# Chapter 1800 Patent Cooperation Treaty

## INTRODUCTION [R-07.2022]

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

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

PCT applications are processed by the Office of PCT Operations within the U.S. Patent and Trademark Office.

# 1801 Basic Patent Cooperation Treaty (PCT) Principles [R-01.2024]

## I. MAJOR CONCEPTS OF THE PCT

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

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

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

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

## II. RECEIVING OFFICE (RO)

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

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

The international application is subject to the payment of certain fees within 1 month from the date of receipt. See PCT Rules 14.1(c), 15.3, and 16.1(f). The receiving Office will grant an international filing date to the application, collect fees, handle informalities by direct communication with the applicant, and monitor all corrections (35 U.S.C. 361(d)). By 13 months from the priority date, the receiving Office should prepare and transmit a copy of the international application, called the search copy (SC), to the International Searching Authority (ISA); and forward the original, called the record copy (RC), to the International Bureau (IB) (PCT Rules 22.1 and 23). A second copy of the international application, the home copy (HC), remains in the receiving Office (PCT Article 12(1)). Once the receiving Office has transmitted copies of the application, the International Searching Authority becomes the focus of international processing.

## III. INTERNATIONAL SEARCHING AUTHORITY (ISA)

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

For most applications filed with the United States Receiving Office, the applicant may choose (in the Request form) the U.S. Patent and Trademark Office, the European Patent Office, the Korean Intellectual Property Office, the Australian Patent Office (IP Australia), the Israel Patent Office (ILPO), the Japan Patent Office (JPO), or the Intellectual Property Office of Singapore (IPOS) to act as the International Searching Authority. However, IP Australia and JPO may not be competent to act as an International Searching Authority for certain applications filed by nationals or residents of the United States. See MPEP §§ 1840.01 - 1840.07. The International Searching Authority is also responsible for checking the content of the title and abstract (PCT Rules 37.2 and 38.2).

An international search report (ISR) and written opinion will normally be issued by the International Searching Authority within 3 months from the receipt of the search copy (usually about 16 months after the priority date) (PCT Rule 42). Copies of the international search report and prior art cited will be made available to the applicant by the ISA (PCT Rules 43 and 44.1). The international search report will contain a listing of documents found to be relevant and will identify the claims in the application to which they are pertinent. The written opinion indicates whether each claim appears to satisfy the PCT Article 33 criteria of "novelty," "inventive step," and "industrial applicability." The written opinion may also indicate defects in the form or content of the international application under the PCT articles and regulations, as well as any observations the ISA wishes to make on the clarity of the claims, the description, and the drawings, or on the question of whether the claims are fully supported by the description.

Once the international search report and written opinion are established, the ISA transmits one copy of each to the applicant and the International Bureau, and international processing continues before the International Bureau. If a Demand for Chapter II examination is not timely filed, the International Bureau communicates a copy of the written opinion established by the ISA (retitled International Preliminary Report on Patentability (Chapter I of the PCT)) to each designated Office after the expiration of 30 months from the priority date.

## IV. 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, 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, or

requested the International Bureau to obtain a copy of the earlier application from a digital library, the applicant must submit such a document directly to the International Bureau or the receiving Office not later than 16 months after the priority date (PCT Rule 17). The request (Form PCT/RO/101) contains a box which can be checked requesting the receiving Office to prepare and transmit a copy of a prior application. This is only possible, of course, if the receiving Office is a part of the same national Office where the priority application was filed. The request (Form PCT/RO/101) also contains a box which can be checked requesting the International Bureau to obtain a copy of the earlier application from a digital library. This is only possible if the application is registered in a digital library, made available to the International Bureau within the prescribed time limit, as set forth in PCT Rule 17.1(b- *bis*), and the access code is furnished to the International Bureau.

The applicant has normally 2 months from the date of transmittal of the international search report to amend the claims by filing an amendment and may file a brief statement explaining the amendment directly with the International Bureau (PCT Article 19 and PCT Rule 46). The International Bureau will then normally publish the international application along with the search report and any amended claims at the expiration of 18 months from the priority date (PCT Article 21). For applications filed before July 1, 2014, former PCT Rule 44 *ter* provided that the written opinion of the ISA would not be made publicly available until the expiration of 30 months from the priority date. For applications filed on or after July 1, 2014, the written opinion of the ISA and any informal comments submitted by the applicant are made available to the public in their original language as of the publication date. The international publication includes a front page containing bibliographical data, the abstract, and a figure of the drawing (PCT Rule 48). The publication also contains the search report and any amendments to the claims submitted by the applicant. If the application is published in a language other than English, the search report and abstract are also published in English. The International Bureau publishes a *PCT Gazette* in the French and English languages which contains information similar to that on the front pages of published international applications, as well as various indexes and announcements (PCT Rule 86). The International Bureau also communicates copies of the publication of the international application to all designated Offices that have requested to receive the publication (PCT Article 20, PCT Rule 47, and PCT Rule 93 *bis*.1).

## V. DESIGNATED OFFICE (DO) and ELECTED OFFICE (EO)

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

PCT Article 22(1) was amended, effective April 1, 2002, to specify that a copy of the international application, a translation thereof (as prescribed), and the national fee are due to the designated Office not later than at the expiration of 30 months from the priority date. Accordingly, the time period for filing the copy of the international application, the translation, and the fee under PCT Article 22 is the same as the 30 month time period set forth in PCT Article 39. The USPTO has adopted the 30 month time limit set forth in PCT Article 22(1). Most Contracting States have changed their national laws for consistency with PCT Article 22(1) as amended. An up-to-date listing of Contracting States that have adopted Article 22(1) as amended is maintained at WIPO's website at **www.wipo.int/pct/en/texts/time_limits.html**. At the time of publication of this Chapter, only two countries have not adopted Article 22(1) as amended: Luxembourg (LU) and the United Republic of Tanzania (TZ). It is noted that Luxembourg is included in the regional designation "EPO" and that the United Republic of Tanzania is included in the regional designation "ARIPO." For those two remaining Contracting States that have not adopted Article 22(1) as amended, if no "Demand" for international preliminary examination has been filed within 19 months of the priority date, the applicant may be required to complete the requirements for entering the national stage within 20 months from the priority date of the international application in the national offices of those states. When entering the national stage following Chapter I or Chapter II, the applicant has the right to amend the application within the time limit set forth in PCT

Rule 52.1 or PCT Rule 78.1, respectively. After this time limit has expired (PCT Article 28 or PCT Article 41 and PCT Rule 52 or PCT Rule 78), each designated/elected Office will make its own determination as to the patentability of the application based upon its own specific national or regional laws (PCT Article 27(5)).

If the applicant desires to obtain the benefit of delaying the entry into the national stage until 30 months from the priority date in one or more countries where the 30 month time limit set forth in PCT Article 22(1) as amended does not apply, a Demand for international preliminary examination must be filed with an appropriate International Preliminary Examining Authority (IPEA) within 19 months of the priority date.

Those states in which the Chapter II procedure is desired must be "elected" in the Demand.

PCT Rule 54 *bis*.1 requires the Demand to be made prior to the expiration of whichever of the following periods expires later:

(A) three months from the date of transmittal to the applicant of the international search report or of the declaration referred to in PCT Article 17(2)(a), and of the written opinion under PCT Rule 43 *bis*.1; or

(B) 22 months from the priority date.

However, applicant may desire to file the Demand by 19 months from the priority date to extend the national stage entry deadline in Luxembourg and the United Republic of Tanzania.

The original Demand is forwarded to the International Bureau by the IPEA. The International Bureau then notifies the various elected Offices that the applicant has entered Chapter II and sends a copy of any amendments filed under PCT Article 19 and any statement explaining the amendments and the basis for the amendments to the IPEA. See PCT Rule 62. The International Bureau also sends the IPEA a copy of the written opinion established by the International Searching Authority (ISA) unless the ISA is also acting as the IPEA. See PCT Rule 62.1(i).

## VI. INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA)

The International Preliminary Examining Authority (IPEA) normally starts the examination process when it is in possession of:

(A) the Demand;

(B) the amount due;

(C) a translation, if the applicant is required to furnish a translation under PCT Rule 55.2;

(D) either the international search report or a notice of the declaration by the International Searching Authority (ISA) that no international search report will be established; and

(E) the written opinion established under PCT Rule 43 *bis*.1.

The IPEA shall start the international preliminary examination upon receipt of the above materials unless the applicant expressly requests to postpone the start of the international preliminary examination until the expiration of the later of three months from the transmittal of the international search report (or declaration that no international search report will be established) and written opinion; or the expiration of 22 months from the priority date, with the exception of the situations provided for in PCT Rule 69.1(b) - (e).

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

The IPEA establishes the international preliminary examination report (entitled "international preliminary report on patentability"), which presents the examiner's final position as to whether each claim is "novel," involves "inventive step," and is "industrially applicable" by 28 months from the priority date. A copy of the international preliminary examination report is sent to the applicant and to the International Bureau. The International Bureau then

communicates a copy of the international preliminary examination report to each elected Office.

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

A listing of all national and regional offices, and the corresponding time limits for entering the national stage after PCT Chapter I and PCT Chapter II, may be found on WIPO's website at: **www.wipo.int/pct/en/texts/time_limits.html**.

## 1802 PCT Definitions [R-07.2015]

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

## 1803 Reservations Under the PCT Taken by, and Notifications of Incompatibility Made by, the United States of America [R-07.2022]

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

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

The U.S. Receiving Office continues to accept applications only in English. See 35 U.S.C. 361(c). PCT Rules 20.1(c), 26.3 *ter*(a) and 26.3 *ter*(c) permit an international filing date to be accorded even though portions of an international application are in a language not acceptable to the Receiving Office. PCT Rules 20.1(c), 26.3 *ter*(a) and 26.3 *ter*(c) are not compatible with the national law applied by the United States Patent and Trademark Office (USPTO) as receiving Office. Thus, the USPTO has made a notification of incompatibility with respect to these rules pursuant to PCT Rules 20.1(d), 26.3 *ter*(b) and 26.3 *ter*(d). As a result, PCT Rules 20.1(c), 26.3 *ter*(a) and 26.3 *ter*(c) shall not apply to the USPTO as receiving Office for as long as the aforementioned incompatibility exists.

PCT Rules 49.5(c- *bis*) and 49.5(k) continue not to be compatible with the national law applied by the USPTO as a designated Office. See 35 U.S.C. 371(c)(2). As a result, PCT Rules 49.5(c -*bis*) and 49.5(k) shall not apply to the USPTO as designated Office for as long as the aforementioned incompatibility exists.

For complete PCT reservations, declarations, notifications and incompatibilities, please see the International Bureau's notice published on the WIPO website at: **www.wipo.int/pct/en/texts/reservations/res_incomp.html**.

## 1804 [Reserved]

## 1805 Where To File an International Application [R-01.2024]

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

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

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See MPEP § 1806 as to who can file an international application.

Only if at least one of the applicants is a resident or national of the United States of America may an international application be filed in the United States Receiving Office. See PCT Article 9(1) and (3), PCT Rules 19.1 and 19.2, 35 U.S.C. 361(a) and 37 CFR 1.412(a) and 1.421. The concepts of residence and nationality are defined in PCT Rule 18.1.

International applications may be filed electronically through the USPTO patent electronic filing system. International applications and related papers may also be deposited with the United States Receiving Office by addressing the papers to "Mail Stop PCT" and hand-delivering them to the Office. See MPEP § 501, subsection III for information regarding hand-delivery of papers. The mailing address for delivery by the U.S. Postal Service is: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. It should be noted that the Priority Mail Express® provisions of 37 CFR 1.10 apply to the filing of all applications and papers filed in the U.S. Patent and Trademark Office, including PCT international applications and related papers and fees. It should be further noted, however, that PCT international applications and papers relating to international applications are specifically excluded from the Certificate of Mailing or Transmission procedures under 37 CFR 1.8. See MPEP § 1834, subsection III. If 37 CFR 1.8 is improperly used, the date to be accorded the paper will be the date of actual receipt in the Office unless the receipt date falls on a Saturday, Sunday, or federal holiday in which case the date of receipt will be the next succeeding day which is not a Saturday, Sunday, or federal holiday (37 CFR 1.6).

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

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

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

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

and the application will be forwarded to the International Bureau as Receiving Office so long as the necessary fee is paid. The fee is an amount equal to the transmittal fee.

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

Any applicant who is a resident or national of a PCT Contracting State may also file their application directly with the International Bureau as receiving Office. An applicant may wish to consider filing directly with the International Bureau as receiving Office instead of the United States Receiving Office in the situation where applicant is filing their international application after the expiration of the 12 month priority period but within two months of the expiration of the priority period, and where applicant desires to request restoration of the right of priority under the in spite of due care standard. See MPEP § 1828.01. An applicant may also request that an application be forwarded to the International Bureau for processing in its capacity as receiving Office in accordance with PCT Rule 19.4(a)(iii) in situations where the international application was filed with the United States Receiving Office after the expiration of the 12 month priority period but within two months of the expiration of the priority period, and where applicant desires to request restoration of the right of priority under the in spite of due care standard. However, any transfer request received after substantial processing of the international application by the United States Receiving Office has occurred may be declined.

An international application filed with, or forwarded to, the International Bureau must have a foreign filing license unless: (1) the invention was not made in the United States; or (2) a U.S. national application on the invention was filed at least six months prior to the filing of the international application, the U.S. national application is not subject to a secrecy order under 37 CFR 5.2, and the international application does not contain modifications, amendments, or supplements changing the general nature of the invention in a manner that would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181. See 37 CFR 5.11 and 5.15.

## 1806 Applicants and Inventors [R-07.2015]

Any resident or national of a Contracting State may file an international application. See PCT Article 9 and PCT Rule 18. The applicant can be an individual, corporate entity or other concern. Where there are two or more applicants, at least one of them must be a national or a resident of a Contracting State.

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

Where the inventor is not the applicant, indications concerning the inventor must nevertheless be made in the Request 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 (PCT Rule 4.1(a)(iv)). See PCT Applicant's Guide, International Phase, Annexes B1 and B2, for those States and regional patent systems which require such indications. Furthermore, information concerning the inventor is required by most countries for the national phase. In such a case, the check-box "inventor only" should be marked, the inventor's name and address indicated in Box No. III, and the inventor's residence and nationality omitted.

### I. APPLICANT FOR PURPOSES OF THE UNITED STATES IN INTERNATIONAL APPLICATIONS HAVING AN INTERNATIONAL FILING DATE ON OR AFTER SEPTEMBER 16, 2012

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

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 on or after September 16, 2012]

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office. If an international application does not include an applicant who is indicated as being a resident or national of the United States of America, and at least one applicant:

(1) Has indicated a residence or nationality in a PCT Contracting State, or

(2) Has no residence or nationality indicated, applicant will be so notified and, if the international application includes a fee amount equivalent to that required by § 1.445(a)(4), the international application will be forwarded for processing to the International Bureau acting as a Receiving Office (see also § 1.412(c)(6)).

(b) Although the United States Receiving Office will accept international applications filed by any applicant who is a resident or national of the United States of America for international processing, for the purposes of the designation of the United States, an international application will be accepted by the Patent and Trademark Office for the national stage only if the applicant is the inventor or other person as provided in § 1.422 or § 1.424. Joint inventors must jointly apply for an international application.

(c) A registered attorney or agent of the applicant may sign the international application Request and file the international application for the applicant. A separate power of attorney from each applicant may be required.

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

(e) Requests for changes in the indications concerning the applicant, agent, or common representative of an international application shall be made in accordance with PCT Rule 92 *bis* and may be required to be signed by all applicants.

(f) Requests for withdrawals of the international application, designations, priority claims, the Demand, or elections shall be made in accordance with PCT Rule 90 *bis* and must be signed by all applicants. A separate power of attorney from the applicants will be required for the purposes of any request for a withdrawal in accordance with PCT Rule 90 *bis* which is not signed by all applicants.

***37 CFR 1.422 Legal representative as applicant in an international application.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 on or after September 16, 2012]

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may be an applicant in an international application which designates the United States of America.

## II. APPLICANT FOR PURPOSES OF THE UNITED STATES IN INTERNATIONAL APPLICATIONS HAVING AN INTERNATIONAL FILING DATE BEFORE SEPTEMBER 16, 2012

***37 CFR 1.421 (pre-AIA) Applicant for international application.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 before September 16, 2012]

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office. If an international application does not include an applicant who is indicated as being a resident or national of the United States of America, and at least one applicant:

(1) Has indicated a residence or nationality in a PCT Contracting State, or

(2) Has no residence or nationality indicated, applicant will be so notified and, if the international application includes a fee amount equivalent to that required by § 1.445(a)(4), the international application will be forwarded for processing to the International Bureau acting as a Receiving Office (see also § 1.412(c)(6)).

(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, for the purposes of the designation of the United States, an international application must be filed, and 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 or 1.423. Joint inventors must jointly apply for an international application.

(c) For the purposes of designations other than the United States, international applications may be filed by the assignee or owner.

(d) A registered attorney or agent of the applicant may sign the international application Request and file the international application for the applicant. A separate power of attorney from each applicant may be required.

(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) Requests for changes in the indications concerning the applicant, agent, or common representative of an international application shall be made in accordance with PCT Rule 92 *bis* and may be required to be signed by all applicants.

(g) Requests for withdrawals of the international application, designations, priority claims, the Demand, or elections shall be made in accordance with PCT Rule 90 *bis* and must be signed by all applicants. A separate power of attorney from the applicants will be required for the purposes of any request for a withdrawal in accordance with PCT Rule 90 *bis* which is not signed by all applicants. The submission of a separate power of attorney may be excused upon the request of another applicant where one or more inventors cannot be found or reached after diligent effort. Such a request must be accompanied by a statement explaining to the satisfaction of the Director the lack of the signature concerned.

***37 CFR 1.422 (pre-AIA) When the inventor is dead.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 before September 16, 2012]

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 (pre-AIA) When the inventor is insane or legally incapacitated.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 before September 16, 2012]

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.

For international applications having international filing dates before September 16, 2012, only inventors (and legal representatives of deceased or legally incapacitated inventors) can be applicants for purposes of the designation of the United States. Therefore, for the purpose of entering the national stage in the United States of America, the inventor(s) must be indicated in the PCT Request as "applicant and inventor" for at least the United States.

A legal representative of a deceased inventor may be indicated in the international application as an applicant for the purposes of the United States. In such a case, the indication in the Request (in Box II or III, as appropriate) for the legal representative should be made as follows: SMITH, Alfred, legal representative of JONES, Bernard (deceased), followed by indications of the address, nationality and residence of the legal representative. The legal representative should be indicated as an "applicant only" except where the legal representative is also an inventor, in which case the legal representative should be indicated as an "applicant and inventor." The name of the deceased inventor should also appear in a separate box (in Box III) with the indication of "deceased" (e.g., "JONES, Bernard (deceased))" and identified as an "inventor only" and not as an applicant.

## 1807 Agent or Common Representative and General Power of Attorney [R-01.2024]

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

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the United States Patent and Trademark Office or by an applicant appointed as a common representative ( PCT Art. 49, Rules 4.8 and 90 and § 11.9). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record ( PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated ( PCT Rule 90.6(b) and (c)).

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

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

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

***PCT Rule 90***

***Agents and Common Representatives***

*****

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

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

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

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

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

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

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

The Customer Number Practice set forth in MPEP § 403 may not be used in the international phase to appoint an agent or designate a correspondence address. A power of attorney making use of the Customer Number Practice in the international phase to indicate the name or address of an appointed person will be considered nonexistent unless the defect is corrected. See PCT Rule 90.4(c). A Customer Number may be used in the international phase solely for purposes of viewing the international application in the USPTO patent electronic filing system. See MPEP § 1809.

## I. "GENERAL" POWER OF ATTORNEY

***PCT Rule 90***

***Agents and Common Representatives***

*****

***90.5 General Power of Attorney***

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

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

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

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

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

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

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"General" powers of attorney are recognized for the purpose of filing and prosecuting an international application before the international authorities. See PCT Rule 90.5.

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

## II. WAIVER OF REQUIREMENT FOR A POWER OF ATTORNEY

Pursuant to PCT Rules 90.4(d) and 90.5(c), which are applicable to international applications having an international filing date on or after January 1, 2004, the receiving Office, International Bureau, International Searching Authority and International Preliminary Examining Authority may waive the requirement for a separate power of attorney or copy of the general power of attorney in all cases except with respect to notice of withdrawals under PCT Rule 90 *bis* (i.e., notices withdrawing international applications, designations, priority claims, demands or elections). The USPTO, when acting in its capacity as a receiving Office, International Searching Authority, or International Preliminary Examining Authority, will in most cases waive the requirement for a separate power of attorney and copy of the general power of attorney. However, a separate power of attorney or copy of the general

power of attorney may still be required in certain cases, e.g., where an agent's authority to act on behalf of the applicant is in doubt or where waiver could result in harm to an applicant as in the case of the removal of an applicant.

Model power of attorney and general power of attorney forms are available online from WIPO's website (**www.wipo.int/pct/en/index.html**).

## 1808 Change in or Revocation of the Appointment of an Agent or a Common Representative [R-07.2015]

***PCT Rule 90***

***Agents and Common Representatives***

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***90.6 Revocation and Renunciation***

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

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

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

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

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

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

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the United States Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49 , Rules 4.8 and 90 and § 11.9). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b) and (c)).

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

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

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

The appointment of an agent or a common representative can be revoked. The document containing the revocation must be signed by the persons who made the appointment or by their successors in title. The appointment of a sub-agent may also be revoked by the applicant concerned. If the appointment of an agent is revoked, any appointment of a sub-agent by that agent is also considered revoked. Also, as an agent may not be appointed by Customer Number Practice in the international phase (see MPEP § 1807), an appointment of an agent may not be revoked by reference to a Customer Number.

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

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

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

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

to the receiving Office at Mail Stop PCT and should indicate the present mailing addresses of the attorney who is withdrawing and of the applicant. The Office will not accept address changes to a new practitioner or law firm absent the filing of a power of attorney to the new representative. Because the United States Patent and Trademark Office (USPTO) does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of another.

In accordance with 37 CFR 11.116, the USPTO will usually require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, that the practitioner(s) intends to withdraw from employment; and (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled. Furthermore, as 37 CFR 11.116 permits withdrawal from representation before the Office for reasons set forth in 37 CFR 11.116(a) and (b), if the reasons for withdrawal do not conform to one of the mandatory or permissive reasons set forth in 37 CFR 11.116, the Office will not approve the request.

The Office will not approve requests from practitioners to withdraw from applications where the requesting practitioner was not appointed in a power of attorney but is acting, or has acted, in a representative capacity pursuant to 37 CFR 1.34. In these situations, the practitioner is responsible for the correspondence the practitioner files in the application while acting in a representative capacity. As such, there is no need for the practitioner to obtain the permission of the Office to withdraw from representation.

Practitioners should note that the International Bureau will not record a change in the agent if the requested change is received by it after the expiration of 30 months from the priority date. See PCT Rule 92 *bis* . Where a request to withdraw from representation is filed with the USPTO after the expiration of this time period, the request may not be treated on the merits.

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

## 1809 Access to the USPTO patent electronic filing system [R-01.2024]

Status information relating to patent applications is available through the USPTO patent electronic filing system, which has a public view and a private view. The public view provides access to all issued patents and published patent applications. Private view allows registered Patent Center users to access information for applications associated with the user that has not been made public, in addition to what is also available through the public view. To have access to the private view, the applicant must be a registered user in Patent Center. Further information can be found at **www.uspto.gov/NewPatentFilers**.

To associate a new international application that is being filed via the USPTO patent electronic filing system with an existing customer number, enter the customer number in the appropriate field when filling in the application data. The customer number will allow access to the application in the USPTO patent electronic filing system but may not be used to establish or change the correspondence address.

To associate a previously filed international application to a customer number, a request must be made. Applicant must provide the customer number, international application number, registration number and signature of applicant or attorney of record. Form PTO-2248 may be obtained from the USPTO website (**www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-chapter-i-forms**). The form can be mailed or transmitted by facsimile to Mail Stop EBC, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. The fax number is 571-273-0177.

The ability to view the status of the international application on the USPTO patent electronic filing system does not allow an applicant to change the correspondence address or appoint or change an agent with the customer number. See MPEP § 1807. Such a change must be made under PCT Rule 92 *bis* through the submission of a written request to the U.S. receiving Office or the International Bureau.

# 1810 Filing Date Requirements [R-07.2022]

***PCT Article 11***

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

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

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

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

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

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

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

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

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

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

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

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the America Invents Act (AIA). See 35 U.S.C. 100 (note).]

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. 363 (pre-AIA) International application designating the United States: Effect.**

[Editor Note: Applicable to applications not subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 363 immediately above for the law otherwise applicable.]

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).

***37 CFR 1.431 International application requirements.***

[Editor Note: See pre-AIA 37 CFR 1.431 in Appendix R for para. (b)(3)(iii) applicable to applications filed before September 16, 2012]

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

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

(1) At least one applicant (§ 1.421) is a United States resident or national and the papers filed at the time of receipt of the international application so indicate (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

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

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

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

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

(iii) The name of the applicant, as prescribed (note §§ 1.421, 1.422, and 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 international filing fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. The international filing, transmittal, and search fee payable is the international filing, transmittal, and search fee in effect on the receipt date of the international application. If the international filing, transmittal and search fees are not paid within one month from the date of receipt of the international application and prior to the sending of a notice of deficiency, which imposes a late payment fee (§ 1.445(a)(6)), the applicant will be notified and given a one month non-extendable time limit within which to pay the deficient fees plus the late payment fee.

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

**THE "INTERNATIONAL FILING DATE"**

An international filing date is accorded to the earliest date on which the requirements under PCT Article 11(1) were satisfied. If the requirements under PCT Article 11(1) are not satisfied as of the date of initial receipt of the international application papers, the receiving Office will invite applicant to correct the

deficiency within a set time limit. See PCT Article 11(2) and PCT Rule 20.3. In such case, the international filing date will be the date on which a timely filed correction is received by the receiving Office. If the defect under PCT Article 11(1) is that the purported international application fails to contain a portion which on its face appears to be a description or claims, and if the application, on its initial receipt date, contained a priority claim and a proper incorporation by reference statement, the initial receipt date may be retained as the international filing date if the submitted correction was completely contained in the earlier application. See PCT Rules 4.18 and 20.6. If the defect under PCT Article 11(1) is not timely corrected, the receiving Office will promptly notify the applicant that the application is not and will not be treated as an international application. See PCT Rule 20.4. 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. If the application, on its initial receipt date, contained a priority claim and a proper incorporation by reference statement, the initial receipt date may be retained as the international filing date if the submitted correction was completely contained in the earlier application. Again see PCT Rules 4.18 and 20.6.

An all too common occurrence is that applicants will file an international application in the U.S. Receiving Office and no applicant has a U.S. residence or nationality. Applicants are cautioned to be sure that at least one applicant is a resident or national of the U.S. before filing in the U.S. Receiving Office. Where no applicant indicated on the request papers is a resident or national of the United States, the USPTO is not a competent receiving Office for the international application under PCT Rule 19.1(a). Nonetheless, the date the international application was filed in the USPTO will not be lost as a filing date for the international application if at least one applicant is a resident or national of any PCT Contracting State. Under PCT Rule 19.4, the USPTO will receive the application on behalf of the International Bureau as receiving Office (PCT Rule 19.4(a)) and, upon payment of a fee equal to the transmittal fee, the USPTO will promptly transmit the international application to the International Bureau under PCT Rule 19.4(b). However, if all of the applicants are indicated to be both residents and nationals of non-PCT Contracting States, PCT Rule 19.4 does not apply, and the application is denied an international filing date.

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

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

## 1811 [Reserved]

## 1812 Elements of the International Application [R-07.2022]

***PCT Article 3***

***The International Application***

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

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

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

(4) The international application shall:

(i) be in a prescribed language;

(ii) comply with the prescribed physical requirements;

(iii) comply with the prescribed requirement of unity of invention;

(iv) be subject to the payment of the prescribed fees.

Any international application must contain the following elements: request, description, claim or claims, abstract and one or more drawings (where

drawings are necessary for the understanding of the invention (PCT Article 3(2) and PCT Article 7(2)). The elements of the international application are to be arranged in the following order: the request, the description (other than any sequence listing part thereof), the claims, the abstract, the drawings, and the sequence listing part of the description (where applicable) (Administrative Instructions Section 207(a)). All the sheets contained in the international application must be numbered in consecutive Arabic numerals by using the following separate series of numbers: a first series applying to the request; a second series to the description, claims and abstract; a third series to the drawings (where applicable); and a further series to the sequence listing part of the description (where applicable) (PCT Rule 11.7 and Administrative Instructions Section 207(b)). Only one copy of the international application need be filed in the United States Receiving Office ( 37 CFR 1.433(a)). The request is made on a standardized form (Form PCT/RO/101), copies of which can be obtained from the USPTO or online from WIPO's website (**www.wipo.int/pct/en/forms/**). The "Request" form can also be presented as a computer printout prepared using WIPO's ePCT system. See MPEP § 1821.

## 1813 - 1816 [Reserved]

## 1817 PCT Member States [R-07.2015]

An updated list of PCT Contracting States is available from WIPO's website (**www.wipo.int/pct/guide/en/gdvol1/annexes/annexa/ax_a.pdf** or **www.wipo.int/pct/en/pct_contracting_states.html**). An updated list of PCT Contracting States for which a regional patent can be obtained via the PCT is available from the WIPO's website (**www.wipo.int/pct/en/texts/reg_des.html**).

## 1818 [Reserved]

## 1819 Earlier Search [R-08.2012]

***PCT Rule 4***

***The Request (Contents)***

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***4.12 Taking into Account Results of Earlier Search***

If the applicant wishes the International Searching Authority to take into account, in carrying out the international search, the results of an earlier international, international-type or national search carried out by the same or another International Searching Authority or by a national Office ("earlier search"):

(i) the request shall so indicate and shall specify the Authority or Office concerned and the application in respect of which the earlier search was carried out;

(ii) the request may, where applicable, contain a statement to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language.

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***PCT Rule 12 bis***

***Copy of Results of Earlier Search and of Earlier Application; Translation***

***12 bis.1 Copy of Results of Earlier Search and of Earlier Application; Translation***

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (c) to (f), submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

(b) The International Searching Authority may, subject to paragraphs (c) to (f), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:

(i) a copy of the earlier application concerned;

(ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;

(iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;

(iv) a copy of any document cited in the results of the earlier search.

(c) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copies referred to in paragraphs (a) and (b)(i) and (iv), indicate the wish that the receiving Office prepare and transmit them to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(d) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that

which is acting as the International Searching Authority, no copy or translation referred to in paragraphs (a) and (b) shall be required to be submitted under those paragraphs.

(e) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (b)(i) and (ii) shall be required to be submitted under those paragraphs.

(f) Where a copy or translation referred to in paragraphs (a) and (b) is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library or in the form of the priority document, and the applicant so indicates in the request, no copy or translation shall be required to be submitted under those paragraphs.

Where the applicant wishes the International Searching Authority (ISA) to take into account, in carrying out the international search, the results of one or more earlier international, international-type, or national searches carried out by the same or another ISA or by a national Office, the application(s) must be identified in the request. Applicants should identify the application(s) in Box No. VII of the request by the filing date, application number, and the country or regional Office.

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. See 37 CFR 1.104(a)(3).

## 1820 Signature of Applicant [R-08.2017]

***PCT Article 14***

***Certain Defects in the International Application***

(1)

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

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

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***PCT Rule 4***

***The Request (Contents)***

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***4.15 Signature***

The request shall be signed by the applicant or, if there is more than one applicant, by all of them.

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***PCT Rule 26***

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

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***26.2 bis Checking of Requirements Under Article 14(1)(a)(i) and (ii)***

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

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

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### SIGNATURE OF APPLICANT OR AGENT

Pursuant to PCT Rule 4.15, the international application must be signed in Box No. X of the request by the applicant, or, where there are two or more applicants, by all of them. However, under PCT Rule 26.2 *bis*, it is sufficient for purposes of PCT Article 14(1)(a)(i) that the application is signed by only one of the applicants. The United States Receiving Office will not issue an invitation to applicants to furnish missing signatures where the request is signed by at least one of the applicants. Notwithstanding PCT Rule 26.2 *bis*, any designated/elected office, in accordance with its national law, can still require confirmation of the international application by the signature of any applicant for such designated state who has not signed the request. PCT Rule 51 *bis*.1(a)(vi). Pursuant to 37 CFR 1.4(d), the request filed may be either an original, or a copy thereof.

The international application may be signed by an agent. Pursuant to 37 CFR 1.34, a patent practitioner acting in a representative capacity must set forth his or her registration number on submitted papers.

The requirement for the submission of a separate power of attorney may be waived by the receiving Office. The United States Receiving Office will, in most cases, waive the requirement for a separate power of attorney. See MPEP § 1807.

The United States Receiving Office will accept signatures meeting the requirements of either 37

CFR 1.4(d)(1) with respect to handwritten signatures or 37 CFR 1.4(d)(2) with respect to S-signatures. For handwritten signatures, the name of each person signing the international application should be indicated (preferably typewritten) next to the signature. For S-signatures, the signer's name must be presented in printed or typed form preferably immediately below or adjacent the S-signature, and must be reasonably specific enough so that the identity of the signer can be readily recognized. See MPEP § 502.02, subsection II. Pursuant to 37 CFR 1.4(d)(2)(ii), a patent practitioner using an S-signature must supply his or her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature.

Where a person signs on behalf of a legal entity (an organization such as a corporation, university, nonprofit organization, or governmental agency), his or her name and the capacity in which he or she signs should be indicated. Proof of the person's authority to sign on behalf of the legal entity will be required if that person does not possess apparent authority to sign on behalf of the legal entity and that person has not submitted a statement that he or she is authorized to sign on behalf of the legal entity (discussed below). An officer (President, Vice-President, Secretary, Treasurer, Chief Executive Officer, Chief Operating Officer or Chief Financial Officer) of an organization is presumed to have authority to sign on behalf of that organization. The signature of the chairman of the board is also acceptable, but not the signature of an individual director. Variations of these titles (such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors) are acceptable. In general, a person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the organization is not presumed to be an officer or to have the authority to sign on behalf of the organization. However, an exception is made with respect to foreign juristic applicants. This is because in foreign countries, a person who holds the title "Manager" or "Director" is normally an officer or the equivalent thereof; therefore, those terms are generally acceptable as indicating proper persons to sign applications for foreign applicants. However, titles such as "Manager of Patents," suggesting narrowly limited duties, are not acceptable. An attorney does not generally have apparent authority to sign on behalf of an organization.

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

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

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

## 1821 The Request [R-01.2024]

A general overview of certain aspects of the request follows.

***37 CFR 1.434 The request.***

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

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

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

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

(1) The name of the inventor; and;

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

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

The Request must either be made on a standardized form PCT/RO/101 to be filled in with the required indications or be presented as a computer printout complying with the PCT Administrative Instructions. The Request form PCT/RO/101 may be downloaded for free from WIPO's website (**www.wipo.int/pct/en/forms/**). Applicants may also obtain an English language Request form free of charge from the United States Patent and Trademark Office using the following address: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

As an alternative to using the standardized Request form PCT/RO/101, applicants may use WIPO's ePCT system to generate a computer printout of the Request complying with the PCT Administrative Instructions. ePCT incorporates and expands the functionality of WIPO's prior PCT-SAFE software. As of July 1, 2022, WIPO no longer develops, distributes, or supports PCT-SAFE. ePCT is a web-based application that does not require installation and subsequent periodic updates of any software on the user's computer. The ePCT system validates user-entered data and creates a zip file containing the Request and fee calculation sheet in PDF format. Submission of the ePCT zip file with an international application filed electronically (i.e., via the USPTO patent electronic filing system) entitles the applicant to a reduction of the international filing fee. For information on ePCT, see **https://pct.wipo.int/ePCT**.

For inventions made in the United States, applicants should be mindful of certain foreign filing restrictions and the potential need to obtain a foreign filing license when using WIPO's ePCT system. See MPEP § 1832 and *Facilitating the Use of the World Intellectual Property Organization's ePCT System To Prepare International Applications for Filing With the United States Receiving Office*, 85 Fed. Reg. 61604 (Sept. 30, 2020).

The Request contains a petition for the international application to be processed according to the PCT and must also contain certain indications. It must contain the title of the invention. It must identify the applicant and the agent (if any), and must contain the designation of at least one Contracting State.

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

**I. DATES**

Each date appearing in the international application or in any correspondence must be indicated by the Arabic number of the day, the name of the month and the Arabic number of the year, in that order. In the request, after, below or above that indication, the date should be repeated in parentheses with a two-digit Arabic numeral each for the number of the day and for the number of the month and followed by the number of the year in four digits, in that order and separated by periods, slashes or hyphens after the digit pairs of the day and of the month, for example, "20 March 2020 (20.03.2020)," "20 March 2020 (20/03/2020)," or "20 March 2020 (20-03-2020)." See Administrative Instructions Section 110.

**II. 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." For indicating the international application as a continuation or continuation-in-part of an earlier application, see MPEP § 1828.02.

**III. FILE REFERENCE**

The applicant or the applicant's agent may indicate a file reference in the box provided for this purpose on the first sheet of the Request form, on each page of the other elements of the international application,

on the first sheet of the demand form, and in any other correspondence relating to the international application. PCT Rule 11.6(f) indicates that the file reference may be included in the top margin of the sheets of the international application. As provided in Administrative Instructions Section 109, the file reference may be composed either of letters of the Latin alphabet or Arabic numerals, or both. It may not exceed 25 characters including spaces. If the file reference exceeds 25 characters, the receiving Office may *ex officio* truncate the reference number to 25 characters and notify the applicant. The receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority (International Authorities) will use the file reference in correspondence with the applicant.

## IV. TITLE OF INVENTION

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

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

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

## V. APPLICANT

See MPEP § 1806 regarding who can be an applicant.

## VI. NAMES

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

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

## VII. ADDRESSES

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

## VIII. DESIGNATION OF STATES

***PCT Rule 4***

***The Request (Contents)***

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***4.9 Designation of States; Kinds of Protection; National and Regional Patents***

(a) The filing of a request shall constitute:

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

(ii) an indication that the international application is, in respect of each designated State to which Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State:

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

(b) Notwithstanding paragraph (a)(i), if, on October 5, 2005, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request in which the priority of an earlier national application filed in that State is claimed may contain an indication that the designation of that State is not made, provided that the designated Office notifies the International Bureau by January 5, 2006, that this paragraph shall apply in respect of designations of that State and that the notification is still in force on the international filing date. The

information received shall be promptly published by the International Bureau in the Gazette.

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

The filing of an international application request shall constitute:

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

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

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

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

Pursuant to PCT Rule 4.9(b), certain States may be excepted from the all-inclusive designation system under limited circumstances. Specifically, where the international application contains a priority claim to an earlier national application having effect in a State whose national law provides that the designation of such State has the result that the earlier national application ceases to have effect in such State, then the request may contain an indication that such State is not designated. Applicability of PCT Rule 4.9(b) is contingent upon timely notice by the affected Office to the International Bureau. The Request may exclude the following designations: Germany (DE), Japan (JP), and Republic of Korea (KR). See Reservations, Declarations, Notifications and Incompatibilities at **www.wipo.int/pct/en/texts/reservations/res_incomp.html**.

# 1822 [Reserved]

# 1823 The Description [R-01.2024]

***PCT Article 5***

***The Description***

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

***PCT Rule 5***

***The Description.***

***5.1 Manner of the Description***

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

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

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

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

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

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

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

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

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

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***PCT Administrative Instructions Section 204***

***Headings of the Parts of the Description***

(a) The headings of the parts of the description should be as follows:

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

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

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

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

(vii) [Deleted]

(viii) [Deleted]

(b) The heading "Title of Invention" shall preferably precede the title of the invention.

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***PCT Administrative Instructions Section 209***

***Indications as to Deposited Biological Material on a Separate Sheet***

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

(b) For the purposes of designated Offices, which have so notified the International Bureau under Rule 13 *bis*.7(a), paragraph (a) applies only if the said Form or sheet is included as one of the sheets of the description of the international application at the time of filing.

***37 CFR 1.435 The description.***

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

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

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

For international applications having an international filing date before July 1, 2022, headings for "Sequence Listing" and "Sequence Listing Free Text" should also be used where applicable. See Section 204 of the Administrative Instructions (in effect before July 1, 2022), which may be found at: **www.wipo.int/wipolex/en/text/584509**.

For international applications having an international filing date on or after July 1, 2022, the description may include a sequence listing. Where applicable, the sequence listing should be included as a separate part of the description complying with the standard provided for in the PCT Administrative Instructions.

For more information on filing nucleotide and/or amino acid sequence listings, see MPEP § 1823.02. For information on reference to deposited biological material, see MPEP § 1823.01.

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

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

A description drafted with due regard to what is said in these provisions will be accepted by all the designated Offices. It might require more care than

the drafting of a national patent application, but certainly much less effort than the drafting of multiple applications, which is necessary where the PCT route is not used for filing in several countries.

## 1823.01 Reference to Deposited Biological Material [R-07.2015]

***PCT Rule 13 bis***

***Inventions Relating to Biological Material***

***13 bis.1 Definition***

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

***13 bis.2 References (General)***

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

***13 bis.3 References: Contents; Failure to Include Reference or Indication***

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

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

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

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

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

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

***13 bis.4 References: Time Limit for Furnishing Indications***

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

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

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

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

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

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

(i) if the indication was received before the technical preparations for international publication have been completed, publish the indication furnished under paragraph (a), and an indication of the date of receipt, together with the international application;

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

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

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

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

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

***13 bis.6 Furnishing of Samples***

Pursuant to Articles 23 and 40, no furnishing of samples of the deposited biological material to which a reference is made in an international application shall, except with the authorization of the applicant, take place before the expiration of the applicable time limits after which national processing may start under the said Articles. However, where the applicant performs the acts referred to in Articles 22 or 39 after international publication

but before the expiration of the said time limits, the furnishing of samples of the deposited biological material may take place, once the said acts have been performed. Notwithstanding the previous provision, the furnishing of samples of the deposited biological material may take place under the national law applicable by any designated Office as soon as, under that law, the international publication has the effects of the compulsory national publication of an unexamined national application.

***13 bis.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 *bis*.3(a)(i), (ii) and (iii), is required to be included in a reference to deposited biological material in a national application;

(ii) that one or more of the indications referred to in Rule 13 *bis*.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 from the priority date.

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

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

***PCT Administrative Instructions Section 209***

***Indications as to Deposited Biological Material on a Separate Sheet***

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

(b) For the purposes of designated Offices, which have so notified the International Bureau under Rule 13 *bis*.7(a), paragraph (a) applies only if the said Form or sheet is included as one of the sheets of the description of the international application at the time of filing.

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

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

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

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

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

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

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

The indications in the first category are:

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

(2) the date of the deposit with that institution; and

(3) the accession number given to the deposit by that institution.

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

The national laws of some of the national (or regional) Offices require that, besides indications concerning the deposit of a biological material, an indication be given concerning the biological material itself, such as, for example, a short description of its characteristics, at least to the extent that this information is available to the applicant. These requirements must be met in the case of international applications for which any such Office is a designated Office, provided that the requirements have been published in the *PCT Gazette*. Annex L of the PCT Applicant's Guide indicates, for each of the national (or regional) Offices, the requirements (if any) of this kind which have been published.

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

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

To the extent that indications relating to the deposit of a biological material are not given in the description, because they are furnished later, they may be given in the "optional sheet" provided for that purpose. If the sheet is submitted when the international application is filed, a reference to it should be made in the check list contained on the last sheet of the Request form. Should certain States be designated, e.g., Israel, Japan, Korea, Mexico, or Turkey , such a sheet must, if used, be included as one of the sheets of the description at the time of filing; otherwise the indications given in it will not be taken into account by the respective patent offices of those designated States in the national phase. Requirements of the various Offices are set forth in Annex L of the PCT Applicant's Guide, available online at **www.wipo.int/pct/en/appguide**. If the sheet is furnished to the International Bureau later, it must be enclosed with a letter.

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

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

institution which will be accepted by the designated Office.

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

The furnishing of samples of a deposit of a biological material to third persons is governed by the national laws applicable in the designated Offices. PCT Rule 13 *bis*.6(b), however, provides for the delaying of any furnishing of samples under the national law applicable in each of the designated (or elected) Offices until the start of the national phase, subject to the ending of this "delaying effect" brought about by the occurrence of either of the following two events:

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

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

## 1823.02 Filing Nucleotide and/or Amino Acid Sequence Listings in International Applications [R-01.2024]

[Editor Note: The PCT Rules and Administrative Instructions reproduced in this section are applicable to international applications, including national phase applications, having an international filing date on or after July 1, 2022. For international applications having an international filing date before July 1, 2022, the applicable rules may be found at: **www.wipo.int/export/sites/www/pct/en/docs/texts/pct-regs2020.pdf** and the applicable instructions may be found at **www.wipo.int/wipolex/en/text/584509**.]

***PCT Rule 5***

***The Description***

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***5.2 Nucleotide and/or Amino Acid Sequence Disclosure***

(a) Where the international application contains disclosure of nucleotide and/or amino acid sequences that, pursuant to the Administrative Instructions, are required to be included in a sequence listing, the description shall include a sequence listing part of the description complying with the standard provided for in the Administrative Instructions.

(b) Language-dependent free text included in the sequence listing part of the description shall not be required to be included in the main body of the description.

***PCT Rule 13 ter***

***Nucleotide and/or Amino Acid Sequence Listings***

***13 ter.1 Procedure before the International Searching Authority***

(a) Where the international application contains disclosure of nucleotide and/or amino acid sequences that, pursuant to the Administrative Instructions, are required to be included in a sequence listing, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing complying with the standard provided for in the Administrative Instructions, unless such listing is already available to it in a form, language and manner acceptable to it, and to pay to it, where applicable, the late furnishing fee referred to paragraph (c), within a time limit fixed in the invitation:

(b) [Deleted]

(c) The furnishing of a sequence listing in response to an invitation under paragraph (a) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

(d) If the applicant does not, within the time limit fixed in the invitation under paragraph (a), furnish the required sequence listing and pay any required late furnishing fee, the International Searching Authority shall only be required to search the international application to the extent that a meaningful search can be carried out without the sequence listing.

(e) Any sequence listing not contained in the international application as filed, whether furnished in response to an invitation under paragraph (a) or otherwise, shall not form part of the international application, but this paragraph shall not prevent the applicant from amending the description in relation to a sequence listing pursuant to Article 34(2)(b).

