

# Chapter 1800 Patent Cooperation Treaty

1081

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## 1801 Basic PCT Principles [R-5]

### MAJOR CONCEPTS

The Patent Cooperation Treaty (PCT) is an international agreement to which the United States of America is a party, which provides for the filing of patent applications on the same invention in a number of countries. The 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 filing in as many member countries to the PCT as the applicant "designates" that is, names, as countries in which patent protection is desired. In the same manner, the PCT enables foreign applicants to file a PCT 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 that the application will be subjected to a search for published disclosures which are capable of assisting in the determination of whether the invention disclosed in the application is new and unobvious. Upon payment of national fees and the furnishing of a translation, usually some twenty 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 in each of the designated countries. If a Demand for an International Preliminary Examination is filed within 19 months of the priority date, the period for entering the national stage is extended to thirty months from the priority date.

The PCT offers an alternative route to filing patent applications directly in those countries which are members of the PCT. It does not preclude taking advantage of the priority rights and other advantages provided under the Paris Convention (PCT Article 1). The PCT provides an additional and optional foreign filing route to United States and foreign applicants.

#### PCT Article 1

##### Establishment of a Union

(1) The States party to this Treaty (hereinafter called "the Contracting States") constitute a Union for cooperation in the filing, searching, and examination, of applications for the protection of inventions, and for rendering special technical services. The Union shall be known as the International Patent Cooperation Union.

(2) No provision of this Treaty shall be interpreted as diminishing the rights under the Paris Convention for the Protection of Industrial Property of any national or resident of any country party to that Convention.

The PCT has also substantially harmonized the formal requirements of applications for the member countries and the European Patent Convention (EPC).

The PCT also provides new filing and searching procedures whereby much of the processing and transmittal of papers is done for the applicant by the various national patent offices which act as international authorities and the International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, which administers the Treaty.

The filing and search procedures are set forth in Chapter I of the PCT. Additional procedures for a preliminary examination of PCT international applications are set forth in PCT Chapter II.\*\*

### Basic Flow of PCT Chapter I

To understand the PCT, it is important to know the basic flow of an international application under the PCT. This flow is illustrated on the next page.

In most instances a U.S. national application (NA) 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 claim the priority benefit of the U.S. national application filing date.

#### RECEIVING OFFICE (RO)

The international application (IA) must be filed in a 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)). The Receiving Office functions as the filing and formalities review organization for international applications. International applications must contain upon filing the designation of those countries 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 upon filing or within one month thereafter and at the expiration of 12 months from the priority date or within one month thereafter (PCT Article 11(3) and 35 U.S.C. 361). 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 copy, called the Record Copy (RC), to the International Bureau (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 function of the International Searching Authority (ISA) is 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). At the option of the U.S. applicant, either the U.S. Patent and Trademark Office or the European Patent Office acts as an International Searching Authority for U.S. residents and nationals. The International Searching Au-

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thority is also responsible for checking the content of the title and abstract (PCT Rules 37.2 and 38.2). An International Search Report (SR) will normally be issued by the International Searching Authority within three 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 and the International Bureau (PCT Rules 43 and 44.1). The Search Report will contain a listing of those documents found to be relevant and will identify the claims in the application to which they are pertinent; however, no judgments or statements as to patentability will be made (PCT Rule 43.9). The applicant will also receive without charge a copy of the cited prior art from the U. S. Patent and Trademark Office as an International Searching Authority. Once the International Search Report has been completed and transmitted, 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

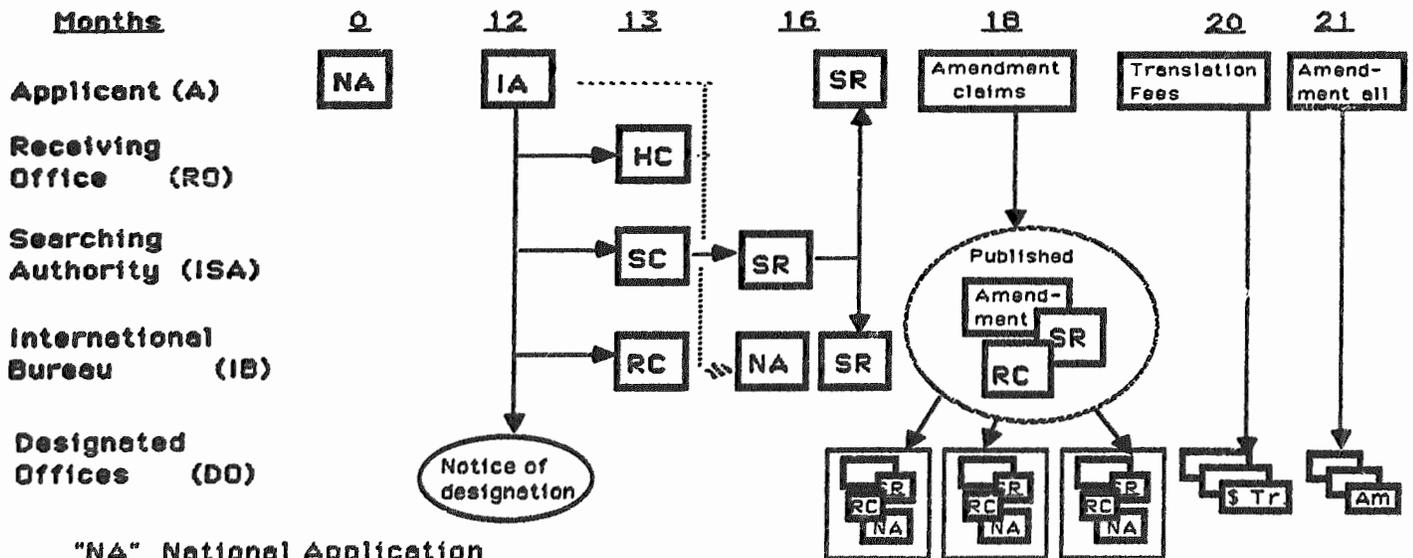
priority date (PCT Rule 17).

The applicant has normally two months from the date of transmittal of the International Search Report to amend the claims by filing an amendment directly with the International Bureau (PCT Article 19 and PCT Rule 46). The International Bureau will then normally publish (P) the international application along with the Search Report and any amendment (Amdt) at the expiration of 18 months from the priority date (PCT Article 21). 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 also publishes a >PCT< Gazette in the French and English languages which contains information similar to that on the front pages of 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)

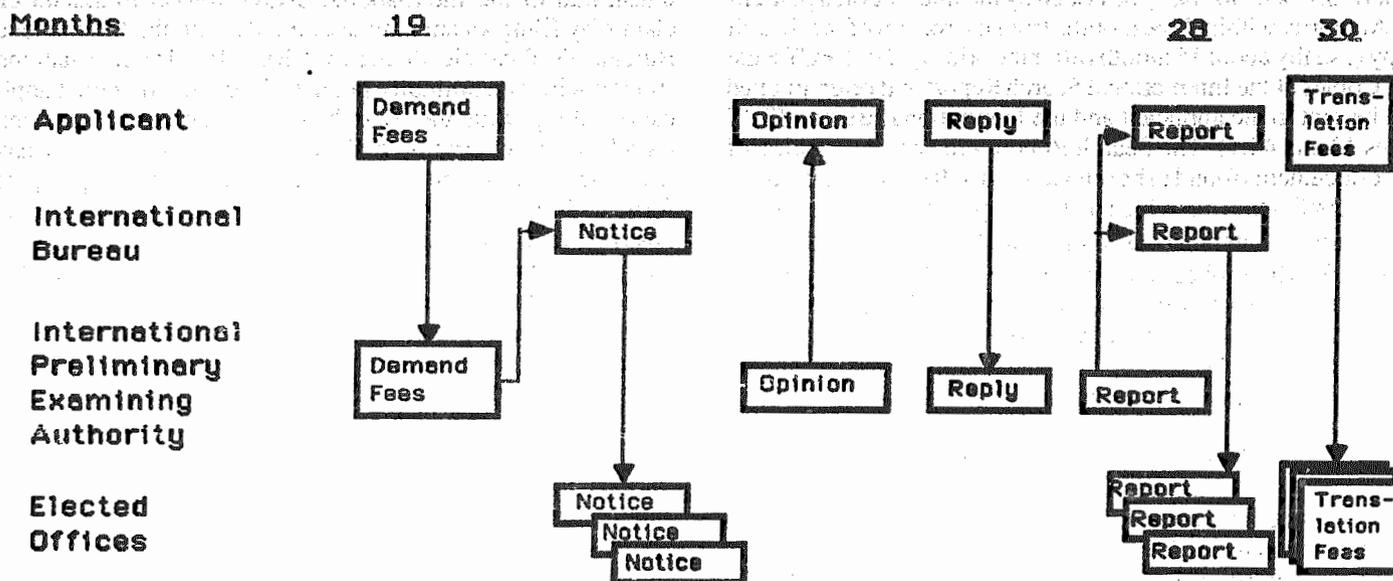
>If no Demand for International Preliminary Examination has been filed within 19 months of the priority date ,< \*\* the applicant must send to each Designated Office any required translations and the appropriate national or regional filing fees >within twenty months from the priority date of the international application,< unless the individual Designated Office grants additional time (PCT Article 22). The applicant also has

Basic Flow under PCT Chapter I



- "NA" National Application
- "IA" International Application
- "HC" Home Copy
- "SC" Search Copy
- "RC" Record Copy
- "SR" Search Report

## Basic Flow under PCT Chapter II



the right to amend the application within one month from the fulfillment of the requirements under Article 22. After this month 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)).

### >Basic Flow of PCT Chapter II

PCT Article 33  
The International Preliminary Examination

(1) The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve inventive step (to be non-obvious), and to be industrially applicable.

\*\*\*\*\*

The basic flow of PCT Chapter II is illustrated in the above diagram. If the applicant desires to obtain the benefit of delaying the entry into the national stage until the 30th month, 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.

A copy of the demand is forwarded to the International Bureau by the International Preliminary Examining Authority. The International Bureau then notifies the various elected Offices that the applicant has entered Chapter II and that the application should not be considered withdrawn for failure to enter the national stage within 20 months of the priority date.

The examiner of the International Preliminary Examining Authority may comment on lack of unity of invention, note errors, and issue a written "opinion" as to whether each claim is "novel", involves an "inventive step", and is "industrially applicable". If a written "opinion" is issued by the examiner, the applicant may respond to the opinion by arguments and amendments within the time period set for response. The examiner will

then issue the "International Preliminary Examination Report" which presents the examiner's final position as to whether each claim is "novel", involves an "inventive step", and is "industrially applicable" by the 27th month after 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 the 30th month from the priority date in order to avoid any question of withdrawal of the application as to that elected Office.

In accordance with the agreement between the United States Patent and Trademark Office (USPTO) and the International Bureau (PCT Article 34), the USPTO will act as an International Preliminary Examining Authority (IPEA) for international applications filed by residents and nationals of the United States and for those applications of other western hemisphere countries which have been searched by the USPTO as an International Searching Authority.

Upon filing of a proper demand and the payment of the necessary fees, the international application shall be the subject of an international preliminary examination.

An international preliminary examination will be carried out only on those inventions for which an International Search Report has been established since the International Preliminary Examining Authority must take into consideration the documents cited in the International Search Report. (PCT Article 33(6)).

The International Searching Authority has the responsibility of initially determining whether or not unity of invention exists in an international application. However, since searching authorities may differ on the question of unity of invention and since an applicant has the right to amend the application subsequent to the receipt of the International Search Report, the international application is again reviewed by the examiner with respect to the question of unity of invention at the onset of the international preliminary examination.

The primary purpose of international preliminary examination is to render a nonbinding opinion on the question of whether the subject matter of the international application meets the criteria set out in PCT Article 33(1), i.e., whether the claimed invention appears to be novel, to involve inventive step (to be non-obvious) and to be industrially applicable. Form PCT/IPEA/408 is provided for use by the examiner to notify applicant of any negative aspects of the application in the form of a written opinion.

After an opportunity to repond, final results of the international preliminary examination are set forth in an International Preliminary Examination Report on Form PCT/IPEA/409. This report takes into consideration any amendments that may have been filed by the applicant in response to the written opinion.<

## 1802 PCT Definitions [R-5]

### PCT Article 2 Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

(i) "application" means an application for the protection of an invention; references to an "application" shall be construed as references to applications for patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;

(ii) references to a "patent" shall be construed as references to patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;

(iii) "national patent" means a patent granted by a national authority;

(iv) "regional patent" means a patent granted by a national or an intergovernmental authority having the power to grant patents effective in more than one State;

(v) "regional application" means an application for a regional patent;

(vi) references to a "national application" shall be construed as references to applications for national patents and regional patents, other than applications filed under this Treaty;

(vii) "international application" means an application filed under this Treaty;

(viii) references to an "application" shall be construed as references to international applications and national applications;

(ix) references to a "patent" shall be construed as references to national patents and regional patents;

(x) references to "national law" shall be construed as references to the national law of a Contracting State or, where a regional application or a regional patent is involved, to the treaty providing for the filing of regional applications or the granting of regional patents;

(xi) "priority date," for the purpose of computing time limits, means:

(a) where the international application contains a priority claim under Article 8, the filing date of the application whose priority is so claimed;

(b) where the international application contains several priority claims under Article 8, the filing date of the earliest application whose priority is so claimed;

(c) where the international application does not contain any priority claim under Article 8, the international filing date of such application;

(xii) "national Office" means the government authority of a Contracting State entrusted with the granting of patents; references to a "national Office" shall be construed as referring also to any intergovernmental authority which several States have entrusted with the task of granting regional patents, provided that at least one of those States is a Contracting State, and provided that the said States have authorized that authority to assume the obligations and exercise the powers which this Treaty and the Regulations provide for in respect of national Offices;

(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;

(xv) "receiving Office" means the national Office or the intergovernmental organization with which the international application has been filed;

(xvi) "Union" means the International Patent Cooperation Union;

(xvii) "Assembly" means the Assembly of the Union;

(xviii) "Organization" means the World Intellectual Property Organization;

(xix) "International Bureau" means the International Bureau of the Organization and, as long as it subsists, the United International Bureaux for the Protection of Intellectual Property (BIRPI);

(xx) "Director General" means the Director General of the Organization and, as long as BIRPI subsists, the Director of BIRPI.

### PCT Rule 2

#### Interpretation of Certain Words

##### 2.1 "Applicant"

Whenever the word "applicant" is used, it shall be construed as meaning also the agent or other representative of the applicant, except where the contrary clearly follows from the wording or the nature of the provision; or the context in which the word is used, such as, in particular, where the provision refers to the residence or nationality of the applicant.

##### 2.2 "Agent"

Whenever the word "agent" is used, it shall be construed as meaning any person who has the right to practice before international authorities as defined in Article 49 and, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used, also the common representative referred to in Rule 4.8.

##### 2.3 "Signature"

Whenever the word "signature" is used, it shall be understood that, if the national law applied by the receiving Office or the competent International Searching or Preliminary Examining Authority requires the use of a seal instead of a signature, the word, for the purposes of that Office or Authority, shall mean seal.

### 35 U.S.C. 351 Definitions.

When used in this part unless the context otherwise indicates—

(a) The term "treaty" means the Patent Cooperation Treaty done at Washington, on June 19, 1970 \*\*.

(b) The term "Regulations", when capitalized, means the Regulations under the treaty \*\*, done at Washington on the same date as the treaty. The term "regulations", when not capitalized, means the regulations established by the Commissioner under this title.

(c) The term "international application" means an application filed under the treaty.

(d) The term "international application originating in the United States" means an international application filed in the Patent and Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.

(e) The term "international application designating the United States" means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term "Receiving Office" means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The terms "International Searching Authority" and "International Preliminary Examining Authority" mean— a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term "International Bureau" means the international intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

### 37 CFR 1.401 Definitions of terms under the Patent Cooperation Treaty.

(a) The abbreviation "PCT" and the term "Treaty" mean the Patent Cooperation Treaty.

(b) "International Bureau" means the World Intellectual Property Organization located in Geneva, Switzerland.

(c) "Administrative Instructions" means that body of instructions for

operating under the Patent Cooperation Treaty referred to in PCT Rule 89.

(d) "Request", when capitalized, means that element of the international application described in PCT Rules 3 and 4.

(e) "International application", as used in this subchapter is defined in § 1.9(b).

(f) "Priority date" for the purpose of computing time limits under the Patent Cooperation Treaty is defined in PCT Art. 2(xi). Note also § 1.465.

(g) ">Demand," when capitalized, means that document filed with the International Preliminary Examining Authority which requests an international preliminary examination.

(h) "Annexes" means amendments made to the claims, description or the drawings before the International Preliminary Examining Authority.

(i) Other terms and expressions in this Subpart C not defined in this section are to be taken in the sense indicated in PCT Art. 2 and 35 U.S.C. 351.

## 1803 Reservations Under the PCT Taken by the United States of America [R-5]

### PCT Article 64 Reservations

(1)(a) Any State may declare that it shall not be bound by the provisions of Chapter II.

(b) States making a declaration under subparagraph (a) shall not be bound by the provisions of Chapter II and the corresponding provisions of the Regulations.

(2)(a) Any State not having made a declaration under paragraph (1)(a) may declare that:

(i) it shall not be bound by the provisions of Article 39(1) with respect to the furnishing of a copy of the international application and a translation thereof (as prescribed).

(ii) the obligation to delay national processing, as provided for under Article 40, shall not prevent publication, by or through its national Office, of the international application or a translation thereof, it being understood, however, that it is not exempted from the limitations provided for in Articles 30 and 38.

(b) States making such a declaration shall be bound accordingly.

(3)(a) Any State may declare that, as far as it is concerned, international publication of international applications is not required.

(b) Where, at the expiration of 18 months from the priority date, the international application contains the designation only of such States as have made declarations under subparagraph (a), the international application shall not be published by virtue of Article 21(2).

(c) Where the provisions of subparagraph (b) apply, the international application shall nevertheless be published by the International Bureau:

(i) at the request of the applicant, as provided in the Regulations,

(ii) when a national application or a patent based on the international application is published by or on behalf of the national Office of any designated State having made a declaration under subparagraph (a), promptly after such publication but not before the expiration of 18 months from the priority date.

(4)(a) Any State whose national law provides for prior art effect of its patents as from a date before publication, but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State, may declare that the filing outside that State of an international application designating that State is not equated to an actual filing in that State for prior art purposes.

(b) Any State making a declaration under subparagraph (a) shall to that extent not be bound by the provisions of Article 11(3).

(c) Any State making a declaration under subparagraph (a) shall, at the same time, state in writing the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State. This statement may be modified at anytime by notification addressed to the Director General.

(5) Each State may declare that it does not consider itself bound by Article 59. With regard to any dispute between any Contracting State having made such a declaration and any other Contracting State, the provisions of Article 59 shall not apply.

(6)(a) Any declaration made under this Article shall be made in writing. It may be made at the time of signing this Treaty, at the time of depositing the instrument of ratification or accession, or, except in the case referred to in paragraph (5), at any later time by notification addressed to the Director General. In the case of the said notification, the declaration shall take effect six months

after the day on which the Director General has received the notification, and shall not affect international applications filed prior to the expiration of the said six-month period.

(b) Any declaration made under this Article may be withdrawn at any time by notification addressed to the Director General. Such withdrawal shall take effect three months after the day on which the Director General has received the notification and, in the case of the withdrawal of a declaration made under paragraph (3), shall not affect international applications filed prior to the expiration of the said three-month period.

(7) No reservations to this Treaty other than the reservations under paragraphs (1) to (5) are permitted.

The United States of America >had originally<\* declared that it >was<\* not bound by Chapter II (Article 64 (1)), >but has now withdrawn that reservation effective July 1, 1987<.

It has also declared that, as far as the United States of America is concerned, international publication is not required (Article 64 (3)).

The \*\* United States of America >also< made >a reservation<\*\* under 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).

## >1804 USPTO - WIPO Agreement [R-5]

Agreement between the UNITED STATES PATENT AND TRADE-MARK OFFICE and THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION concerning the functions of the United States Patent and Trademark Office in the capacity of an International Searching and Preliminary Examining Authority appointed under the Patent Cooperation Treaty.

### Preamble

The United States Patent and Trademark Office and the International Bureau of the World Intellectual Property Organization agree to conclude the following Agreement under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty:

### Article 1

#### Terminology Used in the Agreement

(1) For the purpose of this Agreement:

(a) "Treaty" means the Patent Cooperation Treaty;

(b) "Regulations" mean the Regulations under the Treaty;

(c) "Administrative Instructions" means the Administrative Instructions under the Treaty;

(d) "Article" (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;

(e) "Rule" means a Rule of the Regulations;

(f) "Authority" refers to the United States Patent and Trademark Office acting in the capacity of an International Searching and Preliminary Examining Authority pursuant to this Agreement and appointed under the Treaty;

(g) "International Bureau" means the International Bureau as defined in Article 2(xix); and

(h) "Gazette" means the publication referred to in Article 55(4).

### Article 2

#### Basic Obligations

(1) The Authority will, except in respect to subject matter which pursuant to Article 6 of this Agreement the Authority is not required to search or to examine, carry out international searches and international preliminary examinations and perform such other functions as are specifically provided for by the Treaty, the Regulations, this Agreement, and the Administrative Instructions. In carrying out an international search and an international preliminary examination, the Authority shall be guided by the Guidelines for International Search and for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty. The Authority undertakes to apply and observe all the common rules of international search and of international preliminary examination.

INTERNATIONAL PATENT EXAMINING AUTHORITY  
PATENT COOPERATION TREATY

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, this Agreement, and the Administrative Instructions, each render, to the extent considered to be appropriate by both the Authority and the International Bureau, assistance to the other in relation to the performance, by the other, of its functions thereunder.

**Article 3**

**Competence of the Authority**

(1) Subject to Article 6 of this Agreement, the Authority undertakes to act as an International Searching Authority for all international applications (i) filed with the receiving Office of, or acting for, the States specified in Annex A of this Agreement, and (ii) filed in or translated into the languages specified in Annex A of this Agreement.

(2) Subject to Article 6 of this Agreement, the Authority undertakes to act as an International Preliminary Examining Authority for all international applications (i) filed with the receiving Office of, or acting for, the States specified in Annex A of this Agreement, and (ii) filed in or translated into the languages specified in Annex A of this Agreement.

**Article 4**

**Minimum Personnel Requirements**

(1) The Authority shall, for the purposes of carrying out international search and international preliminary examination, make available the staff at its disposal, to the extent required by the workload, having sufficient technical qualifications to carry out such search and examination in all technical fields except those referred to in Article 6 of this Agreement. The staff of the Authority shall be maintained at a level exceeding the minimum requirement as set out in Rules 36.1(i) and 63.1(i).

(2) The Authority shall maintain, or otherwise secure assistance by, a staff which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

**Article 5**

**Documentation Facilities**

The Authority shall maintain and use all documentation facilities ordinarily at the disposal of the staff referred to in Article 4(1) of this Agreement for search and examination purposes, and shall maintain and use for the said purposes at least the minimum documentation facilities prescribed by Rules 36.1(ii) and 63.1(ii).

**Article 6**

**Subject Matter not required to be Searched**

In accordance with Articles 17(2)(i) and 34(4)(a)(i), the Authority will not be obligated to search or examine any of the subject matter specified in Rule 39.1 or Rule 67.1 except for subject matter specified in Annex B of this Agreement.

**Article 7**

**Fees**

(1) A schedule of all fees charged by the Authority in relation to its functions as an International Searching and Preliminary Examining Authority is set out in Annex C of this Agreement.

(2) The Authority shall, to the extent and under the conditions set out in Annex C of this Agreement, refund the paid search fees in whole or in part.

**Article 8**

**Review of Protest**

The Commissioner of Patents and Trademarks or his designee shall examine protests in respect of additional fees where such additional fees are paid under protest pursuant to Rule 40.2(c) or Rule 68.3(c).

**Article 9**

[Deleted]

**Article 10**

**Classification**

The Authority, in addition to applying the International Patent Classification to a particular subject matter, may also apply the United States Patent Classification.

**Article 11**

**Language of Correspondence Used by the Authority**

For purposes of correspondence, including forms, the Authority shall use the English language.

**Article 12**

**Patent Information Services and Technical Assistance**

The Authority shall cooperate with the International Bureau in providing patent information services and such other contributions to the technical assistance program under Chapter IV of the Treaty as are both practicable within the facilities of the Authority and as may be agreed.

**Article 13**

**Entry into Force of the Agreement**

This Agreement shall enter into force, after approval by the Assembly, on the date of signature thereof. The Agreement together with an indication of the date of its entry into force shall be published in the Gazette by the International Bureau.

**Article 14**

**Duration and Renewability of the Agreement**

Subject to Article 16 of this Agreement, this Agreement shall remain in force for a period of 10 years. It shall be renewable for a period of 10 years subject to the approval of, and the extension of the appointment of the Authority for that period by, the Assembly.

**Article 15**

**Amendment**

(1) Without prejudice to paragraphs (2) and (4) below, amendments may be made to this Agreement by agreement between the Authority and the International Bureau and shall take effect on the date on which those amendments are approved by the Assembly, or, if a later date is specified in the amendments, on that later date.

(2) Annex A may be amended by the Authority at any time. Any amendment adding a State or language will be made by notification from the Authority to the International Bureau and shall take effect one month from the date of publication in the Gazette. Any amendment deleting a State or language will be made by notification from the Authority to the International Bureau and shall take effect nine months from the date of publication in the Gazette.

(3) Annex B may be amended by the Authority at any time. Any amendment adding subject matter to that Annex will be made by notification from the Authority to the International Bureau and shall take effect one month from the date of publication in the Gazette. Any amendment deleting subject matter from the Annex will be made by notification from the Authority to the International Bureau and shall take effect nine months from the date of publication in the Gazette.

(4) Annex C may be amended by the Authority at any time. Any amendment may be made by notification from the Authority to the International Bureau and shall take effect on a date specified by the Authority but not earlier than one month after the publication of the notification in the Gazette. Normally Annex C shall not be amended during the first year after the entry into force of this Agreement or thereafter at an interval of less than one year from a previous amendment of the schedule.

(5) The International Bureau shall publish promptly in the Gazette any amendment of this Agreement agreed to by the Authority and the International Bureau and approved by the Assembly under paragraph (1) and any notifications received by the International Bureau under paragraphs (2) to (4).

**Article 16**

**Termination of the Agreement**

(1) This Agreement shall terminate:  
(a) if the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or  
(b) if the Director General of the World Intellectual Property Organization, with the approval of the Assembly, gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice.

(3) Notwithstanding paragraph (2), if:

(a) notice to terminate this Agreement is given by the Authority under paragraph (1); and

(b) at the same time all those Contracting States, whose receiving Offices have specified the Authority under Articles 16(2) and 32(2), not having denounced the Treaty previously, made the denunciation under Article 66, the notice to terminate this Agreement shall take effect at such time as the denunciation of the Treaty becomes effective for all such States.

## ANNEX A

## COUNTRIES AND LANGUAGES UNDER ARTICLE 3 OF THIS AGREEMENT

(1) The Authority will conduct international searches and prepare international search reports

- (i) for the following countries:  
United States of America, Brazil, Barbados
- (ii) in the following languages:  
English

(2) The Authority will conduct international preliminary examinations and prepare international preliminary examination reports

- (i) for the following countries:  
United States of America,  
and where the Authority has prepared the international search report, for Brazil and Barbados
- (ii) in the following languages:  
English

## ANNEX B

## SUBJECT MATTER SPECIFIED UNDER ARTICLE 6 OF THIS AGREEMENT

Subject matter which is searched or examined in United States national applications

## ANNEX C

## SCHEDULE OF FEES AND EXTENT AND CONDITIONS OF REDUCTIONS OR REFUNDS OF THE SEARCH AND EXAMINATION FEES FOR THE PURPOSES OF ARTICLE 7 OF THE AGREEMENT

## (a) Fees

## Search fee

(i) where no corresponding prior United States national application with basic filing fee has been filed .....	\$520.00
(ii) where a corresponding prior United States national application with basic filing fee has been filed .....	\$350.00
Supplemental Search Fee (per additional invention) .....	\$140.00

Preparation of an international-type search report in a United States national application .....

## Preliminary examination fee

(i) where an international search fee has been paid on the international application for the benefit of the United States Patent and Trademark Office as an International Searching Authority .....	\$370.00
(ii) where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office .....	\$570.00

(2) additional preliminary examination fee (per additional invention)

(i) Where a supplemental search fee has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority .....	\$125.00
(ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office .....	\$190.00

(b) Extent and Conditions of Refunds of the Search and Examination Fees

(i) Money paid for search and preliminary examination fees, where paid by actual mistake or in excess will be refunded.

(ii) Refund of the supplemental search fee and additional preliminary examination fee will be made if such refund is determined to be warranted by the Commissioner of Patents and Trademarks or his designee acting under Rule 40.2(c) or Rule 68.3(c).

(iii) The search fee will be refunded if the determination under Article 11(1) is negative.

## 1805 Who May File in the United States Receiving Office [R-5]

PCT Article 9  
The Applicant

(1) Any resident or national of a Contracting State may file an international application.

(2) The Assembly may decide to allow the residents and the nationals of any country party to the Paris Convention for the Protection of Industrial Property which is not party to this Treaty to file international applications.

(3) The concepts of residence and nationality, and the application of those concepts in cases where there are several applicants or where the applicants are not the same for all the designated States, are defined in the Regulations.

(Editor's Note: The PCT Assembly has not as yet allowed residents or nationals of non-PCT member countries to file PCT international applications.)

PCT Rule 18  
The Applicant

## 18.1 Residence

(a) Subject to the provisions of paragraph (b), the question whether an applicant is a resident of the Contracting State of which he claims to be resident shall depend on the national law of that State and shall be decided by the receiving Office.

(b) In any case, possession of a real and effective industrial or commercial establishment in a Contracting State shall be considered residence in that State.

## 18.2 Nationality

(a) Subject to the provisions of paragraph (b), the question whether an applicant is a national of the Contracting State of which he claims to be a national shall depend on the national law of that State and shall be decided by the receiving Office.

(b) In any case, a legal entity constituted according to the national law of a Contracting State shall be considered a national of that State.

## 18.3 Several Applicants: same for All Designated States

If all the applicants are applicants for the purposes of all designated States, the right to file an international application shall exist if at least one of them is entitled to file an international application according to Article 9.

## 18.4 Several Applicants: Different for Different Designated States

(a) The international application may indicate different applicants for the purposes of different designated States, provided that, in respect of each designated State, at least one of the applicants indicated for the purposes of that State is entitled to file an international application according to Article 9.

(b) If the condition referred to in paragraph (a) is not fulfilled in respect of any designated State, the designation of that State shall be considered not to have been made.

(c) The International Bureau shall, from time to time, publish information on the various national laws in respect of the question who is qualified (inventor, successor in title of the inventor, owner of the invention, or other) to file a national application and shall accompany such information by a warning that the effect of the international application in any designated State may depend on whether the person designated in the international application as applicant for the purposes of that State is a person who, under the national law of that State, is qualified to file a national application.

PCT Rule 19  
The Competent Receiving Office

## 19.1 Where to File

(a) Subject to the provisions of paragraph (b), the international application shall be filed, at the option of the applicant, with the national Office of or acting for the Contracting State of which the applicant is a resident or with the national Office of or acting for the Contracting State of which the applicant is a national.

(b) Any Contracting State may agree with another Contracting State or any intergovernmental organization that the national Office of the latter State or

## PATENT COOPERATION TREATY

the intergovernmental organization shall, for all or some purposes, act instead of the national Office of the former State as receiving Office for applicants who are residents or national of that former State. Notwithstanding such agreement, the national Office of the former State shall be considered the competent receiving Office for the purposes of Article 15(5).

(c) In connection with any decision made under Article 9(2), the Assembly shall appoint the national Office of the intergovernmental organization which will act as receiving Office for applications of residents or nationals of States specified by the Assembly. Such appointment shall require the previous consent of the said national Office or intergovernmental organization.

**19.2 Several Applicants**

If there are several applicants, the requirements of Rule 19.1 shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national.

**19.3 Publication of Fact of Delegation of Duties of Receiving Office**

(a) Any agreement referred to in Rule 19.1(b) shall be promptly notified to the International Bureau by the Contracting State which delegates the duties of the receiving Office to the national Office of or acting for another Contracting State or an intergovernmental organization.

(b) The International Bureau shall, promptly upon receipt, publish the notification in the Gazette.

**PCT Administrative Instructions Section 317  
Procedure in the Case of the Designation of a State Being  
Considered Not To Have Been Made**

Where the receiving Office finds that, under Rule 18.4(b), the designation of a State is to be considered as not having been made, it shall indicate that fact in the international application by enclosing the designation of that State within square brackets and entering, in the margin, the words "CONSIDERED NOT TO HAVE BEEN MADE" or their equivalent in the language of publication of the international application, and shall promptly notify the applicant accordingly. If the record copy has already been sent to the International Bureau, the receiving Office shall also notify promptly that Bureau.

**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.

(b) The Patent and Trademark Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of international fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent and Trademark Office shall be in the English language.

(d) The \*\* international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall either be paid on filing of an international application or within \*\*> such later time as may be fixed by the Commissioner.<

**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 section 119 of this title, if the United States was not the sole country designated in such international application.

**37 CFR 1.421 Applicant for international application.**

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office.

(b) Although the United States Receiving Office will accept international applications filed by any resident or national of the United States of America for international processing, an international application designating the United States of America will be accepted by the Patent and Trademark Office for the national stage only if filed by the inventor or as provided in §§1.422, 1.423 or 1.425.

(c) International applications which do not designate the United States of America may be filed by the assignee or owner.

(d) The attorney or agent of the applicant may sign the international application Request and file the international application for the applicant if the international application when filed is accompanied by a separate power of attorney to that attorney or agent from the applicant. The separate power of attorney from the applicant may be submitted after filing if sufficient cause is shown for not submitting it at the time of filing. Note that paragraph (b) of this section requires that the applicant be the inventor if the United States of America is designated.

(e) Any indication of different applicants for the purpose of different Designated Offices must be shown on the Request portion of the international application.

(f) Changes in the person, name, or address of the applicant of an international application shall be made in accordance with PCT Rule 18.5.

**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.

**37 CFR 1.423 When the inventor is insane or legally incapacitated.**

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may file an international application which designates the United States of America.

**37 CFR 1.424 Joint inventors.**

Joint inventors must jointly file an international application which designates the United States of America; the signature of either of them alone, or less than the entire number will be insufficient for an invention invented by them jointly, except as provided in § 1.425.

**37 CFR 1.425 Filing by other than inventor.**

(a) If a joint inventor refuses to join in an international application which designates the United States of America or cannot be found or reached after diligent effort, the international application which designates the United States of America may be filed by the other inventor on behalf of himself or herself and the omitted inventor. Such an international application which designates the United States of America must be accompanied by proof of the pertinent facts and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the international application to the omitted inventor at said address.

(b) Whenever an inventor refuses to execute an international application which designates the United States of America, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may file the international application on behalf of and as agent for the inventor. Such an international application which designates the United States of America, must be accompanied by proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application.

Any resident or national of the United States of America may file an international application in the United States Receiving Office (PCT Article 9(1) and (3), PCT Rule 19.1, 35 U.S.C. 361(a) and 37 CFR 1.412(a), 1.421). The concepts of residence and nationality are defined in PCT Rules 18.1 and 18.2. 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). See also MPEP § 1820.02.

However, the laws of the various designated countries 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)).

Where there are different applicants for different designated States, at least one applicant named for each designated State must be entitled to file an international application under PCT Article 9, and PCT Rule 18.4. See >MPEP< §1820.09.

PCT Rule 19.2 relates to the situation where there are several applicants for all the designated States.

## 1807 Agent or Common Representative [R-2]

### PCT Article 49

#### Right to Practice before International Authorities

Any attorney, patent agent, or other person, having the right to practice before the national Office with which the international application was filed, shall be entitled to practice before the International Bureau and the competent International Searching Authority and competent International Preliminary Examining Authority in respect of that application.

### PCT Rule 2

#### Interpretation of Certain Words

##### 2.1 "Applicant"

Whenever the word "applicant" is used, it shall be construed as meaning also the agent or other representative of the applicant, except where the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used such as in particular, where the provision refers to the residence or nationality of the applicant.

##### 2.2 "Agent"

Whenever the word "agent" is used, it shall be construed as meaning any person who has the right to practice before international authorities as defined in Article 49 and, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used, also the common representative referred to in Rule 4.8.

##### 2.3 "Signature"

Whenever the word "signature" is used, it shall be understood that, if the national law applied by the receiving Office or the competent International Searching or Preliminary Examining Authority requires the use of a seal instead of a signature, the word, for the purposes of that Office or Authority, shall mean seal.

### PCT Rule 63

#### Right to Practice before International Authorities

##### 63.1 Proof of Right

The International Bureau, the competent International Searching Authority, and the competent International Preliminary Examining Authority, may require the production of proof of the right to practice referred to in Article 49.

##### 63.2 Information

(a) The national Office or the intergovernmental organization which the interested person is alleged to have a right to practice before shall, upon request, inform the International Bureau, the competent International Searching Authority, or the competent International Preliminary Examining Authority, whether such person has the right to practice before it.

(b) Such information shall be binding upon the International Bureau, the International Searching Authority, or the International Preliminary Examining Authority, as the case may be.

### PCT Rule 90

#### Representation

##### 90.1 Definitions

For the purposes of Rule 90.2 and Rule 90.3:

- (i) "agent" means any of the persons referred to in Article 49;
- (ii) "common representative" means the applicant referred to in Rule 4.8.

##### 90.2 Effects

(a) Any act by or in relation to an agent shall have the effect of an act by or in relation to the applicant or applicants having appointed the agent.

(b) Any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

(c) If there are several agents appointed by the same applicant or applicants, any act by or in relation to any of the several agents shall have the effect of an act by or in relation to the said applicant or applicants.

(d) The effects described in paragraphs (a), (b), and (c), shall apply to the processing of the international application before the receiving Office, the International Bureau, the International Searching Authority, and the International Preliminary Examining Authority.

#### 90.3 Appointment

(a) Appointment of any agent, or of any common representative within the meaning of Rule 4.8(a), shall be effected by each applicant, at his choice, either by signing the request in which the agent or common representative is designated or by a separate power of attorney (i.e., a document appointing an agent or common representative).

(b) The power of attorney may be submitted to the receiving Office of the International Bureau. Whichever of the two is the recipient of the power of attorney submitted shall immediately notify the other and the interested International Searching Authority and the interested International Preliminary Examining Authority.

(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 non-existent unless the defect is corrected.

(d) A general power of attorney may be deposited with the receiving Office for purposes of the processing of the international application as defined in Rule 90.2 (d). Reference may be made in the request to such general power of attorney, provided that a copy thereof is attached to the request by the applicant.

#### 90.4 Revocation

(a) Any appointment may be revoked by the persons who have made the appointment or their successors in title.

(b) Rule 90.3 shall apply, *mutatis mutandis*, to the document containing the revocation.

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

(a) Applicants of international applications may be represented by attorneys or agents licensed to practice before the Patent and Trademark Office or by a common representative (PCT Art. 49, Rules 4.8 and 90 and §10.10).

(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by all applicants, 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.

#### PCT Administrative Instructions Section 106

##### Representation

(a) In the case of several applicants, any agent appointed in accordance with Rule 90.3 as an agent representing all the applicants shall be considered a common agent.

(b) Where the international application is filed with reference to a general power of attorney not signed by all the applicants, it shall be sufficient for the purpose of appointment of a common agent under Rule 90.3, if the request or a separate power of attorney is signed by the applicant, who did not sign the general power of attorney.

(c) The appointment of an agent, or of a common representative within the meaning of Rule 4.8(a), shall, unless otherwise indicated by the persons who make the appointment, be regarded as the revocation of any earlier appointment of any other agent, or of any other common representative, and shall be considered as a request for recording a change in the person of the agent or common representative under Rule 92bis.1(a)(ii).

(d) Any document entailing the revocation of an appointment of an agent, or of a common representative within the meaning of Rule 4.8(a), may be submitted to the receiving Office or the International Bureau.

PATENT COOPERATION TREATY

(c) Any agent, or any common representative within the meaning of Rule 4.8(a), may renounce his appointment through a notification signed by him and addressed to the receiving Office or the International Bureau.

**PCT Administrative Instructions Section 108  
Correspondence Intended for the Applicant**

(a) Any correspondence from an International Authority intended for the applicant, or, in the case of several applicants, the applicants, shall be addressed as follows:

(i) Where the applicant has designated or appointed one agent, correspondence shall be addressed to that agent. Where, in the case of several applicants, the applicants are represented by a common representative or a common agent, correspondence shall be addressed to that representative or that agent.

(ii) Where the applicant has designated several agents in the request, correspondence shall be addressed to the agent first mentioned therein. Where, in the case of several applicants, the applicants have designated several common agents in the request, correspondence shall be addressed to the common agent first mentioned therein.

(iii) Where the applicant has appointed several agents in one or more separate powers of attorney, correspondence shall be addressed to the agent first mentioned in the earliest filed and still valid separate power of attorney. Where, in the case of several applicants, the applicants have appointed several common agents in one or more separate powers of attorney, correspondence shall be addressed to the common agent first mentioned in the earliest filed and still valid separate power of attorney.

(b) Any correspondence from an International Authority to the applicant or his agent shall be marked with the file reference, composed either of letters or numbers, or both, of the applicant or the agent, if so indicated on the request Form, provided this reference does not exceed ten characters.

Any act by or in relation to an agent has the effect of an act by or in relation to the applicant or applicants who have designated the agent; any act by or in relation to a common representative has the effect of an act by or in relation to all the applicants; the foregoing applies to the international phase (37 CFR 1.421(d) and 1.435). Powers of Attorney forms are found in Annexes G1 and G2 of the *PCT APPLICANT'S GUIDE*.

Any attorney or agent registered to practice before the United States Patent and Trademark Office may be appointed as an agent under the Patent Cooperation Treaty to file applications in the United States Receiving Office (PCT Article 49 and PCT Rule 83) and to prosecute the application before the International Authorities.

In the national (or regional) phase, other agents usually must be appointed (PCT Rule 90.2). The national laws of the designated states govern the appointment of agents or attorneys in the national stage.

Powers of attorney should be submitted to the United States Receiving Office until the Search Report has issued in order that communications may be correctly addressed. After the Search Report has issued, powers of attorney should be submitted to the International Bureau.

General powers of attorney are recognized for the purpose of filing and prosecuting an international application before the international authorities. The original general power of attorney should be deposited with the PCT Division in the Patent and Trademark Office and any applications relying thereon must include a copy thereof. A general power of attorney form is in Annex G2 of the *"PCT Applicant's Guide."*

See also MPEP § 1820.04 for the power of attorney on the Request form.

**1808 Revocation of the Appointment of an Agent or a Common Representative [R-5]**

**37 CFR 1.472 Changes in person, name, or address of applicants and inventors.**

All requests for a change in person, name or address of applicants and inventor should be sent to the United States Receiving Office until the time of issuance of the international search report. Thereafter requests for such changes should be submitted to the International Bureau.

The document containing the revocation must be signed by the applicant or, where there are several applicants, by all the applicants. It must be submitted to the Receiving Office or the International Bureau (PCT Rule 90.4).

Revocations should be submitted to the United States Receiving Office until the time the Search Report has issued. After the Search Report has issued, revocations should be sent to the International Bureau.

**1810 Filing Date Requirements [R-5]**

**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.

(2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.

(b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.

(3) Subject to Article 64(4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) and accorded 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.

(4) Any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

**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. 376 Fees.**

(a) The required payment of the international fee and the handling fee, which amounts are specified in the Regulations, shall be paid in United States currency. The Patent and Trademark Office may also charge the following fees:

(1) A transmittal fee (see section 361(d));

(2) A search fee (see section 361(d));

(3) A supplemental search fee (to be paid when required);

(4) A national fee (see section 371(c));

(5) A preliminary examination fee and any additional fees (see section 362(b)).

(6) Such other fees as established by the Commissioner.

(b) The amounts of fees specified in subsection (a) of this section, except the international fee and the handling fee, shall be prescribed by the Commissioner. He may refund any sum paid by mistake or in excess of the fees so specified, or if required under the treaty and the Regulations. The Commissioner may also refund any part of the search fee, the preliminary examination fee and any additional fees, where he determines such refund to be warranted.

### 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) The applicant is a United States resident or national (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;

(iii) The name of the applicant, as prescribed (note §§ 1.421-1.424);

(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 basic portion of the international 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. Failure to make full payment within one month of the deposit of the international application papers required by paragraph (b) of this section will result in the fees being charged to the International Bureau under the provisions of paragraph (d) of this section and PCT Rule 16<sup>bis</sup>.

(d) The United States Receiving Office will charge to the International Bureau in accordance with PCT Rule 16bis and will consider as having been timely paid:

(1) The transmittal fee, the basic fee portion of the international fee, or the search fee where these fees have not been fully paid by the applicant within one month of the date of deposit of the international application, and

(2) The designation fee, or the amount necessary to cover all the designations made in the request \* >if 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<.

(e) The International Bureau will notify applicant of any amount charged under paragraph (d) of this section and invite the applicant to pay directly to the International Bureau within one month from the date of the notification, the amount charged, augmented by a surcharge of 50%, provided the surcharge will not be less, and will not be more, than the amounts indicated in the Schedule of Fees appended to the PCT Rules. If the payment needed to cover the transmittal fees, the basic fee, one designation fee and the surcharge is not timely made to the International Bureau, the International Bureau will notify the Receiving Office which will declare the international application withdrawn under PCT Article 14(3)(a). If the applicant makes timely payment of the fees referred to in the previous sentence, but the amount paid is not sufficient to cover all designation fees, the Receiving Office will declare any designation not paid withdrawn under PCT Rule 14(3)(b) in accordance with PCT Rule 16bis. 2(c).

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

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

(1) A transmittal fee (see 35 U.S.C. 361(d) and PCT Rule 14) — \$170.00.

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

(i) No corresponding prior United States national application with >basic filing< fee has been filed.-----> \$520.00<\*.

(ii) A corresponding prior United States national application with >basic filing< fee has been filed.-----> \$350.00<\*.

(3) A supplemental search fee when required, per additional invention.----- \$140.00\*\*

(b) The basic fee and designation fee portions of the international fee shall be as prescribed in PCT Rule 15.

### THE "INTERNATIONAL FILING DATE"

An international filing date is accorded on the date on which the international application was received by the Receiving Office or — pursuant to the correction of defects — on a later date (PCT Articles 11(1) and 11(2)(b) and PCT Rules 20.1, 20.3, 20.4(a), 20.5, and 20.6); in the former case, the international filing date will be the date on which the international application was received by the Receiving Office; in the latter case, the international filing date will be the date on which the correction was received by the Receiving Office. Any correction >must<\*\* be submitted by the applicant within certain time limits. 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.

### CONDITIONS THAT MUST BE FULFILLED FOR THE INTERNATIONAL APPLICATION TO BE ENTITLED TO AN "INTERNATIONAL FILING DATE"

An "international filing date" will be accorded to the international application by the United States Receiving Office if it finds that the conditions of PCT Art. 11(1) and 37 CFR 1.431 are fulfilled.

### NON-PAYMENT, INCOMPLETE PAYMENT OR LATE PAYMENT OF FEES; EFFECT ON THE "INTERNATIONAL FILING DATE"

The non-payment, incomplete or late payment of the fees does not affect the filing date since the payment of fees is not an Article 11(1) requirement. However, non-payment or incomplete payment of fees due will result in the Receiving Office declaring that the international application is considered withdrawn (PCT Article 14(3)(a), PCT Rule 27.1(a) and 35 U.S.C. 361(d)). Although an international application which has not received an international filing date and an international application which is considered to be withdrawn are both excluded from further processing in the international phase, an international application which fulfills the requirements necessary for being accorded an international filing date may be invoked as a priority application under the Paris Convention (PCT Article 11(4) (if the conditions set by that Convention are fulfilled) even where it will be considered as withdrawn for non-payment of fees or other reasons.

In order to assist applicants in the case of mistakes in fees or delays in meeting deadlines for fee payment, PCT Rule 16bis procedures may be used. See >MPEP< § 1827.01.

### 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.

**PCT Rule 9**

**Expressions, etc., Not to be Used**

**9.1 Definition**

The international application shall not contain:

- (i) expressions or drawings contrary to morality;
- (ii) expressions or drawings contrary to public order;
- (iii) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparisons with the prior art shall not be considered disparaging per se);
- (iv) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

**9.2 Noting of Lack of Compliance**

The receiving Office and the International Searching Authority may note lack of compliance with the prescriptions of Rule 9.1 and may suggest to the applicant that he voluntarily correct his international application accordingly. If the lack of compliance was noted by the receiving Office, that Office shall inform the competent International Searching Authority and the International Bureau; if the lack of compliance was noted by the International Searching Authority, that Authority shall inform the receiving Office and the International Bureau.

**9.3 Reference to Article 21(6)**

"Disparaging statements," referred to in Article 21(6), shall have the meaning as defined in Rule 9.1(iii).

**PCT Rule 10**

**Terminology and Signs**

**10.1 Terminology and Signs**

(a) Units of weights and measures shall be expressed in terms of the metric system, or also expressed in such terms if first expressed in terms of a different system.

(b) Temperatures shall be expressed in degrees Celsius, or also expressed in degrees Celsius, if first expressed in a different manner.

