicant asserts that a certified copy of the priority document was timely furnished under PCT Rule 17 in the international phase, then the examiner should consult with a Special Program Examiner in his or her Technology Center.<

### IV. UNITY OF INVENTION

U.S. national applications filed under 35 U.S.C. 111(a) are subject to restriction practice in accordance with 37 CFR 1.141-1.146. See MPEP § 803. U.S. national stage applications (which entered the national stage from international applications after compliance with 35 U.S.C. 371) are subject to unity of invention



practice in accordance with 37 CFR 1.475 and 1.499 (effective May 1, 1993).

**V. FILING FEES**

U.S. national applications filed under 35 U.S.C. 111(a) are subject to the national application filing fees set forth at 37 CFR 1.16. Submissions to enter the U.S. national stage under 35 U.S.C. 371 are subject to the national stage fees prescribed at 37 CFR 1.492.

**VI. REFERENCE TO APPLICATION IN DECLARATION**

Applicant's oath or declaration is required to identify the specification to which it is directed (37 CFR

1.63(b)(1)). The specification may be identified in a U.S. national application filed under 35 U.S.C. 111(a) by reference to an attached specification or by reference to the application number and filing date of a specification previously filed in the Office. MPEP § 601.01(a) gives the minimum requirements for identification of the specification. Submissions to enter the U.S. national stage under 35 U.S.C. 371 may identify the specification (in the oath or declaration) in the same manner as applications filed under 35 U.S.C. 111(a) or may identify the specification by reference to the application number and filing date of the international application.



MANUAL OF PATENT EXAMINING PROCEDURE