***13 ter.2 Procedure before the International Preliminary Examining Authority***

Rule 13 *ter*.1 shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

***13 ter.3 Sequence Listing for Designated Office***

No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

***PCT Administrative Instructions Section 208***

***Sequence Listings***

Any sequence listing, whether forming part of the international application or not forming part of the international application, shall comply with Annex C. Sequences and references to sequences included in the main part of the description, claims and drawings shall also comply with Annex C.

## I. REQUIREMENTS FOR SEQUENCE LISTINGS UNDER WORLD INTELLECTUAL PROPERTY OFFICE STANDARD ST.26 (WIPO STANDARD ST.26)

[Editor Note: This subsection is applicable to all international applications, including national phase applications, having an international filing date on or after July 1, 2022, that disclose one or more nucleotide and/or amino acid sequences as defined in WIPO Standard ST.26.]

Patent applications that disclose a nucleotide and/or amino acid sequence(s) by enumeration of its residues, as defined in WIPO Standard ST.26, must present each sequence and associated sequence data in a standardized electronic eXtensible Markup Language (XML) format as a separate part of the specification. This standardized format is set forth in WIPO Standard ST.26 and applies to sequence listings in international applications filed under the Patent Cooperation Treaty (PCT) and in national and regional applications filed in the intellectual property offices (IPOs) of WIPO member states. As a result, a single sequence listing in compliance with WIPO Standard ST.26 can be prepared for use in all IPOs of WIPO member states.

Where an international application, filed under the PCT, contains a disclosure of nucleotide and/or amino acid sequences that are required to be listed within a sequence listing, PCT Rule 5.2 requires that the description shall include a sequence listing part of the description complying with the standard provided for in the Administrative Instructions. In accordance with Section 208 of the Administrative Instructions, any sequence listing, whether forming part of the international application or not forming part of the international application, shall comply with Annex C of the Administrative Instructions. Where applicant has not provided a sequence listing in accordance with Annex C of the Administrative Instructions and the USPTO acts as International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA), the ISA/IPEA may invite applicant to furnish a sequence listing, with a late furnishing fee, under PCT Rule 13 *ter* . This invitation will specify a time limit for a proper response. A proper response to such an invitation would include, the submission of a sequence listing in accordance with Annex C of the Administrative Instructions, the late furnishing fee specified in 37 CFR 1.445(a)(5), and a statement to the effect that the sequence listing does not go beyond the disclosure of the international application as filed. If a sequence listing compliant with WIPO Standard ST.26 has not been furnished to the ISA/IPEA within the time limit set forth in the invitation, the ISA/IPEA will only search/examine the international application to the extent that a meaningful search or examination can be performed without the sequence listing. See PCT Rule 13 *ter*.1(d). Where the application discloses sequences that are required to be within a sequence listing, it is advisable for the applicant to submit a sequence listing compliant with WIPO Standard ST.26 together with the international application on the international filing date rather than to wait for an invitation by the International Searching Authority or International Preliminary Examining Authority.

For a detailed discussion of the World Intellectual Property Organization (WIPO) Standard ST.26, see MPEP §§ 2412 - 2419, in particular MPEP § 2414.05.

For ease of access, WIPO Standard ST.26 can be found at: **www.wipo.int/standards/en/part_03_standards.html**.

**II. REQUIREMENTS FOR SEQUENCE LISTINGS UNDER WORLD INTELLECTUAL PROPERTY OFFICE STANDARD ST.25 (WIPO ST.25)**

[Editor Note: This subsection is only applicable to international applications, including national phase applications, having an international filing date before July 1, 2022, that disclose one or more nucleotide and/or amino acid sequences as defined in WIPO Standard ST.25.]

Where an international application discloses one or more nucleotide and/or amino acid sequences, the description must contain a sequence listing complying with the standard specified in the Administrative Instructions. A copy of the Administrative Instructions in force before July 1, 2022 can be found at: **www.wipo.int/wipolex/en/text/584509**. The standard is set forth in detail in Annex C - Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in International Patent Applications Under the PCT. The standard allows the applicant to draw up a single sequence listing which is acceptable to all receiving Offices, International Searching and Preliminary Examining Authorities for the purposes of the international phase, and to all designated and elected Offices for the purposes of the national phase.

Under PCT Rule 5.2(a), the sequence listing must always be presented as a separate part of the description. When filing an international application (PCT) using the USPTO patent electronic filing system, the sequence listing part of the description may be submitted either as a single ASCII text file with a ".txt" extension (e.g., "seqlist.txt") or as a PDF file. Note that 100 megabytes is the size limit for submitting a sequence listing text file via the USPTO patent electronic filing system.

A single ASCII text file will serve both as the sequence listing part of the description under PCT Rule 5.2 and the electronic form under PCT Rule 13 *ter*.1(a) in the absence of a PDF sequence listing file. The check list of the PCT Request (PCT/RO/101) provided via the USPTO patent electronic filing system together with the international application (PCT) must indicate that the sequence listing forms part of the international application. Furthermore, the statement as set forth in paragraph 4(v) of the AI Annex C (Administrative Instructions under the PCT, Annex C), that "the information recorded in electronic form furnished under PCT Rule 13 *ter* is identical to the sequence listing as contained in the international application," is not required.

Submission of the sequence listing part of the description in a PDF file is not recommended because the applicant would also be required to supply a copy of the sequence listing in an ASCII text file to the appropriate authority for purposes of international search and/or international preliminary examination in accordance with paragraph 40 of AI Annex C. When a sequence listing is filed via the USPTO patent electronic filing system in a new PCT international application in both a PDF file and an ASCII text file, but the Request form Box No. IX does not indicate which one forms part of the international application, the PDF copy of the sequence listing will be considered to form part of the application and the ASCII text file will be considered an accompanying item for search purposes under PCT Rule 13 *ter*.1(a) only.

In cases where a sequence listing does not meet the necessary requirements, such as it has been submitted in PDF format or .txt file does not comply with Annex C, the International Searching Authority and the International Preliminary Examining Authority may invite the applicant to furnish, within a fixed time limit, a sequence listing complying with the required standard. The invitation may also, in accordance with PCT Rule 13 *ter*.1(c), request the payment of a late furnishing fee. Where such an invitation has been issued, the sequence listing and late fee must be submitted to the International Searching Authority or the International Preliminary Examining Authority. It is advisable for the applicant to submit a listing of the sequence in electronic form

(text), if such a listing is required by the competent International Searching Authority or International Preliminary Examining Authority, together with the international application rather than to wait for an invitation by the International Searching Authority or International Preliminary Examining Authority.

The electronic form (text) is not mandatory in international applications to be searched by the United States International Searching Authority or examined by the United States International Preliminary Examining Authority. However, if an electronic form (text) of a sequence listing is not provided, a search or examination will be performed only to the extent possible in the absence of the electronic form (text). The U.S. sequence rules (37 CFR 1.821 - 1.825) and the PCT sequence requirements are substantively consistent. In this regard, full compliance with the requirements of the U.S. rules will generally ensure compliance with the applicable PCT requirements. However, the requirements of 37 CFR 1.821 through 37 CFR 1.825 are less stringent than the requirements of WIPO Standard ST.25. See MPEP § 2422, subsection II, MPEP § 2422.03(a), subsection IV, and MPEP § 2422.07 for information specific to filing sequence listings in international applications.

For a detailed discussion of the U.S. sequence rules, see MPEP §§ 2420 - 2429.

The calculation of the international filing fee for an international application (PCT), including a sequence listing, filed via the USPTO patent electronic filing system is determined based on the type of sequence listing file. A sequence listing filed in an ASCII text file will not be included in the sheet count of the international application (PCT). A sequence listing filed in a PDF file will be included in the sheet count of the international application (PCT). Therefore, the sheet count for an international application (PCT) filed via the USPTO patent electronic filing system containing both a PDF file and a text file sequence listing will be calculated to include the number of sheets of the PDF sequence listing.

## 1824 The Claims [R-07.2015]

***PCT Article 6***

***The Claims***

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

***PCT Rule 6***

***The Claims***

***6.1 Number and Numbering of Claims***

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

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

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

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

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

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

***6.3 Manner of Claiming***

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

(b) Whenever appropriate, claims shall contain:

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

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

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

### *6.4 Dependent Claims*

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

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

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

### *6.5 Utility Models*

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

***PCT Administrative 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. 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 in Arabic numerals.

(b) The applicant shall, in the letter referred to in Rule 46.5(b) or Rule 66.8(c), indicate the differences between the claims as filed and the claims as amended or, as the case may be, differences between the claims as previously amended and currently 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;

(vi) the claim replaces one or more claims as previously amended;

(vii) the claim is the result of the division of a claim as previously amended.

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

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

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

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

The procedure for rectification of obvious mistakes is explained in MPEP § 1836. The omission of an entire sheet of the claims cannot be rectified without affecting the international filing date, except in applications filed on or after April 1, 2007, where, if the application, on its initial receipt date, contained a priority claim and a proper incorporation by reference statement, the original international filing date may be retained if the submitted correction was completely contained in the earlier application. See PCT Rules 4.18 and 20.6. It is recommended that a request for rectification of obvious mistakes in the claims be made only if the mistake is liable to affect the international search; otherwise, the rectification should be made by amending the claims.

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

Multiple dependent claims are permitted in international applications before the United States Patent and Trademark Office as an International Searching and International Preliminary Examining Authority or as a Designated or Elected Office, if they are in the alternative only and do not serve as a basis for any other multiple dependent claim (PCT Rule 6.4(a), 35 U.S.C. 112). The claims, being an element of the application, should start on a new page (PCT Rule 11.4). Page numbers must not be placed in the margins (PCT Rule 11.7(b)). Line numbers should appear in the right half of the left margin (PCT Rule 11.8(b)). See PCT Rule 11.6(e).

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

## 1825 The Drawings [R-08.2017]

***PCT Article 7***

***The Drawings***

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

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

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

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

***PCT Rule 7***

***The Drawings***

***7.1 Flow Sheets and Diagrams***

Flow sheets and diagrams are considered drawings.

***7.2 Time Limit***

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

***PCT Rule 11***

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

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***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***

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(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.

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***11.11 Words in Drawings***

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

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

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***11.13 Special Requirements for Drawings***

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

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

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

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

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

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

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

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

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

(j) The different figures shall be arranged on a sheet or sheets without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet.

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

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

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

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

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

(a) Drawings are required when they are necessary for the understanding of the invention (PCT Art. 7).

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

The international application must contain drawings when they are necessary for the understanding of the invention. Moreover where, without drawings being actually necessary for the understanding of the invention, its nature admits of illustration by drawings, the applicant may include such drawings and any designated Office may require the applicant to file such drawings during the national phase. Flow sheets and diagrams are considered drawings.

Drawings must be presented on one or more separate sheets. They may not be included in the description, the claims or the abstract. They may not contain text matter, except a single word or words when absolutely indispensable. Note that if the drawings contain text matter not in English but in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office, the international application will be transmitted to the International Bureau for processing in its capacity as a Receiving Office. See 37 CFR 1.412(c)(6)(ii). If the drawings contain text matter not in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office, the application will be denied an international filing date.

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

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

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

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

"2/5" would be used for the second sheet of drawings where there are five in all.

Different figures on the sheets of drawings must be numbered in Arabic numerals consecutively and independently of the numbering of the sheets and, if possible, in the order in which they appear. This numbering should be preceded by the expression "Fig."

In situations where one or more sheets are added, each sheet shall be identified by the number of the preceding sheet followed by a slant and then by another Arabic numeral such that the additional sheets are numbered consecutively, starting always with number one for the first sheet added after an unchanged sheet (e.g., 10/1, 15/1, 15/2, 15/3, etc.). See Administrative Instructions Section 311.

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

The procedure for rectification of obvious mistakes in the drawings is explained in MPEP § 1836. The omission of an entire sheet of drawings cannot be rectified without affecting the international filing date, except in applications filed on or after April 1, 2007, where, if the application, on its initial receipt date, contained a priority claim and a proper incorporation by reference statement, the original international filing date may be retained if the submitted correction was completely contained in the earlier application. See PCT Rules 4.18 and 20.6. Rectifications of obvious mistakes are not considered to be amendments.

The drawings can be amended during the international phase only if the applicant files a Demand for international preliminary examination. The drawings can also be amended during the national phase. The amendment shall not go beyond the disclosure in the international application as filed. See PCT Article 34(2)(b).

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

## 1826 The Abstract [R-08.2017]

***PCT Rule 8***

***The Abstract***

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

(a) The abstract shall consist of the following:

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

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

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

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

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

***8.2 Figure***

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

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

***8.3 Guiding Principles in Drafting***

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

***37 CFR 1.438 The abstract***

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

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

The abstract must consist of a summary of the disclosure as contained in the description, the claims and any drawings. Where applicable, it must also contain the most characteristic chemical formula. The abstract must be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). National practice (see MPEP § 608.01(b)) also provides a maximum of 150 words for the abstract. See 37 CFR 1.72(b). The PCT range of 50 - 150 words is not absolute but publication problems could result when the PCT limit is increased beyond the 150 word limit. Maintaining the PCT upper limit is encouraged. As a rule of thumb, it can be said that the volume of the text of the abstract, including one of the figures from the drawings (if any), should not exceed what can be accommodated on an A4 sheet of typewritten matter, 1 1/2 spaced. The abstract of the international application as filed must begin on a new sheet following the claims (Administrative Instructions Section 207). The other physical requirements must correspond to those for the description. The abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art. These and other requirements concerning the abstract are spelled out in detail in PCT Rule 8. Useful guidance can be obtained from the "Guidelines for the Preparation of Abstracts Under the Patent Cooperation Treaty," published in the *PCT Gazette* (No. 5/1978). Those Guidelines may be obtained, in English and French, from the International Bureau.

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

Where the receiving Office finds that the abstract is missing, it invites the applicant to furnish it within a time limit fixed in the invitation. Where the receiving Office has not invited the applicant to furnish an abstract or the applicant fails to furnish an abstract within a time limit fixed in the invitation, the International Searching Authority establishes one. See PCT Rule 38. The same applies where the abstract does not comply with the requirements outlined in the preceding paragraphs. Where the abstract is established by the International Searching Authority, the applicant may propose modifications of, or comment on, the new abstract until the expiration of 1 month from the date of mailing of the international search report (PCT Rule 38.3).

**SUMMARY OF ABSTRACT REQUIREMENTS**

Preferably 50-150 words. Should contain:

(A) Indication of field of invention.

(B) Clear indication of the technical problem.

(C) Summary of invention's solution of the problem.

(D) Principal use or uses of the invention.

(E) Reference numbers of the main technical features placed between parentheses.

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

Should not contain:

(A) Superfluous language.

(B) Legal phraseology such as "said" and "means."

(C) Statements of alleged merit or speculative application.

(D) Prohibited items as defined in PCT Rule 9.

## 1827 Fees [R-01.2024]

A complete list of Patent Cooperation Treaty fee amounts which are to be paid to the United States

Patent and Trademark Office (USPTO), for both the national and international stages, can be found at the beginning of each weekly issue of the *Official Gazette* of the United States Patent and Trademark Office and on the International Patent Legal Administration page of the USPTO website (see MPEP § 1730). Applicants are urged to refer to this list before submitting any fees to the USPTO.

Pursuant to PCT Rules 14.1(c), PCT Rule 15.3, and 16.1(f), the international filing, transmittal, and search fee payable is the international filing, transmittal, and search fee in effect on the receipt date of the international application. See 37 CFR 1.431(c). For international applications filed on or after November 15, 2011, the transmittal fee paid to the USPTO as Receiving Office consists of both a basic portion and a non-electronic filing portion. See 37 CFR 1.445(a)(1). The non-electronic filing portion is applicable where applicant files the international application in paper rather than via the USPTO patent electronic filing system.

## 1827.01 Refund of International Application Fees [R-07.2022]

***37 CFR 1.446 Refund of international application filing and processing fees.***

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or treaty and its regulations, may be refunded. A mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested and will not notify the payor of such amounts. If the payor or party requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer, the Office may use the banking information provided on the payment instrument to make any refund by electronic funds transfer.

(b) Any request for refund under paragraph (a) of this section must be filed within two years from the date the fee was paid. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization under § 1.25(b), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Director or the Director's designee acting under PCT Rule 40.2(c).

(d) The international and search fees will be refunded if no international filing date is accorded or if the application is withdrawn before transmittal of the record copy to the International Bureau (PCT Rules 15.6 and 16.2). The search fee will be refunded if the application is withdrawn before transmittal of the search copy to the International Searching Authority. The transmittal fee will not be refunded.

(e) The handling fee (§ 1.482(b)) will be refunded (PCT Rule 57.6) only if:

(1) The Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau, or

(2) The Demand is considered not to have been submitted (PCT Rule 54.4(a)).

Although 37 CFR 1.446(a) indicates that a "mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee," 37 CFR 1.446(d) and (e) contain exceptions to this general statement.

According to 37 CFR 1.446(d), the international and search fees will be refunded if no international filing date is accorded or if the application is withdrawn before transmittal of the record copy to the International Bureau. The search fee will be refunded if the application is withdrawn before the search copy is transmitted to the International Searching Authority. The transmittal fee will not be refunded.

According to 37 CFR 1.446(e), the handling fee will be refunded if the Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau.

Refund of the supplemental search fee will be made if the applicant is successful in a protest (filed pursuant to 37 CFR 1.477) to a holding of lack of unity of invention. The supplemental search fee must be paid and be accompanied by (1) a protest and (2) a request for refund of the supplemental search fee.

If the receiving Office and International Searching Authority are not the same Office, any request for refund of the search fee made after the search copy has been transmitted to the International Searching Authority must be directed to the International Searching Authority and not to the receiving Office.

## 1828 Priority Claim and Document [R-07.2015]

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

The applicant may correct or add a priority claim by a notice submitted to the Receiving Office or the International Bureau (IB) within 16 months from the priority date, or where the priority date is changed, within 16 months from the priority date so changed, whichever period expires first, provided that a notice correcting or adding a priority claim may in any event be submitted until the expiration of 4 months from the international filing date. PCT Rule 26 *bis*.1 and 37 CFR 1.451 and 1.465. For a withdrawal of a priority claim, see MPEP § 1859.

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 IB or the receiving Office not later than 16 months from the priority date or, if the applicant has requested early processing in any designated Office, not later than the time such processing or examination is requested. The IB will normally furnish copies of the certified copy to the various designated Offices so that the applicant will not normally be required to submit certified copies to each designated Office. If the earlier filed application was filed with the U.S. Patent and Trademark Office, the applicant may request the U.S. Receiving Office (RO/US) to prepare, and transmit to the IB, a certified copy of the earlier application. The request (Form PCT/RO/101) contains a box which can be checked requesting that the receiving Office prepare the certified copy. In international applications filed in the RO/US on or after August 31, 2007, the RO/US will electronically transmit the certified copy of the earlier application if the applicant has made a request in accordance with PCT Rule 17.1(b) and 37 CFR 1.451(b). Further, in such international applications filed on or after August 31, 2007, the USPTO has waived the fee set out in 37 CFR 1.19(b)(1)(iii)(A) for electronically providing a copy of the patent application as filed. If the earlier application is made available to the International Bureau via a digital library, applicant may request the International Bureau to obtain a copy of the earlier application from the digital library. The International Bureau will electronically obtain the copy of the earlier application if the applicant has made a request in accordance with PCT Rule 17.1(b- *bis* ).

Transmission may be delayed or prevented when no inventor common to the priority application is named in the international application. Further, transmission of the priority document will not occur until its national security review is complete.

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

## 1828.01 Restoration of the Right of Priority [R-07.2022]

***37 CFR 1.452 Restoration of right of priority***

(a) If the international application has an international filing date which is later than the expiration of the priority period as defined by PCT Rule 2.4 but within two months from the expiration of the priority period, the right of priority in the international application may be restored upon request if the delay in filing the international application within the priority period was unintentional.

(b) A request to restore the right of priority in an international application under paragraph (a) of this section must be filed not later than two months from the expiration of the priority period and must include:

(1) A notice under PCT Rule 26 *bis*.1(a) adding the priority claim, if the priority claim in respect of the earlier application is not contained in the international application;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in filing the international application within the priority period was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) If the applicant makes a request for early publication under PCT Article 21(2)(b), any requirement under paragraph (b) of this section filed after the technical preparations for international publication have been completed by the International Bureau shall be considered as not having been submitted in time.

On April 1, 2007, the regulations to the PCT were amended to allow applicants with applications which were filed on or after that date and which were also filed after the expiration of the 12 month priority period but within two months of the expiration of the priority period, to request that the right of priority be restored, provided that the failure to file the application within the priority period was in spite of due care or unintentional. See PCT Rule 26 *bis*.3. Grantable requests for restoration of the right of priority must be filed within two months from the date of expiration of the priority period as defined by new PCT Rule 2.4, and must be accompanied by: (i) the requisite fee as set forth in § 1.17(m); (ii) a notice under PCT Rule 26 *bis*.1(a) adding the priority claim, if the priority claim in respect of the earlier application is not contained in the international application; and (iii) a statement that the delay in filing the international application within the priority period was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. If the applicant makes a request for early publication under PCT Article 21(2)(b), any of requirements (i), (ii), or (iii) above which are filed after the technical preparations for international publication have been completed by the International Bureau shall be considered as not having been submitted in time.

The International Bureau decides these matters under both the in spite of due care and unintentional standards. Therefore, in view of the fact that the USPTO only decides these matters under the unintentional standard, applicants may wish to consider filing directly with the International Bureau as receiving Office instead of the United States Receiving Office in the situation where applicant desires to request restoration of the right of priority under the in spite of due care standard. Applicants may also request that an application be forwarded to the International Bureau for processing in its capacity as a receiving Office in accordance with PCT Rule 19.4(a)(iii) in situations where applicants, after the international application has been filed, realize that the application was filed after the expiration of the 12 month priority period but within two months of the expiration of the priority period, and where applicant desires to request restoration of the right of priority under the in spite of due care standard. However, the United States Receiving Office may decline to forward the international application to the International Bureau under PCT Rule 19.4(a)(iii) if substantial processing of the international application by the United States Receiving Office has occurred. An international application filed with, or forwarded to, the International Bureau must have a foreign filing license unless: (1) the invention was not made in the United States; or (2) a U.S. national application on the invention was filed at least six months prior to the filing of the international application, the U.S. national application is not subject to a secrecy order under 37 CFR 5.2, and the international application does not contain modifications, amendments, or supplements changing the general nature of the invention in a manner that would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181. See 37 CFR 5.11 and 5.15.

It should be noted that restoration of a right of priority to a prior application by the United States Receiving Office, or by any other receiving Office, under the provisions of PCT Rule 26 *bis*.3, will not entitle applicants to a right of priority to such prior application in a national stage application in any office that has notified the International Bureau under PCT Rule 26 *bis*.3(j) and 49 *ter*.1(g) of an incompatibility with its national law. A full listing of the national offices that will not accept the restoration of the right of priority in the national stage may be found on WIPO's website at **www.wipo.int/pct/en/texts/reservations/res_incomp.html**. In the United States, a right of priority that has been restored under PCT Rule 26 *bis*.3 during the international stage will be effective in the U.S. national stage. See MPEP § 1893.03(c).

It should also be noted that regardless of the PCT Rule 26 *bis*.3(j) and 49 *ter*.1(g) status of any particular office, the priority date will still govern

all PCT time limits, including the thirty-month period for filing national stage papers and fees under 37 CFR 1.495. PCT Article 2(xi), which defines "priority date" for purposes of computing time limits, contains no limitation that the priority claim be valid.

In addition, in the context of a request for restoration of the right of priority pursuant to PCT Rule 26 *bis*.3(a), the receiving Office shall, upon reasoned request by the applicant or *sua sponte*, not transmit documents or parts thereof in relation to the request for restoration, if it finds that (i) the document or part thereof does not obviously serve the purpose of informing the public about the international application; (ii) publication or public access or any such document or part thereof would clearly prejudice the personal or economic interests of any person; and (iii) there is no prevailing public interest to grant access to that document or part thereof. See PCT Rule 26 *bis*.3(h- *bis*).

## 1828.02 Continuation or Continuation-in-Part Indication in the Request [R-07.2022]

***PCT Rule 4***

***The Request (Contents)***

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***4.11 Reference to Continuation or Continuation-in-Part, or Parent Application or Grant***

(a) If:

(ii) the applicant intends to make an indication under Rule 49 *bis*.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application; the request shall so indicate and shall indicate the relevant parent application or parent patent or other parent grant.

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The Supplemental Box of the Request form should be used where the applicant has an earlier pending United States nonprovisional application or international application designating the U.S. and wishes the later-filed international application to be treated as a continuation or continuation-in-part of such earlier application. To properly identify the parent application, the specific reference must identify the parent application by application number and indicate the relationship to the parent application (i.e., "continuation" or "continuation-in-part"). The specific reference must also indicate the filing date of the parent application if the parent application is an international application. See 37 CFR 1.78(d)(2).

The applicant may correct or add to the request any indication referred to in PCT Rule 4.11 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if the notice reaches the International Bureau before the technical preparations for international publication have been completed. See PCT Rule 26 *quater*.1. Where any correction or addition of an indication referred to in PCT Rule 4.11 is not timely received under PCT Rule 26 *quater*.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions. See PCT Rule 26 *quater*.2.

The inclusion of a proper reference to the parent application in the PCT Request form or the presence of such reference on the front page of the published international application will satisfy the requirement in 37 CFR 1.78 for the presentation of a benefit claim in an application data sheet. See 37 CFR 1.76(g). In such cases, a reference to the parent application in an application data sheet would not be required in the national stage application. Furthermore, inclusion of a proper reference to the parent application in the PCT Request form is also beneficial where applicant chooses to file a continuing application claiming benefit under 35 U.S.C. 365(c) to the international application (i.e., a bypass application) rather than entering the U.S. national phase under 35 U.S.C. 371. See MPEP § 211.02, which indicates the right to rely on a prior application may be waived by an applicant if a reference to the prior application is not included in the later-filed application.

## 1829 [Reserved]

## 1830 International Application Transmittal Letter [R-07.2015]

A PCT international application transmittal letter, Form PTO-1382, is available for applicants to use when filing PCT international applications and related documents with the United States Receiving

Office. The form, which is intended to simplify the filing of PCT international applications and related documents with the United States Receiving Office, may be obtained online at **www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-chapter-i-forms**.

## 1831 [Reserved]

## 1832 License Request for Foreign Filing Under the PCT [R-07.2022]

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: (1) the invention was not made in the United States; or (2) a U.S. national application on the invention was filed at least six months prior to the filing of the international application, the U.S. national application is not subject to a secrecy order under 37 CFR 5.2, and the international application does not contain modifications, amendments, or supplements changing the general nature of the invention in a manner that would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181. See37 CFR 5.11 and 5.15. In all other instances (direct foreign filings outside the PCT or filings in a foreign receiving Office), the applicant should petition for a license for foreign filing (37 CFR 5.12) and if appropriate, identify any additional subject matter in the international application which was not in the earlier U.S. national application (37 CFR 5.14(c)).

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.

A foreign filing license also authorizes the export of technical data abroad for purposes related to the preparation, filing or possible filing, and prosecution of a foreign application. See 37 CFR 5.11(b). Effective September 30, 2020, 37 CFR 5.11 was amended to expand the scope of a foreign filing license to include the export of technical data abroad for purposes relating to the use of a World Intellectual Property Organization online service (ePCT) for preparing an international application for filing with the United States Receiving Office without separately complying with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy). Applicants using WIPO's ePCT system to prepare an international application for filing with the United States Receiving Office without a foreign filing license are cautioned against exporting technical data into ePCT without separately complying with the aforementioned regulations. See MPEP §§ 140 and 1821.

**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 prevent abandonment as to the United States of America if it has been designated, by fulfilling the requirements of 35 U.S.C. 371(c).

# 1833 [Reserved]

# 1834 Correspondence [R-08.2017]

***PCT Rule 92***

***Correspondence***

***92.1 Need for Letter and for Signature***

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

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

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

***92.2 Languages***

(a) Subject to Rules 55.1 and 55.3 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

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

(c) *[Deleted]*

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

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

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***PCT Administrative Instructions Section 105***

***Identification of International Application With Two or More Applicants***

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

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

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

## II. CORRESPONDENCE ADDRESS

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

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

indicated a special address for notifications, at that address.

### III. FILING OF CORRESPONDENCE BY MAIL

The Priority Mail Express® procedure set forth at 37 CFR 1.10 applies to papers filed with the U.S. Patent and Trademark Office (USPTO) in international applications. Accordingly, papers filed with the USPTO in international applications will be accorded by the USPTO the "date accepted" indicated on the Priority Mail Express® mailing label as the date of filing in the USPTO if the provisions of 37 CFR 1.10 are complied with. See MPEP § 513.

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

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

## 1834.01 Filing of Correspondence by Facsimile [R-07.2015]

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

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

(A) Required by statute to be certified;

(B) A color drawing submitted under 37 CFR 1.437;

(C) An international application for patent; or

(D) A copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.495(b).

Facsimile transmission may be used to submit substitute sheets (other than color drawings), extensions of time, power of attorney, fee authorizations (other than the basic national fee), demands, response to written opinions, oaths or declarations, petitions, Article 34 amendments, and translations in international applications.

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

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

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

## 1834.02 Irregularities in the Mail or Electronic Communications Service [R-07.2022]

***PCT Rule 82***

***Irregularities in the Mail Service***

***82.1 Delay or Loss in Mail***

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

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

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

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

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

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

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

### I. DELAY OR LOSS IN MAIL

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

### II. INTERRUPTION IN MAIL OR ELECTRONIC COMMUNICATIONS SERVICE

Special provisions apply to excuse delays in meeting time limits fixed in the PCT Regulations, and to extend time limits due to a general disruption experienced by an office or authority, caused by war, revolution, civil disorder, strike, natural calamity, epidemic, a general unavailability of electronic

communications services or other like reasons. For example, a delay in meeting a time limit may be excused where the interested party establishes that an outage of electronic communications services affected a widespread geographical area, was unexpected or unforeseen, and that no alternative means of communication was available. See PCT Rule 82 *quater* and PCT Administrative Instruction Section 111 for details.

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

## 1835 [Reserved]

## 1836 Rectification of Obvious Mistakes [R-07.2015]

***PCT Rule 91***

***Rectification of Obvious Mistakes in the International Application and Other Documents***

***91.1 Rectification of Obvious Mistakes***

(a) An obvious mistake in the international application or another document submitted by the applicant may be rectified in accordance with this Rule if the applicant so requests.

(b) The rectification of a mistake shall be subject to authorization by the "competent authority", that is to say:

(i) in the case of a mistake in the request part of the international application or in a correction thereof—by the receiving Office;

(ii) in the case of a mistake in the description, claims or drawings or in a correction thereof, unless the International Preliminary Examining Authority is competent under item (iii)—by the International Searching Authority;

(iii) in the case of a mistake in the description, claims or drawings or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examination shall start in accordance with Rule 69.1 has passed—by the International Preliminary Examining Authority;

(iv) in the case of a mistake in a document not referred to in items (i) to (iii) submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, other than a mistake in the abstract or in an amendment under Article 19—by that Office, Authority or Bureau, as the case may be.

(c) The competent authority shall authorize the rectification under this Rule of a mistake if, and only if, it is obvious to the competent authority that, as at the applicable date under paragraph (f), something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification.

(d) In the case of a mistake in the description, claims or drawings or in a correction or amendment thereof, the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the description, claims and drawings and, where applicable, the correction or amendment concerned.

(e) In the case of a mistake in the request part of the international application or a correction thereof, or in a document referred to in paragraph (b)(iv), the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the international application itself and, where applicable, the correction concerned, or the document referred to in paragraph (b)(iv), together with any other document submitted with the request, correction or document, as the case may be, any priority document in respect of the international application that is available to the authority in accordance with the Administrative Instructions, and any other document contained in the authority's international application file at the applicable date under paragraph (f).

(f) The applicable date for the purposes of paragraphs (c) and (e) shall be:

(i) in the case of a mistake in a part of the international application as filed—the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application—the date on which the document was submitted.

(g) A mistake shall not be rectifiable under this Rule if:

(i) the mistake lies in the omission of one or more entire elements of the international application referred to in Article 3(2) or one or more entire sheets of the international application;

(ii) the mistake is in the abstract;

(iii) the mistake is in an amendment under Article 19, unless the International Preliminary Examining Authority is competent to authorize the rectification of such mistake under paragraph (b)(iii); or

(iv) the mistake is in a priority claim or in a notice correcting or adding a priority claim under Rule 26 *bis*.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that this paragraph shall not affect the operation of Rules 20.4, 20.5, 26 *bis* and 38.3.

(h) Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or another document, it may invite the applicant to request rectification under this Rule.

***91.2 Requests for Rectification***

A request for rectification under Rule 91.1 shall be submitted to the competent authority within 26 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a

brief explanation. Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the proposed rectification shall be indicated.

***91.3 Authorization and Effect of Rectifications***

(a) The competent authority shall promptly decide whether to authorize or refuse to authorize a rectification under Rule 91.1 and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. The International Bureau shall proceed as provided for in the Administrative Instructions, including, as required, notifying the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the designated and elected Offices of the authorization or refusal.

(b) Where the rectification of an obvious mistake has been authorized under Rule 91.1, the document concerned shall be rectified in accordance with the Administrative Instructions.

(c) Where the rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application as filed, from the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which that document was submitted.

(d) Where the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall, upon request submitted to it by the applicant within two months from the date of the refusal, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of the request, reasons and comments (if any) shall if possible be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).

(e) The rectification of an obvious mistake need not be taken into account by any designated Office in which the processing or examination of the international application has already started prior to the date on which that Office is notified under Rule 91.3(a) of the authorization of the rectification by the competent authority.

(f) A designated Office may disregard a rectification that was authorized under Rule 91.1 only if it finds that it would not have authorized the rectification under Rule 91.1 if it had been the competent authority, provided that no designated Office shall disregard any rectification that was authorized under Rule 91.1 without giving the applicant the opportunity to make observations, within a time limit which shall be reasonable under the circumstances, on the Office's intention to disregard the rectification.

Obvious mistakes in the international application or other papers submitted by the applicant may generally be rectified under PCT Rule 91, if the rectification is authorized, as required, within the applicable time limit. Any such rectification is free of charge. The omission of entire sheets of the international application cannot be rectified under PCT Rule 91. Correction of such mistakes may only be made in accordance with PCT Rule 20.6. Mistakes in the abstract, in amendments under PCT Article 19 (unless the International Preliminary Examining Authority is competent to authorize the rectification under PCT Rule 91.1(b)(iii)), or in a priority claim or in a notice correcting or adding a priority claim where the rectification would cause a change in the priority, also cannot be rectified under PCT Rule 91.

Applicants often attempt to rely upon the priority application to establish a basis for obvious mistake. The priority document (application) cannot be used to support obvious mistake corrections to the description, claims, or drawings or in a correction or amendment thereof. The rectification is obvious only in the sense that the competent authority (i.e., the receiving Office, the International Searching Authority, the International Preliminary Examining Authority, or the International Bureau), as appropriate, would immediately realize that something else was intended other than what appears in the document and that nothing else could have been intended than what is offered as rectification. Examples of obvious mistakes that are rectifiable include linguistic errors, spelling errors and grammatical errors so long as the meaning of the disclosure does not change upon entry of the rectification. Changes to chemical or mathematical formulas would not generally be rectifiable unless they would be common knowledge to anyone. A missing chemical formula or missing line of text would not be considered to be an obvious mistake subject to rectification.

Rectifications must be authorized:

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

(B) by the International Searching Authority if the mistake is in the description, claims, or drawings or in a correction thereof or in any paper submitted to that Authority, unless the International Preliminary Examining Authority is competent;

(C) by the International Preliminary Examining Authority if the mistake is in the description, claims,

or drawings or in a correction thereof, or in an amendment under Article 19 or 34, or in any paper submitted to that Authority, where a demand for Chapter II examination has been filed and has not been withdrawn and the date on which international preliminary examination shall start in accordance with PCT Rule 69.1 has passed;

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

The request for rectification must be addressed to the authority competent to authorize the rectification. It must be filed within 26 months from the priority date.

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

## 1837 - 1839 [Reserved]

## 1840 The International Searching Authority [R-01.2024]

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

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

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

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

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

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

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

(1) Approving or establishing the title and abstract;

(2) Considering the matter of unity of invention;

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

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

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

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

Pursuant to an agreement concluded with the International Bureau, the USPTO, as an International Searching Authority, agreed to conduct international searches and prepare international search reports and written opinions of the International Searching Authority, for, in addition to the United States of America, Bahrain, Barbados, Brazil, Chile, Dominican Republic, Egypt, Georgia, Guatemala, India, Israel, Jordan, Mexico, New Zealand, Oman, Panama, Peru, Philippines, Qatar, Saint Kitts and Nevis, Saint Lucia, Saint Vincent and the Grenadines, South Africa, Thailand, and Trinidad and Tobago. The agreement stipulated the English language and specified that the subject matter to be searched is that which is searched or examined in United States national applications.

**I. 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.

**II. THE MAIN PROCEDURAL STEPS IN THE INTERNATIONAL SEARCHING AUTHORITY**

The main procedural steps that any international application goes through in the International Searching Authority are (1) the making of the international search (PCT Article 15), (2) the preparing of the international search report (PCT Article 18 and PCT Rule 43) and (3) for international applications having an international filing date on or after January 1, 2004, the preparing of a written opinion of the International Searching Authority (PCT Rule 43 *bis* ).

**III. COMPETENT INTERNATIONAL SEARCHING AUTHORITY**

In respect of international applications filed with the U.S. Receiving Office, the United States International Searching Authority is competent to carry out the international search (PCT Article 16, PCT Rules 35 and 36, 35 U.S.C. 362 and 37 CFR 1.413). The European Patent Office (EPO), the Korean Intellectual Property Office (KIPO), the Australian Patent Office (IP Australia) (IPAU), the Israel Patent Office (ILPO), the Japan Patent Office (JPO), and the Intellectual Property Office of Singapore (IPOS) may also be competent to carry out the international search (PCT Article 16, PCT Rules 35 and 36) for international applications filed with the U.S. Receiving Office. The choice of International Searching Authority (ISA) must be made by the applicant on filing the international application. See MPEP §§ 1840.01 - 1840.07 for further information regarding the competency of the EPO, KIPO, IPAU, ILPO, JPO, and IPOS as an International Searching Authority for applications filed by U.S. nationals or residents in the USPTO or in the International Bureau (IB) as receiving Office.

The international search fee for the selected ISA must be paid to the USPTO as a receiving Office within one month from the time of receipt of the international application. The search fee amounts for the competent International Searching Authorities are found in each weekly edition of the *Official Gazette* in United States dollars. The search fee will change as costs and exchange rates require. If exchange rates fluctuate significantly, the fee may change frequently. Notice of changes will be published in the *Official Gazette* shortly before the effective date of any change.

If the selected ISA considers that the international application does not comply with the requirement of unity of invention as set forth in PCT Rule 13, the ISA may invite applicants to timely pay directly to it an additional search fee in the currency accepted by the ISA for each additional invention.

## 1840.01 The European Patent Office as an International Searching Authority [R-10.2019]

Since October 1, 1982, the European Patent Office (EPO) has been available as an International Searching Authority for PCT applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office (USPTO) as receiving Office or in the International Bureau (IB) as receiving Office. The original announcement appeared in the *Official Gazette* at 1022 OG 52 on September 28, 1982. An announcement modifying the original arrangement with the EPO appeared in the *Official Gazette* at 1412 OG 61 on March 10, 2015.

For any limitations or restrictions with the EPO as an ISA, please refer to the PCT Information section of the *Official Gazette* found on the USPTO's website (**www.uspto.gov/learning-and-resources/official-gazette**).

For additional information, e.g., subject matter limitations, additional search fees, cited documents, etc., please refer to Annex D of the PCT Applicant's Guide found on WIPO's website (**www.wipo.int/pct/en/guide/index.html**).

## 1840.02 The Korean Intellectual Property Office as an International Searching Authority [R-10.2019]

Since January 1, 2006, the Korean Intellectual Property Office (KIPO) has been available as an International Searching Authority for PCT applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office (USPTO) as receiving Office or in the International Bureau (IB) as receiving Office. The announcement appeared in the *Official Gazette* at 1302 OG 1261 on January 17, 2006.

For any limitations or restrictions with the KIPO as an ISA, please refer to the PCT Information section of the *Official Gazette* found on the USPTO's website (**www.uspto.gov/learning-and-resources/official-gazette**).

For additional information, e.g., subject matter limitations, additional search fees, cited documents, etc., please refer to Annex D of the PCT Applicant's Guide found on WIPO's website (**www.wipo.int/pct/en/guide/index.html**).

## 1840.03 The Australian Patent Office (IP Australia) as an International Searching Authority [R-10.2019]

Since November 1, 2008, the Australian Patent Office (IP Australia) has been available as an International Searching Authority (ISA) for PCT applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office (USPTO) as receiving Office or in the International Bureau (IB) as receiving Office. The original announcement appeared in the *Official Gazette* at 1337 OG 265 on December 23, 2008. An announcement modifying the arrangement with IP Australia appeared in the *Official Gazette* at 1409 OG 302 on December 30, 2014.

For any limitations or restrictions with IP Australia as an ISA, please refer to the PCT Information section of the *Official Gazette* found on the USPTO's website (**www.uspto.gov/learning-and-resources/official-gazette**).

For additional information, e.g., subject matter limitations, additional search fees, cited documents, etc., please refer to Annex D of the PCT Applicant's Guide found on WIPO's website (**www.wipo.int/pct/en/guide/index.html**).

## 1840.04 [Reserved]

## 1840.05 The Israel Patent Office (ILPO) as an International Searching Authority [R-10.2019]

Since October 1, 2014, the Israel Patent Office (ILPO) has been available as an International Searching Authority (ISA) for PCT applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office (USPTO) as receiving Office or in the International Bureau (IB) as receiving Office. The original announcement appeared in the *Official Gazette* at 1408 OG 52 on November 4, 2014. An announcement modifying the arrangement with the ILPO appeared in the *Official Gazette* at 1432 OG 264 on November 22, 2016.

For any limitations or restrictions with the ILPO as an ISA, please refer to the PCT Information section of the *Official Gazette* found on the USPTO's website (**www.uspto.gov/learning-and-resources/official-gazette**).

For additional information, e.g., subject matter limitations, additional search fees, cited documents, etc., please refer to Annex D of the PCT Applicant's Guide found on WIPO's website (**www.wipo.int/pct/en/guide/index.html**).

## 1840.06 The Japan Patent Office (JPO) as an International Searching Authority [R-10.2019]

Since July 1, 2015, the Japan Patent Office (JPO) has been available as an International Searching Authority (ISA) for PCT applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office (USPTO) as receiving Office or in the International Bureau (IB) as receiving Office. The original announcement appeared in the *Official Gazette* at 1417 OG 63 on August 4, 2015. An announcement modifying the arrangement with the

JPO appeared in the *Official Gazette* at 1454 OG 51 on September 4, 2018.

For any limitations or restrictions with the JPO as an ISA, please refer to the PCT Information section of the *Official Gazette* found on the USPTO's website (**www.uspto.gov/learning-and-resources/official-gazette**).

For additional information, e.g., subject matter limitations, additional search fees, cited documents, etc., please refer to Annex D of the PCT Applicant's Guide found on WIPO's website (**www.wipo.int/pct/en/guide/index.html**).

## 1840.07 The Intellectual Property Office of Singapore (IPOS) as an International Searching Authority [R-10.2019]

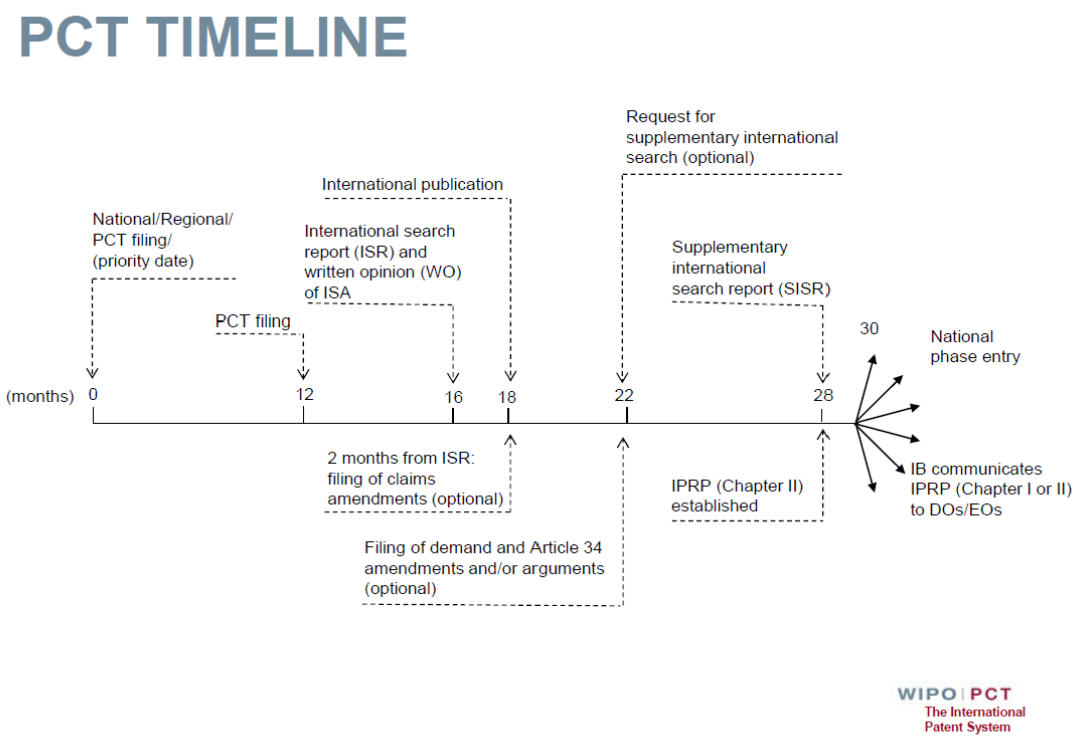
Since April 1, 2016, the Intellectual Property Office of Singapore (IPOS) has been available as an International Searching Authority (ISA) for PCT applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office (USPTO) as receiving Office or in the International Bureau (IB) as receiving Office. The announcement appeared in the *Official Gazette* at 1425 OG 190 on April 19, 2016.

For any limitations or restrictions with the IPOS as an ISA, please refer to the PCT Information section of the *Official Gazette* found on the USPTO's website (**www.uspto.gov/learning-and-resources/official-gazette**).

For additional information, e.g., subject matter limitations, additional search fees, cited documents, etc., please refer to Annex D of the PCT Applicant's Guide found on WIPO's website (**www.wipo.int/pct/en/guide/index.html**).