(c) (deleted)

(d) For indications of heat, energy, light, sound and magnetism, as well as for mathematical formulae and electrical units, the rules of international practice shall be observed; for chemical formulae the symbols, atomic weights, and molecular formulae, in general use, shall be employed.

(e) In general, only such technical terms, signs and symbols should be used as are generally accepted in the art.

(f) When the international application or its translation is in English or Japanese, the beginning of any decimal fraction shall be marked by a period, whereas, when the international application or its translation is in a language other than English or Japanese, it shall be marked by a comma.

**10.2 Consistency**

The terminology and the signs shall be consistent throughout the international application.

**PCT Rule 12**

**Language of the International Application**

**12.1 Admitted Languages**

(a) Any international application shall be filed in the language, or one of the languages specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of that application, provided that, if the agreement specifies several languages, the receiving Office may prescribe among the specified

languages that language in which or those languages in one of which the international application must be filed.

(b) If the international application is filed in a language other than the language in which it is to be published, the request may, notwithstanding paragraph (a), be filed in the language of publication.

(c)\* Subject to paragraph (d), where the official language of the receiving Office is one of the languages referred to in Rule 48.3(a) but is a language not specified in the agreement referred to in paragraph (a), the international application may be filed in the said official language. If the international application is filed in the said official language, the search copy transmitted to the International Searching Authority under Rule 23.1 shall be accompanied by a translation into the language, or one of the languages, specified in the agreement referred to in paragraph (a); such translation shall be prepared under the responsibility of the receiving Office.

(d)\* Paragraph (c) shall apply only where the International Searching Authority has declared, in a notification addressed to the International Bureau, that it accepts to search international applications on the basis of the translation referred to in paragraph (c).

**12.2 Language of Changes in the International Application**

Any changes in the international application, such as amendments and corrections, shall, subject to Rules 46.3 and 66.9, be in the same language as the said application.

\* Paragraphs (c) and (d) of Rule 12.1 will become applicable at the same time that the PCT will enter into force in respect of the country which, among the Spanish-speaking countries, is the first to ratify or accede to the PCT.

**PCT Administrative Instructions Section 207**

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

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

(b) The sequential numbering of the sheets shall be effected by using three separate series of numbering, the first series applying to the request only and commencing with the first sheet of the request, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable to the sheets of the drawings only and commencing with the first sheet of the drawings. The number of each sheet of the drawings shall consist of two arabic numerals separated by a slant, the first being the sheet number and the second being the total number of sheets of drawings.

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, the claims, the abstract, and the drawings (PCT Administrative Instructions, Section 207 (a)). All the sheets contained in the international application must be numbered in consecutive arabic numerals by using three separate series of numbers; the first applying to the Request, the second to the description, claims and abstract, and the third to the drawings (PCT Rule 11.7 and PCT 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)).

**1815 Formal Requirements of an International Application [R-2]**

**PCT Rule 11**

**Physical Requirements of the International Application**

**11.1 Number of Copies**

(a) Subject to the provisions of paragraph (b), the international application and each of the documents referred to in the check list (Rule 3.3(a)(ii)) shall be filed in one copy.

(b) Any receiving Office may require that the international application and any of the documents referred to in the check list (Rule 3.3(a)(ii)), except the receipt for the fees paid or the check for the payment of the fees, be filed in two or three copies. In that case, the receiving Office shall be responsible for verifying the identity of the second and the third copies with the record copy.

#### 11.2 Fitness for Reproduction

(a) All elements of the international application (i.e., the request, the description, the claims, the drawings, and the abstract) shall be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset, and microfilming, in any number of copies.

(b) All sheets shall be free from creases and cracks; they shall not be folded.

(c) Only one side of each sheet shall be used.

(d) Subject to Rule 11.10(d) and Rule 11.13(j), each sheet shall be used in an upright position (i.e., the short sides at the top and bottom).

#### 11.3 Material to be Used

All elements of the international application shall be on paper which shall be flexible, strong, white, smooth, non-shiny, and durable.

#### 11.4 Separate Sheets, Etc.

(a) Each element (request, description, claims, drawings, abstract) of the international application shall commence on a new sheet.

(b) All sheets of the international application shall be so connected that they can be easily turned when consulted, and easily separated and joined again if they have been separated for reproduction purposes.

#### 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

(a) The minimum margins of the sheets containing the request, the description, the claims, and the abstract, shall be as follows:

- top: 2 cm.
- left side: 2.5 cm.
- right side: 2 cm.
- bottom: 2 cm.

(b) The recommended maximum, for the margins provided for in paragraph (a), is as follows:

- top: 4 cm.
- left side: 4 cm.
- right side: 3 cm.
- bottom: 3 cm.

(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.

(d) The margins referred to in paragraphs (a) to (c) apply to A4-size sheets, so that, even if the receiving Office accepts other sizes, the A4-size record copy and, when so required, the A4-size search copy shall leave the aforesaid margins.

(e) The margins of the international application, when submitted, must be completely blank.

#### 11.7 Numbering of Sheets

(a) All the sheets contained in the international application shall be numbered in consecutive arabic numerals.

(b) The numbers shall be placed at the top of the sheet, in the middle, but not in the margin.

#### 11.8 Numbering of Lines

(a) It is strongly recommended to number every fifth line of each sheet of the description, and of each sheet of claims.

(b) The numbers should appear on the left side, to the right of the margin.

#### 11.9 Writing of Text Matter

(a) The request, the description, the claims and the abstract shall be typed or printed.

(b) Only graphic symbols and characters, chemical or mathematical formulae, and certain characters in the Japanese language may, when necessary be written by hand or drawn.

(c) The typing shall be 1 1/2-spaced.

(d) All text matter shall be in characters the capital letters of which are not less than 0.21 cm. high, and shall be in a dark, indelible color, satisfying the requirements specified in Rule 11.2.

(e) As far as the spacing of the typing and the size of the characters are concerned, paragraphs (c) and (d) shall not apply to texts in the Japanese language.

#### 11.10 Drawings, Formulae, and Tables, in Text Matter

(a) The request, the description, the claims and the abstract shall not contain drawings.

(b) The description, the claims and the abstract may contain chemical or mathematical formulae.

(c) The description and the abstract may contain tables; any claim may contain tables only if the subject matter of the claim makes the use of tables desirable.

(d) Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the tops of the tables or formulae are at the left side of the sheet.

#### 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 catch words 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.

#### 11.12 Alterations, Etc.

Each sheet shall be reasonably free from erasures and shall be free from alterations, overwritings, and interlineations. Non-compliance with this Rule may be authorized if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

#### 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

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features denoted by them.

11.14 Later Documents

Rules 10, and 11.1 to 11.13 also apply to any document — for example, corrected pages, amended claims — submitted after the filing of the international application.

\*\*\*

37 CFR 1.433 Physical requirements of international application.

(a) The international application and each of the documents that may be referred to in the check list of the Request (PCT Rule 3.3(a)(ii)) shall be filed in one copy only.

(b) All sheets of the international application must be on A4 size paper (21.0 x 29.7 cm.).

(c) Other physical requirements for international applications are set forth in PCT Rule 11 and Sections 201-207 of the Administrative Instructions.

The international application must comply with certain physical requirements, e.g., requirements concerning: fitness for reproduction (PCT Rule 11.2), the size of the sheets (PCT Rule 11.5), the margin sizes (PCT Rule 11.6), the numbering of the lines in the description and claims (PCT Rule 11.8), the writing of text materials (PCT 11.9), etc. The specifics of each of these requirements are set forth in PCT Rule 11; however, two major requirements in application format are to be especially noted. The first requirement is that all papers in the international applications be "A4" size, which is 29.7 cm. by 21 cm. (PCT Rule 11.5) (approximately 11 11/16 inches by 8 1/4 inches), and the second is the requirement that the typing in the application be at 1 1/2 spacing (PCT Rule 11.9(c)). The international application must also be drafted to satisfy certain other formal requirements. It must not contain matter contrary to morality or public order, disparaging statements, or obviously irrelevant or unnecessary matter (PCT Rule 9). Units of weights, measures and density should be expressed in terms of the metric system, and temperatures in terms of degrees Celsius (PCT Rule 10). The general rule with respect to terminology and signs is: only such technical terms, signs and symbols should be used as are generally accepted in the art. An international application filed in the United States Receiving Office must be in the English language (PCT Rule 12.1 and 35 U.S.C. 361(c)). International applications which comply with the PCT formal requirements are acceptable by all PCT member States (PCT Article 27(1)).

1820 The Request [R-2]

PCT Article 4  
The Request

(1) The request shall contain:

(i) a petition to the effect that the international application be processed according to this Treaty;

(ii) the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application ("designated States"); if for any designated State a regional patent is available and the applicant wishes to obtain a regional patent rather than a national patent, the request shall so indicate; if, under a treaty concerning a regional patent, the applicant cannot limit his application to certain of the States party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent shall be treated as designation of all the States party to that treaty; if, under the national law of the designated State, the designation of that State has the effect of an application for a regional patent, the designation of the said State shall be treated as an indication of the wish to obtain the regional patent;

(iii) the name of and other prescribed data concerning the applicant and the agent (if any);

(iv) the title of the invention;

(v) the name of and other prescribed data concerning the inventor where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application. Otherwise, the said

indications may be furnished either in the request or in separate notices addressed to each designated Office whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application.

(2) Every designation shall be subject to the payment of the prescribed fee within the prescribed time limit.

(3) Unless the applicant asks for any of the other kinds of protection referred to in Article 43, designation shall mean that the desired protection consists of the grant of a patent by or for the designated State. For the purposes of this paragraph, Article 2(ii) shall not apply.

(4) Failure to indicate in the request the name and other prescribed data concerning the inventor shall have no consequence in any designated State whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application. Failure to furnish the said indications in a separate notice shall have no consequence in any designated State whose national law does not require the furnishing of the said indications.

PCT Rule 3  
The Request (Form)

3.1 Printed Form

The request shall be made on a printed form.

3.2 Availability of Forms

Copies of the printed form shall be furnished free of charge to the applicants by the receiving Office, or, if the receiving Office so desires, by the International Bureau.

3.3 Check List

(a) The printed form shall contain a list which, when filled in, will show:

(i) the total number of sheets constituting the international application and the number of the sheets of each element of the international application (request, description, claims, drawings, abstract).

(ii) whether or not the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a document relating to the payment of fees and any other document (to be specified in the check list),

(iii) the number of that figure of the drawings which the applicant suggests should accompany the abstract when the abstract is published on the front page of the pamphlet and in the Gazette; in exceptional cases, the applicant may suggest more than one figure.

(b) The list shall be filled in by the applicant, failing which the receiving Office shall fill it in and make the necessary annotations, except that the number referred to in paragraph(a)(iii) shall not be filled in by the receiving Office.

3.4 Particulars

Subject to Rule 3.3, particulars of the printed form shall be prescribed by the Administrative Instructions.

PCT Rule 4  
The Request (Contents)

4.1 Mandatory and Optional Contents; Signature

(a) The request shall contain:

(i) a petition,

(ii) the title of the invention,

(iii) indications concerning the applicant and the agent, if there is an agent,

(iv) the designation of States,

(v) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

(b) The request shall, where applicable, contain:

(i) a priority claim,

(ii) a reference to any earlier international, international-type or other search,

(iii) choices of certain kinds of protection,

(iv) an indication that the applicant wishes to obtain a regional patent and the names of the designated States for which he wishes to obtain such a patent,

(v) a reference to a parent application or parent patent.

(c) The request may contain:

(i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

INTERNATIONAL APPLICATION UNDER THE PATENT COOPERATION TREATY

REQUEST

THE UNDERSIGNED REQUESTS THAT THE PRESENT INTERNATIONAL APPLICATION BE PROCESSED ACCORDING TO THE PATENT COOPERATION TREATY

(The following is to be filled in by the receiving Office)

INTERNATIONAL APPLICATION No:

INTERNATIONAL FILING DATE:

(Stamp) Name of receiving Office and "PCT International Application"

Applicant's or Agent's File Reference (indicated by applicant if desired): CMC-123

Box No. I TITLE OF INVENTION

Self-Steering Gear for Sailboats

Box No. II APPLICANT (WHETHER OR NOT ALSO INVENTOR); DESIGNATED STATES FOR WHICH HE/SHE/IT IS APPLICANT. Use this box for indicating the applicant or, if there are several applicants, one of them. If more than one person (includes, where applicable, a legal entity) is involved, continue in Box No. III.

The person identified in this box is (check one only): [ ] applicant and inventor\* [x] applicant only

Name and address:\*\*

Columbia Marine Corporation
100 Front Street
Baltimore, Maryland 20726
United States of America

Telephone number: (including area code) 301-555-1122
Country of nationality: United States of America
Country of residence:\*\*\* United States of America

The person identified in this box is applicant for the purposes of (check one only):
[ ] all designated States
[x] all designated States except the United States of America
[ ] the United States of America only
[ ] the States indicated in the "Supplemental Box"

Box No. III FURTHER APPLICANTS, IF ANY; (FURTHER) INVENTORS, IF ANY; DESIGNATED STATES FOR WHICH THEY ARE APPLICANTS (IF APPLICABLE). A separate sub-box has to be filled in in respect of each person (includes, where applicable, a legal entity). If the following two sub-boxes are insufficient, continue in the "Supplemental Box," (giving there for each additional person the same indications as those requested in the following two sub-boxes) or by using a "continuation sheet."

The person identified in this sub-box is (check one only): [x] applicant and inventor\* [ ] applicant only [ ] inventor only\*

Name and address:\*\*

Jones, John Paul
200 Shady Grove Road
Davidsonville, Maryland 20720
United States of America

If the person identified in this sub-box is applicant (or applicant and inventor), indicate also:

Country of nationality: US Country of residence:\*\*\* US

and whether that person is applicant for the purposes of (check one only):
[ ] all designated States
[ ] all designated States except the United States of America
[x] the United States of America only
[ ] the States indicated in the "Supplemental Box"

The person identified in this sub-box is (check one only): [ ] applicant and inventor\* [ ] applicant only [ ] inventor only\*

Name and address:\*\*

If the person identified in this sub-box is applicant (or applicant and inventor), indicate also:

Country of nationality: Country of residence:\*\*\*

and whether that person is applicant for the purposes of (check one only):
[ ] all designated States
[ ] all designated States except the United States of America
[ ] the United States of America only
[ ] the States indicated in the "Supplemental Box"

\* If the person indicated as "applicant and inventor" or as "inventor only" is not an inventor for the purposes of all the designated States, give the necessary indications in the "Supplemental box."

\*\* Indicate the name of a natural person by giving his/her family name first followed by the given name(s). Indicate the name of a legal entity by its full official designation. In the address, include both the postal code (if any) and the country (name).

\*\*\* If residence is not indicated, it will be assumed that the country of residence is the same as the country indicated in the address

PATENT COOPERATION TREATY

Sheet number...2...

**Box No. IV AGENT (IF ANY) OR COMMON REPRESENTATIVE (IF ANY); ADDRESS FOR NOTIFICATIONS (IN CERTAIN CASES).** A common representative may be appointed only if there are several applicants and if no agent is or has been appointed; the common representative must be one of the applicants. The following person (including, where applicable, a legal entity) is hereby/has been appointed as agent or common representative to act on behalf of the applicant(s) before the competent International Authorities:

Name and address, including postal code and country:

If the space below is used instead for an address for notifications, mark here

Adams, John Q.  
Adams, Baker and Charlie  
1200 Marina Drive  
Baltimore, Maryland 20820  
United States of America

Telephone number: (including area code) 301-577-7777

Teletypewriter address:

**Box No. V DESIGNATION OF GROUPS OF STATES OR STATES (1); CHOICE OF CERTAIN KINDS OF PROTECTION OR TREATMENT.** The following designations are hereby made (please mark the applicable check-boxes):

**Regional Patent**

**1 EP European Patent(2):** AT Austria, BE Belgium, CH and LI Switzerland and Liechtenstein, DE Germany (Federal Republic of), FR France, GB United Kingdom, IT Italy, LU Luxembourg, NL Netherlands, SE Sweden, and any other Contracting State of the European Patent Convention which has become party to the PCT after the issuance of this sheet (specify on dotted line):

**OA OAPI Patent:** Benin, Cameroon, Central African Republic, Chad, Congo, Gabon, Mali, Mauritania, Senegal, Togo, and any other member State of OAPI which has become party to the PCT after the issuance of this sheet; if other OAPI title desired, specify on dotted line(3):

**National Patent (if other kind of protection or treatment desired, specify on dotted line(3))**

**4 AT Austria(3)** .....

**AU Australia(3)** .....

**BB Barbados** .....

**BG Bulgaria(3)** .....

**9 BR Brazil(3)** .....

**CH and LI Switzerland and Liechtenstein** .....

**10 DE Germany (Federal Republic of)(3) Utility Model** .....

**5 DK Denmark** .....

**6 FI Finland** .....

**GB United Kingdom** .....

**HU Hungary** .....

**3 JP Japan(3)** .....

**KP Democratic People's Republic of Korea(3)** .....

**8 KR Republic of Korea(3)** .....

**LK Sri Lanka** .....

**LU Luxembourg(3)** .....

**MC Monaco(3)** .....

**MG Madagascar** .....

**MW Malawi(3)** .....

**NL Netherlands** .....

**7 NO Norway** .....

**RO Romania** .....

**SD Sudan** .....

**SE Sweden** .....

**SU Soviet Union(3)** .....

**2 US United States of America(3) Continuation -in-part** .....

Space reserved for designating States (for the purposes of a national patent) which have become party to the PCT after the issuance of this sheet:

(1) The applicant's choice of the order of designations may be indicated by marking the check-boxes with sequential arabic numerals (see also the "Notes to Box No. V").  
(2) The selection of particular States for a European patent can be made upon entering the national (regional) phase before the European Patent Office (see also the "Notes to Box No. V").  
(3) If another kind of protection or a title of addition or, in the United States of America, treatment as a continuation or a continuation-in-part is desired, specify according to the instructions given in the "Notes to Box No. V."

Sheet number 3..

**Supplemental Box. Use this box in the following cases:**

- (i) if more than three persons are involved as applicants and/or inventors; in such case, write "Continuation of Box No. III" and indicate for each additional person the same type of information as required in Box No. III;
- (ii) if, in Box No. II or any of the sub-boxes of Box No. III, the indication "the States indicated in the Supplemental Box," is checked; in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the applicant(s) involved and, next to (each) such name, the country or countries (or EP or OA, if applicable) for the purposes of which he/she/it is applicant;
- (iii) if, in Box No. II or any of the sub-boxes of Box No. III, a person indicated as "applicant and inventor" or "inventor only" is not inventor for the purposes of all designated States or for the purposes of the United States of America; in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the inventor and, next to such name, the country or countries (or EP or OA, if applicable) for the purposes of which the named person is inventor;
- (iv) if there is more than one agent and their addresses are not the same; in such case, write "Continuation of Box No. IV" and indicate for each additional agent the same type of information as required in Box No. IV;
- (v) if, in Box No. V, the name of any country (or OAPI) is accompanied by the indication "patent of addition," "certificate of addition," or "inventor's certificate of addition," or if, in Box No. V, the name of the United States of America is accompanied by an indication "Continuation" or "Continuation in part"; in such case, write "Continuation of Box No. V" and the name of each country involved (or OAPI), and after the name of each such country (or OAPI), the number of the parent title or parent application and the date of grant of parent title or filing of parent application;
- (vi) if there are more than three earlier applications whose priority is claimed; in such case, indicate "Continuation of Box No. VI" and indicate for each additional earlier application the same type of information as required in Box No. VI;
- (vii) if, in any of the Boxes, the space is insufficient to furnish all the information; in such case, write "Continuation of Box No. ..." (indicate the number of the Box) and furnish the information in the same manner as required according to the captions of the Box in which the space was insufficient;
- (viii) if the applicant intends to claim in respect of any designated Office, the benefit of provisions of the national law concerning non-prejudicial disclosures or exceptions to lack of novelty; in such case, write "Statement Concerning Non-prejudicial Disclosures or Exceptions to Lack of Novelty" and furnish that statement below

**Continuation of Box No. V.**

United States of America, Continuation-in-part of  
application Serial Number 06/876,543, filed 15 July 1986.

If this Supplemental Box is not used, this sheet need not be included in the Request.

Sheet number...4...

**Box No. VI PRIORITY CLAIM (IF ANY).** The priority of the following earlier application(s) is hereby claimed:

Country (country in which it was filed if national application; one of the countries for which it was filed if regional or international application)	Filing Date (day, month, year)	Application No.	Office of Filing (fill in only if the earlier application is an international application or a regional application)
(1) US	15 July 1986	06/876,543	
(2)			
(3)			

(Letter codes may be used to indicate country and/or Office of filing)

When the earlier application was filed with the Office which, for the purposes of the present international application, is the receiving Office, the applicant may, against payment of the required fee, ask the following:

the receiving Office is hereby requested to prepare and transmit to the International Bureau a certified copy of the above-mentioned earlier application/of the earlier applications identified above by the numbers (insert the applicable numbers)

**Box No. VII EARLIER SEARCH (IF ANY).** Fill in where a search (international, international-type or other) by the International Searching Authority has already been requested (or completed) and the said Authority is now requested to base the international search, to the extent possible, on the results of the said earlier search. Identify such search or request either by reference to the relevant application (or the translation thereof) or by reference to the search request.

International application number or number and country (or regional Office) of other application:

International/regional/national filing date

Date of request for search:

Number (if available) given to search request:

**Box No. VIII SIGNATURE OF APPLICANT(S) OR AGENT**

*Christopher Columbus*  
 Christopher Columbus  
 President, Columbia Marine Corp.

*John Paul Jones*  
 John Paul Jones

If the present Request form is signed on behalf of any applicant by an agent, a separate power of attorney appointing the agent and signed by the applicant is required. If in such case it is desired to make use of a general power of attorney (deposited with the receiving Office), a copy thereof must be attached to this form.

**Box No. IX CHECK LIST (To be filled in by the Applicant)**

This international application contains the following number of sheets:

1. request	4	sheets
2. description	20	sheets
3. claims	5	sheets
4. abstract	1	sheets
5. drawings	4	sheets
<b>Total</b>	<b>34</b>	<b>sheets</b>

Figure number .....1..... of the drawings (if any) is suggested to accompany the abstract for publication.

This international application as filed is accompanied by the items checked below:

- separate signed power of attorney
- copy of general power of attorney
- priority document(s) (see Box No. VI)
- receipt of the fees paid or revenue stamps
- cheque for the payment of fees
- request to charge deposit account
- other document (specify)

Transmittal letter

(The following is to be filled in by the receiving Office)

1. Date of actual receipt of the purported international application:

2. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:

3. Date of timely receipt of the required corrections under Article 11 of the PCT:

4. Drawings  Received  No Drawings

(The following is to be filled in by the International Bureau)

Date of receipt of the record copy:

THIS SHEET IS NOT PART OF AND DOES NOT COUNT AS A SHEET OF THE INTERNATIONAL APPLICATION

<b>APPLICANT</b> Columbia Marine Corporation		<b>This column for use by receiving Office</b>
<b>INTERNATIONAL APPLICATION NUMBER</b> (to be filled in by the receiving Office)	<b>DATE STAMP OF RECEIVING OFFICE</b>	
<b>FEE CALCULATION SHEET<sup>1</sup></b>		
<b>FEEES SUBMITTED OR TO BE CHARGED TO DEPOSIT ACCOUNT</b>		
<b>I. TRANSMITTAL FEE<sup>2</sup></b> .....	\$170	T
<b>II. SEARCH FEE<sup>3</sup></b> .....	\$350	S
International search to be effected by ..... (Please indicate, but only if the applicant has the choice between two or more International Searching Authorities, the name of the Authority to which the international application is to be transmitted. Note that the amount of the search fee depends on the identity of the International Searching Authority.)		
<b>III. INTERNATIONAL FEE<sup>4</sup></b>		
<b>BASIC FEE<sup>5</sup></b>		
Indicate the number of SHEETS contained in the international application <span style="float: right;">34</span>		
first 30 sheets .....	\$485	b <sub>1</sub>
remaining <u>4</u> sheets x \$10	= \$40	b <sub>2</sub>
Add amounts entered in boxes b <sub>1</sub> and b <sub>2</sub> and enter total in box B.		B
This figure is the amount of the BASIC FEE .....		
<b>DESIGNATION FEES<sup>6</sup></b>		
Indicate the number of NATIONAL PATENTS which have been sought and multiply by the amount of the designation fee.		
<u>9</u> x \$120	= \$1,080	d <sub>1</sub>
Indicate the number of REGIONAL PATENTS which have been sought and multiply by the amount of the designation fee.		
<u>1</u> x \$120	= \$120	d <sub>2</sub>
Add amounts entered in boxes d <sub>1</sub> and d <sub>2</sub> and enter total in box D (if that total exceeds the figure which corresponds to the amount of the designation fee multiplied by ten, enter the latter figure in Box D) <sup>6</sup> .		D
This figure is the amount of the DESIGNATION FEES .....		\$1,200
Add amounts entered in boxes B and D, and enter total in box I.		I
This figure is the amount of the INTERNATIONAL FEE .....		\$1,725.00
<b>IV. TOTAL OF PRESCRIBED FEES SUBMITTED OR TO BE CHARGED TO DEPOSIT ACCOUNT</b>		
Add amounts entered in boxes T, S and I, and enter total in the TOTAL box. This figure is the total amount of the PRESCRIBED FEES SUBMITTED OR TO BE CHARGED TO DEPOSIT ACCOUNT .....		TOTAL
		\$2,245.00
<b>THE APPLICANT MAY PAY THE PRESCRIBED FEES BY (CHEQUE, POSTAL MONEY ORDER, BANK DRAFT, CASH, REVENUE STAMPS, COUPONS, ETC.). PAYMENT SHOULD BE MADE IN THE PRESCRIBED CURRENCY TO THE (ACCOUNT OF, ACCOUNT INDICATED BELOW OF, ORDER OF) THE RECEIVING OFFICE. PAYMENT MAY ALSO BE MADE BY AUTHORIZATION TO CHARGE A DEPOSIT ACCOUNT AT THE RECEIVING OFFICE IF THE LATTER HAS A DEPOSIT ACCOUNT SYSTEM.</b>		
<b>DEPOSIT ACCOUNT AUTHORIZATION<sup>7</sup></b>		
<input checked="" type="checkbox"/> The RO/ US is hereby authorized to charge the total fees indicated above to my deposit account.		
<input checked="" type="checkbox"/> The RO/ US is hereby authorized to charge any deficiency or credit any overpayment in the total fees indicated above to my deposit account.		
<input checked="" type="checkbox"/> The RO/ US is hereby authorized to charge the fee for preparation and transmittal of the priority document to the International Bureau of WIPO to my deposit account.		
99-1111	02 July 1987	<i>John Adams</i>
Deposit Account Number	Date	Signature John Adams

NOTES TO THE REQUEST FORM (PCT/RO/101)

These Notes are intended to facilitate the filing in of the form. For authentic information, see the text of the Patent Cooperation Treaty and the texts of the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and the said texts, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

"Rule" refers to Rules of the Regulations and "Section" refers to Sections of the Administrative Instructions.

Please use a typewriter. The applicable check-boxes may be marked with black ink.

NOTES TO BOX No. I

**Title of Invention (Rules 4.3 and 5.1(a)):** The title must be short (preferably two to seven words when in English or translated into English) and precise. It must be identical with the title heading the description.

NOTES TO BOXES No. II and III

**Indication whether a Person is Applicant and/or Inventor (Rules 4.5(a) and 4.6(a) and (b)):** Please mark the applicable check-box in order to indicate whether the person (including a legal entity) named is "applicant only" (which means that the person is not also inventor), "inventor only" (which means that the person is not also applicant) or "applicant and inventor" (which means that the person is both). A person is to be named only once, even where the person is both applicant and inventor.

**Names and addresses (Rule 4.4):** The family name (preferably in capital letters) must be indicated before the given name(s). Titles and academic degrees must be omitted. Names of legal entities must be indicated by their full official designations.

The address must be indicated in such a way that it allows prompt postal delivery; it must consist of all the relevant administrative units (up to and including the indication of the house number, if any, and the country).

Only one address may be indicated per person. Where no agent is appointed, a special "address for notifications" may be indicated in Box No. IV (see below).

**Nationality (Rules 4.5(a) and (b) and 4.6(a)):** For each applicant, the nationality must be indicated by the name of the State of which the person is a national. This indication is not required where a person is inventor only.

**Residence (Rules 4.5(a) and (c) and 4.6(a)):** For each applicant, the residence must be indicated by the name of the State of which the person is a resident. However, if the residence is not indicated, it will be assumed that the State of residence is the same as the State indicated in the address. The indication of the residence is not required where a person is inventor only.

**Names of States (Section 201(a)):** For the indication of names of States the two-letter country codes may be used.

**Different Applicants for Different Designated States (Rule 18.4(a)):** It is possible to indicate different applicants for the purposes of different designated States. In such a case, in respect of each designated State, at least one of the applicants indicated for the purposes of that State must be a national or resident of a PCT Contracting State. Where the United States of America is one of the designated States, the inventor(s) must be the applicant(s) for the United States of America and the check-box "applicant and inventor" must be marked.

For the indication of the designated States for which a person is applicant please mark the applicable check-box (only one). The check-box "the States indicated in the 'Supplemental Box'" must be marked where none of the other three check-boxes fits; in such a case, the name of the person must be repeated in the Supplemental Box with an indication of the States for which he is applicant (see item (ii) in that Box).

**Naming of inventor (Rule 4.1(a)(v) and (c)(i)):** The inventor's name and address must be indicated where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing; for details see the PCT Applicant's Guide, Volume I, Annex B. It is strongly recommended that the name always be the inventor.

**Different Inventors for Different Designated States (Rule 4.6(c)):** Different persons may be indicated as inventors for different designated States where, in this respect, the requirements of the national laws of the designated States are not the same; in such a case, the Supplemental Box must be used (see item (iii) in that Box).

NOTES TO BOX No. IV

**Agent or Common Representative (Rules 4.7, 4.8 and Section 104):** For the manner in which name(s) and address(es) including names of States must be indicated, see the Notes to Boxes No. II and III. Where several agents are listed, the agent to whom any correspondence must be addressed is to be listed first. If there is more than one applicant but no common agent representing them, the Request must designate one of the applicants who is a national or resident of a Contracting State, as their common representative. If this is not done, the common representative will be the applicant first named in the Request who is entitled to file an international application with the receiving Office.

**Appointment of Agent or Common Representative (Rule 90.3 and Section 106):** Any such appointment may be made by designating the agent(s) or the common representative in the Request or in a separate power of attorney. Each applicant must sign either the Request or the separate power of attorney. Where the international application is filed with reference to a general power of attorney, a copy thereof must be attached to the Request and any applicant who did not sign the general power of attorney must sign either the Request or a separate power of attorney.

**Address for Notifications (Rule 4.4(d)):** If no agent has been appointed, a special address for the sending of notifications to the applicant may be indicated in Box No. IV instead of the name and address of an agent. That address must be different from the address given in Box No. II and the special check-box must be marked. If an agent has been appointed, notifications will be sent to his address.

NOTES TO BOX No. V

**Designation of States:** The Contracting States in which protection is desired must be designated in the Request by marking the applicable check-boxes. Note that after filing further designations cannot be made.

The marking of the check-boxes of the designated States by means of sequential arabic numerals will be taken as indicating the applicant's choice of the order of the designations; if another form of marking is used, the order will be taken as that in which the marked boxes appear on the form. This order will only have any significance if the amount received for the designation fees is insufficient to cover all the designations; in that case, the amount received will be applied in payment of the fees for the designations following the said order (Rule 16bis.2(c) and Section 321).

For the designation of a State which has become party to the PCT after the date appearing on the bottom of the second sheet of the Request form, the name of the State, preferably preceded by the two-letter country code, must be given together with an indication, where applicable, whether national or regional protection or a special kind of protection or treatment is desired.

Where a European patent is desired, only one designation fee must be paid for that purpose, independently of the number of States designated for a European patent.

Where one or more States are designated twice (once for the purposes of a European patent and once for the purposes of national protection), the applicant must pay one designation fee in respect of the European patent and as many designation fees as there are national patents or other titles of protection sought (Rule 15.1(ii) and Section 210).

Note that Belgium, France and Italy can only be designated for the purposes of a European patent and not for the purposes of national protection.

If a European patent is desired for only some of the Contracting States of the European Patent Convention, the names of those States for which no European patent is desired may be deleted by striking them out. However, it is recommended to designate always all the Contracting States of the European Patent Organisation and to make a selection only upon entering the national (regional) phase before the European Patent Office and upon payment of the European designation fees.

**Choice of Certain Kinds of Protection or Treatment (Rules 4.12 to 4.14, Section 202):** Where, in any country where that is possible, instead of a patent, a national title other than a patent is desired, write after the name of that country on the dotted line the name of the title, that is, "petty patent" (available in Australia), "utility model" (available in Brazil, Germany (Federal Republic of), Japan, the Republic of Korea, OAPI) or "inventor's certificate" (available in Bulgaria, the Democratic People's Republic of Korea, the Soviet Union). Where, in the Federal Republic of Germany (the only country in which this possibility exists), in addition to a patent, a utility model is also desired, write after the name of that country "and utility model".

Where, in respect of any country where that is possible, it is desired that the application be treated as an application for a certain title "of addition" or as an application for a "continuation" or a "continuation-in-part", write after the name of that country the appropriate words, that is, "patent of addition" (available in Australia, Austria, Bulgaria, Germany (Federal Republic of), Malawi, the Soviet Union), "certificate of addition" (available in Luxembourg, Monaco, OAPI), "inventor's certificate of addition" (available in Bulgaria, the Soviet Union), "continuation" or "continuation-in-part" (both available in the United States of America). If any of these indications is used, indicate in the "Supplemental Box" the State for which such treatment is desired, the number of the parent title or parent application, and the date of grant of the parent title or the date of filing of the parent application, as the case may be (see item (v) in that Box).

#### NOTES TO BOX No. VI

**Priority Claim (Rule 4.10):** The declaration containing the priority claim must be made in the Request.

The Request must indicate both

- (i) when the earlier application is not a regional or an international application, the country in which it was filed, or, when the earlier application is a regional or an international application, at least one country for which it was filed, and
  - (ii) the date on which it was filed;
- otherwise, the priority claim will, for the purposes of the procedure under the Treaty, be considered not to have been made.

If the application number of the earlier application is not indicated in the Request but is furnished by the applicant to the International Bureau or to the receiving Office prior to the expiration of the 16th month from the priority date, it is considered by all designated States to have been furnished in time.

**Certified Copy of Earlier Application (Priority Document) (Rule 17.1):** Such copy must be submitted to the International Bureau or to the receiving Office prior to the expiration of the 16th month from the priority date or, where an early start of the national phase is requested, not later than at the time such request is made.

Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request may be made by marking the special check-box and by identifying the document. Attention: where such a request is made, the applicant must pay to the receiving Office the applicable fee for priority document.

**Dates (Section 110):** They must be indicated by the arabic number of the day, the name of the month and the arabic number of the year; after or below such indication, the date should be repeated in parentheses by indicating it by two-digit arabic numerals each for the number of the day, for the number of the month and for the last two numbers of the year, e.g., 10 June 1986 (10.06.86).

#### NOTES TO BOX No. VII

**Earlier Search (Rule 4.11):** The filling in of Box No. VII may result in a total or partial refund of the international search fee.

#### NOTES TO BOX No. VIII

**Signature (Rules 4.1(d), 4.15 and 90.3(a)):** The signature must be that of the applicant (if there are several applicants all must sign); however, the signature may be that of the agent where a separate power of attorney appointing the agent, or a copy of a general power of attorney already in the possession of the receiving Office, is attached to the Request. The name of each person signing the Request should be typed below the signature; similarly, an indication of the capacity in which the person signs should be indicated if such capacity is not obvious from reading the Request.

#### NOTES TO BOX No. IX

**Reference to a Deposited Microorganism (Rule 13bis and Section 209):** Form PCT/RO/134 or any separate sheet containing indications concerning a deposited microorganism may, in most cases, be listed as "other document." This is not the case if Japan is designated: in that case, Form PCT/RO/134 or any other sheet containing the said indications must be included as one of the sheets of the description.

#### NOTES TO "SUPPLEMENTAL BOX"

The manner of making indications in this Box is indicated on the top of the "supplemental sheet."

**Statement concerning Non-Prejudicial Disclosures or Exceptions to Lack of Novelty:** Such a statement, unless contained in the description, may be given in this Box. It should comply with the national law applicable by the designated Office to which the statement is addressed.

#### GENERAL REMARKS

**Language of Correspondence (Rule 92.2 and Section 104):** Any letter from the applicant to the Receiving Office, the International Searching Authority or the International Preliminary Examining Authority must be in the same language as the international application to which it relates; however, the receiving Office, the International Searching Authority or the International Preliminary Examining Authority may authorize the use of another language. Any letter from the applicant to the International Bureau must be in the same language as the international application if that language is English or French; otherwise, it must be in English or French, at the choice of the applicant.

**Arrangement of Elements and Numbering of Sheets of the International Application (Rule 11.7 and Section 207):** The elements of the international application must be placed in the following order: the Request, the description, the claim(s), the abstract, the drawings (if any). All sheets constituting the international application must be numbered in consecutive arabic numerals with three separate series of numbers: the first applying to the Request, the second applying to the part consisting of the description, the claim(s) and the abstract, and the third applying to the drawings. The numbers must be placed at the top of the sheet, in the middle, below the 2cm margin which must remain blank. 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.

PCT INTERNATIONAL APPLICATION TRANSMITTAL LETTER	DATE: <b>02 July 1987</b>
REGARDING THE INTERNATIONAL APPLICATION OF <b>Columbia Marine Corporation</b>	DOCKET OR REFERENCE NUMBER <b>CNC-123</b>
ENTITLED <b>Self-Steering Gear for Sailboats</b>	

**Certification under 37 CFR 1.10 (if applicable)**

"Express Mail" mailing number \_\_\_\_\_ Date of Deposit \_\_\_\_\_

I hereby certify that this application is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

(Typed or printed name of person mailing application) \_\_\_\_\_ (Signature of person mailing application) \_\_\_\_\_

To the United States Receiving Office (RO/US):  
Accompanying this transmittal letter is the above-identified International application, including a completed Request form (PCT/RO/101). Please process the application according to the provisions of the Patent Cooperation Treaty.

The following requests are made of the RO/US:

- PREPARATION AND TRANSMITTAL OF CERTIFIED COPY OF PRIORITY DOCUMENTS**—Please prepare and transmit to the International Bureau a certified copy of the United States origin priority documents identified in Box VI of the Request form (37 CFR 1.451).

To cover the cost of copy preparation and certification (37 CFR 1.19(a)(3) and (b)(1)),  
 a (check) (money order) in the amount of \$ \_\_\_\_\_ is attached to this transmittal letter.  
 the RO/US is hereby authorized to charge the following deposit account no.: **89-1111**

- CHOICE OF INTERNATIONAL SEARCHING AUTHORITY**—It is requested that the International Search be performed by the following International Searching Authority:

- United States Patent and Trademark Office (ISA/US)
- European Patent Office (ISA/EP)

The appropriate Search fee for the above-named Authority is indicated on the Fee Calculation Sheet (PCT/RO/101 Annex).

- SUPPLEMENTAL SEARCH FEES (ONLY WHEN ISA/US CONDUCTS THE INTERNATIONAL SEARCH.)**—Please charge any Supplemental Search fees that may be required by the United States International Searching Authority (ISA/US) to deposit account no.: \_\_\_\_\_

I understand that this authorization is subject to my oral confirmation thereof in each instance and that it in no way limits my right to submit a protest against payment of the Supplemental Search fees, but is merely an administrative aid to assure that the ISA/US may timely complete the Search Report

**NOTE: SUPPLEMENTAL SEARCH FEES FOR ISA/EP ARE PAYABLE DIRECTLY TO THE EUROPEAN PATENT OFFICE**

- DISCLOSURE INFORMATION**—In order to assist in screening the accompanying International application for purposes of determining whether a license for foreign transmittal should and could be granted and for other purposes, the following information is supplied:

- A.  There is no prior filed application relating to this invention.
- B.  There is a prior application, serial number **06/876,543** filed on **15 July 1986** which contains subject matter that is
  1.  substantially identical to that of the accompanying International application.
  2.  less than that of the accompanying International application. The additional subject matter of the International application appears on page(s) and line(s) **p12-16**.
  3.  more than that of the accompanying International application.
- C.  Disclosure information cannot be covered by the language of Points 4A or 4B above due to the involvement of several prior applications or for other reasons. A separate sheet on which the disclosure information is explained is attached to this transmittal letter.

- REQUEST FOR FOREIGN TRANSMITTAL LICENSE**—According to the provisions of 35 U.S.C. 184 and 37 CFR 5.11, a license to transmit the accompanying International application to foreign agencies or international authorities is hereby requested.

SIGNER IS THE <input type="checkbox"/> APPLICANT <input type="checkbox"/> COMMON REPRESENTATIVE <input checked="" type="checkbox"/> (ATTORNEY) (AGENT) <b>23,456</b> REG NO _____	NAME OF SIGNER (typed) <b>John Adams</b>
	SIGNATURE <i>John Adams</i>

(ii) a request to the receiving Office to transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office.

(d) The request shall be signed.

#### 4.2 The Petition

The petition shall be to the following effect and shall preferably be worded as follows: "The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty."

(See >MPEP< §§ 1820.01-1820.11 for PCT Rules 4.3-4.15)

#### 4.16 Transliteration or Translation of Certain Words

(a) Where any name or address is written in characters other than those of the Latin alphabet, the same shall also be indicated in characters of the Latin alphabet either as a mere transliteration or through translation into English. The applicant shall decide which words will be merely transliterated and which words will be so translated.

(b) The name of any country written in characters other than those of the Latin alphabet shall also be indicated in English.

#### 4.17 Additional Matter

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.16, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to 4.16 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

#### 37 CFR 1.434. The request.

(a) The request shall be made on a standardized printed form (PCT Rules 3 and 4). Copies of such printed Request forms are available from the Patent and Trademark Office. Letters requesting such forms should be marked "Box 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) International applications which designate the United States of America shall include:

(1) The name, address and signature of the inventor, except as provided by §§ 1.421(d), 1.422, 1.423 and 1.425;

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

#### PCT Administrative Instructions Section 303 Deletion of Additional Matter in the Request

Where, under Rule 4.17(b), the receiving Office deletes *ex officio* any matter contained in the request, it shall do so by enclosing such matter within square brackets and entering, in the margin, the word "DELETED by RO" or their equivalent in the language of publication of the international application, and shall notify the applicant accordingly. If copies of the international application have already been sent to the International Bureau and the International Searching Authority, the receiving Office shall also notify that Bureau and that Authority.

The Request contains a petition to the effect that the international application be processed according to the PCT; it must contain certain bibliographic information (PCT Article 4(1), PCT Rules 3 and 4 and 37 CFR 1.434). The Request must be made on a printed form (PCT/RO/101) to be filled in with the required information (PCT Rules 3.1, 3.2 and Administrative Instructions Section 102(b)). Any prospective applicant may obtain English language Request forms free of charge from the United States Patent and Trademark Office, Box PCT, Washington, D. C. 20231. The PCT sets forth specific requirements for each element of bibliographic information on the Request form. The Request may not contain any matter that is not

specified in PCT Rule 4. Any additional material will be deleted *ex officio* (Administrative Instructions Section 303).

#### APPLICANT OR AGENT'S FILE REFERENCE

The applicant or agent may use a file reference composed either of letters or numbers or both, provided the file reference does not exceed ten characters. If a file reference is indicated on the Request form, any correspondence from an International Authority to the applicant or agent will include it. (Administrative Instructions Section 108)

#### 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." If the supplemental box does not contain sufficient space, the material should be continued on an additional plain sheet of A4 size paper. If such a continuation sheet is used, it is numbered as an additional page 5 of the Request and counted accordingly in the total number of sheets for fee calculation purposes. The sheet should be entitled "Continuation Sheet to the Request".

#### 1820.01 Title of the Invention [R-2]

##### PCT Rule 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.

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. The word "improved" should not be used in the title.

#### 1820.02 Applicant [R-2]

##### PCT Rule 4.4 Names and Addresses

(a) Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s).

(b) Names of legal entities shall be indicated by their full, official designations.

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. It is recommended to indicate any telegraphic and teleprinter address and telephone number of the agent or common representative or, in the absence of the designation of an agent or common representative in the request, of the applicant first named in the request.

(d) For each applicant, inventor, or agent, only one address may be indicated, except that, if no agent has been appointed to represent the applicant, or all of them if more than one, the applicant or, if there is more than one applicant, the common representative, may indicate, in addition to any other address given in the request, an address to which notification shall be sent.

##### PCT Rule 4.5 The Applicant

(a) The request shall indicate the name, address, nationality and residence

of the applicant or, if there are several applicants, of each of them.

(b) The applicant's nationality shall be indicated by the name of the State of which he is a national.

(c) The applicant's residence shall be indicated by the name of the State of which he is a resident.

The names of natural persons must be given with the family name being indicated before the given name (PCT Rule 4.4). The names of legal entities should be given in full. All addresses should be spelled out in full and include the name of the country in order to assure correct publication of the information. If the United States of America is designated, the applicant must be the inventor at the time of filing (35 U.S.C. 373).

The applicant of an international application for a designated office other than the United States of America may be either the inventor or the owner of the invention. In cases where the inventor is the applicant for certain designated countries and the owner or assignee is the applicant for other designated countries, the names and other identifying information of both must appear in Box No. II and Box No. III with the appropriate boxes checked. Only one applicant's or inventor's name should be listed in each Box.

It should be noted that at least one of the inventors must be a resident or national of a PCT member country in order for the application to enter the national stage in the United States of America. This point involves two basic issues which must be addressed separately. One issue relates to the requirements for a valid designation of the United States of America. The other issue relates to the requirements of the U.S. national law in order for the U.S. Patent and Trademark Office to accept the international application for the national stage. As to the first issue, PCT Rules 18.3 and 18.4 require that at least one of the applicants for each designated State must be a resident or national of a member country of the PCT Union in order for the designation to be valid. As to the second issue, although the designation of the United States of America may be valid for PCT international procedure, the international application will not be accepted at the United States national stage unless the applicant is the inventor (PCT Article 27(3) and 35 U.S.C. 111 and 373). Therefore, at least one of the inventors must be a resident of a PCT member country in order for the international application to enter the national stage in the United States of America.

It should be noted, however, that if the owner or assignee is a resident or national of a PCT member country, the owner can be the sole applicant and file an international application designating all current PCT member countries other than the United States of America. Any invalid designation of States for which at least one applicant is not a resident or national of a Contracting State will be deleted by the Receiving Office. See also >MPEP< § 1805 for the text of rules and other provisions concerning applicants.

### 1820.03 Inventor [R-5]

#### PCT Rule 4.6 The Inventor

(a) Where Rule 4.1(a)(v) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them.

(b) If the applicant is the inventor, the request, in lieu of the indication under paragraph (a), shall contain a statement to that effect.

(c) The request may, for different designated States, indicate different persons as inventors where, in this respect, the requirements of the national laws of the designated States are not the same. In such a case, the request shall contain a separate statement for each designated State or group of States in which a particular person, or the same person, is to be considered the inventor, or in which

particular persons, or the same persons, are to be considered the inventors.

For purposes of the designated countries >other than the United States of America<, the name and address of the inventor must be indicated either in the Request or later at some other point in the procedure (PCT Article 4(1)(v), 4(4), and 22(1); and PCT Rules 4.1(a)(v) and 4.6(a)). It should be noted that Japan as a designated office requires the name and address of the inventor to be present on the Request form on filing. Names should be indicated with the family name preceding the given name, and addresses should be spelled out in full, including both the zip code and country.

### 1820.04 Agent or Common Representative (if any) [R-5]

#### PCT Rule 4.7 The Agent

If agents are designated, the request shall so indicate, and shall state their names and addresses.

#### PCT Rule 4.8 Representation of Several Applicants Not Having a Common Agent

(a) If there is more than one applicant and the request does not refer to an agent representing all the applicants ("a common agent"), the request shall designate one of the applicants who is entitled to file an international application according to Article 9 as their common representative.

(b) If there is more than one applicant and the request does not refer to an agent representing all the applicants and it does not comply with the requirement of designating one of the applicants as provided in paragraph (a), the common representative shall be the applicant first named in the request who is entitled to file an international application with the receiving Office with which the international application was filed (Rule 19.1(a)).

Any attorney or agent registered to practice before the Patent and Trademark Office may act as an agent for the applicant in an international application filed in the United States Receiving Office >before all the international authorities, such as the Receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the International Bureau<. Box No. IV of the Request form may be used as a power of attorney document. For particulars concerning who may sign the Request and power of attorney see >MPEP< §§ 1807 and 1820.11.

It should be noted that under PCT there is no provision for correspondence addresses or associate attorneys. The first-named attorney or agent will receive correspondence (PCT Administrative Instructions Section 108(a)). If the power of attorney is found to be defective, the first-named applicant will receive any correspondence.

Joint applicants may also designate one of the applicants to be a common representative under PCT Rule 4.8(a).