## 1841 [Reserved]

## 1842 Basic Flow Under the PCT [R-10.2019]




## I. MEASURING TIME LIMITS UNDER THE PCT

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

## II. INTERNATIONAL FILING DATE

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

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

As provided in PCT Rule 42 and PCT Rule 43 *bis* , the time limit for establishing the international search report (or a declaration that no international search report will be established) and written opinion is three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later.

### IV. INTERNATIONAL PUBLICATION

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

### V. SUPPLEMENTARY INTERNATIONAL SEARCH (SIS)

As provided in PCT Rule 45 *bis* , at any time prior to the expiration of 22 months from the priority date, the applicant can request one or more supplementary international searches each to be carried out by an International Searching Authority other than the International Searching Authority which carries out the main international search.

### VI. DEADLINE FOR FILING THE DEMAND

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

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

A listing of all national and regional offices, and the corresponding time limits for entering the national stage following PCT Chapter I and PCT Chapter II, may be found on WIPO's website at: **www.wipo.int/pct/en/texts/time_limits.html**.

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

PCT Article 22(1) was amended, effective April 1, 2002, to specify that the national stage requirements are due not later than at the expiration of 30 months from the priority date if no demand has been filed. Prior to April 1, 2002, PCT Article 22(1) specified that these requirements were due not later than at the expiration of 20 months from the priority date. See **www.wipo.int/pct/en/texts/time_limits.html** for a list of the Contracting States that have not yet changed their national laws to adopt the 30 month period now set forth in PCT Article 22(1). (At the time of publication of this Chapter, only two countries have not adopted Article 22(1) as amended: Luxembourg (LU) and the United Republic of Tanzania (TZ). It is noted that Luxembourg is included in the regional designation "EPO" and that the United Republic of Tanzania is included in the regional designation "ARIPO.")

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

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

## 1843 The International Search [R-07.2015]

***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 43 bis***

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

***43 bis.1 Written Opinion***

(a) Subject to Rule 69.1(b-*bis*), the International Searching Authority shall, at the same time as it establishes the international search report or the declaration referred to in Article 17(2)(a), establish a written opinion as to:

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

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

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

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6) and 35(2) and (3) and Rules 43.4, 43.6 *bis*, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

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

The international search is a thorough, high quality search of the most relevant resources. Upon completion of the international search an international search report is established. The report provides information on the relevant prior art to the applicant, the public, the designated Offices, and the International Preliminary Examining Authority.

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

The written opinion indicates whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable. The written opinion also indicates any defects in the form or content of the international application under the PCT Articles or Regulations. In addition, the written opinion includes any observations that the International Searching Authority wishes to make on the clarity of the claims, the description, and the drawings, or on the question of whether the claims are fully supported by the description.

## 1843.01 Prior Art for Chapter I Processing [R-10.2019]

***PCT Rule 33***

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

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

(a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

(b) When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such

making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

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

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

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

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

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

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

### *33.3 Orientation of the International Search*

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

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

## *PCT Rule 64*

## *Prior Art for International Preliminary Examination*

### *64.1 Prior Art*

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) shall be considered prior art provided that such making available occurred prior to the relevant date.

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

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

(ii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid;

(iii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

### *64.2 Non-Written Disclosures*

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

### *64.3 Certain Published Documents*

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

The objective of the international search is to discover relevant prior art (PCT Article 15(2)). “Prior art” consists of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations); it is relevant in respect of the international application if it is capable of being of assistance in determining that the claimed invention is or is not new and that the claimed invention does or does not involve an inventive step (i.e., that it is or is not obvious), and if the making available to the public occurred prior to the

international filing date for the purposes of the international search report and prior to the earliest validly claimed priority date for the purposes of the written opinion of the International Searching Authority. For further details, see PCT Rules 33, 43 *bis*.1(b) and 64.

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

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

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

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

The relevant date for the purpose of considering prior art for the purposes of establishment of the written opinion of the International Searching Authority is defined in PCT Rule 64.1(b) as the international filing date or, where the international application contains a claim for priority, the date provided in PCT Rule 64.1(b)(ii) - (iii). See MPEP § 1878.01(a).

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

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

**DOCUMENTS AND DATABASES SEARCHED BY THE INTERNATIONAL SEARCHING AUTHORITY**

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

Even though completeness should be the ultimate goal of the international search, this goal may at times be difficult to obtain, because of such factors as text search limitations and the inevitable imperfections of any classification system and its implementation. The examiner therefore consults the appropriate minimum documentation and the most relevant search resources for the technology, including databases listed in the U.S. Search Guidance index (available through the USPTO Intranet website), and organizes the search effort and utilizes the search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as art that fully anticipates any claims.

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

## 1843.02 Certain Subject Matter Need Not Be Searched [R-07.2022]

***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 Rule 66***

***Procedure Before the International Preliminary Examining Authority***

***66.1 Basis of the International Preliminary Examination***

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

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***PCT Rule 67***

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

***67.1 Definition***

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

(i) scientific and mathematical theories,

(ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than 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 Preliminary Examining Authority is not equipped to carry out an international preliminary examination concerning such programs.

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

(A) Scientific and mathematical theories;

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

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

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

(E) Mere presentation of information; and

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

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

The applicant considering the filing of an international application may be well advised not to file one if the subject matter of the application falls into one of the above mentioned areas. If the applicant still does file, the International Searching Authority may declare that it will not establish an international search report. Accordingly, applicant should take into consideration which International Searching Authority (e.g., European Patent Office)

is selected to conduct the international search. It is to be noted, nevertheless, that the lack of the international search report in such case will not have, in itself, any influence on the validity of the international application and the latter's processing will continue, including its communication to the designated Offices.

## 1843.03 No Search Required if Claims Are Unclear [R-07.2022]

If the International Searching Authority considers that the description, the claims, or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out, it may declare that it will not establish a search report (PCT Article 17(2)(a)(ii)). Further, for applications having an international filing date on or after January 1, 2004, if the International Searching Authority considers that the description, claims, or drawings are so unclear, or the claims are so inadequately supported by the description that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness), or industrial applicability of the claimed invention, the Authority shall not go into these issues in its written opinion with regard to the claims so affected (PCT Rules 43 *bis*.1(b) and 66.1(e)). For example, the examiner may determine that a meaningful search cannot be carried out or that no meaningful opinion can be formed in certain cases where a nucleotide and/or amino acid sequence listing is not furnished in the required form, language and manner. See Administrative Instructions Section 513(c) and MPEP § 1848. Further, the examiner may determine that a meaningful search cannot be carried out or that no meaningful opinion can be formed for improper multiple dependent claims (see PCT Rule 6.4(a)).

## 1843.04 Procedure for Claims Not Required To Be Searched and for Claims That Are Unclear [R-07.2015]

The International Searching Authority (ISA) may declare that a meaningful search cannot be carried out with respect to some of the claims only and/or that only certain claims relate to subject matter which the ISA is not required to and has decided not to search. Where only some of the claims will not be searched, the ISA searches the remaining claims of the international application. Any unsearched claims and the reasons why those claims have not been searched are indicated in Box No. II of the international search report (Form PCT/ISA/210).

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

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

The ISA establishes the written opinion of the International Searching Authority (Form PCT/ISA/237) at the same time it establishes either the international search report (Form PCT/ISA/210) or the declaration of non-establishment of the international search report (Form PCT/ISA/203). However, if the ISA determines that for any or all claims (A) the international application relates to subject matter for which it is not required to establish a written opinion concerning novelty, inventive step and industrial applicability, (B) the description, claims, or drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step, or industrial applicability, of the claimed invention, or (C) the subject matter of the claims relates to inventions for which no international search report will be established, the

ISA indicates, in Box No. III of the written opinion of the International Searching Authority (Form PCT/ISA/237), that no opinion with regard to novelty, inventive step or industrial applicability will be established with regard to those claims. In most instances it will be sufficient for the examiner to (A) indicate that no international search report has been established for the relevant claims as the reason for not establishing an opinion on novelty, inventive step, and industrial applicability and (B) refer to the international search report or declaration of non-establishment of the international search report for further details.

## 1843.05 Time Limit for Establishing the International Search Report and the Written Opinion of the International Searching Authority [R-07.2015]

Publication of the international application occurs at 18 months from the earliest priority date or, where there is no priority date, 18 months from the international filing date. The international search report is subject to international publication. For international applications filed before July 1, 2014, the written opinion of the International Searching Authority (ISA) is not published but is made available to the public after the expiration of 30 months from the priority date. See former PCT Rule 44 *ter*. For international applications filed on or after July 1, 2014, the written opinion of the ISA and any informal comments submitted by the applicant will be made available to the public in their original language as of the publication date. The Office goal is to have the search report and written opinion mailed in sufficient time to reach the International Bureau by the end of 16 months from the priority date or 9 months from the filing date if no priority claim is made. This is necessary since the technical preparations for publication are completed by 17.5 months from the earliest priority date. In view of the treaty mandated publication and the time needed for technical preparation, the Office sets time periods for completion of the search report and the written opinion which will ensure sufficient time to complete internal processing and review and achieve receipt of the search report and the written opinion at the International Bureau by the 16th month from the priority date. See PCT Rule 42.1 and 43 *bis*.1(a).

## 1844 The International Search Report [R-07.2015]

***PCT Article 18***

***The International Search Report***

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

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

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

The results of the international search are recorded in the international search report (Form PCT/ISA/210), which, together with the written opinion of the International Searching Authority (Form PCT/ISA/237) is transmitted with Form PCT/ISA/220. The search report will be published by the International Bureau and, together with the written opinion of the International Searching Authority, will serve as a basis for examination of the international application by the designated Offices and the International Preliminary Examining Authority.

The search report is only for the purpose of identifying prior art and should not contain any expressions of opinion, reasoning, argument or explanation as to any cited prior art. Such comments should be included in the written opinion of the International Searching Authority.

The printed international search report form (Form PCT/ISA/210) to be transmitted to the applicant and to the International Bureau contains two main sheets ("first sheet" and "second sheet") to be used for all searches. These two main sheets are intended for recording the important features of the search such as the fields searched and for citing documents revealed by the search. The printed international search report form also contains five optional continuation sheets for use where necessary. They are the: "continuation of first sheet (1)," "continuation of first sheet (2)," "continuation of first sheet (3)," "continuation of second sheet" and "patent family annex," respectively. The patent family annex sheet is not currently used by the United States International Searching Authority since

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

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

**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 special 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 (PCT Rule 43.5(e)).

## 1844.01 Preparing the International Search Report (Form PCT/ISA/210) [R-07.2022]

[Editor Note: This section discusses the July 2022 version of PCT/ISA/210. For international applications having an international filing date before July 1, 2022, information regarding form PCT/ISA/210 (revised January 2019) may be found in §1844.01 of the 10.2019 revision of the Ninth Edition of the MPEP published June 2020 at: **www.uspto.gov/web/offices/pac/mpep/old/mpep_E9R10.htm**.]

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

**I. BASIS OF THE REPORT**

***A. Box 1a – Language***

In most circumstances, the first box under box 1a is checked indicating that the search is carried out on the basis of the international application in the language in which it was filed. Alternatively, the second box under box 1a is checked and an indication of English made when the search is on the basis of a translation of the international application into English.

***B. Box 1b – Rectification of an Obvious Mistake***

Where the application includes the rectification of an obvious mistake authorized by or notified to the International Searching Authority under PCT Rule 91, box 1b of the first sheet is checked. The authorization or notification will generally be indicated on a Notification of Decision Concerning

Request for Rectification (Form PCT/RO/109 or PCT/ISA/217) (see MPEP § 1836).

### *C. Box 1c And Box No. I – Nucleotide and/or Amino Acid Sequence Listings*

Where the application discloses any nucleotide and/or amino acid sequence, box 1c of the first sheet is checked and Box No. I (appearing on "continuation of first sheet (1)") indicates in items 1.a and 1.b whether the sequence listing was filed as part of the international application or subsequent to the international filing date for the purpose of international search and whether it was accompanied by the required statement to the effect that the sequence listing does not go beyond the disclosure in the international application as filed.

Item 2 indicates the report was established to the extent that a meaningful search could be carried out without a WIPO Standard ST.26 compliant sequence listing. Item 3 indicates any additional comments.

## II. BOX 2 AND BOX NO. II – LIMITATION OF THE SUBJECT OF THE INTERNATIONAL SEARCH

The report indicates whether any claims are unsearchable for any of the reasons indicated below. If any such limitations of the subject of the search are applied, the claims in respect of which a search has not been carried out are identified and the reasons for this are indicated. The three categories where such limitations may arise are:

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

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

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

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

## III. BOX 3 AND BOX NO. III – LACK OF UNITY OF THE CLAIMED INVENTION

The report indicates whether the search is limited due to a lack of unity of invention. If unity is lacking, the claims in respect of which a search has not been carried out are identified and the reasons for this are indicated.

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

An explanation of the separate inventions is entered in the appropriate area in Box No. III (see MPEP § 1850).

If applicant paid all the required additional search fees for additional inventions, the examiner should check item 1 under Box No. III indicating that the international search report covers all searchable claims.

If the examiner did not invite payment of additional search fees, item 2 should be checked under Box. No. III and the international search report will cover all searchable claims.

If, in response to a lack of unity of invention, applicant paid only some of the required additional search fees for additional inventions, the examiner should check item 3 under Box No. III and indicate the claims for which fees were paid and therefore, covered by the international search.

If, in response to a lack of unity of invention, no required additional search fees were timely paid by the applicant, then the international search report is restricted to the invention first mentioned in the claims. The examiner should check item 4 under Box No. III and indicate the claims limited to the

first mentioned invention that are covered by the international search report.

Regarding the three boxes indicating a Remark on Protest, the first box would be checked if the payment of any additional search fees is accompanied by a protest. The second box would not be checked since the ISA/US does not require a protest fee. The third box would be checked if the payment of any additional search fees is not accompanied by a protest. See MPEP § 1850, subsection X., for a discussion of protest procedure.

## IV. TITLE, ABSTRACT, AND FIGURE FOR PUBLICATION

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

### *A. Box 4 - Title*

***PCT Rule 4***

***The Request (Contents)***

*****

***4.3 Title of the Invention***

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

*****

***PCT Rule 37***

***Missing or Defective Title***

***37.1 Lack of Title***

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

***37.2 Establishment of Title***

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

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

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

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

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

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

On the first sheet of the international search report, the examiner indicates the title text is approved (the first box under Box 4) or has been established (the second box under Box 4).

### *B. Box 5 and Box 6 - Abstract and Figure for Publication*

***PCT Rule 8***

***The Abstract***

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

(a) The abstract shall consist of the following:

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

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

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

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

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

***8.2 Figure***

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

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

*****

***PCT Rule 38***

***Missing or Defective Abstract***

***38.1 Lack of Abstract***

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

***38.2 Establishment of Abstract***

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

***38.3 Modification of Abstract***

The applicant may, until the expiration of one month from the date of mailing of the international search report, submit to the International Searching Authority:

(i) proposed modifications of the abstract; or

(ii) where the abstract has been established by the Authority, proposed modifications of, or comments on, that abstract, or both modifications and comments;

and the Authority shall decide whether to modify the abstract accordingly. Where the Authority modifies the abstract, it shall notify the modification to the International Bureau.

In general, the examiner will have to establish a new abstract if the applicant did not provide an abstract or if the abstract does not comply with PCT Rule 8. In determining the definitive contents of the abstract, or establishing the text of the abstract anew where it is missing, the examiner should take into consideration the fact that the abstract is merely for use as technical information and, in particular, must not be used for the purpose of interpreting the scope of the protection sought. The abstract constitutes an efficient instrument for the purpose of assisting the scientist, engineer, or researcher in searching in the particular technical field and should in particular make it possible to assess whether there is need for consulting the international application itself. WIPO guidelines for the preparation of abstracts are found in WIPO Standard ST.12/A, which is available from WIPO's website (**www.wipo.int/standards/en/part_03_standards.html**).

In considering the adequacy of the applicant's abstract and figure, because of practical difficulties experienced by the International Bureau with publication, examiners should have particular regard to the following:

(A) It is important that the abstract be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). Within this constraint the abstract must provide a summary of the technical information about the disclosure as contained in the description, claims, and drawings. It should be drafted so as to serve as an efficient scanning tool for searching purposes in the art.

(B) Phrases should not be used which can be implied, such as "This disclosure concerns," "The invention defined by this disclosure," and "This invention relates to."

(C) Only one figure should normally be selected unless this would lead to inadequate disclosure. The inclusion of more than two figures should not be considered except in extreme circumstances where necessary information cannot be otherwise conveyed. Where none of the figures is considered useful for the understanding of the invention (even where the applicant has suggested a figure), no figure should be selected.

(D) Abstracts may be incomprehensible if the numerals of the selected figure(s) do not correspond with those in the abstract. Thus, this should be avoided.

(E) An absence of reference numbers on the figures must be accepted as the examiner has no mechanism to initiate their addition.

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

In box 5 of the first sheet of the international search report, the examiner indicates approval of the text of the abstract by checking the first box. When the text of the abstract is missing or defective the second box is checked and the new abstract is established by entering the text of the new abstract. The defect or reason for establishing the new abstract should be indicated, e.g., too long or missing.

The applicant may submit modifications of the abstract until the expiration of one month from the date of mailing of the search report. If the examiner establishes a new abstract, the applicant may propose modifications of, and/or comment on, the new abstract after it has been established in the international search report. The applicant is allowed one month from the date of mailing of the international search report to respond to the examiner's abstract in the report. If the applicant does comment, the examiner takes the applicant's comments into consideration. It is not necessary for the examiner to reply to the applicant's comments even if adverse. If the examiner decides to amend the abstract established in the international search report based on the proposed modifications and/or comment, the International Bureau and the applicant are notified using Form PCT/ISA/205. See PCT Rule 38.3 and Administrative Instructions Section 515.

When indicating the figure to be published, the applicant's suggestion is found in Box No. IX of the request (Form PCT/RO/101). Where none of the figures is considered useful for the understanding of the abstract, this is indicated at the appropriate box (box 6b of the first sheet of Form PCT/ISA/210). When no drawings accompany the application, none of the boxes are checked. Otherwise, box 6a is checked and the reason for selecting the figure to be published is indicated, i.e., as suggested by the applicant, as selected by the examiner because either the applicant failed to suggest a figure in Box No. IX of Form PCT/RO/101 or the figure better characterizes the invention. It is not recommended to select more than one figure; however, if it is necessary to do so then the wording of the form should be changed to reflect the change from single case to plural case. For example, "figure" is changed to "figures", "is" to "are" and " No." to "Nos.".

## V. BOX A - CLASSIFICATION OF SUBJECT MATTER

The International Searching Authority assigns obligatory International Patent Classification (IPC) symbols in accordance with the rules as set forth in the Guide to the IPC and in the IPC itself (using the edition of the IPC in force at the time), whereby the technical subject of the invention of the application is identified. The International Searching Authority then records the International Patent Classification and the Cooperative Patent Classification (CPC) as required by the ISA/US in Box A of the second sheet of the international search report. The IPC Guide can be accessed via the Patent Examiner's Toolkit under Classification Tools or via WIPO's website (**www.wipo.int/classifications/ipc/en/**).

## VI. BOX B - RECORDING THE SEARCH

The examiner records the search history in Box B of the second sheet of the international search report. In recording the search history of the international search, the examiner lists the classification identification of the fields searched. Examiners are also encouraged to record the search history in sufficient detail to allow examiners of national stage applications to fully interpret and rely upon the international search. This includes recording the details of any patent and non-patent literature

searches as well as searches conducted on the Internet.

Where the international search report is entirely or partly based on a previous search made for an application relating to a similar subject, the previous application number and the relevant search history consulted for this previous search is, where appropriate, identified as having been consulted for the international application in question, except in those instances where the details of an earlier search cannot be ascertained, or whenever it is impractical to record the full details of the earlier search. In the later case, a summary of the earlier search should be included. Where the previous application has been published, this information is recorded in the international search report.

The USPTO in its capacity as the International Searching Authority makes a separate detailed search history of record in the applications. These search histories are mailed to applicants with the international search report.

## VII. BOX C - DOCUMENTS CONSIDERED TO BE RELEVANT

The completion of Box C of the second sheet of the international search report can be considered as having three components. These are: (A) the citation category; (B) the citation of the document together with identification of the relevant passages where appropriate; and (C) the identification of relevant claim numbers. The citation of multiple documents showing the same inventive elements should be kept to a minimum. Further, when citing a document, the examiner should clearly indicate which portions of the document are most relevant.

### *A. Citation Category*

Documents which are cited are given a category indication by way of an alphabetic character, details of which are given in PCT Administrative Instructions Sections 505 and 507 and below. The categories for citations are also explained under the "documents considered to be relevant" section of the report. A category should always be indicated for each document cited. Where needed, combinations of different categories are possible.

#### 1. Particularly Relevant Documents

Where a document cited in the international search report is particularly relevant, it is indicated by the letters "X" or "Y". Category "X" is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel or where a document is such that when considered in light of common general knowledge, a claimed invention cannot be considered to involve an inventive step. Category "Y" is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents of the same category, such combination being obvious to a person skilled in the art.

#### 2. Documents Defining the State of the Art and Not Prejudicing Novelty or Inventive Step

Where a document cited in the international search report represents state of the art and is not prejudicial to the novelty or inventive step of the claimed invention, it is indicated by the letter "A".

#### 3. Documents Which Refer to a Non-Written Disclosure

Where a document cited in the international search report refers to a non-written disclosure referred to in PCT Rule 33.1(b), the letter "O" is entered. Examples of such disclosures include conference proceedings. The document category "O" is always accompanied by a symbol indicating the relevance of the document, for example: "O,X", "O,Y", or "O,A".

#### 4. Intermediate Documents

Documents published on dates falling between the date of filing of the application being searched and the date of priority claimed, or the earliest priority if there is more than one (see PCT Article 2(xi)(b)), are denoted by the letter "P". The letter "P" is also given to a document published on the very day of the earliest date of priority of the patent application under consideration. The document category "P" is always accompanied by a symbol indicating the relevance of the document, for example: "P,X", "P,Y", or "P,A".

**5. Documents Relating to the Theory or Principle Underlying the Invention**

Where any document cited in the search report is a document that may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it is indicated by the letter "T".

**6. Potentially Conflicting Patent Documents**

Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date) but published on or later than that date and the content of which would constitute prior art relevant to novelty (PCT Article 33(2)) is indicated by the letter "E" (see PCT Administrative Instructions Section 507(b) and PCT Rule 33.1(c)).

**7. Documents Cited in the Application**

When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, such documents are denoted by the letter "D". The document category "D" is always accompanied by a symbol indicating the relevance of the document, for example: "D,X", "D,Y", or "D,A".

**8. Documents Cited for Other Reasons**

Where in the search report any document is cited for reasons other than those referred to in the foregoing paragraphs (in particular as evidence), for example:

(A) a document which may throw doubt on a priority claim (Article 4(C)(4) of the Paris Convention), or

(B) a document cited to establish the publication date of another citation,

the document is indicated by the letter "L". Brief reasons for citing the document should be given. Documents of this type need not be indicated as relevant to any particular claims. However, where the evidence that they provide relates only to certain claims (for example the "L" document cited in the search report may invalidate the priority in respect of certain claims and not others), then the citation of the document should refer to those claims.

***B. Citation of the Documents***

Identification of any document should be made according to WIPO Standard ST.14 (see PCT Administrative Instructions Section 503). For "A" citations it is not necessary to indicate the relevant claims unless there is good reason to do so; for example where there is a clear lack of unity *a priori* (see MPEP § 1850) and the citation is relevant only to a particular claim or group of claims or when the claims meet the criteria of novelty, inventive step, and industrial applicability under PCT Article 33(2) to (4) and the "A" category citations represent the most relevant prior art. The box on the second sheet of Form PCT/ISA/210 entitled "Further documents listed are in the continuation of Box C" is checked if a continuation sheet is used to list additional documents that will not fit in the space provided in Box C.

***C. Relationship Between Documents and Claims***

Each citation should include a reference to the claims to which it relates (see PCT Administrative Instructions Section 508). If necessary, various relevant parts of the document cited should each be related to the claims in like manner (with the exception of "L" documents and "A" documents). It is also possible for the same document to represent a different category with respect to different claims. For example:

WO1990/001867 A (WIDEGREN LARS (SE)) 8 March 1990 (08-03-1990), figures 1 and 2

X 1

Y 2-5

A 6-10

The above example means that Figures 1 and 2 of the cited document disclose subject matter which prejudices the novelty or inventive step of claim 1, which prejudices the inventive step of claims 2-5 when combined with another document cited in the

search report, and which represents non-prejudicial state of the art for the subject matter of claims 6-10.

## VIII. FINALIZATION OF THE SEARCH REPORT

The identification of the International Searching Authority which established the international search report and the date of actual completion, i.e., the date on which the report was drawn up are indicated at the bottom of the second sheet of the international search report. The international search report will be accompanied by a transmittal letter (Form PCT/ISA/220) indicating the date the search report was mailed to the applicant. See MPEP § 1845.02.

Pursuant to PCT Rule 43.8, the international search report must indicate the name of the officer of the International Searching Authority responsible for the report, i.e., the "authorized officer." An "authorized officer" is the person who actually performed the search work and prepared the search report, or another person who was responsible for supervising the search. See PCT Administrative Instructions Section 514. Thus, an examiner need not have signatory authority in order to be named as an authorized officer on the search report. However, the "file copy" of the search report must be signed by an examiner having at least partial signatory authority.

The international search report should be mailed within 3 months of receipt of the search copy or within 9 months from the priority date, whichever is later.

PATENT COOPERATION TREATY

# PCT

**INTERNATIONAL SEARCH REPORT**

(PCT Article 18 and Rules 43 and 44)

| Applicant's or agent's file reference | | FOR FURTHER ACTION |
|---|---|---|
| CMC-123-PCT | | see Form PCT/ISA/220 as well as, where applicable, item 5 below. |
| International application No. | International filing date *(day/month/year)* | (Earliest) Priority Date *(day/month/year)* |
| PCT/US2022/080008 | 10 March 2022 (10.03.2022) | 10 March 2021 (10.03.2021) |
| Applicant | | |
| ACME FASTENER CORPORATION | | |

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 4 sheets.

☐ It is also accompanied by a copy of each prior art document cited in this report.

1. **Basis of the report**

a. With regard to the **language**, the international search was carried out on the basis of:

☒ the international application in the language in which it was filed.

☐ a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

b. ☐ This international search report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43.6*bis*(a)).

c. ☐ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

2. ☐ **Certain claims were found unsearchable** (see Box No. II).

3. ☐ **Unity of invention is lacking** (see Box No. III).

4. With regard to the **title**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☐ the text is approved as submitted by the applicant.

☐ the text has been established, according to Rule 38.2, by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the **drawings**,

a. the figure of the **drawings** to be published with the abstract is Figure No. 3

☒ as suggested by the applicant.

☐ as selected by this Authority, because the applicant failed to suggest a figure.

☐ as selected by this Authority, because this figure better characterizes the invention.

b. ☐ none of the figures is to be published with the abstract.

Form PCT/ISA/210 (first sheet) (July 2022)

**INTERNATIONAL SEARCH REPORT**

International application No.
PCT/US2022/080008

**Box No. II Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)**

This international search report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. ☐ Claims Nos.:
because they relate to subject matter not required to be searched by this Authority, namely:

2. ☐ Claims Nos.:
because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:

3. ☐ Claims Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

**Box No. III Observations where unity of invention is lacking (Continuation of item 3 of first sheet)**

This International Searching Authority found multiple inventions in this international application, as follows:

Please See Continuation Sheet

1. ☒ As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.

2. ☐ As all searchable claims could be searched without effort justifying additional fees, this Authority did not invite payment of additional fees.

3. ☐ As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:

4. ☐ No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

**Remark on Protest**

☐ The additional search fees were accompanied by the applicant's protest and, where applicable, the payment of a protest fee.

☐ The additional search fees were accompanied by the applicant's protest but the applicable protest fee was not paid within the time limit specified in the invitation.

☒ No protest accompanied the payment of additional search fees.

Form PCT/ISA/210 (continuation of first sheet (2)) (July 2022)

**INTERNATIONAL SEARCH REPORT**

International application No.
PCT/US2022/080008

A. CLASSIFICATION OF SUBJECT MATTER
IPC: B25C 5/06, 5/16 (2022.01)
CPC: B25C 5/06, 5/16

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

See Search History Document

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

See Search History Document

Electronic database consulted during the international search (name of database and, where practicable, search terms used)

See Search History Document

C. DOCUMENTS CONSIDERED TO BE RELEVANT

| Category* | Citation of document, with indication, where appropriate, of the relevant passages | Relevant to claim No. |
|---|---|---|
| X<br>--<br>Y | US 4,375,867 A (NOVAK et al.) 08 March 1983 (08.03.1983), column 3, line 65 - column 4, line 49, and figure 3 | 1 and 2<br>---------<br>3 and 5-15 |
| A | | 4 and 16-20 |
| Y | US 4,183,453 A (BARRETT et al.) 15 January 1980 (15.01.1980), column 1, lines 40-49; column 2, line 40 - column 5, line 2; column 6, line 34 - column 7, line 7; and figures 5-7 | 3 and 5-10 |
| Y | US 3,041,614 A (D'HAEM et al.) 03 July 1962 (03.07.1962), column 4, line 76 - column 5, line 23 | 11-15 |

☐ Further documents are listed in the continuation of Box C. ☐ See patent family annex.

* Special categories of cited documents:
"A" document defining the general state of the art which is not considered to be of particular relevance
"D" document cited by the applicant in the international application
"E" earlier application or patent but published on or after the international filing date
"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)
"O" document referring to an oral disclosure, use, exhibition or other means
"P" document published prior to the international filing date but later than the priority date claimed
"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
"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"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
"&" document member of the same patent family

| Date of the actual completion of the international search | Date of mailing of the international search report |
|---|---|
| 05 July 2022 (05.07.2022) | **08 July 2022 (08.07.2022)** |
| Name and mailing address of the ISA/US<br>Mail Stop PCT, Attn: ISA/US<br>Commissioner for Patents<br>P.O. Box 1450 Alexandria, VA 22313-1450<br>Facsimile No. (571) 273-8300 | Authorized officer<br>Patent Examiner<br>Telephone No. (571) 272-4300 |

Form PCT/ISA/210 (second sheet) (July 2022)

INTERNATIONAL SEARCH REPORT
Information on patent family members

International application No.
PCT/US2022/080008

Box III. OBSERVATIONS WHERE UNITY OF INVENTION IS LACKING

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In order for all inventions to be searched, the appropriate additional search fees must be paid.

Group I, claim(s) 1 and 2, drawn to an electromagnetic fastener driver with a safety interlock to prevent actuation of the tool without the fastener output channel being pressed against a work piece.

Group II, claim(s) 3 and 5, drawn to an electromagnetic fastener driver with means to prevent the feeding of a fastener while the tool is being actuated.

Group III, claim(s) 6-10, drawn to an electromagnetic fastener driver with a control means to provide for multiple driving strokes to be delivered to a single fastener with a single actuation of the tool.

Group IV, claim(s) 11-15, drawn to an electromagnetic fastener driver with fastener anti-jam means.

Group V, claim(s) 4 and 16-20, drawn to an electromagnetic fastener driver with means to hold the fastener magazine in a predetermined position.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of the Group I invention is the safety interlock to prevent actuation of the tool without the fastener output channel being pressed against a work piece. The special technical feature of the Group II invention is the means to prevent the feeding of a fastener while the tool is being actuated. The special technical feature of the Group III invention is the control means to provide for multiple driving strokes to be delivered to the same fastener with a single actuation of the tool. The special technical feature of the Group IV invention is the fastener anti-jam means. The special technical feature of the Group V invention is the means to hold the fastener magazine in a predetermined position. None of these special technical features are common to the other groups, nor do they correspond to a special technical feature in the other groups. Therefore, unity of invention is lacking.

Form PCT/ISA/210 (extra sheet) (July 2022)

## 1845 Written Opinion of the International Searching Authority [R-07.2015]

***PCT Rule 43 bis.***

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

***43 bis .1. Written Opinion***

(a) Subject to Rule 69.1(b- *bis*) , the International Searching Authority shall, at the same time as it establishes the international search report or the declaration referred to in Article 17(2)(a), establish a written opinion as to:

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

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

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

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6) and 35(2) and (3) and Rules 43.4, 43.6 *bis* , 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

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

The examiner is required, in most instances, to establish a written opinion on novelty, inventive step, and industrial applicability of the claimed invention at the same time he/she establishes the international search report. The international search report and written opinion together serve to inform the International Preliminary Examining Authority of the documents and arguments necessary to complete the relevant assessments if international preliminary examination is demanded, and to inform the designated Offices of information that may be relevant to examination in the national phase. (The written opinion is transmitted to the designated offices in the form of an international preliminary report on patentability if no international preliminary examination report is established under Chapter II of the PCT). A written opinion of the International Searching Authority is not required in the limited instance where a demand for international preliminary examination and required fees (PCT Rule 69.1(a)) have been filed with the United States International Preliminary Examining Authority and the examiner considers all the conditions of PCT Article 34(2)(c)(i) to (iii) to be fulfilled. In this limited instance, a positive international preliminary examination report may be issued. See PCT Rule 69.1(b- *bis*)).

The applicant must be notified in the written opinion of the defects found in the application. The examiner is further required to fully state the reasons for his/her opinion (PCT Rules 66.1 *bis* and 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)).

## 1845.01 Preparing the Written Opinion of the International Searching Authority (Form PCT/ISA/237) [R-07.2022]

[Editor Note: This section discusses the July 2022 version of PCT/ISA/237. For international applications having an international filing date before July 1, 2022, information regarding form PCT/ISA/237 (revised January 2019) may be found in §1845.01 of the 10.2019 revision of the Ninth Edition of the MPEP published June 2020 at: **www.uspto.gov/web/offices/pac/mpep/old/mpep_E9R10.htm**.]

The classifications in the header on the cover sheet of Form PCT/ISA/237 are to be consistent with the classifications of subject matter in Box A on the second sheet of the International Search Report (Form PCT/ISA/210).

The Boxes marked on the cover sheet represent a summary of the indications detailed on the subsequent relevant sheets of Form PCT/ISA/237.

### I. BOX NO. I. — BASIS OF OPINION

When completing Box No. I, item 1, of Form PCT/ISA/237, the examiner must indicate whether or not the opinion has been established on the basis of the international application in the language in which it was filed. If a translation was furnished for the purpose of the search, this must be indicated.

Box No. I, item 2 of Form PCT/ISA/237 is to be marked when the opinion is established taking into account the rectification of an obvious mistake under PCT Rule 91.

With respect to Box No. I, item 3 of Form PCT/ISA/237, if the opinion has been based on a nucleotide and/or amino acid sequence disclosed and necessary to the claimed invention, the examiner must indicate whether the sequence listing was filed as part of the international application or subsequent to the international filing date for the purpose of international search, and whether it was accompanied by the required statement to the effect that the sequence listing does not go beyond the disclosure in the international application as filed, if filed subsequent to the international filing date.

Item 4 indicates the opinion was established to the extent that a meaningful opinion could be formed without a WIPO Standard ST.26 compliant sequence listing. Item 5 is available for providing any additional comments.

**II. BOX NO. II. — PRIORITY**

Box No. II of Form PCT/ISA/237 is to inform applicant of the status of a request for priority. Where one or more citations of the international search report were published after the earliest priority date, the validity of that earliest priority date requires checking. Where the priority document is one which is in the records of the ISA, it should be obtained from those records. If a copy of the priority document is not available before preparation of the written opinion of the ISA because it has not yet been provided by the applicant, and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, the written opinion of the ISA may be established as if the priority had been validly claimed.

If the examiner needs a copy of a foreign priority document, the copy will be supplied on request to the International Bureau (IB) unless the IB has not yet received the priority document, in which case the examiner may invite the applicant to furnish such a copy. See PCT Rule 66.7(a). The examiner may consult with the Technology Center Quality Assurance Specialist or PCT Special Program Examiner regarding requesting a copy of the priority document from the IB. If the priority document is not in English, the examiner may invite the applicant to furnish a translation of the priority document within two months of the invitation. See PCT Rule 66.7(b). Box No. II, item 3, "Additional Observations" may be used to invite applicant to supply a copy of the priority document and/or translation. Preparation of the written opinion by the International Searching Authority should not be delayed to await a response to the invitation. The written opinion of the ISA will ordinarily be established as if the priority claim had been validly claimed even though the copy and/or translation has not been furnished. However, failure to timely furnish a copy of the priority document and/or translation may result in any further written opinion or international preliminary examination report of the International Preliminary Examining Authority being established as if the priority had not been claimed.

If applicant fails to furnish a copy or translation of the earlier application, whose priority has been claimed, check item 1 and then check the first box of the subsection if applicant failed to furnish a copy of the earlier application whose priority has been claimed, and check the second box of the subsection if applicant failed to furnish a translation of the earlier application whose priority has been claimed.

When the claim for priority has been found invalid (e.g., the notification under PCT Rule 26 *bis*.2(b) has been provided or all claims are directed to inventions which were not described and enabled by the earlier application), check item 2 in Box II and indicate why the claim for priority has been found invalid following item 3 "Additional observations."

**III. BOX NO. III. — NON-ESTABLISHMENT OF OPINION ON NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY**

Box No. III of Form PCT/ISA/237 is intended to cover situations where some or all claims of an application are so unclear or inadequately supported

by the description that the question of novelty, inventive step (nonobviousness), and industrial applicability cannot be considered, or where the international application or claims thereof relate to subject matter for which it is not required to establish a written opinion concerning novelty, inventive step and industrial applicability, or where no international search report has been established for the claims.

If some or all of the claims of an application relate to subject matter for which it is not required to establish a written opinion concerning novelty, inventive step and industrial applicability, check the appropriate box, indicate which claims relate to that subject matter and specify the reasons e.g., improper multiple dependent claims that fail to comply with PCT Rule 6.4.

If some or all of the claims of an application are so unclear that no meaningful opinion could be formed, check the appropriate box, indicate which claims are unclear and specify the reasons.

If some or all of the claims are so inadequately supported by the description that no meaningful opinion could be formed, check the appropriate box.

If no international search report has been established for certain claims, check the appropriate box and indicate the claim numbers.

If a meaningful opinion could not be formed without the nucleotide and/or amino acid sequence listing because it does not comply with WIPO Standard ST.26, and/or the applicant did not pay the late furnishing fee, if required, the examiner must indicate the reason for the non-compliance.

### IV. BOX NO. IV. — LACK OF UNITY OF INVENTION

Box No. IV of Form PCT/ISA/237 should be used by the examiner to notify applicant that lack of unity has been found by checking item 1, and one of the four boxes under item 1.

If applicant paid additional fees for additional inventions, the examiner should check the first box under item 1.

If the additional fees were paid under protest, the examiner should check the second box under item 1.

Regarding the third box, since the ISA/US does not require a protest fee, this box would not be checked.

If the search report is based on the first mentioned invention (no additional search fees were paid), the examiner should check the fourth box under item 1.

Item 2 of Box No. IV is to be completed if the examiner determines that unity of invention is lacking but chooses not to invite the applicant to agree to a search limited to the first mentioned invention or pay additional fees.

If a lack of unity exists, the examiner would mark the second box under item 3. However, since the reasons for the lack of unity have already been set forth on the simultaneously issued international search report, the examiner can simply state that the reason the requirement of unity of invention is not complied with is set forth in the international search report. The first box under item 3 would never be marked.

Item 4 is used by the examiner to indicate which parts of the application form the basis of the opinion after the lack of unity of invention has been explained. The first box should be checked when the opinion is established for all parts. Otherwise, the second box is checked and the relevant claims identified.

### V. BOX NO. V. — REASONED STATEMENT WITH REGARD TO NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY OF CLAIMS

In Box No. V of Form PCT/ISA/237, the examiner must list in summary form all claims with regard to the criteria of novelty (N), inventive step (IS), and industrial applicability (IA). For definitions of novelty, inventive step, and industrial applicability see MPEP §§ 1878.01(a)(1), 1878.01(a)(2), and 1878.01(a)(3), respectively.

Box No. V is the main purpose of the written opinion. All claims without fatal defects are treated

on the merits in Box No. V as to novelty, inventive step (nonobviousness) and industrial applicability.

The treatment of claims in Box No. V is similar in format to an Office action in a U.S. national patent application except that the words "rejection," "patentability," and "allowable are never used in a written opinion. On the international level, all written opinions are nonbinding and a patent does not issue; what does issue is an international preliminary report on patentability (IPRP), which is nonbinding on the elected States.

Examiner statements in Box No. V can be positive or negative. If the claims define over the prior art and meet the test of novelty, inventive step (nonobviousness) and industrial applicability, a positive statement equivalent to detailed reasons for allowance in a corresponding U.S. national application should be provided, indicating how the claims meet the tests of novelty, inventive step and industrial applicability. Form paragraphs 18.04 and 18.04.01 may be used for this purpose.

**¶ 18.04 Meets Novelty and Inventive Step**

Claim **[1]** the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest **[2]**.

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and insert the verb --meet-- or --meets--, as appropriate.

2. In bracket 2, insert the details of the claimed subject matter that render it unobvious over the prior art.

3. If the claims also meet the industrial applicability criteria set out in PCT Article 33(4), this form paragraph should be followed by form paragraph 18.04.01.

4. If the claims do not meet the industrial applicability criteria set out in PCT Article 33(4), this form paragraph should be followed by form paragraph 18.03.

**¶ 18.04.01 Meets Industrial Applicability**

Claim **[1]** the criteria set out in PCT Article 33(4), and thus **[2]** industrial applicability because the subject matter claimed can be made or used in industry.

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --meet-- or -- meets--, as appropriate.

2. In bracket 2, insert --have-- or --has--, as appropriate.

3. If the claims meet all of the requirements of PCT Article 33(2)-(4), use form paragraph 18.04 before this form paragraph to provide positive statements for novelty and inventive step under PCT Article 33(2)-(3).

4. If the claims have industrial applicability but lack novelty and inventive step, use this form paragraph and additionally use form paragraph 18.01.

5. If the claims have industrial applicability and novelty but lack inventive step, use this form paragraph and additionally use one or more of form paragraphs 18.02, 18.02.01 and 18.02.02, as appropriate.

6. If the claims do not have industrial applicability, use form paragraph 18.03 instead of this form paragraph.

If, on the other hand, it is the opinion of the examiner that some or all claims lack novelty, inventive step, or industrial applicability, specific reasons must be given similar to those used in U.S. national applications.

Form paragraphs 18.01, 18.02, 18.02.01, 18.02.02, and 18.03 may be used, as appropriate, to explain the negative statements listed in Box No. V.

**¶ 18.01 Lacks Novelty**

Claim **[1]** novelty under PCT Article 33(2) as being anticipated by **[2]**.

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.

2. In bracket 2, insert name of prior art relied upon.

**¶ 18.02 Lacks Inventive Step - One Reference**

Claim **[1]** an inventive step under PCT Article 33(3) as being obvious over **[2]**. **[3]**

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.

2. In bracket 2, insert name of prior art relied upon.

3. In bracket 3, add reasoning.

**¶ 18.02.01 Lacks Inventive Step - Two References**

Claim **[1]** an inventive step under PCT Article 33(3) as being obvious over **[2]** in view of **[3]**. **[4]**

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.

2. In bracket 2, insert name of PRIMARY prior art relied upon.

3. In bracket 3, insert name of SECONDARY prior art relied upon.

4. In bracket 4, add reasoning.

**¶ 18.02.02 Lacks Inventive Step - Additional Reference**

Claim **[1]** an inventive step under PCT Article 33(3) as being obvious over the prior art as applied in the immediately preceding paragraph and further in view of **[2]**. **[3]**

**Examiner Note:**

1. This form paragraph may follow either 18.02 or 18.02.01.

2. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.

3. In bracket 2, insert name of additional prior art relied upon.

4. In bracket 3, add reasoning.

**¶ 18.03 Lacks Industrial Applicability**

Claim **[1]** industrial applicability as defined by PCT Article 33(4). **[2]**

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.

2. In bracket 2, add reasoning.

Examiners are encouraged to indicate any amendments which applicant could present which would avoid a negative statement in the international preliminary examination report in the event that applicant chooses to file a demand.

## VI. BOX NO. VI. — CERTAIN DOCUMENTS CITED

Since all documents cited at the time of establishment of the written opinion will be listed on the simultaneously established search report, there is no need to also list them on the written opinion, and as such this box should be left blank.

## VII. BOX NO. VII. — CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION

In Box No. VII of Form PCT/ISA/237, defects in the form and content of the international application are identified.

Defects that would be listed in Box No. VII include informalities such as misplaced and/or omitted drawing numerals, misspelled words, and grammatical errors.

The following form paragraphs are used in Box No. VII of PCT/ISA/237, "Certain defects in the international application," for noting technical defects.

**¶ 18.08 Drawing - Defect in Form or Contents Thereof**

The drawings contain the following defect(s) in the form or content thereof: **[1]**

**Examiner Note:**

In bracket 1, insert identification of defects in drawings.

**¶ 18.08.01 Drawing Is Required**

The subject matter of this application admits of illustration by drawing to facilitate understanding of the invention. Applicant is required under PCT Article 7(1) to furnish a drawing.

**¶ 18.09 Description - Defect in Form or Contents Thereof**

The description contains the following defect(s) in the form or contents thereof: **[1]**

**Examiner Note:**

In bracket 1, insert the technical problem, e.g., misspelled word.

**¶ 18.10 Claims - Defect in Form or Contents Thereof**

Claim **[1]** contain(s) the following defect(s) in the form or contents thereof: **[2]**

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, and insert claim no.(s).

2. In bracket 2, identify the technical deficiency.

## VIII. BOX NO. VIII. — CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION

In Box No. VIII, the examiner notifies the applicant of observations made as to the clarity of the claims, the description, the drawings, or on the question whether the claims are fully supported by the description.

If the claims, the description, or the drawings are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the question of novelty, inventive step (nonobviousness) or industrial applicability, the applicant is so informed in Box No. III. See PCT Article 34(4)(a)(ii). Reasons for the examiner's opinion that the claims, description and drawings, etc., lack clarity must also be provided.

If the above situation is found to exist in certain claims only, the provisions of PCT Article 34(4)(a)(ii) shall apply to those claims only.

If the lack of clarity of the claims, the description, or the drawings is of such a nature that it is possible to form a meaningful opinion on the claimed subject matter, then it is required that the examiner consider the claims and render a written opinion on novelty, inventive step, and industrial applicability in Box No. V.

Since the claims of an international application are not subject to a rejection on either art or indefiniteness consistent with U.S. practice, observations by the examiner with regard to clarity of the claims, the description and the drawings will be treated in the form of an objection in the written opinion in Box No. VIII.