### 1820.05 Designation of States [R-5]

#### PCT Article 43

##### Seeking Certain Kinds of Protection

In respect of any designated or elected State whose law provides for the grant of inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, or utility certificates of addition, the applicant may indicate, as prescribed in the Regulations, that his international application is for the grant, as far as that State is concerned, of an inventor's certificate, a utility certificate, or a utility model, rather than a patent, or that it is for the grant of a patent or certificate of addition, an inventor's certificate of addition, or a utility certificate of addition, and the ensuing effect shall be governed by the applicant's choice. For the purposes of this Article and any Rule thereunder, Article 2(ii) shall not apply.

**PCT Article 44****Seeking Two Kinds of Protection**

In respect of any designated or elected State whose law permits an application, while being for the grant of a patent or one of the other kinds of protection referred to in Article 43, to be also for the grant of another of the said kinds of protection, the applicant may indicate, as prescribed in the Regulations, the two kinds of protection he is seeking, and the ensuing effect shall be governed by the applicant's indications. For the purposes of this Article, Article 2(ii) shall not apply.

**PCT Article 45****Regional Patent Treaties**

(i) Any treaty providing for the grant of regional patents ("regional patent treaty"), and giving to all persons who, according to Article 9, are entitled to file international applications the right to file applications for such patents, may provide that international applications designating or electing a State party to both the regional patent treaty and the present Treaty may be filed as applications for such patents.

(2) The national law of the said designated or elected State may provide that any designation or election of such State in the international application shall have the effect of an indication of the wish to obtain a regional patent under the regional patent treaty.

**PCT Rule 4.9 Designation of States**

Contracting State shall be designated in the request by their names.

\*\*\*\*\*

**PCT Rule 4.12 Choice of Certain Kinds of Protection**

(a) If the applicant wishes his international application to be treated, in any designated State, as an application not for a patent but for the grant of any of the other kinds of protection specified in Article 43, he shall so indicate in the request. For the purposes of this paragraph, Article 2(ii) shall not apply.

(b) In the case provided for in Article 44, the applicant shall indicate the two kinds of protection sought, or, if one of two kinds of protection is primarily sought, he shall indicate which kind is sought primarily and which kind is sought subsidiarily.

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

(a) The names of Designated States shall appear in the Request upon filing and must be indicated as set forth in Section 201 of the Administrative Instructions.

(b) The designation fees may be paid upon filing of the international application, but must be paid \* before the expiration of 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 < \*. Failure to timely pay the designation fee for a particular Designated State will result in the withdrawal of that designation \*. Failure to timely pay at least one designation fee will result in the withdrawal of the international application \*.

**PCT Administrative Instructions Section 201****Names of States**

(a) The name of any State referred to in the request shall be indicated either by the full name of the State, or by a generally accepted short title which, if the indications are in English or French, shall be as appears in Annex A, or by the two-letter country code identifying that State as appears in Annexes A and B.

(b) [Deleted]

**PCT Administrative Instruction Section 202****Kind of Protection**

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

addition" or "utility certificate of addition," or their equivalent in the language of the international application, immediately after the indication of the said State.

(b) Where, in respect of the designation of the Federal Republic of Germany, the applicant is seeking two kinds of protection under Article 44, he shall make the indication referred to in Rule 4.12 (b) by inserting, immediately after the indication of the Federal Republic of Germany and in the language of the international application, one of the two following indications:

(i) "and utility model";

(ii) "and auxiliary utility model."

**PCT Administrative Instructions Section 203****Regional Patents**

(a) If the applicant wishes to obtain a regional patent in respect of any designated State and the request form does not contain preprinted indications permitting the applicant to make the indication in the request referred to in Rule 4.1(b)(iv), the applicant shall make the said indication by inserting the words "regional patent," or their equivalent in the language of the international application, immediately after the indication of the said State or, where an indication has been made under Section 202, after that indication, provided that:

(i) where Article 4(1)(ii), third clause, applies, and not all the States party to the regional treaty have been designated, the international application shall be treated as if all those States had been designated and as if the designations of all such States contained the said words, whether the said designations contained an indication of the wish to obtain a regional patent or, according to Article 4(1)(ii), fourth clause, are to be treated as containing such indication;

(ii) where the national law of any designated State contains a provision as referred to in Article 45(2), the International Bureau shall, according to Article 4(1)(ii), fourth clause, treat the designation as if it contained the said words even where the applicant failed to indicate them.

(b) The applicant may, instead of the words "regional patent" referred to in paragraph (a), use other words to the same effect; such words may include a reference to a patent to be granted by the European Patent Office under the Convention of the Grant of European Patents done at Munich on October 5, 1973 ("European patent"), where the regional patent which the applicant wishes to obtain is a European patent.

(c) An indication, in respect of the designation of Liechtenstein or Switzerland, or both, of the wish to obtain a regional patent shall be taken as indicating a wish to obtain a European patent in respect of those States, whereas the absence of any indication of the wish to obtain a regional patent in respect of such a designation shall be taken as indicating a wish to obtain a patent granted by the Swiss Federal Intellectual Property Office in respect of those States.

**PCT Administrative Instructions Section 210****Calculation of Designation Fee for the Purposes of National and Regional Patents**

Where the request of the international application contains a designation of a Contracting State without an indication of the wish to obtain a regional patent and also a designation of the same Contracting State with an indication of the wish to obtain a regional patent and the national law of the Contracting State does not contain a provision referred to in Article 45(2), the designation fees shall be calculated on the basis that a separate fee is payable in respect of the designation of the Contracting State in addition to the designation fee payable in respect of that Contracting State as a Contracting State or as one of a group of Contracting States for which a regional patent is sought.

All designated States must be named in the Request on filing. It is not possible to add designations of countries to an international application after it is filed. Only those countries for which the PCT has come into effect at the time the international application is filed may be designated. The Request form, as filed, must contain the names of all designated countries in which protection is desired (PCT Article 4(1)(ii), PCT Rules 4.1(a)(iv), and 4.9, and 37 CFR 1.432. However, since the designation fees are not required until one year after the priority date, or if no priority is claimed, until one year after the actual international application filing date > or one month after the international filing date, if that month ends later than one year

## PATENT COOPERATION TREATY

## LIST OF PCT MEMBER STATES

State	Ratification or Accession	Date of Ratification or Accession	Date from Which State May be Designated
(1) Central Africa Republic*	Accession	15 September 1971	01 June 1978
(2) Senegal*	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*	Accession	15 March 1973	01 June 1978
(6) Chad*	Accession	12 February 1974	01 June 1978
(7) Togo*	Ratification	28 January 1975	01 June 1978
(8) Gabon*	Accession	06 March 1975	01 June 1978
(9) United States of America	Ratification	26 November 1975	01 June 1978
(10) Germany, Federal Republic of**	Ratification	19 July 1976	01 June 1978
(11) Congo*	Accession	08 August 1977	01 June 1978
(12) Switzerland**	Ratification	14 September 1977	01 June 1978
(13) United Kingdom**	Ratification	24 October 1977	01 June 1978
(14) France**	Ratification	25 November 1977	01 June 1978
(15) Soviet Union	Ratification	29 December 1977	01 June 1978
(16) Brazil	Ratification	09 January 1978	01 June 1978
(17) Luxembourg**	Ratification	31 January 1978	01 June 1978
(18) Sweden**	Ratification	17 February 1978	01 June 1978
(19) Japan	Ratification	01 July 1978	01 October 1978
(20) Denmark	Ratification	01 September 1978	01 December 1978
(21) Austria**	Ratification	23 January 1979	23 April 1979
(22) Monaco	Ratification	22 March 1979	22 June 1979
(23) Netherlands**	Ratification	10 April 1979	10 July 1979
(24) Romania	Accession	23 April 1979	23 July 1979
(25) Norway	Ratification	01 October 1979	01 January 1980
(26) Liechtenstein**	Accession	19 December 1979	19 March 1980
(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	Ratification	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<

\* 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. \*\* Members of European Patent Convention (EPC) regional patent system. Either national patents or European patents for member States are available through PCT, except for France, Belgium and Italy, for which only European patents are available if PCT is used. Note: only one designation fee is due if European patent protection is sought for one, several or all EPC member countries.

after the priority date (PCT Rule 15.4(b)(ii)<\*, applicants who file without claiming priority, or who file early in the priority year, may initially designate all PCT countries in which they may have an interest and later only pay designation fees for those countries in which patent protection is seriously desired >and withdraw the designations as to the other States<. Any designated country for which a designation fee is not timely paid is considered withdrawn.

States must be designated in Box No. V by checking the appropriate box beside the name of each State. A choice between a national patent and a regional patent is available for States that are members of both the PCT and the European (EPC) regional patent convention. For the EPC, regional or national protection is available for Austria, The Federal Republic of Germany, Luxembourg, The Netherlands, Sweden, Switzerland, Liechtenstein, or the United Kingdom. However, where France, Belgium

and/or Italy is designated, the application will be treated as an application for a European patent with effect for France, Belgium and/or Italy.

The designation of any State is treated as an expression of the wish to obtain a patent in the designated State. However, if the applicant wishes the international application to be treated in any designated States (whose national law>offers<\* that kind of protection) as an application not for a patent but for an inventor's certificate, a utility certificate, a utility model, a patent of addition, a certificate of addition, an inventor's certificate of addition or a utility certificate of addition, the applicant must indicate that desire in Box No. V of the Request by indicating the kind of protection immediately after the indication of the State (Administrative Instructions Section 202(a)), and the application will be dealt with accordingly in that State (PCT Rules 4.1(b)(iii) and 4.12). Annex B of the

"PCT Applicant's Guide" indicates, in respect of each Contracting State, the kinds of protection available

The applicant may, in respect of any designated State (whose national law offers\* the kinds of protection involved and admits the possibility of seeking two kinds of protection), mention in the Request of two kinds of protection (Box No. V), together with an indication of the one preferred and the application will be dealt with accordingly in that State (PCT Article 44 and PCT Rule 4.12(b)). Annex B of the PCT Applicant's Guide indicates, in respect of each Contracting State, whether this possibility is available. Currently the possibility of seeking two kinds of protection is available only for the Federal Republic of Germany as a designated State.

The indication on the line of the type of protection desired is placed directly after the checkbox for the State. Where a title (patent, certificate, inventor's certificate, utility certificate) of addition, is sought, or where the applicant wishes the international application to be treated in any designated State as an application for a continuation or a continuation-in-part, the fact must be indicated together with an identification of the parent application (PCT Rules 4.1(b)(v), 4.13 and 4.14). This indication is placed in the Supplemental Box and should be clearly identified as continuing information from Box V regarding the designation of a specific State. See >MPEP< § 1820.07.

## 1820.06 Priority [R-2]

### PCT Article 8 Claiming Priority

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2)(a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

### PCT Rule 4.10 Priority Claim

(a) The declaration referred to in Article 8(1) shall be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, the country or countries for which it was filed,

(ii) the date on which it was filed,

(iii) the number under which it was filed, and

(iv) when the earlier application is a regional or an international application, the national Office or intergovernmental organization with which it was filed.

(b) If the request does not indicate both

(i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, at least one country for which it was filed, and

(ii) the date on which it was filed,

the priority claim shall, for the purposes of the procedure under the Treaty,

be considered not to have been made except where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous; whenever the identity or correct identity of the said country, or the said date or the correct date, may be established on the basis of the copy of the earlier application which reaches the receiving Office before it transmits the record copy to the International Bureau, the error shall be considered as an obvious error.

(c) If the application number of the earlier application is not indicated in the request but is furnished by the applicant to the International Bureau or to the receiving Office prior to the expiration of the 16th month from the priority date, it shall be considered by all designated States to have been furnished in time.

(d) If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within one month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled *ex officio*.

(e) Where the priorities of several earlier applications are claimed, the provisions of paragraphs (a) to (d) shall apply to each of them.

### PCT Rule 32<sup>bis</sup>

#### Withdrawal of the Priority Claim

##### Rule 32<sup>bis</sup>.1 Withdrawals

(a) The applicant may withdraw the priority claim made in the international application under Article 8(1) at any time before the international publication of the international application.

(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 them.

(c) Where the withdrawal of the priority claim, or in the case of more than one such claim, the withdrawal of any of them, 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 already expired shall be computed from the priority date resulting from that change. In the case of the time limit of 18 months 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 effecting withdrawal reaches the International Bureau during the period of 15 days preceding the expiration of that time limit.

(d) For any withdrawal under paragraph (a), the provisions of Rule 32.1(c) shall apply *mutatis mutandis*.

### PCT Administrative Instructions Section 302

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

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

### PCT Administrative Instructions Section 314

#### Manner of Indicating and Notification of Correction of the Priority Date or Cancellation of the Priority Claim

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

(b) Where, under Rule 4.10(d), the receiving Office cancels the declara-

tion made under Article 8(1), that Office shall enclose the box in the request Form which provides for the information concerning the priority claim (or, where the priorities of several earlier applications are claimed and not all those priority claims are cancelled, the relevant part of the said box) within square brackets and enter, in the margin, the words "CANCELLED ON REQUEST OF APPLICANT" or "CANCELLED EX OFFICIO BY RO," as the case may be, or their equivalent in the language of publication of the international application.

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

**PCT Administrative Instructions Section 402**  
**Manner of Indicating and Notification of Correction of the**  
**Priority Date or Cancellation of the Priority Claim**

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

(b) Where, under Rule 4.10(d), the International Bureau cancels the declaration made under Article 8(1), that Bureau shall enclose the box in the request form which provides for the information concerning the priority claim (or, where the priorities of several earlier applications are claimed and not all those priority claims are cancelled, the relevant part of the said box) within square brackets and enter, in the margin, the words "CANCELLED ON REQUEST OF APPLICANT" or "CANCELLED EX OFFICIO BY THE INTERNATIONAL BUREAU," as the case may be, or their equivalent in the language of publication of the international application.

(c) The applicant, the receiving Office and the International Searching Authority shall be notified by the International Bureau of any correction or cancellation effected under Rule 4.10(d) by the International Bureau.

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

**PCT Administrative Instructions Section 408**  
**Priority Application Number**

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

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

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

**PCT Administrative Instructions Section 409**  
**Notification of Priority Claim Considered Not To Have Been**  
**Made**

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

**35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application.**

(a) In accordance with the conditions and requirements of section 119 of this title, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of the first paragraph of section 119 of this title and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120 of this title, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Commissioner may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

An applicant who claims the priority of one or more earlier national or international applications for the same invention must indicate, in the Request at the time of filing the international application, the country in or for which the application was filed, the date on which it was filed, and its application number. (PCT Article 8 and PCT Rule 4.10) When the earlier application is a regional or an international application, the applicant must also indicate the national Office or intergovernmental organization with which it was filed. If the number cannot be indicated in the Request at the time of filing of the international application, it must be furnished to the International Bureau at the latest by the expiration of sixteen months from the priority date.

The applicant may withdraw any priority claim made in the international application until the international publication of the international application (PCT Rule 32<sup>bis</sup>). If the signed notice containing the withdrawal of any priority claim causes a change in the priority date of the international application (for the definition of "priority date," see PCT Article 2(xi)), 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 said change. Further details are provided in PCT Rule 32<sup>bis</sup>.

The date of the filing of the priority application should be given by indicating the number of the day by two digits, the name of the month spelled out in full and the number of the year in four digits, for example, 05 October 1978 (PCT Administrative Instructions, Section 110). The name of the country of filing should be either the official name or accepted short title listed in Annex A of the PCT Administrative Instructions. 35 U.S.C. 365 provides for recognition of priority claims in international applications.

Applicant is required to file a certified copy of each priority application. For particulars, see >MPEP< § 1828.

**1820.07 Parent Application or Grant**

**PCT Rule 4.13 Identification of Parent Application or Parent Grant**

If the applicant wishes his international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, he shall identify the parent application or the parent patent, parent inventor's certificate,

or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph, Article 2(ii) shall not apply.

**PCT Rule 4.14 Continuation or Continuation-in-Part**

If the applicant wishes his international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, he shall so indicate in the request and shall identify the parent application involved.

Box No. V and the Supplemental Box should be used where the applicant has an earlier application in a country designated in the international application and where special title or treatment of the international application is desired. For example, if the applicant has a pending United States application, the international application could contain additional subject matter and be treated as a continuation-in-part in the United States, if the United States is designated in the international application (PCT Rule 4.14). In this example, the entries to be placed in Box No. V would be as follows: "United States of America; continuation-in-part; and in the Supplemental Box, the entry "Continuation of Box No. V, Parent application for U.S. designation: United States of America, 20 May 1981, 222,222" should be inserted.

### 1820.08 Earlier International or International-Type Search

**PCT Rule 4.11 Reference to Earlier Search**

If an international or international-type search has been requested on an application under Article 15(5) or if the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application, the request shall contain a reference to that fact. Such reference shall either identify the application (or its translation, as the case may be) in respect of which the earlier search was made by indicating country, date and number, or the said search by indicating, where applicable, date and number of the request for such search.

The United States Patent and Trademark Office performs an international-type search on all U.S. national applications filed on and after June 1, 1978. No specific request by the applicant is required and no number identifying the international-type search is assigned by the Office. All earlier U.S. applications referred to in Box No. VI and Box No. VII as well as all U.S. applications referred to in separate transmittal letters will be considered by the Office.

Box No. VII should be used to identify related international applications and U.S. national applications.

### 1820.09 Different Applicants for Different Designated States [R-5]

In any international application, different applicants may be indicated for different designated states. This possibility is of great practical importance since, for the purposes of the United States of America, the applicant must be the inventor, whereas, for the purposes of the other countries currently members of the Treaty, no such requirement exists (PCT Article 9(3), PCT Rules 4.6(c) and 18.4 and 35 U.S.C. 373). Where there are several applicants, at least one of them must qualify to file an

international application for each designated State (PCT Rules 18.3, 18.4(a) and (b)).

If it is desired that different applicants be indicated for different designated countries, for example, in an application designating the United States, Sweden and Switzerland, for the purposes of the United States, the inventor must be the applicant. If the invention has been assigned, the assignee may wish to be the applicant for Sweden and Switzerland. If in this example, "A" is the assignee and "B" is the inventor, "A" and "B" must both be indicated as applicants, A as "Applicant only" in Box No. II and B as "applicant and inventor" in Box No. III. The sub-boxes at the bottom of Box No. II and III of the Request are used to identify different applicants for different designated countries. In Box No. III, "B" would be indicated as the applicant for the United States of America and in Box No. II "A" would be indicated as the applicant for Sweden and Switzerland by checking the box labeled "all designated States except the United States of America". It should be noted that both "A" and "B" must also sign the Request form or a power of attorney if the Request is signed by an attorney or agent.

### 1820.10 Different Inventors for Different Designated States

Where, because of the provisions of the national law in the different designated States, it is necessary to indicate different inventors for different designated States, such information should be placed in the Supplemental Box as continuing information from Box II, III, or II and III as the case may be and be labeled "Different Inventors for Different Designated States." (PCT Rule, 4.6(c)). Names of inventors should be indicated family name first. The States should be named by official titles or accepted short titles as listed in Annex A to the PCT Administration Instructions.

### 1820.11 Signature of Applicant [R-5]

**PCT Rule 4.15 Signature**

The request shall be signed by the applicant.

The request form of an international application must be signed. The supplemental box may be used if Box No. VIII has insufficient room for all signatures.

Each applicant must sign either the Request form or a power of attorney appointing the agent named in Box IV of the Request. If the latter, the attorney must sign the Request on behalf of the applicant or applicants signing the separate power of attorney. Each signature appearing in Box VIII should appear over the typed name and title of the person signing.

For provisions concerning representation and for particulars regarding powers of attorney see >MPEP<§1808.

### 1820.12 Check List [R-2]

**PCT Administrative Instructions Section 313**

**Documents Filed with the International Application; Manner of Marking the Necessary Annotations In the Check List**

(a) Any power of attorney and any priority document filed with the international application referred to in Rule 3.3(a)(ii) shall accompany the record copy; any other document referred to in that Rule shall be sent only at the specific request of the International Bureau. If any document referred to in Rule 3.3(a)(ii) which is indicated in the check list as accompanying the international application is not, in fact, filed at the latest by the time the record copy leaves the receiving Office, that Office shall so note on the check list and the said

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indication shall be considered as if it had not been made.

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

When calculating the list of pages, the Notes to the Request and the fee calculation sheet, form PCT/RO/101 Annex, are not counted. Any supplemental sheet used for continuing material, however, is counted.

Items which accompany the international application should be identified in this portion. If transmittal form PTO-1382 is used, it should be referred to as "transmittal letter" under item 7 in Box No. IX.

The figure of drawing which applicant considers to best illustrate the invention should be identified in Box No. IX for publication in the >PCT< Gazette and on the front page of the pamphlet. The figure selection will be reviewed by the International Searching Authority. When the international application contains only one figure which the applicant wishes to have published, the word "sole" should be typed in the space.

The lower box following Box No. IX is to be filled in by the Receiving Office only to indicate whether drawings are missing upon filing. (PCT Administrative Instructions, Section 310(a).)

#### ASSIGNMENT DOCUMENT

An assignment document, or a copy thereof, may be filed with the International application. The Check List of the Request form, Box No. IX, item 7, should be marked to indicate that an assignment document has accompanied the International application on filing. (PCT Rule 3.3(a)(ii)) The assignment document will be transmitted with the Record Copy of the application to the International Bureau.

It should be noted that U.S. Patent and Trademark Office records assignments *only* for International applications in which the United States is named as a designated State. (37 CFR 1.331).

The assignment instrument for an International application must include the indication that the application to which it relates is an international application designating the United States. The assignment instrument and the prescribed fee for recording (37 CFR 1.21) may be filed together with the International application. The Receiving Office will route the instrument and fee to the appropriate organizations for recording.

### 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 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.

#### 37 CFR 1.435 The description.

(a) Requirements as to the content and form of the description are set forth in PCT Rules 5, 9, 10 and 11 and Administrative Instruction 204, and shall be adhered to.

(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.

#### PCT Administrative Instructions Section 204

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

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

- (i) for matter referred to in Rule 5.1(a)(i), "Technical Field";
- (ii) for matter referred to in Rule 5.1(a)(ii), "Background Art";
- (iii) for matter referred to in Rule 5.1(a)(iii), "Disclosure of Invention";
- (iv) for matter referred to in Rule 5.1(a)(iv), "Brief Description of Drawings";
- (v) for matter referred to in Rule 5.1(a)(v), "Best Mode for Carrying Out the Invention", or, where appropriate, "Mode(s) for Carrying Out the Invention";
- (vi) for matter referred to in Rule 5.1(a)(vi), "Industrial Applicability."

The description must "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 Article 5). PCT Rule 5 contains detailed requirements as to the "manner and order" of the description, which, generally, should consist of six parts under the following headings: "Technical Field," "Background Art," "Disclosure of Invention," "Brief Description of Drawings," "Best Mode of Carrying Out the Invention," "Industrial Applicability" (PCT Administrative Instruction Section 204.) The description must begin with the title of the invention as stated in Box No. I of the Request. (PCT Rule 5.) Every fifth line of typing may be numbered along the left hand side to the right of the margin. (PCT Rule 11.8.) Both the line numbers and the text should be between the left and right margins. The page numbers must be placed at the top of the page but not in the top margin. (PCT Rule 11.6 (e).) If the United States of America is designated, the best mode contemplated by the inventor for carrying out the invention must be included in the description (37 CFR 1.435).

## 1823.01 Reference to Deposited Microorganism [R-2]

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

#### Microbiological inventions

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

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

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

Any reference to a deposited microorganism 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 a deposited microorganism shall indicate,  
(i) the name and address of the depositary institution with which the deposit was made;

(ii) the date of deposit of the microorganism 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)(1), 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 a deposited microorganism or failure to include, in a reference to a deposited microorganism, 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 of Furnishing Indications

If any of the indications referred to in Rule 13<sup>bis</sup>.3(a) is not included in a reference to a deposited microorganism in the international application as filed but is furnished by the applicant to the International Bureau within 16 months after the priority date, the indication shall be considered by any designated Office to have been furnished in time unless its national law requires the indication to be furnished at an earlier time in the case of a national application and the International Bureau has been notified of such requirement pursuant to Rule 13<sup>bis</sup>.7(a)(ii), provided that the International Bureau 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. In the event that the applicant makes a request for early publication under Article 21(2)(b), however, any designated Office may consider any indication not furnished by the time such request is made as not having been furnished in time. Irrespective of whether the applicable time limit under the proceeding sentences has been observed, the International Bureau shall notify the applicant and the designated Offices of the date on which it has received any indication not included in the international application as filed. The International Bureau shall indicate that date in the international publication of the international application if the indication has been furnished to it before the completion of technical preparations for international publication.

##### 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 a deposited microorganism 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 microorganism may be made for different designated States.

(c) Any designated Office shall be entitled to 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

(a) Where the international application contains a reference to a deposited microorganism, the applicant shall, upon the request of the International Searching Authority or the International Preliminary Examining Authority, authorize and assure the furnishing of a sample of that microorganism by the depositary institution to the said Authority, provided that the said Authority has notified the International Bureau that it may require the furnishing of samples and that such samples will be used solely for the purposes of international search or interna-

national preliminary examination, as the case may be, and such notification has been published in the Gazette.

(b) Pursuant to Articles 23 and 40, no furnishing of samples of the deposited microorganism 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 microorganism may take place, once the said acts have been performed. Notwithstanding the previous provision, the furnishing of samples from the deposited microorganism may take place under the national law applicable for 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 reference to a deposited microorganism 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 microorganisms 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 Instructions Section 209

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

(a) To the extent that any indication with respect to a deposited microorganism is not contained in the description, it may be given on a separate sheet. Where any such indication is so given, it shall preferably be on the form provided in Annex F as form PCT/RO/134 and, if furnished at the time of filing, the said form shall, subject to paragraph (b), preferably be attached to the request and referred to in the Check List referred to in Rule 3.3(a)(ii).

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

## 1824 The Claims [R-2]

### 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

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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 by 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 feature 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 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 Instructions 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 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.<\*\*\*

**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 shall be clear and concise. They shall be fully supported by the description" (PCT Article 6). 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, generally and wherever appropriate, the claims must consist of two distinct parts, the statement of the prior art and the statement of the features for which protection is sought ("the characterizing portion").

Multiple dependent claims are permitted in international applications 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 and line numbers must not be placed in the margins (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 [R-2]****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 Administrative Instructions Section 310****Procedure in the Case of Missing Drawings**

(a) Where the international application refers to drawings which in fact are not included in that application, the receiving Office shall make the indication referred to in Rule 26.6(a) by an appropriate marking of the request Form.

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

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

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

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

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

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

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

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

(ii) where transmittals under Article 12(1) have already been made, forward a copy of the later submitted drawings to the International Bureau with the indication that such drawings and any reference to such drawings are not to be taken into consideration for the purposes of international processing;

(iii) where transmittals under Article 12(1) have not yet been made, attach a copy of the later submitted drawings to the record copy with the indication that such drawings and any reference to such drawings are not to be taken into consideration for the purposes of international processing.

### 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.

Any international application must contain drawings "when they are necessary for the understanding of the invention" (PCT Article 7(1), 37 CFR 1.437). However, even where, without being necessary for the understanding of the invention, the nature of the invention 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 (or regional) phase. Flow sheets and diagrams are considered drawings (PCT Rule 7.1). The drawing sheets must be numbered in a separate series either as 1/3, 2/3, 3/3 to indicate one of three, two of three and three of three or 1, 2, 3. The drawings in an international application must be on A4 size sheets of paper which must be flexible, strong, white, smooth, non-shiny and durable (PCT Rules 11.3 and 11.5). The space used for illustration on each sheet must not exceed 26.2 cm. by 17.0 cm. (PCT Rule 11.6(c)). One figure of the drawings should be indicated in the Request Box No. IX for use on the front page of the published application to accompany the abstract (PCT Rules 3.3(a)(iii) and 48.2(d)).

## 1826 The Abstract [R-2]

### 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 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 begin on a new sheet following the claims (PCT Administrative Instruction Section 207). It must consist of a summary of the disclosure as contained in the description, the claims and any drawings (PCT Article 3(3)). 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 in English). It 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 (37 CFR 1.438).

## SUMMARY OF ABSTRACT REQUIREMENTS

Preferably 50-150 words, but not more than 250. Should contain —

1. Indication of field of invention.
2. Clear indication of the technical problem.
3. Gist of invention's solution of the problem.
4. Principal use or uses of the invention.
5. Reference numbers of the main technical features.
6. Where applicable, chemical formula which best characterizes the invention.

Should not contain —

1. Superfluous language.
2. Legal phraseology such as "said" and "means."

- 3. Statements of alleged merit or speculative application.
- 4. Prohibited items as defined in PCF Rule 9.

**1827 Fees [R-5]**

**PCT Rule 14  
 The Transmittal Fee**

**14.1 The Transmittal Fee**

(a) Any receiving Office may require that the applicant pay a fee to it, for its own benefit, for receiving the international application, transmitting copies to the International Bureau and the competent International Searching Authority, and performing all the other tasks which it must perform in connection with the international application in its capacity of receiving Office ("transmittal fee").

(b) The amount and the due date of the transmittal fee, if any, shall be fixed by the receiving Office.

**PCT Rule 15  
 The International Fee**

**15.1 Basic Fee and Designation Fee**

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau ("international fee") to be collected by the receiving Office and consisting of,

(i) a "basic fee," and

(ii) as many "designation fees" as there are national patents and regional patents sought by the applicant in the international application, except that, where Article 44 applies in respect of a designation, only one designation fee shall be due.

**15.2 Amounts**

(a) The amounts of the basic fee and of the designation fee areas set out in the Schedule of Fees.

(b) The amounts of the basic fee and of the designation fee shall be established, for each receiving Office which, under Rule 15.3, prescribes the payment of those fees in a currency or currencies other than Swiss currency, by the Director General after consultation with that Office and in the currency or currencies prescribed by that Office ("prescribed currency"). The amounts in each prescribed currency shall be the equivalent, in round figures, of the amounts in Swiss currency set out in the Schedule of Fees. They shall be published in the Gazette.

(c) Where the amounts of the fees set out in the Schedule of Fees are changed, the corresponding amounts in the prescribed currencies shall be applied from the same date as the amounts set out in the amended Schedule of Fees.

(d) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish new amounts in the prescribed currency according to directives given by the Assembly. The newly established amounts shall become applicable two months after the date of their publication in the Gazette, provided that the interested Office and the Director General may agree on a date falling during the said two-month period in which case the said amounts shall become applicable for that Office from that date.

**15.3 Mode of Payment**

The international fee shall be payable in the currency or currencies prescribed by the receiving Office, it being understood that, when transferred by the receiving Office to the International Bureau, the amount transferred shall be freely convertible into Swiss currency.

**15.4 Time of Payment**

(a) The basic fee shall be paid within one month from the date of receipt of the international application.

(b) The designation fee shall be paid:

(i) where the international application does not contain a priority claim under Article 8, within one year from the receipt of the international application,

(ii) where the international application contains a priority claim under Article 8, 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.

(c) Where the basic fee or designation fee is paid later than the date on which the international application was received and where the amount of that fee is in the currency in which it is payable, higher on the date of payment ("the higher amount") than it was on the date on which the international application was received ("the lower amount"),

(i) the lower amount shall be due if the fee is paid within one month from

the date of receipt of the international application,

(ii) the higher amount shall be due if the fee is paid later than one month from the date of receipt of the international application.

(d) If, on February 3, 1984, paragraphs (a) and (b) are not compatible with the national law applied by the receiving Office and as long as they continue to be not compatible with that law, the basic fee shall be paid on the date of receipt of the international application and the designation fee shall be paid within one year from the priority date.

15.5 (Deleted)

**15.6 Refund**

(a) The international fee shall be refunded to the applicant if the determination under Article 11(1) is negative.

(b) In no other case shall the international fee be refunded.

**PCT Rule 16  
 The Search Fee**

**16.1 Right to Ask for a Fee**

(a) Each International Searching Authority may require that the applicant pay a fee ("search fee") for its own benefit for carrying out the international search and for performing all other tasks entrusted to International Searching Authorities by the Treaty and these Regulations.

(b) The search fee shall be collective by the receiving Office. The said fee shall be payable in the currency or currencies prescribed by that Office ("the receiving Office currency"), it being understood that, if any receiving Office currency is not that, or one of those, in which the International Searching Authority has fixed the said fee ("the fixed currency or currencies"), it shall, when transferred by the receiving Office to the International Searching Authority, be freely convertible into the currency of the State in which the International Searching Authority has its headquarters ("the headquarters currency"). The amount of the search fee in any receiving Office currency, other than the fixed currency or currencies, shall be established by the Director General after consultation with that Office. The amounts so established shall be the equivalents, in round figures, of the amount established by the International Searching Authority in the headquarters currency. They shall be published in the Gazette.

(c) Where the amount of the search fee in the headquarters currency is changed, the corresponding amounts in the receiving Office currencies, other than the fixed currency or currencies, shall be applied from the same date as the changed amount in the headquarters currency.

(d) Where the exchange rate between the headquarters currency and any receiving Office currency, other than the fixed currency or currencies, becomes different from the exchange rate last applied, the Director General shall establish the new amount in the said receiving Office currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that any interested receiving Office and the Director General may agree on a date falling during the said two-month period in which case the said amount shall become applicable for that Office from that date.

(e) Where, in respect of the payment of the search fee in a receiving Office currency, other than the fixed currency or currencies, the amount actually received by the International Searching Authority in the headquarters currency is less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) As to the time of payment of the search fee, the provisions of Rule 15.4 relating to the basic fee shall apply.

**16.2 Refund**

The search fee shall be refunded to the applicant if the determination under Article 11(1) is negative.

**16.3 Partial Refund**

Where the international application claims the priority of an earlier international application which has been the subject of an international search by the same International Searching Authority, that Authority shall refund the search fee paid in connection with the later international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b), if the international search report on the later international application could wholly or partly be based on the results of the international search effected on the earlier international application.

**PCT Rule 27**

**Level of Payment of Fees**

**27.1 Fee (a)**

For the purposes of Article 14(3)(a), "fees prescribed under Article 14(3)(a)" means the basic fee (Rule 14), the basic fee part of the international fee (Rule 15.1), and the search fee (Rule 16).

(b) For the purposes of Article 14(3)(a) and (b), "the fee prescribed under Article 14(3)(b)" means the designation fee part of the international fee (Rule 15.2(b)).

**PCT Rule 96**

**The Schedule of Fees**

**96.1 Schedule of Fees Annexed to Regulations**

The amounts of the fees referred to in Rules 15 and 57 shall be expressed in Swiss currency. They shall be specified in the Schedule of Fees which is annexed to these Regulations and forms an integral part thereof.

**SCHEDULE OF FEES**

(EFFECTIVE JANUARY 1, 1986)

**1. Basic Fee**

(Rule 15.2(a))

if the international application contains not more than 30 sheets

706 Swiss francs

if the international application contains more than 30 sheets

706 Swiss francs plus 14 Swiss francs for each sheet in excess of 30 sheets

**2. Designation Fee:**

(Rule 15.2 (a))

171 Swiss francs per designation for which the fee is due, with a maximum of 1,710 Swiss francs, any such designation in excess of 10 being free of charge

**3. Handling Fee:**

(Rule 57.2(a))

216 Swiss francs

**4. Supplement to the Handling Fee:**

(Rule 57.2(b))

216 Swiss Francs

**SURCHARGES**

**5. Surcharge for late payment:**

(Rule 16<sup>ter</sup>.2(a))

Minimum 268 Swiss francs  
Maximum: 674 Swiss francs

Note that effective July 1, >1987<, the "prescribed currency" and amounts for filing in the United States Receiving Office are in U.S. dollars as follows (PCT Rule 15.2(b)):

Basic Fee (application up to 30 sheets)..... >\$485.00<

Fee for each sheet in excess of 30 sheets.....> \$10.00<

Designation Fee (per country or region up to ten)>\$120.00<

Designation Fee (for 11th and subsequent countries or regions) .....No Charge

Applicants should check the most recent issue of the Official Gazette for any changes in the amounts of the fees.

**Fees Associated with International Applications.** — There are three kinds of fees which must be paid to the United States Patent and Trademark Office in connection with the filing and processing of international applications in the United States Receiving Office:

**A transmittal fee** — for the benefit of the Receiving Office for receiving, processing, and transmitting copies of the international applications (PCT Rule 14);

**A search fee** — for the benefit of the International Searching Authority for carrying out the international search and preparing an international search report (PCT Rule 16); and

**An international fee** which includes a basic fee portion and a designation fee portion for each State designated — for the benefit of the International Bureau for performing the tasks required of it under the PCT (PCT Rule 15).

When an international application is filed with the U.S. Patent and Trademark Office as a Receiving Office, the transmittal fee, the search fee, and the basic fee portion of the international fee are due upon filing of the application and may be paid within one month thereafter (35 U.S.C. 361(d)). The designation fee portion of the international fee must be paid within one year of the priority date >or within one month of filing, whichever is later<.

The amounts of the transmittal fee (PCT Rule 14.1) and the search fee (PCT Rule 16.1) set forth in 37 CFR 1.445 are intended to cover the costs of performing the required functions in the U.S. Patent and Trademark Office and are as follows:

Transmittal fee ..... \$170.00

Search fee .....>\$520.00<\*, or >\$350.00<\* if a corresponding U.S. national application has been filed.

The amount of the basic fee portion of the international fee is >\$485.00<\* for an international application containing up to thirty sheets, with an additional charge of \$10.00 per sheet for each sheet in excess of thirty (PCT Rule 15.2(b)). Although all designated States must be named at the time the international application is filed, the payment of the designation fee portion of the international fee need not be paid on filing but must be paid to the Receiving Office, at the latest, within one year of the priority date. The designation fee portion of the international fee is >\$120.00<\* for each State or group of designated States for which the same regional patent is sought (PCT Rule 15.2(b)). In other words, only one \* designation fee is due for all countries for which European patent protection is desired. The maximum amount due for designation fees is >\$1,200.00<\*, any designation in excess of 10 being free of charge.

Fees may be paid by check (37 CFR 1.23) or be charged against a Patent and Trademark Office Deposit Account (37 CFR 1.25).

**REFUND OF FEES**

There is no provision in the PCT concerning the possibility of asking for a refund of the transmittal fee. The search fee and the international fee (both the basic fee and the designation fees) will be refunded where the Receiving Office refuses to "accord" an "international filing date" (PCT Rules 15.6 and 16.2). Such refusal will occur, generally speaking, where the international application is defective in certain respects. Where a (later) international application claims the priority of another (earlier) U.S. national application which has been the subject of search by the U.S. and the U.S. International Searching Authority will carry out the search on the later application, a reduced search fee of >\$350.00<\* is set in respect of the later application (37 CFR 1.445(a)(2)).

**FEE CALCULATION SHEET (FORM PCT/RO/101)**

**ANNEX**

This sheet is not counted as a part of the international application for purposes of determining the amount of the Basic International fee (PCT Rule 15.2(a)).

The instructions for use of this form are printed on the reverse side of the form. When calculating fees, the latest issue of the Official Gazette should be consulted to determine the current level of the PCT fees.

**1827.01 Advance for Unpaid Fees [R-2]**

**PCT Rule 16<sup>bis</sup>**

**Advancing Fees by the International Bureau**

**16<sup>bis</sup>.1 Guarantee by the International Bureau**

(a) Where, by the time they are due under Rule 14.1(b), Rule 15.4 (a) and Rule 16.1(f), the receiving Office finds that in respect of an international application no fees were paid to it by the applicant, or that the amount paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and the search fee, the receiving Office shall charge the amount required to cover those fees, or the missing part thereof, to the International Bureau and shall consider the said amount as if it had been paid by the applicant at the due time.

(b) Where, by the time they are due under Rule 15.4(b), the receiving Office finds that in respect of an international application the payment made by the applicant is insufficient to cover the designation fees necessary to cover all the designations, the receiving Office shall charge the amount required to cover those fees to the International Bureau and shall consider that amount as if it has been paid by the applicant at the due time.

(c) The International Bureau shall transfer from time to time to each receiving Office an amount which is expected to be necessary for covering any charges that the receiving Office has to make under paragraphs (a) and (b). The amount and the time of such transfers shall be determined by each receiving Office according to its own wish. The charging of any amount under paragraphs (a) and (b) shall not require any advance notice to, or any agreement by, the International Bureau.

**16<sup>bis</sup>.2 Obligations of the Applicant, Etc.**

(a) The International Bureau shall promptly notify the applicant of any amount by which it was charged under Rule 16<sup>bis</sup>.1 (a) and (b) and shall invite him to pay to it, within one month from the date of the notification, the said amount augmented by a surcharge of 50%, provided that the surcharge will not be less, and will not be more, than the amounts indicated in the Schedule of Fees. The notification may refer to the charges made both under Rule 16<sup>bis</sup>.1 (a) and (b) or, at the discretion of the International Bureau, there may be two separate notifications, one referring to charges made under Rule 16<sup>bis</sup>.1 (a), the other referring to charges made under Rule 16<sup>bis</sup>.1 (b).

(b) If the applicant fails to pay, within the said time limit, to the International Bureau the amount claimed, or pays less than what is needed to cover the transmittal fee, the basic fee, the search fee, one designation fee and the surcharge, the International Bureau shall notify the receiving Office accordingly and the receiving Office shall declare the international application withdrawn under Article 14(3)(a) and the receiving Office and the International Bureau shall proceed as provided in Rule 29.

(c) If the applicant pays, within the said time limit, to the International Bureau an amount which is more than what is needed to cover the fees and surcharges referred to in paragraph (b) but less than what is needed to cover all the designations maintained, the International Bureau shall notify the receiving Office accordingly and the receiving Office shall apply the amount paid in excess of what is needed to cover the fees and surcharge referred to in paragraph (b) in an order which shall be established as follows:

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

(ii) to the extent that the applicant has not given the indications under item (i), the amount or the balance thereof shall be applied to the designations in the

order in which they appear in the international application;

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

The receiving Office shall declare any designation not covered by the amount paid withdrawn under Article 14(3)(b) and the receiving Office and the International Bureau shall proceed as provided in Rule 29.

Rule 16<sup>bis</sup> was added to provide greater security to the applicant and his professional representative in the case of a mistake (as to the prescribed amount) or delay (beyond the prescribed time limit) in the payment of fees to the Receiving Office (transmittal fee, search fee, basic fee and designation fees). The system introduced by the Rule guarantees that any such mistake or delay will not result in a loss of rights without the International Bureau of WIPO first having issued an invitation to the applicant to pay any amount that was missing when the time for payment expired. Payment pursuant to such an invitation will be subject to a surcharge which in general will be equal to 50% of the missing amount but which will have an upper limit of 674 Swiss francs and a lower limit of 268 Swiss francs. Any payment made in conformity with such an invitation will be regarded as if it had been made within the prescribed — but, in fact, missed — time limit.

The new system operated in the following fashion. Where the receiving Office finds the amount paid to be insufficient to cover all fees due, the Receiving Office will charge the International Bureau with the amount due. The International Bureau will then notify the applicant of the amount it has advanced and will invite the applicant to pay the International Bureau the amount advanced together with a 50% surcharge, provided that the surcharge can not be less than 268 Swiss francs or more than 674 Swiss francs (see the Schedule of Fees.) If the applicant does not timely pay the required amount to the International Bureau, the International Bureau will notify the Receiving Office which will then declare the international application or certain designations withdrawn.

If applicant decides not to pay certain designation fees, it is requested that a letter be sent to the Receiving Office specifically withdrawing such designations. If no such withdrawal letter is received and some designations remain unpaid one year after the priority date, the procedure under PCT Rule 16<sup>bis</sup> will be used.

**1828 Priority Document [R-5]**

**PCT Rule 17**

**The Priority Document**

**17.1 Obligation to Submit Copy of Earlier National Application**

(a) Where the priority of an earlier national application is claimed under Article 8 in the international application, a copy of the said national application, certified by the authority with which it was filed ("the priority document"), shall, unless already filed with the receiving Office, together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or, in the case referred to in Article 23(2), not later than at the time the processing or examination is requested.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request shall be made not later than the expiration of the applicable time limit referred to under paragraph (a) and may be subjected by the receiving Office to the payment of a fee.

(c) If the requirements of neither of the two preceding paragraphs are complied with, any designated State may disregard the priority claim.

#### 17.2 Availability of Copies

(a) The International Bureau shall, at the specific request of the designated Office, promptly but not before the expiration of the time limit fixed in Rule 17.1(a), furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy, except where it requires the furnishing of a copy of the priority document together with a certified translation thereof. The applicant shall not be required to furnish a certified translation to the designated Office before the expiration of the applicable time limit under Article 22.

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.

(c) Paragraph (a) and (b) shall apply also to any earlier international application whose priority is claimed in the subsequent international application.

### PCT Administrative Instructions Section 411

#### Receipt of Priority Document

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

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

(c) Where the date of receipt of the priority document is later than the date of expiration of the time limit referred to in Rule 17.1(a), the International Bureau shall notify the applicant and the designated Offices accordingly.

(d) Where, within the time limit referred to in Rule 17.1(a), the International Bureau has not received the priority document and the receiving Office has received neither the priority document nor a request (together with any required fee) to transmit the priority document, the International Bureau shall notify the applicant and the designated Offices accordingly.

#### 37 CFR 1.451 The priority claim and priority document in an international application.

(a) The claim for priority must be made on the Request (PCT Rule 4.10) in a manner complying with Sections 110 and 201 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application is claimed in an international application, the applicant may request in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office, or in a separate letter filed in the Receiving Office not later than 16 months after the priority date, that the Patent and Trademark Office prepare a certified copy of the national application for transmittal to the International Bureau (PCT Article 8 and PCT Rule 17). The fee for preparing a certified copy is stated in § 1.19(a)(3) and (b)(1).

(c) If a certified copy of the priority document is not submitted together with the international application on filing, or, if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

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 after 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 nor-

mally 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.

Under 37 CFR 1.451, applicant may request, on filing the international application, that the United States Receiving Office prepare and transmit a certified copy of a U.S. national application, the priority of which is claimed, to the International Bureau. The United States Receiving Office will prepare and transmit the certified copy provided that the fees for copying and certification are paid. See >MPEP< § 1830, item (1).

Applicants may also request the United States Receiving Office to prepare and transmit to the International Bureau a certified copy of a priority application filed in the U.S. by checking Box No. VI of the Request form and by paying or authorizing the payment of the fee therefor. The fee Calculation Sheet annexed to the Request form has a check box for authorizing charges for preparation of certified copies of priority applications to a Deposit Account. The fee for a certified copy of a priority application is set forth in 37 CFR 1.19(a)(3) and (b)(1).

### 1830 PCT International Application Transmittal Letter [R-5]

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

(1) Requests under 37 CFR 1.451 for preparation and transmittal to the International Bureau of certified copies of the U.S. national applications, the priority of which is claimed in international application;

(2) Choice of Searching Authority to conduct the International search. Currently, applicants may choose either the U.S. Patent and Trademark Office or the European Patent Office as the Searching Authority.

(3) Authorizations for any required additional \* fees requested by the United States International Searching >or International Preliminary Examining< Authority to be charged to a Deposit Account subject to oral confirmation of the authorization. It should be noted that if the European Patent Office is chosen as the >International< Searching >or Preliminary Examining< Authority, any supplemental search fees requested by that office are payable directly to the European Patent Office.

(4) Indications of information concerning differences in disclosure, if any, between the international application and related applications to assist in determining any foreign transmittal licensing requirements as well as for other purposes; and

(5) Requests for foreign transmittal license.

### 1832 License Request for Foreign Filing Under the PCT [R-2]

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 six months prior to the filing of the international application (37 CFR 5.11(a)(2)). In all other instances, the applicant should petition for a license for foreign filing (transmittal) (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 withdrawn (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 save the U.S. filing date, if the United States of America has been designated, by fulfilling the requirements of 35 U.S.C. 371(c).

**1840 International Stage Time Limits [R-5]**

**PCT Article 47  
Time Limits**

- (1) The details for computing time limits referred to in this Treaty are governed by the Regulations.
- (2)(a) All time limits fixed in Chapters I and II of this Treaty may, outside any revision under Article 60, be modified by a decision of the Contracting States.
- (b) Such decisions shall be made in the Assembly or through voting by correspondence and must be unanimous.
- (c) The details of the procedure are governed by the Regulations.

**PCT Article 48**

**Delay in Meeting Certain Time Limits**

- (1) Where any time limit fixed in this Treaty or the Regulations is not met because of interruption in the mail service or unavoidable loss or delay in the mail, the time limit shall be deemed to be met in the cases and subject to the proof and other conditions prescribed in the Regulations.
- (2)(a) Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.
- (b) Any Contracting State may, as far as that State is concerned, excuse, for reasons other than those referred to in subparagraph (a), any delay in meeting any time limit.

**PCT Rule 79**

**Calendar**

**79.1 Expressing dates**

Applicants, national Offices, receiving Offices, International Searching and Preliminary Examining Authorities, and the International Bureau, shall, for the purposes of the Treaty and the Regulations, express any date in terms of the Christian era and the Gregorian calendar, or, if they use other eras and calendars, they shall also express any date in terms of the Christian era and the Gregorian calendar.

**PCT Rule 80**

**Computation of Time Limits**

**80.1 Periods Expressed in Years**

When a period is expressed as one year or a certain number of years, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

**80.2 Periods Expressed in Months**

When a period is expressed as one month or a certain number of months, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

**80.3 Periods Expressed in Days**

When a period is expressed as a certain number of days, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire on the day on which the last day of the count has been reached.

**80.4 Local dates**

(a) The date which is taken into consideration as the starting date of the computation of any period shall be the date which prevails in the locality at the time when the relevant event occurred.