The following form paragraphs may be used in Box No. VIII, "Certain observations on the international application," of Form PCT/ISA/237 for noting objections which are substantive rather than merely technical in nature.

**¶ 18.11 Drawing Objections - Lack Clarity**

The drawings are objected to under PCT Article 7 as lacking clarity under PCT Article 7 because: **[1]**

**Examiner Note:**

In bracket 1, insert reasons why the drawings lack clarity, e.g., inaccurate showing.

**¶ 18.12.01 Claims Objectionable - Inadequate Written Description**

Claim **[1]** objected to under PCT Article 6 because the claim **[2]** not fully supported by the description. The application, as originally filed, did not describe: **[3]**

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s), and the verb --is-- or --are--, as appropriate.

2. In bracket 2, pluralize "claim" if needed, and insert the verb --is-- or --are--.

3. In bracket 3, identify subject matter not described in the application as filed.

**¶ 18.13.01 Claims Objectionable - Non-Enabling Disclosure**

Claim **[1]** objected to under PCT Article 6 because the claim **[2]** not fully supported by the description. The description does not disclose the claimed invention in a manner sufficiently clear and complete for the claimed invention to be carried out by a person skilled in the art as required by PCT Article 5 because: **[3]**

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.

2. In bracket 2, pluralize "claim" if needed, insert the verb --is-- or --are--.

3. In bracket 3, identify the claimed subject matter that is not enabled and explain why it is not enabled.

**¶ 18.14.01 Claims Objectionable - Lack of Best Mode**

Claim **[1]** objected to under PCT Article 6 because the claim **[2]** not fully supported by the description. The description fails to set forth the best mode contemplated by the applicant for carrying out the claimed invention as required by PCT Rule 5.1(a)(v) because: **[3]**.

**Examiner Note:**

1. In bracket 1, pluralize "claim" if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.

2. In bracket 2, pluralize "claim" if needed, and insert the appropriate verb --is-- or --are--.

3. In bracket 3, insert the objection and reasons.

**¶ 18.15 Claims Objectionable - Indefiniteness**

Claim **[1]** objected to under PCT Article 6 as lacking clarity because claim **[2]** indefinite for the following reason(s): **[3]**

**Examiner Note:**

1. In brackets 1 and 2, pluralize "claim" if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.

2. In bracket 3, insert reasons.

## IX. AUTHORIZED OFFICER

Pursuant to PCT Rules 43 *bis*.1 and 70.14, the written opinion of the International Searching Authority must indicate the name of the officer of the International Searching Authority responsible for the written opinion, i.e., the "authorized officer." An "authorized officer" is the person who actually performed the search work and prepared the search report and the written opinion, or another person who was responsible for supervising the search and the establishment of the written opinion. See PCT Administrative Instructions Section 514. Thus, an examiner need not have signatory authority in order to be named as an authorized officer on the written opinion. However, the "file copy" of the written opinion must be signed by an examiner having at least partial signatory authority.

## X. TIME TO REPLY

If, in response to the written opinion of the International Searching Authority (Form PCT/ISA/237), applicant wishes to file a demand and amendments and/or arguments, the time period for response is 3 months from the mailing of the international search report and the written opinion or before the expiration of 22 months from the priority date, whichever expires later.

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:

JOHN J. SMITH
220 RICHMOND HIGHWAY
ARLINGTON, VA 22202

# PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43*bis*.1)

| | |
|---|---|
| Date of mailing *(day/month/year)* | 08 July 2022 (08.07.2022) |
| Applicant's or agent's file reference: CMC-123-PCT | FOR FURTHER ACTION: See paragraph 2 below |

| International application No. | International filing date *(day/month/year)* | Priority date *(day/month/year)* |
|---|---|---|
| PCT/US2022/080008 | 10 March 2022 (10.03.2022) | 10 March 2021 (10.03.2021) |

International Patent Classification (IPC) or both national classification and IPC
IPC: B25C 5/06, 5/16 (2022.01)
CPC: B25C 5/06, 5/16

Applicant
ACME FASTENER CORPORATION

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☒ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1*bis*(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

| Name and mailing address of the ISA/US | Date of completion of this opinion | Authorized officer |
|---|---|---|
| Mail Stop PCT, Attn: ISA/US<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450<br>Facsimile No. (571) 273-8300 | 05 July 2022 (05.07.2022) | Patent Examiner<br>Telephone No. (571) 272-4300 |

Form PCT/ISA/237 (cover sheet) (July 2022)

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US2022/080008

**Box No. I Basis of this opinion**

1. With regard to the **language**, this opinion has been established on the basis of:

☒ the international application in the language in which it was filed.

☐ a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43*bis*.1(b)).

3. ☐ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, this opinion has been established on the basis of a sequence listing:

a. ☐ forming part of the international application as filed.

b. ☐ furnished subsequent to the international filing date for the purposes of international search (Rule 13*ter*.1(a)),

☐ accompanied by a statement to the effect that the sequence listing does not go beyond the disclosure in the international application as filed.

4. ☐ With regard to any nucleotide and/or amino acid sequence disclosed in the international application, this opinion has been established to the extent that a meaningful opinion could be formed without a WIPO Standard ST.26 compliant sequence listing.

5. Additional comments:

Form PCT/ISA/237 (Box No. I) (July 2022)

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US2022/080008

**Box No. IV Lack of unity of invention**

1. ☒ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has, within the applicable time limit:
   - ☒ paid additional fees.
   - ☐ paid additional fees under protest and, where applicable, the protest fee.
   - ☐ paid additional fees under protest but the applicable protest fee was not paid.
   - ☐ not paid additional fees.
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
   - ☐ complied with.
   - ☒ not complied with for the following reasons:

See the lack of unity section of the International Search Report (Form PCT/ISA/210)

4. Consequently, this opinion has been established in respect of the following parts of the international application:
   - ☒ all parts.
   - ☐ the parts relating to claims Nos. _____

Form PCT/ISA/237 (Box No. IV) (July 2022)

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US2022/080008

**Box No. V** **Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement**

1. Statement

| | | | |
|---|---|---|---|
| Novelty (N) | Claims | 3-20 | YES |
| | Claims | 1 and 2 | NO |
| Inventive step (IS) | Claims | 4 and 16-20 | YES |
| | Claims | 1-3 and 5-15 | NO |
| Industrial applicability (IA) | Claims | 1-20 | YES |
| | Claims | NONE | NO |

2. Citations and explanations:

Claims 1 and 2 lack novelty under PCT Article 33(2) as being anticipated by Novak et al. (US 4,375,867). Novak et al. teaches the claimed electromagnetic fastener tool 10 with a housing 12 having a fastener magazine assembly 18 mounted thereon with the magazine assembly having a fastener output channel. The magazine assembly 18 is pivoted between a first position wherein the tool can not be actuated and a second position wherein a fastener may be driven from the tool (note figure 3 and column 3, line 65 through column 4, line 5). The-magazine assembly 18 is moved from the first position to the second position by placing the fastener output channel firmly against a work piece. As shown in figure 3 and described at column 4, lines 6-49, the magazine assembly 18 and the trigger button 24 are coupled by a safety mechanism 62. This safety mechanism has a sliding rod 64 with the lower end of the rod 64 being attached to the top of the channel 48 of the magazine assembly such that rod 64 moves with the magazine assembly. When the magazine assembly 18 is placed on a work piece, it rotates into the second position and pushes rod 64 upward. The upper portion of rod 64 has a spring 74 which includes a cam surface 76, a curved surface 78 and a bottom edge 81. Bottom edge 81 of spring 74 is normally positioned adjacent flange 86 of trigger button 24 and blocks upward movement of the trigger button. Thus, the trigger button may not be depressed (moved upwards) to actuate the tool until the bottom edge of spring 74 is moved away from flange 86. This is accomplished by the interaction of curved surface 78 of spring 74 with a corresponding curved surface 82 fixed to the housing 12. When rod 64 moves upward, spring 74 is bent away from trigger button 24 by the interaction of curved surfaces 78 and 82. Thus, placing the fastener output channel of the magazine assembly 18 against the work piece moves bottom edge 81 of spring 74 out of its blocking position adjacent flange 86 of trigger button 24 and permits the tool to be actuated.

---See Supplemental Box---

Form PCT/ISA/237 (Box No. V) (July 2022)

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US2022/080008

**Box No. VII Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof: It is noted that the word "staples" at line 15 of page 9 is misspelled as "stpales".

Form PCT/ISA/237 (Box No. VII) (July 2022)

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US2022/080008

**Supplemental Box**

In case **the space in any of the preceding boxes is not sufficient.**
Continuation of:

Box No. V.2. Citations and Explanations

Claims 3 and 5-10 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. (US 4,375,867) in view of Barrett et al. (US 4,183,453). As for claims 3 and 5, Novak et al. does not teach the claimed mechanical means for blocking the feeding of a fastener from the magazine while the magazine assembly is in the second position (pressed against the work piece). Barrett et al. teaches such a blocking means. Note figures 5-7 and column 6, line 34 through column 7, line 7. The Barrett et al. blocking means is interconnected with the trigger switch 40 such that when the trigger is depressed to actuate the tool and drive a fastener from the magazine output channel, a clamp 48 is depressed onto the top of the second fastener in the fastener stick in magazine 42. Forward movement of the second fastener into the magazine output channel is thus prevented as long as trigger switch 40 remains depressed. When the trigger switch is released, clamp 48 moves away from the fastener stick and a fastener can be fed into the magazine output channel. Since the provision of such a blocking means is known as a desirable feature for solenoid actuated fastener driving tools because they are notorious for needing multiple strokes of the driver to properly drive a fastener, it would have been obvious to one of ordinary skill in this art to provide such a blocking means in the Novak et al. solenoid actuated tool. Note the teaching in Barrett et al. from column 2, line 40 through column 5, line 2 regarding the need for multiple blows from the driver to a single fastener. Barrett et al. discloses a control means which provides for multiple blows by the driver 32 on the fastener for each actuation of the trigger. Barrett et al. teaches at column 1, lines 40-49 that is advantageous to operate solenoid actuated fastener drivers in this manner because such tools may require two or more blows from the driver to properly drive the fastener an adequate depth into the work piece. In view of this teaching, it would have been obvious to one of ordinary skill in this art to provide the Novak et al. tool with the claimed control means to provide a predetermined plurality of driving strokes to a single fastener.

Claims 11-15 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. (US 4,375,867) in view of D'Haem et al. (US 3,041,614). Novak at al. does not teach the provision of an anti-jam means to clear jammed fasteners from the fastener output channel. The claims call for the fastener output channel to be formed with a removable cover plate to permit clearing the tool in the event of a fastener jam. D'Haem et al. teaches the use of a removable cover plate 51 to allow clearing the tool as claimed (see column 4, line 76 through column 5, line 23). In view of this teaching, it would have been obvious to one of ordinary skill in this art to modify Novak et al. to include a removable cover plate in order to allow the tool to be cleared.

Claims 4 and 16-20 meet the criteria set out in PCT Article 33(2) and (3) because the prior art does not teach or fairly suggest the claimed means to hold the fastener magazine in the second position as claimed in claims 4 and 16-20.

Claims 1-20 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

Form PCT/ISA/237 (Supplemental Box) (July 2022)

## 1845.02 Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or the Declaration (Form PCT/ISA/220) [R-07.2022]

The examiner completes the Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or the Declaration (Form PCT/ISA/220) upon completion of the International Search Report (Form PCT/ISA/210) or the Declaration of Non-Establishment of the International Search Report (Form PCT/ISA/203) and completion of the Written Opinion of the International Searching Authority (Form PCT/ISA/237).

The Form PCT/ISA/220 serves as a cover letter for the PCT/ISA/210 or PCT/ISA/203 and for the PCT/ISA/237.

The Form PCT/ISA/220 indicates the mailing date, which is important for the computation of the time limit for filing amendments to the claims under PCT Article 19 (see MPEP § 1853) and proposed modifications of, or comments on, the abstract. The mailing date on Form PCT/ISA/220 may also establish the time limit for making a demand under PCT Rule 54 *bis*.1 (see MPEP § 1842, subsection VI) and for making Article 34 amendments that will be ensured consideration by the examiner (see MPEP § 1871).

### I. ADDRESS FOR CORRESPONDENCE

The address for correspondence is taken from the request (Form PCT/RO/101). When an agent represents the applicant, the address for correspondence is listed in Box No. IV of the PCT Request form. For applicants processing their own applications, the address for correspondence may be listed in Box No. II of the Request form. However, where a Notification of the Recording of a Change (Form PCT/IB/306) shows any changes in the applicant or address for correspondence effected under PCT Rule 92 *bis* , the later address is used.

### II. APPLICANT

When there is more than one applicant in respect of the international application, only the first mentioned of these on the Request form is indicated in the international search report. Other applicants, if any, are indicated by the words “et al” following the first applicant’s name. The first mentioned applicant is indicated in Box No. II of the Request form, a second applicant is listed in Box No. III; further applicants are listed on the continuation sheet if there are more than two applicants. Company names are preferably written in capital letters; for personal names the family name is preferably given first in capital letters and the given names are in mixed case. This helps to identify the family name.

**PATENT COOPERATION TREATY**

From the INTERNATIONAL SEARCHING AUTHORITY

To:

JOHN J. SMITH
220 RICHMOND HIGHWAY
ARLINGTON, VA 22202

# PCT

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL SEARCH REPORT AND THE WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY, OR THE DECLARATION

(PCT Rule 44.1)

| | |
|---|---|
| Applicant's or agent's file reference: CMC-123-PCT | Date of mailing *(day/month/year)*: 08 July 2022 (08.07.2022) |
| International application No.: PCT/US2022/080008 | **FOR FURTHER ACTION** See paragraphs 1 and 4 below |
| Applicant: ACME FASTENER CORPORATION | International filing date *(day/month/year)*: 10 March 2022 (10.03.2022) |

1. ☒ The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.

   **Filing of amendments and statement under Article 19:**
   The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

   **When?** The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

   **How?** Directly to the International Bureau preferably through ePCT, or on paper to:
   The International Bureau of WIPO, 34, chemin des Colombettes, 1211 Geneva 20, Switzerland

   **For more detailed instructions**, see the *PCT Applicant's Guide*, International Phase, paragraphs 9.004 – 9.011.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.

3. ☐ **With regard to any protest** against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:
   ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with any request to forward the texts of both the protest and the decision thereon to the designated Offices.
   ☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Reminders**

   The applicant may **submit comments on an informal basis on the written opinion of the International Searching Authority** to the International Bureau. These comments will be made available to the public after international publication. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established.

   Shortly after the expiration of **18 months from the priority date, the international application will be published** by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau before the completion of the technical preparations for international publication (Rules 90*bis*.1 and 90*bis*.3).

   Within **19 months** from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase **until 30 months** from the priority date (in some Offices even later); otherwise, the applicant must, **within 20 months** from the priority date, perform the prescribed acts for **entry into the national phase** before those designated Offices. In respect of other designated Offices, the time limit of **30 months** (or later) will apply even if no demand is filed within 19 months. For details about the applicable time limits, Office by Office, see www.wipo.int/pct/en/texts/time_limits.html and the *PCT Applicant's Guide*, National Chapters.

   Within **22 months from the priority date, the applicant may request that a supplementary international search be carried out** by a different International Searching Authority that offers this service (Rule 45*bis*.1). The procedure for requesting supplementary international search is described in the *PCT Applicant's Guide*, International Phase, paragraphs 8.006-8.032.

| | |
|---|---|
| Name and mailing address of the ISA/US<br>Mail Stop PCT, Attn: ISA/US<br>Commissioner for Patents<br>P.O. Box 1450 Alexandria, VA 22313-1450<br>Facsimile No. (571) 273-8300 | Authorized officer<br>Patent Examiner<br>Telephone No. (571) 272-4300 |

Form PCT/ISA/220 (revised January 2020)

## 1846 - 1847 [Reserved]

## 1848 Sequence Listings [R-01.2024]

[Editor Note: The PCT Rules and Administrative Instructions reproduced in this section are applicable to international applications, including national phase applications, having an international filing date on or after July 1, 2022. For international applications having an international filing date before July 1, 2022, the applicable rules and instructions may be found at: **www.wipo.int/pct/en/texts/**.]

***PCT Rule 13 ter***

***Nucleotide and/or Amino Acid Sequence Listings***

***13 ter.1 Procedure before the International Searching Authority***

(a) Where the international application contains disclosure of nucleotide and/or amino acid sequences that, pursuant to the Administrative Instructions, are required to be included in a sequence listing, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing complying with the standard provided for in the Administrative Instructions, unless such listing is already available to it in a form, language and manner acceptable to it, and to pay to it, where applicable, the late furnishing fee referred to paragraph (c), within a time limit fixed in the invitation.

(b) [Deleted]

(c) The furnishing of a sequence listing in response to an invitation under paragraph (a) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

(d) If the applicant does not, within the time limit fixed in the invitation under paragraph (a), furnish the required sequence listing and pay any required late furnishing fee, the International Searching Authority shall only be required to search the international application to the extent that a meaningful search can be carried out without the sequence listing.

(e) Any sequence listing not contained in the international application as filed, whether furnished in response to an invitation under paragraph (a) or otherwise, shall not form part of the international application, but this paragraph shall not prevent the applicant from amending the description in relation to a sequence listing pursuant to Article 34(2)(b).

***13 ter.2 Procedure before the International Preliminary Examining Authority***

Rule 13 *ter*.1 shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

***13 ter.3 Sequence Listing for Designated Office***

No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

***PCT Administrative Instructions Section 513***

***Sequence Listings***

(a) [Deleted]

(b) Where the international search report and the written opinion of the International Searching Authority are based on a sequence listing not forming part of the international application but furnished for the purposes of the international search, the international search report and the written opinion of the International Searching Authority shall so indicate.

(c) Where a meaningful international search cannot be carried out and a meaningful written opinion, as to whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable, cannot be established because a sequence listing is not available to the International Searching Authority in the required form, language and manner that Authority shall so state in the international search report or declaration referred to in Article 17(2)(a), and in the written opinion.

(d) Where a sequence listing for the purposes of the international search is furnished on a physical medium, that Authority shall physically label that medium with the words "SEQUENCE LISTING NOT FORMING PART OF THE INTERNATIONAL APPLICATION" in accordance with the procedures in Annex C.

(e) The International Searching Authority shall:

(i) keep in its files one copy of any sequence listing which does not form part of the international application but was furnished for the purposes of the international search; and

(ii) transmit one copy thereof to the International Bureau together with the copy of the international search report. If that listing is furnished on a physical medium in less than the number of copies required by the International Searching Authority, that Authority shall be responsible for the preparation of the additional copy and shall have the right to fix a fee for performing that task and to collect such fee from the applicant.

(f) Each International Searching Authority shall notify the International Bureau of the means of transmittal of the sequence listing accepted by it in accordance with Annex F. The International Bureau shall promptly publish details of the notification in the Gazette.

### I. REQUIREMENTS FOR SEQUENCE LISTINGS UNDER WORLD INTELLECTUAL PROPERTY OFFICE STANDARD ST.26 (WIPO STANDARD ST.26)

[Editor Note: This subsection is applicable to all international applications, including national phase applications, having an international filing date on or after July 1, 2022, that disclose one or more

nucleotide and/or amino acid sequences as defined in WIPO Standard ST.26.]

Patent applications that disclose a nucleotide and/or amino acid sequence(s) by enumeration of its residues, as defined in WIPO Standard ST.26, must present each sequence and associated sequence data in a standardized electronic eXtensible Markup Language (XML) format as a separate part of the specification. This standardized format is set forth in WIPO Standard ST.26, and applies to sequence listings in international applications filed under the Patent Cooperation Treaty (PCT) and in national and regional applications filed in the intellectual property offices (IPOs) of WIPO member states. As a result, a single sequence listing in compliance with WIPO Standard ST.26 can be prepared for use in all IPOs of WIPO member states.

The sequence listing part of the description must be an electronic file in WIPO Standard ST.26 XML format. Where sequences are included in a sequence listing, they are not required to also appear in the main part of the description. In the description, claims or drawings of the application, the sequences included in the sequence listing shall be referred to by the sequence identifier preceded by "SEQ ID NO:", even if the sequence is also embedded in the description, claims or drawings.

Where an international application, filed under the PCT, contains a disclosure of nucleotide and/or amino acid sequences that are required to be listed within a sequence listing, PCT Rule 5.2 requires that the description shall include a sequence listing part of the description complying with the standard provided for in the Administrative Instructions. In accordance with Section 208, any sequence listing, whether forming part of the international application or not forming part of the international application, shall comply with Annex C of the Administrative Instructions. Where applicant has not provided a sequence listing in accordance with Annex C of the Administrative Instructions and the USPTO acts as International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA), the ISA/IPEA may invite applicant to furnish a sequence listing, with a late furnishing fee, under PCT Rule 13 *ter* . This invitation will specify a time limit for a proper response. A proper response to such an invitation would include, the submission of a sequence listing in accordance with Annex C of the Administrative Instructions, the late furnishing fee specified in 37 CFR 1.445(a)(5), and a statement to the effect that the sequence listing does not go beyond the disclosure of the international application as filed. If a sequence listing compliant with WIPO Standard ST.26 has not been furnished to the ISA/IPEA within the time limit set forth in the invitation, the ISA/IPEA will only search / examine the international application to the extent that a meaningful search or examination can be performed without the sequence listing. See PCT Rule 13 *ter*.1(d). Where the application discloses sequences that are required to be within a sequence listing, it is advisable for the applicant to submit a sequence listing compliant with WIPO Standard ST.26 XML format together with the international application on the international filing date rather than to wait for an invitation by the International Searching Authority or International Preliminary Examining Authority.

For a detailed discussion of the World Intellectual Property Organization (WIPO) Standard ST.26, see MPEP § 2412 - 2419, in particular MPEP § 2414.05.

For ease of access, WIPO Standard ST.26 can be found at: **www.wipo.int/standards/en/part_03_standards.html**.

## II. REQUIREMENTS FOR SEQUENCE LISTINGS UNDER WORLD INTELLECTUAL PROPERTY OFFICE STANDARD ST.25 (WIPO ST.25)

[Editor Note: This subsection is only applicable to international applications, including national phase applications, having an international filing date before July 1, 2022, that disclose one or more nucleotide and/or amino acid sequences as defined in WIPO Standard ST.25.]

Where an international application contains disclosure of a nucleotide and/or amino acid sequence, the description must contain a listing of the sequence complying with the standard specified in Annex C of the Administrative Instructions. A copy of the Administrative Instructions in force before July 1, 2022 can be found at: **www.wipo.int/wipolex/en/text/584509**. See MPEP

§ 1823.02, subsection II. If the International Searching Authority finds that an international application contains nucleotide and/or amino acid sequences in the disclosure, but finds that the description does not contain a sequence listing or that the sequence listing provided in the international application does not comply with the PCT Administrative Instructions Annex C, the International Searching Authority may invite the applicant to furnish a listing that complies with the standard and pay a late furnishing fee.

An invitation from the International Searching Authority to furnish a sequence listing that complies with the standard specified in the Administrative Instructions and pay a late furnishing fee will specify a time limit for complying with the invitation. Any sequence listing furnished by the applicant in response to the invitation must be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed and must be submitted to the International Searching Authority. If the applicant does not furnish the required sequence listing and pay any required late furnishing fee within the time limit specified in the invitation, the search undertaken by the International Searching Authority may be limited. See MPEP § 1823.02, subsection II.

Any sequence listing provided after the international filing date and in response to the invitation to furnish a sequence listing by the International Searching Authority, is not considered part of the international application. If the applicant wishes to include such a listing as part of the international application, appropriate amendments to the description may be made later under PCT Article 34, provided that the applicant files a Demand for international preliminary examination and does not go beyond the disclosure in the international application as filed.

## 1849 [Reserved]

## 1850 Unity of Invention Before the International Searching Authority [R-01.2024]

***PCT Rule 13***

***Unity of Invention***

***13.1 Requirement***

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

***13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled***

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

***13.3. Determination of Unity of Invention Not Affected by Manner of Claiming***

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

***13.4. Dependent Claims***

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

***13.5. Utility Models***

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 13.1 to 13.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.

***PCT Rule 40***

***Lack of Unity of Invention (International Search)***

***40.1 Invitation to Pay Additional Fees; Time Limit***

The invitation to pay additional fees provided for in Article 17(3)(a) shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention;

(ii) invite the applicant to pay the additional fees within one month from the date of the invitation, and indicate the amount of those fees to be paid; and

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(e) within one month from the date of the invitation, and indicate the amount to be paid.

***40.2. Additional Fees***

(a) The amount of the additional fees due for searching under Article 17(3)(a) shall be determined by the competent International Searching Authority.

(b) The additional fees due for searching under Article 17(3)(a) shall be payable direct to the International Searching Authority.

(c) Any applicant may pay the additional fees 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 fees is excessive. Such protest shall be examined by a review body constituted in the framework of the International Searching Authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fees. 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 membership of the review body referred to in paragraph (c) may include, but shall not be limited to, the person who made the decision which is the subject of the protest.

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee. Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required protest fee, the protest shall be considered not to have been made and the International Searching Authority shall so declare. The protest fee shall be refunded to the applicant where the review body referred to in paragraph (c) finds that the protest was entirely justified.

***37 CFR 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.***

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

## I. 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 1.475). Observance of this requirement is checked by the International Searching Authority and may be relevant in the national (or regional) phase.

The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 650 F. Supp. 218, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of

37 CFR 1.141(b)(2) as applied to unity of invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression "specifically designed" as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change was made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT.

In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.

PCT Rule 13.2, as it was modified effective July 1, 1992, no longer specifies the combinations of categories of invention which are considered to have unity of invention. Those categories, which now appear as a part of Chapter 10 of the International Search and Preliminary Examination Guidelines, may be obtained from the Patent Examiner's Toolkit link or from WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**). The categories of invention in former PCT Rule 13.2 have been replaced with a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Chapter 10 of the International Search and Preliminary Examination Guidelines also contains examples concerning unity of invention.

## II. DETERMINATION OF "UNITY OF INVENTION"

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving

two or more dependent claims without a single general inventive concept.

Lack of unity of invention may be directly evident " *a priori*," i.e., before considering the claims in relation to any prior art, or may only become apparent " *a posteriori*," i.e., after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant.

From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. However, the International Searching Authority or the International Preliminary Examining Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the international search to certain classification groups.

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (PCT Rule 6.4). The examiner should bear in mind that a claim may also contain a reference to another claim even if it is not a dependent claim as defined in PCT Rule 6.4. One example of this is a claim referring to a claim of a different category (for example, "Apparatus for carrying out the process of Claim 1 ...," or "Process for the manufacture of the product of Claim 1 ..."). Similarly, a claim to one part referring to another cooperating part, for example, "plug for cooperation with the socket of Claim 1 ...") is not a dependent claim.

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner such that it avoids the prior art, while claim 2 is for a "turbine rotor blade as claimed in claim 1" and produced from alloy Z. Then no objection under PCT Rule 13 arises either because alloy Z was new and its composition was not obvious and thus the alloy itself already contains the essential features of an independent possibly later patentable invention, or because, although alloy Z was not new, its application in respect of turbine rotor blades was not obvious, and thus represents an independent invention in conjunction with turbine rotor blades. As another example, suppose that the main claim defines a process avoiding the prior art for the preparation of a product A starting from a product B and the second claim reads: "Process according to claim 1 characterized by producing B by a reaction using the product C." In this case, too, no objection arises under PCT Rule 13, whether or not the process for preparation of B from C is novel and inventive,

since claim 2 contains all the features of claim 1. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art, provided the genus claim is directed only to alternatives of a similar nature and the species falls entirely within the genus. To determine if a genus claim is directed only to alternatives "of a similar nature," see subsection III.B. below. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

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

This method for determining whether unity of invention exists is intended to be applied even before the commencement of the international search. Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

Alternative forms of an invention may be claimed either in a plurality of independent claims, or in a single claim. In the latter case, the presence of the independent alternatives may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether there is unity of invention. Accordingly, lack of unity of invention may exist within a single claim. Where the claim contains distinct embodiments that are not linked by a single general inventive concept, the objection as to lack of unity of invention should be raised. PCT Rule 13.3 does not prevent an Authority from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Authority.

Objection of lack of unity of invention does not normally arise if the combination of a number of individual elements is claimed in a single claim (as opposed to distinct embodiments as discussed in the paragraph immediately above), even if these elements seem unrelated when considered individually.

## III. ILLUSTRATIONS OF PARTICULAR SITUATIONS

There are three particular situations for which the method for determining unity of invention contained in PCT Rule 13.2 is explained in greater detail:

(A) Combinations of different categories of claims;

(B) So-called "Markush practice"; and

(C) Intermediate and final products.

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

Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the Patent Examiner's Toolkit link or from WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**).

### *A. Combinations of Different Categories of Claims*

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

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

(B) In addition to an independent claim for a given process, an independent claim for an apparatus

or means specifically designed for carrying out the said process; or

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

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

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

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

More extensive combinations than those set forth above should be looked at carefully to ensure that the requirements of both PCT Rule 13 (unity of invention) and PCT Article 6 (conciseness of claims) are satisfied. In particular, while a single set of independent claims according to one of (A), (B), or (C) above is always permissible, it does not require the International Authority to accept a plurality of such sets which could arise by combining the provisions of PCT Rule 13.3 (which provides that the determination of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim), with the provisions set out above (thus resulting in a set based on each of a number of independent claims in the same category under PCT Rule 13.3). The proliferation of claims arising from a combined effect of this kind should be accepted only exceptionally. For example, independent claims are permissible for two related articles such as a transmitter and receiver; however, it does not follow that an applicant may include also, in the one international application, four additional independent claims: two for a process for the manufacture of the transmitter and the receiver, respectively, and two for use of the transmitter and receiver, respectively.

A single general inventive concept must link the claims in the various categories and in this connection the wording above should be carefully noted. The link between product and process in (A) is that the process must be "specially adapted for the manufacture of" the product. Similarly, in (B), the apparatus or means claimed must be "specifically designed for" carrying out the process. Likewise, in (C), the process must be "specially adapted for the manufacture of" the product and the apparatus must be "specifically designed for" carrying out the process. In combinations (A) and (C), the emphasis is on, and the essence of the invention should primarily reside in, the product, whereas in combination (B) the emphasis is on, and the invention should primarily reside in, the process. (See Examples in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the Patent Examiner's Toolkit link or from WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**.))

### *B. "Markush Practice"*

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

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

(A) All alternatives have a common property or activity; and

(B)

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

(B)

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

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

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

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

When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention should be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised. (See Examples in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the Patent Examiner's Toolkit link or from WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**.))

### *C. Intermediate and Final Products*

The situation involving intermediate and final products is also governed by PCT Rule 13.2.

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

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

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

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

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

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

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

the final product or incorporates an essential element into the final product.

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

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

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

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

As long as unity of invention can be recognized applying the above interpretations, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities shall not affect the decision on unity of invention. (See Examples in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the Patent Examiner's Toolkit link or from WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**.))

## IV. SEARCH OF ADDITIONAL INVENTIONS WITHOUT PAYMENT OF FEES

If little or no additional search effort is required, reasons of economy *may* make it advisable for the examiner, while making the search for the main invention, to search at the same time, despite the nonpayment of additional fees, one or more additional inventions in the classification units consulted for the main invention. The international search for such additional inventions will then have to be completed in any further classification units which may be relevant, when the additional search fees have been paid. This situation may occur when the lack of unity of invention is found either " *a priori* " or " *a posteriori*."

When the examiner finds lack of unity of invention, normally, the applicant is invited to pay fees for the search of additional inventions. In exceptional circumstances, however, the examiner may be able to establish both an international search and a written opinion covering more than one invention with negligible additional work, in particular, when the inventions are conceptually very close. In those cases, the examiner may decide to complete the international search and the written opinion of the International Searching Authority for the additional invention(s) together with that for the invention first mentioned. In considering the amount of work involved, the examiner should take into account the time needed to create the written opinion as well as that needed to perform the search, since even when the additional work with regard to the search is negligible, the opposite may be the case for the written opinion of the International Searching Authority and therefore justify requesting the additional fees. If it is considered that the total additional work does not justify requesting additional fees, all results are included in the international search report (and where applicable, the written opinion) without inviting the applicant to pay an additional search fee in respect of the additional inventions searched but stating the finding of lack of unity of invention.

## V. INVITATION TO PAY ADDITIONAL FEES

The search fee which the applicant is required to pay is intended to compensate the International Searching Authority for carrying out an international search and preparing a written opinion, but only where the international application meets the "requirement of unity of invention." That means that the international application must relate to only one invention or must relate to a group of inventions which are so linked as to form a single general inventive concept (PCT Articles 3(4)(iii) and 17(3)(a)).

If the International Searching Authority finds that the international application does not comply with the requirement of unity of invention, the applicant

will be informed of the lack of unity of invention by a communication preceding the issuance of the international search report and written opinion of the International Searching Authority which contains an invitation to pay additional search fees. (Form PCT/ISA/206 or USPTO/299 (telephone practice), see below). This invitation specifies the reasons the international application is not considered to comply with the requirement of unity of invention, identifies the separate inventions, and indicates the number of additional search fees and the amount to be paid (PCT Rules 40.1, 40.2(a) and (b)). The International Searching Authority cannot consider the application withdrawn for lack of unity of invention, nor invite the applicant to amend the claims, but informs the applicant that, if the international search report is to be drawn up in respect of those inventions present other than the first mentioned, then the additional fees must be paid within one month from the date of the invitation to pay additional fees (PCT Rule 40.1). Such additional fees are payable directly to the International Searching Authority which is conducting the search, i.e., the USPTO, EPO, KIPO, IPAU, ILPO, JPO, or IPOS. The additional search fee amounts for the competent international searching authorities can be found in Annex D of the Applicant's Guide (**www.wipo.int/pct/en/appguide**).

In the invitation to pay additional fees, the International Searching Authority should set out a logically presented, technical reasoning containing the basic considerations behind the finding of lack of unity (PCT Rule 40.1).

Since these payments must take place within the time limit set by the International Searching Authority so as to enable the observation of the time limit for establishing the international search report set by PCT Rule 42, the International Searching Authority should endeavor to ensure that international searches be made as early as possible after the receipt of the search copy. The International Searching Authority finally draws up the international search report and written opinion of the International Searching Authority on those parts of the international application which relate to the "main invention," that is, the invention or the group of inventions so linked as to form a single general inventive concept first mentioned in the claims (PCT Article 17(3)(a)). Moreover, the international search report and written opinion of the International Searching Authority will be established also on those parts of the international application which relate to any invention (or any group of inventions so linked as to form a single general inventive concept) in respect of which the applicant has paid any additional fee within the prescribed time limits.

Where, within the prescribed time limit, the applicant does not pay any additional fees or only pays some of the additional fees indicated, certain parts of the international application will consequently not be searched. The lack of an international search report in respect of such parts of the international application will, in itself, have no influence on the validity of the international application and processing of the international application will continue, both in the international and in the national (regional) phases. The unsearched claims, upon entry into the national stage, will be considered by the examiner and may be the subject of a holding of lack of unity of invention.

## VI. PREPARATION OF THE INVITATION TO PAY ADDITIONAL FEES

An Invitation to Pay Additional Fees and, Where Applicable, Protest Fee (Form PCT/ISA/206) is used to invite the applicant to pay additional search fees. In the space provided on form PCT/ISA/206, the examiner should indicate the number of inventions claimed in the international application covering which particular claims and explain why the international application is not considered to comply with the requirements of unity of invention. The examiner should then indicate the total amount of additional fees required for the search of all claimed inventions.

Any claims found to be unsearchable under PCT Article 17(2)(b) are not included with any invention. Unsearchable claims include the following:

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

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

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

In the box provided at the top of the form, the time limit of one month for response is set according to PCT Rule 40.1. Extensions of time are not permitted.

## VII. AUTHORIZED OFFICER

Form PCT/ISA/206 must be signed by an examiner with at least partial signatory authority.

## VIII. TELEPHONIC UNITY PRACTICE

Telephone practice may be used to allow applicants to pay additional fees if

(A) Applicant or applicant's legal representative has a USPTO deposit account,

(B) Applicant or the legal representative orally agrees to charge the additional fees to the account, and

(C) A complete record of the telephone conversation is included with the international search report including:

(1) Examiner's name;

(2) Authorizing attorney's name;

(3) Date of conversation;

(4) Inventions for which additional fees paid; and

(5) Deposit account number and amount to be charged.

When the telephone practice is used in making lack of unity requirements, it is critical that the examiner orally inform applicant that there is no right to protest the holding of lack of unity of invention for any group of invention(s) for which no additional search fee has been paid.

The examiner must further orally advise applicant that any protest to the holding of lack of unity or the amount of additional fee required must be filed in writing no later than one month from the mailing date of the international search report. The examiner should fill in the information on Form USPTO/299 "Chapter I PCT Telephone Memorandum for Lack of Unity" as a record of the telephonic holding of lack of unity.

If the applicant or the legal representative or agent refuses to either agree to a search limited to the first mentioned invention or authorize payment of additional fees over the telephone, or if applicant does not have a deposit account, the examiner should send a written invitation using Form PCT/ISA/206.

If a written invitation is required, the examiner should, if possible, submit the written invitation to the Technology Center for review and mailing within 7 days from the date the international application is charged to the examiner.

## IX. FORM PARAGRAPHS FOR LACK OF UNITY IN INTERNATIONAL APPLICATIONS

### ¶ 18.05 Heading for Lack of Unity Action for PCT Applications During the International Phase (Including Species)

REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR 1.475(a), an international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an international application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

When Claims Are Directed to Multiple Processes, Products, and/or Apparatuses:

Products, processes of manufacture, processes of use, and apparatuses are different categories of invention. When an application includes claims to more than one product, process, or apparatus, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the "main invention" in the claims. In the case of non-compliance with unity of invention and where no additional fees are timely paid, the international search and/or international preliminary examination, as appropriate, will be based on the main invention in the claims. See PCT Article 17(3)(a), 37 CFR 1.475(d), 37 CFR 1.476(c) and 37 CFR 1.488(b)(3).

As provided in 37 CFR 1.475(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 following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

**Examiner Note:**

1. Begin all Lack of Unity actions for PCT applications during the international phase (including species) with this heading.

2. Follow with form paragraphs 18.06 - 18.06.02, 18.07 - 18.07.03, as appropriate.

3. Use form paragraph 18.18 for lack of unity in U.S. national stage applications submitted under 35 U.S.C. 371 .

**¶ 18.06 Lack of Unity - Three Groups of Claims**

Group **[1]**, claim(s) **[2]**, drawn to **[3]**.

Group **[4]**, claim(s) **[5]**, drawn to **[6]**.

Group **[7]**, claim(s) **[8]**, drawn to **[9]**.

**Examiner Note:**

1. In brackets 1, 4 and 7, insert Roman numerals for each Group.

2. In brackets 2, 5 and 8, insert respective claim numbers.

3. In brackets 3, 6 and 9, insert respective names of grouped inventions.

**¶ 18.06.01 Lack of Unity - Two (or Additional) Groups of Claims**

Group **[1]**, claim(s) **[2]**, drawn to **[3]**.

Group **[4]**, claim(s) **[5]**, drawn to **[6]**.

**Examiner Note:**

This form paragraph may be used alone or following form paragraph 18.06.

**¶ 18.06.02 Lack of Unity - One Additional Group of Claims**

Group **[1]**, claim(s) **[2]**, drawn to **[3]**.

**Examiner Note:**

This form paragraph may be used following either form paragraph 18.06 or 18.06.01.

**¶ 18.07 Lack of Unity - Reasons Why Inventions Lack Unity**

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

**Examiner Note:**

Follow with form paragraphs 18.07.01 through 18.07.03, as appropriate.

**¶ 18.07.01 Same or Corresponding Technical Feature Lacking Among Groups**

**[1]** lack unity of invention because the groups do not share the same or corresponding technical feature.

**Examiner Note:**

1. This form paragraph may be used, for example, where the claims of Group I are directed to A + B, whereas the claims of Group II are directed to C + D, and thus the groups do not share a technical feature.

2. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371** , identify the groups involved by Roman numerals (e.g., “Groups I and II”) where inventions have been grouped using form paragraphs 18.06 - 18.06.02, or identify the species involved where species have been listed using form paragraph 18.20.

**¶ 18.07.02 Shared Technical Feature Does Not Make a Contribution Over the Prior Art**

**[1]** lack unity of invention because even though the inventions of these groups require the technical feature of **[2]**, this technical feature is not a special technical feature as it does not make a contribution over the prior art in view of **[3]**. **[4]**

**Examiner Note:**

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371** , identify the groups involved by Roman numerals (e.g., “Groups I and II”) where inventions have been grouped using form paragraphs 18.06 - 18.06.02, or identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, identify the technical feature shared by the groups.

3. In bracket 3, insert citation of prior art reference(s) demonstrating the shared technical feature does not make a contribution over the prior art. Whether a particular technical feature makes a "contribution" over the prior art, and, therefore, constitutes a "special technical feature," is considered with respect to novelty and inventive step.

4. In bracket 4, explain how the shared technical feature lacks novelty or inventive step in view of the reference(s).

**¶ 18.07.03 Heading – Chemical Compound Alternatives of Markush Group Are Not of a Similar Nature**

Where a single claim defines alternatives of a Markush group, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, is considered met when the alternatives are of a similar nature. When the Markush grouping is for alternatives of chemical compounds, the alternatives are regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity; AND

(B)

(1) a common structure is present, that is, a significant structural element is shared by all of the alternatives; OR

(B)

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

The phrase "significant structural element is shared by all of the alternatives" refers to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity.

The phrase "recognized class of chemical compounds" means that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

**Examiner Note:**

1. This heading should be used when the chemical alternatives of a Markush group are determined to lack unity of invention.

2. Follow with form paragraphs listed using form paragraphs 18.07.03a - 18.07.03c, as appropriate.

**¶ 18.07.03a Alternatives Lack Common Property or Activity**

The chemical compounds of **[1]** are not regarded as being of similar nature because all of the alternatives do not share a common property or activity. **[2]**

**Examiner Note:**

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., "Groups I and II") in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371** , identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, insert reasoning.

**¶ 18.07.03b Alternatives Share a Common Structure - However, the Common Structure is Not a Significant Structural Element and the Alternatives Do Not Belong to a Recognized Class**

Although the chemical compounds of **[1]** share a common structure of **[2]**, the common structure is not a significant structural element because it represents only a small portion of the compound structures and does not constitute a structurally distinctive portion in view of **[3]**. Further, the compounds of these groups do not belong to a recognized class of chemical compounds. **[4]**

**Examiner Note:**

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., "Groups I and II") in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371** , identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, identify common structure.

3. In bracket 3, insert citation of prior art reference(s) relied upon to demonstrate the commonly shared structure is not distinctive.

4. In bracket 4, explain why the compounds do not belong to a recognized class of chemical compounds.

**¶ 18.07.03c Alternatives Do Not Share a Common Structure or Belong to Recognized Class**

The chemical compounds of **[1]** are not regarded as being of similar nature because: (1) all the alternatives do not share a common structure and (2) the alternatives do not all belong to a recognized class of chemical compounds. **[2]**

**Examiner Note:**

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., "Groups I and II") in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371** , identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, insert reasoning.

## X. PROTEST PROCEDURE

***PCT Administrative Instructions Section 502.***

***Transmittal of Protest Against Payment of Additional Fees and Decision Thereon Where International Application Is Considered to Lack Unity of Invention***

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

***37 CFR 1.477 Protest to lack of unity of invention before the International Searching Authority.***

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international search report when forwarded to the Designated Offices, may notify the International Searching Authority to that effect any time prior to the issuance of the international search report. Thereafter, such notification should be directed to the International Bureau (PCT Rule 40.2(c)).

The applicant may protest the allegation of lack of unity of invention or that the number of required additional fees is excessive and request a refund of the additional fee(s) paid. If, and to the extent that, the International Searching Authority finds the protest justified, the fee(s) are refunded (PCT Rule 40.2(c)). (The additional search fees must be paid for any protest to be considered, but no protest fee under PCT Rule 40.2(e) is due in the ISA/US.)

Protest of allegation of lack of unity is in the form of a reasoned statement accompanying payment of the additional fee, explaining why the applicant believes that the requirements of unity of invention are fulfilled and fully taking into account the reasons indicated in the invitation to pay additional fees issued by the International Searching Authority. Any such protest filed with the U.S. International Searching Authority will be decided by a Technology Center Director (MPEP § 1002.02(c) item (2)). To the extent applicant's protest is found to be justified, total or partial reimbursement of the additional fee will be made. On the request of the applicant, the text of both the protest and the decision thereon is sent to the designated Offices together with the international search report (37 CFR 1.477(c)).

## XI. NOTIFICATION OF DECISION ON PROTEST

A Notification of Decision of Protest or Declaration That Protest Considered Not to Have Been Made (Form PCT/ISA/212) is used by the Technology Center (TC) to inform the applicant of the decision regarding applicant's protest on the payment of additional fees concerning unity of invention. The TC checks the appropriate box, i.e., 1 or 2. If box 2 is checked, a clear and concise explanation as to why the protest concerning the unity of invention was found to be unjustified must be given. Since the space is limited, supplemental attachment sheet(s) should be incorporated whenever necessary.

## XII. AUTHORIZED OFFICER

Form PCT/ISA/212 must be signed by a TC Director. See MPEP § 1002.02(c), item (2).

## XIII. UNITY OF INVENTION - NUCLEOTIDE SEQUENCES

Under 37 CFR 1.475 and 1.499 *et seq.*, when claims do not comply with the requirement of unity of invention, i.e., when the claimed subject matter does not involve "one or more of the same or corresponding special technical features," 37 CFR 1.475(a), an additional fee is required to maintain the claims in the same application. 37 CFR 1.476(b).

Nucleotide sequences encoding the same protein are considered to satisfy the unity of invention standard and will continue to be examined together.

Examples concerning Unity of Invention involving biotechnological inventions may be found in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the Patent Examiner's Toolkit link or from the

WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**).

## 1851 Identification of Patent Documents [R-01.2024]

The examiner, in completing the international search report as well as the written opinion and international preliminary examination report, is required to cite the references in accordance with the provisions of Administrative Instructions Sections 503 and 611 and WIPO Standard ST.14. These sections of the Administrative Instructions require reference citations to include, in addition to other information which is apparent from the forms which the examiner fills out, an indication of the two-letter country code of the country or entity issuing or publishing the document and the standard code for identifying the kind of patent document. The discussion which follows is limited to the identification of patent documents (and nonpatent publications) and a listing of the two-letter country codes for countries or other entities which issue or publish industrial property information.

The standard codes for identifying different kinds of patent documents are found in the "WIPO Handbook on Industrial Property Information and Documentation" - WIPO Standard ST.16 which is published by the World Intellectual Property Organization. The listing is extensive. The Quality Assurance Specialists in each Technology Center (TC) have a complete copy of Standard ST.16. It is also accessible on WIPO's website (**www.wipo.int/standards/en/part_03_standards.html**). Provided herein is an abbreviated version representing the countries and codes commonly used by the examiner in preparing search reports.

U.S. patents published before January 2, 2001, are Code A documents generally. Beginning with patents published on January 2, 2001, U.S. patents are Code B documents. Patent Application Publications, first published on March 15, 2001, are Code A documents. Reexamination certificates published before January 2, 2001, are Code B documents. Reexamination certificates published on or after January 2, 2001, are Code C documents. Tables providing a complete list of the kind codes of patents and other documents published by the USPTO are included in MPEP § 901.04(a). All nonpatent literature documents are Code N. Numerical designations are sometimes found on published documents along with the letter code designation. These should be used by the examiner only if such numerical designation is on the document. Numerical codes along with letter codes can be found, for example, on certain published patent documents such as the German Offenlegungsschrift and published international applications. If numerical designations are not provided, the examiner should use only the letter code designation.

The most commonly cited documents are patents and published patent applications. A guideline for the citation of such documents is listed below. The listing is indicated in the order in which the elements should be listed.

In the case of a patent or published patent application:

(A) The Office that issued the document, by the two letter code (WIPO Standard ST.3);

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

(C) The kind of document, by the appropriate symbols as indicated on the document under WIPO Standard ST.16 or, if not indicated on that document, as provided in that Standard, if possible;

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

(E) The date of publication of the cited patent document or, in case of a corrected patent document, the date of issuance of the corrected patent document as referred to under INID code (48) of WIPO Standard ST.9 and, if provided on the document, the supplementary correction code as referred to under INID code (15);

(F) Where applicable, the pages, columns, lines or paragraph numbers where the relevant passages appear, or the relevant figures of the drawings.

The following examples illustrate the citation of a patent document as indicated above:

JP 10-105775 A (NCR INTERNATIONAL INC.) 24 April 1998 (24.04.1998) paragraphs 26 to 30.

DE 3744403 A1 (JOSEK, A.) 29 August 1991 (29-08-1991), page 1, abstract.

US 5,635,683 A (MCDERMOTT, R. M. et al.) 03 June 1997 (03/06/1997), column 7, lines 21 to 40.

**STANDARD CODE FOR THE IDENTIFICATION OF DIFFERENT KINDS OF PATENT DOCUMENTS**

The Code, WIPO Standard ST.16 is subdivided into mutually exclusive groups of letters. The groups characterize patent documents, nonpatent literature documents (N), and restricted documents (X). Groups 1-7 comprise letters enabling identification of documents pertaining to different publication levels.

Part 7.3 "Examples and Kinds of Patent Documents" provides, in the first document (Part 7.3.1), examples of patent documents, previously and currently published, or intended to be published, listed according to code. The second document (Part 7.3.2) contains a listing, in alphabetical order of issuing industrial property office, of kinds of patent documents and their codes, as applied by the offices. Finally, the third document (Part 7.3.3) provides access to a collection of samples of first pages of patent documents published by industrial property offices.

***Country Codes***

The two-letter country codes are set forth in WIPO Standard ST.3, which is published in the "WIPO Handbook on Industrial Property Information and Documentation" and is accessible via the internet at the WIPO website (**www.wipo.int/standards/en/part_03_standards.html**). WIPO Standard ST.3 provides, in Annex I, a listing of two-letter country codes and/or organizational codes in alphabetic sequence of their short names for the states, other entities and intergovernmental organizations issuing or publishing industrial property documents. Codes for states or organizations that existed on January 1, 1978, but that no longer exist are provided in Annex II, Section 2. Annex II, Section 1 lists States for which the Codes have changed.

# 1852 Taking Into Account Results of Earlier Search(es) [R-07.2015]

***PCT Rule 41***

***Taking into Account Results of Earlier Search***

***41.1 Taking into Account Results of Earlier Search***

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12 *bis*.1 and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

***37 CFR 1.104 Nature of examination.***

(a) *Examiner's action.*

*****

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

*****

PCT Rule 4.12 provides that the applicant may request that the results of an earlier international, international-type or national search carried out by the same or another International Searching Authority or by a national Office be used in establishing an international search report on such international application.

See MPEP § 1819. An international-type search is conducted on all U.S. nonprovisional applications filed after June 1, 1978.

When specifically requested by the applicant, the examiner is required to prepare an international search report taking into account the results of an earlier search. The examiner can determine whether

applicant has requested the ISA/US to use the results of an earlier search by inspecting Box No. VII of the PCT Request. Box No. VII of the Request also allows applicant to indicate that certain documents relating to the earlier search are either available to the Authority or are being transmitted thereto.

Where the applicant has requested the United States International Searching Authority (ISA/US) to take into account earlier search results from a foreign Office and where a copy of the earlier search results (and a translation into English where the search results are in a foreign language) and copies of the documents cited therein (other than copies of U.S. patents and U.S. patent application publications) have been provided, the examiner shall take into account such earlier search results. Where the earlier search results (including any required translation thereof) or any copies of the documents cited therein (other than copies of U.S. patents and U.S. patent application publications) have not been furnished and therefore are not of record in the file, whether the earlier foreign Office search results will be taken into account is at the examiner's discretion.

It is emphasized that when taking into account the results of an earlier search, the examiner is not bound by the results of the earlier search. The process of taking into account earlier search results consists of a cursory review of the provided results, followed by a more comprehensive inspection of the cited references if warranted. The forms used in preparing the international search report do not provide for indicating either that the results of an earlier search have been taken into account or the extent to which the results of an earlier search have been taken into account and, accordingly, the examiner need not make such indications in the international search report.

## 1853 Amendment Under PCT Article 19 [R-10.2019]

***PCT Article 19***

***Amendment of the Claims before the International Bureau***

(1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

(2) The amendments shall not go beyond the disclosure in the international application as filed.

(3) If the national law of any designated State permits amendments to go beyond the said disclosure, failure to comply with paragraph (2) shall have no consequence in that State.

***PCT Rule 46***

***Amendment of Claims Before the International Bureau***

***46.1 Time Limit***

The time limit referred to in Article 19 shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later, provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

***46.2 Where to File***

Amendments made under Article 19 shall be filed directly with the International Bureau.

***46.3 Language of Amendments***

If the international application has been filed in a language other than the language in which it is published, any amendment made under Article 19 shall be in the language of publication.

***46.4 Statement***

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published and shall not exceed 500 words if in the English language or if translated into that language. The statement shall be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement.

(b) The statement shall contain no disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

***46.5 Form of Amendments***

(a) The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed.

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled.

(iii) shall indicate the basis for the amendments in the application as filed.

***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. 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 in Arabic numerals.

(b) The applicant shall, in the letter referred to in the second and third sentences of Rule 46.5(b) or Rule 66.8(c) indicate the differences between the claims as filed and the claims as amended or, as the case may be, differences between the claims as previously amended and currently 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;

(vi) the claim replaces one or more claims as previously amended;

(vii) the claim is the result of the division of a claim as previously amended

The applicant is entitled, under Article 19, to one opportunity to amend the claims of the international application in the international phase. Further opportunities to amend the claims, and also the description and the drawings, are available during the international phase under Article 34 if, and only if, the applicant files a Demand for international preliminary examination. Any amendment to the claims under Article 19 must be filed with the International Bureau – not with the receiving Office nor with the International Searching Authority. The amendments must be in the language in which the international application is published.

The opportunity to make amendments under Article 19 is available after the applicant has received the international search report and the written opinion of the International Search Authority, and remains available until the end of 16 months from the priority date or two months after the transmittal (i.e., the date of mailing) of that report and opinion, whichever expires later. Amendments received by the International Bureau after the time limit are still accepted if they have been received before the technical preparations for international publication have been completed. Amendments to the claims under Article 19 are not allowed where the International Searching Authority has declared, under Article 17(2), that no international search report would be established. If the amendments to the claims are timely received by the International Bureau, such amendments will be published as part of the publication of the international application directly following the claims as filed. Article 19 offers applicants the opportunity to generally amend the claims before entering the designated Offices. The national laws of some designated Offices may grant provisional protection on the invention from the date of publication of the claims. Therefore, some applicants take advantage of the opportunity under Article 19 to polish the claims anticipating provisional protection. See PCT Rule 46.5.

The submission of Article 19 amendments should comprise:

(i) a complete set of claims in replacement of the claims originally filed

(ii) a letter which must indicate the differences between the claims as filed and those as amended plus the basis for the amendments

(iii) an optional statement under Article 19

When filing amendments to the claims under Article 19, the applicant is required to file a sheet or sheets containing a complete set of claims in replacement of the claims originally filed. The replacement sheet or sheets must be accompanied by a letter drawing attention to the differences between the claims as filed and the claims as amended. It must also indicate the basis for the amendment to the claims with specific references to particular parts of the application as originally filed, as illustrated in the Example below. Where an amendment results in the cancellation of an entire sheet of the international application as originally filed, the amendment (i.e., the cancellation) is evidenced only by the letter addressed to the International Bureau. Amendments may consist in the cancellation of one or more entire

claims, in the addition of one or more new claims, or in the amendment of the text of one or more of the claims as filed. All the claims appearing on a replacement sheet must be numbered in Arabic numerals (corresponding to the order of the claims). Where a claim is cancelled, no renumbering of the other claims is required. However, where the applicant does renumber claims, they must be renumbered consecutively.

The letter, which must accompany the replacement sheets containing amendments to the claims, must indicate firstly the differences between the claims as filed and those as amended and secondly the basis for the amendments in the application as filed. This should be done by stating, in connection with each claim appearing in the international application, 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, etc.

The replacement sheets containing the amended claims should not, however, contain marked-up text; they should contain clean text only. This should be followed by an indication of the basis for the amendments in the application as filed. The basis for the amendments has to be indicated so that the examiner may, by consulting those precise references in the application, assess whether the amendments contain subject-matter which extends beyond the disclosure of the application as filed. Therefore, non-specific indications such as "see the description as filed" or "see the claims as filed" are generally not considered sufficient for an indication of the basis for the amendment.

Example:

> "Claim 1 amended; claims 2 to 7 unchanged; claims 8 and 9 amended; claims 10 to 14 cancelled; claims 15 to 17 unchanged; new claim 18 added.
>
> (i) Basis for the amendment: Claim 1 has been amended at lines 4 and 11 to 14 and now indicates that the filter comprises a periodic backwashing means serially coupled to a first and second chamber. The basis for this amendment can be found in original claims 2 and 4 as filed.
>
> (ii) Basis for the amendment: Concerning amended claims 8 and 9, the indication of 'quick-fire piston' is in the paragraphs numbered 2 and 19 in the description as filed.
>
> (iii) Basis for the amendment: Claim 18 is new, the indication is in drawing No. III of the original application."

Any amendment may be accompanied by a brief statement by the applicant explaining the amendment and indicating any impact it might have on the description and the drawings. Such a statement is published together with the international application itself. Statements not referring to a specific amendment are not permitted. The statement must not exceed 500 words if in English or when translated into English. It may not contain disparaging comments on the international search report or on the relevance of any of the citations contained in that report. References to certain citations in the report may be made only in connection with an amendment made to a specific claim. The statement must be in the language in which the international application is published.

A statement explaining the amendment is not to be confused with and must be clearly distinguished from the letter indicating the differences between the claims as filed and those as amended and the basis for the amendment. It is also distinct from the statement concerning amendments which must be included in a demand for international preliminary examination. It must therefore be identified as such by a heading "Statement under Article 19(1)." Where the statement does not comply with the requirements, it is neither published by the International Bureau nor communicated to the designated Offices.

The PCT provides that amendments are not to go beyond the disclosure in the international application as filed. This requirement is not directly enforceable during Chapter I of the international phase, but failure to comply with it may have adverse consequences for the applicant during the international preliminary examination and in the national phase.

## 1854 - 1855 [Reserved]

## 1856 Supplementary International Searches [R-10.2019]

***PCT Rule 45 bis***

***Supplementary International Searches***

***45 bis.1 Supplementary Search Request***

(a) The applicant may, at any time prior to the expiration of 22 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45 *bis*.9. Such requests may be made in respect of more than one such Authority.

(b) A request under paragraph (a) ("supplementary search request") shall be submitted to the International Bureau and shall indicate:

(i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number;

(ii) the International Searching Authority that is requested to carry out the supplementary international search ("Authority specified for supplementary search"); and

(iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search.

(c) The supplementary search request shall, where applicable, be accompanied by:

(i) where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Authority specified for supplementary search, a translation of the international application into a language which is accepted by that Authority;

(ii) preferably, a copy of a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, if required by the Authority specified for supplementary search.

(d) Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to restrict the supplementary international search to one of the inventions as identified by the International Searching Authority other than the main invention referred to in Article 17(3)(a).

(e) The supplementary search request shall be considered not to have been submitted, and the International Bureau shall so declare:

(i) if it is received after the expiration of the time limit referred to in paragraph (a); or

(ii) if the Authority specified for supplementary search has not stated, in the applicable agreement under Article 16(3)(b), its preparedness to carry out such searches or is not competent to do so under Rule 45 *bis*.9(b).

***45 bis.2 Supplementary Search Handling Fee***

(a) The supplementary search request shall be subject to the payment of a fee for the benefit of the International Bureau ("supplementary search handling fee") as set out in the Schedule of Fees.

(b) The supplementary search handling fee shall be paid in the currency in which the fee is set out in the Schedule of Fees or in any other currency prescribed by the International Bureau. The amount in such other currency shall be the equivalent, in round figures, as established by the International Bureau, of the amount as set out in the Schedule of Fees, and shall be published in the Gazette.

(c) The supplementary search handling fee shall be paid to the International Bureau within one month from the date of receipt of the supplementary search request. The amount payable shall be the amount applicable on the date of payment.

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45 *bis*.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under Rule 45 *bis*.1(e).

***45 bis.3 Supplementary Search Fee***

(a) Each International Searching Authority carrying out supplementary international searches may require that the applicant pay a fee ("supplementary search fee") for its own benefit for carrying out such a search.

(b) The supplementary search fee shall be collected by the International Bureau. Rules 16.1(b) to (e) shall apply *mutatis mutandis*.

(c) As to the time limit for payment of the supplementary search fee and the amount payable, the provisions of Rule 45 *bis*.2(c) shall apply *mutatis mutandis*.

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45 *bis*.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under Rules 45 *bis*.1(e) or 45 *bis*.4(d).

(e) The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under Article 16(3)(b), refund the supplementary search fee if, before it has started the supplementary international search in accordance with Rule 45 *bis*.5(a), the supplementary search request is considered not to have been submitted under Rule 45 *bis*.5(g).

***45 bis.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to Authority Specified for Supplementary Search***

(a) Promptly after receipt of a supplementary search request, the International Bureau shall check whether it complies with the requirements of Rule 45 *bis*.1(b) and (c)(i) and shall invite the applicant to correct any defects within a time limit of one month from the date of the invitation.

(b) Where, by the time they are due under Rules 45 *bis*.2(c) and 45 *bis*.3(c), the International Bureau finds that the supplementary search handling fee and the supplementary search fee have not been paid in full, it shall invite the applicant to pay to it the amount required to cover those fees, together with the late payment fee under paragraph (c), within a time limit of one month from the date of the invitation.

(c) The payment of fees in response to an invitation under paragraph (b) shall be subject to the payment to the International Bureau, for its own benefit, of a late payment fee whose amount shall be 50% of the supplementary search handling fee.

(d) If the applicant does not furnish the required correction or does not pay the amount in full of the fees due, including the late payment fee, before the expiration of the time limit applicable under paragraph (a) or (b), respectively, the supplementary search request shall be considered not to have been submitted and the International Bureau shall so declare and shall inform the applicant accordingly.

(e) On finding that the requirements of Rule 45 *bis*.1(b) and (c)(i), 45 *bis*.2(c) and 45 *bis*.3(c) have been complied with, the International Bureau shall promptly, but not before the date of receipt by it of the international search report or the expiration of 17 months from the priority date, whichever occurs first, transmit to the Authority specified for supplementary search a copy of each of the following:

(i) the supplementary search request;

(ii) the international application;

(iii) any sequence listing furnished under Rule 45 *bis*.1(c)(ii); and

(iv) any translation furnished under Rule 12.3, 12.4 or 45 *bis*.1(c)(i) which is to be used as the basis of the supplementary international search;

and, at the same time, or promptly after their later receipt by the International Bureau:

(v) the international search report and the written opinion established under Rule 43 *bis*.1;

(vi) any invitation by the International Searching Authority to pay additional fees referred to in Article 17(3)(a); and

(vii) any protest by the applicant under Rule 40.2(c) and the decision thereon by the review body constituted in the framework of the International Searching Authority.

(f) Upon request of the Authority specified for supplementary search, the written opinion referred to in paragraph (e)(v) shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to that Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

***45 bis.5 Start, Basis and Scope of Supplementary International Search***

(a) The Authority specified for supplementary search shall start the supplementary international search promptly after receipt of the documents specified in Rule 45 *bis*.4(e)(i) to (iv), provided that the Authority may, at its option, delay the start of the search until it has also received the documents specified in Rule 45 *bis*.4(e)(v) or until the expiration of 22 months from the priority date, whichever occurs first.

(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in Rule 45 *bis*.1(b)(iii) or 45 *bis*.1(c)(i), taking due account of the international search report and the written opinion established under Rule 43.1 where they are available to the Authority specified for supplementary search before it starts the search. Where the supplementary search request contains an indication under Rule 45 *bis*.1(d), the supplementary international search may be restricted to the invention specified by the applicant under Rule 45 *bis*.1(d) and those parts of the international application which relate to that invention.

(c) For the purposes of the supplementary international search, Article 17(2) and Rules 13 *ter*.1, 33 and 39 shall apply *mutatis mutandis*.

(d) Where the international search report is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may exclude from the supplementary search any claims which were not the subject of the international search.

(e) Where the International Searching Authority has made the declaration referred to in Article 17(2)(a) and that declaration is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may decide not to establish a supplementary international search report, in which case it shall so declare and promptly notify the applicant and the International Bureau accordingly.

(f) The supplementary international search shall cover at least the documentation indicated for that purpose in the applicable agreement under Article 16(3)(b).

(g) If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation or condition referred to in Rule 45 *bis*.9(a), other than a limitation under Article 17(2) as applicable by virtue of Rule 45 *bis*.5(c), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

(h) The Authority specified for supplementary search may, in accordance with a limitation or condition referred to in Rule 45 *bis*.9(a), decide to restrict the search to certain claims only, in which case the supplementary international search report shall so indicate.

### *45 bis.6 Unity of Invention*

(a) If the Authority specified for supplementary search finds that the international application does not comply with the requirement of unity of invention, it shall:

(i) establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention");

(ii) notify the applicant of its opinion that the international application does not comply with the requirement of unity of invention and specify the reasons for that opinion; and

(iii) inform the applicant of the possibility of requesting, within the time limit referred to in paragraph (c), a review of the opinion.

(b) In considering whether the international application complies with the requirement of unity of invention, the Authority shall take due account of any documents received by it under Rule 45 *bis*.4(e)(vi) and (vii) before it starts the supplementary international search.

(c) The applicant may, within one month from the date of the notification under paragraph (a)(ii), request the Authority to review the opinion referred to in paragraph (a). The request for review may be subjected by the Authority to the payment to it, for its own benefit, of a review fee whose amount shall be fixed by it.

(d) If the applicant, within the time limit under paragraph (c), requests a review of the opinion by the Authority and pays any required review fee, the opinion shall be reviewed by the Authority. The review shall not be carried out only by the person who made the decision which is the subject of the review. Where the Authority:

(i) finds that the opinion was entirely justified, it shall notify the applicant accordingly;

(ii) finds that the opinion was partially unjustified but still considers that the international application does not comply with the requirement of unity of invention, it shall notify the applicant accordingly and, where necessary, proceed as provided for in paragraph (a)(i);

(iii) finds that the opinion was entirely unjustified, it shall notify the applicant accordingly, establish the supplementary international search report on all parts of the international application and refund the review fee to the applicant.

(e) On the request of the applicant, the text of both the request for review and the decision thereon shall be communicated to the designated Offices together with the supplementary international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* where the Authority specified for supplementary search decides to restrict the supplementary international search in accordance with the second sentence of Rule 45 *bis*.5(b) or with Rule 45 *bis*.5(h), provided that any reference in the said paragraphs to the "international application" shall be construed as a reference to those parts of the international application which relate to the invention specified by the applicant under Rule 45 *bis*.1(d) or which relate to the claims and those parts of the international application for which the Authority will carry out a supplementary international search, respectively.

### *45 bis.7 Supplementary International Search Report*

(a) The Authority specified for supplementary search shall, within 28 months from the priority date, establish the supplementary international search report, or make the declaration referred to in Article 17(2)(a) as applicable by virtue of Rule 45 *bis*.5(c) that no supplementary international search report will be established.

(b) Every supplementary international search report, any declaration referred to in Article 17(2)(a) as applicable by virtue of Rule 45 *bis*.5(c) and any declaration under Rule 45 *bis*.5(e) shall be in a language of publication.

(c) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2, 43.5, 43.6, 43.6 *bis*, 43.8 and 43.10 shall, subject to paragraphs (d) and (e), apply *mutatis mutandis*. Rule 43.9 shall apply *mutatis mutandis*, except that the references therein to Rules 43.3, 43.7 and 44.2 shall be considered non-existent. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

(d) The supplementary international search report need not contain the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report.

(e) The supplementary international search report may contain explanations:

(i) with regard to the citations of the documents considered to be relevant;

(ii) with regard to the scope of the supplementary international search.

### *45 bis.8 Transmittal and Effect of the Supplementary International Search Report*

(a) The Authority specified for supplementary search shall, on the same day, transmit one copy of the supplementary international search report or the declaration that no supplementary international search report shall be established, as applicable, to the International Bureau and one copy to the applicant.

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

***45 bis.9 International Searching Authorities Competent to Carry Out Supplementary International Search***

(a) An International Searching Authority shall be competent to carry out supplementary international searches if its preparedness to do so is stated in the applicable agreement under Article 16(3)(b), subject to any limitations and conditions set out in that agreement.

(b) The International Searching Authority carrying out the international search under Article 16(1) in respect of an international application shall not be competent to carry out a supplementary international search in respect of that application.

(c) The limitations referred to in paragraph (a) may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, other than limitations under Article 17(2) as applicable by virtue of Rule 45 *bis*.5(c), limitations as to the total number of supplementary international searches which will be carried out in a given period, and limitations to the effect that the supplementary international searches will not extend to any claim beyond a certain number of claims.

The supplementary international search (SIS) is an optional service that allows additional searches to be performed by a Supplementary International Searching Authority (SISA) during the international phase, in addition to the search performed by the main International Searching Authority (ISA). Requesting supplementary international search reduces the risk of new prior art being cited in the national phase. The increasing diversity of prior art in different languages and different technical fields means that the Authority carrying out the main international search is not always capable of discovering all of the relevant prior art. Requesting one or more supplementary international searches, during this early phase of the patent prosecution, expands both the linguistic and technical scope of the search. In addition, it may also be possible to have the supplementary search carried out in a State where an applicant is likely to enter the national phase later on.

Only an ISA that has stated its preparedness to carry out supplementary international searches (see the Annex SISA of the Applicant's Guide at **www.wipo.int/pct/en/appguide/index.jsp**) and which is not the ISA that carried out the main international search, can be requested to carry out a SIS. The Authorities prepared to offer supplementary international searches may specify any limitations and conditions on this service in their agreement with the IB (see **www.wipo.int/pct/en/access/isa_ipea_agreements.html**). These limitations may include limitations as to the subject matter for which supplementary searches will be carried out, beyond those limitations that can be evoked in respect of the main international search, and limitations as to the total number of supplementary international searches which will be carried out in a given period.

The SIS will be carried out on the application as filed (amendments under PCT Article 19 and/or 34 will not be considered) and will only cover one invention or group of inventions having unity of invention – there is no option for paying additional fees for the searching of multiple inventions. However, if the main ISA has identified a lack of unity before SIS is requested, the latter can be requested to concentrate on an invention which is not necessarily the first one claimed (PCT Rule 45 *bis*.1(d)). If not established in English, the resulting supplementary international search report will be translated into English by the IB.

In many cases, requests for supplementary search will be filed once the applicant has received the main international search report. In any event, the applicant must file a request for a SIS prior to the expiration of 22 months from the priority date. If the request is received after the expiration of this time limit, it will be considered not to have been submitted and there are no provisions to extend this time limit. The requests for SIS must be submitted directly to the IB and not to an individual SISA. There is a supplementary search handling fee to cover the costs of the IB and a supplementary search fee set by each SISA. These fees must be paid to the IB in Swiss francs within one month of filing the request for SIS. Applicants from certain States may be eligible for a 90% reduction in the supplementary search handling fee.

## 1857 International Publication [R-01.2024]

***PCT Article 21***

***International Publication***

(1) The International Bureau shall publish international applications.

(2)

(a) Subject to the exceptions provided for in subparagraph (b) and in Article 64(3), the international publication of the international application shall be effected

promptly after the expiration of 18 months from the priority date of that application.

(b) The applicant may ask the International Bureau to publish his international application any time before the expiration of the time limit referred to in subparagraph (a). The International Bureau shall proceed accordingly, as provided in the Regulations.

(3) The international search report or the declaration referred to in Article 17(2)(a) shall be published as prescribed in the Regulations.

(4) The language and form of the international publication and other details are governed by the Regulations.

(5) There shall be no international publication if the international application is withdrawn or is considered withdrawn before the technical preparations for publication have been completed.

(6) If the international application contains expressions or drawings which, in the opinion of the International Bureau, are contrary to morality or public order, or if, in its opinion, the international application contains disparaging statements as defined in the Regulations, it may omit such expressions drawings, and statements, from its publications, indicating the place and number of words or drawings omitted, and furnishing, upon request, individual copies of the passages omitted.

***PCT Article 29***

***Effects of the International Publication***

(1) As far as the protection of any rights of the applicant in a designated State is concerned, the effects, in that State, of the international publication of an international application shall, subject to the provisions of paragraphs (2) to (4), be the same as those which the national law of the designated State provides for the compulsory national publication of unexamined national applications as such.

(2) If the language in which the international publication has been effected is different from the language in which publications under the national law are effected in the designated State, the said national law may provide that the effects provided for in paragraph (1) shall be applicable only from such time as:

(i) a translation into the latter language has been published as provided by the national law, or

(ii) a translation into the latter language has been made available to the public, by laying open for public inspection as provided by the national law, or

(iii) a translation into the latter language has been transmitted by the applicant to the actual or prospective unauthorized user of the invention claimed in the international application, or

(iv) both the acts described in (i) and (iii), or both the acts described in (ii) and (iii), have taken place.

(3) The national law of any designated State may provide that, where the international publication has been effected, on the request of the applicant, before the expiration of 18 months from the priority date, the effects provided for in paragraph (1) shall be applicable only from the expiration of 18 months from the priority date.

(4) The national law of any designated State may provide that the effects provided for in paragraph (1) shall be applicable only from the date on which a copy of the international application as published under Article 21 has been received in the national Office of or acting for such State. The said Office shall publish the date of receipt in its gazette as soon as possible.

***PCT Administrative Instructions Section 404***

***International Publication Number of International Application***

The International Bureau shall assign to each published international application an international publication number which shall be different from the international application number. The international publication number shall be used on the published international application and in the Gazette entry. It shall consist of the two-letter code “WO” followed by a four-digit indication of the year of publication, a slant, and a serial number consisting of six digits (e.g., “WO 2004/123456”).

**35 U.S.C. 374 Publication of international application.**

The publication under the treaty defined in section 351(a), of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in section 154(d).

The publication of international applications currently occurs every Thursday. Under PCT Article 20 and PCT Rules 47.1(a) and 93 *bis*.1, the International Bureau communicates published international applications to each of the designated Offices that have requested to receive such documents on the date specified by that Office. Published international applications are available from the WIPO’s Patentscope (**www.wipo.int/patentscope/en/**).

## I. PUBLICATION OF SEQUENCE LISTING FILED IN ELECTRONIC FORM

As of August 2, 2001, WIPO began to publish sequence listing parts of the description on the internet. Sequence listing parts of the description may be viewed and downloaded on the page containing the published international application or at **https://patentscope.wipo.int/search/en/sequences.jsf**. This page also contains a link to the remainder of the published international application.

The bibliographic page of a published international application includes the statement: “Published with sequence listing part of description.”

### II. OMISSION OF CERTAIN INFORMATION

***PCT Rule 48***

***International Publication***

***48.2 Contents***

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(l) The International Bureau shall, upon a reasoned request by the applicant received by the International Bureau prior to the completion of the technical preparations for international publication, omit from publication any information, if it finds that:

(i) this information does not obviously serve the purpose of informing the public about the international application;

(ii) publication of such information would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that information.

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Where the receiving Office, the International Searching Authority, the Authority specified for supplementary search, or the International Bureau notes any information satisfying the requirements of PCT Rule 48.2(l), above, that Office, Authority or Bureau may suggest to the applicant to request the omission of that information from the international publication. See PCT Rule 48.2(m).

Where the International Bureau has omitted such information from the international publication and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplemental search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly. See PCT Rule 48.2(n).

The International Bureau shall not provide access to any information contained in its file which has been omitted from publication as described above, nor to any document contained in its file relating to a request for such omission.

Upon a reasoned request by the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that (i) this information does not obviously serve the purpose of informing the public about the international application; (ii) publication of such information would clearly prejudice the personal or economic interests of any person; and (iii) there is no prevailing public interest to have access to that information. The International Bureau will promptly notify the receiving Office, the International Searching Authority, the Authority specified for supplemental search or the International Preliminary Examining Authority where the International Bureau has omitted information from public access and that information is also contained in the file of that Office and Authority. See PCT Rule 94.1.

The receiving Office, the International Searching Authority, the Authority specified for supplemental search or the International Preliminary Examining Authority shall not provide access to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication or from public access.

## 1858 [Reserved]

## 1859 Withdrawal of International Application, Designations, or Priority Claims [R-10.2019]

***PCT Rule 90 bis***

***Withdrawals***

***90 bis.1 Withdrawal of the International Application***

(a) The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(c) No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

***90 bis.2 Withdrawal of Designations***

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90 *bis*.4 .

(b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent,

withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.

(c) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90 *bis*.1.

(d) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(e) No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

***90 bis.3 Withdrawal of Priority Claims***

(a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date.

(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one or more or all of the priority claims.

(c) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change.

(e) In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

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***90 bis.5 Signature***

Any notice of withdrawal referred to in Rules 90 *bis*.1 to 90 *bis*.4 shall be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall not be entitled to sign such a notice on behalf of the other applicants.

***90 bis.6 Effect of Withdrawal***

(a) Withdrawal under Rule 90 *bis* of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).

(b) Where the international application is withdrawn under Rule 90 *bis*.1, the international processing of the international application shall be discontinued.

(c) Where the demand or all elections are withdrawn under Rule 90 *bis*.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

***90 bis.7 Faculty Under Article 37(4)(b)***

(a) Any Contracting State whose national law provides for what is described in the second part of Article 37(4)(b) shall notify the International Bureau in writing.

(b) The notification referred to in paragraph (a) shall be promptly published by the International Bureau in the Gazette, and shall have effect in respect of international applications filed more than one month after the date of such publication.

For a discussion of the withdrawal of the demand or of elections ( PCT Rule 90 *bis*.4), see MPEP § 1880.

Form PCT/IB/372 may be used by the applicant to make a withdrawal under any of PCT Rules 90 *bis*.1, 90 *bis*.2, 90 *bis*.3, and 90 *bis*.4. The form is available from WIPO's website (**www.wipo.int/pct/en/forms/**).

The applicant may withdraw the international application, the designation of any state, or a priority claim by a notice addressed to the International Bureau or to the receiving Office and received before the expiration of 30 months from the priority date. Where Article 39(1) applies, the notice may also be addressed to the International Preliminary Examining Authority. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. The provisions for waiver of a power of attorney set forth in PCT Rules 90.4(d) and 90.5(c) do not apply in the case of withdrawals under PCT Rule 90 *bis*. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is considered to be the common representative may not sign such a notice on behalf of the other applicants. For international applications filed prior to January 1, 2013, please see the version of PCT Rule 90 *bis*.5 in effect at that time.

The applicant may prevent international publication by withdrawing the international application, provided that the notice of withdrawal reaches the International Bureau before the completion of

technical preparations for that publication. The notice of withdrawal may state that the withdrawal is to be effective only on the condition that international publication can still be prevented. In such a case the withdrawal is not effective if the condition on which it was made cannot be met - i.e., if the technical preparations for international publication have already been completed.

If all designations are withdrawn, the international application will be treated as withdrawn.

Where the withdrawal of a priority claim causes a change in the priority date of the international application, any time limit which is computed from the original priority date and which has not yet expired—for example, the time limit before which processing in the national phase cannot start—is computed from the priority date resulting from the change. (It is not possible to extend the time limit concerned if it has already expired when the priority claim is withdrawn.) Thus, international publication may be postponed by withdrawing the priority claim prior to publication. However, if the notice of withdrawal reaches the International Bureau after the completion of the technical preparations for international publication, the International Bureau may proceed with the international publication on the basis of the time limit for international publication as computed from the original priority date.

## 1860 International Preliminary Examination Procedure [R-01.2024]

### I. EXAMINATION PROCEDURE

The international preliminary examination is to be carried out in accordance with PCT Article 34 and PCT Rule 66. After the demand is checked for compliance with PCT Rules 53 - 55, 57 and 58, the first step of the examiner is to study the description, the drawings (if any), the claims of the international application, the documents describing the prior art as cited in the international search report, and the written opinion established by the International Searching Authority. Furthermore, the examiner shall search at least to the point of bringing the previous search up to date and any new prior art discovered and applied must be made of record. See PCT Rule 66.1 *ter* .

A further written opinion is usually not mandatory where the written opinion of the International Searching Authority is treated as the first written opinion of the International Preliminary Examining Authority. The United States International Preliminary Examining Authority will treat any written opinion of the International Searching Authority established by the USPTO, EPO, KIPO, IP Australia, ILPO, JPO, or IPOS as the first written opinion of the International Preliminary Examining Authority.

Assuming the written opinion of the International Searching Authority is treated as the first written opinion of the International Preliminary Examining Authority, as noted above, no further written opinion need be issued before the international preliminary examination report, even if there are objections outstanding. The examiner takes into consideration any comments or amendments made by the applicant when establishing the international preliminary examination report.

### II. FURTHER WRITTEN OPINION SHOULD BE ISSUED

A further written opinion should be prepared by the examiner if applicant files a response which includes a persuasive argument that the written opinion issued by the International Searching Authority was improper because of a negative opinion with respect to a lack of novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2) - (4); and which results in the examiner considering any of the claims to lack novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2) - (4) based on new art not necessitated by any amendment.

Any further written opinion established by the International Preliminary Examining Authority should set forth, as applicable:

(A) Any defects in the international application as described in PCT Article 34(4) concerning subject matter which is not required to be examined or which is unclear or inadequately supported;

(B) Any negative findings with respect to any of the claims because of a lack of novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2) - (4);

(C) Any defects in the form or contents of the international application;

(D) Any finding by the examiner that an amendment goes beyond the disclosure in the international application as originally filed;

(E) Any observation which the examiner wishes to make on the clarity of the claims, the description, the drawings or to the question whether the claims are fully supported by the description (PCT Rule 66.2);

(F) Any decision by the examiner not to carry out the international preliminary examination on a claim for which no international search report was issued; or

(G) If the examiner considers that no acceptable nucleotide and/or amino acid sequence listing is available in a form that would allow a meaningful international preliminary examination to be carried out.

The further written opinion is prepared on Form PCT/IPEA/408 to notify applicant of the defects found in the international application. The examiner is further required to fully state the reasons for the opinion (PCT Rule 66.2(b)) and invite a written reply, with amendments where appropriate (PCT Rule 66.2(c)), normally setting a 2 month time limit for the reply.

The applicant may reply to the invitation by making amendments or, if applicant disagrees with the opinion of the examiner, by submitting arguments, as the case may be, or both.

The U.S. Rules of Practice pertaining to international preliminary examination of international applications permit a second written opinion in those cases where sufficient time is available. Normally only one written opinion will be issued. Any reply received after the expiration of the set time limit will not normally be considered in preparing the international preliminary examination report. In situations, however, where the examiner has requested an amendment or where a later amendment places the application in better condition for examination, the amendment may be considered by the examiner.

If the applicant does not reply to any further written opinion established by the International Preliminary Examining Authority within the set time period, the international preliminary examination report will be prepared after expiration of the time limit plus sufficient time to have any reply clear the Mail Center.

## 1861 [Reserved]

## 1862 Agreement With the International Bureau To Serve as an International Preliminary Examining Authority [R-07.2015]

***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.

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***37 CFR 1.416 The United States International Preliminary Examining Authority.***

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

(b) The United States Patent and Trademark Office, when acting as an International Preliminary Examining Authority,

will be identified by the full title "United States International Preliminary Examining Authority" or by the abbreviation "IPEA/US."

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

(1) Receiving and checking for defects in the Demand;

(2) Forwarding Demands in accordance with PCT Rule 59.3;

(3) Collecting the handling fee for the International Bureau and the preliminary examination fee for the United States International Preliminary Examining Authority;

(4) Informing applicant of receipt of the Demand;

(5) Considering the matter of unity of invention;

(6) Providing an international preliminary examination report which is a nonbinding opinion on the questions whether the claimed invention appears to be novel, to involve inventive step (to be nonobvious), and to be industrially applicable; and

(7) Transmitting the international preliminary examination report to applicant and the International Bureau.

An agreement was concluded between the United States Patent and Trademark Office (USPTO) and the International Bureau under which the USPTO agreed to serve as an International Preliminary Examining Authority for those applications filed in the USPTO as a Receiving Office and for those international applications filed in other receiving Offices for which the USPTO has served as an International Searching Authority. This agreement between the USPTO and IB is available on WIPO's website (**www.wipo.int/export/sites/www/pct/en/texts/agreements/ag_us.pdf**).

The agreement is provided for in PCT Articles 32(2) & (3) and 34(1), and in PCT Rules 59.1, 63.1, 72.1, and 77.1(a). Authority is given in 35 U.S.C. 361(c), 362(a) & (b) and in 364(a). 37 CFR 1.416(a) and PCT Administrative Instructions Section 103(c) are also relevant.

## 1863 [Reserved]

## 1864 The Demand and Preparation for Filing of Demand [R-07.2015]

***37 CFR 1.480 Demand for international preliminary examination.***

(a) On the filing of a proper Demand in an application for which the United States International Preliminary Examining Authority is competent and for which the fees have been paid, the international application shall be the subject of an international preliminary examination. The preliminary examination fee (§ 1.482(a)(1)) and the handling fee (§ 1.482(b)) shall be due within the applicable time limit set forth in PCT Rule 57.3.

(b) The Demand shall be made on a standardized form (PCT Rule 53). Copies of the printed Demand forms are available from the United States Patent and Trademark Office. Letters requesting printed Demand forms should be marked "Mail Stop PCT."

(c) Withdrawal of a proper Demand prior to the start of the international preliminary examination will entitle applicant to a refund of the preliminary examination fee minus the amount of the transmittal fee set forth in § 1.445(a)(1).

(d) The filing of a Demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7).

(e) Any Demand filed after the expiration of the applicable time limit set forth in PCT Rule 54 *bis*.1(a) shall be considered as if it had not been submitted (PCT Rule 54 *bis*.1(b)).

Once applicant has filed an international application under Chapter I of the PCT, applicant has the right to file a demand for preliminary examination under Chapter II of the Treaty. The use of the term "Demand" distinguishes Chapter II from the "Request" under Chapter I. It is not possible to file a demand unless a proper Chapter I "Request" for an international application has been filed. Chapter I affords applicant the benefit of an international search, which includes an international search report and a written opinion established by the International Searching Authority. The filing of a demand affords applicant examination of the application and allows applicant to file amendments to the description, claims and drawings to correct any defects, respond to any observations, or address negative findings with respect to any of the claims because of a lack of novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2) - (4) mentioned in the written opinion (Form PCT/ISA/237) established by the International Searching Authority. Thus, examination enables applicant to attempt to obtain a positive international preliminary examination report, which in some elected Offices is used as a basis for the issuance of a patent or acceleration programs, e.g., Patent Prosecution Highway.

The demand should be filed on Form PCT/IPEA/401 along with the fee calculation sheet. The form is available free of charge on WIPO's website at **www.wipo.int/pct/en/forms/index.html**.

# 1864.01 Amendments Filed Under PCT Article 34 [R-07.2015]

***PCT Article 34***

***Procedure Before the International Preliminary Examining Authority***

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(2)

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(b) The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.

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***PCT Rule 66***

***Procedure Before the International Preliminary Examining Authority***

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***66.8 Form of Amendments***

(a) Subject to paragraph (b) when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, shall indicate the basis for the amendment in the application as filed and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, the replacement sheet referred to in paragraph (a) may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

*****

***37 CFR 1.485 Amendments by applicant during international preliminary examination.***

The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining Authority for reply to any notification under § 1.484(b) or to any written opinion. Any such amendments must be made in accordance with PCT Rule 66.8.

Under PCT Article 34(2)(b), the applicant has a right to amend the claims, the description, and the drawings in the application before the International Preliminary Examining Authority (IPEA) before the international preliminary examination report is established. The amendment may be filed with the demand (PCT Article 34), within the period for reply to the written opinion of the International Searching Authority (ISA), or within the period for reply to the written opinion of the IPEA.

See MPEP § 1871 regarding the processing of amendments filed prior to or at the start of international preliminary examination. See MPEP § 1878.02 regarding amendments filed in reply to the written opinion of the ISA or IPEA.

The applicant must submit a replacement sheet for every sheet which, on account of an amendment, differs from the sheet previously filed. The amendment must be submitted with an accompanying letter which explains the difference between the replaced sheet and the replacement sheet and which preferably explains the reasons for the amendment. In addition, the letter must indicate the basis for the amendment in the application. The basis for the amendment must always refer to the application (description, claims, drawings) as originally filed, even if multiple amendments were made during the international phase. When filing amendments to the claims, a complete set of claims in replacement of the claims as originally filed (or previously amended under Article 19) shall be submitted. For an example of how the basis for the amendment should be indicated, see MPEP § 1853. Where the amendment consists in the deletion of passages or in minor alterations or additions, the alterations or additions may be made on a copy of the relevant sheet of the international application, provided that the clarity and direct reproducibility of that sheet are not adversely affected. No replacement sheet is required where the amendment results in the cancellation of an entire sheet; such an amendment may be communicated in a letter which preferably explains the reasons for the amendment.

Where the international application was not filed in the language of publication, any amendments under Article 34 and any accompanying letter (as well as any letter accompanying Article 19 amendments)

must be in the language of publication. Where the international preliminary examination is carried out on the basis of a translation of the international application, any amendments under Article 34 and any amendments under Article 19, which are to be taken into account, and any accompanying letter must be in the language of that translation. Where such amendments have been or are filed in another language, a translation of the amendments into the language in which the international preliminary examination is carried out must also be furnished. No fee is payable in respect of filing any amendments under Article 34(2)(b). If the amendments or accompanying letter are not in the required language, the International Preliminary Examining Authority will invite the applicant to furnish them within a reasonable time limit. If the applicant fails to furnish the amendments and/or the accompanying letter within the time limit set in the invitation, the International Preliminary Examining Authority shall not take such amendments into account for the purposes of the international preliminary examination.

## 1864.02 Applicant's Right To File a Demand [R-07.2015]

***PCT Article 31***

***Demand for International Preliminary Examination***

*****

(2)

(a) Any applicant who is a resident or national, as defined in the Regulations, of a Contracting State bound by Chapter II, and whose international application has been filed with the receiving Office of or acting for such State, may make a demand for international preliminary examination.

*****

***PCT Rule 54***

***The Applicant Entitled to Make a Demand***

***54.1 Residence and Nationality***

(a) Subject to the provisions of paragraph (b), the residence or nationality of the applicant shall, for the purposes of Article 31(2), be determined according to Rule 18.1(a) and (b).

(b) The International Preliminary Examining Authority shall, in the circumstances specified in the Administrative Instructions, request the receiving Office or, where the international application was filed with the International Bureau as receiving Office, the national Office of, or acting for, the Contracting State concerned to decide the question whether the applicant is a resident or national of the Contracting State of which he claims to be a resident or national. The International Preliminary Examining Authority shall inform the applicant of any such request. The applicant shall have an opportunity to submit arguments directly to the Office concerned. The Office concerned shall decide the said question promptly.

***54.2 Right to Make a Demand***

The right to make a demand under Article 31(2) shall exist if the applicant making the demand or, if there are two or more applicants, at least one of them is a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II.

***54.3 International Applications Filed with the International Bureau as Receiving Office***

Where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), the International Bureau shall, for the purposes of Article 31(2)(a), be considered to be acting for the Contracting State of which the applicant is a resident or national.

***54.4 Applicant Not Entitled to Make a Demand***

If the applicant does not have the right to make a demand or, in the case of two or more applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.

If there is a sole applicant, he or she must be a resident or national of a Contracting State bound by Chapter II of the PCT. If there are two or more applicants, it is sufficient that one of them be a resident or national of a Contracting State bound by Chapter II, regardless of the elected State(s) for which each applicant is indicated. Only applicants for the elected States are required to be indicated in the Demand. The detailed requirements for the various indications required in connection with each applicant (name and address, telephone number, facsimile machine number, nationality and residence) are the same as those required under PCT Rule 4 in connection with the Request. Note that any inventor who is not also an applicant is not indicated in the Demand.

If the recording of a change in the name or person has been requested under PCT Rule 92 *bis*.1 before the Demand was filed, it is the applicant(s) of record at the time when the Demand is filed who must be indicated in the Demand.

## 1864.03 States Which May Be Elected [R-07.2015]

***PCT Article 31***

***Demand for International Preliminary Examination***

*****

(4)

(a) The demand shall indicate the Contracting State or States in which the applicant intends to use the results of the international preliminary examination ("elected States"). Additional Contracting States may be elected later. Election may relate only to Contracting States already designated under Article 4.

(b) Applicants referred to in paragraph (2)(a) may elect any Contracting State bound by Chapter II. Applicants referred to in paragraph (2)(b) may elect only such Contracting States bound by Chapter II as have declared that they are prepared to be elected by such applicants.