(b) The date on which any period expires shall be the date which prevails in the locality in which the required document must be filed or the required fee must be paid.

**80.5 Expiration on a Non-Working Day**

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day on which such Office or organization is not open to the public for the purposes of the transaction of official business, or on which ordinary mail is not delivered in the locality in which such Office or organization is situated, the period shall expire on the next subsequent day on which neither if the said two circumstances exists.

**80.6 Date of Documents**

(a) Where a period starts on the day of the date of a document or letter emanating from a national Office or intergovernmental organization, any interested party may prove that the said document or letter was mailed on a day later than the date it bears, in which case the date of actual mailing shall, for the purposes of computing the period, be considered to be the date on which the period starts. Irrespective of the date on which such a document or letter was mailed, if the applicant offers to the national Office or intergovernmental organization evidence which satisfies the national Office or intergovernmental organization that the document or letter was received more than seven days after the date it bears, the national Office or intergovernmental organization shall treat the period starting from the date of the document or letter as expiring later by an additional number of days which is equal to the number of days which the document or letter was received later than seven days after the date it bears.\*\*

**80.7 End of working day**

(a) A period expiring on a given day shall expire at the moment the national Office or intergovernmental organization with which the document must be filed or to which the fee must be paid closes for business on that day.

(b) Any Office or organization may depart from the provisions of paragraph (a) up to midnight on the relevant day.

(c) The International Bureau shall be open for business until 6 p.m.

**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 such mailing 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.

**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 proved 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*.

**PCT Administrative Instructions Section 110****Dates**

Any date in the international application, or used in any correspondence emanating from International Authorities relating to the international application, shall be indicated by the Arabic number of the day, by the name of the month, and by the Arabic number of the year. The receiving Office, where the applicant has not done so, or the International Bureau, where the applicant has not done so and the receiving Office fails to do so, shall, after or below any date indicated by the applicant in the request, repeat the date, in parenthesis, by indicating it by two-digit Arabic numerals each for the number of the day, for the number of the month and for the last two numbers of the year, in that order and with a period after the digit pairs of the day and of the month (for example, "30 March 1978 (30.03.78)").

**35 U.S.C. 364. International stage: Procedure.**

(a) International applications shall be processed by the Patent and Trademark Office when acting as a Receiving Office,\* International Searching Authority, or >International Preliminary Examining Authority< \* in accordance with the applicable provisions of the treaty, the Regulations, and this title.

(b) An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Commissioner of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with.

**37 CFR 1.465 Timing of application processing based on the priority date.**

(a) For the purpose of computing time limits under the Treaty, the priority date shall be defined as in PCT Art. 2(xi).

(b) When a claimed priority date is cancelled under PCT Rule 4.10(d), or considered not to have been made under PCT Rule 4.10(b), the priority date for the purposes of computing time limits will be the date of the earliest valid

remaining priority claim of the international application, or if none, the international filing date.

(c) When corrections under PCT Art. 11(2), Art. 14(2) or PCT Rule 20.2(a) (i) or (iii) are timely submitted, and the date of receipt of such corrections falls later than one year from the claimed priority date or dates, the Receiving Office shall proceed under PCT Rule 4.10(d).

**37 CFR 1.468 Delays in meeting time limits.**

Delays in meeting time limits during international processing of international applications may only be excused as provided in PCT Rule 82. For delays in meeting time limits in a national application, see §1.137.

**1845 Receiving Office Procedure [R-5]****PCT Article 10****The Receiving Office**

The international application shall be filed with the prescribed receiving Office, which will check and process it as provided in this Treaty and the Regulations.

**PCT Rule 20****Receipt of the International Application****20.1 Date and Number**

(a) Upon receipt of papers purporting to be an international application, the receiving Office shall indelibly mark the date of actual receipt in the space provided for that purpose in the request form of each copy received and one of the numbers assigned by the International Bureau to that Office on each sheet of each copy received.

(b) The place on each sheet where the date or number shall be marked, and other details, shall be specified in the Administrative Instructions.

**20.2 Receipt on Different Days**

(a) In cases where all the sheets pertaining to the same purported international application are not received on the same day by the receiving Office, that Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the papers completing the international application were received, provided that:

(i) where no invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within 30 days from the date on which sheets were first received;

(ii) where an invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within the applicable time limit under Rule 20.6;

(iii) in the case of Article 14(2), the missing drawings are received within 30 days from the date on which the incomplete papers were filed;

(iv) the absence or later receipt of any sheet containing the abstract or part thereof shall not, in itself, require any correction of the date marked on the request.

(b) Any sheet received on a date later than the date on which sheets were first received shall be marked by the receiving Office with the date on which it was received.

**20.3 Corrected International Application**

In the case referred to in Article 11(2)(b), the receiving Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the last required correction was received.

**20.3<sup>b</sup> Manner of Carrying Out Corrections**

The Administrative Instructions prescribe the manner in which corrections required under Article 11(2)(a) shall be presented by the applicant and the manner in which they shall be entered in the file of the international application.

**20.4 Determination under Article 11(1)**

(a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers comply with the requirements of Article 11(1).

(b) For the purposes of Article 11(1)(iii)(c), it shall be sufficient to indicate the name of the applicant in a way which allows his identity to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

## PATENT COOPERATION TREATY

**20.5 Positive Determination**

(a) If the determination under Article 11(1) is positive, the receiving Office shall stamp in the space provided for that purpose in the request form the name of the receiving Office and the words "PCT International Application," or "Demande internationale PCT." If the official language of the receiving Office is neither English nor French, the words "International Application" or "Demande internationale" may be accompanied by a translation of these words in the official language of the receiving Office.

(b) The copy whose request sheet has been so stamped shall be the record copy of the international application.

(c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

**20.6 Invitation to Correct**

(a) The invitation to correct under Article 11(2) shall specify the requirement provided for under Article 11(1) which, in the opinion of the receiving Office, has not been fulfilled.

(b) The receiving Office shall promptly mail the invitation to the applicant and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall not be less than 10 days, and shall not exceed one month, from the date of the invitation. If such time limit expires after the expiration of one year from the filing date of any application whose priority is claimed, the receiving Office may call this circumstance to the attention of the applicant.

**20.7 Negative Determination**

If the receiving Office does not, within the prescribed time limit, receive a reply to its invitation to correct, or if the correction offered by the applicant still does not fulfill the requirements provided for under Article 11(1), it shall:

(i) promptly notify the applicant that his application is not and will not be treated as an international application and shall indicate the reasons therefor,

(ii) notify the International Bureau that the number it has marked on the papers will not be used as an international application number,

(iii) keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1, and

(iv) send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under Article 25(1), the International Bureau needs such a copy and specially asks for it.

**20.8 Error by the Receiving Office**

If the receiving Office later discovers, or on the basis of the applicant's reply realizes, that it has erred in issuing an invitation to correct since the requirements provided for under Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in Rule 20.5.

**20.9 Certified Copy for the Applicant**

Against payment of a fee, the receiving Office shall furnish to the applicant, on request, certified copies of the international application as filed and of any corrections thereto.

**PCT Rule 26****Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application****26.1 Time Limit for Check**

(a) The receiving Office shall issue the invitation to correct provided for in Article 14(1)(b) as soon as possible, preferably within one month from the receipt of the international application.

(b) If the receiving Office issues an invitation to correct the defect referred to in Article 14(1)(a) (iii) or (iv) (missing title or missing abstract), it shall notify the International Searching Authority accordingly.

**26.2 Time Limit for Correction**

The time limit referred to in Article 14(1)(b) shall be reasonable under the circumstances and shall be fixed in each case by the receiving Office. It shall not be less than one month from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

**26.3 Checking of Physical Requirements under Article 14(1)(a)(v)**

The physical requirements referred to in Rule 11 shall be checked only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

**26.3<sup>4</sup> Invitation to Correct Defects under Article 14(1)(b)**

The receiving Office shall not be required to issue the invitation to correct

a defect under Article 14(1)(a)(v) where the physical requirements referred to in Rule 11 are complied with to the extent necessary for the purpose of reasonably uniform international publication.

**26.4 Procedure**

(a) Any correction offered to the receiving Office may be stated in a letter addressed to that Office if the correction is of such a nature that it can be transferred from the letter to the record copy without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

(b) to (d) [Deleted]

**26.5 Decision of the Receiving Office**

(a) The receiving Office shall decide whether the applicant has submitted the correction within the time limit under Rule 26.2 and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn; provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

(b) [Deleted]

**26.6 Missing Drawings**

(a) If, as provided in Article 14(2), the international application refers to drawings which in fact are not included in that application, the receiving Office shall so indicate in the said application.

(b) The date on which the applicant receives the notification provided for in Article 14(2) shall have no effect on the time limit fixed under Rule 20.2(a)(iii).

**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.

(b) The Patent and Trademark Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of international fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent and Trademark Office shall be in the English language.

(d) The \*international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall either be paid on filing of an international application or within \*-> such later time as may be fixed by the Commissioner.<

**37 CFR 1.412 The United States Receiving Office.**

(a) The United States Patent and Trademark Office is a Receiving Office only for applicants who are residents or nationals of the United States of America.

(b) The Patent and Trademark Office, when acting as a Receiving Office, will be identified by the full title "United States Receiving Office" or by the abbreviation "RO/US."

(c) The major functions of the Receiving Office include:

(1) According of international filing dates to international applications meeting the requirements of PCT Art. 11(1), and PCT Rule 20;

(2) Assuring that international applications meet the standards for format and content of PCT Art. 14(1), PCT Rule 9, 26, 29.1, 37, 38, 91, and portions of PCT Rules 3 through 11;

(3) Collecting and, when required, transmitting fees due for processing international applications (PCT Rule 14, 15, 16);

(4) Transmitting the record and search copies to the International Bureau and International Searching Authority, respectively (PCT Rules 22 and 23); and

(5) Determining compliance with applicable requirements of Part 5 of this chapter.

#### PCT Administrative Instructions Section 105 Several Applicants

Where any international application indicates as applicants several persons, 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.

#### PCT Administrative Instructions Section 301

##### Notification of Receipt of Purported International Application

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

#### PCT Administrative Instructions Section 305

##### Identifying the Copies of the International Application

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

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

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

(iii) in the same space on the other such copy, the words "HOME COPY," or their equivalent in the language of publication of the international application.

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

#### PCT Administrative Instructions Section 307

##### System of Numbering International Applications

Papers purporting to be an international application under Rule 20.1 shall be marked with the international application number, consisting of the letters "PCT," a slant, the two-letter code, as in Annex B, indicating the receiving Office, a two-digit indication of the last two numbers of the year in which such papers were first received, a slant and a five-digit number, allotted in sequential order corresponding to the order in which the international applications are received (e.g., "PCT/SU78/00001"). Where the International Bureau acts, pursuant to Rule 19.1(b), as receiving Office for a national Office, the two-letter code indicating the national Office for which the International Bureau acts as a receiving Office shall be used. However, if a negative determination is made under Rule 20.7 or a declaration is made under Article 14(4), the letters "PCT" shall be deleted by the receiving Office from the indication of the international application number on any papers marked previously with that number, and the said number shall be used without such letters in any future correspondence relating to the purported international application.

#### PCT Administrative Instructions Section 308

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

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

(b) [Deleted]

#### PCT Administrative Instruction Section 316

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

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

The main procedural steps that any international application goes through in the United States Receiving Office are the following:

(i) the international application and the related fees are received by the Receiving Office and appropriate records created (PCT Article 10);

(ii) the international application is checked by the Receiving Office to determine whether it meets the requirements prescribed by the PCT as to whether a filing date may be granted, fees due on filing are paid in full, whether the priority claim is acceptable, and whether any pages or drawings are missing (PCT Article 11(1), PCT Rule 4.10 and 35 U.S.C. 361(d)). The checks performed by the Receiving Office are of a formal nature and do not go into the substance of the invention;

(iii) where the checks by the United States Receiving Office show that the international application does not meet the requirements for a filing date or other matters are missing, that Office immediately communicates with the applicant in order to obtain any possible necessary corrections (PCT Articles 11(2)(a) and 14(3) and PCT Rules 4.10 and 20).

(iv) where — possibly after correction — the relevant checks by the Receiving Office show that the international application meets the requirements for the granting of a filing date, an international filing date is accorded to the international application by the Receiving Office (PCT Articles 11(1) and 11(2)(b), and PCT Rules 20.3, 20.4, and 20.5);

(v) the United States Receiving Office reviews the application for formal defects under Article 14(1), contacts the applicant or agent by telephone and discusses any necessary corrections. The Receiving Office will mail an invitation to correct and set a time limit for response, which is usually one month.

(vi) the application is reviewed by Licensing and Review Branch and copies of the international application and other documents related thereto are prepared and transmitted by the United States Receiving Office to the International Searching Authority and to the International Bureau so that these Authorities may carry out the procedural steps for which they are responsible in the further processing of the international application (PCT Article 12 and PCT Rules 22, 23, 24, and 25).

#### WHERE TO FILE

The United States Receiving Office is located in Crystal Plaza, Arlington, Virginia, Building 2, Room 7-A04. International applications and related papers may be deposited directly with the United States Receiving Office or be mailed to: Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231. It should be noted that the "Express Mail" Certificate of Mailing 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 thereto are specifically excluded from the Certificate of Mailing procedures under 37 CFR 1.8. The United States Receiving Office staff is available to offer guidance on PCT requirements and procedures. In person, telephone or written inquiries are welcome. Telephone inquiries should be directed to (703) 557-2003. Written inquiries should be addressed to: Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231.

## 1845.01 Transmittal of Record Copy [R-2]

### PCT Article 12

#### Transmittal of the International Application to the International Bureau and the International Searching Authority

(1) One copy of the international application shall be kept by the receiving Office ("home copy"), one copy ("record copy") shall be transmitted to the International Bureau, and another copy ("search copy") shall be transmitted to the competent International Searching Authority referred to in Article 16, as provided in the Regulations.

(2) The record copy shall be considered the true copy of the international application.

(3) The international application shall be considered withdrawn if the record copy has not been received by the International Bureau within the prescribed time limit.

### PCT Rule 21

#### Preparation of Copies

##### 21.1 Responsibility of the Receiving Office

(a) Where the international application is required to be filed in one copy, the receiving Office shall be responsible for preparing the home copy and the search copy required under Article 12(1).

(b) Where the international application is required to be filed in two copies, the receiving Office shall be responsible for preparing the home copy.

(c) If the international application is filed in less than the number of copies required under Rule 11.1(b), the receiving Office shall be responsible for the prompt preparation of the number of copies required, and shall have the right to fix a fee for performing that task and to collect such fee from the applicant.

### PCT Rule 22

#### Transmittal of the Record Copy

##### 22.1 Procedure

(a) If the determination under Article 11(1) is positive, and unless prescriptions concerning national security prevent the international application from being treated as such, the receiving Office shall transmit the record copy to the International Bureau. Such transmittal shall be effected promptly after receipt of the international application or, if a check to preserve national security must be performed, as soon as the necessary clearance has been obtained. In any case, the receiving Office shall transmit the record copy in time for it to reach the International Bureau by the expiration of the 13th month from the priority date. If the transmittal is effected by mail, the receiving Office shall mail the record copy not later than five days prior to the expiration of the 13th month from the priority date.

(b) If the International Bureau has received a copy of the notification under Rule 20.5(c) but is not, by the expiration of 13 months from the priority date, in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly.

(c) If the International Bureau has received a copy of the notification under Rule 20.5(c) but is not, by the expiration of 14 months from the priority date, in possession of the record copy, it shall notify the applicant and the receiving Office accordingly.

(d) After the expiration of 14 months from the priority date, the applicant may request the receiving Office to certify a copy of his international application as being identical with the international application as filed and may transmit such certified copy to the International Bureau.

(e) Any certification under paragraph (d) shall be free of charge and may be refused only on any of the following grounds:

(i) the copy which the receiving Office has requested to certify is not identical with the international application as filed;

(ii) prescriptions concerning national security prevent the international

application from being treated as such;

(iii) the receiving Office has already transmitted the record copy to the International Bureau and that Bureau has informed the receiving Office that it has received the record copy.

(f) Unless the International Bureau has received the record copy, or until it receives the record copy, the copy certified under paragraph (e) and received by the International Bureau shall be considered to be the record copy.

(g) If, by the expiration of the time limit applicable under Article 22, the applicant has performed the acts referred to in that Article but the designated Office has not been informed by the International Bureau of the receipt of the record copy, the designated Office shall inform the International Bureau. If the International Bureau is not in possession of the record copy, it shall promptly notify the applicant and the receiving Office unless it has already notified them under paragraph (c).

22.2 [Deleted]

##### 22.3 Time Limit Under Article 12(3)

The time limit referred to in Article 12(3) shall be three months from the date of the notification sent by the International Bureau to the applicant under Rule 22.1(c) or (g).

### PCT Rule 23

#### Transmittal of the Search Copy

##### 23.1 Procedure

(a) The search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau.

(b) If the International Bureau has not received, within 10 days from the receipt of the record copy, information from the International Searching Authority that that Authority is in possession of the search copy, the International Bureau shall promptly transmit a copy of the international application to the International Searching Authority.

#### 37 CFR 1.461 Procedures for transmittal of record copy to the International Bureau.

(a) Transmittal of the record copy of the international application to the International Bureau shall be made by the United States Receiving Office.

(b) [Reserved]

(c) No copy of an international application may be transmitted to the International Bureau, a foreign Designated Office, or other foreign authority by the United States Receiving Office or the applicant, unless the applicable requirements of Part 5 of this chapter have been satisfied.

The Receiving Office transmits all Record Copies of international applications to the International Bureau. Several rule changes have been made since the PCT became operational in 1978 to relax the time limits of receipt of the Record Copy by the International Bureau and to provide procedures for monitoring such receipt.

The international fees will also be forwarded to the International Bureau by the Receiving Office (35 U.S.C. 42). Since the applicant is required to file only one copy of the international application in the United States Receiving Office (37 CFR 1.433), the United States Receiving Office will prepare the "Search Copy" for the International Searching Authority and the "Home Copy" for its own records (PCT Rule 21.1 and Administrative Instructions Section 305(a)).

#### SAFEGUARDS FOR ASSURING TIMELY RECEIPT OF THE RECORD COPY

The following steps are being taken by the United States Receiving Office to insure timely receipt of the Record Copy by the International Bureau.

(i) The Record Copy is sent by Registered Air Mail to the International Bureau with transmittal letter listing contents.

(ii) The Applicant is informed of the date of mailing of the

Record Copy by form PCT/RO/150 from the United States Receiving Office.

(iii) A Telex is sent to the International Bureau in Geneva giving notice of mailing and the Mail Registration number.

(iv) The International Bureau acknowledges receipt to the United States Receiving Office.

(v) The Applicant is informed of receipt of the Record Copy by the International Bureau.

(vi) The United States Receiving Office is in telephone contact with the International Bureau in Geneva, Switzerland at least once a week, at which time questions are handled and records are coordinated.

## 1845.02 Correction of Defects Before the Receiving Office [R-2]

### 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;

(ii) it does not contain the prescribed indications concerning the applicant;

(iii) it does not contain a title;

(iv) it does not contain an abstract;

(v) it does not comply to the extent provided in the Regulations with the prescribed physical requirements.

(b) If the receiving Office finds any of the said defects, it shall invite the applicant to correct the international application within the prescribed time limit, failing which that application shall be considered withdrawn and the receiving Office shall so declare.

(2) If the international application refers to drawings which, in fact, are not included in that application, the receiving Office shall notify the applicant accordingly and he may furnish them within the prescribed time limit and, if he does, the international filing date shall be the date on which the drawings are received by the receiving Office. Otherwise, any reference to the said drawings shall be considered non-existent.

(3)(a) If the receiving Office finds that, within the prescribed time limits, the fees prescribed under Article 3(4)(iv) have not been paid, or no fee prescribed under Article 4(2) has been paid in respect of any of the designated States, the international application shall be considered withdrawn and the receiving Office shall so declare.

(b) If the receiving Office finds that the fee prescribed under Article 4(2) has been paid in respect of one or more (but less than all) designated States within the prescribed time limit, the designation of those States in respect of which it has not been paid within the prescribed time limit shall be considered withdrawn and the receiving Office shall so declare.

(4) If, after having accorded an international filing date to the international application, the receiving Office finds, within the prescribed time limit, that any of the requirements listed in items (i) to (iii) of Article 11(1) was not complied with at that date, the said application shall be considered withdrawn and the receiving Office shall so declare.

### PCT Rule 29

#### International Applications or Designations Considered Withdrawn under Article 14(1), (3) or (4)

##### 29.1 Finding by Receiving Office

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), that the international application is considered withdrawn:

(i) the receiving Office shall transmit the record copy (unless already transmitted), and any correction offered by the applicant, to the International Bureau;

(ii) the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall

in turn notify the interested designated Offices;

(iii) the receiving Office shall not transmit the search copy as provided in Rule 23, or, if such copy has already been transmitted, it shall notify the International Searching Authority of the said declaration;

(iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy.

(b) If the receiving Office declares under Article 14(3)(b) (failure to pay the prescribed designation fee under Rule 27.1(b)) that the designation of any given State is considered withdrawn, the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration. The International Bureau shall in turn notify the interested national Office.

29.2 [Deleted]

##### 29.3 Calling Certain Facts to the Attention of the Receiving Office

If the International Bureau or the International Searching Authority considers that the receiving Office should make a finding under Article 14(4), it shall call the relevant facts to the attention of the receiving Office.

##### 29.4 Notification of Intent to Make Declaration under Article 14(4)

Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefor. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within one month from the notification.

### PCT Rule 30

#### Time Limit Under Article 14(4)

##### 30.1 Time Limit

The time limit referred to in Article 14(4) shall be four months from the international filing date.

#### PCT Administrative Instructions Section 304 Corrections Submitted to the Receiving Office Concerning Expressions, etc., not to be used in the International Application

Where the applicant submits corrections to the receiving Office aimed at complying with the prescriptions of Rule 9.1, that Office shall, if copies of the international application have not yet been transmitted to the International Bureau and the International Searching Authority, attach copies of such corrections to the international application. If copies of the international application have already been transmitted, the receiving Office shall transmit copies of such corrections to the said Bureau and the said Authority.

#### PCT Administrative Instructions Section 309 Procedure in the Case of Later Submitted Sheets

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

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

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

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

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

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

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

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

(ii) where transmittals under Article 12(1) have already been made, forward a copy of the later submitted sheets to the International Bureau with the indication that such sheets are not to be taken into consideration for the purposes of international processing;

(iii) where transmittals under Article 12(1) have not yet been made, attach a copy of the later submitted sheets to the record copy with the indication

that such sheets are not to be taken into consideration for the purposes of international processing.

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

**PCT Administrative Instructions Section 311**

**Deletion, Substitution or Addition of Sheets of the International Application; Renumbering, etc.**

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

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

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

(ii) when a sheet is substituted, the receiving Office shall mark in the middle of the bottom margin the words "SUBSTITUTE SHEET" or their equivalent in the language of publication of the international application;

(iii) when one or more sheets are added, each sheet shall be identified by the number of the preceding sheet followed by a slant and then by a natural number series, starting always with number one for the first sheet added after an unchanged sheet (e.g., 10/1, 15/1, 15/2, 15/3, etc.). When later additions of sheets to an existing series of added sheets are necessary, an extra digit shall be used for identifying the further additions (e.g., 15/1, 15/1/1, 15/1/2, 15/2, etc.).

(c) In the cases mentioned in (b)(i) and (iii) above, it is recommended that the receiving Office should write, below the number of the last sheet, the total number of the sheets of the international application followed by the words "TOTAL OF SHEETS" or their equivalent in the language of publication of the international application. It is further recommended that, at the bottom of any last sheet added, the words "LAST ADDED SHEET" or their equivalent in the language of publication of the international application should be inserted.

**PCT Administrative Instructions Section 312**

**Notification of Decision Not To Issue Declaration that the International Application is Considered Withdrawn**

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

**37 CFR 1.471 Corrections and amendments during international processing.**

(a) All corrections submitted to the United States Receiving Office must be in the form of replacement sheets and be accompanied by a letter that draws attention to the differences between the replaced sheets and the replacement sheets, except that the deletion of lines of text, the correction of simple typographical errors, and one addition or change of not more than five words per sheet may be stated in a letter and the United States Receiving Office will make the deletion or transfer the correction to the international application, provided that such corrections do not adversely affect the clarity and direct reproducibility of the application (PCT Rule 26.4).

(b) Amendments of claims submitted to the International Bureau shall be as prescribed by PCT Rule 46.

**DEFECTS IN THE INTERNATIONAL APPLICATION WHICH MAY BE CORRECTED**

Four major types of defects may be present in PCT International applications: (1) those fatal defects under Article 11(2) which must be corrected before a filing date can be accorded, (2)

those formal defects under PCT Article 14 which can be corrected without prejudice to the filing date, and (3) defects of missing sheets or drawings and (4) defects in priority information, the correction of which may cause a change in the filing and/or priority dates.

The following defects under PCT Article 11(2) must be corrected before an international filing date can be accorded. Form PCT/RO/103 is used to call applicant's attention to these defects and to invite correction thereof. The time limit for filing the correction is fixed by the Receiving Office. It cannot be less than 10 days or more than one month from the date of the invitation to correct (PCT Rule 20.6(b)).

(i) The international application does not designate at least one Contracting State.

(ii) The international application does not contain the name of the applicant or does not contain at least those minimal indications concerning the name of the applicant which are indicated in PCT Article 11(1)(iii)(c) and PCT Rule 20.4(b).

(iii) The international application does not contain a part which, on the face of it, appears to be a description or a part which, on the face of it, appears to be a claim or claims (PCT Article 11(1)(iii)(d) and (e)).

(iv) None of the applicants is a resident or national of the United States of America, and thereby entitled to file an international application with the United States Receiving Office (PCT Article 11(1)(i)).

(v) The international application is not in the English language which must be used for international applications filed with the United States Receiving Office (PCT Article 11(1)(ii)).

(vi) The international application does not contain an indication that it is intended as an international application (PCT Article 11(1)(iii)(a)).

The following defects under Article 14 must be corrected within the time period set by the United States Receiving Office in the invitation to correct (form PCT/RO/106) to prevent withdrawal of the international application (PCT Rule 26.5). The time limit for correction is fixed by the Receiving Office. It must be reasonable under the circumstances; it cannot be less than one month and normally not more than two months from the date of the invitation to correct. If the correction is timely presented, the application will not be withdrawn.

(i) Where the Receiving Office finds that the international application is not signed (PCT Article (14)(1)(a)(i) and PCT Rules 2, 3, 4.1(d) and 4.15). The invitation to complete together with a copy of the unsigned Request are issued by the Receiving Office as soon as possible after receipt of the international application (PCT Article 14(1)(b), PCT Rule 26.2 and Administrative Instructions Section 316). The applicant must return the copy of the Request properly signed, within the prescribed time limit.

(ii) Where the Receiving Office finds that the international application does not contain the name of the applicant in the prescribed way or the prescribed indications concerning the applicant (other than those specified in Rule 20.4(b)). These indications include, in particular, the applicant's address, residence and nationality (PCT Article 14(1)(a)(ii) and PCT Rules 4.4 and 4.5).

(iii) Where the Receiving Office finds that the international application does not contain a title, that is, a title for the claimed invention (PCT Article 14(1)(a)(iv) and PCT Rule 26.1(b)).

(iv) Where the Receiving Office finds that the international application does not contain an abstract (PCT Article 14(1)(a)(iv) and PCT Rule 26.1(b)).

(v) Where the Receiving Office finds that the international application does not comply, to the extent provided for in the Regulations, with the prescribed physical requirements (PCT Article 14(1)(a)(v) and PCT Rules 11 and 26.3). The physical requirements are provided for in detail in PCT Rule 11. Compliance with them must be checked to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

Several other defects, namely missing sheets or drawings and defective priority information, will not cause the application to become abandoned, but may effect filing and priority dates.

(i) Where the Receiving Office finds that any of the drawings referred to in the international application are, in fact, not included in that application (PCT Article 14(2) and PCT Rule 26.6), the time limit for furnishing such drawings is 30 days from the date on which incomplete papers were received by the Receiving Office (PCT Rule 20.2(a)(iii)). It should be carefully noted that when missing drawings are received within 30 days they will be entered into the application papers, however, the date of receipt of the application and the filing date, will be amended to reflect the date on which the missing drawings were received. The United States Receiving Office will notify the applicant of any missing drawings on form PCT/RO/107. Detailed procedures in the case where drawings are missing are set forth in Section 310 of the PCT Administrative Instructions.

(ii) Where the Receiving Office finds that sheets of the description or claims are missing, the procedures are similar to those in (i) above; and are set forth in detail in PCT Rule 20 and Section 309 of the PCT Administrative Instructions.

(iii) If the Receiving Office finds that the priority claim fails to meet the requirements of Rule 4.10(b) in that the name of the country of filing or the date of filing of the earlier application are missing, the priority claim is considered not to have been made and the applicant is notified accordingly on form PCT/RO/121 (PCT Administrative Instructions Section 302).

(iv) If the Receiving Office finds that the claimed priority date does not fall within the period of one year preceding the International filing date, it will invite the applicant to amend or cancel the priority claim using form PCT/RO/110 (PCT Rule 4.10(d)). The applicant has one month to respond by amending or canceling the priority claim. If no response is timely received, the Receiving Office will cancel the priority claim *ex officio* (Administrative Instructions Section 314). The amendment or cancellation of the priority claim will be acknowledged using form PCT/RO/111.

## PRESENTATION OF CORRECTIONS

According to the nature of the defect, the correction may be stated in a letter only or may have to be filed in the form of a replacement sheet or replacement sheets accompanied by a letter (37 CFR 1.471). The details are provided for in PCT Rule 26.4. Any correction must be in the English language (PCT Rule 12.2). As to the signature and other requirements of such letters, see PCT Rule 92.1. The Receiving Office must inform, and where necessary, transmit copies of replacement sheets to the International Searching Authority.

## CONSEQUENCES OF THE CORRECTION OF DEFECTS

Where the correction is filed with the Receiving Office within the prescribed time limit and is found acceptable, the international application will be considered valid (PCT Article 11(2)(b)). If the correction relates to any of the defects referred to in PCT Article 11(1) and 14(2), the international filing date will be the date on which the correction was received; if it relates only to any of the defects referred to in Article 14(1), the international filing date will be the date on which the international application was received by the Receiving Office.

## CONSEQUENCES OF NOT CORRECTING DEFECTS

Where an acceptable response or correction is not filed within the prescribed time limit, the international application:

(i) will not be treated as an international application (and, consequently will not be accorded an international filing date) if the defect is one of those referred to in PCT Article 11(1) and PCT Rule 20.7;

(ii) will be treated as withdrawn if the defect is one of those referred to in PCT Article 14(1) and PCT Rule 26.5. In the case of a defect of the kind referred to in PCT Article 14(2), which remains uncorrected, the reference to the (missing) drawing(s) in the international application will be considered non-existent. Missing sheets will not be entered into the application if received after 30 days of the receipt of incomplete papers (PCT Rule 20.2(a)(i) and PCT Administrative Instructions Section 309);

(iii) if the priority claim fails to meet the requirements of PCT Rule 4.10(b), the priority claim is considered not to have been made and the applicant is notified accordingly (Administrative Instructions Section 302).

## 1845.03 Correction of Obvious Errors in Documents [R-2]

### PCT Rule 91

#### Obvious Errors in Document

##### 91.1 Rectification

(a) Subject to paragraphs (b) to (g), 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). Rule 26.4(a) 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

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(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>) or (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 publication have been completed, the authorization 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)(ii) 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 to be effective, not later than at the time of the communication of the international application under Article 20.<\*

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 letter 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.

(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.

92.3 Mailings by National Offices and Intergovernmental Organizations

Any document or letter emanating from or transmitted by a national Office or an intergovernmental organization and constituting an event from the date of which any time limit under the Treaty or these Regulations commences to run shall be sent by registered air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within two days from mailing or where air mail service is not available.

92.4 Use of Telegraph, Teleprinter, Etc.

(a) Notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraph (b), below, any document (including any drawing) subsequent to the international application may be sent by telegraph or teleprinter or other like means of communication producing a printed or written document. Any such document so sent shall be considered to have been submitted in a form complying with the requirements of the said Rules on the day on which it was communicated by the means mentioned above, provided that, within 14 days after being so communicated, its contents are furnished in that form, otherwise, the telegraphic, teleprinter or other communication shall be considered not to have been made.

(b) Each national Office or intergovernmental organization shall promptly notify the International Bureau of any means referred to in paragraph (a) by which it is prepared to receive documents referred to in that paragraph. The International Bureau shall publish the information so received in the Gazette as well as information concerning the means referred to in paragraph (a) by which the International Bureau is prepared to receive any such document. Paragraph (a) shall apply with respect to any national Office or intergovernmental organization only to the extent the said information has been so published with respect to it. The International Bureau shall publish, from time to time, in the Gazette, changes in the information previously published.

Obvious errors of transcription may be rectified (PCT Rule 91). The Receiving Office or the International Searching Authority will inform the applicant of obvious errors of transcription using form PCT/RO/108 or PCT/ISA/216, respectively. The form will indicate to which Authority the applicant may request rectification of the error. In general the Receiving Office may authorize rectification of errors in the Request only. The International Searching Authority may authorize rectification of errors in the description, claims, abstract or drawings. The applicant, upon noticing an error of transcription, may spontaneously present a request for rectification to the appropriate Authority. The Authority will promptly inform the applicant of the authorization or the refusal to authorize the rectification of obvious errors. The forms used by the United States Receiving Office and the International Searching Authority for authorization or refusal are PCT/RO/109 and PCT/ISA/217.

1845.04 Changes in Certain Indications in the Request [R-2]

PCT Rule 92<sup>bis</sup>

Recording of Changes in Certain Indications in the Request or the Demand

92<sup>bis</sup>.1 Recording of Changes by the International Bureau

(a) The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:

- (i) person, name, residence, nationality or address of the applicant,
- (ii) person, name or address of the agent, the common representative or the inventor.

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration:

- (i) of the time limit referred to in Article 22(1), where Article 39.1 is not applicable with respect to any Contracting State
- (ii) of the time limit referred to in Article 39(1)(a), where Article 39.1 is applicable with respect to at least one Contracting State.

## 1860 The International Searching Authority [R-2]

### PCT Article 16

#### The International Searching Authority

(1) International search shall be carried out by an International Searching Authority, which may be either a national Office or an intergovernmental organization, such as the International Patent Institute, whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications.

(2) If, pending the establishment of a single International Searching Authority, there are several International Searching Authorities, each receiving Office shall, in accordance with the provisions of the applicable agreement referred to in paragraph(3)(b), specify the International Searching Authority or Authorities competent for the searching of international applications filed with such Office.

(3)(a) International Searching Authorities shall be appointed by the Assembly. Any national Office and any intergovernmental organization satisfying the requirements referred to in subparagraph (c) may be appointed as International Searching Authority.

(b) Appointment shall be conditional on the consent of the national Office or intergovernmental organization to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office or organization and the International Bureau. The agreement shall specify the rights and obligations of the parties, in particular, the formal undertaking by the said Office or organization to apply and observe all the common rules of international search.

(c) The Regulations prescribe the minimum requirements, particularly as to manpower and documentation, which any Office or organization must satisfy before it can be appointed and must continue to satisfy while it remains appointed.

(d) Appointment shall be for a fixed period of time and may be extended for further periods.

(e) Before the Assembly makes a decision on the appointment of any national Office or intergovernmental organization, or on the extension of its appointment, or before it allows any such appointment to lapse, the Assembly shall hear the interested Office or organization and seek the advice of the Committee for Technical Cooperation referred to in Article 56 once that Committee has been established.

### 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.

### PCT Rule 25

#### Receipt of the Search Copy by the International Searching Authority

##### 25.1 Notification of Receipt of the Search Copy

The International Searching Authority shall promptly notify the International Bureau, the applicant, and — unless the International Searching Authority is the same as the receiving Office — the receiving Office, of the fact and the date of receipt of the search copy.

### PCT Rule 35

#### The Competent International Searching Authority

##### 35.1 When Only One International Searching Authority is Competent

Each receiving Office shall, in accordance with the terms of the applicable agreement referred to in Article 16(3)(b), inform the International Bureau which International Searching Authority is competent for the searching of the international applications filed with it, and the International Bureau shall promptly publish such information.

##### 35.2 When Several International Searching Authorities Are Competent

(a) Any receiving Office may, in accordance with the terms of the applicable agreement referred to in Article 16(3)(b), specify several International Searching Authorities:

(i) by declaring all of them competent for any international application filed with it, and leaving the choice to the applicant, or

(ii) by declaring one or more competent for certain kinds of international applications filed with it, and declaring one or more others competent for other kinds of international applications filed with it, provided that, for those kinds of international applications for which several International Searching Authorities are declared to be competent, the choice shall be left to the applicant.

(b) Any receiving Office availing itself of the faculty provided in paragraph (a) shall promptly inform the International Bureau, and the International Bureau shall promptly publish such information.

#### 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 Commissioner.<

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

(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 Commissioner, in accordance with 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
- (4) Transmitting the international search report to the applicant and the International Bureau.

#### 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 the following:

- (i) the making of the international search (PCT Article 15), and
- (ii) the preparing of the international search report (PCT Article 18 and PCT Rule 43).

#### 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 United States Patent and Trademark Office, and the European Patent Office are 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 United States Patent and Trademark Office has informed the International Bureau that in addition to the United States Patent and Trademark Office, the European Patent Office is competent as an International Searching Authority for searching all kinds of international applications filed in the United States Receiving Office on and after Oct. 1, 1982. (PCT Article 16(2) and PCT Rule 35.2(a)(i).

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

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

- (1) Claims may be amended according to EPO search results before entering the European Office as a designated Office.
- (2) The EPO search fee need not be paid upon entering the European Office as a designated Office.
- (3) The EPO search results may be available for use in a U.S. priority application.

(4) The EPO international search may be obtained without the need for a European Professional Representative.

(5) The European Patent Office search could provide the U.S. applicant with the benefit of a European art search (which may be different from his own or the USPTO's search) before it is necessary to enter the European Patent Office or other designated Offices and usually before amendments to the U.S. priority application are needed.\*\*

Some of the disadvantages that may occur due to the European Patent Office making the International Search are the following:

(1) 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.

(2) 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.

#### 1861 The European Patent Office as an International Searching Authority [R-2]

Since October 1, 1982, the European Patent Office (EPO) has been available as a Searching Authority for PCT applications filed in the United States Receiving Office. The choice of Searching Authority, either the EPO or the United States Patent and Trademark Office, must be made by the applicant on filing the International Application. The choice of Searching Authority may also be indicated on Transmittal Letter form PTO-1382.

It should be noted that the European Patent Office 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. Furthermore, the European Patent Office is not equipped to search computer programs.

The international search fee for the European Patent Office must be paid to the United States Patent and Trademark Office (USPTO) as a Receiving Office at the time of filing the international application. The search fee for the European Patent Office is currently set under PCT Rule 16.1(b) at >1,080<\* 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 of 2,095 Deutsche Marks for each additional invention.

A revised fee calculation sheet (form PCT/RO/101, Annex) having appropriate spaces to indicate the choice of International Searching Authority has been developed so that applicants may indicate which International Searching Authority is to make the search.

**1862 The International Search [R-2]****PCT Article 15****The International Search**

(1) Each international application shall be the subject of international search.

(2) The objective of the international search is to discover relevant prior art.

(3) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any).

(4) The International Searching Authority referred to in Article 16 shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.

(5) If the national law of the Contracting State so permits, the applicant who files a national application with the national Office of or acting for such State may, subject to the conditions provided for in such law, request that a search similar to an international search ("international-type search") be carried out on such application.

(b) If the national law of the Contracting State so permits, the national Office of or acting for such State may subject any national application filed with it to an international-type search.

(c) The international-type search shall be carried out by the International Searching Authority referred to in Article 16 which would be competent for an international search if the national application were an international application and were filed with the Office referred to in subparagraphs (a) and (b). If the national application is in a language which the International Searching Authority considers it is not equipped to handle, the international-type search shall be carried out on a translation prepared by the applicant in a language prescribed for international applications and which the International Searching Authority has undertaken to accept for international applications. The national application and the translation, when required, shall be presented in the form prescribed for international applications.

**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 posterior to the international filing date.

(c) Any published application or any patent whose publication date is later 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) Insofar 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 34****Minimum Documentation****34.1 Definition**

(a) The definitions contained in Article 2(i) and (ii) shall not apply for the purposes of this Rule.

(b) The documentation referred to in Article 15(4) ("minimum documentation") shall consist of:

(i) the "national patent documents" as specified in paragraph (c),

(ii) the published international (PCT) applications, the published regional applications for patents and inventors' certificates, and the published regional patents and inventors' certificates,

(iii) such other published items of non-patent literature as the International Searching Authorities shall agree upon and which shall be published in a list by the International Bureau when agreed upon for the first time and whenever changed.

(c) Subject to paragraphs (d) and (e), the "national patent documents" shall be the following:

(i) the patents issued in and after 1920 by France, the former Reichspatentamt of Germany, Japan, the Soviet Union, Switzerland (in French and German languages only), the United Kingdom, and the United States of America,

(ii) the patents issued by the Federal Republic of Germany,

(iii) the patent applications, if any, published in and after 1920 in the countries referred to in items (i) and (ii),

(iv) the inventors' certificates issued by the Soviet Union,

(v) the utility certificates issued by, and the published applications for utility certificates of France,

(vi)\* such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, [or] German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.

(d) Where an application is republished once (for example, and *Offenlegungsschrift* as an *Auslegeschrift*) or more than once, no International Searching Authority shall be obliged to keep all versions in its documentation; consequently, each such Authority shall be entitled not to keep more than one version. Furthermore, where an application is granted and is issued in the form of a patent or a utility certificate (France), no International Searching Authority shall be obliged to keep both the application and the patent or utility certificate (France) in its documentation; consequently, each such Authority shall be entitled to keep either the application only or the patent or utility certificate (France) only.

(e)\* Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan and the Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) For the purposes of this Rule, applications which have only been laid open for public inspection are not considered published applications.

\* The words printed in italics in paragraphs (c)(vi) and (e) of Rule 34.1 will become applicable at the same time that the PCT will enter into force in respect of the country which, among the Spanish-speaking countries, is the first to ratify or accede to the PCT.

## PATENT COOPERATION TREATY

## PCT Rule 36

**Minimum Requirements for International Searching Authorities****36.1 Definition of Minimum Requirements**

The minimum requirements referred to in Article 16(3)(c) shall be the following:

(i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches;

(ii) that Office or organization must have in its possession at least the minimum documentation referred to in Rule 34, properly arranged for search purposes;

(iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

## 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 microbiological 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 Administrative Instructions Section 501****Corrections Submitted to the International Searching Authority Concerning Expressions, etc., Not to be Used in the International Application**

Where the applicant submits corrections to the International Searching Authority aimed at complying with the prescription of Rule 9.1, that Authority shall transmit copies of such corrections to the receiving Office and the International Bureau.

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 further details see PCT Rule 33. 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)).

**DOCUMENTS 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).

**CERTAIN SUBJECT MATTER NEED NOT BE SEARCHED**

No International Searching Authority is required to perform an international search where the international application relates to any of the following subject matters:

(i) scientific and mathematical theories,

(ii) 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,

(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 presentation of information, and

(vi) computer programs to the extent that it, the said Authority is not equipped to search prior art (PCT Article 17(2)(a)(i) and PCT Rule 39).

The applicant planning to file 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. 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.

>The USPTO has declared that it will search and examine in international applications all subject matter searched and examined in U.S. national applications.<

**NO SEARCH REQUIRED IF CLAIMS ARE UNCLEAR**

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) and (b)). Such declaration may also be made in respect of some of the claims only. This may be particularly the case where the description or the claims are unclear. 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. Where only some of the claims are found to be "unsearchable," the International Searching Authority will not search them, but will search the rest of the international application. Any unsearched claims will be indicated in the Search Report.

**1863 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.

### 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.

### PCT Rule 38 Missing 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 (in the language in which the international application is published). In the latter case, it shall invite the applicant to comment on the abstract established by it within one month from the date of the invitation.

(b) The definitive contents of the abstract shall be determined by the International Searching Authority.

### PCT Rule 43 The International Search Report

#### 43.1 Identifications

The international search report shall identify the International Searching Authority which established it by indicating the name of such Authority, and the international application by indicating the international application number, the name of the applicant, the name of the receiving Office, and the international filing date.

#### 43.2 Dates

The international search report shall be dated and shall indicate the date on which the international search was actually completed. It shall also indicate the filing date of any earlier application whose priority is claimed.

#### 43.3 Classification

(a) The international search report shall contain the classification of the subject matter at least according to the International Patent Classification.

(b) Such classification shall be effected by the International Searching Authority.

#### 43.4 Language

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is published.

#### 43.5 Citations

(a) The international search report shall contain the citations of the documents considered to be relevant.

(b) The method of identifying any cited document shall be regulated by the Administrative Instructions.

(c) Citations of particular relevance shall be specially indicated.

(d) Citations which are not relevant to all the claims shall be cited in relation to the claim or claims to which they are relevant.

(e) If only certain passages of the cited document are relevant or particularly relevant, they shall be identified, for example, by indicating the page, the column, or the lines, where the passage appears.

#### 43.6 Fields Searched

(a) The international search report shall list the classification identification of the fields searched. If that identification is effected on the basis of a classification other than the International Patent Classification, the international Searching Authority shall publish the classification used.

(b) If the international search extended to patents, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, utility certificates of addition, or published applications for any of those kinds of protection, of States, periods, or languages, not included in the minimum documentation as defined in Rule 34, the international search report shall, when practicable, identify the kinds of documents, the States, the periods, and the languages to which it extended. For the purposes of this paragraph, Article 2(ii) shall not apply.

#### 43.7 Remarks Concerning Unity of Invention

If the applicant paid additional fees for the international search, the international search report shall so indicate. Furthermore, where the international search was made on the main invention only (Article 17(3)(a)), the international search report shall indicate what parts of the international application were and what parts were not searched.

#### 43.8 Signature

The international search report shall be signed by an authorized officer of the International Searching Authority.

#### 43.9 No Other Matter

The international search report shall contain no matter other than that enumerated in Rules 33.1(b) and (c), 43.1, 2, 3, 5, 6, 7 and 8, and 44.2(a) and (b), and the indication referred to in Article 17(2)(b). In particular, it shall contain no expressions of opinion, reasoning, arguments, or explanations.

#### 43.10 Form

The physical requirements as to the form of the international search report shall be prescribed by the Administrative Instructions.

### PCT Rule 44

#### Transmittal of the International Search Report, Etc.

##### 44.1 Copies of Report or Declaration

The International Searching Authority shall, on the same day, transmit one copy of the international search report or the declaration referred to in Article 17(2)(a) to the International Bureau and one copy to the applicant.

##### 44.2 Title or Abstract

(a) Subject to paragraphs (b) and (c), the international search report shall either state that the International Searching Authority approves the title and the abstract as submitted by the applicant or be accompanied by the text of the title and/or abstract as established by the International Searching Authority under Rules 37 and 38.

(b) If, at the time the international search is completed, the time limit allowed for the applicant to comment on any suggestion of the International Searching Authority in respect of the abstract has not expired, the international search report shall indicate that it is incomplete as far as the abstract is concerned.

(c) As soon as the time limit referred to in paragraph (b) has expired, the International Searching Authority shall notify the abstract approved or established by it to the International Bureau and to the applicant.

##### 44.3 Copies of Cited Documents

(a) The request referred to in Article 20(3) may be presented any time during seven years from the international filing date of the international application to which the international search report relates.

(b) The International Searching Authority may require that the party (applicant or designated 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 16(3)(b) between the International Searching Authorities and the International Bureau.

(c) Any International Searching Authority not wishing to send copies direct to any designated Office shall send a copy to the International Bureau and the International Bureau shall then proceed as provided in paragraphs (a) and (b).

(d) Any international Searching Authority may perform the obligations referred to in (a) to (c) through another agency responsible to it.

### PCT Administrative Instructions Section 503 Method of Identifying Documents Cited in the International Search Report

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

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

- (i) the Office that issued the document, by the two-letter code as in Annex B;
- (ii) the kind of document, by the appropriate symbols as in the Standard Code for Identification of Different Kinds of Patent Documents. Published in WIPO Handbook on Patent Information and Documentation, Volume 1, Part 3, Standards-ST.16.
- (iii) the number of the document as given to it by the Office that issued it (for Japanese patent documents the indication of the year of the reign of the Emperor must precede the serial number of the patent document);
- (iv) the name of the patentee or applicant (in capital letters, where appropriate abbreviated);
- (v) the date of publication of the cited patent document as indicated thereon; and
- (vi) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

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

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

(b) In the case of any book or other separately issued publication:

- (i) the name of the author;
- (ii) the title (including, where applicable, the number of the edition and/or volume);
- (iii) the year of publication (when this coincides with the year of the international application or of the priority claim, the International Searching Authority shall endeavor to determine the month and, if necessary, the day of publication and to indicate these data in the international search report);
- (iv) the name of the publisher;
- (v) as far as available, the place of publication (where only the location of the publisher appears on the book or other separately issued publication, then that location shall be indicated as the place of publication); and
- (vi) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

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

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

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

- (i) the title of the periodical or other serial publication;
- (ii) the number of the volume and the date of the issue in which the article appears;
- (iii) as far as available, the place of publication (where only the location of the publisher appears in the periodical or other serial publication, then that location shall be indicated as the place of publication);
- (iv) the author and the title of the article and the number of the page both on which the article starts and ends; and
- (v) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

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

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

(d) In the case of abstracts:

- (i) the identification of the document containing the abstract in the manner set forth in paragraphs (a), (b) and (c) respectively, depending upon whether the abstract is contained in a patent document, in a book or other separately issued publication, or in an article published in a periodical or other serial publication;
- (ii) in the case where the abstract is not published together with the full text document which served as its basis, the identification of both abstract and full text document on the basis of whatever bibliographic data may be available in respect thereto.