*****

The filing of a demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7). For demands filed before January 1, 2004, only those eligible states pursuant to PCT Article 31 indicated as being elected are elected. Only PCT member states which have ratified or acceded to Chapter II and which were designated in the Request may be elected under Chapter II. The Assembly has taken no action to allow persons who are residents or nationals of a State not party to the PCT or not bound by Chapter II to make a Demand under Article 31(2)(b).

## 1864.04 Agent's Right To Act [R-08.2012]

Any agent entitled to practice before the receiving Office where the international application was filed may represent the applicant before the international authorities ( PCT Article 49).

If for any reason, the examiner needs to question the right of an attorney or agent to practice before the International Preliminary Examining Authority (IPEA), the USPTO roster of registered attorneys and agents should be consulted. If the international application was filed with a receiving Office other than the United States, Form PCT/IPEA/410 may be used by the requesting IPEA to ask the receiving Office with which the international application was filed, whether the agent named in the international application has the right to practice before that Office.

The PCT Article and Regulations governing the right to practice are PCT Article 49 and PCT Rule 83.

## 1865 Filing of Demand [R-01.2024]

***PCT Article 31***

***Demand for International Preliminary Examination***

(1) On the demand of the applicant, his international application shall be the subject of an international preliminary examination as provided in the following provisions and the Regulations.

*****

(3) The demand for international preliminary examination shall be made separately from the international application. The demand shall contain the prescribed particulars and shall be in the prescribed language and form.

*****

(6)

(a) The demand shall be submitted to the competent International Preliminary Examining Authority referred to in Article 32.

*****

Applicants should submit the Demand and appropriate fees directly to the International Preliminary Examining Authority (IPEA) they desire to prepare the International Preliminary Examination Report. The demand must be filed prior to the expiration of whichever of the following periods expires later: (A) three months from the date of transmittal to the applicant of the international search report and the written opinion; or (B) 22 months from the priority date. Otherwise the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare. See PCT Rule 54. In order to take advantage of a national phase entry time limit of at least 30 months from the priority date in relation to all States designated in the international application, it may be necessary to file a demand before the expiration of 19 months from the priority date. See MPEP § 1842, subsection VII.A.

**CHOICE OF INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**

The IPEA/US will serve as International Preliminary Examining Authority for U.S. residents and nationals if the USPTO, EPO, KIPO, IP Australia, ILPO, JPO or IPOS served as the International Searching Authority (ISA) and the international application was filed in the U.S. receiving Office or the International Bureau as receiving Office.

The IPEA/US will also serve as International Preliminary Examining Authority for residents or nationals of Bahrain, Barbados, Brazil, Chile, Dominican Republic, Egypt, Georgia, Guatemala, India, Israel, Jordan, Mexico, New Zealand, Oman, Panama, Peru, the Philippines, Qatar, Saint Kitts and Nevis, Saint Lucia, Saint Vincent and the Grenadines, South Africa, Thailand, and Trinidad and Tobago if the USPTO was the ISA.

U.S. residents and nationals may also choose to have the international preliminary examination done by KIPO if the USPTO, EPO, KIPO, IP Australia, ILPO, JPO, or IPOS served as the ISA.

U.S. residents and nationals may choose to have the international preliminary examination done by the EPO if the EPO served as the ISA.

U.S. residents and nationals may choose to have the international preliminary examination done by IP Australia if IP Australia served as the ISA and IP Australia has not received more than 250 international applications from the USPTO during the fiscal quarter.

U.S. residents and nationals may choose to have the international preliminary examination done by ILPO if ILPO served as the ISA. ILPO has certain restrictions of competency as an IPEA based upon the subject matter of the application.

U.S. residents and nationals may choose to have the international preliminary examination done by the JPO if the JPO served as the ISA.

U.S. residents and nationals may choose to have the international preliminary examination done by the IPOS if the IPOS served as the ISA.

Information regarding the demand filing with the specific IPEA is available on the PCT Applicant's Guide at WIPO's website (**www.wipo.int/pct/en/appguide/**).

Demands filed in the United States Patent and Trademark Office (USPTO) should preferably be filed via the USPTO patent electronic filing system by registered users in an application filed with the U.S. receiving office or searched by the USPTO. Filers who are not registered users of the USPTO patent electronic filing system must file the demand by another acceptable method.

To avoid unnecessary work and communication by the USPTO, applicants should not file a courtesy copy of a Demand with the USPTO, because the U.S. International Preliminary Examining Authority will process the Demand. If the USPTO is not a competent IPEA, the Demand will be forwarded to the IB.

If mailed to the USPTO, the Demand should be addressed as follows:

Mailing address for delivery by the U.S. Postal Service:

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

OR

If hand-carried directly to the USPTO, papers should be addressed to "Mail Stop PCT." See MPEP § 501, subsection III for information regarding hand-delivery of papers.

The Priority Mail Express® provisions of 37 CFR 1.10 may be used to file a Demand under Chapter II in the USPTO. Applicants are advised that failure to comply with the provisions of 37 CFR 1.10 will result in the paper or fee being accorded the date of receipt and not the date of deposit. See MPEP § 513.

Demand for international preliminary examination may also be submitted to the USPTO via facsimile. The Certificate of Mailing or Transmission practice under 37 CFR 1.8 CANNOT be used to file a

Demand if the date of deposit is desired. If used, the date of the Demand will be the date of receipt in the USPTO. See MPEP §§ 513, 1834, and 1834.01.

All Demands filed in the USPTO must be in the English language.

PCT Rule 59.3 provides a safeguard in the case of a Demand filed with an International Preliminary Examining Authority which is not competent for the international preliminary examination of a particular international application. The USPTO will forward such a Demand to the International Bureau and the International Bureau will forward the Demand to a competent International Preliminary Examining Authority pursuant to PCT Rule 59.3(c). The competent International Preliminary Examining Authority will process the Demand based on the date of receipt in the USPTO. See 37 CFR 1.416(c)(2).

Rec'd PCT/PTO 09 September 2022 (09.09.2022)

*The demand must be filed directly with the competent International Preliminary Examining Authority or, if two or more Authorities are competent, with the one chosen by the applicant. The full name or two-letter code of that Authority may be indicated by the applicant on the line below:*

**IPEA/** US

# PCT

## DEMAND

**CHAPTER II**

under Article 31 of the Patent Cooperation Treaty:
The undersigned requests that the international application specified below be the subject of international preliminary examination according to the Patent Cooperation Treaty.

For International Preliminary Examining Authority use only

| Identification of IPEA | Date of receipt of DEMAND |
|---|---|
| /US | 09 September 2022 (09.09.2022) |

**Box No. I IDENTIFICATION OF THE INTERNATIONAL APPLICATION**

| Applicant's or agent's file reference | International application No. |
|---|---|
| CMC-123-PCT | PCT/US2022/080008 |
| International filing date *(day/month/year)* | (Earliest) Priority date *(day/month/year)* |
| 10 March 2022 (10.03.2022) | 10 March 2021 (10.03.2021) |

Title of invention
ELECTRO-MAGNETIC FASTENER DRIVER

**Box No. II APPLICANT(S)**

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

ACME FASTENER CORPORATION
300 Pratt Street
Baltimore, Maryland 20726
United States of America

E-mail address*

Telephone No.
(410) 876-5432

Facsimile No.
(410) 876-5555

Applicant's registration No. with the Office

* **E-mail authorization**: Indicating an e-mail address above authorizes the International Bureau and the International Preliminary Examining Authority, if they provide such a service, to send notifications exclusively by e-mail to that address, unless the following box is marked:

☐ notifications are requested to be sent exclusively by postal mail.

| State *(that is, country)* of nationality: | State *(that is, country)* of residence: |
|---|---|
| US | US |

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

JONES, Mary
1600 South Eads Street
Arlington, Virginia 22202
United States of America

| State *(that is, country)* of nationality: | State *(that is, country)* of residence: |
|---|---|
| US | US |

☐ Further applicants are indicated on a continuation sheet.

Form PCT/IPEA/401 (first sheet) (July 2022) *See Notes to the demand form*

Sheet No. . 2

International application No.
PCT/US2022/080008

**Box No. III AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE**

The following person is ☒ agent ☐ common representative

and ☒ has been appointed earlier and represents the applicant(s) also for international preliminary examination.

☐ is hereby appointed and any earlier appointment of (an) agent(s)/common representative is hereby revoked.

☐ is hereby appointed, specifically for the procedure before the International Preliminary Examining Authority, in addition to the agent(s)/common representative appointed earlier.

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

SMITH, John J.
220 Richmond Highway
Arlington, Virginia 22202
United States of America

E-mail address*

Telephone No.
(703) 557-3054

Facsimile No.
(703) 557-3060

Agent's registration No. with the Office
11,111

* **E-mail authorization**: Indicating an e-mail address above authorizes the International Bureau and the International Preliminary Examining Authority, if they provide such a service, to send notifications exclusively by e-mail to that address, unless the following box is marked:

☐ notifications are requested to be sent exclusively by postal mail.

☐ **Address for correspondence:** Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.

**Box No. IV BASIS FOR INTERNATIONAL PRELIMINARY EXAMINATION**

**Statement concerning amendments:***

1. The applicant wishes the international preliminary examination **to start on the basis of:**

| | | |
|---|---|---|
| the description | ☒ | as originally filed, or |
| | ☐ | as amended under Article 34 |
| the sequence listing (if any) | ☐ | as originally filed, or |
| | ☐ | as amended under Article 34 |
| the claims | ☐ | as originally filed, or |
| | ☐ | as amended under Article 19, and/or |
| | ☒ | as amended under Article 34 |
| the drawings (if any) | ☒ | as originally filed, or |
| | ☐ | as amended under Article 34 |

2. ☐ The applicant wishes any amendment to the claims under Article 19 to be considered as reversed.

3. ☐ Where the IPEA wishes to start the international preliminary examination at the same time as the international search in accordance with Rule 69.1(b), the applicant requests the IPEA **to postpone** the start of the international preliminary examination until the expiration of the applicable time limit under Rule 69.1(d).

4. ☐ The applicant expressly requests **to postpone** the start of the international preliminary examination until the expiration of the applicable time limit under Rule 54*bis*.1(a).

* Where no check-box is marked, international preliminary examination will start on the basis of the international application as originally filed or, where a copy of amendments to the claims under Article 19 and/or amendments of the international application under Article 34 are received by the International Preliminary Examining Authority before it has begun to draw up a written opinion or the international preliminary examination report, as so amended.

**Language for the purposes of international preliminary examination:** English

☒ which is the language in which the international application was filed.

☐ which is the language of a translation furnished for the purposes of international search.

☐ which is the language of publication of the international application.

☐ which is the language of the translation (to be) furnished for the purposes of international preliminary examination.

**Box No. V ELECTION OF STATES**

The filing of this demand constitutes the election of all Contracting States which are designated and are bound by Chapter II of the PCT.

Form PCT/IPEA/401 (second sheet) (July 2022) *See Notes to the demand form*

Sheet No. . . 3

International application No.
PCT/US2022/080008

**Box No. VI CHECK LIST**

The demand is accompanied by the following elements, in the language referred to in Box No. IV, for the purposes of international preliminary examination:

| | | | | For International Preliminary Examining Authority use only: received | not received |
|---|---|---|---|---|---|
| 1. translation of international application | : | | sheets | ☐ | ☐ |
| 2. amendments under Article 34 | : | 2 | sheets | ☒ | ☐ |
| 3. amended sequence listing under Article 34 | : | | ☐ | ☐ | ☐ |
| 4. letter accompanying the amendments under Article 34 (Rule 66.8) | : | 3 | sheets | ☒ | ☐ |
| 5. copy (or, where required, translation) of amendments under Article 19 | : | | sheets | ☐ | ☐ |
| 6. copy of the letter accompanying the amendments under Article 19 (Rules 46.5(b) and 53.9) | : | | sheets | ☐ | ☐ |
| 7. copy (or, where applicable, translation) of any statement under Article 19 (Rule 62.1(ii)) | : | | sheets | ☐ | ☐ |
| 8. other *(specify)* | : | | sheets | ☐ | ☐ |

The demand is also accompanied by the item(s) marked below:

1. ☒ fee calculation sheet
2. ☐ original separate power of attorney
3. ☐ original general power of attorney
4. ☐ copy of general power of attorney; reference number, if any:
5. ☐ sequence listing for the purposes of international preliminary examination (Rule 13*ter*)
6. ☐ a statement to the effect that the sequence listing does not go beyond the disclosure in the international application as filed
7. ☐ other *(specify)*: _____

**Box No. VII SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE**

*Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the demand).*

/J J Smith, reg. no. 11,111/
John J. Smith, agent

For International Preliminary Examining Authority use only

1. Date of actual receipt of DEMAND: Rec'd PCT/PTO 09 September 2022 (09.09.2022)

2. Adjusted date of receipt of demand due to CORRECTIONS under Rule 60.1(b):

3. ☐ The date of receipt of the demand is AFTER the expiration of 19 months from the priority date and item 4 or 5, below, does not apply.
   ☐ The applicant has been informed accordingly.
4. ☐ The date of receipt of the demand is WITHIN the time limit of 19 months from the priority date as extended by virtue of Rule 80.5.
5. ☐ Although the date of receipt of the demand is after the expiration of 19 months from the priority date, the delay in arrival is EXCUSED pursuant to Rules 82 or 82*quater*.
6. ☐ The date of receipt of the demand is AFTER the expiration of the time limit under Rule 54*bis*.1(a) and item 7 or 8, below, does not apply.
7. ☐ The date of receipt of the demand is WITHIN the time limit under Rule 54*bis*.1(a) as extended by virtue of Rule 80.5.
8. ☐ Although the date of receipt of the demand is after the expiration of the time limit under Rule 54*bis*.1(a), the delay in arrival is EXCUSED pursuant to Rules 82 or 82*quater*.

For International Bureau use only

Demand received from IPEA on:

Form PCT/IPEA/401 (last sheet) (July 2022) *See Notes to the demand form*

CHAPTER II

# PCT

**FEE CALCULATION SHEET**

**Annex to the Demand**

International application No.
PCT/US2022/080008

Applicant's or agent's file reference
CMC-123-PCT

For International Preliminary Examining Authority use only

09 September 2022 (09.09.2022)

Date stamp of the IPEA

Applicant
ACME FASTENER CORPORATION

**CALCULATION OF PRESCRIBED FEES**

*(Applicants may be entitled to a reduction of the preliminary examination fee and the handling fee as indicated in the PCT Fee Tables (www.wipo.int/pct/en/fees.pdf))*

| | | |
|---|---|---|
| 1. PRELIMINARY EXAMINATION FEE . . . . . | 640 P | 640 |
| 2. HANDLING FEE . . . . . | 217 H | 217 |
| 3. TOTAL OF PRESCRIBED FEES<br>Add the amounts entered at P and H and enter total in the TOTAL box . . . . . | 857<br>TOTAL | 857 |

**MODE OF PAYMENT**
*(Not all modes of payment may be available at all IPEAs)*

- ☐ credit card *(details should not be included on this sheet)*
- ☒ authorization to charge deposit or current account with the IPEA (see below)
- ☐ bank transfer
- ☐ cash
- ☐ postal money order
- ☐ check
- ☐ revenue stamps
- ☐ other *(specify)*: _____

**AUTHORIZATION TO CHARGE (OR CREDIT) DEPOSIT OR CURRENT ACCOUNT**
*(This mode of payment may not be available at all IPEAs)*

IPEA/ US

☒ Authorization to charge the total fees indicated above.

☒ *(This check-box may be marked only if the conditions for deposit or current accounts of the IPEA so permit)* Authorization to charge any deficiency or credit any overpayment in the total fees indicated above.

Deposit or Current Account No.: 12-3456

Date: 09 September 2022 (09.09.2022)

Name: John J. Smith

Signature: /J J Smith, reg. no. 11,111/

Form PCT/IPEA/401 (Annex) (July 2022) *See Notes to the fee calculation sheet*

## 1866 [Reserved]

## 1867 Preliminary Examination Fees [R-07.2015]

***37 CFR 1.481 Payment of international preliminary examination fees.***

(a) The handling and preliminary examination fees shall be paid within the time period set in PCT Rule 57.3. The handling fee or preliminary examination fee payable is the handling fee or preliminary examination fee in effect on the date of payment.

(1) If the handling and preliminary fees are not paid within the time period set in PCT Rule 57.3, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of:

(i) Fifty percent of the amount of the deficient fees, but not exceeding an amount equal to double the handling fee; or

(ii) An amount equal to the handling fee (PCT Rule 58 *bis*.2).

(2) The one-month time limit set in this paragraph to pay deficient fees may not be extended.

(b) If the payment needed to cover the handling and preliminary examination fees, pursuant to paragraph (a) of this section, is not timely made in accordance with PCT Rule 58 *bis*.1(d), the United States International Preliminary Examination Authority will declare the Demand to be considered as if it had not been submitted.

The preliminary examination fee is for the benefit of the International Preliminary Examining Authority and the amount for the USPTO doing the preliminary examination is specified in 37 CFR 1.482. The fee is somewhat higher if the international search was performed by an authority other than the USPTO.

The handling fee is a fee for the benefit of the International Bureau and is collected by the International Preliminary Examining Authority.

The current amount of both the preliminary examination fee and the handling fee can be found in each weekly issue of the *Official Gazette.* Since supplements to the handling fee were deleted, no additional Chapter II fees are required other than any additional preliminary examination fee where additional inventions are determined to be present. The amount of this fee is also specified in 37 CFR 1.482 and in the weekly issues of the *Official Gazette*. See also PCT Rules 57 and 58.

The time limit for paying the preliminary examination fee and the handling fee is set forth in PCT Rules 57.3 and 58.1(b). 37 CFR 1.481(a) provides that the preliminary examination fee or handling fee payable is the preliminary examination fee or handling fee in effect on the date of payment. The preliminary examination fee and handling fee are considered to have been received before the expiration of the time limit set in PCT Rule 57.3 if the fees were submitted prior to the sending of an invitation to pay the fees. See PCT Rule 58 *bis*.1(c).

PCT Rule 58 *bis*.1(a) permits the International Preliminary Examining Authority to collect a late payment fee set forth in PCT Rule 58 *bis*.2 if the fees for preliminary examination are not paid prior to the sending of the invitation to pay the fees. If the preliminary examination fee and handling fee are not paid within the time set in PCT Rule 57.3, applicants will be notified and given 1 month within which to pay the deficient fees plus a late payment fee equal to the greater of: (1) 50% of the amount of the deficient fees, but not exceeding an amount equal to double the handling fee; or (2) an amount equal to the handling fee. See 37 CFR 1.481(a)(1)(i) and (ii). The 1 month time limit set forth in 37 CFR 1.481(a)(1) to pay deficient fees may not be extended. See 37 CFR 1.481(a)(2).

If the payment needed to cover the preliminary examination fee and handling fee is not timely made in accordance with PCT Rule 58 *bis*.1(d), the United States International Preliminary Examining Authority will declare the Demand to be considered as if it had not been submitted. In this regard, where the Authority sends a notification that the Demand is considered not to have been made and applicant's payment is received on the same date the notification is sent, the fee is considered to be late and the notification remains effective. The fee must antedate the notice in order for the notice not to be effective. See 37 CFR 1.481(b).

## 1868 Correction of Defects in the Demand [R-07.2015]

***PCT Rule 60***

***Certain Defects in the Demand or Elections***

***60.1 Defects in the Demand***

(a) Subject to paragraphs (a-*bis*) and (a-*ter*), if the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iii), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(a-bis) For the purposes of Rule 53.4, if there are two or more applicants, it shall be sufficient that the indications referred to in Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who has the right according to Rule 54.2 to make a demand.

(a-ter) For the purposes of Rule 53.8, if there are two or more applicants, it shall be sufficient that the demand be signed by one of them.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

(c) If the applicant does not comply with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(d) [Deleted]

(e) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs (a) to (c).

(f) If the demand does not contain a statement concerning amendments, the International Preliminary Examining Authority shall proceed as provided for in Rules 66.1 and 69.1(a) or (b).

(g) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand ( Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall invite the applicant to submit the amendments within a time limit fixed in the invitation and shall proceed as provided for in Rule 69.1(e).

Defects in the Demand may be corrected. The type of correction determines whether the filing date of the Demand must be changed. The most common defects which result in the mailing of an invitation to correct are found in PCT Rules 53 and 55. If the applicant complies with the invitation, the Demand is considered as if it had been received on the actual filing date, i.e., the original date of receipt, provided that the demand as submitted permitted the international application to be identified. See PCT Rule 60.1(b).

## 1869 Notification to International Bureau of Demand [R-08.2012]

***PCT Article 31***

***Demand for International Preliminary Examination***

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(7) Each elected Office shall be notified of its election.

The International Preliminary Examining Authority, pursuant to PCT Rule 61, promptly notifies the International Bureau and the applicant of the filing of any Demand. The International Bureau in turn notifies each elected Office of their election and also notifies the applicant that such notification has been made.

## 1870 Priority Document and Translation Thereof [R-08.2012]

***PCT Rule 66***

***Procedure before the International Preliminary Examining Authority***

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***66.7 Copy and Translation of Earlier Application Whose Priority Is Claimed***

(a) If the International Preliminary Examining Authority needs a copy of the earlier application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1, and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, the international preliminary examination report may be established as if the priority had not been claimed.

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the

international preliminary examination report may be established as if the priority had not been claimed.

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A copy of the priority document and/or a translation thereof, if the priority document is not in English may be required by the examiner if necessary because of an intervening reference.

## 1871 Processing Amendments Filed Under Article 19 and Article 34 Prior to or at the Start of International Preliminary Examination [R-01.2024]

***PCT Rule 62***

***Copy of the Written Opinion by the International Searching Authority and of Amendments Under Article 19 for the International Preliminary Examining Authority***

***62.1 Copy of Written Opinion by International Searching Authority and of Amendments Made Before the Demand Is Filed***

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

(i) a copy of the written opinion established under Rule 43 *bis*.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and

(ii) a copy of any amendment under Article 19, and any statement referred to in that Article, and the letter required under Rule 46.5(b), unless that Authority has indicated that it has already received such a copy.

***62.2 Amendments Made After the Demand Is Filed***

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments, and any statement referred to in that Article and the letter required under Rule 46.5(b). In any case, the International Bureau shall promptly transmit a copy of such amendments, statement and letter to that Authority.

***PCT Rule 62 bis***

***Translation for the International Preliminary Examining Authority of the Written Opinion of the International Searching Authority***

***62 bis.1 Translation and Observations***

(a) Upon request of the International Preliminary Examining Authority, the written opinion established under Rule 43 *bis*.1 shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau.

(b) The International Bureau shall transmit a copy of the translation to the International Preliminary Examining Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

(c) The applicant may make written observations as to the correctness of the translation and shall send a copy of the observations to the International Preliminary Examining Authority and to the International Bureau.

***PCT Rule 66***

***Procedure before the International Preliminary Examining Authority***

***66.8 Form of Amendments***

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, shall indicate the basis for the amendment in the application as filed and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, the replacement sheet referred to in paragraph (a) may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

The documents making up the international application may include amendments of the claims filed by the applicant under PCT Article 19. Article 19 amendments are exclusively amendments to the claims and these amendments can only be made after the international search report has been established. Article 19 amendments, any statement referred to in that Article, and the letter required under PCT Rule 46.5(b) will be transmitted to the International Preliminary Examining Authority (IPEA) by the International Bureau unless that Authority has indicated that it has already received such a copy. The International Bureau marks, in the upper right-hand corner of each replacement sheet submitted under PCT Article 19, the international

application number, the date on which that sheet was received under PCT Article 19 and, in the middle of the bottom margin, the words "AMENDED SHEET (ARTICLE 19)." Where a demand for international preliminary examination has been submitted to the IPEA/US and a copy of the PCT Article 19 amendments has not yet been received from the IB, applicant may consider filing a copy directly with the IPEA/US. If the copy of the PCT Article 19 amendments has not been stamped as "AMENDED SHEET (ARTICLE 19)" by the IB, the IPEA/US will treat the unstamped copy as an amendment under PCT Article 34.

The IPEA starts the international preliminary examination when it is in possession of the demand; the required fees; if the applicant is required to furnish a translation under PCT Rule 55.2, that translation; either the international search report or a notice of the declaration by the International Searching Authority under PCT Article 17(2)(a) that no international search report will be established; and the written opinion established under PCT Rule 43 *bis*.1, unless the applicant expressly requests to postpone the start of the international preliminary examination until the expiration of the later of three months from the transmittal of the international search report, or declaration that no international search report will be established, and written opinion; or the expiration of 22 months from the priority date, with the exception of the following situations:

(A) If the competent IPEA is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the IPEA so wishes, start at the same time as the international search, provided that the examination is not to be postponed according to the statement concerning PCT Article 19 amendments (PCT Rule 53.9(b));

(B) Where the statement concerning amendments contains an indication that amendments made with the International Bureau under PCT Article 19 are to be taken into account (PCT Rule 53.9(a)(i)), the IPEA does not start the international preliminary examination before it has received a copy of the amendments concerned, any statement referred to in that Article and the letter required under PCT Rule 46.5(b). These will be transmitted to the IPEA by the International Bureau. The applicant should preferably, at the time the applicant files the demand, also file a copy of the amendments, any statement referred to in that Article and the letter required under PCT Rule 46.5(b) with the IPEA;

(C) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (PCT Rule 53.9(b)), the IPEA does not start the international preliminary examination before:

(1) it has received a copy of any amendments made under PCT Article 19, any statement referred to in that Article and the letter required under Rule 46.5(b);

(2) it has received a notice from the applicant that the applicant does not wish to make amendments under PCT Article 19; or

(3) the later of two months from the transmittal of the international search report or the expiration of 16 months from the priority date;

whichever occurs first; and

(D) Where the statement concerning amendments contains an indication that amendments under PCT Article 34 are submitted with the demand (PCT Rule 53.9(c)) but no such amendments are, in fact, submitted, the IPEA does not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in PCT Rule 60.1(g) has expired, whichever occurs first.

The applicant has the right to amend the claims, the description, and the drawings, in the prescribed manner and before the start of international preliminary examination. The amendment must not go beyond the disclosure in the international application as filed. These amendments are referred to as PCT Article 34(2)(b) amendments. It should be noted that PCT Article 19 amendments are strictly amendments to the claims made during the Chapter I search phase while PCT Article 34(2)(b) amendments to the description, claims, and drawings are made during the Chapter II examination phase.

When amendments to the description or drawings are made under PCT Rule 66.8, the applicant shall

be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, shall indicate the basis for the amendment in the application as filed and shall preferably also explain the reasons for the amendment. When amendments to the claims are made under PCT Rule 66.8, the applicant shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed or previously amended under Articles 19 or 34, as the case may be. The replacement sheet or sheets must be accompanied by a letter that identifies the claims which, on account of the amendments, differ from the claims originally filed, and shall (A) draw attention to the differences between the claims originally filed and the claims as amended, (B) identify the claims originally filed which, on account of the amendments, are cancelled, and (C) indicate the basis for the amendments in the application as filed. These amendments may have been submitted to avoid possible objections as to lack of novelty or lack of inventive step in view of the citations listed in the international search report and the observations on novelty, inventive step, and industrial applicability set forth in the written opinion established by the International Searching Authority; to meet any objections noted by the International Searching Authority under PCT Article 17(2)(a)(ii) (i.e., that all or at least some claims do not permit a meaningful search) or under PCT Rule 13 (i.e., that there is a lack of unity of invention); or to meet objections that may be raised for some other reason, e.g., to remedy some obscurity which the applicant has noted in the original documents.

The amendments are made by the applicant of the applicant's own volition. This means that the applicant is not restricted to amendments necessary to remedy a defect in the international application. It does not, however, mean that the applicant should be regarded as free to amend in any way the applicant chooses. Any amendment must not add subject matter which goes beyond the disclosure of the international application as originally filed. Furthermore, it should not itself cause the international application as amended to be objectionable under the PCT, e.g., the amendment should not introduce obscurity.

As a matter of policy and to ensure consistency in handling amendments filed under Articles 19 and 34 of the PCT, the following guidelines for processing these amendments have been established:

(A) Any argument or amendment which complies with 37 CFR 1.485 will be considered;

(B) Amendments filed after the demand:

(1) will be considered if filed before the expiration of the applicable time limit under PCT Rule 54 *bis*.1(a) which is the later of:

(a) three months from the transmittal of either the international search report or a notice of the declaration by the International Searching Authority under PCT Article 17(2)(a) that no international search report will be established, and the written opinion established under PCT Rule 43 *bis*.1; or

(b) the expiration of 22 months from the priority date.

Note however, that if applicant did not expressly request to postpone the start of the international preliminary examination until the expiration of the time limit under PCT Rule 54 *bis*.1(a), then the examiner is not required to consider the post-Demand amendment, even if such amendment is filed before the expiration of the applicable time limit under PCT Rule 54 *bis*.1(a).

(2) will be considered if filed before the application is docketed to the examiner. To ascertain if the application has been docketed to the examiner, check the USPTO patent electronic filing system or contact the PCT Help Desk. See MPEP § 1730, subsection III.

(3) may be considered if filed after docketing. The examiner has discretion to consider such amendments if the examiner determines that the amendment places the application in better condition for examination or the examiner determines that the amendment should otherwise be entered.

(C) Amendments and/or arguments filed after expiration of the period for response to the written opinion:

(1) will be considered if the amendment was requested by the examiner,

(2) need not be taken into account for the purposes of a further written opinion or the international preliminary examination report if they are received after the examiner has begun to draw up that opinion or report. The applicant may file an amendment to the description, the claims and the drawings in the prescribed manner, even if this is outside the time period set for reply in PCT Rule 66.2(d). Since the examiner may begin to draw up the final report once the time period set for reply in PCT Rule 66.2(d) expires, amendments filed after the expiration of the time period set in for reply in PCT Rule 66.2(d) may or may not be considered. There may be situations where it is advisable, to the extent possible, to take such amendments or arguments into account, for example, where the international preliminary examination report has not yet been completed and it is readily apparent to the examiner that consideration of the late-filed response would result in the issuance of a favorable report.

It is expected, due to the relatively short time period for completion of preliminary examination, that the Chapter II application will be taken up promptly after docketing to the examiner for preparation of either a further written opinion, if necessary, or the international preliminary examination report (Form PCT/IPEA/409).

Amendments timely filed but misdirected or otherwise late reaching the examiner will be considered as in the case of regular domestic applications and may require a supplemental written opinion and/or international preliminary examination report.

Clearly, these guidelines offer the examiner flexibility. The examiner should be guided by the overriding principle that the international preliminary examination report should be established with as few written opinions as possible and resolution of as many issues as possible consistent with the goal of a timely and quality report.

See also Administrative Instructions Section 602 regarding processing of amendments by the IPEA.

## 1872 Availability of the International Application File for International Preliminary Examination by the Examining Corps [R-08.2012]

***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.

After the PCT International Application Processing Division has finished processing the documents and fees filed with a complete demand, the international application is docketed to an examiner in the appropriate Technology Center for examination. If the USPTO was the International Searching Authority for the international application, the same file used for purposes of the international search will be used for purposes of international preliminary examination.

## 1873 [Reserved]

## 1874 Determination if International Preliminary Examination Is Required and Possible [R-07.2015]

***PCT Article 34***

***Procedure Before the International Preliminary Examining Authority***

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(4)

(a) If the International Preliminary Examining Authority considers

(i) that the international application relates to a subject matter on which the International Preliminary Examining Authority is not required, under the Regulations, to carry out an international preliminary examination, and an international preliminary examination, and in the particular case decides not to carry out such examination, or

(ii) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness), or industrial applicability, of the claimed invention, the said authority shall

not go into the questions referred to in Article 33(1) and shall inform the applicant of this opinion and the reasons therefor.

(b) If any of the situations referred to in subparagraph (a) is found to exist in, or in connection with, certain claims only, the provisions of that subparagraph shall apply only to the said claims.

There are instances where international preliminary examination is not required because of the nature of the subject matter claimed and also because the claims are so indefinite that no examination is possible. Such instances should seldom occur, especially since most problems of this nature would have already been discovered and indicated at the time of the international search.

If it is found that certain claims of an international application relate to subject matter for which no international preliminary examination is required, check the appropriate box on a Form PCT/IPEA/408 or a Form PCT/IPEA/409, as appropriate (see MPEP § 1860). It should be noted that subject matter which is normally examined under U.S. national procedure should also be examined as an International Preliminary Examining Authority.

The examiner should check the appropriate box if it is found that the description, claims or drawings are so unclear, or the claims are so inadequately supported by the description that no opinion could be formed as to the novelty, inventive step (nonobviousness) and industrial applicability of the claimed invention.

Subject matter not searched under Chapter I will not be the subject of a preliminary examination under Chapter II. This is so even if claims which were not searched under Chapter I are modified to be acceptable for examination.

## 1875 Unity of Invention Before the International Preliminary Examining Authority [R-07.2015]

***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.

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(c) If the applicant does not comply with the invitation referred to in subparagraph (a) within the prescribed time limit, the International Preliminary Examining Authority shall establish an international preliminary examination report on those parts of the international application which relate to what appears to be the main invention and shall indicate the relevant facts in the said report. The national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office.

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***37 CFR 1.488 Determination of unity of invention before the International Preliminary Examining Authority.***

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for reply, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary

Examining Authority may raise the objection of lack of unity of invention.

The examiner will usually begin the preliminary examination by checking the international application for unity of invention. The international preliminary examination will only be directed to inventions which have been searched by the International Searching Authority. All claims directed to inventions which have not been searched by the International Searching Authority will not be considered by the International Preliminary Examining Authority. If the examiner in the International Preliminary Examining Authority finds lack of unity of invention in the claims to be examined, an invitation is normally prepared and sent to the applicant requesting the payment of additional fees or the restriction of the claims on Form PCT/IPEA/405. Such an invitation will include the identification of what the examiner considers to be the "main invention" which will be examined if no additional fees are paid or restriction is made by the applicant.

The procedure before the International Preliminary Examining Authority regarding lack of unity of invention is governed by PCT Article 34(3)(a) through (c), PCT Rule 68 (see also PCT Rule 70.13), and 37 CFR 1.475 and 1.488. It should be noted that in most instances lack of unity of invention will have been noted and reported upon by the International Searching Authority which will have drawn up an international search report and a written opinion based on those parts of the international application relating to the invention, or unified linked group of inventions, first mentioned in the claims ("main invention"), unless the applicant has paid additional fees . If the applicant has paid additional search fees, additional inventions would also have been searched. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority (37 CFR 1.488(b)(2)).

If the examiner determines that unity of invention is lacking, there are two options:

(A) The examiner may conduct an international preliminary examination covering all the claimed and previously searched inventions and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees (PCT Rule 68.1), or

(B) The examiner may invite the applicant to restrict the claims, so as to comply with the requirement, or pay additional fees, pointing out the categories of invention found using Form PCT/IPEA/405 or USPTO/499 (telephone practice). See MPEP § 1875.01. The invitation to restrict or pay additional fees shall state the reasons for which the international application is considered as not complying with the requirement of unity of invention. (PCT Rule 68.2). Inventions not previously searched will not be considered or included in the invitation.

The written opinion, if any, and the international preliminary examination report must be established on all inventions for which examination fees have been paid.

If the applicant fails to reply to the invitation to restrict the claims or pay additional examination fees due to lack of unity of invention (by not paying the additional fees or by not restricting the claims either sufficiently or at all), the written opinion, if any, and international preliminary examination report must be established on the claims directed to what appears to be the main invention (PCT Article 34(3)(c)). The main invention, in case of doubt, is the first claimed invention for which an international search report has been issued by the International Searching Authority. The main invention, as viewed by the examiner, must be set forth on Form PCT/IPEA/405.

If the applicant timely complies with the invitation to pay additional fees even under protest, or to restrict the claims, the examiner carries out international preliminary examination on those claimed inventions for which additional fees have been paid or to which the claims have been restricted. It should be noted that the national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office (PCT Article 34(3)(c)). Whether or not the question of unity of invention

has been raised by the International Searching Authority, it may be considered by the examiner when serving as an authorized officer of the International Preliminary Examining Authority. In the examiner's consideration, all documents cited by the International Searching Authority should be taken into account and any additional relevant documents considered. However, there are cases of lack of unity of invention, where, compared with the procedure of inviting the applicant to restrict the international application or pay additional fees (PCT Rule 68.2), little or no additional effort is involved in establishing the written opinion , if any, and the international preliminary examination report for the entire international application. Then reasons of economy may make it advisable for the examiner to use the option referred to in PCT Rule 68.1 by choosing not to invite the applicant to restrict the claims or to pay additional fees.

Unity of invention is defined by 37 CFR 1.475 which describes the circumstances in which the requirement of unity of invention is considered fulfilled.

## 1875.01 Preparation of Invitation Concerning Unity [R-07.2015]

The "Invitation to restrict or pay additional fees," Form PCT/IPEA/405, is used to invite the applicant, at his/her option, to restrict the claims to comply with the requirements of unity of invention or to pay additional examination fees. In addition, the examiner must explain the reasons why the international application is not considered to comply with the requirement of unity of invention. The examiner must also specify, on Form PCT/IPEA/405, at least one group or groups of claims which, if elected, would comply with the requirement for unity of invention.

### I. INVITATION TO RESTRICT OR PAY ADDITIONAL FEES

In the space provided on form PCT/IPEA/405, the examiner should identify the disclosed inventions by claim numerals and indicate which disclosed inventions are so linked as to form a single general inventive concept, thereby complying with the requirement of unity of invention. For example, claims to different categories of invention such as a product, claims to a process specifically adapted for the manufacture of the product and a claim for a use of the product would be considered related inventions which comply with the unity of invention requirement, whereas a claim to an apparatus for making the product in the same application would be considered a second invention for which additional fees would be required. The reasons for holding that unity of invention is lacking must be specified. See 37 CFR 1.475 and Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**).

Also, the examiner should specify the main invention and claims directed thereto which will be examined if the applicant fails to restrict or pay additional fees. The main invention, in case of doubt, is the first claimed invention or related invention before the International Preliminary Examining Authority for which a search fee has been paid and an international search report has been prepared.

The examiner should indicate the total amount of additional fees required for examination of all claimed inventions.

In the box provided at the top of the form, the time limit of one month for response is set according to PCT Rule 68.2. Extensions of time are not permitted.

Since the space provided on Form PCT/IPEA/405 is limited, supplemental attachment sheets, supplied by the examiner, with reference back to the specific section, should be incorporated whenever necessary.

### II. AUTHORIZED OFFICER

Form PCT/IPEA/405 must be signed by an examiner with at least partial signatory authority.

### III. TELEPHONIC RESTRICTION PRACTICE

Telephone practice may be used to allow applicants to elect an invention to be examined or to pay additional fees if:

(A) Applicant or applicant's legal representative has a USPTO deposit account,

(B) Applicant or the legal representative or agent orally agrees to charge the additional fees to the account, and

(C) A complete record of the telephone conversation is included with the written opinion, if any, or the international preliminary examination report, including:

(1) Examiner's name;

(2) Authorizing attorney's name;

(3) Date of conversation;

(4) Invention elected and/or inventions for which additional fees paid; and

(5) Deposit account number and amount to be charged.

When the telephone practice is used in making lack of unity requirements, it is critical that the examiner orally inform applicant that there is no right to protest the holding of lack of unity of invention for any group of invention(s) for which no additional examination fee has been paid.

The examiner must further orally advise applicant that any protest to the holding of lack of unity or the amount of additional fee required must be filed in writing no later than one month from the mailing date of the written opinion or the international preliminary examination report if the lack of unity holding is first mailed with the IPER because there was no written opinion. The examiner should fill in the information on Form USPTO/499 "Chapter II PCT Telephone Memorandum for Lack of Unity" as a record of the telephonic holding of lack of unity.

If applicant refuses to either restrict the claims to one invention or authorize payment of additional fees, or if applicant does not have a deposit account, Form PCT/IPEA/405 should be prepared and mailed to applicant.

If a written invitation is required, the examiner should, if possible, submit that written invitation to the TC for review and mailing within 7 days from the date the international application is charged to the examiner.

See MPEP § 1850 for form paragraphs for lack of unity in international applications.

## 1875.02 Reply to Invitation Concerning Lack of Unity of Invention [R-07.2022]

***PCT Administrative Instructions Section 603***

***Transmittal of Protest Against Payment of Additional Fees and Decision Thereon Where International Application Is Considered to Lack Unity of Invention***

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

***37 CFR 1.489 Protest to lack of unity of invention before the International Preliminary Examining Authority.***

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Preliminary Examining Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both.

(b) Protest under paragraph (a) of this section will be examined by the Director or the Director's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international preliminary examination report when forwarded to the Elected Offices, may notify the International Preliminary Examining Authority to that effect any time prior to the issuance of the international preliminary examination report. Thereafter, such notification should be directed to the International Bureau.

Applicant may reply directly to the International Preliminary Examining Authority issuing the invitation 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. The IPEA/US does not charge a protest fee under PCT Rule 68.3(e).

### I. NOTIFICATION OF DECISION ON PROTEST

Form PCT/IPEA/420 is used by the Technology Center (TC) to inform the applicant of the decision regarding applicant's protest on the payment of additional fees concerning unity of invention.

### II. NOTIFICATION

The TC checks the appropriate box, i.e., 1 or 2. If box 2 is checked, a clear and concise explanation as to why the protest concerning the unity of invention was found to be unjustified must be given.

Since the space is limited, supplemental attachment sheet(s) should be incorporated whenever necessary.

### III. AUTHORIZED OFFICER

Form PCT/IPEA/420 must be signed by a TC Director. See MPEP § 1002.02(c), item (2).

## 1876 Notation of Errors and Informalities by the Examiner [R-07.2015]

***PCT Administrative Instructions Section 607***

***Rectifications of Obvious Mistakes under Rule 91***

(a) Where the International Preliminary Examining Authority authorizes a rectification of an obvious mistake under Rule 91, it shall:

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

(ii) indelibly mark, in the middle of the bottom margin of each replacement sheet, the words "RECTIFIED SHEET (RULE 91)" or their equivalent in the language of the demand as well as an indication of the International Preliminary Examining Authority as provided for in Section 107(b);

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

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

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

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

(b) Where the rectification of an obvious mistake is not taken into account by the International Preliminary Examining Authority pursuant to Rule 66.4 *bis* , and the Authority so indicates in the international preliminary examination report in accordance with Rule 70.2(e), it shall proceed as indicated under paragraph (a), provided that the words "RECTIFIED SHEET (RULE 91) – NOT CONSIDERED FOR REPORT (Rule 66.4 *bis*)" shall be used when marking in accordance with paragraph (a)(ii).

(c) Where the rectification of an obvious mistake is not taken into account by the International Preliminary Examining Authority pursuant to Rule 66.4 *bis* , and the Authority is not able to so indicate in the international preliminary examination report in accordance with the second sentence of Rule 70.2(e), it shall proceed as indicated under paragraph (a)(i) to (iv) and forward any replacement sheet and any letter containing the rectification or accompanying any replacement sheet to the International Bureau. The International Bureau will promptly notify the elected Offices accordingly.

Although the examiner is not responsible for discovering mistakes in the international application, if any mistakes come to the attention of the examiner, they may be noted and called to the applicant's attention. The examiner may invite applicant to rectify obvious mistakes using Form PCT/IPEA/411. Mistakes that are not obvious may be called to applicant's attention in Box VII of PCT/IPEA/408.

### AUTHORIZED OFFICER

Form PCT/IPEA/408 and Form PCT/IPEA/411 must be signed by an examiner having at least partial signatory authority.

## 1876.01 Request for Rectification and Notification of Action Thereon [R-07.2015]

### I. NOTIFICATION OF DECISION CONCERNING REQUEST FOR RECTIFICATION

The rectification of obvious mistakes is governed by PCT Rule 91. PCT Administrative Instructions Section 325 provides instructions for the processing of rectifications of obvious mistakes by the receiving Office; PCT Administrative Instructions Sections 413 and 413 *bis* provide instructions for the processing of rectifications of obvious mistakes by the International Bureau; PCT Administrative Instructions Section 511 provides instructions for

the processing of rectifications of obvious mistakes by the International Searching Authority; and PCT Administrative Instructions Section 607 provides instructions for the processing of rectifications of obvious mistakes by the International Preliminary Examining Authority.

**II. NOTIFICATION**

If the applicant requests rectification of any obvious mistakes in the description, claims, or drawings, or in a correction thereon, or in an amendment under Article 19 or 34, the International Preliminary Examining Authority should notify applicant whether the rectification is authorized or refused using Form PCT/IPEA/412. Any rectification offered to the international preliminary examining authority must be in the form of a replacement sheet embodying the rectification and the letter accompanying the replacement sheet must draw attention to the differences between the replaced sheet and the replacement sheet.

The International Preliminary Examining Authority, after fully considering applicant's request for rectification of an obvious mistake, 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.

## 1877 Nucleotide and/or Amino Acid Sequence Listings During the International Preliminary Examination [R-07.2022]

If the International Preliminary Examining Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences that, pursuant to the Administrative Instructions, are required to be included in a sequence listing, the International Preliminary Examining Authority may invite the applicant to furnish such a sequence listing complying with the standard provided for in the Administrative Instructions and pay a late furnishing fee. PCT Rule 13 *ter*.2.

## 1878 Preparation of the Written Opinion of the International Preliminary Examining Authority [R-07.2022]

***PCT Article 34***

***Procedure Before the International Preliminary Examining Authority***

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(2)

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(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.

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***37 CFR 1.484 Conduct of international preliminary examination.***

(a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves an inventive step (is non-obvious) and is industrially applicable.

(b) International preliminary examination will begin in accordance with PCT Rule 69.1.

(c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to reply.

(e) The written opinion established by the International Searching Authority under PCT Rule 43 *bis*.1 shall be considered to be a written opinion of the United States International Preliminary Examining Authority for the purposes of paragraph (d) of this section.

(f) The International Preliminary Examining Authority may establish further written opinions under paragraph (d) of this section.

(g) If no written opinion under paragraph (d) of this section is necessary, or if no further written opinion under paragraph (f) of this section is to be established, or after any written opinion and the reply thereto or the expiration of the time limit for reply to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the

International Bureau and one copy will be submitted to the applicant.

(h) An applicant will be permitted a personal or telephone interview with the examiner, which may be requested after the filing of a Demand, and must be conducted during the period between the establishment of the written opinion and the establishment of the international preliminary examination report. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant or, if not filed by applicant be made of record in the file by the examiner.

(i) If the application whose priority is claimed in the international application is in a language other than English, the United States International Preliminary Examining Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish an English translation of the priority document within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary report may be established as if the priority had not been claimed.