(The following example illustrates the citation of an abstract according to

paragraph (d) (ii) above:

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

**PCT Administrative Instructions Section 504**

**Classification of the Subject Matter of the International Application**

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

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

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

**PCT Administrative Instructions Section 505**

**Indication of Citations of Particular Relevance in the International Search Report**

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

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

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

**PCT Administrative Instructions Section 507**

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

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

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

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

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

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

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

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

— a document which may throw doubt on a priority claim,\*\*

— a document cited to establish the publication date of another cita-

tion\*\*\*

**PATENT COOPERATION TREATY  
INTERNATIONAL SEARCH REPORT**

<b>IDENTIFICATION OF INTERNATIONAL APPLICATION</b>		<b>Applicant's or Agent's File Reference <sup>18</sup></b> CMC-123
<b>International Application No. <sup>2</sup></b> PCT/US87/88888	<b>International Filing Date <sup>1</sup></b> 06 July 1987 (06.07.87)	
<b>Receiving Office <sup>3</sup></b> RO/US	<b>Priority Date Claimed <sup>4</sup></b> 15 July 1986 (15.07.86)	
<b>Applicant <sup>5</sup></b> Columbia Marine Corporation		
I. <input type="checkbox"/> <b>CERTAIN CLAIMS WERE FOUND UNSEARCHABLE <sup>10</sup></b> (Observations on supplemental sheet (2))		
II. <input checked="" type="checkbox"/> <b>UNITY OF INVENTION IS LACKING <sup>11</sup></b> (Observations on supplemental sheet (2))		
<b>III. TITLE, ABSTRACT AND FIGURE OF DRAWING</b>		
1. The following indicated items are approved as submitted by the applicant: <sup>6</sup>		
<input checked="" type="checkbox"/> Title. <input type="checkbox"/> Abstract.		
2. The tests established by this International Searching Authority of the following indicated items are set forth below:		
<input type="checkbox"/> Title. <input checked="" type="checkbox"/> Abstract.		
<p style="text-align: center;">A wind vane steering gear (10) for a sailboat (1) comprising a bracket (11) adapted for attachment to the bow of the sailboat for pivotally supporting a forward rudder (12), and a wind vane (42) adjustable to different positions by means of an actuating member (65) to control the position of the rudder.</p>		
<input type="checkbox"/> Text of the abstract continued on supplemental sheet (1)		
3. a. <input type="checkbox"/> The definite contents of the abstract are established by this International Searching Authority as proposed in form PCT/ISA/204 previously sent to the applicant.		
b. <input type="checkbox"/> This report is incomplete as far as the abstract is concerned as the time limit for comments by the applicant on the draft prepared by this International Searching Authority has not expired. <sup>7</sup>		
4. Figure to be published with the abstract <sup>8</sup>		
<input checked="" type="checkbox"/> Figure No. <u>1</u> <input type="checkbox"/> None of the figures.		
<input type="checkbox"/> because the applicant failed to suggest a figure		
<input type="checkbox"/> because this figure better characterizes the invention. <sup>9</sup>		

Form PCT/ISA/210 (first sheet) (May 1986)

See notes on accompanying sheet

International Application No. PCT/US87/888888

FURTHER INFORMATION CONTINUED FROM THE SECOND SHEET

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V.  OBSERVATIONS WHERE CERTAIN CLAIMS WERE FOUND UNSEARCHABLE <sup>10</sup>

This international search report has not been established in respect of certain claims under Article 17(2) (a) for the following reasons:

- 1.  Claim numbers . . . . . because they relate to subject matter <sup>12</sup> not required to be searched by this Authority, namely:
  
- 2.  Claim numbers. . . . . 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 <sup>13</sup>, specifically:

VI.  OBSERVATIONS WHERE UNITY OF INVENTION IS LACKING <sup>11</sup>

This International Searching Authority found multiple inventions in this International application as follows:

- I. Claims 1-5 drawn to a sailboat self-steering gear.
- II. Claims 6-8 drawn to a compass with an alarm to indicate deviation from a planned course.

- 1.  As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims of the international application.
- 2.  As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims of the international application for which fees were paid, specifically claims:
  
- 3.  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 claim numbers:
  
- 4.  As all searchable claims could be searched without effort justifying an additional fee, the International Searching Authority did not invite payment of any additional fee.

Remark on Protest

- The additional search fees were accompanied by applicant's protest.
- No protest accompanied the payment of additional search fees.

## INTERNATIONAL SEARCH REPORT

International Application No PCT/US87/88888

<b>I. CLASSIFICATION OF SUBJECT MATTER</b> (if several classification symbols apply, indicate all) <sup>3</sup>		
According to International Patent Classification (IPC) or to both National Classification and IPC		
IPC <sup>4</sup> B63H 25/02 // B63H 25/04		
U.S. Cl. 114/144C		
<b>II. FIELDS SEARCHED</b>		
Minimum Documentation Searched <sup>4</sup>		
Classification System	Classification Symbols	
U.S. Cl.	144/144C, 144R, 39	
Documentation Searched other than Minimum Documentation to the Extent that such Documents are Included in the Fields Searched <sup>5</sup>		
<b>III. DOCUMENTS CONSIDERED TO BE RELEVANT</b> <sup>14</sup>		
Category <sup>6</sup>	Citation of Document, <sup>14</sup> with indication, where appropriate, of the relevant passages <sup>17</sup>	Relevant to Claim No. <sup>18</sup>
Y	GB,A 392,415 IVERSON 18 May 1933 (18.05.33) (Note page 2, lines 4-9 for vane)	1 - 5
Y	WO,A WO83/01934 DAW 09 June 1983 (09.06.83) (Note forward rudder in Figure 5)	1 - 3
A	Engineering, Vol. 216, no. 5465, 26 February 1971, Eric Twiname, "Auto-helmsmen for yachts" pages 823 and 824.	4
A	JP,A 60-166,591 MITSUBISHI, 29 August 1985 (29.08.85)	6 - 8
<p><sup>3</sup> Special categories of cited documents: <sup>13</sup></p> <p>"A" document defining the general state of the art which is not considered to be of particular relevance</p> <p>"E" earlier document but published on or after the international filing date</p> <p>"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)</p> <p>"O" document referring to an oral disclosure, use, exhibition or other means</p> <p>"P" document published prior to the international filing date but later than the priority date claimed</p> <p>"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</p> <p>"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step</p> <p>"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.</p> <p>"Δ" document member of the same patent family</p>		
<b>IV. CERTIFICATION</b>		
Date of the Actual Completion of the International Search <sup>1</sup>		Date of Mailing of this International Search Report <sup>4</sup>
14 October 1987 (14.10.87)		
International Searching Authority <sup>1</sup>		Signature of Authorized Officer <sup>10</sup>
ISA/US		<i>Stephen Decatur</i> Stephen Decatur

Form PCT/ISA/210 (second sheet) (May 1986)

See notes on accompanying sheet

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

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

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

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

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

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

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

**PCT Administrative Instruction Section 508  
Manner of Indicating the Claims to which the Documents Cited  
in the International Search Report Are Relevant**

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

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

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

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

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

**CONTENTS OF THE INTERNATIONAL SEARCH  
REPORT**

The international search report (PCT Rule 43) contains, among other things, the citations of the documents 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. The international search report form, PCT/ISA/210 appears in MPEP § 1865. It is important to note that an international search report must not contain any expression of opinion, reasoning, argument or explanation of any kind

whatsoever relating to patentability.

**TRANSMITTAL OF THE INTERNATIONAL SEARCH  
REPORT**

The United States International Searching Authority transmits, on the same day, a copy of the international search report or, where no search report is established, the declaration to that effect, to the applicant and the International Bureau (PCT Article 18(2) and PCT Rule 44.1). The International Bureau uses the search report for publication and communication to the designated Offices.

**TITLE OF THE INVENTION OR ABSTRACT MISSING  
OR DEFECTIVE**

If the title of the invention or the abstract are missing or defective, the International Searching Authority will establish a proper title or abstract. When the International Searching Authority finds that the abstract is defective, it will prepare a new abstract and allow the applicant 30 days to comment. For further details, see PCT Rules 37, 38, and 44.2

**1865 Time Limit for Establishing the  
International Search Report [R-2]**

**PCT Rule 42**

**Time Limit for International Search**

**42.1 Time Limit for International Search**

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be 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.

The international search report must be established within three months from the receipt of the search copy by the International Searching Authority, or within nine months from the priority date (for the definition of "priority date", see PCT Article 2(xi)), whichever time limit expires later (PCT Article 18(1) and PCT Rule 42).

**1867 Refund of International Search Fee**

**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, will be refunded.

(b) [Reserved]

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Commissioner or the Commissioner'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 (PCT Rules 15.6 and 16.2).

Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Commissioner of Patents and Trademarks or his designee acting under Rule 40.2(c).

## 1868 Unity of Invention before the International Searching Authority [R-5]

### 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.

##### 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.

#### PCT Administrative Instructions Section 502 Protest Against Payment of Additional Fee and Decision Thereon

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

#### 37 CFR 1.476\* Determination of unity of invention before the international searching authority.

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in PCT Rule 13 >(see §1.475(f) and §1.475.<

(b) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it shall inform the applicant accordingly and invite the payment of additional fees (note §1.445 and PCT Art. 17(3)(a) and PCT Rule 40). The applicant will be given a time period in accordance with PCT Rule 40.3 to pay the additional fees due.

(c) In the case of non-compliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned ("main invention") in the claims.

(d) 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 Searching Authority may raise the objection of lack of unity of invention.

#### 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 Commissioner or the Commissioner'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 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 13.1, and 37 CFR 1.481). The construction of this principle is laid down in PCT Rule 13.2, 13.3, and 13.4. 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 Company 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 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 set forth in the Manual of Patent Examining Procedure (MPEP) § 806.05(e).

Therefore, when the Patent and Trademark 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 is made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT. No change in practice is being made in regard to claims of the same category of invention either in PCT international applications or in U.S. national applications.

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 any one of PCT Rule 13.2(i) to (ii).

The examiner should also permit in the same international or national stage application the following two combinations:

(1) An independent claim for a given product and an independent claim for a process specially adapted for the manufacture of said product.

(2) An independent claim for a given product and an independent claim for a process of using the said product.

If an application contains a combination of categories of the claims which do not fall within one of the combinations of PCT Rule 13.2(i) to (iii) or additional combinations (1) or (2) above, i.e., they claim more or less categories of invention than permitted in any one of PCT Rule 13.2(i) to (iii) or combination (1) or (2) above, unity of invention may not be present.

Further, an independent claim for a use in PCT Rule 13.2(i) and combination (2) above will be construed as being limited to a claim directed to a process of using. In determining unity of invention under PCT Rule 13.2(i) and (iii) and combination (1) above, under the rules, the examiner should consider the word "specially" which appears before "adapted" to be an emphasis word rather than a limitation. In determining unity of invention under PCT Rule 13.2(ii), the examiner should consider the word "specifically" which appears before "designated" to be an emphasis word rather than a limitation.

If an application includes claims to all the categories of invention set forth in any one of PCT Rule 13.2(i), (ii), (iii), combinations (1) or (2) above and no additional categories of invention are present, unity of invention may exist and no additional fees should be required or restriction requirement made, subject to the following guidelines.

For example, if an application contained claims to only a process for the manufacture of a product and claims to a use of a product and no product claim is present, there will be lack of unity of invention since the provisions of Rule 13.2(i) do not apply because claims to all categories of invention set forth in PCT Rule 13.2(i) are not included in the application and the process for manufacture of a product is independent of the use of the product since neither is dependent on the other. Also, if claims to all three categories of PCT Rule 13.2(i) were present at the time of the first Office action in a national stage application and all the product claims are rejected in the first Office action, a requirement for restriction could also be made, if appropriate, in view of independent inventions being in the application without an allowable linking (product) claim.

Where claims to a category of invention in addition to those listed in any one of PCT Rule 13.2(i), (ii), (iii) or combinations (1) or (2) above are included in an application, unity of invention may be lacking between the claims drawn to the combination of the categories of invention set forth in any one of PCT Rule 13.2(i), (ii), (iii) or combinations (1) or (2) above, and the claims to the additional category of invention. For example, if an application contains claims to a process for manufacture, claims to an apparatus or means for carrying out the process and claims to a process of using the product manufactured, there could be lack of unity of invention. In such a situation the examiner should group the claims to the process for manufacture and the claims for an apparatus or means for carrying out the process

because unity of these two categories exists under PCT Rule 13.2(i). The claims to the use of the product can be separately grouped if the "use" is shown to be "independent and distinct" of both the "process for manufacture" and the "apparatus or means for carrying out the process" as provided in Chapter 800 of the Manual of Patent Examining Procedure (MPEP).

When the claims presented to an application are directed to several categories of invention under the rules so that more than one paragraph of PCT Rule 13.2 and combinations (1) or (2) above applies, the examiner should inspect the claims to see if the categories of invention set forth in PCT Rule 13.2, paragraphs (i), (ii), and (iii), and then combinations (1) or (2) above are present in the application in that order. For example, if the categories of PCT Rule 13.2(i) are found in the application, the claims to those categories stated in PCT Rule 13.2(i) will be considered as one invention and any claims to different categories of invention will be reviewed to determine if they are "independent and distinct" of all the claims covered in PCT Rule 13.2(i) in accordance with the provisions of Chapter 800 of the MPEP.

Under PCT Rule 13.2 and combinations (1) and (2) above, unity of invention will exist where the claims are limited to one invention in each category of invention recited. For example, under PCT Rule 13.2(i), claims are permitted to one product, one process of manufacturing the product and one use of the product. If multiple products, processes of manufacture or uses are claimed, the first invention in the category first mentioned in the claims should be considered as the elected invention under the rules. The first recited invention of each additional category which is related to the first invention as indicated in the previous sentence will be considered elected. Accordingly, for example, if multiple products are claimed, the first recited product will be considered to be constructively elected and if multiple processes adapted for making and/or using the product are claimed, the first recited process will also be constructively elected. Any additional inventions of the same category will be subject to payment of additional fees during the international stage. In a national stage application submitted under 35 U.S.C. 371 any such holding by the examiner will be made in the form of a restriction requirement. Such a restriction requirement will be made on the basis of criteria set forth in MPEP Chapter 800. Applicant will have the right to traverse such a restriction requirement in the response to the Office Action.

Inventions of different categories, to have unity of invention, must be related rather than independent inventions. For example, the product as claimed in PCT Rule 13.2(i) and combinations (1) and (2) above must be capable of being made by the claimed process for manufacture or being used in the claimed process of use. Likewise in PCT Rule 13.2(ii), the apparatus as claimed must be capable of carrying out the claimed process. In PCT Rule 13.2(iii), the claimed process of manufacture must be capable of preparing the claimed product and the claimed apparatus or means must be able to perform the claimed process of manufacture.<

#### LACK OF UNITY OF INVENTION

The search fee which the applicant is required to pay is intended to compensate the International Searching Authority for carrying out an international search on the international application, 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 invited to pay additional search fees. The International Searching Authority will specify the reasons for its findings and indicate the number of additional fees to be paid (PCT Rules 40.1, 40.2(a) and (b)). 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 amount of the additional search fee per additional invention charged by the U.S. International Searching Authority is \$140.00 per invention (37 CFR 1.445(a)(3)). The additional search fee charged by the European Patent Office as an International Searching Authority is >2,095<\* Deutsche Marks, payable directly to the European Patent Office.

The International Searching Authority will establish the international search report 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 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.

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 (PCT Rule 40.2(c)). Any such protest filed with the U.S. International Searching Authority will be examined and decided by the Group Director (37 CFR 1.482(b)). To the extent that the 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 1.482(c)).

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. Nevertheless, the U.S. national law provides that such unsearched parts of the international application will be considered by the United States as a designated Office.

## 1870 Administrative Instructions Annexes

### [R-2]

#### ANNEX B

##### Code for identifying states and organizations

AE	United Arab Emirates
AF	Afghanistan
AG	Antigua and Barbuda
AL	Albania
AO	Angola
AR	Argentina
AT	Austria
AU	Australia
BB	Barbados
BD	Bangladesh
BE	Belgium
BG	Bulgaria
BH	Bahrain
BI	Burundi
BJ	Benin (Dahomey)
BN	Brunei
BO	Bolivia
BR	Brazil
BS	Bahamas
BT	Bhutan
BU	Burma
BW	Botswana
BY	Byelorussian SSR
BZ	Belize
CA	Canada
CF	Central African Republic
CG	Congo
CH	Switzerland
CI	Ivory Coast
CL	Chile
CM	Cameroon
CN	China
CO	Columbia
CR	Costa Rica
CS	Czechoslovakia
CU	Cuba
CV	Cape Verde
CY	Cyprus
DD	German Democratic Republic (East Germany)
DE	Germany, Federal Republic of (West Germany)
DJ	Djibouti
DK	Denmark
DM	Dominica
DO	Dominican Republic
DZ	Algeria
EC	Ecuador
EG	Egypt
ES	Spain
ET	Ethiopia
FI	Finland
FJ	Fiji
FR	France
GA	Gabon
GB	United Kingdom
GD	Grenada
GH	Ghana
GM	Gambia
GN	Guinea
GQ	Equatorial Guinea
GR	Greece
GT	Guatemala
GW	Guine a-Bissau
GY	Guyana

HN	Honduras	SN	Senegal
HT	Haiti	SO	Somalia
HU	Hungary	SR	Suriname
HV	Burkina Faso (Upper Volta)	ST	Sao Tome and Principe
ID	Indonesia	SU	Soviet Union
IE	Ireland	SV	El Salvador
IL	Israel	SY	Syria
IN	India	SZ	Swaziland
IQ	Iraq	TD	Chad
IR	Iran (Islamic Republic of)	TG	Togo
IS	Iceland	TH	Thailand
IT	Italy	TN	Tunisia
JM	Jamaica	TO	Turkey
JO	Jordan	TR	Turkey
JP	Japan	TT	Trinidad and Tobago
KE	Kenya	TZ	Tanzania
KH	Democratic Kampuchea	UA	Ukrainian SSR
KM	Comoros	UG	Uganda
KN	Saint Christopher and Nevis	US	United States of America
KP	Democratic People's Republic of Korea (North Korea)	UY	Uruguay
KR	Korea, Republic of (South Korea)	VA	Holy See
KW	Kuwait	VC	Saint Vincent and the Grenadines
LA	Laos	VE	Venezuela
LB	Lebanon	VN	Viet Nam
LC	Saint Lucia	VU	Vanuatu
LI	Liechtenstein	WS	Samoa
LK	Sri Lanka	YD	Democratic Yeman
LR	Liberia	YE	Yemen
LS	Lesotho	YU	Yugoslavia
LU	Luxembourg	ZA	South Africa
LY	Libya	ZM	Zambia
MA	Morocco	ZR	Zaire
MC	Monaco	ZW	Zimbabwe
MG	Madagascar	AP	Industrial Property Organization for Africa (ARIPO)
MN	Mongolia	EP	European Patent Office (EPO)
MR	Mauritania	OA	African Intellectual Property Organization (OAPI)
MT	Malta	WO	International Bureau of WIPO
MU	Mauritius		
MV	Maldives		
MW	Malawi		
MX	Mexico		
MY	Malaysia		
MZ	Mozambique		
NE	Niger		
NG	Nigeria		
NI	Nicaragua		
NL	Netherlands		
NO	Norway		
NP	Nepal		
NR	Nauru		
NZ	New Zealand		
OM	Oman		
PA	Panama		
PE	Peru		
PG	Papua New Guinea		
PH	Philippines		
PK	Pakistan		
PL	Poland		
PT	Portugal		
PY	Paraguay		
QA	Qatar		
RO	Romania		
RW	Rwanda		
SA	Saudi Arabia		
SB	Solomon Islands		
SC	Seychelles		
SD	Sudan		
SE	Sweden		
SG	Singapore		
SL	Sierra Leone		
SM	San Marino		

ANNEX C  
STANDARD CODE FOR IDENTIFICATION OF DIFFERENT KINDS OF  
PATENT DOCUMENTS

Introduction

1. The recommendation provides for groups of letter codes in order to distinguish patent documents. The letter codes also facilitate the storage and retrieval of such documents.

2. If any Office wants to amplify the information contained in the letter code, this letter code may be optionally associated with a numerical code. The meaning of such numerical code should then be defined by each Patent Office availing itself of this option.

3. The code also provides for a letter for non-patent literature documents (N) and for documents to be restricted to the internal use of Patent Offices (X) (e.g., confidential documents, not to be disclosed outside the Office). See in this respect also SI.1 (ICIREPAT Manual pages 4.3.1.1 to 4.3.1.4).

Definitions

4. For the purposes of this recommendation, the expression "patent documents" includes patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, utility certificates of addition, plant patents and published applications therefor.

5. For the purposes of this recommendation, the term "entry in an official gazette" means at least one comprehensive announcement in an official gazette regarding the making available to the public of the complete text, claims (if any) and drawings (if any) of a patent document.

6. For the purposes of this recommendation, the terms "publication" and "published" and used in the sense of making available:

- (i) a patent document to the public for inspection or supplying a copy on request
- (ii) multiple copies of a patent document produced by printing or like process

**Explanation:** If, at a particular procedural stage, a copy of the document is first made available to the public for inspection or copying and is then, at the same procedural stage, made available in multiple copies produced by printing or like process, only a single publication is considered to have occurred. If, on the other hand, multiple reproduction results from a new procedural stage, this reproduction is considered to be a further publication of the document, even if the texts at the two stages are identical.

7. According to certain national patent laws or regulations, the same patent application may be published at various procedural stages. For the purposes of this recommendation, a publication level is defined as the level corresponding to a procedural stage at which normally a document is published under a given national patent law.

#### Recommendation

8. It is recommended that the code:

(a) be used for the recording of the "kind of document" in machine-readable data carriers, such as 80-column punched cards, magnetic tapes, aperture cards, etc.;

(b) be used in the first page of patent documents, preferably near the document number, if these have been published in the sense of paragraph 6;

(c) be used in entries in official gazettes or, if all entries in a section of the Gazette relate to the same kind of a document at the beginning of such a section;

(d) be used for the identification of patent documents cited in "Search Reports" and "Lists of References" in patent documents (IND Number 56).

#### 9. Code

The Code is subdivided into mutually exclusive groups of letters. The groups characterize patent documents and documents specified in paragraph 3. Groups 1-5 comprise one or several letters enabling identification of documents pertaining to different publication levels.

##### Group 1 Use for primary or major series of patent documents

- A First publication level
- B Second publication level
- C Third publication level

##### Group 2 Use for secondary series of patent documents

- E First publication level
- F Second publication level
- G Third publication level

Group 3 Use for further series of patent documents, as the special requirements of each Office may be

- H
- I

##### Group 4 Use for major special types of patent documents

- M Medicament patent documents
- P Plant patent documents
- S Design patent

Group 5 Use for utility model documents having a numbering series other than the documents of Group 1

- U First publications level
- Y Second publication level
- Z Third publication level

##### Group 6 Other (see paragraph 3)

- N Non-patent literature documents
- X Documents restricted to the internal use of Offices

10. It is understood that documents resulting from a patent application and being identified as the major series will fall under Group 1 (e.g. DT Offenlegungsschrift, Auslegungsschrift and Patentschrift). However, documents identified as a secondary series will fall under Group 2 (e.g., FR patent of addition under old law, US reissue). In exceptional cases of need for a further series, Group 3 is reserved for such purposes (e.g., US defensive publication). Group 4 applies only, at present, to special documents concerning the medicament patents published in France and the plant patents published in the United States of America. In any country publishing similar documents, Group 4 should then be used.

11. As indicated in paragraph 2, the above letter code may optionally be associated with a numerical code to amplify the information represented by the letter code. For this numerical code only digits 1 to 9 should be used. The significance of this code will be defined by any national Office applying such code and communicated to the International Bureau, which will publicize this information. The numerical code must always be interpreted in conjunction with the country code and the above letter code.

12. As an appendix to this recommendation a list of patent documents, past and currently published, and intended to be published in the future, divided in accordance with the code, is given.

## 1871 Administrative Instructions Appendixes

### APPENDIX I

#### LIST OF PATENT DOCUMENTS, PAST AND CURRENTLY PUBLISHED, AND INTENDED TO BE PUBLISHED IN THE FUTURE, DIVIDED IN ACCORDANCE WITH THIS CODE

CODE: A Patent Documents Numbered in Primary or Major Series— First Publication Level

#### EXAMPLES:

Austria	Patent Application published in the sense of paragraph 6(i)
Belgium	Brevet d'invention/Uitvindingsoctrooi
Belgium	Brevet de perfectionnement/Verbeteringsoctrooi
Bulgaria	Opisanie na izobretenie po patent
Canada	Patent
Cuba	Patent Application published in the sense of paragraph 6(i)
Czechoslovakia	Patent Application published in the sense of paragraph 6(i)
Czechoslovakia	Inventor's Certificate Application published in the sense of paragraph 6(i)
Denmark	Patent Application published in the sense of paragraph 6(i)
Egypt	Patent specification
Europat	Document published after 18 months
Finland	Patent Application published in the sense of paragraph 6(i)
France	Brevet d'invention (old law)
France	Brevet d'invention, premiere et unique publication
France	Certificat d'addition a un brevet d'invention, premiere et unique publication
France	Certificat d'utilite, premiere et unique publication
France	Certificat d'addition a un certificat d'utilite, et unique publication
France	Demande de brevet d'invention, premiere publication
France	Demande de certificat d'addition a un brevet d'invention, premiere publication
France	Demande de certificat d'utilite, premiere publication
France	Demande de certificat d'addition a un certificat d'utilite, premiere publication
German Democratic Republic	Patentschrift (Ausschlusspatent), granted in accordance with paragraph 5.1 of the Patent Amendment Act of the German Democratic Republic
German Democratic Republic	Patentschrift (Wirtschaftspatent), granted in accordance with paragraph 5.1 of the Patent Amendment Act of the German Democratic Republic
Germany, Federal Republic of	Offenlegungsschrift
Hungary	Patent Application published in the sense of paragraph 6(i)
India	Patent specification
Ireland	Patent specification
Italy	Brevetto per invenzione industriale
Japan	Kokai tokkyo koho
Luxembourg	Brevet d'invention
Luxembourg	Certificat d'addition a un brevet d'invention
Netherlands	Ter inzage gelegde octrooiaanvraag
Norway	Patent Application published in the sense of paragraph 6(i)
Pakistan	Patent specification
PCT	Pamphlet published after 18 months
Poland	Opis patentowy
Romania	Descrierea i nventiei
Soviet Union	Opisanie izobreteniya k patentu
Soviet Union	Opisanie izobreteniya k avtorskomu svidetelstvu
Spain	Patente de invencion
Sweden	Patent Application published in the sense of paragraph 6(i)
Switzerland	Auslegungsschrift/Memoire Expose/Esposito Memoriale (Patent Application published in the sense of paragraphs 6(i) and 6(ii) pertaining to the technical

fields for which search and examination as to novelty are made)

Switzerland Patentschrift/ Exposé d'invention/Esposed'invenzione (Patent published in the sense of paragraph 6(ii) and pertaining to the technical fields for which neither search nor examination as to novelty are made)

United Kingdom Patent specification  
 United States Patent  
 Yugoslavia Patentni spis

CODE: B Patent Documents Numbered in Primary or Major Series — Second Publication Level  
 Examples:

Australia Patent specification  
 Austria Patentschrift  
 Canada Reissue  
 Cuba Patente de invencion  
 Czechoslovakia Popis vynalezu k patentu  
 Czechoslovakia Popis vynalezu k autorskemu osvedceni  
 Denmark Fremlaeggelseskraft  
 Finland Kuulutusjulkais u — Utlaggningskraft  
 France Brevet d'invention, deuxieme publication del'invention  
 France Certificat d'addition a un brevet d' invention, deuxieme publication de l'invention  
 France Certificat d'utilite, deuxieme publication del'invention  
 France Certificat d'addition a un certificat d'utilite, deuxieme publication de l'invention  
 German Democratic Republic Patentschrift (Ausschliessungspatent), granted in accordance with paragraph 29 of the Patent Act of the German Democratic Republic  
 German Democratic Republic Patentschrift (Wirtschaftspatent), granted in accordance with paragraph 29 of the Patent Act of the German Democratic Republic  
 Germany, Federal Republic of Auslegeschrift  
 Hungary Szabadalmi leiras  
 Japan Tokkyo koho  
 Netherlands Openbaar gemaakte octrooiaanvrage  
 Norway Utegningskraft  
 Sweden Utlaggningskraft  
 Switzerland Patentschrift/Exposé d'invention/Esposed'invenzione (Patent published in the sense of paragraph 6(ii) and pertaining to the technical fields for which search and examination as to the novelty are made)

United Kingdom Amended Patent Specification

CODE: C Patent Documents Numbered in Primary or Major Series — Third Publication Level  
 Examples:

Denmark Patent  
 Finland Patentti — Patent  
 Germany, Federal Republic of Patentschrift  
 Netherlands Octrooi  
 Norway Patent  
 Sweden Patentskrift

CODE: E Patent Documents Numbered in Secondary Series — First Publication Level

Examples:  
 France Certificat d'addition a brevet d'invention (old law)  
 United States Reissue

CODE: H Patent Documents Numbered in Further Series

Example:  
 United States Defensive publication  
 Statutory Invention Registration

CODE: M Medicament Patent Documents

EXAMPLES:  
 France Brevet special de medicament  
 France Addition a un brevet special de medicament

CODE: P Plant Patent Documents

Example:  
 United States Plant patent

CODE: U Utility Model Documents Numbered in Series Other than the Documents of Group I — First Publication Level

Examples:  
 Germany, Federal Republic of Gebrauchsmuster  
 Japan Kokai jitsuyo shinan koho  
 Spain Utility Model Application published in the sense of paragraph 6(i)

CODE: Y Utility Model Documents Numbered in Series Other than the Documents of Group I — Second Publication Level

Examples:  
 Japan Jitsuyo shinan koho  
 Spain Model o de utilidad

## Appendix II

## List of Patent Documents, Past and Currently Published, broken down by issuing country and coded in accordance with the SI.8 Code

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Australia	Unexamined complete specification open to public inspection (not marked on document)		Unexamined Patent Application published in the sense of paragraph 6(i)	A	
	Patent specification		Patent published in the sense of paragraph 6(ii)	B	
Austria	Aufgebot (not marked on document but indicated as such in the Official Gazette)	Document laid open	Patent Application published in the sense of paragraph 6(i)	A	
	Patentschrift	Patent specification	Patent published in the sense of paragraph 6(ii)	B	
Belgium	Brevet d'invention/ Uitvindingsoctrooi	Patent of invention	Patent published in the sense of paragraph 6(ii)	A	
	Brevet de perfectionnement/ Verbeteringsoctrooi	Patent of improvement	Patent of improvement published in the sense of paragraph 6(ii)	A	
	Brevet d'importation/ Invoeringsoctrooi	Patent of importation	Patent of importation published in the sense of paragraph 6(ii)	A	
Bulgaria	ОПИСАНИЕ НА ИЗОБРЕТЕНИЕ ПО ПАТЕНТ (Opisanie na izobretenie po patent)	Description of invention for a patent	Patent published in the sense of paragraph 6(ii)	A	
	ОПИСАНИЕ НА ИЗОБРЕТЕНИЕ ПО АВТОРСКО СВИДЕТЕЛСТВО (Opisanie na izobretenie po avtorsko svidetelstvo)	Description of invention for an author's certificate	Inventor's certificate published in the sense of paragraph 6(ii)	A	
Canada	Patent/Brevet		Patent published in the sense of paragraph 6(ii)	A	
	Reissue Patent/Brevet de redélivrance		Patent reissued and republished in the sense of paragraph 6(ii)	B	
Cuba	Publicación de la solicitud (not marked on document)	Publication of the application	Patent application published in the sense of paragraph 6(i)	A	
	Patente de invención	Patent of invention	Patent published in the sense of paragraph 6(ii)	B	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Czechoslovakia	Přihláška vynálezu (se žádostí o autorské osvědčení)	Application for an invention asking for author's certificate	Application for inventor's certificate published in the sense of paragraph 6(i), in accordance with Law No. 84 of 01.11.1972	A	1
	Přihláška vynálezu (se žádostí o patent)	Application for an invention asking for a patent	Patent application published in the sense of paragraph 6(i), in accordance with Law No. No. 84 of 01.11.1972	A	2
	Patentová přihláška or Přihláška vynálezu	Patent application or Application for invention	Patent application published in the sense of paragraph 6(i) up to patent No. 149260 (granted before the entry into force of Law No. 84 of 01.11.1972)	A	5
	Popis vynálezu k autorskému osvědčení	Description of an invention for an author's certificate	Inventor's certificate published in the sense of paragraph 6(ii), granted in accordance with Law No. 84 of 01.11.1972	B	1
	Popis vynálezu k patentu	Description of an invention for a patent	Patent published in the sense of paragraph 6(ii), granted in accordance with Law No. 84 of 01.11.1972	B	2
	Popis vynálezu k autorskému osvědčení	Description of an invention for an author's certificate	Dependant author's certificate published in the sense of paragraph 6(ii), granted in accordance with Law No. 84 of 01.11.1972	B	3
	Popis vynálezu k patentu	Description of an invention for a patent	Dependent patent published in the sense of paragraph 6(ii), granted in accordance with Law No. 84 of 01.11.1972	B	4
	Patentový spis	Patent specification	Patent published in the sense of paragraph 6(ii), up to No. 149 260, granted before the entry into force of Law No. 84 of 01.11.1972	B	5
Denmark	Almindelig tilgængelig patentansøgning	Patent application accessible to the public	Patent application published in the sense of paragraph 6(i)	A	
	Fremlaeggelseskraft	Document laid open	Patent application published after examination as to novelty in the sense of paragraph 6(ii)	B	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Denmark (cont'd)	Patent	Patent	Patent published in the sense of paragraph 6(ii)	C	
Egypt	إدارة براءات الاختراع (Idarat bara'at alikhtirah)	Authority for Patent Delivery	Patent published in the sense of paragraph 6(ii)	A	
Finland	Julkiseksi tullut patenttihakemus (not marked on the document)	Patent application made accessible to the public	Patent application published in the sense of paragraph 6(i)	A	
	Kuulutusjulkaisu – Utläggningsskrift	Document laid open	Patent application published after examination as to novelty in the sense of paragraphs 6(i) and 6(ii)	B	
	Patentti-Patent	Patent	Patent published in the sense of paragraph 6(ii)	C	
France	Demande de brevet d'invention	Application for patent of invention	Patent application, first publication, published in the sense of paragraph 6(ii)	A	1
	Demande de certificat d'addition à un brevet d'invention	Application for a certificate of addition to a patent of invention	Application for a certificate of addition, first publication, published in the sense of paragraph 6(ii)	A	2
	Demande de certificat d'utilité	Application for certificate of utility	Utility certificate application, first publication, published in the sense of paragraph 6(ii)	A	3
	Demande de certificat d'addition à un certificat d'utilité	Application for a certificate of addition to a certificate of utility	Application for a certificate of addition to a utility certificate, first publication, published in the sense of paragraph 6(ii)	A	4
	Brevet d'invention	Patent of invention	Patent, first and only publication, published in the sense of paragraph 6(ii)	A	5
	Certificat d'addition à un brevet d'invention	Certificate of addition to a patent of invention	Certificate of addition to a patent, first and only publication, published in the sense of paragraph 6(ii)	A	6
	Certificat d'utilité	Certificate of utility	Utility certificate, first and only publication, published in the sense of paragraph 6(ii)	A	7

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
France (cont'd)	Certificat d'addition à un certificat d'utilité	Certificate of addition to a certificate of utility	Certificate of addition to a utility certificate, first and only publication, published in the sense of paragraph 6(ii)	A	8
	Brevet d'invention	Patent of invention	Patent, second publication, published in the sense of paragraph 6(ii)	B	1
	Certificat d'addition à un brevet d'invention	Certificate of addition to a patent of invention	Certificate of addition to a patent, second publication, published in the sense of paragraph 6(ii)	B	2
	Certificat d'utilité	Certificate of utility	Utility certificate, second publication, published in the sense of paragraph 6(ii)	B	3
	Certificat d'addition à un certificat d'utilité	Certificate of addition to a certificate of utility	Certificate of addition to a utility certificate, second publication, published in the sense of paragraph 6(ii)	B	4
	Brevet d'invention	Patent of invention	Patent (old law) published in the sense of paragraph 6(ii)	A	
	Certificat d'addition à un brevet d'invention	Certificate of addition to a patent of invention	Certificate of addition to a patent (old law) published in the sense of paragraph 6(ii)	E	
	Brevet spécial de médicament	Special patent for medicament	Medicament patent (old law) published in the sense of paragraph 6(ii)	M	
Certificat d'addition à un brevet spécial de médicament	Certificate of addition to a special patent for medicament	Certificate of addition to a medicament patent (old law) published in the sense of paragraph 6(ii)	M		
German Democratic Republic	Patentschrift (Ausschliessungspatent)	Patent specification (Exclusive Patent)	Exclusive patent, granted in accordance with paragraph 5.1 of the Patent Amendment Act of the German Democratic Republic, published in the sense of paragraph 6(ii)	A	
	Patentschrift (Wirtschaftspatent)	Patent specification (Economic Patent)	Industrial patent, granted in accordance with paragraph 5.1 of the Patent Amendment Act of the German Democratic Republic, published in the sense of paragraph 6(ii)	A	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
German Democratic Republic (cont'd)	Patentschrift (Ausschlusspatent)	Patent specification (Exclusive Patent)	Exclusive patent granted in accordance with paragraph 29 of the Patent Act of the German Democratic Republic, (2nd publication after examination as to novelty whenever this examination is effected), published in the sense of paragraph 6(ii)	B	
	Patentschrift (Wirtschaftspatent)	Patent specification (Economic Patent)	Industrial patent granted in accordance with paragraph 29 of the Patent Act of the German Democratic Republic (2nd publication after examination as to novelty whenever this examination is effected), published in the sense of paragraph 6(ii)	B	
	Berichtigte Patentschrift (Ausschlusspatent)	Corrected patent specification (Exclusive Patent)	Corrected patent (Exclusive patent) published in the sense of paragraph 6(ii)	C	
	Berichtigte Patentschrift (Wirtschaftspatent)	Corrected patent specification (Economic Patent)	Corrected patent (Industrial patent) published in the sense of paragraph 6(ii)	C	
Germany (Federal Republic of)	Offenlegungsschrift	Document open for inspection	Patent application published, before examination as to novelty, in the sense of paragraph 6(ii)	A	
			- 1st publication	A	1
			- 2nd publication. Modified reprint following A1 Offenlegungsschrift or B1 Auslegeschrift	A	2
				- 3rd publication. Modified reprint following A2 Offenlegungsschrift or B2 Auslegeschrift	A
Auslegeschrift	Document laid open	Patent application published, after examination as to novelty, in the sense of paragraph 6(ii)	B		
			- 1st publication. Offenlegungsschrift not yet published	B	1
			- 2nd publication. Normally following an A1 Offenlegungsschrift or B1 Auslegeschrift	B	2

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Germany (Federal Republic of) (cont'd)	Patentschrift	Patent specification	- 3rd publication. Following an A2 Offenlegungsschrift or B2 Auslegeschrift	B	3
			- 4th publication. Following an A3 Offenlegungsschrift or B3 Auslegeschrift	B	4
Patent published in the sense of paragraph 6(ii)			C		
- 1st publication. Offenlegungsschrift and Auslegeschrift not published			C	1	
- 2nd publication. Modified reprint normally following a B1 Auslegeschrift or C1 Patentschrift			C	2	
- 3rd publication. Normally following a B2 Auslegeschrift and an A1 Offenlegungsschrift or following a B2 Auslegeschrift with a preceding B1 Auslegeschrift as well			C	3	
Gebrauchsmuster	Utility model	- 4th publication. Following a B3 Auslegeschrift or C3 Patentschrift	C	4	
		- 5th publication. Following a B4 Auslegeschrift or a C4 Patentschrift	C	5	
Hungary	Közzétett szabadalmi bejelentés	Published patent application	Patent application published in the sense of paragraph 6(i)	A	
	Szabadalmi leírás	Patent specification	Patent published in the sense of paragraph 6(ii)	B	
India	Patent specification		Patent published in the sense of paragraph 6(ii)	A	
Ireland	Patent specification		Patent published in the sense of paragraph 6(ii)	A	
Italy	Brevetto per invenzione industriale	Patent for industrial invention	Patent published in the sense of paragraph 6(ii)	A	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Japan	公開特許公報 (Kôkai tokkyo kôhō)	Published unexamined patent application	Patent application published before examination as to novelty in the sense of paragraphs 6(i) and 6(ii).	A	
	特許公報 (Tokkyo kôhō)	Published examined patent application	Patent application published after examination as to novelty in the sense of paragraphs 6(i) and 6(ii). - 1st publication. A Kôkai tokkyo kôhō not published. "T" headed the numerical number of Tokkyo kôhō published from 1922 to 1926. - 2nd publication. Normally following an A Kôkai tokkyo kôhō.	B	1
	特許発明明細書 (Tokkyo hatsumei meisaisyō)	Patent specification	Patent (old law) published in the sense of paragraphs 6(i) and 6(ii). - 1st publication. Tokkyo kôhō not published. - 2nd publication. Normally following a B 1 Tokkyo kôhō.	C	1
	特許審判請求公告 (Tokkyo shinpan Seikyū kôkoku)	Corrected patent specification	Corrected patent published in the sense of paragraphs 6(i) and 6(ii).	H	
	意匠公報 (Isyō kôhō)	Registered design publication	Registered design application published after examination as to novelty in the sense of paragraphs 6(i) and 6(ii).	S	
	公開実用新案公報 (Kôkai jitsuyō shinan kôhō)	Published unexamined utility model application	Utility model application published before examination as to novelty in the sense of paragraphs 6(i) and 6(ii)	U	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Japan (cont'd)	実用新案公報 (Jitsuyō shinan kōhō)	Published examined utility model application	Utility model application published after examination as to novelty in the sense of paragraphs 6(i) and 6(ii) - 1st publication. U Kōkai jitsuyō shinan kōhō not published. "T" headed the numerical number of Jitsuyō shinan kōhō published from 1922 to 1926. - 2nd publication. Normally following a U Kōkai jitsuyō shinan kōhō.	Y	1
	登録実用新案 (Tōroku jitsuyō shinan)	Registered utility model specification	Registered utility model published in the sense of paragraphs 6(i) and 6(ii) - 1st publication Jitsuyō shinan kōhō not published - 2nd publication. Normally following a Y 1 Jitsuyō shinan kōhō.	Y	2
	登録実用新案審判請求公報 (Tōroku jitsuyō shinan shinpan seikyū kōkoku)	Corrected registered utility model specification	Corrected registered utility model published in the sense of paragraphs 6(i) and 6(ii).	Z	1
				Z	2
				I	
Luxembourg	Brevet d'invention	Patent of invention	Patent published in the sense of paragraph 6(ii)	A	
	Certificat d'addition à un brevet d'invention	Certificate of addition to a patent of invention	Certificate of addition to a patent published in the sense of paragraph 6(ii)	A	
Monaco	Brevet d'invention	Patent of invention	Patent published in the sense of paragraph 6(ii)	A	
Netherlands	Terinzagelegging	Patent application laid open	Patent application published in the sense of paragraphs 6(i) and 6(ii)	A	
	Openbaarmaking	Published patent application	Patent application published after examination in the sense of paragraphs 6(i) and 6(ii)	B	
	Octrooi	Patent	Patent published in the sense of paragraph 6(ii)	C	
Norway	Alment tilgjengelige patentsøknader (not marked on the document)	Patent application accessible to the public	Patent application published in the sense of paragraph 6(i)	A	
	Utlegningskrift	Document laid open	Patent application published after examination as to novelty in the sense of paragraph 6(ii)	B	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Norway (cont'd)	Patent	Patent	Patent published in the sense of paragraph 6(ii)	C	
Pakistan	Patent specification		Patent published in the sense of paragraph 6(ii)	A	
Poland			Patent application published in the sense of paragraph 6(i)	A	
	Opis patentowy Patentu tymczasowego	Description of patent	Patent published in the sense of paragraph 6(ii)	B	
Romania	Descrierea invenției	Description of the invention	Patent published in the sense of paragraph 6(ii)	A	
Soviet Union	ОПИСАНИЕ ИЗОБРЕТЕНИЯ К ПАТЕНТУ (Opisanie izobreteniya k patentu)	Description of the invention for a patent	Patent published in the sense of paragraph 6(ii)	A	
	ОПИСАНИЕ ИЗОБРЕТЕНИЯ К АВТОРСКОМУ СВИДЕТЕЛЬСТВУ (Opisanie izobreteniya k avtorskomu svidetelstvu)	Description of the invention for an author's certificate	Inventor's certificate published in the sense of paragraph 6(ii)	A	
Spain	Patente de invención	Patent of invention	Patent published in the sense of paragraph 6(i)	A	
	Patente de introducción	Patent of introduction	Patent of importation published in the sense of paragraph 6(i)	A	
	Certificado de adición	Certificate of addition	Certificate of addition published in the sense of paragraph 6(i)	A	
	Solicitud de Modelo de Utilidad	Application for a utility model	Utility Model Application published in the sense of paragraph 6(i)	U	
	Modelo de Utilidad	Utility Model	Utility Model published in the sense of paragraph 6(i)	Y	
Sweden	Allmänt tillgänglig patentansökan	Patent application accessible to the public	Patent Application published in the sense of paragraph 6(i)	A	
	Utläggningsskrift	Document laid open	Patent Application published after examination as to novelty in the sense of paragraphs 6(i) and 6(ii)	B	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
Sweden (cont'd)	Patentskrift	Patent document	Patent published in the sense of paragraph 6(ii)	C	
Switzerland	Auslegeschrift/Mémoire Exposé/Esposito Memoriale	Document laid open	Patent Application published after examination as to novelty in the sense of paragraphs 6(i) and 6(ii), and pertaining to the technical fields for which examination as to novelty is made, issued since 1959	A	4
	Patentschrift/Exposé d'invention/Esposito d'invenzione	Patent specification	Patent published in the sense of paragraph 6(ii) and pertaining to the technical fields for which no examination as to novelty is made, issued since 1959	A	5
	Patentschrift/Exposé d'invention/Esposito d'invenzione	Patent specification	Patent published in the sense of paragraph 6(ii) and pertaining to technical fields for which examination as to novelty is made, issued since 1959	B	5
	Patentschrift/Exposé d'invention/Esposito d'invenzione (Hauptpatent/Brevet principal/Brevetto principale)	Patent specification (Main patent)	Patent published in the sense of paragraph 6(ii), issued from 1888 to 1959	A	
	Patentschrift/Exposé d'invention/Esposito d'invenzione (Zusatzpatent/Brevet additionnel/Brevetto addizionale)	Patent specification (Additional patent)	Patent of addition published in the sense of paragraph 6(ii), issued from 1907 to 1959	A	
	Patentschrift/Exposé d'invention/Esposito d'invenzione (Zusatzpatent/Brevet additionnel/Brevetto addizionale)	Patent specification (Additional patent)	Patent of addition published in the sense of paragraph 6(ii) in secondary series from 1888 to 1907	E	
United Kingdom	Patent Specification		Examined Patent Application published in the sense of paragraph 6(ii). Grant of letters Patent usually occurs 3 months after publication.	A	

Issuing country	Kind of published patent document			Letter code	Associated numerical code (when defined)
	Designation in language of issuing country (and, if required, transliteration in Latin characters)	Translation into English (when needed)	Identification of document		
United Kingdom (cont'd)	Amended Patent Specification		Amended Specification of a Granted Patent published in the sense of paragraph 6(ii)	B	
United States	Patent		Patent published in the sense of paragraph 6(ii)	A	
	Design Patent			S	
	Reissue Patent		Patent reissued and republished in the sense of paragraph 6(ii)	E	
	Defensive Publication		Patent application published without examination or assertion as to novelty, in the sense of paragraph 6(i)	H	
	Defensive Publication		Patent document published in the sense of paragraph 5: Entry of an abstract of the application in the Official Gazette	H	
	Defensive Publication		Patent document published in the sense of paragraph 6(ii): Abstract of an application published in a discrete document form distinctively numbered in a numerical series unique to Defensive Publications	H	
	Plant Patent		Patent published in the sense of paragraph 6(ii)	P	
Yugoslavia			Accepted Patent Application published in the sense of paragraph 6(i)	A	
	Patentni spis	Patent specification	Patent published in the sense of paragraph 6(ii)	B	

**1872 International-Type Search [R-2]**

**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 1.21 Miscellaneous fees and charges**

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**(c) International-type search reports:**

For preparing an international type search report of an international type search made at the time of the first action on the merits in a national patent application..... \$28.00.

**37 CFR 1.104 Nature of examination; examiner's action.**

\*\*\*\*\*

(c) An international-type search will be made in all national applications filed on and after June 1, 1978.

(d) 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. See §1.21(e) for amount of fee for preparation of international-type search report.

NOTE: 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 (c) and (d)), be used in establishing an international search report on such international application. An international-type search is conducted on all U.S. national applications filed after June 1, 1978. Upon specific request, at the time of the examination of a U.S. national application and provided that the payment of a \$28.00 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.

**1873 Amendment Under PCT Article 19 [R-2]**

**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 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 the time limit if it reaches it before the technical preparations for international publication have been completed.

**46.2 [Deleted]**

**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 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**

(a) 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 sheet 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.

(b) and (c) [Deleted]

**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 Instructions 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 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 law of some designated Offices grants 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.

## 1875 International Bureau Procedures [R-2]

### PCT Rule 24

#### Receipt of the Record Copy by the International Bureau

##### 24.1 [Deleted]

##### 24.2 Notification of Receipt of the Record Copy

(a) Subject to the provisions of paragraph (b), the International Bureau shall promptly notify the applicant, the receiving Office, the International Searching Authority, and all designated Offices, of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date, the name of the applicant, and the name of the receiving Office, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain the list of the designated Offices which have been notified under this paragraph, and shall, in respect of each designated Office, indicate any applicable time limit under Article 22(3).

(b) If the record copy is received after the expiration of the time limit fixed in Rule 22.3, the International Bureau shall promptly notify the applicant, the receiving Office, and the International Searching Authority accordingly.

### PCT Rule 28

#### Defects Noted by the International Bureau

##### 28.1 Note on Certain Defects

(a) If, in the opinion of the International Bureau, the international application contains any of the defects referred to in Article 14(1)(a)(i), (ii), or (v), the International Bureau shall bring such defects to the attention of the receiving Office.

(b) The receiving Office shall, unless it disagrees with the said opinion, proceed as provided in Article 14(1)(b) and Rule 26.

## 1877 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 Rule 48

#### International Publication

##### 48.1 Form

(a) The international application shall be published in the form of a pamphlet.

(b) The particulars regarding the form of the pamphlet and the method of reproduction shall be governed by the Administrative Instructions.

##### 48.2 Contents

(a) The pamphlet shall contain:

(i) a standardized front page,

(ii) the description,

(iii) the claims,

(iv) the drawings, if any,

(v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a); the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet.

(vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4,

(vii) any request for rectification referred to in the third sentence of Rule 91.1(f).

(b) Subject to paragraph (c), the front page shall include:

(i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions,

(ii) a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies.

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first.

(c) Where a declaration under Article 17(2)(a) has issued, the front page shall conspicuously refer to that fact and need include neither a drawing nor an abstract.

(d) The figure or figures referred to in paragraph (b)(ii) shall be selected as provided in Rule 8.2. Reproduction of such figure or figures on the front page may be in a reduced form.

(e) If there is not enough room on the front page for the totality of the abstract referred to in paragraph (b)(iii), the said abstract shall appear on the back of the front page. The same shall apply to the translation of the abstract when such translation is required to be published under Rule 48.3(c).

(f) If the claims have been amended under Article 19, the publication shall contain either the full text of the claims both as filed and as amended or the full text of the claims as filed and specify the amendments. Any statement referred to in Article 19(1) shall be included as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4. The date of receipt of the amended claims by the International Bureau shall be indicated.

(g) If, at the time of completion of the technical preparations for international publication, the international search report is not yet available (for example, because of publication on the request of the applicant as provided in Articles 21(2)(b) and 64(3)(c)(i)), the pamphlet shall contain, in place of the international search report, an indication to the effect that the report was not available and that either the pamphlet (then also including the international search report) will be republished or the international search report (when it becomes available) will be separately published.

(h) If, at the time of the completion of the technical preparations for international publication, the time limit for amending the claims under Article 19 has not expired, the pamphlet shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after such amendments, either the pamphlet (containing the claims as amended) will be republished or a statement reflecting all the amendments will be published. In the latter case, at least the front page and the claims shall be republished and, if a statement under Article 19(1) has been filed, that statement shall be published as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4.

(i) The Administrative Instructions shall determine the cases in which the various alternative referred to in paragraphs (g) and (h) shall apply. Such determination shall depend on the volume and complexity of the amendments and/or the volume of the international applications and the cost factors.

#### 48.3 Languages

(a)\* If the international application is filed in English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed.

(b)\* If the international application is filed in a language other than English, French, German, Japanese, Russian or Spanish, that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

\* The words printed in italics will become applicable at the same time that the PCT will enter into force in respect of the country which, among the Spanish-speaking countries is the first to ratify or accede to the PCT.

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the

International Bureau.

#### 48.4 Earlier Publication on the Applicant's Request

(a) Where the applicant asks for publication under Articles 21(2)(b) and 64(3)(c)(i) and the international search report, or the declaration referred to in Article 17(2)(a), is not yet available for publication together with the international application, the International Bureau shall collect a special publication fee whose amount shall be fixed in the Administrative Instructions.

(b) Publication under Articles 21(2)(b) and 64(3)(c)(i) shall be effected by the International Bureau promptly after the applicant has asked for it and, where a special fee is due under paragraph (a), after receipt of such fee.

#### 48.5 Notification of National Publication

Where the publication of the international application by the International Bureau is governed by Article 64(3)(c)(ii), the national Office concerned shall, promptly after effecting the national publication referred to in the said provision, notify the International Bureau of the fact of such national publication.

#### 48.6 Announcing of Certain Facts

(a) If any notification under Rule 29.1(a)(ii) reaches the International Bureau at a time later than that at which it was able to prevent the international publication of the international application, the International Bureau shall promptly publish a notice in the Gazette reproducing the essence of such notification.

(b) [Deleted]

(c) If the international application or the designation of any designated State is withdrawn under Rule 32.1, or if the priority claim is withdrawn under Rule 32<sup>bis</sup>.1 after the technical preparations for international publication have been completed, this fact shall be published in the Gazette.

### PCT Rule 86 The Gazette

#### 86.1 Contents

The Gazette referred to in Article 55(4) shall contain:

(i) for each published international application, data specified by the Administrative Instructions taken from the front page of the pamphlet published under Rule 48, the drawing (if any) appearing on the said front page, and the abstract,

(ii) the schedule of all fees payable to the receiving Offices, the International Bureau, and the International Searching and Preliminary Examining Authorities,

(iii) notices the publication of which is required under the Treaty or these Regulations,

(iv) information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned,

(v) any other useful information prescribed by the Administrative Instructions, provided access to such information is not prohibited under the Treaty or these Regulations.

#### 86.2 Languages

(a) The Gazette shall be published in an English-language edition and a French-language edition. It shall also be published in editions in any other language, provided the cost of publication is assured through sales or subventions.

(b) The Assembly may order the publication of the Gazette in languages other than those referred to in paragraph (a).

#### 86.3 Frequency

(a) Subject to paragraph (b), the Gazette shall be published once a week.

(b) For a transitional period after the entry into force of the Treaty terminating upon a date fixed by the Assembly, the Gazette may be published at such times as the Director General considers appropriate having regard to the number of international applications and the amount of other material required to be published.

#### 86.4 Sale

(a) Subject to paragraph (b), the subscription and other sale prices of the Gazette shall be fixed in the Administrative Instructions.

(b) For a transitional period after the entry into force of the Treaty terminating upon a date fixed by the Assembly, the Gazette may be distributed on such terms as the Director General considers appropriate having regard to the number of international applications and the amount of other material published therein.

**86.5 Title**

The title of the Gazette shall be "Gazette of International Patent Applications," and "Gazette des Demandes internationales de brevets," respectively.

**86.6 Further Details**

Further details concerning the Gazette may be provided for in the Administrative Instructions.

**PCT Administrative Instructions Section 404****International Publication Number**

The International Bureau shall assign to each published international application an international publication number which shall be different from the international application number. The international publication number shall be used on the pamphlet and in the Gazette entry. It shall consist of the two-letter code "WO" followed by a two-digit designation of the last two numbers of the year of publication, a slant, and a serial number consisting of five digits (e.g., "WO78/1 2345").

**35 U.S.C. 374 Publication of international application: Effect.**

The publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.

**37 CFR 1.318 Notification of national publication of a patent based on an international application.**

The Office will notify the International Bureau when a patent is issued on an application filed under 35 U.S.C. 371, and there has been no previous international publication.

The publication of international applications currently occurs every other Thursday. Under Article 20 the International Bureau sends copies of published applications to each of the designated Offices on the day of publication. As a PCT member country, the U.S. Patent and Trademark Office also receives copies of all published International applications for inclusion in the examiner search files. Also a complete set of published International applications in numeric order by publication number is available on microfilm in the Scientific Library.

**1880 Withdrawal of International Application or Designations [R-2]****PCT Rule 32****Withdrawal of the International Application or of Designations****32.1 Withdrawals**

(a) The applicant may withdraw the international application prior to the expiration of 20 months from the priority date except as to any designated State in which national processing or examination has already started. He may withdraw the designation of any designated State prior to the date on which processing or examination may start in that State.

(b) Withdrawal of the designation of all designated States shall be treated as withdrawal of the international application.

(c) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau or to the receiving Office. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

(d) [Deleted]

(e) There shall be no international publication of the international application or of the designation, as the case may be, if the notice effecting withdrawal reaches the International Bureau before the technical preparations for publication have been completed.

**1885 Receipt of the International Application by the Designated Offices [R-2]****PCT Article 20****Communication to Designated Offices**

(1)(a) The international application, together with the international search report (including any indication referred to in Article 17(2)(b)) or the declaration referred to in Article 17(2)(a), shall be communicated to each designated

Office, as provided in the Regulations, unless the designated Office waives such requirement in its entirety or in part.

(b) The communication shall include the translation (as prescribed) of the said report or declaration.

(2) If the claims have been amended by virtue of Article 19(1), the communication shall either contain the full text of the claims both as filed and as amended or shall contain the full text of the claims as filed and specify the amendments, and shall include the statement, if any, referred to in Article 19(1).

(3) At the request of the designated Office or the applicant, the International Searching Authority shall send to the said Office or the applicant, respectively, copies of the documents cited in the international search report, as provided in the Regulations.

**PCT Rule 47****Communication to Designated Offices****47.1 Procedure**

(a) The communication provided for in Article 20 shall be effected by the International Bureau.

(b) Such communication shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication promptly to the designated Offices by the International Bureau, and the later shall notify the applicant accordingly.

(c) The International Bureau shall send a notice to the applicant indicating the designated Offices to which the communication has been effected and the date of such communication. Such notice shall be sent on the same day as the communication. Each designated Office shall be informed separately from the communication, about the sending and the date of mailing of the notice. The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice.

(d) Each designated Office shall, when it so requires, receive the international search reports and the declarations referred to in Article 17(2)(a) also in the translation referred to in Rule 45.1.

(e) Where any designated Office has waived the requirement provided under Article 20, the copies of the documents which otherwise would have been sent to that Office shall, at the request of that Office or the applicant, be sent to the applicant at the time of the notice referred to in paragraph (c).

**47.2 Copies**

(a) The copies required for communication shall be prepared by the International Bureau.

(b) They shall be in sheets of A4 size.

(c) Except to the extent that any designated Office notifies the International Bureau otherwise, copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.

**47.3 Languages**

The international application communicated under Article 20 shall be in the language in which it is published provided that if that language is different from the language in which it was filed it shall, on the request of the designated Office, be communicated in either or both of these languages.

**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 \*.

The International Bureau communicates a copy of the international application to each designated Office, except the United States Patent and Trademark Office where that Office is not only a designated Office but was also the Receiving Office (35 U.S.C. 371(a)). The copy is prepared by the International Bureau and it is accompanied by a copy of any amendments to the claims, and a copy of the international search report or the declaration by the International Searching Authority to the effect that no international search report will be established (PCT Article 20(1)(a) and (2) and PCT Rules 47.1(a) and 47.2). The International Bureau also sends a notice to the applicant (form PCT/IB/308) informing him or her of those Offices to which it has sent the copies and the date on which they were sent (PCT Rule 47.1(c)).

The International Bureau effects the said communication of the international application to the designated Offices promptly after publication.

The applicant may, if he or she so desires, transmit, or ask the International Bureau to transmit, at any time, a copy of the international application to any designated Office. Further details may be found in PCT Article 13 and PCT Rule 31. It is to be noted that any transmittal of this kind does not in the absence of an express request from the applicant, entitle the designated Office to start processing the international application in that Office. At the express request of the applicant, however, any designated Office may start processing or examining the international application earlier (PCT Article 23(2)).

### 1887 Entry into the National (or Regional) Phase Before the Designated Offices [R-2]

#### PCT Article 22

##### Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 20 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for that State not later than at the expiration of 20 months from the priority date.

(2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).

(3) Any national law may, for performing the acts referred to in paragraphs (1) or (2), fix time limits which expire later than the time limit provided for in those paragraphs.

#### PCT Article 23

##### Delaying of National Procedure

(1) No designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22.

(2) Notwithstanding the provisions of paragraph (1), any designated Office may, on the express request of the applicant, process or examine the international application at any time.

#### PCT Article 24

##### Possible Loss of Effect in Designated States

(1) Subject, in case (ii) below, to the provisions of Article 25, the effect of the international application provided for in Article 11(3) shall cease in any designated State with the same consequences as the withdrawal of any national application in that State:

(i) if the applicant withdraws his international application or the desig-

nation of that State;

(ii) if the international application is considered withdrawn by virtue of Articles 12(3), 14(1)(b), 14(3)(a), or 14(4), or if the designation of that State is considered withdrawn by virtue of Article 14(3)(b);

(iii) if the applicant fails to perform the acts referred to in Article 22 within the applicable time limit.

(2) Notwithstanding the provisions of paragraph (1), any designated Office may maintain the effect provided for in Article 11(3) even where such effect is not required to be maintained by virtue of Article 25(2).

#### PCT Article 26

##### Opportunity to Correct Before Designated Offices

No designated Office shall reject an international application on the grounds of non-compliance with the requirements of this Treaty and the Regulations without first giving the applicant the opportunity to correct the said application to the extent and according to the procedure provided by the national law for the same or comparable situations in respect of national applications.

#### PCT Article 27

##### National Requirements

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

(2) The provisions of paragraph (1) neither affect the application of the provisions of Article 7(2) nor preclude any national law from requiring, once the processing of the international application has started in the designated Office, the furnishing:

(i) when the applicant is a legal entity, of the name of an officer entitled to represent such legal entity.

(ii) of documents not part of the international application but which constitute proof of allegations or statements made in that application, including the confirmation of the international application by the signature of the applicant when that application, as filed, was signed by his representative or agent.

(3) Where the applicant, for the purposes of any designated State, is not qualified according to the national law of that State to file a national application because he is not the inventor, the international application may be rejected by the designated Office.

(4) Where the national law provides, in respect of the form or contents of national applications, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for by this Treaty and the Regulations in respect of international applications, the national Office, the courts and any other competent organs of or acting for the designated State may apply the former requirements, instead of the latter requirements, to international applications, except where the applicant insists that the requirements provided for by this Treaty and the Regulations be applied to his international application.

(5) Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.

(6) The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.

(7) Any receiving Office or, once the processing of the international application has started in the designated Office, that Office may apply the national law as far as it relates to any requirement that the applicant be represented by an agent having the right to represent applicants before the said Office and/or that the applicant have an address in the designated State for the purpose of receiving notifications.

(8) Nothing in this Treaty and the Regulations is intended to be construed as limiting the freedom of any Contracting State to apply measures deemed necessary for the preservation of its national security or to limit, for the protection of the general economic interests of that State, the right of its own residents or nationals to file international applications.

## PCT Article 28

**Amendment of the Claims, the Description, and the Drawings, before Designated Offices**

(1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each designated Office within the prescribed time limit. No designated Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired except with the express consent of the applicant.

(2) The amendments shall not go beyond the disclosure in the international application as filed unless the national law of the designated State permits them to go beyond the said disclosure.

(3) The amendments shall be in accordance with the national law of the designated State in all respects not provided for in this Treaty and the Regulations.

(4) Where the designated Office requires a translation of the international application, the amendments shall be in the language of the translation.

## PCT Rule 49

**Copy, Translation and Fee under Article 22**

## 49.1 Notification

(a) Any Contracting State requiring the furnishing of a translation or the payment of a national fee, or both, under Article 22, shall notify the International Bureau of:

(i) the languages from which and the language into which it requires translation,

(ii) the amount of the national fee.

(a<sup>bis</sup>) Any Contracting State not requiring the furnishing, under Article 22, by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau under Rule 47 has not taken place by the expiration of the time limit applicable under Article 22) shall notify the International Bureau accordingly.

(a<sup>ter</sup>) Any Contracting State which, pursuant to Article 24(2), maintains, if it is a designated State, the effect provided for in Article 11(3) even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under Article 22 shall notify the International Bureau accordingly.

(b) Any notification received by the International Bureau under paragraphs (a), (a<sup>bis</sup>) or (a<sup>ter</sup>) shall be promptly published by the International Bureau in the Gazette.

(c) If the requirements under paragraph (a) change later, such changes shall be notified by the Contracting State to the International Bureau and that Bureau shall promptly publish the notification in the Gazette. If the change means that translation is required into a language which, before the change, was not required, such change shall be effective only with respect to international applications filed later than two months after the publication of the notification in the Gazette. Otherwise, the effective date of any change shall be determined by the Contracting State.

## 49.2 Languages

The language into which translation may be required must be an official language of the designated Office. If there are several of such languages, no translation may be required if the international application is in one of them. If there are several official languages and a translation must be furnished, the applicant may choose any of those languages. Notwithstanding the foregoing provisions of this paragraph, if there are several official languages but the national law prescribes the use of one such language for foreigners, a translation into that language may be required.

49.3 Statements Under Article 19; Indications Under Rule 13<sup>ter</sup>.4

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13<sup>ter</sup>.4 shall, subject to Rule 49.5(c) and (h), be considered part of the international application.

## 49.4 Use of National Form

No applicant shall be required to use a national form when performing the acts referred to in Article 22.

## 49.5 Contents of and Physical Requirements for the Translation

(a) For the purposes of Article 22, the translation of the international application shall contain the description, the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b) and (c),

(i) contain the request,

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended, and

Rev. 5(11/1997) accompanied by a copy of the drawings.

(b) Any designated Office requiring the furnishing of a translation of the request shall furnish copies of the language of the translation free of charge to the applicants. The form and contents of the request form in the language of the translation shall not be different from those of the request under Rules 3 and 4; in particular, the request form in the language of the translation shall not ask for any information that is not in the request as filed. The use of the request form in the language of the translation shall be optional.

(c) Where the applicant did not furnish a translation of any statement made under Article 19(1), the designated Office may disregard such statement.

(d) If any drawing contains text matter, the translation of that text matter shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

(e) Any designated Office requiring under paragraph (a) the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under Article 22,

(i) invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation, or

(ii) disregard the said drawing if such invitation, on February 3, 1984 is not compatible with the national law applied by that Office and as long as it continues to be not compatible with that law.

(f) The expression "Fig." does not require translation into any language.

(g) Where any copy of the drawings or any drawing executed anew which has been furnished under paragraph (d) or (e) does not comply with the physical requirements referred to in Rule 11, the designated Office may invite the applicant to correct any defect within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(h) Where the applicant did not furnish a translation of any indication furnished under Rule 13<sup>ter</sup>.4, the designated Office shall invite the applicant to furnish such translation, if it deems it to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(i) Information on any requirement and practice of designated Offices under the second sentence of paragraph (a) shall be published by the International Bureau in the Gazette.

(j) No designated Office shall require that the translation of the international application comply with physical requirements other than those prescribed for the international application as filed.

## PCT Rule 50

**Faculty Under Article 22(3)**

## 50.1 Exercise of Faculty

(a) Any Contracting State allowing a time limit expiring later than the time limits provided for in Article 22(1) or (2) shall notify the International Bureau of the time limits so fixed.

(b) Any notification received by the International Bureau under paragraph (a) shall be promptly published by the International Bureau in the Gazette.

(c) Notifications concerning the shortening of the previously fixed time limit shall be effective in relation to international applications filed after the expiration of three months computed from the date on which the notification was published by the International Bureau.

(d) Notifications concerning the lengthening of the previously fixed time limit shall become effective upon publication by the International Bureau in the Gazette in respect of international applications pending at the time or filed after the date of such publication, or, if the Contracting State effecting the notification fixes some later date, as from the latter date.

## PCT Rule 52

**Amendment of the Claims, the Description, and the Drawings, before Designated Offices**

## 52.1 Time Limit

(a) In any designated State in which processing or examination starts without special request, the applicant shall if he so wishes, exercise the right under Article 28 within one month from the fulfillment of the requirements under Article 22, provided that, if the communication under Rule 47.1 has not been effected by the expiration of the time limit applicable under Article 22, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any other time if so permitted by the national law of the said State.

(b) In any designated State in which the national law provides that examination starts only on special request, the time limit within or the time at which the applicant may exercise the right under Article 28 shall be the same as

that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under paragraph (a).

In order that his application may be processed by the Office (national or regional) which grants (or refuses the grant of) a national (or regional) patent, the applicant must, subject to the exceptions stated in this paragraph, do the following things:

(i) The applicant must pay the national fee to each designated Office not later than at the expiration of 20 months from the priority date (PCT Article 22(1)), unless more time is allowed by the designated Office.

(ii) Depending on the language of the international application, the applicant may have to furnish a translation of the international application to the designated Office. The preparation of the translation is the applicant's responsibility. The translation must reach the designated Office not later than at the expiration of 20 months from the priority date (PCT Article 22(1) and 35 U.S.C. 371 (c)(2)). Where the applicant has amended the claims by filing amendments with the International Bureau, he will have to furnish the translation also of the original claims, and if he has filed a statement explaining the amendments, a translation of that statement into the same language as that into which the international application is translated must be attached to the translation of the international application (PCT Article 28(4) and PCT Rules 49.1(a)(i) and 49.2).

(iii) Where the International Bureau has not yet communicated a copy of the international application to the designated Office, the applicant must furnish a copy of the international application (that is, a copy in its original language) to the designated Office not later than at the expiration of 20 months from the priority date. The applicant will receive form PCT/IB/308 from the International Bureau indicating the date of mailing of the communications as well as the designated Offices to which the communication of copies was effected (PCT Rule 47.1(c)).

(iv) In respect of certain designated Offices, the applicant must furnish, if it is not already contained in the "Request" part of the international application, the name and certain other data concerning the inventor (PCT Articles 4 (1)(v) and 4(4)).

A summary of requirements for each of the designated Offices is contained in Vol. II of the PCT Applicant's Guide, published by the International Bureau and available to U.S. applicants from Pergamon International Information Corporation, 1340 Old Chain Bridge Road, McLean, Virginia 22101, Teleprinter address: 90-1811, Telephone (703) 442-0900.

#### AMENDMENT OF THE INTERNATIONAL APPLICATION IN THE "NATIONAL PHASE"

The applicant is permitted to amend the claims, the description and the drawings before the designated Offices. Any such amendments must be submitted within the given time limit, generally within one month of the payment of the national fees and the furnishing of a translation, if necessary (PCT Article 28 and PCT Rule 52). The amendments must not go beyond the disclosure in the international application as filed except where the law of the designated State permits them to go beyond the said disclosure. The amendments must be in accordance with the law of the designated State in all respects not provided for in

the PCT. The amendments must be presented in the language of the translation of the international application, if a translation was required.

#### 1889 Representation Before the Designated Office

Any designated Office may, once the processing of the international application has started in that Office, apply the national (regional) law as far as it relates to any requirement that the applicant be represented by an agent having the right to represent applicants before the said Office and/or that the applicant have an address in the designated State for the purpose of receiving notifications (PCT Article 27(7)).

#### 1890 Requirements To Enter National Stage in United States of America [R-2]

##### 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 prescribed under section 376(a)(4) of this part;

(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 Commissioner. 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 Commissioner 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 Commissioner 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 speci-

fication, 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.

**35 U.S.C. 372 National stage: Requirements and procedure.**

(a) All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent and Trademark Office.

(b) In case of international applications designating but not originating in, the United States - -

(1) the Commissioner may cause to be reexamined questions relating to form and contents of the application in accordance with the requirements of the treaty and the Regulations;

(2) the Commissioner may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations.

(3) the Commissioner may require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English.

**37 CFR 1.491 Entry into the national stage.**

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 periods set in §1.494 or §1.495.

**37 CFR 1.492 National stage fees.**

The following fees and charges for international applications entering the national stage under 35 U.S.C. 371 are established by the Commissioner under 35 U.S.C. 376:

(a) The basic national fee:

(1) Where an international preliminary examination fee as set forth in §1.482 has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§1.9(f)) .....\$150.00  
By other than a small entity .....\$300.00

(2) Where no international preliminary examination fee as set forth in §1.482 has been paid to the United States Patent and Trademark Office, but an international search fee as set forth in §1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

By a small entity (§1.9(f)) .....\$170.00  
By other than a small entity .....\$340.00

(3) Where no international preliminary examination fee as set forth in §1.482 has been paid and no international search fee as set forth in §1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§1.9(f)) .....\$225.00  
By other than a small entity .....\$450.00

(4) Where the international preliminary examination fee as set forth in §1.482 has been paid to the United States Patent and Trademark Office and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all the claims presented in the application entering the national stage (see §1.496(b)):

By a small entity (§1.9(f)) .....\$25.00  
By other than a small entity .....\$50.00

(b) In addition to the basic national fee, for filing or later presentation of each independent claim in excess of 3:

By a small entity (§1.9(f)) .....\$17.00  
By other than a small entity .....\$34.00

(c) In addition to the basic national fee, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that §1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

By a small entity (§1.9(f)) .....\$6.00  
By other than a small entity .....\$12.00

(d) In addition to the basic national fee, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§1.9(f)) .....\$55.00  
By other than a small entity .....\$110.00

(If the additional fees required by paragraphs (b), (c) and (d) are not paid on presentation of the claims for which the additional fees are due, they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Office in any notice of fee deficiency.)

(e) Surcharge for filing the basic national fee or oath or declaration later than 20 months from the priority date pursuant to §1.494(c) or later than 30 months from the priority date pursuant to §1.495(c):

By a small entity (§1.9(f)) .....\$55.00  
By other than a small entity .....\$110.00

(f) For filing an English translation of an international application later than 20 months after the priority date (§1.494(c)) or for filing an English translation of the international application or of any annexes to the international preliminary examination report later than 30 months after the priority date (§1.495(c) and (e)) .....\$26.00

(35 U.S.C. 6, 376)

**37 CFR 1.494 Entering the national stage in the United States of America as a Designated Office.**

(a) Where no Demand has been filed with an appropriate International Preliminary Examining Authority by the expiration of 19 months from the priority date (see §1.495), the applicant must fulfill the requirements of PCT Article 22 and 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. 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) The applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 20 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;

(2) a translation of the international application into the English language, if it was originally filed in another language;

(3) the basic national fee (see §1.492(a)); and

(4) an oath or declaration of the inventor (see §1.497).

(c) The applicant may furnish any required English translation of the international application, the basic national fee and the oath or declaration of the inventor after 20 months but not later than the expiration of 22 months from the priority date. 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 20 months after the priority date. The payment of the surcharge set forth in §1.492(e) is required for acceptance of the basic national fee or the oath or declaration of the inventor later than the expiration of 20 months after the priority date.

(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 20 months from the priority date. Amendments under PCT Article 19 which are not received by the

expiration of 20 months from the priority date will be considered to be cancelled.

(e) 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.

(f) 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.

(g) The time limits set out in paragraphs (b), (c) and (d) of this section may not be extended pursuant to §1.136 or otherwise.

(h) An international application becomes abandoned as to the United States 20 months from the priority date if a copy of the international application is not communicated to the Patent and Trademark Office prior to 20 months from the priority date where the United States has been designated but not elected prior to 19 months from the priority date. If a copy of the international application is communicated within 20 months to the Patent and Trademark Office, an international application will become abandoned as to the United States 22 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 22 months from the priority date.

### 37 CFR 1.495 Entering the national stage in the United States of America as an Elected Office

(a) Where a Demand has been filed with an appropriate International Preliminary Examining Authority and not withdrawn by the expiration of 19 months from the priority date, the applicant 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. International applications for which those requirements are timely fulfilled will enter the national stage and obtain a: examination as to the patentability of the invention in the United States of America.

(b) The applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 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;

(2) a translation of the international application into the English language, if it was originally filed in another language;

(3) the basic national fee (see §1.492(a)); and

(4) an oath or declaration of the inventor (see §1.497).

(c) The applicant may furnish any required English translation of the international application, the basic national fee and the oath or declaration of the inventor after 30 months but not later than the expiration of 32 months from the priority date. 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 30 months after the priority date. The payment of the surcharge set forth in §1.492(e) is required for acceptance of the basic national fee or the oath or declaration of the inventor later than the expiration of 30 months after the priority date.

(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 30 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 30 months from the priority date will be considered to be cancelled.

(e) A translation into English of any annexes to the international preliminary examination report, if the annexes were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Translations of the annexes which are not received by the expiration of 30 months from the priority date may be submitted within 32 months from the priority date accompanied by the processing fee set forth in §1.492(f). Translations of the annexes which are not timely received will be considered to be cancelled.

(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 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.

(g) The time limits set out in paragraphs (b), (c), (d) and (e) of this section may not be extended pursuant to §1.136 or otherwise.

(h) An international application becomes abandoned as to the United States 30 months from the priority date if a copy of the international application is not communicated to the Patent and Trademark Office prior to 30 months from the priority date and a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of 19 months from the priority date. If a copy of the international application is communicated within 30 months to the Patent and Trademark Office, an international application will become abandoned as to the United States 32 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 32 months from the priority date.

### 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.

### 37 CFR 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application, if the inventor, desires to enter the national stage under 35 U.S.C. 371 pursuant to §1.494 or §1.495, he or she must file an oath or declaration in accordance with §1.63.

(b) If the international application was made as provided in §1.422, 1.423 or 1.425, the applicant shall state his or her relationship to the inventor and, upon information and belief, the facts which the inventor is required by §1.63 to state.

The United States national stage commencement requirements are set forth in 35 U.S.C. 371 and 372. In order to retain the international filing date and enter the national stage in the United States, and unless the international application was filed in the United States Receiving Office or was already received from the International Bureau, the applicant, who must be the inventor for the United States (35 U.S.C. 373), must timely file in the Patent and Trademark Office (37 CFR 1.61) the following items:

(i) a copy of the international application and a English translation thereof, if necessary,

(ii) Amendments to the claims under PCT Article 19 which were made before the International Bureau, if any, and an English translation thereof, if necessary,

(iii) an oath or declaration of the inventor (37 CFR 1.70), and

(iv) the national filing fee (35 U.S.C. 376(4) and 37 CFR 1.402(a)). The applicant must submit a copy of the international application, if it has not been communicated by the International Bureau, not later than the expiration of 20 months from the priority date to avoid abandonment of the application (35 U.S.C. 371(d) and PCT Article 22). The filing fee and oath or declaration may be submitted between 20 and 22 months from the priority date if accompanied with the surcharge. If the filing fee, oath or declaration, and any required surcharge are not filed

by the expiration of 22 months from the priority date, the application is abandoned. If any required English translation of the international application is not filed within 20 months from the priority date, it must be filed within 22 months from the priority date along with the processing fee (37 CFR 1.492(f)) in order to prevent abandonment of the international application. At 20 months the applicant may also file copies of the prior art cited in the Search Report. After filing, the applicant has the right to amend the application before the designated Office within one month after entry into the national stage. The amendment may affect the description, claims and drawings, but may not add new matter. It should be noted that the time limit of 20 months from the priority date applies irrespective of whether the international search report is available.

Entry into the national stage may also occur earlier at the express request of the applicant under the provisions of 35 U.S.C. 371(f). In order that earlier entry into the national stage may take place, the applicable requirements of 35 U.S.C. 371(c) must be received by the United States Patent and Trademark Office. Requirements such as the Search Report and any amendments to the claims must be submitted promptly after they are made available, if not submitted with the other requirements of 35 U.S.C. 371(c).

#### EARLY PROCESSING OF APPLICATION AT THE U.S. NATIONAL STAGE

National stage processing in the United States Patent and Trademark Office will normally not begin until after the expiration of the applicable time limit under PCT Article 22 (35 U.S.C. 371(b)).

This is true even if the applicant fulfills the requirements of 35 U.S.C. 371(c), paragraphs (1), (2), and (4) to obtain an early prior art date under 35 U.S.C. 102(e) well before the expiration of the above mentioned time limit.

Applicants may, however, expressly request early processing at any time after the applicable requirements of 35 U.S.C. 371(c) have been complied with. If a proper express request for early processing is received, the international application will promptly be assigned a national serial number and be forwarded for examination.

#### PRIOR ART STATEMENT REQUIREMENT FOR UNITED STATES

If the United States of America is designated, an information disclosure statement under 37 CFR 1.97 and 1.98 should be filed at the time of entering the national stage (35 U.S.C. 371 (b) or (f)) or within three months thereafter. For purposes of 37 CFR 1.97(a) the date of entry into the national stage is considered to be "the time of filing the application".

#### UNITED STATES DRAWING REQUIREMENTS

When the nature of the subject matter of the invention admits of illustration by the drawing and the applicant has not furnished such a drawing, the Commissioner of Patents and Trademarks may require the submission of such a drawing within a time period of not less than two months from the sending of a notice to the applicant (35 U.S.C. 113 and 37 CFR 1.81 and 1.83). Accordingly, whenever filing international

applications which designate the United States, applicants may wish to routinely furnish a drawing with each application in which the subject matter "admits of illustration by a drawing" even though the drawing is not deemed necessary for the understanding of the invention.

#### 1892 Filing of Continuation or Continuation-in-part Application During Pendency of International Application Designating the United States [R- 2]

It is possible to file a U.S. national application under 35 U.S.C. 111 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 "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...". 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 "In 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..." (emphasis added). The filing of a continuation or continuation-in-part application of an international application may be useful to patent applicants where the oath or declaration required by 35 U.S.C. 371(c)(4) cannot be filed within 22 months from the priority date as required by 37 CFR 1.61(b). An applicant filing an application under 35 U.S.C. 111 may obtain additional time to file the oath or declaration under 37 CFR 1.53(d) and 1.136(a).

A Continuing application under 35 U.S.C. 365(c) and 120 must be filed before the abandonment or patenting of the prior application.

37 CFR 1.494 Entering the national stage in the United States of America as a Designated Office.

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(h) An international application becomes abandoned as to the United States 20 months from the priority date if a copy of the international application is not communicated to the Patent and Trademark Office prior to 20 months from the priority date where the United States has been designated but not elected prior to 19 months from the priority date. If a copy of the international application is communicated within 20 months to the Patent and Trademark Office, an international application will become abandoned as to the United States 22 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 22 months from the priority date.

**37 CFR 1.495 Entering the national stage in the United States of America as an Elected Office**

\*\*\*\*\*  
 (1) An international application becomes abandoned as to the United States 30 months from the priority date if a copy of the international application is not communicated to the Patent and Trademark Office prior to 30 months from the priority date and a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of 19 months from the priority date. If a copy of the international application is communicated within 30 months to the Patent and Trademark Office, an international application will become abandoned as to the United States 32 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 32 months from the priority date.

**1895 Review Under PCT Article 25 [R-2]**

**PCT Article 25**

**Review by Designated Offices**

(1)(a) Where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn, or where the International Bureau has made a finding under Article 12(3), the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to any of the designated Offices named by the applicant.

(b) Where the receiving Office has declared that the designation of any given State is considered withdrawn, the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to the national Office of such State.

(c) The request under subparagraphs (a) or (b) shall be presented within the prescribed time limit.

(2)(a) Subject to the provisions of subparagraph (b), each designated Office shall, provided that the national fee (if any) has been paid and the appropriate translation (as prescribed) has been furnished within the prescribed time limit, decide whether the refusal, declaration, or finding, referred to in paragraph (1) was justified under the provisions of this Treaty and the Regulations, and, if it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the International Bureau, it shall, as far as effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred.

(b) Where the record copy has reached the International Bureau after the expiration of the time limit prescribed under Article 12(3) on account of any error or omission on the part of the applicant, the provisions of subparagraph (a) shall apply only under the circumstances referred to in Article 48(2).

**35 U.S.C. 366 Withdrawal international application**

Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect after the date of withdrawal and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal. However, such withdrawn international application may serve as the basis for a claim of priority under section 365 (a) and (b) of this part, if it designated a country other than the United States.

**35 U.S.C. 367 Actions of other authorities: Review**

(a) Where a Receiving Office other than the Patent and Trademark Office has refused to accord an international filing date to an international application designating the United States or where it has held such application to be withdrawn either generally or as to the United States, the applicant may request review of the matter by the Commissioner, on compliance with the requirements of and within the time limits specified by the treaty and the Regulations. Such review may result in a determination that such application be considered as pending in the national stage.

(b) The review under subsection (a) of this section, subject to the same requirements and conditions, may also be requested in those instances where an international application designating the United States is considered withdrawn

due to a finding by the International Bureau under Article 12(3) of the treaty.

PCT Article 25 and 35 U.S.C. 367 provide for review by the United States Designated Office of decisions by another Receiving Office (1) refusing to grant a filing date or (2) withdrawing the international application or the designation of the United States of America.

**1896 Effect of U.S. Patent Issued on an International Application**

**PCT Article 46**

**Incorrect Translation of the International Application**

If, because of an incorrect translation of the international application, the scope of any patent granted on that application exceeds the scope of the international application in its original language, the competent authorities of the Contracting State concerned may accordingly and retroactively limit the scope of the patent, and declare it null and void to the extent that its scope has exceeded the scope of the international application in its original language.

**35 U.S.C. 375 Patent Issued on International application: Effect**

(a) A patent may be issued by the Commissioner based on an international application designating the United States, in accordance with the provisions of this title. Subject to section 102(e) of this title, such patent shall have the force and effect of a patent issued on a national application filed under the provisions of chapter 11 of this title.

(b) Where due to an incorrect translation the scope of a patent granted on an international application designating the United States, which was not originally filed in the English language, exceeds the scope of the international application in its original language, a court of competent jurisdiction may retroactively limit the scope of the patent, by declaring it unenforceable to the extent that it exceeds the scope of the international application in its original language.

A patent issued on an international application has the same force and effect as a patent issued on a national application except that a court may retroactively limit the scope of a patent if it is too broad because of an incorrect translation, 35 U.S.C.375.

**1897 Filing and Prior Art Effect in United States of America [R-2]**

**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.

**37 CFR 1.53 Serial number, filing date, and completion of application.**

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(f) The filing date of an international application designating the United States of America shall be treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

The prior art effect under 35 U.S.C. 102(e) begins on the date the applicant has fulfilled the requirements of 35 U.S.C. 371(c)(1), (2) and (4). These requirements are that the national filing fee, a copy of the international application and a verified English translation thereof, if it was filed in another language, and an oath or declaration be filed in the United States Patent and Trademark Office. The international application also becomes prior art when it is published promptly after the expiration of 18 months from the priority date, or earlier at applicant's request.

## 1898.01 International Preliminary Examination [R-5]

### QUICK REFERENCE CHART

The following chart is designed to be a guide to patent examiners to direct them to those sections of this Manual which discuss the various operations for which the examiner is responsible.

The procedures required of the examiner are basically taken in the order presented.

#### 1. Unity of Invention [Form PCT/IPEA/405]

The examiner must determine whether or not unity of invention exists in the claims before the International Preliminary Examining Authority.

Time deadline - 7 days from the date the international application is charged to the Examining Group from PCT Central.

See §§ 1898.02(a) - (c).

Only those inventions that were previously searched by an International Searching Authority will be considered for International Preliminary Examination.

#### 2. Written Opinion [Form PCT/IPEA/408]

The Written Opinion is similar to a first Office Action in a national application in which the examiner sets forth his or her position as to each claim and offers the applicant an opportunity to respond.

**Defective claims** - this includes claims so defective that examination cannot be considered and claims drawn to subject matter which is not examined by the United States Patent and Trademark Office.

See § 1898.02(a).

**Examination as to novelty, Inventive Step and Industrial Applicability** - this is the focus of the examination and the Written Opinion. All claims which are not defective must be treated on the merits.

See §§ 1898.03(a)(1) - (4).

#### 3. Applicant's response to the Written Opinion

Any response must be made within the time limit set in the Written Opinion which is usually 2 months from the date of mailing the Written Opinion. The time limit cannot be extended. The response may include amendments to the specification, claims and drawings which do not include new matter.

#### 4. Interviews

The applicant, or the applicant's representative may hold an interview with the examiner during the time limit for response to the Written Opinion. All interviews must be made of record in the international application.

#### 5. International Preliminary Examination Report [Form PCT/IPEA/409]

Time limit - The completed International Preliminary Examination Report must be forwarded to PCT Central before the expiration of 27 months from the priority date of the interna-

tional application.

After receipt of applicant's response to the Written Opinion or the expiration of the time limit, the International Preliminary Examination Report should be prepared.

The matter of unity of invention may again be reviewed in view of any amendments filed.

See §§ 1898.04(a) and (c).

### 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:

1. 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,

2. 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 as described in PCT Article 33(2) - (4),

3. notices any defects in the form or contents of the international application,

4. considers that any amendment goes beyond the disclosure in the international application as originally filed, or

5. 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).

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 or her opinion (PCT Rule 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)) normally setting a two month time limit for the reply.

The applicant may respond 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 response received after the expiration of the time limit set for response to a Written Opinion will not be considered in preparing the International Preliminary Examination Report.

If the applicant does not respond to the Written Opinion within the set time period, the International Preliminary Examination Report will be prepared after expiration of the time limit and sufficient time to have any response clear the Mail Room.

If after initial examination of the international application, there is no negative statement or comment to be made, then only the International Preliminary Examination Report will be prepared without a Written Opinion having been issued.

**1898.01(a) Provisions of Agreement with the International Bureau to serve as an International Searching and Preliminary Examination Authority [R-5]**

A copy of the Agreement appears in MPEP §1804.

**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 Commissioner, 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) Collecting the handling fee for the International Bureau and the preliminary examination fee for the United States International Preliminary Examining Authority;

(3) Informing applicant of receipt of the Demand;

(4) Considering the matter of unity of invention;

(5) Providing an international preliminary examination report which is a non-binding opinion on the questions whether the claimed invention appears to be novel, to involve inventive step (to be non-obvious), and to be industrially applicable; and

(6) Transmitting the international preliminary examination report to applicant and the International Bureau.

An agreement has been concluded between the United States Patent and Trademark Office (USPTO) and the International Bureau under which the USPTO agrees 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 58.3, 59.1, 63.1, 72.1, 75.4, 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 Instruction § 103(c) are also relevant.

**1898.01(b) Preparation for filing of Demand [R-5]**

**37 CFR 1.480 Demand for international preliminary examination.**

(a) On the filing of a Demand and payment of the fees for international preliminary examination (§1.482), 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 at the time of filing of the Demand.

(b) The Demand shall be made on a standardized printed form. Copies of the printed Demand forms are available from the Patent and Trademark Office. Letters requesting printed forms should be marked "Box PCT".

(c) If the Demand is made prior to the expiration of the 19th month from the priority date and the United States of America is elected, the provisions of §1.495 shall apply rather than §1.494.

(d) Withdrawal of a proper Demand will not entitle applicant to a refund of the preliminary examination fee or handling fee.

The Demand should be filed on PCT Form PCT/IPEA/401 along with the fee calculation sheet. These forms may be obtained free of charge by requesting them by writing to the United States Patent and Trademark Office, Box PCT, Washington D.C. 20231 or by telephone by calling (703) 557-2003.

**1898.01(b)(1) Amendments filed with Demand [R-5]**

**PCT Rule 66**

**Procedure before the International Preliminary Examining Authority**

**66.8 Form of Amendments**

(a) 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 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.

(b) [Deleted]

**66.9 Language of Amendments**

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(a), shall be submitted in the language of publication.

**PCT Administrative Instructions Section 602  
Amendments under Rule 66.8(a)**

(a) The International Preliminary Examining Authority shall indelibly mark, so as to admit of direct reproduction in any of the manners set forth in Rule 11.2(a), in the upper right-hand corner of each replacement sheet submitted under Rule 66.8(a), the international application number and the date on which it was received and, in the middle of the bottom margin, the words "SUBSTITUTE SHEET" or their equivalent in the language of publication of the international application. It shall keep in its files any replaced sheet, the letter accompanying the replacement sheet or sheets, and any letter referred to in the last sentence of Rule 66.8(a)

(b) Section 311(b)(iii) shall apply when one or more sheets are added under Rule 66.8(a)

**37 CFR 1.485 Amendments by applicant during international preliminary examination.**

The applicant may make amendments at the time of filing of the Demand and within the time limit set by the International Preliminary Examining Authority for response to the written opinion. Any such amendments 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. If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter.

Amendments may be filed with the Demand if desired to place the application claims in better condition for international preliminary examination. Such amendments, however, may not include new matter and must be accompanied with a description of how the replacement sheet differs from the replaced sheet.

**1898.01(b)(2) Applicant's Right to file a Demand [R-5]****PCT Article 31****Demand for International Preliminary Examination**

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(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

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**PCT Rule 54****The Applicant Entitled to Make a Demand****54.1 Residence and Nationality**

The residence or nationality of the applicant shall, for the purposes of Article 31(2), be determined according to Rules 18.1 and 18.2.

**54.2 Several Applicants: Same for All Elected States**

If all the applicants are applicants for the purposes of all elected States, the rights to make a demand under Article 31(2) shall exist if at least one of them is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed as provided in Article 31(2)(a), or

(ii) a person entitled to make a demand under Article 31(2)(b) and the international application has been filed as provided in the decision of the Assembly.

**54.3 Several Applicants: Different for Different Elected States**

(a) For the purposes of different elected States, different applicants may be indicated, provided that, in respect of each elected State, at least one of the applicants indicated for the purposes of that State is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed as provided in Article 31(2)(a), or

(ii) a person entitled to make a demand under Article 31(2)(b) and the international application has been filed as provided in the decision of the Assembly.

(b) [Deleted]

**54.4 Applicant Not Entitled to Make a Demand or an Election**

(a) If the applicant does not have the right or, in the case of several applicants, if none of them has the right to make a demand under Article 31(2), the demand shall be considered not to have been submitted.

(b) If the requirement under Rule 54.3(a) is not fulfilled in respect of any elected State, the election of that State shall be considered not to have been made.

At least one applicant must be a resident or national of a state bound by Chapter II for each Elected State. If such is not the case the election of such a state will be considered as not having been made. If no applicant has the right to file a Demand, the Demand is considered as not having been submitted.

**1898.01(b)(3) States which may be Elected [R-5]****PCT Article 31****Demand for International Preliminary Examination**

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(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.

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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). At the present time all PCT member States except Denmark, Norway, Lichtenstein, Republic of Korea (South Korea), and Switzerland are members of Chapter II and may be elected.

**1898.01(b)(4) Agent's Right to Act [R-5]**

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, 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 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 Regulation governing the right to practice are Article 49 and Rule 83.

**1898.01(c) Filing of Demand [R-5]****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.

\*\*\*\*\*

CHAPTER II

PATENT COOPERATION TREATY  
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

<b>Box No. I IDENTIFICATION OF THE INTERNATIONAL APPLICATION</b>		Applicant's or Agent's File Reference (indicated by applicant if desired): <b>CMC-123</b>
International Application No. <b>PCT/US87/88888</b>	International Filing Date <b>06 July 1987 (06.07.87)</b>	(Earliest) Priority Date <b>15 July 1986 (15.07.86)</b>
Title of Invention <b>Self-Steering Gear for Sailboats</b>		
<b>Box No. II APPLICANT(S).</b> Further applicants are indicated on a continuation sheet <input type="checkbox"/>		
Name and address, including postal code and country: <b>Columbia Marine Corporation 100 Front Street Annapolis, Maryland 20726 United States of America</b>		
State of nationality: <b>US</b>	State of residence *: <b>US</b>	
Telephone number (including area code): <b>301-555-1122</b>	Telegraphic address:	Teleprinter address:
Name and address, including postal code and country: <b>Jones, John Paul 200 Shady Grove Road Davidsonville, Maryland 20720 United States of America</b>		
State of nationality: <b>US</b>	State of residence *: <b>US</b>	
<b>Box No. III AGENT OR COMMON REPRESENTATIVE (IF ANY); ADDRESS FOR NOTIFICATIONS (IN CERTAIN CASES)</b>		
The following named agent or common representative		
1. <input checked="" type="checkbox"/> has been appointed earlier and represents the applicant also for international preliminary examination		
2. <input type="checkbox"/> is hereby appointed and any earlier appointment of an agent is hereby revoked		
3. <input type="checkbox"/> is hereby appointed, in addition to the agent(s) appointed earlier, for the procedure before the International Preliminary Examining Authority		
Name and address, including postal code and country: <b>Adams, John Q. Adams, Baker and Charlie 1200 Marina Drive Baltimore, Maryland 20820 United States of America</b>		If the space below is used instead for an address for notifications, check here <input type="checkbox"/>
Telephone number (including area code): <b>301-577-7777</b>	Telegraphic address:	Teleprinter address:
* If the State of residence is not indicated, it will be assumed that it is the same as the State indicated in the address.		