***PCT Rule 66***

***Procedure Before the International Preliminary Examining Authority***

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***66.1bis Written Opinion of the International Searching Authority***

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(a) Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43 *bis*.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

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***66.1 ter Top-up Searches***

The International Preliminary Examining Authority shall conduct a search ("top-up search") to discover documents referred to in Rule 64 which have been published or have become available to the said Authority for search subsequent to the date on which the international search report was established, unless it considers that such a search would serve no useful purpose. If the Authority finds that any of the situations referred to in Article 34(3) or (4) or Rule 66.1(e) exists, the top-up search shall cover only those parts of the international application that are the subject of international preliminary examination.

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***66.4 Additional Opportunity for Submitting Amendments or Arguments***

(a) If the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and Rules 66.2 and 66.3 shall apply.

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A written opinion must be prepared by the International Searching Authority at the same time the international search report is prepared. The United States International Preliminary Examining Authority (IPEA/US) will consider the written opinion of the International Searching Authority to be the first written opinion of the IPEA and as such in most instances no further written opinion need be issued by the U.S. examiner handling the international preliminary examination before establishment of the international preliminary examination report, even if there are objections outstanding. The examiner is to take into consideration any comments or amendments made by the applicant when he/she establishes the international preliminary examination report. However, a further written opinion must be prepared if applicant files a response which includes a persuasive argument that the written opinion issued by the International Searching Authority was improper because of a negative opinion with respect to a lack of novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2) - (4); and which results in the examiner considering any of the claims to lack novelty, inventive step (non-obviousness) or industrial applicability as described in PCT Article 33(2) - (4) based on new art not necessitated by any amendment. Such a further written opinion should be established as the Written Opinion of the International Preliminary Examining Authority (Form PCT/IPEA/408).

When preparing Form PCT/IPEA/408, the classification of the subject matter inserted by the examiner in the header on the cover sheet shall be either:

(A) that given by the International Searching Authority under PCT Rule 43.3, if the examiner agrees with such classification; or

(B) 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 CPC classification as required by the IPEA/US should be given.

Since the IPEA/US will consider the written opinion of the ISA to be the first written opinion of the IPEA, item 1 of the cover sheet is marked accordingly. Further, since the written opinion of the ISA is considered to be the first written opinion, the written opinion of the IPEA needs to be indicated as a second opinion in item 2 of the cover sheet.

A top-up search should be conducted by the IPEA to identify any additional prior art that has been published or has become available subsequent to the date of the establishment of the international search report. The purpose is to discover any intermediate prior art not available during the international search, i.e., a patent application published on or after the filing or, the valid priority date of the international application, but having an earlier filing or priority date. The top-up search should be differentiated from additional search. A top-up search is to find prior art which recently became available, which is not the same as additional search required as a result of a claim amendment to present additional features not previously claimed.

A top-up search should be performed in all Chapter II examination, except where the examiner considers performing a top-up search would serve no useful purpose. This, however, should be a rare occurrence. For example, this is the case when it is decided that the international application, in its entirety, relates to subject matter on which the International Preliminary Examining Authority is not required to carry out an international preliminary examination, or that the international application is so unclear or the claims are so inadequately supported by the description that no meaningful opinion can be formed on the novelty, inventive step, or industrial applicability, of the claimed invention. The same applies when no international search report has been established for certain claims and it is thus decided not to carry out an international preliminary examination on these claims. Note, however, that when any of the above situations applies to only part of the claimed subject matter or where there is lack of unity of invention, a top-up search should still be carried out but restricted to those parts of the international application that are the subject of international preliminary examination. Another situation is when the IPEA considers that the documents cited in the International Search Report are sufficient to show there is lack of novelty on the entire subject matter. A further example where a top-up search is considered to serve no useful purpose is when the International Search Report cited novelty defeating X references and no amendment to the claims or comments on the application of art has been filed.

If the claims in the international application lack unity, the examiner will first issue an invitation to pay further examination fees and then perform the top-up search on inventions for which examination fees have been paid. The invention paid for must not have been excluded from preliminary examination due to lack of international search in Chapter I.

In an application where an Article 34 amendment has been filed but no basis can be located, and/or there is no letter explaining the basis, the top-up search may be limited to the scope of the claims forming the basis for the report.

In cases where relevant documents have been discovered in a top-up search and the examiner intends to raise a new objection based on the documents, a second written opinion should be issued where the new objection was not necessitated by an amendment.

**I. BOX NO. I. — BASIS OF OPINION**

When completing Box No. I, item 1 of Form PCT/IPEA/408, the examiner must indicate whether or not the opinion has been established on the basis of the international application in the language in which it was filed. If a translation was furnished for the purpose of the international search, publication, or international preliminary examination, this must be indicated. The opinion 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.

For the purpose of completing Box No. I, item 2, sheets of the description and drawings filed during Chapter I proceedings and stamped “SUBSTITUTE SHEET (RULE 26)”, “RECTIFIED SHEET (RULE 91)”, and “INCORPORATED BY REFERENCE

(RULE 20.6)" are considered to be originally filed/furnished pages and should be listed as originally filed/furnished pages. Only those amendments or rectifications to the description and drawings filed on the date of demand or after the filing of a demand should be listed as pages "received by this Authority on _____." Claims filed during the Chapter I proceedings and stamped "SUBSTITUTE SHEET (RULE 26)", "RECTIFIED SHEET (RULE 91)", and "INCORPORATED BY REFERENCE (RULE 20.6)" are also considered to be originally filed/furnished and should be listed as originally filed/furnished claim numbers.

However, amended claims filed under PCT Article 19 in response to the international search report are to be indicated as claim numbers as amended (together with any statement) under PCT Article 19. The International Bureau (IB) marks, in the upper right-hand corner of each replacement sheet submitted under PCT Article 19, the international application number, the date on which that sheet was received under PCT Article 19 and, in the middle of the bottom margin, the words "AMENDED SHEET (ARTICLE 19)." See PCT Administrative Instructions Section 417. Applicant's submission of a timely amendment to the claims alleged to be under Article 19 is accepted under Article 34 (not Article 19) unless the International Bureau has indicated the amendments were accepted under Article 19. Only those claims filed on the date of demand or after the filing of a demand should be listed as claim numbers "received by this Authority on _____."

Further, if the opinion has been based on a nucleotide and/or amino acid sequence disclosed and necessary to the claimed invention, the examiner must indicate the purpose for which the sequence listing was filed (i.e., whether as part of the international application or solely for purposes of international search), the time of filing/furnishing the sequence listing (i.e., whether filed on the international filing date or subsequently), and the format of the sequence listing (i.e., whether filed on paper or in the form of an image file (PDF) and/or in electronic form (Annex C/ST.25 text file)). If more than one version or copy of the sequence listing is filed, the examiner must indicate in item 2 whether the applicant has provided the required statement indicating that the information in the subsequent or additional copies are identical to that in the application as filed or does not go beyond the application as filed, as appropriate. Item 3 is available for providing additional comments.

The examiner must also indicate, in Box No. I, item 3, if any of the amendments filed resulted in the cancellation of any pages of the description, any of the claims, any sheets and/or figures of the drawings, or any of sequence listing. If the examiner considers any of the amendments to go beyond the original disclosure, or they were not accompanied by a letter indicating the basis for the amendment in the application as filed, the examiner must point this out in Box No. I, item 4 and explain the reasons for this determination in the Supplemental Box. New matter which appears on a replacement sheet will be disregarded for the purpose of establishing the opinion. However, the remainder of the replacement sheet, including any amendments which do not constitute new matter, will be taken into consideration for the purpose of establishing the opinion. Box No. I, item 5 needs to be marked if the opinion is established taking into account the rectification of an obvious mistake under PCT Rule 91. Further, Box No. I, item 6 needs to be marked if the opinion is established taking into account the supplementary international search report(s) from the specified Supplementary International Searching Authority(ies) (SISA).

### II. BOX NO. II. — PRIORITY

Where the priority document is provided by the applicant in compliance with PCT Rule 17.1 after the preparation of the search report and the written opinion of the ISA, any written opinion of the IPEA and/or the international preliminary examination report should reconsider the validity of the priority claim. Where the priority document is a foreign document and it is not already in the file, the IPEA may request a copy of the document from the IB and, if necessary, a translation from the applicant. In the meantime, if the outcome of the examination requires the issuing of an opinion, that opinion should be issued without waiting to obtain the priority document and/or the translation. An appropriate comment should be made under the heading "Additional observations, if necessary" in Box No. II of the written opinion. If the IPEA needs

a copy of the priority document, and the priority document was not filed with the IPEA in its capacity as a national office and is not available to the IPEA from a digital library in accordance with the Administrative Instructions, then the IPEA may request the IB to furnish such copy. PCT Rule 66.7(a). If the priority document is in a foreign language, the IPEA may invite applicant to furnish a translation within two months of such invitation. PCT Rule 66.7(b). Failure to furnish the copy of the priority document or translation may result in the IPEA establishing the written opinion of the IPEA and/or the IPER as if the priority had not been claimed. This is indicated by checking the appropriate boxes in item 1 of Box No. II in the opinion or report.

### III. BOX NO. III. — NON-ESTABLISHMENT OF OPINION ON NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY

Box No. III of Form PCT/IPEA/408 is intended to cover situations where some or all claims of an application are so unclear or inadequately supported by the description that the question of novelty, inventive step (nonobviousness), and industrial applicability cannot be considered, or where the international application or claims thereof relate to subject matter which does not require international preliminary examination, or where no international search report has been established for the claims.

Box No. III of Form PCT/IPEA/408 should be filled out in accordance with the instructions for Box No. III of Form PCT/ISA/237 provided in MPEP § 1845.01.

### IV. BOX NO. IV. — LACK OF UNITY OF INVENTION

Box No. IV of Form PCT/IPEA/408 should be used by the examiner to notify applicant that lack of unity of invention has been found.

Subsection 1 of Box IV is to be completed to indicate applicant's response to an invitation to restrict or pay additional fees. Under subsection 1, check the first box if the applicant restricted the claims to a particular group. Check the second box if the applicant paid additional fees for examination of additional inventions. Check the third box if the additional fees were paid under protest. The fourth box should not be checked. Check the fifth box if the applicant neither restricted nor paid additional fees (i.e., there was no response to the invitation to restrict or pay additional fees or the response was not timely).

Subsection 2 of Box IV is to be completed if the examiner determines that unity of invention is lacking but chooses not to invite the applicant to restrict or pay additional fees.

Subsection 3 of Box IV is to be completed to indicate which claims were the subject of international preliminary examination. If all claims are to be examined, check the first box under subsection 3. If only some of the claims were the subject of international preliminary examination, check the second box under subsection 3 and identify the claim numbers.

### V. BOX NO. V. — REASONED STATEMENT WITH REGARD TO NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY OF CLAIMS

In Box No. V, the examiner must list in summary form all claims with regard to the criteria of novelty (N), inventive step (IS), and industrial applicability (IA), and should be filled out in accordance with the instructions for Box No. V of Form PCT/ISA/237 provided in MPEP § 1845.01.

In all cases, the application should be searched by the examiner at least to the point of bringing the previous search up to date. Prior art discovered in a search and applied in a reasoned statement in Box No. V must be made of record in Box No. V. Prior art already cited on the international search report need not again be cited on the written opinion or international preliminary examination report. The subsequently discovered prior art is to be cited in compliance with PCT Rule 43.5 and PCT Administrative Instructions Section 503 using the same citation format used on the international search report. One copy of each newly cited foreign patent document and non-patent literature reference will be sent to the applicant and one copy will be retained for the application file. The USPTO no longer mails paper copies of U.S. patents and U.S. patent

application publications cited during the international stage of an international application, so paper copies of these documents need not be included in the file.

### VI. BOX NO. VI. — CERTAIN DOCUMENTS CITED

Box No. VI provides a convenient manner of listing two different types of documents that were newly discovered and which were not applied in Box No. V:

(A) Published applications or patents which would constitute prior art for purposes of PCT Article 33(2) and (3) had they been published prior to the relevant date (PCT Rule 64.1) but were filed prior to, or claim the priority of an earlier application which had been filed prior to, the relevant date (PCT Rule 64.3) - by the application number or patent number as well as the publication date, filing date and priority date; and

(B) Non-written disclosure - by the kind of disclosure, date of the disclosure and the date of the written disclosure referring to the non-written disclosure.

As with the newly cited art in Box No. V, the subsequently discovered prior art is to be cited in compliance with PCT Rule 43.5 and Administrative Instructions Section 503 using the same citation format used on the international search report. Two copies of each newly cited foreign patent document and non-patent literature reference should be included in the application file when it is sent to PCT Operations for the mailing of the Form PCT/IPEA/408. One of the copies of each newly cited foreign patent document and non-patent literature reference will be sent to the applicant and one copy will be for the Chapter II file. The USPTO no longer mails paper copies of U.S. patents and U.S. patent application publications cited during the international stage of an international application, so paper copies of these documents need not be included in the file.

### VII. BOX VII. — CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION

In Box No. VII, defects in the form and content of the international application are identified. Box No. VII should be filled out in accordance with the instructions for Box No. VII of Form PCT/ISA/237 provided in MPEP § 1845.01.

### VIII. BOX NO. VIII. — CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION

In Box No. VIII, the examiner notifies the applicant of observations made as to the clarity of the claims, the description, the drawings, or on the question whether the claims are fully supported by the description. Box No. VIII should be filled out in accordance with the instructions for Box No. VIII of Form PCT/ISA/237 provided in MPEP § 1845.01.

### IX. TIME TO REPLY

An invitation by the International Preliminary Examining Authority (IPEA) to applicant to reply to the examiner's written opinion will normally set a 2-month time limit for reply.

However, PCT Rule 69.2 sets forth time limits for the IPEA to establish the international preliminary examination report (IPER). Accordingly, a 1-month time limit should be set by the examiner in situations when a 2-month time limit would risk delaying the date of establishment of the IPER beyond:

(A) 28 months from the priority date; or

(B) 6 months from the time provided under PCT Rule 69.1 for the start of international preliminary examination; or

(C) 6 months from the date of receipt by the IPEA of the translation furnished under PCT Rule 55.2.

As a general rule, a 1-month time limit for reply to the written opinion should be set by the examiner if the written opinion (Form PCT/IPEA/408) has not been completed by the examiner within 24 months following the application's "priority date" as defined in PCT Article 2.

The United States rules pertaining to international preliminary examination of international applications do not provide for any extension of time to reply to a written opinion. See 37 CFR 1.484(d) - (f) and MPEP § 1878.02.

## X. AUTHORIZED OFFICER

Every written opinion must be signed by an examiner having at least partial signatory authority.

## 1878.01 Includes Subsections Regarding Prior Art, Novelty, Inventive Step, and Industrial Applicability for Purposes of the Written Opinion and the International Preliminary Examination Report [R-07.2022]

## 1878.01(a) Prior Art for Purposes of the Written Opinion and the International Preliminary Examination Report [R-10.2019]

***PCT Article 33.***

***The International Preliminary Examination***

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(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 shall be:

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

(ii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid;

(iii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

***64.2 Non-Written Disclosures***

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

***64.3 Certain Published Documents***

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

The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43 *bis*.1(b).

The relevant date for the purpose of considering prior art is defined in PCT Rule 64.1(b) as:

(A) the international filing date (subject to (B) and (C));

(B) where the international application claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application, unless the Authority considers that the priority claim is not valid;

(C) where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

When a potentially relevant document has been published between a claimed priority date of the application and its international filing date, the examiner is required to consider whether the claimed priority date is valid for the purposes of determining the "relevant date" of the claims in the international application. For international applications filed on or after April 1, 2007, a priority date should not be considered invalid merely because the international application was not filed prior to the date of expiration of the priority period, provided that the international application is filed within the period of two months from the date of expiration of the priority period. Note that if there is time left for the applicant to perfect, correct or add a priority claim but there is insufficient time for the examiner to make a proper determination as to whether the priority claim is valid, due to the need to issue a timely written opinion by the International Searching Authority, the "relevant date" for the purposes of the written opinion will be based on the claimed priority date. See Chapter 11 of the International Search and Preliminary Examination Guidelines, which may be obtained from WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**). In cases where any application or any patent which would constitute prior art for the purpose of international preliminary examination as to novelty and inventive step (nonobviousness) was published on or after the relevant date of the international application under consideration but was filed earlier than the relevant date or claimed the priority of an earlier application which was filed prior to the relevant date, the published application or patent is not to be considered part of the prior art for the purpose of international preliminary examination as to novelty and inventive step. Nevertheless, these documents are to be listed on Form PCT/ISA/237, PCT/IPEA/408, or PCT/IPEA/409, as appropriate under the heading "CERTAIN PUBLISHED DOCUMENTS".

In determining whether there is inventive step, account should be taken of what the applicant acknowledges in his/her description as known. Such acknowledged prior art should be regarded as correct and used during preliminary examination where appropriate.

For oral or non-written disclosure, see PCT Rules 64.2 and 70.9.

## 1878.01(a)(1) Novelty for Purposes of the Written Opinion and the International Preliminary Examination Report [R-08.2012]

Novelty is defined in PCT Article 33(2).

***PCT Article 33***

***The International Preliminary Examination***

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(2) For the purposes of the international preliminary examination, a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.

*****

The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43 *bis*.1(b).

## 1878.01(a)(2) Inventive Step for Purposes of the Written Opinion and the International Preliminary Examination Report [R-08.2012]

Inventive step is defined in PCT Article 33(3).

***PCT Article 33***

***The International Preliminary Examination***

*****

(3) For purposes of the international preliminary examination, a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.

*****

***PCT Rule 65***

***Inventive Step or Non-Obviousness***

***65.1 Approach to Prior Art***

For the purposes of Article 33(3), the international preliminary examination shall take into consideration the relation of any particular claim to the prior art as a whole. It shall take into consideration the claim's relation not only to individual documents or parts thereof taken separately but also its relation to combinations of such documents or parts of documents, where such combinations are obvious to a person skilled in the art.

***65.2 Relevant Date***

For the purposes of Article 33(3), the relevant date for the consideration of inventive step (non-obviousness) is the date prescribed in Rule 64.1.

The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43 *bis*.1(b).

## 1878.01(a)(3) Industrial Applicability for Purposes of the Written Opinion and the International Preliminary Examination Report [R-08.2012]

Industrial applicability is defined in PCT Article 33(4).

***PCT Article 33.***

***The International Preliminary Examination***

*****

(4) For the purposes of the international preliminary examination, a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. "Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.

*****

The above provisions apply *mutatis mutandis* to the written opinion of the International Searching Authority. See PCT Rule 43 *bis*.1(b).

## 1878.02 Reply to the Written Opinion of the ISA or IPEA [R-07.2015]

***PCT Article 34***

***Procedure Before the International Preliminary Examining Authority***

*****

(2)

(d) The applicant may respond to the written opinion.

*****

***PCT Rule 66***

***Procedure before the International Preliminary Examining Authority***

*****

***66.3 Formal Response to the International Preliminary Examining Authority***

(a) The applicant may respond to the invitation referred to in Rule 66.2(c) of the International Preliminary Examining Authority by making amendments or - if he disagrees with the opinion of that Authority - by submitting arguments, as the case may be, or do both.

(b) Any response shall be submitted directly to the International Preliminary Examining Authority.

*****

***66.4. bis Consideration of Amendments, Arguments and Rectifications of Obvious Mistakes***

Amendments, arguments and rectifications of obvious mistakes need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received by, authorized by or notified to that Authority, as applicable, after it has begun to draw up that opinion or report.

***66.5 Amendment***

Any change, other than the rectification of an obvious mistake, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

***66.6 Informal Communications with the Applicant***

The International Preliminary Examining Authority may, at any time, communicate informally, over the telephone, in writing, or through personal interviews, with the applicant. The said Authority shall, at its discretion, decide whether it wishes to grant more than one personal interview if so requested by the applicant, or whether it wishes to reply to any informal written communication from the applicant.

*****

***66.8 Form of Amendments***

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, shall indicate the basis for the amendment in the application as filed and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, the replacement sheet referred to in paragraph (a) may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

***37 CFR 1.485 Amendments by applicant during international preliminary examination.***

The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining

Authority for reply to any notification under § 1.484(b) or to any written opinion. Any such amendments must be made in accordance with PCT Rule 66.8.

A reply to the written opinion of the ISA in the form of arguments and/or amendments will be considered by the IPEA if a demand has been filed with the IPEA. All amendments in reply to a written opinion must be received within the time limit set for reply in order to be assured of consideration in the international preliminary examination report. Amendments filed at or before expiration of the period for reply will be considered. Since the examiner will begin to draw up the international preliminary examination report rather promptly after the time period expires, amendments filed after expiration of the reply period may not be considered. However, as indicated in MPEP § 1871, there may be situations where it is advisable, to the extent possible, to take such amendments or arguments into account, for example, where the international preliminary examination report has not yet been completed and it is readily apparent to the examiner that consideration of the late-filed response would result in the issuance of a favorable report. In view of the short time period for completion of preliminary examination, applicants are strongly encouraged to file any amendments promptly. 37 CFR 1.484(d) does not allow for extensions of time to reply to a written opinion. The policy of not allowing extensions of time is to ensure that the USPTO can meet its treaty deadline for transmission of the international preliminary examination report.

Any change, other than the rectification of obvious mistakes 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 description and the drawings in reply to a written opinion must (1) be made by submitting a replacement sheet for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled and (2) include a description of how the replacement sheet differs from the replaced sheet in accordance with PCT Rule 66.8.

Any amendment to the claims in reply to a written opinion must be made by submitting a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed or previously amended under Articles 19 or 34, as the case may be in accordance with PCT Rule 66.8. The replacement sheet or sheets shall be accompanied by a letter which: (i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended; (ii) shall identify the claims originally filed which, on account of the amendments, are cancelled; (iii) shall indicate the basis for the amendments in the application as filed.

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)).

Generally, the replacement sheets should be in typed form and contain the changes in clean copy without any underlining and/or bracketing. A marked-up copy may be included as part of the remarks, along with the clean copy.

Any paper submitted by the applicant, if not in the form of a letter, must be accompanied by a letter signed by the applicant or agent (PCT Rule 92.1). The letter must draw attention to the differences between the replaced sheet and the replacement sheet.

The examiner should make sure that amendments filed in accordance with the PCT, which are necessary to correct any deficiencies notified to the applicant, do not go beyond the disclosure of the international application as filed, thus violating PCT Article 34(2)(b). In other words, no amendment should contain matter that cannot be substantiated by the application as originally filed. In a situation where new matter is introduced by amendment in reply to a written opinion, the international preliminary examination report will be established as if the amendment had not been made, and the

report should so indicate. It shall also indicate the reasons why the amendment goes beyond the disclosure (PCT Rule 70.2(c)). Although new matter which appears on a replacement sheet will be disregarded for the purpose of establishing the report, the remainder of the replacement sheet, including any amendments which do not constitute new matter, will be taken into consideration for the purpose of establishing the report.

**INTERVIEWS**

The examiner or applicant may, after the filing of a demand and during the time limit for reply to the written opinion, request a telephone or personal interview. Only one interview is a matter of right, whether by telephone or in person. Additional interviews may be authorized by the examiner in a particular international application where such additional interview may be helpful to advance the international preliminary examination procedure.

All interviews of substance must be made of record by using PCT/IPEA/428 Notice on Informal Communication with the Applicant.

When an interview is arranged, whether by telephone or in writing, and whether by the examiner or by the applicant, the matters for discussion should be stated.

The records of interviews or telephone conversations should indicate, where appropriate, whether a reply is due from the applicant or agent or whether the examiner wishes to issue an additional written opinion or establish the international preliminary examination report.

If the applicant desires to reply to the written opinion, such reply must be filed within the time limit set for reply in order to assure consideration. No extensions to the time limit will be considered or granted. If no timely reply is received from the applicant, the international preliminary examination report will be established by the examiner, treating each claim substantially as it was treated in the written opinion. Replies to the written opinion which are not filed within the time limit set but which reach the examiner before the examiner takes up the application for preparation of the final report may be considered. Thus, only timely replies can be assured of consideration.

The applicant may reply to the invitation referred to in Rule 66.2(c) by making amendments or, if the applicant disagrees with the opinion of the authority, by submitting arguments, as the case may be, or both (PCT Rule 66.3).

If applicant does not reply to the written opinion, the international preliminary examination report will be prepared in time for forwarding to the International Division in finished form by 27 months from the priority date.

## 1879 Preparation of the International Preliminary Examination Report [R-07.2022]

[Editor Note: This section discusses the July 2022 version of PCT/IPEA/409. For international applications having an international filing date before July 1, 2022, information regarding form PCT/IPEA/409 (revised January 2019) may be found in §1879 of the 10.2019 revision of the Ninth Edition of the MPEP published June 2020 at: **www.uspto.gov/web/offices/pac/mpep/old/mpep_E9R10.htm**.]

***PCT Article 35***

***The International Preliminary Examination Report***

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

(2) The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law. It shall state, subject to the provisions of paragraph (3), in relation to each claim, whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined for the purposes of the international preliminary examination in Article 33(1) to (4). The statement shall be accompanied by the citation of the documents believed to support the stated conclusion with such explanations as the circumstances of the case may require. The statement shall also be accompanied by such other observation as the Regulations provide for.

(3)

(a) If, at the time of establishing the international preliminary examination report, the International Preliminary Examining Authority considers that any of the situations referred to in Article 34(4)(a) exists, that report shall state this opinion and the reasons therefor. It shall not contain any statement as provided in paragraph (2).

(b) If a situation under Article 34(4)(b) is found to exist, the international preliminary examination report shall, in relation to the claims in question, contain the statement as provided in subparagraph (a), whereas, in relation to the other claims, it shall contain the statement as provided in paragraph (2).

***PCT Administrative Instructions Section 604***

***Guidelines for Explanations Contained in the International Preliminary Examination Report***

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

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

The international preliminary examination report (otherwise known as International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)) is established on Form PCT/IPEA/409.

The international preliminary examination report must be established within:

(A) 28 months from the priority date; or

(B) 6 months from the time provided under PCT Rule 69.1 for the start of international preliminary examination; or

(C) 6 months from the date of receipt by the IPEA of the translation furnished under PCT Rule 55.2, whichever expires last, as provided in PCT Rule 69.2.

To meet the 28-month date for establishing the report, Office practice is to complete internal processing by 27 months from the priority date in order to provide adequate time for reviewing, final processing and mailing. Thus, under normal circumstances, the applicant receives the report, at the latest, 2 months before national processing at the elected Offices may start. This ensures that he/she has time to consider whether, and in which elected Offices, he/she wants to enter the national stage and to take the necessary action.

The international preliminary examination report contains, among other things, a statement (in the form of simple “yes” or “no”), in relation to each claim which has been examined, on whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability. The statement is, where appropriate, accompanied by the citation of relevant documents together with concise explanations pointing out the criteria to which the cited documents are applicable and giving reasons for the International Preliminary Examining Authority’s conclusions. Where applicable, the report also includes remarks relating to the question of unity of invention.

The international preliminary examination report identifies the basis on which it is established, i.e., whether, and if so, which amendments have been taken into account. Replacement sheets containing amendments under PCT Article 19 and/or PCT Article 34 which have been taken into account are attached as “annexes” to the international preliminary examination report. Amendments under PCT Article 19 which have been considered as reversed by an amendment under PCT Article 34 are not annexed to the report; neither are the letters which accompany replacement sheets.

Superseded amendments are not normally included. However, if a first replacement sheet is acceptable and a second replacement sheet for the same numbered sheet contains subject matter that goes beyond the original disclosure of the application as filed, the second replacement sheet supersedes the first replacement sheet, but both the first and second replacement sheets shall be attached to the international preliminary examination report. In this case, the superseded replacement sheets are to be marked as provided in PCT Administrative Instructions Section 602.

Before the preparation of the Chapter II report, a top-up search should be conducted by the IPEA to identify any additional prior art that has been published or has become available subsequent to the date of the establishment of the international search report. The purpose is to discover any intermediate prior art not available during the international search, i.e. patent application published on or after the filing or, the valid priority date of the international application, but having an earlier filing or priority date. The top-up search should be differentiated from additional search. A top-up search is to find prior

art which recently became available, which is not the same as additional search required as a result of a claim amendment to present additional features not previously claimed.

A top-up search should be performed in all Chapter II examination, except where the examiner considers performing a top-up search would serve no useful purpose. This, however, should be a rare occurrence. For example, this is the case when it is decided that the international application, in its entirety, relates to subject matter on which the International Preliminary Examining Authority is not required to carry out an international preliminary examination, or that the international application is so unclear or the claims are so inadequately supported by the description that no meaningful opinion can be formed on the novelty, inventive step, or industrial applicability, of the claimed invention. The same applies when no international search report has been established for certain claims and it is thus decided not to carry out an international preliminary examination on these claims. Note, however, that when any of the above situations applies to only part of the claimed subject matter or where there is lack of unity of invention, a top-up search should still be carried out but restricted to those parts of the international application that are the subject of international preliminary examination. Another situation is when the IPEA considers that the documents cited in the International Search Report are sufficient to show there is lack of novelty on the entire subject matter. A further example where a top-up search is considered to serve no useful purpose is when the International Search Report cited novelty defeating X references and no amendment to the claims or comments on the application of art has been filed.

If the claims in the international application lack unity, the examiner will first issue an invitation to pay further examination fees and then perform the top-up search on inventions for which examination fees have been paid. The invention paid for must not have been excluded from preliminary examination due to lack of international search in Chapter I.

In an application where an Article 34 amendment has been filed but no basis can be located, and/or there is no letter explaining the basis, the top-up search may be limited to the scope of the claims forming the basis for the report.

In cases where relevant documents have been discovered in a top-up search and the examiner intends to raise a new objection based on the documents, a second written opinion should be issued where the new objection was not necessitated by an amendment.

The international preliminary examination report may not express a view on the patentability of the invention. PCT Article 35(2) expressly states that "the international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law."

***Form PCT/IPEA/409 Cover Sheet.*** The classification of the subject matter placed on the cover sheet of the report 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 CPC classification required by the IPEA/US should be given. The cover sheet will also include the date on which the report was completed and the name and mailing address of the International Preliminary Examining Authority. This information is generated automatically by the Official Correspondence (OC) software when preparing the report. In addition, the examiner must indicate the date on which the demand for international preliminary examination was submitted. The date of receipt of the demand is usually stamped on the first sheet of the demand (form PCT/IPEA/401).

**I. BOX NO. I. BASIS OF REPORT**

When completing Box No. I, item 1 of Form PCT/IPEA/409, the examiner must indicate whether or not the report has been established on the basis of the international application in the language in which it was filed. If a translation was furnished for the purpose of the international search, publication

or international preliminary examination, this must be indicated. The international preliminary examination report will be established on the basis of any amendments, rectifications, priority and/or unity of invention holdings and shall answer the questions concerning novelty, inventive step, and industrial applicability for each of the claims under examination.

For the purpose of completing Box No. I, item 2, sheets of the description and drawings filed during Chapter I proceedings and stamped "SUBSTITUTE SHEET (RULE 26)", "RECTIFIED SHEET (RULE 91)", and "INCORPORATED BY REFERENCE (RULE 20.6)" are considered to be originally filed/furnished pages and should be listed as originally filed/furnished pages. Only those amendments or rectifications to the description and drawings filed on the date of demand or after the filing of a demand should be listed as later filed pages "received by this Authority on _____."

Claims filed during the Chapter I proceedings and stamped "SUBSTITUTE SHEET (RULE 26)", "RECTIFIED SHEET (RULE 91)", and "INCORPORATED BY REFERENCE (RULE 20.6)" are also considered to be originally filed/furnished and should be listed as originally filed/furnished claim numbers. However, amended claims filed under Article 19 in response to the international search report are to be indicated as claim numbers as amended (together with any statement) under Article 19. The International Bureau (IB) marks, in the upper right-hand corner of each replacement sheet submitted under PCT Article 19, the international application number, the date on which that sheet was received under PCT Article 19 and, in the middle of the bottom margin, the words "AMENDED SHEET (ARTICLE 19)." See Administrative Instructions Section 417. Applicant's submission of a timely amendment to the claims alleged to be under Article 19 is accepted under Article 34 (not Article 19) unless the International Bureau has indicated the amendments were accepted under Article 19. Only those claims filed on the date of demand or after the filing of a demand should be listed as claim numbers "received by this Authority on _____."

Further, if the report has been based on a nucleotide and/or amino acid sequence disclosed and necessary to the claimed invention, the examiner must indicate the purpose for which the sequence listing was filed (i.e., whether as part of the international application or solely for purposes of international search), the time of filing/furnishing the sequence listing (i.e., whether filed on the international filing date or subsequently), and the format of the sequence listing (i.e., whether filed on paper or in the form of an image file (PDF) and/or in electronic form (Annex C/ST.25 text file)). If more than one version or copy of the sequence listing is filed, the examiner must indicate in item 2 whether the applicant has provided the required statement indicating that the information in the subsequent or additional copies are identical to that in the application as filed or does not go beyond the application as filed Item 3 is available for providing additional comments.

The examiner must also indicate, in Box No. I, item 3, if any of the amendments filed resulted in the cancellation of any pages of the description, any of the claims, any sheets and/or figures of the drawings, any of the sequence listing.

If the examiner considers any of the amendments to go beyond the original disclosure, or they were not accompanied by a letter indicating the basis for the amendment in the application as filed, the examiner must point this out in Box No. I, item 4 and explain the reasons for this determination in the Supplemental Box. New matter which appears on a replacement sheet will be disregarded for the purpose of establishing the report. However, the remainder of the replacement sheet, including any amendments which do not constitute new matter, will be taken into consideration for the purpose of establishing the report.

Box No. I, item 5 needs to be marked if the report is established taking into account the rectification of an obvious mistake under PCT Rule 91.

Box No. I, item 6 needs to be marked whether or not top-up searches have been carried out by the International Preliminary Examining Authority. If the search was carried out, the date of the top-up search and whether additional relevant document discovered need to be indicated. If any document

discovered in the top-up search is used to support any negative statement with respect to any of the claimed subject matter, it should be cited in Box No. V of the report. Documents that refer to an oral disclosure, use, exhibition or other means occurred prior to the international filing date and documents that refer to earlier patent document, but published on or after the international filing date, should be cited in Box VI of the report.

Further, Box No. I, item 7 needs to be marked if the report is established taking into account the supplementary international search report(s) from the specified Supplementary International Searching Authority(ies) (SISA).

**II. BOX NO. II. PRIORITY**

Box No. II of Form PCT/IPEA/409 is to inform applicant of the establishment of the report as if the priority claim made in the international application had not been made. This may occur where:

(A) the IPEA requested, but was not furnished, a copy of the earlier application whose priority is claimed (PCT Rule 66.7(a)), or

(B) applicant failed to timely comply with an invitation to furnish a translation of the earlier application (PCT Rule 66.7(b)), or

(C) the priority claim is found invalid or all claims are directed to inventions which were not described and enabled by the earlier application (PCT Rule 64.1), or

(D) the priority claim has been withdrawn.

**III. BOX NO. III. NON-ESTABLISHMENT OF OPINION WITH REGARD TO NOVELTY, INVENTIVE STEP OR INDUSTRIAL APPLICABILITY**

Indications that a report has not been established on the questions of novelty, inventive step or industrial applicability, either as to some claims or as to all claims, are given in Box No. III on the Report. The examiner must specify that the report has not been established because:

(A) the application relates to subject matter which does not require international preliminary examination;

(B) the description, claims or drawings are so unclear that no meaningful opinion could be formed;

(C) the claims are so inadequately supported by the description that no meaningful opinion could be formed;

(D) no international search report has been established for the claims.

Where the report has not been established in relation to certain claims only, the claims affected must be specified.

If a meaningful opinion could not be formed without the nucleotide and/or amino acid sequence listing because it does not comply with WIPO Standard ST.26 and/or the applicant did not pay the late furnishing fee, if required, the examiner must indicate the reason for non-compliance.

**IV. BOX NO. IV. LACK OF UNITY OF INVENTION**

If the applicant has paid additional fees or has restricted the claims in response to an invitation to do so or if the applicant has failed to respond to the invitation to pay additional fees or restrict the claims, the international preliminary examination report shall so indicate. The examiner should indicate whether:

(A) the claims have been restricted;

(B) additional fees have been paid without protest;

(C) additional fees have been paid by the applicant under protest;

(D) the applicant has neither restricted the claims nor paid additional fees;

(E) the examiner was of the opinion that the international application did not comply with the requirement of unity of invention but decided not to issue an invitation to restrict the claims or pay additional fees.

In addition, if the examiner is examining less than all the claims, the examiner must indicate which parts of the international application were, and which parts were not, the subject of international preliminary examination.

In the case where additional fees were paid under protest, the text of the protest, together with the decision thereon, must be annexed to the report by International Application Processing Division IPEA personnel if the applicant has so requested.

Where an indication has been given under item (E) above, the examiner must also specify the reasons for which the international application was not considered as complying with the requirement of unity of invention.

**V. BOX NO. V. REASONED STATEMENT UNDER ARTICLE 35(2) WITH REGARD TO NOVELTY, INVENTIVE STEP, AND INDUSTRIAL APPLICABILITY; AND CITATIONS AND EXPLANATIONS SUPPORTING SUCH STATEMENT**

The examiner must indicate whether each claim appears to satisfy the criteria of novelty, inventive step (nonobviousness), and industrial applicability. The determination or statement should be made on each of the three criteria taken separately. The determination as to any criteria should be negative if the criteria as to the particular claim is not satisfied. The examiner should always cite documents believed to support any negative determination as to novelty and inventive step. Any negative holding as to lack of industrial applicability must be fully explained. See the further discussion in MPEP § 1845.01 relating to Box No. V of Form PCT/ISA/237. The citation of documents should be in accordance with Administrative Instructions Sections 503 and 611. The procedure is the same as the procedure for search report citations. Explanations should clearly indicate, with reference to the cited documents, the reasons supporting the conclusions that any of the said criteria is or is not satisfied, unless the statement is positive and the reason for citing any document is easy to understand when consulting the document. If only certain passages of the cited documents are relevant, the examiner should identify them, for example, by indicating the page, column, or the lines where such passages appear. Preferably, a reasoned statement should be provided in all instances.

**VI. BOX NO. VI. CERTAIN DOCUMENTS CITED**

If the examiner has discovered, or the international search report has cited, a relevant document which refers to a non-written disclosure, and the document was only published on or after the relevant date of the international application, the examiner must indicate on the international preliminary examination report:

(A) the date on which the document was made available to the public;

(B) the date on which the non-written public disclosure occurred.

The examiner should also identify any published application or patent which would constitute prior art for purposes of PCT Article 33(2) and (3) had it been published prior to the relevant date (PCT Rule 64.1) but was filed prior to, or claims the priority of an earlier application which had been filed prior to, the relevant date (PCT Rule 64.3). For each such published application or patent the following indications should be provided:

(A) its date of publication;

(B) its filing date, and its claimed priority date (if any).

The Report may also indicate that, in the opinion of the International Preliminary Examining Authority, the priority date of the document cited has not been validly claimed ( PCT Rule 70.10).

Guidelines explaining to the examiner the manner of indicating certain special categories of documents as well as the manner of indicating the claims to which the documents cited in such report are relevant are set forth in Administrative Instructions Sections 507(c), (d), and (e) and 508.

**VII. BOX NO. VII. CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION**

If, in the opinion of the examiner, defects existing in the form or contents of the international application have not been suitably solved at the prescribed time limit for establishing the international preliminary examination report, the examiner may include this opinion in the report, and

if included, must also indicate the reasons therefor. See the further discussion in MPEP § 1845.01 relating to Box No. VII of Form PCT/ISA/237.

**VIII. BOX NO. VIII. CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION**

If, in the opinion of the examiner, the clarity of claims, the description, and the drawings, or the question as to whether the claims are fully supported by the description have not been suitably solved at the prescribed time limit for establishing the international preliminary examination report, the examiner may include this opinion in the report, and if included, must also indicate the reasons therefor. See the further discussion in MPEP § 1845.01 relating to Box No. VIII of Form PCT/ISA/237.

**IX. FINALIZATION OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

The name of the authorized officer responsible for the report must be indicated. Pursuant to Administrative Instructions Section 612, an "authorized officer" is the person who actually performed the examination work and prepared the international preliminary examination report or another person who was responsible for supervising the examination. Thus, an examiner need not have signatory authority in order to be named as an authorized officer on the examination report. However, the "file copy" of the international preliminary examination report must be signed by a primary examiner.

The total number of sheets of the international preliminary examination report, including the cover sheet, must be indicated on the cover sheet. In addition, the annexes, if any, must accompany the international preliminary examination report.

For annexes to be sent to the applicant and to the International Bureau, an indication must be made regarding the total sheets of the following: sheets of the description, claims and/or drawings which have been amended and/or sheets containing rectifications authorized by the IPEA, unless those sheets were superseded or cancelled, and any accompanying letters (see PCT Rules 46.5, 66.8, 70.16, 91.2, and PCT Administrative Instructions Section 607); sheets containing rectifications, where the decision was made by the IPEA not to take them into account because they were not authorized by or notified to the IPEA at the time when the IPEA began to draw up the report, and any accompanying letters (PCT Rules 66.4 *bis* , 70.2(e), 70.16 and 91.2); and superseded sheets and any accompanying letters, where the IPEA either considered that the superseding sheets contained an amendment that goes beyond the disclosure in the international application as filed, or the superseding sheets were not accompanied by a letter indicating the basis for the amendments in the application as filed, as indicated in item 4 of Box No. I and the Supplemental Box (see PCT Rule 70.16(b)).

For annexes to be sent to the International Bureau only, an indication must be made regarding the total of the type and number of electronic carrier(s) containing a sequence listing, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see paragraph 3 *bis* of Annex C of the PCT Administrative Instructions).

**PATENT COOPERATION TREATY**

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

JOHN J. SMITH
220 RICHMOND HIGHWAY
ARLINGTON, VA 22202

# PCT

NOTIFICATION OF TRANSMITTAL OF
INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Rule 71.1)

| | |
|---|---|
| Date of mailing *(day/month/year)* | 12 December 2022 (12.12.2022) |
| Applicant's or agent's file reference | **IMPORTANT NOTIFICATION** |
| CMC-123-PCT | |

| International application No. | International filing date *(day/month/year)* | Priority date *(day/month/year)* |
|---|---|---|
| PCT/US2022/080008 | 10 March 2022 (10.03.2022) | 10 March 2021 (10.03.2021) |

Applicant

ACME FASTENER CORPORATION

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.

2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.

3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the *PCT Applicant's Guide*.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

| | |
|---|---|
| Name and mailing address of the IPEA/US<br>Mail Stop PCT, Attn: IPEA/US<br>Commissioner for Patents<br>P.O. Box 1450 Alexandria, VA 22313-1450<br>Facsimile No. (571) 273-8300 | Authorized officer<br><br>Patent Examiner<br><br>Telephone No. (571) 272-4300 |

Form PCT/IPEA/416 (January 2004)

PATENT COOPERATION TREATY

# PCT

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

| Applicant's or agent's file reference | | FOR FURTHER ACTION |
|---|---|---|
| CMC-123-PCT | | See Form PCT/IPEA/416 |
| International application No. | International filing date *(day/month/year)* | Priority date *(day/month/year)* |
| PCT/US2022/080008 | 10 March 2022 (10.03.2022) | 10 March 2021 (10.03.2021) |

International Patent Classification (IPC) or national classification and IPC

IPC: B25C 5/06, 5/16 (2022.01)
CPC: B25C 5/06, 5/16

Applicant

ACME FASTENER CORPORATION

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 6 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
   a. ☒ a total of 5 sheets, as follows:
      ☒ sheets of the description, claims and/or drawings which have been amended and/or sheets containing rectifications authorized by this Authority, unless those sheets were superseded or cancelled, and any accompanying letters (see Rules 46.5, 66.8, 70.16, 91.2, and Section 607 of the Administrative Instructions).
      ☐ sheets containing rectifications, where the decision was made by this Authority not to take them into account because they were not authorized by or notified to this Authority at the time when this Authority began to draw up this report, and any accompanying letters (Rules 66.4*bis*, 70.2(e), 70.16 and 91.2).
      ☐ superseded sheets and any accompanying letters, where this Authority either considers that the superseding sheets contain an amendment that goes beyond the disclosure in the international application as filed, or the superseding sheets were not accompanied by a letter indicating the basis for the amendments in the application as filed, as indicated in item 4 of Box No. I and the Supplemental Box (see Rule 70.16(b)).
   b. ☐ a separate electronic file containing a sequence listing *(sent to the International Bureau only)*.
4. This report contains indications relating to the following items: _____

| | | |
|---|---|---|
| ☒ | Box No. I | Basis of the report |
| ☐ | Box No. II | Priority |
| ☐ | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| ☒ | Box No. IV | Lack of unity of invention |
| ☒ | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement |
| ☐ | Box No. VI | Certain documents cited |
| ☒ | Box No. VII | Certain defects in the international application |
| ☐ | Box No. VIII | Certain observations on the international application |

| Date of submission of the demand | Date of completion of this report |
|---|---|
| 09 September 2022 (09.09.2022) | 10 December 2022 (10.12.2022) |
| Name and mailing address of the IPEA/US<br>Mail Stop PCT, Attn: IPEA/US<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450<br>Facsimile No. (571) 273-8300 | Authorized officer<br>Patent Examiner<br>Telephone No. (571) 272-4300 |

Form PCT/IPEA/409 (cover sheet) (July 2022)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US2022/080008

**Box No. I Basis of the report**

1. With regard to the **language**, this report is based on:
   - ☒ the international application in the language in which it was filed.
   - ☐ a translation of the international application into _____ which is the language of a translation furnished for the purposes of:
     - ☐ international search (Rules 12.3(a) and 23.1(b)).
     - ☐ publication of the international application (Rule 12.4(a)).
     - ☐ international preliminary examination (Rules 55.2(a) and/or 55.3(a) and (b)).

2. With regard to the **elements** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
   - ☐ the international application as originally filed/furnished, or
   - ☒ the description: pages 1-10 as originally filed/furnished.
     pages* _____ received by this Authority on _____
     pages* _____ received by this Authority on _____
   - ☒ the claims: Nos. _____ as originally filed/furnished.
     Nos.* _____ as amended (together with any statement) under Article 19
     Nos.* 1-3 and 5-20 received by this Authority on 09 September 2022 (09.09.2022)
   - ☒ the drawings: pages 1/2 - 2/2 as originally filed/furnished.
     pages* _____ received by this Authority on _____
     pages* _____ received by this Authority on _____
   - ☐ a sequence listing - see Supplemental Box Relating to Sequence Listing.