Form PCT/IPEA/401 (first sheet) (July 1987)

See notes on accompanying sheet

OMB No. 0651-0021  
Expiration Date 12/89

**Box No. IV DECLARATION CONCERNING AMENDMENTS OF THE CLAIMS**

Applicant wishes international preliminary examination to start promptly on the basis of the claims

- as filed (amendments under Article 19 have not been made and will not be made)
- as amended under Article 19
- as specified on the attached sheet

**BOX No. V - ELECTION OF STATES**

The following designated States are hereby elected (please check the applicable boxes):

**Regional Patent**

- EP** European Patent: AT Austria, BE Belgium, DE Germany (Federal Republic of), FR France, GB United Kingdom, IT Italy, LU Luxembourg, NL Netherlands, SE Sweden, and any other Contracting State of the European Patent Convention which has become party to the PCT (including Chapter II thereof) or bound by Chapter II of the PCT after the issuance of this sheet (specify on dotted line):
- OA** OAPI Patent: Benin, Cameroon, Central African Republic, Chad, Congo, Gabon, Mali, Mauritania, Senegal, Togo, and any other member State of OAPI which has become party to the PCT (including Chapter II thereof) after the issuance of this sheet.

**National Patent**

- |  |   |
|--|---|
| <input type="checkbox"/> AT Austria                                  | <input type="checkbox"/> LK Sri Lanka                           |
| <input checked="" type="checkbox"/> AU Australia                     | <input type="checkbox"/> LU Luxembourg                          |
| <input type="checkbox"/> BB Barbados                                 | <input type="checkbox"/> MC Monaco                              |
| <input type="checkbox"/> BG Bulgaria                                 | <input type="checkbox"/> MG Madagascar                          |
| <input checked="" type="checkbox"/> BR Brazil                        | <input type="checkbox"/> MW Malawi                              |
| <input checked="" type="checkbox"/> DE Germany (Federal Republic of) | <input type="checkbox"/> NL Netherlands                         |
| <input checked="" type="checkbox"/> FI Finland                       | <input type="checkbox"/> RO Romania                             |
| <input type="checkbox"/> GB United Kingdom                           | <input type="checkbox"/> SD Sudan                               |
| <input type="checkbox"/> HU Hungary                                  | <input type="checkbox"/> SE Sweden                              |
| <input checked="" type="checkbox"/> JP Japan                         | <input type="checkbox"/> SU Soviet Union                        |
| <input type="checkbox"/> KP Democratic People's Republic of Korea    | <input checked="" type="checkbox"/> US United States of America |

Space reserved for electing States which have become party to the PCT (including Chapter II thereof) or bound by Chapter II of the PCT after the issuance of this sheet:

**Box No. VI SIGNATURE**

*John Adams*  
John Adams

(The following is to be filled in by the International Preliminary Examining Authority)

1. Date of actual receipt of DEMAND:
2. Adjusted date of receipt of DEMAND due to CORRECTIONS under Rule 60.1(b):

## NOTES TO THE DEMAND FORM (PCT/IPEA/401)

These Notes are intended to give some information concerning international preliminary examination under Chapter II of the PCT and to facilitate the filling in of the present form. For authentic information, see the text of the Patent Cooperation Treaty and the texts of the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and the said texts, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

"Article" refers to Articles of the Treaty, "Rule" refers to Rules of the Regulations and "Section" refers to Sections of the Administrative Instructions.

## IMPORTANT GENERAL INFORMATION

**Who May File a Demand (Article 31(2)(a))?** A demand (for international preliminary examination) may only be filed by an applicant who is a national or resident of a PCT Contracting State which is bound by Chapter II of the PCT; furthermore, the international application must have been filed with the receiving Office of, or acting for, such State. Where there are several applicants, at least one of them must qualify for the purposes of each elected State (Rule 54.3(a)).

**Where Must the Demand Be Filed (Article 31(6)(a))?** The demand must be filed with the International Preliminary Examining Authority (IPEA). The receiving Office with which the international application was filed will, upon request, give information about the competent IPEA (or see Annex C of the PCT Applicant's Guide, Volume I). If several IPEAs are competent, the applicant has the choice and the demand must be filed with (and the fees must be paid to) the IPEA chosen by the applicant.

**When Must the Demand be Filed (Article 39(1))?** The demand must be filed before the expiration of 19 months from the priority date in order to extend the time limit for entering the national phase of the PCT procedure from 20 to 30 months from the priority date. Warning: if the demand is filed later, the national phase will not be delayed in respect of the elected States and the applicant must enter the national phase before the expiration of the time limit applicable under Article 22 (which is usually 20 months from the priority date).

**In Which Language Must the Demand be Filed (Rule 55.1)?** The demand must be filed in the language of the international application if that language is English, French, German, Japanese or Russian; otherwise, the demand must be filed in English.

**What is the Language of Correspondence (Rules 66.9 and 92.2, Section 104)?** Any letter from the applicant to the IPEA must be in the same language as the international application to which it relates. However, the IPEA may authorize the use of another language for letters which do not contain or relate to amendments of the international application, whereas amendments and letters relating thereto must be in the language of publication. Any letter from the applicant to the International Bureau must be in the same language as the international application if that language is English or French; otherwise, it must be in English or French, at the choice of the applicant.

**Which Fees Must be Paid and When (Rules 57 and 58)?** At the time the demand is submitted, the applicant must pay

- (i) the preliminary examination fee, and
- (ii) the handling fee.

For details concerning the payment of those fees, see the Fee Calculation Sheet.

## NOTES TO BOX No. I

**Identification of the International Application (Rule 53.6):** The international application number must be indicated in Box No. I. Where the demand is filed at a time when the international application number has not yet been notified by the receiving Office, the name of that Office must be indicated instead of the international application number.

**International Filing Date and Priority Date (Section 110):** They must be indicated by the arabic number of the day, the name of the month and the arabic number of the year; after or below such indication, the date should be repeated in parenthesis by indicating it by two-digit arabic numerals each for the number of the day, for the number of the month and for the last two numbers of the year, e.g., 10 June 1986 (10.06.86). Where the international application claims the priority of several earlier applications, the filing date of the earliest application whose priority is claimed must be indicated as the priority date.

## NOTES TO BOX No. II

**Applicant(s) (Rule 53.4):** Make here the relevant indications as appearing in Boxes Nos. II and III of the REQUEST (Form PCT/RO/101). The Notes to the REQUEST apply *mutatis mutandis*.

If different applicants for different designated States are indicated in the REQUEST part of the international application, indicate only the names of the applicants for the States elected in Box No. V (no indication of the States for which a person is applicant must be made, because those indications have been made in the REQUEST). If there are more than two applicants, make the required indications on the "continuation sheet."

## NOTES TO BOX No. III

**Agent or Common Representative (Rule 53.5):** The first check-box must be marked where the applicant is already represented by an agent or where a common representative has been appointed. The second check-box must be marked where the applicant was not represented in the earlier stages of the PCT procedure and now wants to be represented by an agent before the IPEA, or where the applicant was represented in the earlier stages of the PCT procedure but wants to change the agent for the procedure before the IPEA. The third check-box must be marked where the applicant wants to be represented by an additional agent appointed only for the procedure before the IPEA without revocation of any earlier appointment; please note that in the latter case all notifications issued by the IPEA will be addressed only to that additional agent. Where the second or the third check-box is marked and the applicant does not sign himself the demand, a separate power of attorney must be filed with the International Bureau of WIPO or with the receiving Office (Rule 90.3(b)).

**Address for Notifications (Rule 4.4(d)):** If no agent has been appointed, a special address for the sending of notifications to the applicant may be indicated in Box No. III instead of the name and address of an agent. That address must be different from the address given in Box No. II and the special check-box must be marked. If an agent has been appointed, notifications will be sent to his address.

## NOTES TO BOX No. IV

**Declaration Concerning Amendments of the Claims (Rules 62.2, 66.1 and 69.1(b)):** Marking of the appropriate check-box is recommended, as it will help the IPEA to know immediately to which claims the international preliminary examination must be directed. International preliminary examination can only start once this is clear.

It is recalled that any amendment to the claims under Article 19 or any declaration that the applicant does not intend to file such amendments, are required to be filed with the International Bureau. That Bureau will promptly transmit any amendment or declaration to the IPEA. The international preliminary examination can start when the IPEA has received from the International Bureau such amendments or such declaration or a notice that no amendments have been filed in the prescribed time limit.

In case the demand for international preliminary examination has already been submitted, the applicant must, if he subsequently files amendments under Article 19 with the International Bureau, file at the same time a copy of such amendments with the IPEA.

The third of the three check-boxes relates to amendments under Rule 66.1. Those amendments must be filed with the IPEA.

## NOTES TO BOX No. V

**Election of States (Rule 53.7):** Only States which are bound by Chapter II of the PCT and which have been designated at the time of filing the international application (in the REQUEST) can be elected. The election is effected by marking the applicable check-box. The kind of protection or treatment desired follows the indication made in the REQUEST part of the international application. If a European patent is desired and only some of the Contracting States of the European Patent Convention have been designated for a European patent in the REQUEST part of the international application, the names of the other such States must be struck out. Switzerland and Liechtenstein are not bound by Chapter II and cannot be elected; however, if they have been designated in the REQUEST part of the international application for a European patent together with at least one other Contracting State of the European Patent Convention, the time limit under PCT Article 39(1) applies also with respect to those

two States if the other State has been elected before the expiration of 19 months from the priority date. Further States which are, at the time of publication of these Notes, not bound by Chapter II and cannot be elected are: Denmark, Norway and the Republic of Korea. Warning: if Japan is elected and the international application was filed in a language other than Japanese, a translation into Japanese of the international application must be furnished to the Japanese Patent Office within 20 months from the priority date.

## NOTES TO BOX No. VI

**Signature (Rule 53.8):** The demand must be signed by the applicant or by his agent. If the demand is not signed by (all) the applicant(s), a power of attorney signed by (all) the applicant(s) must be filed with the International Bureau of WIPO or with the receiving Office, unless the agent has previously been appointed.

07/1987

Member and Non-Member States of the International Patent Cooperation Treaty  
 States which have not yet become Members of the International Patent Cooperation Treaty  
 States which have not yet become Members of the International Patent Cooperation Treaty

EA-Form 1017  
 (10-1987)

**FEE CALCULATION SHEET**  
**ANNEX TO THE DEMAND FOR INTERNATIONAL PRELIMINARY EXAMINATION**

<b>APPLICANT</b>  Columbia Marine Corporation		<b>For use by IPEA</b>
<b>INTERNATIONAL APPLICATION NUMBER</b>  PCT/US87/88888	<b>DATE STAMP OF THE IPEA</b>	
<b>I. PRELIMINARY EXAMINATION FEE</b> .....		\$370.00    P
<b>II. HANDLING FEE</b>		
Indicate the amount fixed in the Schedule of Fees.....		\$150.00    h <sub>1</sub>
Repeat the amount indicated in Box h <sub>1</sub> if the Soviet Union has been elected.....		b <sub>2</sub>
Add the amount (if any) entered in Box h <sub>2</sub> to the amount entered in Box h <sub>1</sub> and enter the total in Box H. This figure is the amount of the <b>HANDLING FEE</b> .....		\$150.00    H
<b>III. TOTAL OF PRESCRIBED FEES SUBMITTED OR TO BE CHARGED TO DEPOSIT ACCOUNT</b>		
Add the amounts entered in Boxes P and H, and enter the total in the <b>TOTAL</b> Box. <b>THIS FIGURE IS THE TOTAL AMOUNT OF THE PRESCRIBED FEES SUBMITTED OR TO BE CHARGED TO THE DEPOSIT ACCOUNT</b> .....		\$520.00 <hr/> TOTAL
<b>THE APPLICANT MAY PAY THE PRESCRIBED FEES BY CHEQUE, POSTAL MONEY ORDER, BANK DRAFT, CASH, REVENUE STAMPS, COUPONS, ETC. PAYMENT SHOULD BE MADE IN THE PRE- SCRIBED CURRENCY TO THE (ACCOUNT OF, ACCOUNT INDICATED BELOW OF, ORDER OF) THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY. PAYMENT MAY ALSO BE MADE BY AUTHORIZATION TO CHARGE A DEPOSIT ACCOUNT AT THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY IF THE LATTER HAS A DEPOSIT ACCOUNT SYSTEM.</b>		
<b>DEPOSIT ACCOUNT AUTHORIZATION</b>		
<input type="checkbox"/> The IPEA/ US is hereby authorized to charge the total fees indicated above to my deposit account.		
<input checked="" type="checkbox"/> The IPEA/ US is hereby authorized to charge any deficiency or credit any overpayment in the total fees indicated above to my deposit account.		
99-1111 Deposit Account Number	10 February 1988 Date	<i>John Adams</i> Signature    John Adams

**PCT Rule 53**  
**The Demand**

**53.1 Form**

- (a) The demand shall be made on a printed form.  
 (b) Copies of printed forms shall be furnished free of charge by the receiving Offices to the applicants.  
 (c) The particulars of the forms shall be prescribed by the Administrative Instructions.

**53.2 Contents**

- (a) The demand shall contain:  
 (i) a petition,  
 (ii) indications concerning the applicant and the agent if there is an agent,  
 (iii) indications concerning the international application to which it relates,  
 (iv) election of States.  
 (b) The demand shall be signed.

**53.3 The Petition**

The petition shall be to the following effect and shall preferably be worded as follows: "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."

**53.4 The Applicant**

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*.

**53.5 The Agent**

If an agent is designated, Rules 4.4, 4.7, and 4.16 shall apply, and Rule 4.8 shall apply *mutatis mutandis*.

**53.6 Identification of the International Application**

The international application shall be identified by the name of the receiving Office with which the international application was filed, the name and address of the applicant, the title of the invention, and, where the international filing date and the international application number are known to the applicant, that date and that number.

**53.7 Election of States**

The demand shall name, among the designated States, at least one Contracting State bound by Chapter II of the Treaty as elected State.

**53.8 Signature**

The demand shall be signed by the applicant.

**PCT Rule 55**

**Languages (International Preliminary Examination)**

**55.1 The Demand**

The demand shall be in the language of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication.

**PCT Rule 59**

**The Competent International Preliminary Examining Authority**

**59.1 Demands under Article 31(2)(a)**

For demands made under Article 31(2)(a), each Contracting State bound by the provisions of Chapter II shall, in accordance with the terms of the applicable agreement referred to in Article 32(2) and (3), inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with its national Office, or, in the case provided for in Rule 19.1(b), with the national Office of another State or an intergovernmental organization acting for the former Office, and the International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of Rule 35.2 shall apply *mutatis mutandis*.

**59.2 Demands under Article 31(2)(b)**

As to demands under Article 31(2)(b), the Assembly, in specifying the International Preliminary Examining Authority competent for international applications filed with a national Office which is an International Preliminary

Examining Authority, shall give preference to that Authority; if the national Office is not an International Preliminary Examining Authority, the Assembly shall give preference to the International Preliminary Examining Authority recommended by that Office.

**PCT Rule 63**

**Minimum Requirements for International Preliminary Examining Authorities**

**63.1 Definition of Minimum Requirements**

The minimum requirements referred to in Article 32(3) shall be the following:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out examinations;  
 (ii) that Office or organization must have at its ready disposal at least the minimum documentation referred to in Rule 34, properly arranged for examination purposes;  
 (iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or translated.

**37 CFR 1.8 Certificate of Mailing**

(a) Except in the cases enumerated below, papers and fees required to be filed in the Patent and Trademark Office within a set period of time will be considered timely filed if:

- (1) They are addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, and deposited with the U.S. Postal Service with sufficient postage as first class mail prior to expiration of the set period; and  
 (2) They also include a certificate for each paper or fee stating the date of deposit. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed on or before the date indicated. The actual date of receipt of the paper or fee will be used for all other purposes. This procedure does not apply to the following:

\* \* \*

- (xi) The filing of international applications for patent and all papers and fees relating thereto.

\* \* \* \* \*

Applicants should mail the demand and appropriate fees directly to the International Preliminary Examining Authority they desire to prepare the international preliminary examination report. U.S. applicants who have had the international search prepared by the European Patent Office may also request the European Patent Office to act as the International Preliminary Examining Authority. The use of the European Patent Office as an International Preliminary Examining Authority by United States applicants is further limited to 500 international applications a year for the first 3 years that Chapter II is in effect for the United States. Applicants should consult the USPTO Official Gazette or the PCT Branch for the latest information as to the number of Demands that have been filed in the European Patent Office.

Demands filed in the European Patent Office should be addressed to:

European Patent Office  
 Erhardstrasse 27  
 8000 Munich 2,  
 Federal Republic of Germany.

Demands directed to the United States Patent and Trademark Office should be addressed to:

United States Patent and Trademark Office  
 Box PCT  
 Washington, D.C. 20231.

The Express Mail™ provisions of 37 CFR 1.10 may be used to file a Demand under Chapter II in the USPTO.

All Demands filed in the USPTO must be in the English language.

**1898.01(c)(1) Preliminary Examination Fees [R-5]**

**PCT Article 31**

**Demand for International Preliminary Examination**

\*\*\*\*\*

(5) The demand shall be subject to the payment of the prescribed fees within the prescribed time limit.

\*\*\*\*\*

**PCT Rule 57  
The Handling Fee**

**57.1 Requirement to Pay**

(a) Each demand for preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau ("handling fee") to be collected by the International Preliminary Examining Authority to which the demand is submitted.

(b) Where, because of later election or elections, the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau into one or more additional languages, a "supplement to the handling fee" shall be collected by the International Bureau.

**57.2 Amounts of the Handling Fee and the Supplement to the Handling Fee**

(a) The amount of the handling fee is as set out in the Schedule of Fees. The amount payable in any particular case shall be the amount as so set out, increased by as many times the same amount as the number of languages into which the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau.

(b) The amount of the supplement to the handling fee is as set out in the Schedule of Fees. The amount payable in any particular case shall be the amount as so set out, multiplied by the number of additional languages referred to in Rule 57.1(b).

(c) The amount of the handling fee shall be established, for each International Preliminary Examining Authority which, under Rule 57.3(c), prescribes the payment of the handling fee in a currency or currencies other than the Swiss currency, by the Director General after consultation with that Authority and in the currency or currencies prescribed by that Authority ("prescribed currency"). The amount in each prescribed currency shall be the equivalent, in round figures, of the amount of the handling fee in Swiss currency set out in the Schedule of Fees. The amounts in the prescribed currencies shall be published in the Gazette.

(d) Where the amount of the handling fee set out in the Schedule of Fees is changed, the corresponding amounts in the prescribed currencies shall be applied from the same date as the amount set out in the amended Schedule of Fees.

(e) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new amount in the prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that the interested International Preliminary Examining Authority and the Director General may agree on a date falling during the said two-month period in which case the amount shall become applicable for that Authority from that date.

**57.3 Time and Mode of Payment**

(a) The handling fee shall be due at the time the demand is submitted.  
(b) Any supplement to the handling fee shall be due at the time the later election is submitted.

(c) The handling fee shall be payable in the currency or currencies prescribed by the International Preliminary Examining Authority to which the demand is submitted, it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency.

(d) Any supplement to the handling fee shall be payable in Swiss currency.

**57.4 Failure to Pay (Handling Fee)**

(a) Where the handling fee is not paid as required, the International Preliminary Examining Authority shall invite the applicant to pay the fee within

one month from the date of the invitation.

(b) If the applicant complies with the invitation within the one-month time limit, the handling fee shall be considered as if it had been paid on the due date.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

**57.5 Failure to Pay (Supplement to the Handling Fee)**

(a) Where the supplement to the handling fee is not paid as required, the International Bureau shall invite the applicant to pay the supplement within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the one-month time limit, the supplement to the handling fee shall be considered as if it had been paid on the due date.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the later election shall be considered as if it had not been submitted.

**57.6 Refund**

In no case shall the handling fee, or the supplement to the handling fee, be refunded.

**PCT Rule 58**

**The Preliminary Examination Fee**

**58.1 Right to Ask for a Fee**

(a) Each International Preliminary Examining Authority may require that the applicant pay a fee ("preliminary examination fee") for its benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.

(b) The amount and the due date of the preliminary examination fee, if any, shall be fixed by the International Preliminary Examining Authority, provided that the said due date shall not be earlier than the due date of the handling fee.

(c) The preliminary examination fee shall be payable directly to the International Preliminary Examining Authority. Where the Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental organization is located or in any other currency which is freely convertible into the currency of the said State.

**58.2 Failure to Pay**

(a) Where the preliminary examination fee fixed by the International Preliminary Examining Authority under Rule 58.1(b) is not paid as required under that Rule, the International Preliminary Examining Authority shall invite the applicant to pay the fee or the missing part thereof within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the prescribed time limit, the preliminary examination fee will be considered as if it had been paid on the due date.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

**58.3 Refund**

The International Preliminary Examining Authority shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted, and the International Bureau shall promptly publish such information.

**37 CFR 1.482 International preliminary examination fees.**

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

(1) A preliminary examination fee is due on filing the Demand:

(i) Where an international search fee as set forth in §1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority, a preliminary examination fee of .....\$370.00

(ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office, a preliminary examination fee of .....\$570.00

(2) An additional preliminary examination fee when required, per additional invention:

(i) Where a supplemental search fee as set forth in §1.445(a)(3) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority .....\$125.00

(ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office.....\$190.00

(b) The handling fee is due on filing the Demand. Any necessary supplement to the handling fee shall be paid directly to the International Bureau.

(35 U.S.C. 6, 376)

### 1898.01(d) Correction of Defects in the Demand [R-5]

#### PCT Rule 60

##### Certain Defects in the Demand or Election

###### 60.1 Defects in the Demand

(a) If the demand does not comply with the requirements specified in Rules 53 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the prescribed time limit, the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted contained at least one election and 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 prescribed time limit, the demand shall be considered as if it had not been submitted.

(d) 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).

###### 60.2 Defects in Later Elections

(a) If the later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the prescribed time limit, the later election shall be considered as if it had been received on the actual filing date, provided that the later election as submitted contained at least one election and permitted the international application to be identified; otherwise, the later election shall be considered as if it had been received on the date on which the International Bureau receives the correction.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the later election shall be considered as if it had not been submitted.

Defects in the Demand may be corrected. The type of correction determines whether the filing date of the Demand must be changed.

### 1898.01(e) Processing of Fees [R-5]

Fees for Chapter II procedure are processed promptly after receipt and checked for completeness. If the fees are insufficient, the applicant is notified so that the required additional amounts may be promptly paid.

### 1898.01(f) Preparation of Office Records [R-5]

The Patent and Trademark Office maintains status and location information concerning international applications before it on the "Patent Application Location and Monitoring" (PALM) system. In addition, various other forms are used to control financial and formality data.

### 1898.01(g) Notification to International Bureau of Demand [R-5]

#### PCT Article 31

##### Demand for International Preliminary Examination

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(7) Each elected Office shall be notified of its election.

#### PCT Rule 61

##### Notification of the Demand and Elections

61.1 *Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority*

(a) The International Preliminary Examining Authority shall indicate on the demand the date of receipt or, where applicable, the date referred to in Rule 60.1(b). The International Preliminary Examining Authority shall promptly send the demand to the International Bureau, and shall prepare and keep a copy in its files.

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 54.4(b) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) The International Bureau shall promptly notify the International Preliminary Examining Authority and the applicant of the receipt, and the date of receipt, of any later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 60.2(b). Where the later election has been considered under Rules 57.5(c) or 60.2(c) as if it had not been submitted, the International Bureau shall notify the applicant accordingly.

\*\*\*\*\*

The PCT Division 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.

### 1898.01(h) Priority Document and Translation thereof [R-5]

#### PCT Rule 66

##### Procedure before the International Preliminary Examining Authority

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###### 66.7 Priority Document

(a) If the International Preliminary Examining Authority needs a copy of the 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, 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 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 is required by the International Preliminary Examining Authority, and a translation thereof, if the priority document is in a language which is not an acceptable language of the International Preliminary Examining Authority.

**1898.01(i) Processing Amendments filed under Article 19 [R-5]**

**PCT Rule 62**

**Copy for the International Preliminary Examining Authority**

62.1 [Deleted]

**62.2 Amendments**

(a) Any amendment filed under Article 19 shall be promptly transmitted by the International Bureau to the International Preliminary Examining Authority. If, at the time of filing such amendments, a demand for international preliminary examination has already been submitted, the applicant shall, at the same time as he files the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority.

(b) If the time limit for filing amendments under Article 19 (see Rule 46.1) has expired without the applicant's having filed amendments under that Article, or if the applicant has declared that he does not wish to make amendments under that Article, the International Bureau shall notify the International Preliminary Examining Authority accordingly.

The receipt of a copy of the amendment under Article 19 or the statement that no amendment under Article 19 will be made starts the examination before the International Preliminary Examining Authority.

**1898.01(j) Transmittal of Demand to the Examining Corps [R-5]**

**PCT Administrative Instructions 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 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 examining group for examination. The documents will be placed in the "Search Copy" file wrapper when forwarded to the examining corps.

**1898.01(k) Later Election of States [R-5]**

**PCT Article 31**

**Demand for International Preliminary Examination**

\*\*\*\*\*

(6)(b) Any later election shall be submitted to the International Bureau.

\*\*\*\*\*

**PCT Rule 56**

**Later Elections**

**56.1 Elections Submitted Later Than the Demand**

The election of States not named in the demand shall be effected by a notice signed and submitted by the applicant, and shall identify the international application and the demand.

**56.2 Identification of the International Application**

The international application shall be identified as provided in Rule 53.6.

**56.3 Identification of the Demand**

The demand shall be identified by the date on which it was submitted and by the name of the International Preliminary Examining Authority to which it was submitted.

**56.4 Form of Later Elections**

The later election shall preferably be made on a printed form furnished free of charge to applicants. If it is not made on such a form, it shall preferably be worded as follows: "In relation to the international application filed with ... on ... under No. ... by ... (applicant) (and the demand for international preliminary examination submitted on ... to ...), the undersigned elects the following additional State(s) under Article 31 of the Patent Cooperation Treaty: ..."

**56.5 Language of Later Elections**

The later election shall be in the language of the demand.

Applicants may, after filing of the Demand, later, but still within 19 months of the priority date, elect additional States which have been previously designated and obtain the benefit of delaying the national stage until 30 months after the priority date in the additional elected States. All such later elections must be filed directly with the International Bureau. If additional translations are required due to the requirements of the additional States elected, the supplement to the handling fee must also be paid directly to the International Bureau.

**1898.02(a) Determination if International Preliminary Examination is Required and Possible [R-5]**

**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 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.

**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 or animals, other than microbiological processes and the products of such processes,

(iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,

(iv) methods of treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,

(v) mere presentation 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.

There are instances where international preliminary examination is not required because of the nature of the subject matter claimed or 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, on Form PCT/IPEA/408, check the first unnumbered box under box 2. Discretion is given as to that subject matter under PCT Rule 67 which may be excluded from International Preliminary Examination. 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.

Check the second and third unnumbered boxes under box II of Form PCT/IPEA/408, respectively, 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 (non-obviousness) and industrial applicability of the claimed invention.

#### Form paragraph 18.06

Claims (Inventions) for which no International Search Report will be issued

Claim [1] directed to an invention which has not been previously searched by an International Searching Authority. Consequently, these claims are not considered for international preliminary examination. Note: 37 CFR 1.484(c).

#### EXAMINER NOTE:

This paragraph must be included when one or more of the claimed inventions has not been the subject of an International Search Report by a competent International Searching Authority.

#### Form paragraph 18.11

Name and Number of Examiner to be Contacted.

Any inquiry concerning this communication should be directed to [1] at telephone number 703-[2]

#### EXAMINER NOTE:

1. This paragraph should be used at the end of all requirements for unity of invention.
2. In bracket [1], the examiner who prepared the requirement for lack of unity of invention.
3. In bracket [3] insert the telephone number of the examiner identified at [2].

## 1898.02(b) Unity of Invention before the International Preliminary Examining Authority [R-5]

### 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, 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 Rule 68 Lack of Unity of Invention (International Preliminary Examination)

#### 68.1 No Invitation to Restrict or Pay

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to pay additional fees, it shall establish the international preliminary examination report, subject to Article 34(4)(b), in respect of the entire international application, but shall indicate, in the said report, that, in its opinion, the requirement of unity of invention is not fulfilled and shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention.

#### 68.2 Invitation to Restrict or Pay

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or pay additional fees, it shall specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement, and specify the amount of the additional fees and the reasons for which the international application is not considered as complying with the requirement of unity of invention. It shall, at the same time, fix a time limit, with regard to the circumstances of the case, for complying with the invitation: such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

#### 68.3 Additional Fees

(a) The amount of the additional fee due for international preliminary examination under Article 34(3)(a) shall be determined by the competent International Preliminary Examining Authority.

(b) The additional fee due for international preliminary examination under Article 34(3)(a) shall be payable direct to the International Preliminary Examining 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 Preliminary Examining 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 elected Offices as an annex to the international preliminary examination report.

(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.

#### 68.4 Procedure in the Cases of Insufficient Restriction of the Claims

If the applicant restricts the claims but not sufficiently to comply with the requirement of unity of invention, the International Preliminary Examining Authority shall proceed as provided in Article 34(3)(c).

#### 68.5 Main Invention

In case of doubt which invention is the main invention for the purposes of Article 34(3)(c), the invention first mentioned in the claims shall be considered the main invention.

### 37 CFR 1.487 Unity of Invention before the International Preliminary Examining Authority.

(a) An international application before the International Preliminary Examining Authority will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see § 1.475(f)).

(b) An international 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 combinations of categories as set forth in PCT Rule 13.2 (see § 1.475(f)) or to the combination of (1) a product and a process for the manufacture of said product or (2) a product and a process of use of said product. If an application contains claims to more or less than one of the combinations of categories of invention set forth in PCT Rule 13.2 (see § 1.475(f)) or a combination set forth in paragraphs (b)(1) or (2) of this section, unity of invention may not be present.

(c) If an international application contains claims to a category of invention in addition to those categories included in any one of the combinations

specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.

(d) Unity of invention will exist where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see §1.475(f)) or a combination set forth in paragraphs (b)(1) or (2) of this section. 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 inventions to be examined. Any such holding by the examiner will be made of record as a holding of lack of unity of invention.

(e) The inventions recited by the claims of different categories must be related rather than independent inventions.

#### **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 §1.487.

(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 the 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 Preliminary Examining Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for response, 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 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 searched if no additional fees are paid or no 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 1.487 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 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"). 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)).

Unity of invention must be addressed within 7 days from the date the PCT application is charged to the Examining Group from PCT Central. This simply means that a determination must be made as to whether or not the international application relates to one invention or to a group of inventions so linked as to form a single general inventive concept.

If it is determined that the international application does meet the requirements for unity of invention and no additional fees will be requested, the international application must be returned to the PCT Docket Clerk in the Examining Group so that an indication to that effect may be made on the PALM System which monitors deadlines such as the deadline for checking unity of invention.

If the examiner determines that unity of invention is lacking, there are two options:

1. The examiner may conduct an international preliminary examination covering all the claimed, 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

2. 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. 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 respond to the invitation to restrict the claims or pay additional examination fees due to lack of unity of invention, the Written Opinion and 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.

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), no or little additional effort is involved in establishing the Written Opinion 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 PCT Rule 13 which sets forth several combinations of related categories of invention that may be included in an international application and still comply with the unity of invention requirement.

### 1898.02(b)(1) Preparation of Invitation Concerning Unity [R-5]

Notes on Completing "Invitation to restrict or pay additional fees", Form PCT/IPEA/405

This form is used to invite the applicant, at his or 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.

The following identifying information is to be placed on the top of the first page of Form PCT/IPEA/405:

Applicant's mailing address - this is usually the attorney's address taken from the file wrapper by the typist.

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 ten characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401.

International Application Number - this is the 14 digit PCT application serial 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) - this is 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.

#### INVITATION

In the space provided, after the first paragraph on form PCT/IPEA/405, the examiner should identify the disclosed inventions by claim numerals or drawing figure numerals, as appropriate, 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.

In the space provided after the third paragraph at the bottom of the first page, 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.

In the space provided, after the first paragraph of the second page of form PCT/IPEA/405, the examiner indicates the invention or groups of inventions which are so linked as to form a single general inventive concept, thereby meeting the requirement of unity of invention. This is normally a restatement of the inventions identified in the space provided, after the first paragraph on page 1 of form PCT/IPEA/405.

In the space at the end of the second paragraph of page 2 of form PCT/IPEA/405, the examiner should indicate the total amount of additional fees required for examination of all claimed inventions.

In the third paragraph printed on page 2, the time limit for response is set according to PCT Rule 68.2, normally a one month time limit should be set. No extensions of time are 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 in certain cases to allow applicants to elect an invention to be examined or to pay additional fees. Additional fees may be charged to a deposit account using the telephone practice only if:

1) The Demand for International Preliminary Examination included an authorization to charge additional fees to a deposit account,

2) Applicant or the legal representative or agent orally agrees to charge the additional fees to the account, and

3) A complete record of the telephone conversation is included with the Written Opinion including:

- a) Examiner's name;
- b) Authorizing attorney's name;
- c) Date of conversation;
- d) Invention elected and/or inventions for which additional fees paid; and
- e) Deposit account number and amount to be charged.

If applicant or the legal representative or agent refuses to either restrict the claims to one invention or authorize payment of additional fees, form PCT/IPEA/405 should be prepared and mailed to applicant.

PATENT COOPERATION TREATY

TO

John Adams  
 Adams, Baker and Charlie  
 1200 Marina Drive  
 Baltimore, Maryland 20820

UNITED STATES  
 INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA/US)

INVITATION TO RESTRICT OR PAY  
 ADDITIONAL FEES

issued pursuant to PCT Article 34 (3)(e) and Rule 68.2

Inscribe NAME and ADDRESS of the AGENT and if  
 there is no agent, of the APPLICANT

DATE OF MAILING by the International Preliminary

Examining Authority

APPLICANT'S OR AGENT'S FILE REFERENCE

CMC-123

IDENTIFICATION OF THE INTERNATIONAL APPLICATION

International Application No.

PCT/US87/88888

International Filing Date

06 July 1987 (06.07.87)

Applicant (Name)

Columbia Marine Corporation

INVITATION

This International Preliminary examining Authority considers that the above-identified international application does not comply with the requirement of unity of invention<sup>(1)</sup> for the following reasons:

Group I, Claims 1-5, 9 and 10, drawn to a sailboat self-steering gear.

Group II, Claims 6-8, drawn to a compass with an alarm to indicate deviation from a desired course.

The claims of these two groups are directed to different inventions which are not so linked as to form a single general inventive concept. The inventions are not linked in operation and perform completely different operations.

CONSEQUENTLY THE APPLICANT IS HEREBY GIVEN THE OPTION OF RESTRICTING THE CLAIMS OR PAYING ADDITIONAL FEES.

If the applicant does not exercise the option, the International Preliminary Examining Authority will establish the international preliminary examination report on those parts of the international application indicated below which, in the opinion of this International Preliminary Examining Authority, appear to relate to the main invention. (Specify)

Claims 1-5, 9 and 10.

(Invitation continued on the following page)

STATISTISKA FORSAETNINGEN PCT/US87/88488

PCT/US87/88488

INVITATION TO RESTRICT OR PAY ADDITIONAL FEES (continued)

If the applicant opts to restrict the claims, this International Preliminary Examining Authority suggests below restriction possibilities which in its opinion would be in compliance with the requirement of unity of invention. (specify)

Group I, Claims 1-5, 9 and 10

Group II, Claims 6-8

If the applicant opts to pay additional fees, this International Preliminary Examining Authority will establish the international preliminary examination report on the other parts of the international application only if, and to the extent to which, additional fees are paid by the applicant. The total amount of the additional fees is \$125.00.

THE APPLICANT IS HEREBY INVITED TO RESTRICT THE CLAIMS OR TO PAY THE AMOUNT OF ADDITIONAL FEES WITHIN one (MONTHS) ~~(ONE)~~ FROM THE DATE OF MAILING INDICATED ABOVE. The payment of any additional fee may be made under protest.<sup>(2)</sup>

Computation of the time limit starts on the day following the date of mailing of the present invitation. Within this time limit either the payment or the restriction has to be made to this International Preliminary Examining Authority.

Payment should be made by check, postal money order, or bank draft, payable to the Commissioner of Patents and Trademarks Payment and may also be made by authorization to charge a Patent and Trademark Office deposit account.

THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

Address Only:  
Commissioner of Patents and Trademarks  
Box PCT  
Washington, D.C. 20231

Authorized Officer  
*Stephen Decatur*  
Stephen Decatur - Primary Examiner

FORM PCT/PEAMP/2 (January 1985)

**Form paragraph 18.01****Permissible Combinations**

In the examination of international applications filed under the Patent Cooperation Treaty, PCT Rule 13.1 states that 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".

PCT Rule 13.2 indicates that this shall be construed as permitting, in particular, one of the following three possible combinations of the claimed invention:

- (1) a product, a process specifically adapted for the manufacture of said product and a use of said product, or
- (2) a process, and an apparatus or means specifically designed for carrying out said process, or
- (3) a product, a process specially adapted for the manufacture of said product and an apparatus or means specifically designed for carrying out the process.

Additionally, current United States Patent and Trademark Office restriction practice permits the following combinations of the claimed invention:

- (4) a product, and a process specifically adapted for the manufacture of said product, and
- (5) a product, and a use of the said product, as where said use as claimed cannot be practiced with another materially different product.

**EXAMINER NOTE:**

1. This paragraph must be used as the beginning paragraph of a separate sheet holding of lack of unity of invention involving different categories of invention. On the first page of Form PCT/FEA/405 insert the notation "See attached sheet" and proceed using these form paragraphs. However, the main invention should be indicated on the bottom of the form PCT/FEA/405.

**Form paragraph 18.02****Invitation to restrict**

This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept. In order for all inventions to be examined, the appropriate additional examination fees must be paid.

**EXAMINER NOTE:**

1. This is the heading that should be used in all holdings of lack of Unity of Invention.

**Form paragraph 18.03****Groupings of invention**

Group [1], Claim [2], drawn to [3].

**EXAMINER NOTE:**

1. In bracket [1], place sequential Roman numerals to identify the groupings.
2. In bracket [2], place the appropriate claim number(s).
3. In bracket [3], define the invention or groups of invention(s) so linked as to form a single general inventive concept.

**Form paragraph 18.04****Reasons for holding a lack of Unity of Invention**

The inventions listed as Groups [1] do not meet the requirements for Unity of Invention for the following reasons: [2]

**EXAMINER NOTE:**

1. In bracket [1], list the Roman numerals that identify the groupings of invention.
2. This paragraph follows the listing of the Groups of invention and should be completed at [2] with a thorough and concise explanation as to why there is a lack of unity of invention between the groups.

**Form paragraph 18.07****Telephone Election - Single Invention**

During a telephonic requirement for election, on [1] applicant's representative, [2], elected the invention of Group [3] for examination.

No additional examination fees were authorized and only one invention was elected.

**EXAMINER NOTE:**

1. In bracket [1], insert the date the election was made.

2. In bracket [2], insert the name of applicant's representative.

3. In bracket [3], insert the Roman numeral identifying the elected invention.

**Form paragraph 18.08****Telephone Election - Multiple Inventions**

During a telephonic requirement for election, on [1], applicant's representative, [2], elected the inventions of Groups [3] for examination.

Applicant's representative also authorized the charging to the Deposit Account for payment of additional examination fees totaling \$[4] for the examination of said inventions. The additional examination fees have been charged to Deposit Account Number [5].

**EXAMINER NOTE:**

1. In bracket [1], insert the date the election was made
2. In bracket [2], insert the name of applicant's representative
3. In bracket [3], insert the Roman numeral identifying the elected inventions.
4. In bracket [4], insert the amount of the additional fees for the examination of the additional invention(s).
5. In bracket [5], insert the Deposit Account Number.

**Form paragraph 18.09****Notice of Right to Protest Telephone Practice in Written Opinion**

Applicant stands advised 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 fees has been paid. Any protest to the holding of lack of unity of invention or the amount of the additional fee required must be filed no later than the filing of a response to the Written Opinion.

**EXAMINER NOTE:**

1. This paragraph must be included in the record of a telephone election made in a Written Opinion.

**Form paragraph 18.10****Notice of Right to Protest Telephone Practice, No Written Opinion**

Applicant stands advised 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 fees has been paid. Any protest to the holding of lack of unity of invention or the amount of the additional fee required must be filed no later than one month from the date of this letter.

**EXAMINER NOTE:**

1. This paragraph must be included in the record of a telephone election made in a separate letter.

**1898.02(c) Response to Invitation Concerning Lack of Unity of Invention [R-5]****PCT Administrative Instructions Section 603  
Transmittal of Protest Against Payment of Additional Fee and Decision Thereon**

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. At the same time, it shall transmit to the International Bureau a copy of both the protest and the decision thereon, as well as any request by the applicant to forward the texts of both the protest and the decision thereon to any of the elected Offices.

**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

Commissioner or the Commissioner'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 respond 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 Group Director to inform the applicant of the decision regarding applicant's protest on the payment of additional fees concerning unity of invention.

The following identifying information must be placed on the top of the first page of Form PCT/IPEA/420:

Applicant's address - usually the attorney's address taken from international application 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 ten characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401.

International Application Number - this is the 14 digit PCT application serial 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) - this is 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.

#### NOTIFICATION

The Group Director checks the appropriate box, i.e., 1.a., 1.b. 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 Group Director.

#### 1898.02(d) Notation of errors and informalities by the Examiner [R-5]

#### PCT Administrative Instructions Section 607 Rectifications under Rule 91.1

Where the International Preliminary Examining Authority authorizes a rectification under Rule 91.1, Rule 70.16 and Section 602 shall apply *mutatis mutandis*.

Although the examiner is not responsible for discovering errors in the international application, if any errors come to the attention of the examiner, they should be noted and called to the applicant's attention. Notations as to obvious errors (see PCT Rule 91) should be called to the applicant's attention by using PCT form PCT/IPEA/411 or 423.

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.

#### INVITATION TO REQUEST RECTIFICATION OR CORRECTION

The procedure governing the rectification of obvious errors are PCT Rules 91.1(d) and 26.4(a) which state that:

The request for rectification which the applicant is invited to make must be submitted in a letter. The rectification may be stated in that letter if it 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 containing the request for rectification must draw attention to the differences between the replaced sheet and the replacement sheet.

Defects that are not obvious errors may be called to applicant's attention by using form PCT/IPEA/408 or 423.

The following identifying information is to be placed on the top of the first page of Form PCT/IPEA/411 or 423:

Applicant's address - usually the attorney's address taken from the front of the international application 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 ten characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401.

International Application Number - this is the 14 digit PCT application serial 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) - this is 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.

#### INVITATION

The examiner may invite applicant to rectify obvious errors which do not impede the examination of the PCT application. Applicant is notified of the obvious errors by checking the first

box and supplying a photocopy of the obvious errors or checking the second box and clearly describing the obvious errors in the space provided.

Since the space provided is limited, supplemental attachment sheet(s) should be incorporated whenever necessary.

The examiner then must complete the section of the Form which notifies applicant where the Request for Rectification should be submitted. This will be the USPTO if the error is in a part of the international application other than the request which has been submitted to the International Preliminary Examining Authority. See PCT Rule 91.1(e). This should be indicated by checking the last box.

#### AUTHORIZED OFFICER

Forms PCT/IPEA/411 and 423 must be signed by an examiner having at least partial signatory authority.

In the large rectangle on the form, the examiner should clearly set forth the deficiency.

Since the space is limited, supplemental sheet(s), supplied by the examiner, should be incorporated whenever necessary. The examiner should check the appropriate box to indicate the type of deficiency in the papers.

The time limit for response is set in the last paragraph (which is in capital letters). Applicant is given 30 days, or less depending on the time remaining to complete the International Preliminary Examination Report.

#### Form paragraph 18.28

**Drawings objected to, Correction requested**  
The drawings are objected to because [1]. Correction is requested.

#### Form paragraph 18.29

##### Subject matter admits of Illustration

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.

#### Form paragraph 18.30

##### Amendment containing New Matter

The amendment of [1] is objected to under PCT Article 34(2)(b) because it introduces matter into the application that goes beyond the disclosure as originally filed. The added material which is not supported by the original disclosure is as follows: [2]

Under PCT Rule 70.2(c), the international application is being treated as if the entire amendment had not been made.

##### EXAMINER NOTE:

1. An amendment that attempts to add new matter to any of the drawings, specification or claims in effect voids the entire amendment, and the international application is in effect treated as if the amendment had never been submitted.

#### Form paragraph 18.33

##### Improper Multiple dependent claims

Claim [1] objected to under PCT Rule 6.4(a) as being in improper dependent form because a multiple dependent claim [2]. Accordingly, claim [3] not being examined for novelty, inventive step and industrial applicability.

##### EXAMINER NOTE:

1. In bracket [2], insert "should refer to other claims in the alternative only.", and/or "cannot depend from any other multiple dependent claim."

#### 1898.02(d)(1) Rectification [R-5]

#### NOTIFICATION OF DECISION CONCERNING REQUEST FOR RECTIFICATION

The rectification of obvious errors is governed by PCT Rules 91.1(b)-(h) and 66.5.

The following identifying information is to be placed on the top of the first page of Form PCT/IPEA/412:

**Applicant's address** - usually the attorney's address taken from the front of the international application 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 ten characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401.

**International Application Number** - this is the 14 digit PCT application serial 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)** - this is 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.

#### NOTIFICATION

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.

The last box, indicating that this rectification with any attachment has been sent to the International Bureau, is checked when the Request for Rectification has been approved or approved in part. This box is not checked when the Request for Rectification has been refused.

#### AUTHORIZED OFFICER

Form PCT/IPEA/412 must be signed by an examiner having at least partial signatory authority.

#### 1898.03(a) Preparation of the Written Opinion [R-5]

##### PCT Article 34

##### Procedure before the International Preliminary Examining Authority

\*\*\*\*\*

(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.

\*\*\*\*\*

## PCT Rule 66

## Procedure before the International Preliminary Examining Authority

## 66.1 Basis of the International Preliminary Examination

Before the international preliminary examination starts, the applicant may make amendments according to Article 34(2)(b) and the international preliminary examination shall initially be directed to the claims, the description, and the drawings, as contained in the international application at the time the international preliminary examination starts.

## 66.2 First Written Opinion of the International Preliminary Examining Authority

## (a) If the International Preliminary Examining Authority

(i) considers that the international application has any of the defects described in Article 34(4),

(ii) considers that the international preliminary examination report should be negative in respect of any of the claims because the invention claimed therein does not appear to be novel, does not appear to involve an inventive step (does not appear to be non-obvious), or does not appear to be industrially applicable,

(iii) notices that there is some defect in the form or contents of the international application under the Treaty or these Regulations,

(iv) considers that any amendment goes beyond the disclosure in the international application as filed, or

(v) wishes to accompany the international preliminary examination report by observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description,

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

(b) The notification shall fully state the reasons for the opinion of the International Preliminary Examining Authority.

(c) The notification shall invite the applicant to submit a written reply together, where appropriate, with amendments.

(d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. In no case shall it be more than three months after the said date.

\*\*\*\*\*

## 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) No international preliminary examination report will be established prior to issuance of an international search report.

(c) No international preliminary examination report 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 respond.

(e) If no written opinion under paragraph (d) of this section is necessary, or after any written opinion and the response thereto or the expiration of the time limit for response 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 response by the applicant to a written opinion. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful in 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 response to the written opinion or, if applicant files no

response, be made of record in the file by the examiner.

## If the examiner:

1. considers that the international application has any of the defects described in PCT Article 34(4);

2. 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;

3. notices any defects in the form or contents of the international application under the PCT;

4. considers that any amendment goes beyond the disclosure in the international application as originally filed; or

5. 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;

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 or her opinion (PCT Rule 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)) setting two or three months time limit for the reply.

## WRITTEN OPINION

The following identifying information is placed on the first page of the Written Opinion Form PCT/IPEA/408.

Applicant's address - usually the attorney's address taken from the international application 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 ten characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401.

International Application Number - this is the 14 digit PCT application serial 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) - this is 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.

Receiving Office - this is the Office with which the application was first filed, identified on the first page of the Demand as RO/US, RO/BR for Brazil, RO/BB for Barbados, etc. This will usually be the United States Receiving Office identified as RO/US.

Priority Date Claimed - this is the date of an earlier application of which the priority is claimed under PCT Rule 4.10. This information is typed on the international application file wrapper and can be found in Box VI of the Request Form PCT/RO/101.

## WRITTEN OPINION

The examiner should insert the words "first" or "second", as the case may be, in the space provided in the box below the notation 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 two months of the mailing of the International Search Report. Applicant is also permitted to make amendments before the International Preliminary Examining Authority under PCT Article 34(2)(b) and PCT Rule 66.1. However, this right is limited to the time of the filing of the Demand for International Preliminary Examination by 37 CFR 1.485.

In item I, the first box is checked if the international application remains as originally filed, i.e., with no amendments.

The second, third and/or fourth boxes are checked, as appropriate, if the application has been amended under PCT Article 19 and/or PCT Rule 66.1 and the U.S. rules. Verify any changes to the international application in the spaces provided. Proceed with the examination and the preparation of the Written Opinion of the application as amended.

Check the last box in Item I if it has been determined that any amendment goes beyond the disclosure in the international application as originally filed (contains "new matter") and proceed to establish the Written Opinion as if the amendment had not been made. The Written Opinion should also indicate in Paragraph V the reasons why the amendment goes beyond the original disclosure. (Rule 70.1(c)).

**ITEM II. NON-ESTABLISHMENT OF OPINION ON NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY**

Item II, of Form PCT/IPEA/408, is intended to cover the situation where claims of an application are so defective that the question of novelty, inventive step (non-obviousness) and industrial applicability cannot be considered. This should seldom occur.

Check box 1 if all claims of an application are so defective that no meaningful examination can be performed as to the novelty, inventive step (non-obviousness) and industrial applicability.

Check box 2 where only some of the claims of an application are defective and cannot be examined as to novelty, inventive step (non-obviousness) and industrial applicability or where there has been no international search for the only invention currently claimed in the international application.

The remaining unnumbered boxes in Item II are for indicating those claims which have specific defects under PCT Rules, such as PCT Rules 6.4, 66.2(a)(v), and/or 67.1.

For example, check the first unnumbered box under box 2 if it is found that certain claims of an international application relate to subject matter for which no examination on the merits is required. Any subject matter that is examined under the U.S. national procedure should also be examined in international applications

Check the second and third unnumbered boxes, respectively, 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 full opinion can be formed as to novelty,

inventive step or industrial applicability of the claimed invention (PCT Rule 66.2(a)(v)). When box 1 or 2 of item II is checked, reasons why no examination was given must be given under items V or VI of Form PCT/IPEA/408.

**Form paragraph 18.25**

**Indefinite claims**

Claim [1] objected to as indefinite under PCT Article 6 for lack of clarity. [2]

**EXAMINER NOTE:**

1. This form is analogous to a 35 U.S.C.112, second paragraph rejection. However, remember in an international application undergoing International Preliminary Examination, that the claims are never rejected nor is the patentability or lack thereof discussed.

2. In bracket [2] explain the lack of clarity.

**Form paragraph 18.26**

**Claims not supported by the disclosure**

Claim [1] objected to under PCT Article 6 because it is not fully supported by the disclosure. [2]

**EXAMINER NOTE:**

1. In bracket [2] explain the deficiency in the disclosure.

**Form paragraph 18.27**

**Inadequate description**

The description of the invention does not satisfy PCT Article 5 in that the invention must be disclosed in a manner sufficiently clear and complete to be carried out by a person skilled in the art. [1]

**EXAMINER NOTE:**

1. In bracket [1] explain why the description is not clear and complete.

**ITEM III. NEGATIVE STATEMENT IN REGARD TO NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY OF CLAIMS**

In Item III, the examiner must list in summary form those claims that do not meet the criteria of novelty (N), inventive step (IS) and/or industrial applicability (IA).

An example of this paragraph is as follows:

- Claims 1 and 5 (no N)
- Claims 1 to 10 (no IS)
- Claims 11 and 12 (no IA).

**ITEM IV. CITATIONS AND EXPLANATIONS IN REGARD TO NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY OF THE CLAIMS**

Item IV is the focus of the Written Opinion. All claims without fatal defects are treated on the merits in Item IV as to novelty, inventive step (non-obviousness) and industrial applicability.

The treatment of claims in Item IV is similar in format to an Office action in a regular 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 non-binding on the Elected States.

Examiner statements in Item IV can be positive and/or negative. If, for example, claims define over the prior art and meet the test of novelty, inventive step (non-obviousness) and industrial applicability, a simple statement to this effect is sufficient. If on the other hand it is the opinion of the examiner that some or all claims lack novelty, inventive step and/or

PATENT COOPERATION TREATY

TO  
John Adams  
Adams, Baker and Charlie  
1200 Marina Drive  
Baltimore, Maryland 20820

UNITED STATES  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEAUS)

WRITTEN OPINION

issued pursuant to PCT Rules 66.2<sup>(1)</sup> or 66.4 (a)<sup>(2)</sup>

Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT

DATE OF MAILING by the International Preliminary Examining Authority  
APPLICANT'S OR AGENT'S FILE REFERENCE  
CMC-123

IDENTIFICATION OF THE INTERNATIONAL APPLICATION

International Application No. <b>PCT/US87/88888</b>	International Filing Date <b>06 July 1987 (06.07.87)</b>
Applicant (Name) <b>Columbia Marine Corporation</b>	
Receiving Office <b>RO/US</b>	Priority Date Claimed <b>15 July 1986 (15.07.86)</b>

WRITTEN OPINION

With reference to the above-identified international application, this constitutes the FIRST (first, etc.) written opinion by this International Preliminary Examining Authority.

I. BASIS OF OPINION

- The examination is being carried out on the following application documents: the application documents as filed
- description, pages 1-20, as originally filed
- description, pages \_\_\_\_\_, filed with your letter of \_\_\_\_\_
- claim(s) 1-8, as originally filed
- claim(s) 9 and 10, filed with your letter of 15 February 1988
- drawings, sheet/fig. 1-4, as originally filed
- drawings, sheet/fig. \_\_\_\_\_, filed with your letter of \_\_\_\_\_
- This opinion has been established as if the amendments indicated on the extra sheet have not been made, since, for the reasons indicated, they have been considered to go beyond the disclosure as filed.

II. NON ESTABLISHMENT OF OPINION ON NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY

The question whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable will not for the reasons indicated below be gone into in respect of:

1.  The above-identified international application.
2.  claims Nos. 6-8 (specify particular claims).  
 for which no additional fees have been paid to the IPEA  
 said international application, or said claim Nos. \_\_\_\_\_ relate to the following subject matter<sup>(3)</sup> which does not require an international preliminary examination. (specify)

- The description, claims, or drawings (indicate particular elements) or said claims Nos. \_\_\_\_\_ are so unclear that no meaningful opinion could be formed.<sup>(3)</sup>
- The claims, or said claims Nos. \_\_\_\_\_ are so inadequately supported by the description that no meaningful opinion could be formed.<sup>(3)</sup>

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PCT/US87/88888

WRITTEN OPINION (continued)

III. NEGATIVE STATEMENT IN REGARD TO NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY OF CLAIMS

The statement under Article 35 (2) should be negative in respect of the claims indicated below. The criteria not satisfied in respect of such claims are indicated by the letter abbreviation: N (for Novelty); IS (for Inventive Step); and IA (for Industrial Applicability).

Claim 1, No N

Claims 2 to 4, No IS

IV. CITATIONS AND EXPLANATIONS IN REGARD TO NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY OF CLAIMS

No. of Claim / Relevant Supporting Documents Cited / Explanation

Claim 1 lacks novelty under PCT Article 33(2) as being anticipated by the patent to KNOOS.

Claims 2 and 3 lack an inventive step under PCT Article 33(3) as being obvious over IVERSEN in view of DAW. To mount the device of IVERSEN in a position forward of the keel as taught by DAW would not involve an inventive step.

Claims 4, 5, 9 and 10 meet the criteria set forth in PCT Article 33(2)-(4)

New Citation

US, A, 4,366,767 KNOOS 04 January 1983 (04.01.83), See figure 1.

PCT/US87/88888

WRITTEN OPINION (continued)	
V. CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION	
<p>The following defects in the form or contents of the above-identified international application under the Treaty or the Regulations have been noted.</p> <p>Page 5, line 8, "victor" should be "vector".</p> <p>In figure 2 of the drawings, the lead line for reference numeral 6 should be directed to the tiller rather than to the boom.</p>	
VI. CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION	
<p>The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are notified:</p>	
VII. INVITATION	
<p>APPLICANT IS INVITED TO SUBMIT A WRITTEN REPLY ACCOMPANIED, WHERE APPROPRIATE, BY AMENDMENTS<sup>(1)</sup> WITHIN <u>two</u> MONTHS/_____ DAYS OF THE DATE OF MAILING INDICATED ON THE FIRST SHEET.</p> <p>Any inquiry concerning this communication should be directed to Stephen Decatur at telephone number 703-557-3310.</p> <p>The time limit for response to a Written Opinion will not be extended, 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.</p>	
THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY	
<p>Address Only: Commissioner of Patents and Trademarks Box PCT Washington, D.C.</p>	<p>Authorized Officer <i>Stephen Decatur</i> Stephen Decatur - Primary Examiner</p>
ATTN: IPEA/US	

FORM PCT/IPEA408 (last sheet) (January 1985)

industrial applicability, specific reasons for the opinion employing PCT form paragraphs must be given similar to those used in U.S. national applications.

Form paragraphs to be used by the examiners appear in the relevant sections of this Manual. All examiners are expected to use exclusively the PCT form paragraphs in appropriate situations in formulating any negative statements listed in Item IV. See MPEP §§ 1898.03(a)(2) and (3).

Since the space provided in Item IV on Form PCT/IPEA/408 is limited, supplemental sheets typed on plain white paper, with reference back to Item IV should be incorporated into the Written Opinion whenever necessary.

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 re-search and applied in an Item IV statement must be made of record in Item IV. 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. See M.P.E.P. §1863. See § 1898.03(a)(1) for definition of prior art to be considered.

#### Form paragraph 18.32

Claims that meet test of novelty, inventive step and industrial applicability

Claim [1] meets the criteria set out in PCT Article 33(2)-(4).

#### EXAMINER NOTE:

1. This form paragraph is used in Item IV of form PCT/IPEA/408 to indicate those claims that define over the prior art.

### ITEM V. CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION

In Item V, defects in the form and content of the international application are identified.

Examples of defects that would be listed in Item V are:

1. Informalities such as misplaced and/or omitted drawing numerals, misspelled words, grammatical errors, etc.
2. An amendment to the drawings, description or claims not filed with the Demand, unless it is an amendment to the claims under PCT Article 19 which was timely filed with the International Bureau or in response to a Written Opinion.
3. Improper multiple-dependent claims (PCT Rule 6.4).
4. Defects detected by the PCT Branch that are transmitted with the application to the examiner for inclusion in Item V.

#### Form paragraph 18.31

Disclosure objected to, Minor informalities

The disclosure is objected to because of the following informalities: [1]. Appropriate correction is requested.

#### EXAMINER NOTE:

1. This form paragraph is used in Item V of Form PCT/IPEA/408 to point out minor informalities in the disclosure.

### ITEM VI. CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION

In Item VI, 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 (non-obviousness) or industrial applicability, the applicant is so informed in Item VI (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 IV 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 VI.

### ITEM VII INVITATION

Item VII is an invitation by the International Preliminary Examining Authority (IPEA) to applicant to reply to the examiner's Written Opinion. A two month time limit to respond to the Written Opinion should normally be set, although a 3 month time limit may be set where the time limit for reply ends prior to the expiration of 25 months from the priority date.

#### Form paragraph 18.35

Name and telephone number of examiner to be contacted

Any inquiry concerning this communication should be directed to [1] at telephone number 703-[2].

#### EXAMINER NOTE:

1. This paragraph should be inserted in the "INVITATION", Item VII of all Written Opinions.
2. In bracket [1], the examiner to be contacted first is the examiner who prepared the Written Opinion.

Form paragraph 18.36 must be employed in Item VII of every Written Opinion.

#### Form paragraph 18.36

No extensions of time limit to respond to the Written Opinion

The time limit set for response to a Written Opinion may not be extended, 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

#### EXAMINER NOTE:

1. This form paragraph must be employed in Item VII, the "INVITATION", of each Written Opinion.

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. 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.

### 1898.03(a)(1) Prior Art under Chapter II [R-5]

#### 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 Disclosure

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 after 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, as such, after 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 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.

In cases where any application or any patent which would constitute prior art for the purpose of international preliminary examination as to the novelty and inventive step (non-obviousness) 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 consid-

ered 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/IP/EA/409 under the heading "CERTAIN PUBLISHED DOCUMENTS".

### 1898.03(a)(2) Novelty under Chapter II [R-5]

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.

\*\*\*\*\*

#### Form paragraph 18.21 Novelty

Claim [1] lack(s) novelty under PCT Article 33(2) as being [2] by [3].

##### EXAMINER NOTE:

1. This form paragraph is the equivalent of a 35 U.S.C.102 rejection.
2. In bracket [2], insert "clearly anticipated", or insert "anticipated" and add an explanation at the end of the paragraph.
3. In bracket [3], insert the prior art relied upon.

### 1898.03(a)(3) Inventive Step under Chapter II [R-5]

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.

#### Form paragraph 18.22

##### Inventive Step (non-obviousness)

Claim [1] lack(s) an inventive step under PCT Article 33(3) as being obvious over [2].

##### EXAMINER NOTE:

1. This form paragraph is used when the claim(s) are rendered obvious in view of the prior art.
2. In bracket [2], insert the prior art relied upon and explain how it is applied to the claimed subject matter. If the prior art applied is a combination of references, explain how they are obviously combined to show lack of inventive step.

#### Form paragraph 18.23

##### Inventive Step (obviousness), further explanation

Claim [1] lacks an inventive step under PCT Article 33(3) as obvious over [2] in view of [3] as applied in the above paragraph, further in view of [4].

##### EXAMINER NOTE:

1. See the EXAMINER NOTE in paragraph 18.22 above.

**1898.03(a)(4) Industrial Applicability under Chapter II [R-5]**

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.

\*\*\*\*\*

**Form paragraph 18.24  
Industrial applicability**

Claim [1] lack(s) industrial applicability as defined by PCT Article 33(4). [2]

**EXAMINER NOTE:**

1. This form paragraph is used when the claim(s) define an invention that cannot be made or used (in the technological sense) in any kind of industry.
2. In bracket [2], identify the appropriate basis for stating that the claims lack industrial applicability.

**1898.03(b) Response to the Written Opinion [R-5]**

**PCT Article 34  
Procedure before the International Preliminary Examining Authority**

\*\*\*\*\*

(2)(a) The applicant shall have a right to communicate orally and in writing with the International Preliminary Examining Authority.

(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.

\*\*\*\*\*

(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 Communication 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) 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 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.

(b) [Deleted]

**66.9 Language of Amendments**

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(a), shall be submitted in the language of publication.

**37 CFR 1.485 Amendments by applicant during International preliminary examination.**

The applicant may make amendments at the time of filing of the Demand and within the time limit set by the International Preliminary Examining Authority for response to any written opinion. Any such amendments must -

(1) be made by submitting a replacement sheet for each 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.

If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter.

**RESPONSE OF APPLICANT TO THE WRITTEN OPINION**

All amendments in response to a Written Opinion must be received within the time limit set for response in order to be considered in the International Preliminary Examination Report. 37 CFR 1.484(d) does not allow for extensions of time to respond to a Written Opinion, therefore, any amendment received after the time limit is treated as if the amendment had not been made.

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 response 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 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 response 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, during the time limit for response 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 advancing the international preliminary examination procedure.

All interviews of substance must be made of record by using USPTO Form PTOL-413.

If the applicant desires to respond to the Written Opinion, such response must be filed within the time limit set for response. No extensions to the time limit will be considered or granted. If no timely response 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.

The applicant may respond 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).

The United States rules pertaining to international preliminary examination of international applications provide for a second Written Opinion if time permits.

If applicant does not respond to the Written Opinion, the International Preliminary Examination Report will be prepared in time for forwarding to PCT Central in finished form by 27 months from the priority date.

Any response to a Written Opinion that is received after the expiration of the set time period is not timely and will not be considered in preparing the International Preliminary Examination Report (IPER).

## 1898.04(a) Preparation of the International Preliminary Examination Report [R-5]

### 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 Rule 70

#### The International Preliminary Examination Report

##### 70.1 Definition

For the purposes of this Rule, "report" shall mean international preliminary examination report.

##### 70.2 Basis of the Report

(a) If the claims have been amended, the report shall issue on the claims as amended.

(b) If, pursuant to Rule 66.7(a) or (b), the report is established as if the priority had not been claimed, the report shall so indicate.

(c) If the International Preliminary Examining Authority considers that any amendment goes beyond the disclosure in the international application as filed, the report shall be established as if such amendment had not been made, and the report shall so indicate. It shall also indicate the reasons why it considers that the amendment goes beyond the said disclosure.

##### 70.3 Identification

The report shall identify the International Preliminary Examining Authority which established it by indicating the name of the Authority, and the international application, by indicating the international application number, the name of the applicant, the name of the receiving Office, and the international filing date.

##### 70.4 Dates

The report shall indicate:

(i) the date on which the demand was submitted, and

(ii) the date of the report; that date shall be the date on which the report is completed.

##### 70.5 Classification

(a) The report shall repeat the classification given under Rule 43.3 if the International Preliminary Examining Authority agrees with the classification.

(b) Otherwise, the International Preliminary Examining Authority shall indicate in the report the classification, at least according to the International Patent Classification, which it considers correct.

##### 70.6 Statement under Article 35(2)

(a) The statement referred to in Article 35(2) shall consist of the words "YES" or "NO" or their equivalent in the language of the report, or some appropriate sign provided for in the Administrative Instructions, and shall be accompanied by the citations, explanations and observations, if any, referred to in the last sentence of Article 35(2).

(b) If any of the three criteria referred to in Article 35(2) (that is, novelty, inventive step (non-obviousness), industrial applicability) is not satisfied, the statement shall be negative. If, in such a case, any of the criteria, taken separately, is satisfied, the report shall specify the criterion or criteria so satisfied.

##### 70.7 Citations under Article 35(2)

(a) The report shall cite the documents considered to be relevant for supporting the statements made under Article 35(2).

(b) The provisions of Rule 43.5(b) and (c) shall apply also to the report.

##### 70.8 Explanations under Article 35(2)

The Administrative Instructions shall contain guidelines for cases in which the explanations referred to in Article 35(2) should or should not be given and the form of such explanations. Such guidelines shall be based on the following principles:

(i) explanations shall be given whenever the statement in relation to any claim is negative;

(ii) explanation shall be given whenever the statement is positive unless the reason for citing any document is easy to imagine on the basis of consultation of the cited document;

(iii) generally, explanations shall be given if the case provided for in the last sentence of Rule 70.6(b) obtains.

##### 70.9 Non-Written Disclosures

Any non-written disclosure referred to in the report by virtue of Rule 64.2 shall be mentioned by indicating its kind, the date on which the written disclosure referring to the non-written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public.

**70.10 Certain Published Documents**

Any published application or patent referred to in the report by virtue of Rule 64.3 shall be mentioned as such and shall be accompanied by an indication of the date of publication, of its filing date, and its claimed priority date (if any). In respect of the priority date of any such document, the report may indicate that, in the opinion of the International Preliminary Examining Authority, such date has not been validly claimed.

**70.11 Mention of Amendments**

If, before the International Preliminary Examining Authority, amendments have been made, this fact shall be indicated in the report. Where any amendment has resulted in the cancellation of an entire sheet, this fact shall also be specified in the report.

**70.12 Mention of Certain Defects**

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) the international application contains any of the defects referred to in Rule 66.2(a)(iii), it shall include this opinion and the reasons therefor in the report;

(ii) the international application calls for any of the observations referred to in Rule 66.2(a)(v), it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for each opinion.

**70.13 Remarks Concerning Unity of Invention**

If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a), or the main invention only (Article 34(3)(c)), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination.

**70.14 Signature**

The report shall be signed by an authorized officer of the International Preliminary Examining Authority.

**70.15 Form**

The physical requirements as to form of the report shall be prescribed by the Administrative Instructions.

**70.16 Annexes of the Report**

If the claims, the description, or the drawings, were amended before the International Preliminary Examining Authority, each replacement sheet under Rule 66.8(a) shall be annexed to the report. Replacement sheets superseded by later replacement sheets and letters under Rule 66.8(a) shall not be annexed.

**70.17 Languages of the Report and the Annexes**

(a) The report and any annex shall be in the language in which the international application to which they relate is published.

(b) [Deleted]

**Administrative Instructions Section 604**

**Guidelines for Explanations Contained in the International Preliminary Examination Report**

Explanations under Rule 70.8 shall clearly point out to which of the three criteria 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.

After examination of the international application, if there are no negative statements and/or negative comments for Form PCT/IPEA/408, then the only statement that will issue from the International Preliminary Examining Authority will be the International Preliminary Examination Report (IPER).

The International Preliminary Examination Report is established on PCT form PCT/IPEA/409.

**ESTABLISHMENT OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

Forms PTO/IPEA/409

The following identifying information will be placed on the first page of the International Preliminary Examination Report, Form PCT/IPEA/409 and Transmittal Letter PCT/IPEA/416:

**Applicant's address** - usually the attorney's address taken from the front of the international application 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 ten characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401.

**International Application Number** - this is the 14 digit PCT application serial 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.

**Receiving Office** - this is the Office with which the international application was filed, identified on the first page of the Demand as RO/US, RO/BR, RO/BB, etc. This will normally be the United States Receiving Office, identified as RO/US.

**Priority Date Claimed** - this is the date of an earlier application of which the priority is claimed under PCT Rule 4.10. This information is typed on the international application file wrapper and can be found in Box VI of the Request (Form PCT/RO/101).

**Applicant (Name)** - this is 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.

**BASIS OF REPORT**

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.

**Amendments and/or rectifications**

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. 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.

The final Report package when sent to the PCT Branch for mailing must include copies of all amendments and rectifications entered and any cover letters to those amendments.

PATENT COOPERATION TREATY

UNITED STATES

INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA/US)

TO

John Adams  
Adams, Baker and Charlie  
1200 Marina Drive  
Baltimore, Maryland 20820

NOTIFICATION OF TRANSMITTAL OF  
INTERNATIONAL PRELIMINARY EXAMINATION REPORT  
Issued pursuant to PCT Rule 71.1

Inscribe NAME and ADDRESS of the AGENT and if  
there is no agent, of the APPLICANT

DATE OF MAILING by the International Preliminary  
Examining Authority

APPLICANTS OR AGENTS FILE REFERENCE

CMC-123

IDENTIFICATION OF THE INTERNATIONAL APPLICATION

International Application No.

PCT/US87/88888

International Filing Date

06 July 1987 (06.07.87)

Applicant (Name)

Columbia Marine Corporation

NOTIFICATION

The applicant is hereby notified that this International Preliminary  
Examining Authority transmits herewith the international preliminary  
examination report and its annexes, if any, established on the above-  
identified international application.

The attention of the applicant is drawn to the reminder contained in  
form PCT/IB/332, which he received from the International Bureau,  
concerning the time limits within which he must perform certain acts  
before each elected Office.

A copy of the report and its annexes, if any, has this same day also  
been transmitted to the International Bureau.

THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

Address Only:

Commissioner of Patents and Trademarks  
Box PCT  
Washington, D.C. 20231

ATTN: IPEA/US

Authorized Officer

*Stephen Decatur*

Stephen Decatur - Primary Examiner

**PATENT COOPERATION TREATY  
INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

<b>IDENTIFICATION OF THE INTERNATIONAL APPLICATION</b>		<b>Applicant's or Agent's File Reference</b> CNC-123																						
<b>International Application No.</b> PCT/US87/88888	<b>International Filing Date</b> 06 July 1987 (06.07.87)																							
<b>Receiving Office</b> RO/US	<b>Priority Date Claimed</b> 15 July 1986 (15.07.86)																							
<b>Applicant (Name)</b> Columbia Marine Corporation																								
<b>BASIS OF REPORT</b>																								
<p><b>1. AMENDMENTS AND/OR RECTIFICATIONS*</b> - The amendments and/or rectifications made before this International Preliminary Examining Authority in respect of the claims, the description, and/or drawings in the above-identified international application are annexed to this report.</p> <p>a. <input checked="" type="checkbox"/> This report has been established on the basis of the following application documents:</p> <table border="0"> <tr> <td><input type="checkbox"/> the application documents as filed</td> <td>as originally filed</td> </tr> <tr> <td><input checked="" type="checkbox"/> description, pages <u>1-20</u></td> <td>as originally filed</td> </tr> <tr> <td>description, pages _____</td> <td>filed with your letter of _____</td> </tr> <tr> <td>description, pages _____</td> <td>filed with your letter of _____</td> </tr> <tr> <td>description, pages _____</td> <td>filed with your letter of _____</td> </tr> <tr> <td><input checked="" type="checkbox"/> claim(s) <u>4 and 5</u></td> <td>as originally filed</td> </tr> <tr> <td>claim(s) <u>9 and 10</u></td> <td>filed with your letter of <u>15 February 1988</u></td> </tr> <tr> <td>claim(s) <u>11-13</u></td> <td>filed with your letter of <u>14 August 1988</u></td> </tr> <tr> <td>claim(s) _____</td> <td>filed with your letter of _____</td> </tr> <tr> <td><input checked="" type="checkbox"/> drawings, sheeting: <u>1-4</u></td> <td>as originally filed</td> </tr> <tr> <td>drawings, sheeting: _____</td> <td>filed with your letter of _____</td> </tr> </table> <p>b. <input checked="" type="checkbox"/> The amendments resulted in the cancellation of the following sheets: <u>pages 21 and 22</u></p> <p>c. <input type="checkbox"/> This report has been established as if the amendments indicated on the extra sheet have not been made, since, for the reasons indicated, they have been considered to go beyond the disclosure as filed.</p>			<input type="checkbox"/> the application documents as filed	as originally filed	<input checked="" type="checkbox"/> description, pages <u>1-20</u>	as originally filed	description, pages _____	filed with your letter of _____	description, pages _____	filed with your letter of _____	description, pages _____	filed with your letter of _____	<input checked="" type="checkbox"/> claim(s) <u>4 and 5</u>	as originally filed	claim(s) <u>9 and 10</u>	filed with your letter of <u>15 February 1988</u>	claim(s) <u>11-13</u>	filed with your letter of <u>14 August 1988</u>	claim(s) _____	filed with your letter of _____	<input checked="" type="checkbox"/> drawings, sheeting: <u>1-4</u>	as originally filed	drawings, sheeting: _____	filed with your letter of _____
<input type="checkbox"/> the application documents as filed	as originally filed																							
<input checked="" type="checkbox"/> description, pages <u>1-20</u>	as originally filed																							
description, pages _____	filed with your letter of _____																							
description, pages _____	filed with your letter of _____																							
description, pages _____	filed with your letter of _____																							
<input checked="" type="checkbox"/> claim(s) <u>4 and 5</u>	as originally filed																							
claim(s) <u>9 and 10</u>	filed with your letter of <u>15 February 1988</u>																							
claim(s) <u>11-13</u>	filed with your letter of <u>14 August 1988</u>																							
claim(s) _____	filed with your letter of _____																							
<input checked="" type="checkbox"/> drawings, sheeting: <u>1-4</u>	as originally filed																							
drawings, sheeting: _____	filed with your letter of _____																							
<b>2. PRIORITY?</b>																								
<p>a. This report has been established as if no priority has been claimed due to the failure to furnish within the prescribed time limit the requested:</p> <p><input type="checkbox"/> copy of the earlier application whose priority has been claimed.</p> <p><input type="checkbox"/> translation of the earlier application whose priority has been claimed.</p> <p>b. <input type="checkbox"/> This report has been established as if no priority has been claimed due to the fact that the priority claim has been found invalid.</p> <p>Thus, for the purpose of this report, the international filing date indicated above is considered to be the relevant date.</p>																								
<p>* Where replacement sheets are annexed to this report, a translation of these replacement sheets must be furnished to the elected Offices within the time limit applicable under PCT Article 39(1).</p>																								

## BASIS OF REPORT (Continued)

3. UNITY OF INVENTION<sup>3</sup> - The international application does not comply with the requirement of unity of invention.

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

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

- all parts.
- the parts relating to the restricted claims, that is claims Nos. \_\_\_\_\_
- the parts relating to the main invention, that is claims Nos. 4, 5 and 9 to 13.

4. NON-ESTABLISHMENT OF REPORT ON QUESTIONS OF NOVELTY, INVENTIVE STEP OR INDUSTRIAL APPLICABILITY<sup>4</sup>

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

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

- The description, claims, or drawings (indicate particular elements) or said claims Nos. \_\_\_\_\_ are so unclear that no meaningful opinion could be formed.
- The claims, or said claims Nos. \_\_\_\_\_ are so inadequately supported by the description that no meaningful opinion could be formed.
- Said claims Nos. \_\_\_\_\_ are dependent claims and are not drafted in accordance with the second and third sentences of PCT Rule 6.4(a).

CLASSIFICATION OF SUBJECT MATTER (If several classification symbols apply, indicate all.) <sup>6</sup>		
According to International Patent Classification (IPC) or to both National Classification and IPC		
IPC <sup>4</sup> B 63 H 25/02 // B 63 H 25/04		
U.S. Cl. 114/144C		
REASONED STATEMENT AS TO CLAIMS MEETING CRITERIA OF NOVELTY (N), INVENTIVE STEP (IS) AND INDUSTRIAL APPLICABILITY (IA) <sup>5</sup> AND CITATIONS <sup>7</sup> AND EXPLANATIONS <sup>8</sup> SUPPORTING SUCH STATEMENT		
CLAIM NUMBER	STATEMENT (CRITERIA)	CITATIONS AND EXPLANATIONS
4, 5, 9, 10	Yes (N) Yes (IS) Yes (IA)	<p>Claims 4, 5, 9 and 10 meet the criteria of PCT Article 33(1) because the combination claimed consisting of a sailboat with a rudder positioned forward of the keel and a wind controlled vane electronically connecting the forward rudder and the wind vane to maintain course direction within 2 degrees of the desired course is not shown in the prior art.</p> <p style="text-align: center;"><u>New citation</u></p> <p>US, A, 1,846,458 ROBINSON, 23 February 1932, (23.02.32) (See figures 2 and 4)</p>
11-13	Yes (N) Yes (IA) No (IS)	<p>Claims 11-13 lack an inventive step under PCT Article 33(3) as being obvious over DAW in view of ROBINSON. To control the forward rudder of Daw with a wind vane located at the opposite end of the sailboat as in ROBINSON would not involve an inventive step.</p>

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NON-WRITTEN DISCLOSURES <sup>8</sup>			
Kind of Non-Written Disclosure	Date of Written Disclosure relating to the Non-Written Disclosure	Date of Non-Written Disclosure	
CERTAIN PUBLISHED DOCUMENTS <sup>10</sup>			
Application/Patent	Date of Publication	Filing Date	Priority Date (Valid Claim)
CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION <sup>11</sup>			
<p>The following defects in the form or contents of the international application have been noted.</p> <p>Page 5, line 8, "victor" should be "vector".</p> <p>In figure 2 of the drawings, the lead line for reference numeral 6 should be directed to the tiller rather than the boom.</p>			
CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION <sup>12</sup>			
<p>The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description have been noted.</p>			
CERTIFICATION			
Date Demand Submitted		Date of Completion of the International Preliminary Examination Report	
10 February 1988 (10.02.88)		10 October 1988 (10.10.88)	
International Preliminary Examining Authority		Signature of Authorized Officer	
IPEA/US		 Stephen Decatur-Primary Examiner	

Form PCT/IPEA409 (last sheet) (January 1985)

See notes on accompanying sheet

**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 (1) a copy of the earlier application whose priority has been claimed, or (2) a translation of the earlier application, where the priority claim has been found invalid (PCT Rule 17), or where the priority claim has been withdrawn.

**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 place the indications on Boxes 3(a) and (b) of the supplemental sheet, indicating 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 on Box 3(c) 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 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.

#### **NON-ESTABLISHMENT OF REPORT REGARDING ALL OR PART OF THE APPLICATION ON QUESTIONS OF 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 4 on the supplemental sheet of 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.

**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 top of the Continuation Sheet.

#### **REASONED STATEMENT AS TO CLAIMS MEETING CRITERIA OF NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY AND CITATIONS AND EXPLANATIONS SUPPORTING SUCH STATEMENT**

The examiner must indicate on the Continuation Sheet whether each claim appears to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability by placing the words "YES" or "NO" in the column labeled "Statement"/(Criteria). 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. The citation of documents should be in accordance with Administrative Instructions Section 503.

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.

#### **NON-WRITTEN DISCLOSURES AND/OR CERTAIN PUBLISHED DOCUMENTS**

If the examiner has discovered or the International Search Report has cited, a relevant document which refers to a non-written disclosure, and the document was only published on or after the relevant date of the international application, the examiner must indicate at the top of the last sheet of the International Preliminary Examination Report:

- (i) the date on which the document was made available to the public;
- (ii) 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:

- (i) its date of publication;
- (ii) 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 64.3).

Guidelines explaining to the examiner the manner of indi-

be cited in the International Preliminary Examination Report as well as the manner of indicating the claims to which the documents cited in such Report are relevant are set forth in Administrative Instruction Section 507(c), (d), and (e).

### CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION AND OBSERVATIONS ON THE INTERNATIONAL APPLICATION

If, in the opinion of the examiner, defects exist in the form or contents of the international application, the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description has 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.

### CERTIFICATION

When completing the certification of the Report, the examiner must indicate the date on which the Demand for International Preliminary Examination was submitted and the date on which the examiner completed the Report and the name of the International Preliminary Examining Authority.

These last mentioned items may either be completed when including the other data or when completing the certification. Every International Preliminary Examination Report must be signed by a Primary Examiner.

### 1898.04(c) Time Limit for Preparing Report [R-5]

#### PCT Rule 69

#### Time Limit for International Preliminary Examination

##### 69.1 Time Limit for International Preliminary Examination

(a) The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;

(ii) nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

(b) International preliminary examination shall start upon receipt, by the International Preliminary Examining Authority:

(i) under Rule 62.2(a), of the claims as amended under Article 19, or

(ii) under Rule 62.2(b), of a notice from the International Bureau that no amendments under Article 19 have been filed within the prescribed time limit or that the applicant has declared that he does not wish to make such amendments, or

(iii) of a notice, after the international search report is in the possession of the International Preliminary Examining Authority, from the applicant expressing the wish that the international preliminary examination should start and be directed to the claims as specified in such notice, or

(iv) of a notice of the declaration by the International Searching Authority that no international search report will be established (Article 17(2)(a)).

(c) 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, start at the same time as the international search. In such a case, the international preliminary

examination report shall be established, notwithstanding the provisions of paragraph (a), no later than six months after the expiration of the time limit allowed under Article 19 for amending the claims.

### 1898.04(d) Transmittal of the International Preliminary Examining Report [R-5]

#### 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) Any International Preliminary Examining Authority not wishing to send copies direct to any elected Office shall send a copy to the International Bureau and the International Bureau shall then proceed as provided in paragraphs (a) and (b).

(d) Any International Preliminary Examining Authority may perform the obligations referred to in (a) to (c) through another agency responsible to it.

The following identifying information will be placed on the top of the first page of Form PCT/IPEA/416:

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 ten characters. This reference may be found in the upper right hand box on the first sheet of the Demand, Form PCT/IPEA/401.

International Application Number - this is the 14 digit PCT application serial number as stamped and typed on the 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 application file wrapper and may also be found on the first page of the Demand, Form PCT/IPEA/401.

Applicant (Name) - this is the first named applicant as set forth on the application file wrapper and may also be found in box II of the Demand, Form PCT/IPEA/401.

AUTHORIZED OFFICER

Form PCT/IPEA/416 must be signed by a primary examiner.

**1898.04(e) Translations [R-5]**

**PCT Article 36**

**Transmission, 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.

\*\*\*\*\*

**PCT Rule 72**

**Translation of the International Preliminary Examination Report**

**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, French, German, Japanese, Russian, or Spanish.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

**72.2 Copies of Translations for the Applicant**

The International Bureau shall transmit a copy of each translation 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.

**72.3 Observations on the Translation**

The applicant may make written observations on what, in his opinion, are errors of translation of the international preliminary examination report and shall send a copy of any such observation to each of the interested elected Offices and a copy to the International Bureau.

**1898.04(f) Confidential Nature of the Report [R-5]**

**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 nonwithdrawal of the demand or of any election.

**1898.05(a) Withdrawal of Demand or Election [R-5]**

**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 75**

**Withdrawal of the Demand, or of Elections**

**75.1 Withdrawals**

(a) Withdrawal of the Demand or all the elections may be effected prior to the expiration of 30 months from the priority date except as to any elected State in which national processing or examination has already started. Withdrawal of the election of any elected State may be effected prior to the date on which examination and processing may start in that State.

(b) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

**75.2 and 75.2 [Deleted]**

**75.4 Faculty under Article 37(4)(b)**

(a) Any Contracting State wishing to take advantage of the faculty provided for in Article 37(4)(b) shall notify the International Bureau in writing

(b) The notification under 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 publication date of the relevant issue of the Gazette.

**Administrative Instructions Section 606**

**Cancellation of Elections**

The International Preliminary Examining Authority shall, if the election is in the demand, cancel ex officio the election of any State which is not a designated State or which is not bound by Chapter II of the Treaty, shall enclose that election within square brackets, shall enter, in the margin, the words "CANCELLED EX OFFICIO BY IPPEA" or their equivalent in the language of publication of the international application, and shall notify the applicant accordingly.

Any withdrawal of the demand or any election must be sent to the International Bureau.

**1898.06(a) Receipt of Notice of Election by the Patent and Trademark Office [R-5]**

**PCT Rule 61**

**Notification of the Demand and Election**

\*\*\*\*\*

**61.2 Notification to the Elected Offices**

(a) The notification provided for in Article 31(7) shall be effected by the International Bureau.

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the name of the receiving Office, the filing date of the application whose priority is claimed (where priority is claimed), the date of receipt by the International Preliminary Examining Authority of the demand, and - in the case of later elections - the date of receipt by the International Bureau of the later election.

(c) The notification shall be sent to the elected Office promptly after the expiration of the 18th month from the priority date, or, if the international preliminary examination report is communicated earlier, then, at the same time as the communication of that report. Elections effected after such notification shall be notified promptly after they have been effected.

**61.3 Information for the Applicant**

The International Bureau shall inform the applicant in writing that it has effected the notification referred to in Rule 61.2. At the same time, it shall indicate to him, in respect of each elected State, any applicable time limit under Article 39(1)(b).

All notices of election are received by the PCT Division from the International Bureau. The PCT Division 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.

### 1898.06(b) Receipt of the International Preliminary Examination Report from the International Bureau [R-5]

#### PCT Article 36 Transmittal, Translation, and Communication, of the International Preliminary Examination Report

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(3)(a) The international preliminary examination report, together with its translation (as prescribed) and its annexes (in the original language), shall be communicated by the International Bureau to each elected Office.

\*\*\*\*\*

#### PCT Rule 73 Communication of the International Preliminary Examination Report

##### 73.1 Preparation of Copies

The International Bureau shall prepare the copies of the documents to be communicated under Article 36(3)(a).

##### 73.2 Time Limit for Communication

The communication provided for in Article 36(3)(a) shall be effected as promptly as possible.

The International Bureau will forward to the Patent and Trademark Office copies of all International Preliminary Examination Reports in international applications in which the United States of America has been elected. The Reports are processed by the PCT Division and are forwarded for national processing when the requirements for entering the national stage have been fulfilled.

### 1898.07(a) Entering the National Stage under Chapter II [R-5]

#### PCT Article 36 Transmittal, Translation, and Communication, of the International Preliminary Examination Report

\*\*\*\*\*

(3)(b) The prescribed translation of the annexes shall be transmitted within the prescribed time limit by the applicant to the elected Office.

\*\*\*\*\*

#### PCT Article 39 Copy, Translation, and Fee, to Elected Offices

(1)(a) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date.

(b) Any national law may, for performing the acts referred to in subparagraph (a), fix time limits which expire later than the time limit provided for in that subparagraph.

(2) The effect provided for in Article 11(3) shall cease in the elected State with the same consequences as the withdrawal of any national application in that State if the applicant fails to perform the acts referred to in paragraph (1)(a) within the time limit applicable under paragraph (1)(a) or (b).

(3) Any elected Office may maintain the effect provided for in Article 11(3) even where the applicant does not comply with the requirements provided for in paragraph (1)(a) or (b).

#### PCT Rule 74

#### Translation of Annexes of the International Preliminary Examination Report and Transmittal Thereof

##### 74.1 Contents of Translation and Time Limit for Transmittal Thereof

Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), transmit a translation of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report. The same time limit shall apply where the furnishing of a translation of the international application to the elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

The statutory requirements for entering the national stage in the United States are set forth in 35 U.S.C. 371.

#### >37 CFR 1.495 Entering the national stage in the United States of America as an Elected Office

(a) Where a Demand has been filed with an appropriate International Preliminary Examining Authority and not withdrawn by the expiration of 19 months from the priority date, the applicant must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraph (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. 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) The applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 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;

(2) a translation of the international application into the English language, if it was originally filed in another language;

(3) the basic national fee (see § 1.492(a)); and

(4) an oath or declaration of the inventor (see § 1.497).

(c) The applicant may furnish any required English translation of the international application, the basic national fee and the oath or declaration of the inventor after 30 months but not later than the expiration of 32 months from the priority date. 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 30 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the basic national fee or the oath or declaration of the inventor later than the expiration of 30 months after the priority date.

(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 30 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 30 months from the priority date will be considered to be cancelled.

(e) A translation into English of any annexes to the international preliminary examination report, if the annexes were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Translations of the annexes which are not received by the expiration of 30 months from the priority date may be submitted within 32 months from the priority date accompanied by the processing fee set forth in § 1.492(f). Translations of the annexes which are not timely received will be considered to be cancelled.

(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 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.

(h) The time limits set out in paragraphs (b), (c), (d) and (e) of this section may not be extended pursuant to § 1.136 or otherwise.

may not be extended pursuant to §1.136 or otherwise.

(i) An international application becomes abandoned as to the United States 30 months from the priority date if a copy of the international application is not communicated to the Patent and Trademark Office prior to 30 months from the priority date and a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of 19 months from the priority date. If a copy of the international application is communicated within 30 months to the Patent and Trademark Office, an international application will become abandoned as to the United States 32 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 32 months from the priority date.

>1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application, if the inventor, desires to enter the national stage under 35 U.S.C. 371 pursuant to §1.494 or §1.495, he or she must file an oath or declaration in accordance with §1.63.

(b) If the international application was made as provided in §1.422, 1.423 or 1.425, the applicant shall state his or her relationship to the inventor and, upon information and belief, the facts which the inventor is required by §1.63 to state.

See also MPEP § 1890 for fees and explanation of requirements.

**1898.07(b) National Stage Amendments [R-5]**

**PCT Article 41**

**Amendment of the Claims, the Description, and the Drawings, before Elected Offices**

(1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each elected Office within the prescribed time limit. No elected Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired, except with the express consent of the applicant.

(2) The amendments shall not go beyond the disclosure in the international application as filed, unless the national law of the elected State permits them to go beyond the said disclosure.

(3) The amendments shall be in accordance with the national law of the elected State in all respects not provided for in this Treaty and the Regulations.

(4) Where an elected Office requires a translation of the international application, the amendments shall be in the language of the translation.

**PCT Article 42**

**Results of National Examination in Elected Offices**

No elected Office receiving the international preliminary examination report may require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same international application in any other elected Office.

**PCT Rule 76**

**Copy, Translation and Fee under Article 39(1); Translation of Priority Document**

76.1, 76.2 and 76.3 [Deleted]

**76.4 Time Limit for Translation of Priority Document**

The applicant shall not be required to furnish to any elected Office a certified translation of the priority document before the expiration of the applicable time limit under Article 39.

**76.5 Application of Rules 22.1(g), 49 and 51<sup>bis</sup>**

Rules 22.1(g), 49 and 51<sup>bis</sup> shall apply, provided that:

(i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) any reference in the said Rules to Article 22 shall be construed as a reference to Article 39(1).

(iii) the words "international applications filed" in Rule 49.1(c) shall be replaced by the words "a demand submitted."

**PCT Rule 77**

**Faculty under Article 39(1)(b)**

**77.1 Exercise of Faculty**

(a) Any Contracting State allowing a time limit expiring later than the time limit provided for in Article 39(1)(a) shall notify the International Bureau of the time limit so fixed.

(b) Any notification received by the International Bureau under paragraph (a) shall be promptly published by the International Bureau in the Gazette.

(c) Notification concerning the shortening of the previously fixed time limit shall be effective in relation to demands submitted after the expiration of three months computed from the date on which the notification was published by the International Bureau.

(d) Notification concerning the lengthening of the previously fixed time limit shall become effective upon publication by the International Bureau in the Gazette in respect of demands pending at the time or submitted after the date of such publication, or, if the Contracting State effecting the notification fixes some later date, as from the latter date.

**PCT Rule 78**

**Amendment of the Claims, the Description, and the Drawings, before Elected Offices**

**78.1 Time Limit Where Election Is Effected prior to Expiration of 19 Months from Priority Date.**

(a) Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the applicant shall, if he so wishes, exercise the right under Article 41 after the transmittal of the international preliminary examination report under Article 36(1) has been effected and before the time limit applicable under Article 39 expires, provided that, if the said transmittal has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than on such expiration date. In either case, the applicant may exercise the said right at any time if so permitted by the national law of the said State.

(b) In any elected State in which the national law provides that the examination starts only on special request, the national law may provide that the time limit within or the time at which the applicant may exercise the right under Article 41 shall, where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under Article 39.

**78.2 Time Limit Where Election Is Effected after Expiration of 19 Months from Priority Date**

Where the election of any Contracting State has been effected after the expiration of the 19th month from the priority date and the applicant wishes to make amendments under Article 41, the time limit for making amendments under Article 28 shall apply.

**78.3 Utility Models**

The provisions of Rules 6.5 and 13.5 shall apply, mutatis mutandis, before elected Offices. If the election was made before the expiration of the 19th month from the priority date, the reference to the time limit applicable under Article 22 is replaced by a reference to the time limit applicable under Article 39.

Under §§ 1.494 and 1.495, applicants must indicate on all application papers filed for entry into the national stage in the United States under 35 U.S.C. 371 that the filing is being made under 35 U.S.C. 371. Otherwise the application papers will be treated under 35 U.S.C. 111.

37 CFR 1.492(a)(4) and 1.496(b) provide for a substantially reduced national fee and special procedure, respectively, where the application has satisfied the requirements of novelty, inventive step (non-obviousness) and industrial applicability before the United States International Preliminary Examining Authority as to the identical claims which are in the application at the national stage in the Patent and Trademark Office. Amendments during subsequent prosecution will only be permitted in response to an examiner's rejections or objections. Thus, no new claims are permitted. Therefore, most of such cases will require little or no prosecution to satisfy the require-

ments for patentability.

The Patent and Trademark Office considers the international application pending as to the United States where it has been designated until the 22nd month from the priority date and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and pending until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within 20 or 30 months of the priority date respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period, respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of §1.494 and as paragraph (i) of § 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application.

### 1898.07(c) Unity of Invention during the National Stage [R-5]

#### 37 CFR 1.499 Unity of invention during the national stage.

(a) An international application which has entered the national stage by meeting the requirements of 35 U.S.C. 371 will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see §1.475(f)).

(b) An application in the national stage 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 combinations as set forth in PCT Rule 13.2 (see §1.475(f)) or to the combination of

- (1) a product and a process for the manufacture of said product or
- (2) a product and a process of use of said product.

If an application contains claims to more or less than one of the combinations of categories of invention set forth in PCT Rule 13.2 (see §1.475(f)) or combination set forth in paragraphs (b)(1) and (2) of this section, unity of invention may not be present.

(c) If an application in the national stage contains claims to a category of invention in addition to those categories included in any one of the combinations specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.

(d) Unity of invention will exist in an application in the national stage where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see §1.475(f)) or a combination set forth in paragraphs (b)(1) or (2) of this section. 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 elected invention to be examined. Any such holding of an election by the examiner will be made in the form of a restriction requirement which confirms the election made by the presentation of claims. Such a restriction requirement would be made on the basis of whether the inventions are independent and distinct. Applicant has the right to traverse such a restriction requirement in the response to the Office action in which the election is indicated.

(e) The inventions recited by the claims of different categories must be related rather than independent inventions.

(f) If the examiner finds that a national stage application lacks unity of invention, the examiner may in an Office action require the applicant in the response to that Office action to elect the invention to which the claims shall be restricted, this official action being called a requirement for restriction. 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.

The unity of invention practice set forth in PCT Rule 13 will be applied in national stage applications entered under 35 U.S.C. 371 because 35 U.S.C. 372(b) provides that, "The Commissioner may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations." However, continuing applications filed under 35 U.S.C. 111 of the international applications under the provisions of 35 U.S.C. 365(c) will be subject to the same restriction practice as other United States national applications filed under 35 U.S.C. 111. Where several inventions have been searched in the parent international application, the examination of such inventions in a continuing national application may not be burdensome and the examiner may consider all the inventions in such an application without making a restriction requirement.

See also MPEP § 1868 for explanation of Unity of Invention requirements.

### 1898.08(a) National Stage Processing [R-5]

#### PCT Article 33

#### The International Preliminary Examination

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(5) The criteria described above merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purpose of deciding whether, in that State, the claimed invention is patentable or not.

(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 Article 40

#### Delaying of National Examination and Other processing

(1) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 23 shall not apply to such State and the national Office of or acting for that State shall not proceed, subject to the provisions of paragraph (2), to the examination and other processing of the international application prior to the expiration of the applicable time limit under Article 39.

(2) Notwithstanding the provisions of paragraph (1), any elected Office may, on the express request of the applicant, proceed to the examination and other processing of the international application at any time.

#### >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.<

The unity of invention practice set forth in PCT Rule 13 will be applied in national stage applications under 35 U.S.C. 371 because 35 U.S.C. 372(b)(2) provides that, "The Commissioner

may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations." However, continuing applications filed under 35 U.S.C. 111 of international applications under the provisions of 35 U.S.C. 365(c) will be subject to the same restriction as other national applications filed under 35

U.S.C. 111. However, it is noted that where several inventions have been searched in the parent international application, the examination of such inventions in a continuing national application may not be burdensome and the examiner may consider all the inventions in such an application without making a restriction requirement.