3. ☒ The amendments have resulted in the cancellation of:
   - ☐ the description, pages _____
   - ☒ the claims, Nos. 4
   - ☐ the drawings, sheets/figs _____
   - ☐ the sequence listing *(specify)*: _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since either they are considered to go beyond the disclosure as filed, or they were not accompanied by a letter indicating the basis for the amendments in the application as filed, as indicated in the Supplemental Box (Rules 70.2(c) and (c-*bis*)):
   - ☐ the description, pages _____
   - ☐ the claims, Nos. _____
   - ☐ the drawings, sheets/figs _____
   - ☐ the sequence listing *(specify)*: _____

5. ☐ This report has been established:
   - ☐ taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rules 66.1(d-*bis*) and 70.2(e)).
   - ☐ without taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91(Rules 66.4*bis* and 70.2(e)).

6. With regard to top-up searches (Rules 66.1*ter* and 70.2(f)):
   - ☒ A top-up search was carried out by this Authority on 10 December 2022 (10.12.2022)
     - ☐ Additional relevant documents have been discovered during the top-up search.
   - ☐ No top-up search was carried out by this Authority because it would serve no useful purpose.

7. ☐ Supplementary international search report(s) from Authority(ies) _____ has/have been received and taken into account in establishing this report (Rule 45*bis*.8(b) and (c)).

* *If item 4 applies, some or all of those sheets may be marked "superseded."*

Form PCT/IPEA/409 (Box No. I) (July 2022)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US2022/080008

**Box No. IV Lack of unity of invention**

1. ☒ In response to the invitation to restrict or pay additional fees the applicant has, within the applicable time limit:
   - ☐ restricted the claims.
   - ☒ paid additional fees.
   - ☐ paid additional fees under protest and, where applicable, the protest fee.
   - ☐ paid additional fees under protest but the applicable protest fee was not paid.
   - ☐ neither restricted the claims nor paid additional fees.
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is:
   - ☐ complied with.
   - ☒ not complied with for the following reasons:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In order for all inventions to be examined the appropriate additional examination fees must be paid.

Group I, claim(s) 1-3, 5 and 16-20, drawn to an electromagnetic fastener driver with means to hold the fastener magazine in a predetermined position.

Group II, claim(s) 6-10, drawn to an electromagnetic fastener driver with a control means to provide for multiple driving strokes to be delivered to a single fastener with a single actuation of the tool.

Group III, claim(s) 11 -15, drawn to an electromagnetic fastener driver with fastener anti-jam means.

The inventions listed as Groups I - III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of the Group I invention is the claimed means to hold the fastener magazine in a predetermined position. The special technical feature of the Group II invention is the control means to provide for multiple driving strokes to be delivered to the same fastener with a single actuation of the tool. The special technical feature of the Group III invention is the fastener anti-jam means. None of these special technical features are common to the other groups, nor do they correspond to a special technical feature in the other groups. Therefore, unity of invention is lacking.

4. Consequently, this report has been established in respect of the following parts of the international application:
   - ☒ all parts.
   - ☐ the parts relating to claims Nos._____

Form PCT/IPEA/409 (Box No. IV) (July 2022)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US2022/080008

**Box No. V** **Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement**

1. Statement

| | | | |
|---|---|---|---|
| Novelty (N) | Claims | 1-3 and 5-20 | YES |
| | Claims | NONE | NO |
| Inventive step (IS) | Claims | 1-3, 5 and 16-20 | YES |
| | Claims | 6-15 | NO |
| Industrial applicability (IA) | Claims | 1-3 and 5-20 | YES |
| | Claims | NONE | NO |

2. Citations and explanations (Rule 70.7)

Claims 6 - 10 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. in view of Barrett et al. Novak et al. teaches the claimed electromagnetic fastener tool 10 with a housing 12 having a fastener magazine assembly 18 mounted thereon with the magazine assembly having a fastener output channel. The magazine assembly 18 is pivoted between a first position wherein the tool can not be actuated and a second position wherein a fastener may be driven from the tool (note figure 3 and column 1, line 65 through column 2, line 5). The magazine assembly 18 is moved from the first position to the second position by placing the fastener output channel firmly against a work piece. As shown in figure 3 and described at column 4, lines 6 - 49, the magazine assembly 18 and the trigger button 24 are coupled by a safety mechanism 62. This safety mechanism has a sliding rod 64 with the lower end of the rod 64 being attached to the top of channel 48 of the magazine assembly such that rod 64 moves with the magazine assembly. When the magazine assembly 18 is placed on a work piece, it rotates into the second position and pushes rod 64 upward. The upper portion of rod 64 has a spring 74 which includes a cam surface 76, a curved surface 78 and a bottom edge 81 . Bottom edge 81 of spring 74 is normally positioned adjacent flange 86 of trigger button 24 and blocks upward movement of the trigger button. Thus, the trigger button may not be depressed (moved upwards) to actuate the tool until the bottom edge of spring 74 is moved away from flange 86. This is accomplished by the interaction of curved surface 78 of spring 74 with a corresponding curved surface 82 fixed to the housing 12. When rod 64 moves upward, spring 74 is bent away from trigger button 24 by the interaction of curved surfaces 78 and 82. Thus, placing the fastener output channel of the magazine assembly 18 against the work piece moves bottom edge 81 of spring 74 out of its blocking position adjacent flange 86 of trigger button 24 and permits the tool to be actuated. Novak et al. does not teach the claimed electronic control means to provide multiple blows from the driver to a single fastener. Barrett et al. discloses a control means which provides for multiple blows by the driver 32 on the fastener for each actuation of the trigger. Barrett et al. teaches at column 1, lines 40 - 49 that it is advantageous to operate solenoid actuated fastener drivers in this manner because such tools may require two or more blows from the driver to properly drive the fastener an adequate depth into the work piece. In view of this teaching, it would have been obvious to one of ordinary skill in this art to provide the Novak et al. tool with the claimed control means to provide a predetermined plurality of driving strokes to a single fastener.

---See Supplemental Box---

Form PCT/IPEA/409 (Box No. V) (July 2022)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US2022/080008

**Box No. VII Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof: It is noted that the word 'staples' at line 15 of page 9 is misspelled as "stpales".

Form PCT/IPEA/409 (Box No. VII) (July 2022)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US2022/080008

**Supplemental Box**

In case **the space in any of the preceding boxes is not sufficient.**
Continuation of:

Box No. V. 2. Citations and Explanations:

Claims 11-15 lack an inventive step under PCT Article 33(3) as being obvious over Novak et al. in view of D'Haem et al. Novak et al. does not teach the provision of an anti-jam means to clear jammed fasteners from the fastener output channel. The claims call for the fastener output channel to be formed with a removable cover plate to permit clearing the tool in the event of a fastener jam. D'Haem et al. teaches the use of a removable cover plate to allow clearing the tool as claimed (see column 4, line 76 - column 5, line 23). In view of this teaching, it would have been obvious to one of ordinary skill in this art to provide the claimed anti-jam feature in the Novak et al. tool.

Claims 1-3, 5 and 16-20 meet the criteria set out in PCT Article 33(2) and (3) because the prior art does not teach or fairly suggest the claimed means to hold the fastener magazine in the second position as claimed

Claims 1-3 and 5-20 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

Form PCT/IPEA/409 (Supplemental Box) (July 2022)

## 1879.01 Time Limit for Preparing Report [R-10.2019]

***PCT Rule 69***

***Start of and Time Limit for International Preliminary Examination***

***69.1 Start of International Preliminary Examination***

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:

(i) the demand;

(ii) the amount due (in full) for the handling fee and the preliminary examination fee, including where applicable, the late payment fee under Rule 58 *bis*.2; and

(iii) either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, and the written opinion established under Rule 43 *bis*.1;

unless the applicant expressly requests to postpone the start of the international preliminary examination until the expiration of the applicable time limit under Rule 54 *bis*.1(a).

(b) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes and subject to paragraphs (d) and (e), start at the same time as the international search.

(b-bis) Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization need not, in its capacity as International Searching Authority, establish a written opinion under Rule 43 *bis*.1.

(c) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account ( Rule 53.9(a)(i)), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed ( Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:

(i) it has received a copy of any amendments made under Article 19;

(ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19; or

(iii) the expiration of the applicable time limit under Rule 46.1.

(e) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand ( Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.

***69.2 Time Limit for International Preliminary Examination***

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

(i) 28 months from the priority date; or

(ii) six months from the time provided under Rule 69.1 for the start of the international preliminary examination; or

(iii) six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2.

The time limit for preparing the international preliminary examination report is 28 months from the priority date, or 6 months from the time provided under PCT Rule 69.1 for the start of the international preliminary examination, or 6 months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under PCT Rule 55.2, whichever expires first. This time limit is 27 months internally to ensure sufficient time to process, review and mail the report in sufficient time to reach the International Bureau by 28 months from the earliest priority date.

## 1879.02 Transmittal of the International Preliminary Examination Report and Related Documents [R-07.2022]

***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***

(a) 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.

(b) The International Preliminary Examining Authority shall transmit copies of other documents from the file of the international preliminary examination to the International Bureau in accordance with the Administrative Instructions.

***71.2 Copies of Cited Documents***

(a) The request under Article 36(4) may be presented any time during seven years from the international filing date of the international application to which the report relates.

(b) The International Preliminary Examining Authority may require that the party (applicant or elected Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be provided for in the agreements referred to in Article 32(2) between the International Preliminary Examining Authorities and the International Bureau.

(c) *[Deleted]*

(d) Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

The international preliminary examination report and its annexes, if any, are transmitted to the applicant and the International Bureau using a Notification of Transmittal of International Preliminary Report on Patentability (Form PCT/IPEA/416). Every effort is made to ensure that the transmittal is effected in sufficient time to reach the International Bureau before the expiration of the time limit set in PCT Rule 69.2.

**AUTHORIZED OFFICER**

The name of the authorized officer responsible for the international preliminary report must be indicated on the Form PCT/IPEA/416.

## 1879.03 Translations [R-07.2015]

***PCT Article 36***

***Transmittal, Translation, and Communication of the International Preliminary Examination Report***

*****

(2)

(a) The international preliminary examination report and its annexes shall be translated into the prescribed languages.

(b) Any translation of the said report shall be prepared by or under the responsibility of the International Bureau, whereas any translation of the said annexes shall be prepared by the applicant.

*****

***PCT Rule 70***

***International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)***

*****

***70.17 Languages of the Report and the Annexes***

The report and any annex shall be in the language in which the international application to which they relate is published, or, if the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, in the language of that translation.

***PCT Rule 72***

***Translation of the International Preliminary Examination Report and of the Written Opinion of the International Searching Authority***

***72.1 Languages***

(a) Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office, be translated into English.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

***72.2 Copy of Translation for the Applicant***

The International Bureau shall transmit a copy of the translation referred to in Rule 72.1(a) of the international preliminary examination report to the applicant at the same time as it communicates such translation to the interested elected Office or Offices.

***72.2 bis Translation of the Written Opinion of the International Searching Authority Established under Rule 43 bis.1***

In the case referred to in Rule 73.2(b)(ii), the written opinion established by the International Searching Authority under Rule 43 *bis*.1 shall, upon request of the elected Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the elected Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

***72.3 Observations on the Translation***

The applicant may make written observations as to the correctness of the translation of the international preliminary examination report or of the written opinion established by the International Searching Authority under Rule 43 *bis*.1 and shall

send a copy of the observations to each of the interested elected Offices and to the International Bureau.

The written opinion established by the International Searching Authority and the international preliminary examination report and any annexes are established in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish, if the international application was filed in one of those languages or translated into one of those languages. See PCT Rules 48.3(b), 55.2 and 70.17. Each elected State may require that the written opinion and/or the report, if it is not in (one of) the official language(s) of its national Office, be translated into English. See PCT Rule 72.1(a). In that case, the translation of the body of the written opinion and/or report is prepared by the International Bureau, which transmits copies to the applicant and to each interested elected Office. If any elected Office requires a translation of annexes to the report, the preparation and furnishing of that translation is the responsibility of the applicant. See PCT Article 36(2)(b).

The U.S. requires the final report and the annexes thereto to be in English. Translation of the annexes for national stage purposes is required pursuant to 35 U.S.C. 371(c)(5) and 37 CFR 1.495(e). Failure to timely provide such translation results in cancellation of the annexes.

## 1879.04 Confidential Nature of the Report [R-07.2015]

***PCT Article 38***

***Confidential Nature of the International Preliminary Examination***

(1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4) to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

(2) Subject to the provisions of paragraph (1) and Articles 36(1) and (3) and 37(3)(b), neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, give information on the issuance or non-issuance of an international preliminary examination report and on the withdrawal or non-withdrawal of the demand or of any election.

***37 CFR 1.11 Files open to the public.***

(a) The specification, drawings, and all papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). If an application was published in redacted form pursuant to § 1.217, the complete file wrapper and contents of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of § 1.217 have been met in the application; and the application is still pending. See § 2.27 of this title for trademark files.

*****

***37 CFR 1.14 Patent applications preserved in confidence.***

*****

(g) *International applications*.

(1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see § 1.19(b)), if:

(i) With respect to the Home Copy (the copy of the international application kept by the Office in its capacity as the Receiving Office, see PCT Article 12(1)), the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy (the copy of an international application kept by the Office in its capacity as the International Searching Authority, see PCT Article 12(1)), the U.S. acted as the International Searching Authority, except for the written opinion of the International Searching Authority which shall not be available until the expiration of thirty months from the priority date; or

(iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be permitted in accordance with PCT Articles 30 and 38 and PCT Rules 44 *ter*.1, 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (a) of this

section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (a)(1)(i) through (a)(1)(vi) and (g)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

*****

(i) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

(1) The fee set forth in § 1.17(g); and

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

For a discussion of the availability of copies of documents from international application files and/or access to international application files, see MPEP § 110.

## 1880 Withdrawal of Demand or Election [R-07.2015]

***PCT Article 37***

***Withdrawal of Demand or Election***

(1) The applicant may withdraw any or all elections.

(2) If the election of all elected States is withdrawn, the demand shall be considered withdrawn.

(3)

(a) Any withdrawal shall be notified to the International Bureau.

(b) The elected Office concerned and the International Preliminary Examining Authority concerned shall be notified accordingly by the International Bureau.

(4)

(a) Subject to the provisions of subparagraph (b), withdrawal of the demand or of the election of a Contracting State shall, unless the national law of that State provides otherwise, be considered to be withdrawal of the international application as far as that State is concerned.

(b) Withdrawal of the demand or of the election shall not be considered to be withdrawal of the international application if such withdrawal is effected prior to the expiration of the applicable time limit under Article 22; however, any Contracting State may provide in its national law that the aforesaid shall apply only if its national Office has received, within the said time limit, a copy of the international application, together with a translation (as prescribed), and the national fee.

***PCT Rule 90 bis***

***Withdrawals***

*****

***90 bis.4 Withdrawal of the Demand, or of Elections***

(a) The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.

(c) If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

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***PCT Administrative Instructions Section 606***

***Cancellation of Elections***

(a) The International Preliminary Examining Authority shall cancel *ex officio*:

(i) the election of any State which is not a designated State;

(ii) the election of any State not bound by Chapter II of the Treaty.

(b) The International Preliminary Examining Authority shall enclose that election within square brackets, shall draw a line between the square brackets while still leaving the election legible and shall enter, in the margin, the words "CANCELLED EX OFFICIO BY IPEA" or their equivalent in the language of the demand, and shall notify the applicant accordingly.

Any withdrawal of the demand or any election must be sent to the International Bureau or to the International Preliminary Examining Authority, provided that the withdrawal is signed by all applicants in accordance with PCT Rule 90 *bis*.5. Pursuant to PCT Rules 90.4(e) and 90.5(d), the requirement for a separate power of attorney or a copy of the general power of attorney shall not be waived in cases of withdrawal.

## 1881 Receipt of Notice of Election and Preliminary Examination Report by the United States Patent and Trademark Office [R-07.2015]

***PCT Rule 61***

***Notification of the Demand and Elections***

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***61.2 Notification to the Elected Offices***

(a) The notification provided for in Article 31(7) shall be effected by the International Bureau.

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed) and the date of receipt by the International Preliminary Examining Authority of the demand.

(c) The notification shall be sent to the elected Office together with the communication provided for in Article 20. Elections effected after such communication shall be notified promptly after they have been made.

(d) Where the applicant makes an express request to an elected Office under Article 40(2) prior to the international publication of the international application, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect the communication provided for in Article 20 to that Office.

***61.3 Information for the Applicant***

The International Bureau shall inform the applicant in writing of the notification referred to in Rule 61.2 and of the elected Offices notified under Article 31(7).

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All notices of election are received by the Office of PCT Operations from the International Bureau. The Office of PCT Operations prepares the appropriate records of the election when a request for national stage entry is received. The international preliminary examination report received by the USPTO will also be included in the national stage file. The international preliminary report on patentability is communicated to the elected Offices by the International Bureau.

## 1882 - 1892 [Reserved]

## 1893 National Stage (U.S. National Application Filed Under 35 U.S.C. 371) [R-07.2022]

There are four types of U.S. national applications: a national stage application under 35 U.S.C. 371, a regular domestic national application filed under 35 U.S.C. 111(a), a provisional application filed under 35 U.S.C. 111(b), and an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10. See 37 CFR 1.9.

An applicant who uses the Patent Cooperation Treaty gains the benefit of:

(A) a delay in the time when papers must be submitted to the national offices;

(B) an international search (to judge the level of the relevant prior art) and a written opinion on the question of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable before having to expend resources for filing fees, translations and other costs;

(C) a delay in the expenditure of fees;

(D) additional time for research;

(E) additional time to evaluate financial, marketing, commercial and other considerations; and

(F) the option of obtaining international preliminary examination.

The time delay is, however, the benefit most often recognized as primary. Ultimately, applicant might choose to submit the national stage application. The national stage is unique compared to a domestic national application in that:

(A) it is submitted later (i.e., normally 30 months from a claimed priority date as compared to 12 months for a domestic application claiming priority); and

(B) the status of the prior art is generally known before the national stage begins and this is not necessarily so in a domestic national application.

**IDENTIFICATION OF THE NATIONAL STAGE APPLICATION**

Once an international application entering the U.S. national phase (“national stage application”) has been accorded a U.S. application number (the two digit series code followed by a six digit serial number), that number should be used whenever papers or other communications are directed to the USPTO regarding the national stage application. See 37 CFR 1.5(a). The national stage application is tracked through the Patent Data Portal system by the eight digit U.S. application number. Therefore, processing is expedited if the U.S. application number is indicated. The international application number, international filing date, and the national stage entry date under 35 U.S.C. 371 (if such has been accorded) should also be included, as such

would also be helpful for identification purposes and can be used to cross-check a possibly erroneous U.S. application number.

## 1893.01 Commencement and Entry [R-07.2015]

**35 U.S.C. 371 National stage: Commencement.**

(a) Receipt from the International Bureau of copies of international applications with any amendments to the claims, international search reports, and international preliminary examination reports including any annexes thereto may be required in the case of international applications designating or electing the United States.

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty.

(c) The applicant shall file in the Patent and Trademark Office —

(1) the national fee provided in section 41(a);

(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) complying with the requirements of section 115 and with regulations prescribed for oaths or declarations of applicants;

(5) a translation into the English language of any annexes to the international preliminary examination report, if such annexes were made in another language.

(d) The requirement with respect to the national fee referred to in subsection (c)(1), the translation referred to in subsection (c)(2), and the oath or declaration referred to in subsection (c)(4) of this section shall be complied with by the date of the commencement of the national stage or by such later time as may be fixed by the Director. The copy of the international application referred to in subsection (c)(2) shall be submitted by the date of the commencement of the national stage. Failure to comply with these requirements shall be regarded as abandonment of the application by the parties thereof, unless it be shown to the satisfaction of the Director that such failure to comply was unavoidable. The payment of a surcharge may be required as a condition of accepting the national fee referred to in subsection (c)(1) or the oath or declaration referred to in subsection (c)(4) of this section if these requirements are not met by the date of the commencement of the national stage. The requirements of subsection (c)(3) of this section shall be complied with by the date of the commencement of the national stage, and failure to do so shall be regarded as a cancellation of the amendments to the claims in the international application made under article 19 of the treaty. The requirement of subsection (c)(5) shall be complied with at such time as may be fixed by the Director and failure to do so shall be regarded as cancellation of the amendments made under article 34(2)(b) of the treaty.

(e) After an international application has entered the national stage, no patent may be granted or refused thereon before the expiration of the applicable time limit under article 28 or article 41 of the treaty, except with the express consent of the applicant. The applicant may present amendments to the specification, claims, and drawings of the application after the national stage has commenced.

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with.

***37 CFR 1.491 National stage commencement, entry, and fulfillment.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 on or after September 16, 2012]

(a) Subject to 35 U.S.C. 371(f), the national stage shall commence with the expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a).

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c)(1) and (c)(2) within the period set in § 1.495.

(c) An international application fulfills the requirements of 35 U.S.C. 371 when the national stage has commenced under 35 U.S.C. 371(b) or (f) and all applicable requirements of 35 U.S.C. 371 have been satisfied.

***37 CFR 1.491 (pre-AIA) National stage commencement and entry.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 prior to September 16, 2012]

(a) Subject to 35 U.S.C. 371(f), the national stage shall commence with the expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a).

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c) within the period set in § 1.495.

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date.

Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c).

Entry into the national stage occurs upon completion of certain acts, as provided in 37 CFR 1.491(b). For international applications having an international filing date before September 16, 2012, the international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c) within the period set in 37 CFR 1.495. For international applications having an international filing date on or after September 16, 2012, the international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c)(1) and (2) within the period set in 37 CFR 1.495. Thus, for international applications having an international filing date on or after September 16, 2012, submission of the oath or declaration of the inventor under 35 U.S.C. 371(c)(4) is not required to enter the U.S. national phase.

## 1893.01(a) Entry via the U.S. Designated or Elected Office [R-07.2022]

***PCT Article 2***

***Definitions***

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(xiii) "designated Office" means the national Office of or acting for the State designated by the applicant under Chapter I of this Treaty;

(xiv) "elected Office" means the national Office of or acting for the State elected by the applicant under Chapter II of this Treaty;

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***37 CFR 1.414 The United States Patent and Trademark Office as a Designated Office or Elected Office.***

(a) The United States Patent and Trademark Office will act as a Designated Office or Elected Office for international applications in which the United States of America has been designated or elected as a State in which patent protection is desired.

(b) The United States Patent and Trademark Office, when acting as a Designated Office or Elected Office during international processing will be identified by the full title "United States Designated Office" or by the abbreviation "DO/US" or by the full title "United States Elected Office" or by the abbreviation "EO/US."

(c) The major functions of the United States Designated Office or Elected Office in respect to international applications in which the United States of America has been designated or elected, include:

(1) Receiving various notifications throughout the international stage and

(2) National stage processing for international applications entering the national stage under 35 U.S.C. 371.

An international application designating the U.S. will enter the national stage via the U.S. Designated Office unless a Demand electing the U.S. is filed under PCT Article 31 whereupon entry will be via the U.S. Elected Office.

When entering the U.S. national stage following either Chapter I or Chapter II, the applicant has the right to amend the application within the time limit of one month from commencement (PCT Article 28 and PCT Rule 52.1 or PCT Article 41 and PCT Rule 78.1, respectively).

## 1893.01(a)(1) Submissions Required by 30 Months from the Priority Date [R-01.2024]

***37 CFR 1.495 Entering the national stage in the United States of America.***

[Editor Note: Paragraphs (a) and (h) below are applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012]

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)).

(c)

(1) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date, the Office will notify the applicant if he or she has omitted any of:

(i) A translation of the international application, as filed, into the English language, if it was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417 ) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2));

(ii) The inventor's oath or declaration (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with §1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1;

(iii) The search fee set forth in § 1.492(b);

(iv) The examination fee set forth in § 1.492(c); and

(v) Any application size fee required by § 1.492(j);

(2) A notice under paragraph (c)(1) of this section will set a time period within which applicant must provide any omitted translation, search fee set forth in § 1.492(b), examination fee set forth in § 1.492(c), and any application size fee required by § 1.492(j) in order to avoid abandonment of the application.

(3) The inventor's oath or declaration must also be filed within the period specified in paragraph (c)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (c)(3)(i) through (c)(3)(iii) of this section.

(i) The application contains an application data sheet in accordance with § 1.76 filed prior to the expiration of the time period set in any notice under paragraph (c)(1) identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)). The Office may dispense with the notice provided for in paragraph (c)(1) of this section if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

(iii) An international application in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid and for which an application data sheet in accordance with § 1.76 has been filed may be treated as complying with 35 U.S.C. 371 for purposes of eighteen-month publication under 35 U.S.C. 122(b) and § 1.211 et seq.

(4) The payment of the processing fee set forth in § 1.492(i) is required for acceptance of an English translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in § 1.492(h) is required for acceptance of any of the search fee, the examination fee, or the inventor's oath or declaration after the date of the commencement of the national stage (§ 1.491(a)).

(5) For international applications having an international filing date before July 1, 2022, a sequence listing need not be translated if the sequence listing complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b). For international applications having an international filing date on or after July 1, 2022, for purposes of paragraph (c)(1)(i) of this section, an English translation is required for any sequence listing in XML format ("Sequence Listing XML") containing non-English language values for any language-dependent free text qualifiers in accordance with §§ 1.831 through 1.834.

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of thirty months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of thirty months from the priority date will be considered to be canceled.

(e) A translation into English of any annexes to an international preliminary examination report (if applicable), if the annexes were made in another language must be furnished not later than the expiration of thirty months from the priority date. Translations of the annexes which are not received by the expiration of thirty months from the priority date may be submitted within any period set pursuant to paragraph (c) of this section accompanied by the processing fee set forth in § 1.492(f). Annexes for which translations are not timely received will be considered canceled.

(f) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must be identified as a submission to enter the national stage under 35 U.S.C. 371. If the documents and fees contain conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371, the documents and fees will be treated as a submission to enter the national stage under 35 U.S.C. 371.

(h) An international application becomes abandoned as to the United States thirty months from the priority date if the requirements of paragraph (b) of this section have not been complied with within thirty months from the priority date.

***37 CFR 1.495 (pre-AIA) Entering the national stage in the United States of America.***

[Editor Note: Paragraphs (a) and (h) below are **not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012. See § 1.495 for more information and for the current rule, including the portions of the rule not reproduced below and applicable irrespective of application filing date and paras. (a) and (h) applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after Sept. 16, 2012]

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

* * * * *

(h) An international application becomes abandoned as to the United States thirty months from the priority date if the requirements of paragraph (b) of this section have not been complied with within thirty months from the priority date. If the requirements of paragraph (b) of this section are complied with within thirty months from the priority date but either of any required translation of the international application as filed or the oath or declaration are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

To avoid abandonment of an international application as to the United States, applicant is required to comply with 37 CFR 1.495(b) within 30 months from the priority date. Thus, applicant must pay the basic national fee not later than the expiration of 30 months from the priority date and be sure that a copy of the international application has been received by the U.S. Designated or Elected Office not later than the expiration of 30 months from the priority date.

It is preferable to file the required national stage items online using the USPTO patent electronic filing system (further information regarding the USPTO patent electronic filing system is available at **www.uspto.gov/patents-application-process/file-online**). Applicants may also file these items using the Priority Mail Express® mailing procedure set forth in 37 CFR 1.10. Facsimile transmission is not acceptable for submission of the basic national fee and/or the copy of the international application. See 37 CFR 1.6(d). Likewise, the certificate of mailing procedures of 37 CFR 1.8 do not apply to the filing of the copy of the international application and payment of the basic national fee. See 37 CFR 1.8(a)(2)(i)(F).

Applicants cannot pay the basic national fee with a surcharge after the 30 month deadline. Failure to pay the basic national fee within 30 months from the priority date will result in abandonment of the application. The time for payment of the basic national fee is not extendable.

Where the international application was filed with the United States Receiving Office as the competent receiving Office, the copy of the international application referred to in 37 CFR 1.495(b) is not required. Otherwise, the copy of the international application required under 37 CFR 1.495(b) must be provided within 30 months from the priority date to avoid abandonment. A copy of the international application is published by the International Bureau at about 18 months from the priority date, at which time the published application becomes available to the U.S. Designated or Elected Office in electronic form in a digital library from which the U.S. Designated or Elected Office is entitled to retrieve the application. Pursuant to PCT Rule 93 *bis*(b), the publication of the international application by the International Bureau (and the resulting availability of the published application in a digital library) is considered to effect the required communication of the copy of the international application to the U.S. Designated or Elected Office. Thus, publication of an international application by the International Bureau within 30 months from the priority date is considered to satisfy the requirement of 37 CFR 1.495(b).

Where the basic national fee has been paid and the copy of the international application (if required) has been received not later than the expiration of 30 months from the priority date, but applicant has omitted any required item set forth in 37 CFR 1.495(c)(1), the Office will process the national stage application in accordance with the provisions of 37 CFR 1.495 in effect for that application. As a consequence of the America Invents Act (AIA), 37 CFR 1.495 was amended to permit postponement of the submission of the inventor's oath or

declaration under certain conditions and is applicable to national stage applications having an international filing date on or after September 16, 2012. For national stage applications having an international filing date prior to September 16, 2012, the pre-AIA version of 37 CFR 1.45 remains in effect.

If the international filing date is prior to September 16, 2012, and the basic national fee has been paid and the copy of the international application (if required) has been received not later than the expiration of 30 months from the priority date, but the required oath or declaration, translation, search fee (37 CFR 1.492(b)), examination fee (37 CFR 1.492(c)), or application size fee (37 CFR 1.492(j) ) has not been filed prior to commencement of the national stage (see MPEP § 1893.01), the Office will send applicant a notice identifying any deficiency and provide a period of time to correct the deficiency as set forth in 37 CFR 1.495(c). The time period usually set is 2 months from the date of the notification by the Office or 32 months from the priority date, whichever is later. This period may be extended for up to 5 additional months pursuant to the provisions of 37 CFR 1.136(a). Failure to timely file the proper reply to the notification will result in abandonment of the national stage application. The processing fee set forth in 37 CFR 1.492(i) will be required for acceptance of an English translation of the international application later than the expiration of thirty months after the priority date, and the surcharge fee set forth in 37 CFR 1.492(h) will be required for acceptance of any of the search fee, examination fee, or oath or declaration of the inventor after the date of commencement. See pre-AIA 37 CFR 1.495(c)(3).

If the international filing date is on or after September 16, 2012, the filing of the oath or declaration may be postponed until the application is otherwise in condition for allowance if applicants submit an application data sheet in accordance with 37 CFR 1.76 identifying each inventor by the inventor's legal name, the mailing address where each inventor customarily receives mail, and the residence of each inventor, if the inventor lives at a location which is different from where the inventor customarily receives mail. 37 CFR 1.495(c)(3).

For further information regarding the oath or declaration required under 35 U.S.C. 371(c)(4) and 37 CFR 1.497, including for early entry and RCE filing, see MPEP § 1893.01(e).

For further information regarding the translation required under 35 U.S.C. 371(c)(2) and 37 CFR 1.495(c), see MPEP § 1893.01(d).

## 1893.01(a)(2) Article 19 Amendment (Filed With the International Bureau) [R-10.2019]

The claims of an international application may be amended under PCT Article 19 after issuance of the search report. The description and drawings may not be amended under PCT Article 19. The amendment is forwarded to the U.S. Designated Office by the International Bureau for inclusion in the U.S. national stage application. Article 19 amendments including a complete claim set in English will be entered by replacing the original English language claims of the international application with the amended claim set. If the Article 19 amendments were made in a language other than English, applicant must provide an English translation for the U.S. national stage application. The Article 19 amendment(s) and the English translation of the amendment(s) must be received by the Office by the date of commencement of the national stage (see MPEP § 1893.01). Otherwise, the amendment(s) will be considered to be canceled, 35 U.S.C. 371(d). If such canceled amendments are desired, they must be offered under 37 CFR 1.121 as a preliminary amendment or a responsive amendment under 37 CFR 1.111. In this regard, the "Transmittal Letter To The United States Designated/Elected Office (DO/EO/US) Concerning A Submission Under 35 U.S.C. 371" (Form PTO-1390) available at **www.uspto.gov/patent/patents-forms** includes a check box by which the applicant may expressly instruct the U.S. Designated/Elected Office not to enter the Article 19 amendment(s) in the United States national stage application.

Article 19 amendments filed before July 1, 2009 were not required to include a complete claim set and the pages of the translation would not have been entered as replacement claim sheets where entry would have resulted in an inconsistency in the flow of the claims from the bottom of one page to the top

of the following page. In such situations, applicants are encouraged to submit a preliminary amendment in accordance with 37 CFR 1.121 to obtain entry of the desired changes.

## 1893.01(a)(3) Article 34 Amendments (Filed with the International Preliminary Examining Authority) [R-07.2022]

Amendments to the international application that were properly made under PCT Article 34 during the international preliminary examination phase (i.e., Chapter II) will be annexed by the International Preliminary Examining Authority to the international preliminary examination report (IPER) and communicated to the elected Offices. See PCT Article 36, PCT Rule 70.16, and MPEP § 1893.03(e). If these annexes are in English, they will normally be entered into the U.S. national stage application by the Office absent a clear instruction by the applicant that the annexes are not to be entered. In this regard, the "Transmittal Letter To The United States Designated/Elected Office (DO/EO/US) Concerning A Submission Under 35 U.S.C. 371" (Form PTO-1390) available at **www.uspto.gov/patent/patents-forms** includes a check box by which the applicant may expressly instruct the U.S. Designated/Elected Office not to enter the Article 34 amendment(s) in the United States national stage application. However, if entry of the replacement sheets will result in an obvious inconsistency in the description, claims or drawings of the international application, then the annexes will not be entered. If the annexes are in a foreign language, a proper translation of the annexes must be furnished to the Office not later than the expiration of 30 months from the priority date, unless a period has been set pursuant to 37 CFR 1.495(c) to furnish an oath or declaration, English translation of the international application, search fee (37 CFR 1.492(b)), examination fee (37 CFR 1.492(c)), or application size fee (37 CFR 1.492(j)), in which case the translations of the annexes, accompanied by the processing fee set forth in 37 CFR 1.492(f), may be submitted within the period set pursuant to 37 CFR 1.495(c). See 37 CFR 1.495(e). Annexes for which translations are not timely received will be considered canceled. Amendments made under PCT Article 34 to the international application after commencement and entry into the U.S. national phase (see MPEP § 1893.01) will not be considered in a U.S. national stage application. However, applicants may still amend the U.S. national stage application by way of a preliminary amendment submitted in accordance with 37 CFR 1.115 and 37 CFR 1.121.

Where an English translation of the annexes is provided, the translation must be such that the translation of the originally filed application can be changed by replacing the originally filed application page(s) (of translation) with substitute page(s) of translation of the annex. Thus, applicant should check to be sure that the English translation can be entered by substituting the pages of translation for corresponding pages of the description or claims of the international application without leaving an inconsistency. If entry of the page of translation causes inconsistencies in the description or claims of the international application the translation will not be entered. Non-entry of the annexes will be indicated on the "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903). For example, if the translation of the originally filed application has a first page which ends with the first part of paragraph 0012, with the remainder of paragraph 0012 on the next page then the translation of the annex of the first page must include a substitute page or pages ending with the exact same first part of paragraph 0012. This enables the original translated first page of description to be replaced by the translation of the annex without changing the subsequent unamended page(s). Alternatively applicant may submit a preliminary amendment in accordance with 37 CFR 1.121. The fact that an amendment made to the international application during the international phase was entered in the national stage application does not necessarily mean that the amendment is proper. Specifically, amendments are not permitted to introduce "new matter" into the application. See PCT Article 34(2)(b). Where it is determined that such amendments introduce new matter into the application, then the examiner should proceed as in the case of regular U.S. national applications filed under 35 U.S.C. 111(a) by requiring removal of the new matter and making any necessary rejections to the claims. See MPEP §§ 608.04 and 2163.06.

## 1893.01(a)(4) Claim Amendment (Filed With the U.S. Designated or Elected Office) [R-10.2019]

For the manner of making amendments and the required format, see the applicable U.S. regulations, in particular 37 CFR 1.121 and 1.125. One of the requirements for effectively amending claims in a national phase application is a complete listing of all claims ever presented, including the text of all pending and withdrawn claims. The status of every claim in such listing must be indicated after its claim number by one of the following identifiers in a parenthetical expression: (Original), (Currently Amended), (Canceled), (Withdrawn), (Previously Presented), (New), and (Not Entered). However, to prevent delays in prosecution, the Office may waive certain provisions of 37 CFR 1.121 and accept alternative status identifiers not specifically set forth in 37 CFR 1.121(c). Accordingly claim listings that include alternative status identifiers as set forth in MPEP § 714, subsection II.C, item (E) will be accepted if the amendment otherwise complies with 37 CFR 1.121. See MPEP § 714, subsection II.C, item (E) and *Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c),* **1296 OG 27** (July 5, 2005).

All "currently amended" claims must include markings to indicate the changes made relative to the immediate prior version of the claims: underlining to indicate additions, strike-through or double brackets for deletions (see 37 CFR 1.121(c) for further details regarding the format of claim amendments). Applicants should note that, in an amendment to the claims filed in a national phase application, the status identifier "original" must be used for claims that had been presented on the international filing date and not modified or canceled. The status identifier "previously presented" must be used in any amendment submitted during the national phase for any claims added or modified under PCT Articles 19 or 34 in the international phase that were subsequently entered in the national phase. The status identifier "canceled" must be used in any amendment submitted during the national phase for any claims canceled under a PCT Article 19 or 34 amendment in the international phase and subsequently entered in the national phase.

Example 1: Original claims 1-10; Article 19/34 filed with claims 1-20 listed on the replacement sheet wherein claims 1-10 were unchanged and claims 11-20 were added; the status of the claims prior to any further amendment under 37 CFR 1.121 would be as follows: claims 1-10 as "original" and claims 11-20 as "previously presented."

Example 2: Original claims 1-10; Article 19/34 filed with claims 1-9 listed on the replacement sheet wherein claims 1-9 were unchanged and claim 10 was cancelled; the status of the claims prior to any further amendment under 37 CFR 1.121 would be as follows: claims 1-9 as "original" and claim 10 as "cancelled."

Example 3: Original claims 1-10; Article 19/34 filed with claims 1-9 listed on the replacement sheet wherein claim 1 was unchanged, claim 2 was cancelled and claims 3-10 were renumbered as claims 2-9; the status of the claims prior to any further amendment under 37 CFR 1.121 would be as follows: claim 1 as "original,", claims 2-9 as "previously presented" and claim 10 as "cancelled."

Example 4: Original claims 1-10; Article 19/34 filed with claims 1-10 listed on the replacement sheet wherein claims 1 and 3-10 were unchanged and claim 2 was cancelled; the status of the claims prior to any further amendment under 37 CFR 1.121 would be as follows: claims 1 and 3-10 as "original" and claim 2 as "cancelled."

Proposed amendments that are not submitted in compliance with the applicable regulations will not be entered. For example, the submission with the national phase documents of a revised set of claims, absent a preliminary amendment to the claims in compliance with 37 CFR 1.121(c), will not be effective to amend the claims of record in the application.

## 1893.01(b) Applicant for a U.S. National Stage Application [R-07.2022]

***37 CFR 1.42 Applicant for Patent***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012]

(a) The word "applicant" when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.

(b) If a person is applying for a patent as provided in § 1.46, the word "applicant" refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under § 1.46 and not the inventor.

(c) If fewer than all joint inventors are applying for a patent as provided in § 1.45, the phrase "the applicant" means the joint

inventors who are applying for the patent without the omitted inventor(s).

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***37 CFR 1.43 Application for patent by a legal representative of a deceased or legally incapacitated inventor.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012]

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor. If an inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention. See § 1.64 concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

***37 CFR 1.45 Application for patent by joint inventors.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012]

(a) Joint inventors must apply for a patent jointly, and each must make an inventor's oath or declaration as required by § 1.63, except as provided for in § 1.64. If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor. See § 1.64 concerning the execution of a substitute statement by the other joint inventor or inventors in lieu of an oath or declaration.

(b) Inventors may apply for a patent jointly even though:

(1) They did not physically work together or at the same time;

(2) Each inventor did not make the same type or amount of contribution; or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

***37 CFR 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012]

(a) A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

(b) If an application under 35 U.S.C. 111 is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under § 1.76 specifying in the applicant information section (§ 1.76(b)(7)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under 35 U.S.C. 371, or a nonprovisional international design application, is applied for by a person other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3).

(1) If the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership (e.g., assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) should be recorded as provided for in part 3 of this chapter no later than the date the issue fee is paid in the application.

(2) If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

(i) The fee set forth in § 1.17(g);

(ii) A showing that such person has sufficient proprietary interest in the matter; and

(iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

(c)(1) *Correction or update in the name of the applicant.* Any request to correct or update the name of the applicant under this section must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)) in accordance with § 1.76(c)(2). A change in the name of the applicant recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application.

(2) *Change in the applicant.* Any request to change the applicant under this section after an original applicant has been specified must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) in accordance with § 1.76(c)(2) and comply with §§ 3.71 and 3.73 of this title.

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In general, for U.S. national stage applications having an international filing date prior to September

16, 2012, the inventors are required to be the applicants. The America Invents Act (AIA) amended 35 U.S.C. 118 to expand who may be an applicant in patent applications. Consequently, for national stage applications having an international filing date on or after September 16, 2012, the applicant may be: (a) the inventor(s); (b) the legal representative of a deceased or legally incapacitated inventor; (c) the assignee; (d) the obligated assignee (i.e., a person to whom the inventor is under an obligation to assign the invention); or (e) a person who otherwise shows proprietary interest in the application. See 37 CFR 1.42, 1.43, 1.45, and 1.46.

For national stage applications having an international filing date on or after September 16, 2012, the person identified in the international stage as the applicant for the United States will normally be considered the applicant for the U.S. national stage application. See 37 CFR 1.46(b).

Where the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including: the fee set forth in 37 CFR 1.17(g), a showing that such person has sufficient proprietary interest in the matter, and a statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties. See 37 CFR 1.46(b)(2).

The name of the applicant may be corrected or updated, or the applicant may be changed, in accordance with the procedure set forth in 37 CFR 1.46(c). A request to change the applicant under 37 CFR 1.46(c)(2) must include an ADS specifying the corrected applicant and a statement under 37 CFR 3.73. The 37 CFR 3.73 statement must be furnished before or concurrently with the ADS specifying the corrected applicant.

## 1893.01(c) Fees [R-01.2024]

Because the national stage fees are subject to change, applicants and examiners should always consult the *Official Gazette* for the current fee listing.

The basic national fee must be paid prior to the expiration of 30 months from the priority date to avoid abandonment of the international application as to the United States. This time period is not extendable. 37 CFR 1.495(a) - (b). This is distinguished from U.S. national application filings under 35 U.S.C. 111(a) in which the basic filing fee due on filing may be later accepted with a surcharge. Accordingly, in situations in which a payment of fees has been made in a national stage application prior to the expiration of 30 months from the priority date, but the applicant has not specified a sufficient amount for the payment of the basic national fee, the Office will apply the payment first to the basic national fee regardless of whether the applicant specified the fees to which the payment is to be applied.

Fees under 37 CFR 1.16 relate to national applications under 35 U.S.C. 111(a), and not to international applications entering the national stage under 35 U.S.C. 371. National stage fees are specifically provided for in 37 CFR 1.492. However, an authorization to charge fees under 37 CFR 1.16 in an international application entering the national stage under 35 U.S.C. 371 will be treated as an authorization to charge fees under 37 CFR 1.492. See 37 CFR 1.25(b). Accordingly, applications will not be held abandoned if an authorization to charge fees under 37 CFR 1.16 has been provided instead of an authorization to charge fees under 37 CFR 1.492.

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that is effective to cancel claims and/or eliminate multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(d) - (e) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(f). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP §§ 607 and 608.

The application size fee for a national stage application (37 CFR 1.492(j)) is determined on the basis of the international application as published by WIPO pursuant to PCT Article 21. Specifically,

the application size fee is calculated on the basis of the number of sheets of specification (including the description, claims, abstract, and, if present, a sequence listing in portable document format (PDF)) and drawings present in the published international application. This calculation is made without regard to the language of publication. Certain other sheets typically present in the international publication are not taken into account in determining the application size fee, e.g., Article 19 amendments/statement, the international search report, and any additional bibliographic sheets (other than the cover sheet containing the abstract). Nor are Article 34 amendments or preliminary amendments taken into account in determining the application size fee.

The processing fee set forth in 37 CFR 1.492(i) will be required for acceptance of an English translation of the international application later than the expiration of thirty months after the priority date, and the surcharge fee set forth in 37 CFR 1.492(h) will be required for acceptance of any of the search fee, examination fee, or inventor's oath or declaration after the date of commencement. 37 CFR 1.495(c)(4).

## 1893.01(d) Translation [R-07.2022]

Applicants entering the national stage in the U.S. are required to file an English translation of the international application if the international application was filed in another language and was not published under PCT Article 21(2) in English. 35 U.S.C. 371(c)(2) and 37 CFR 1.495(c). For international applications having an international filing date on or after July 1, 2022, an English translation is required for any sequence listing in XML format ("Sequence Listing XML") containing non-English language values for any language-dependent free text qualifiers in accordance with 37 CFR 1.831 through 1.834. For international applications having an international filing date before July 1, 2022, a sequence listing need not be translated if the sequence listing complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b). See 37 CFR 1.495(c). The translation must be a translation of the international application as filed or with any changes which have been properly accepted under PCT Rule 26 or any rectifications which have been properly accepted under PCT Rule 91. A translation of less than all of the international application (e.g., a translation that fails to include a translation of text contained in the drawings or a translation that includes a translation of claims amended under PCT Article 19 or 34 but does not include a translation of the original claims) is unacceptable. In addition, a translation that includes modifications other than changes that have been properly accepted under PCT Rule 26 or 91 (e.g., a translation that includes headings that were not present in the international application as originally filed) is unacceptable. A translation of words contained in the drawings must be furnished either in the form of new drawings or in the form of a copy of the original drawings with the translation pasted on the original text matter. See PCT Rule 49.5(d).

Amendments, even those considered to be minor or to not include new matter, may not be incorporated into the translation. If an amendment to the international application as filed is desired for the national stage, it may be submitted in accordance with 37 CFR 1.121. An amendment filed under 37 CFR 1.121 should be submitted within 3 months from the date the national stage is entered as set forth 37 CFR 1.491. See 37 CFR 1.115(b)(3)(iii). If applicant has timely paid the basic national fee and submitted the copy of the international application but the translation is missing or is defective, a Notification of Missing Requirements (PCT/DO/EO/905) will be sent to applicant setting a period to correct any missing or defective requirements. The time period is 32 months from the priority date or 2 months from the date of the notice, whichever expires later. The time period may be extended for up to five additional months as provided in 37 CFR 1.136(a). A processing fee is required for accepting a translation after 30 months from the priority date. See 37 CFR 1.492(i).

Pursuant to PCT Rule 48.3(c), if the international application is published in a language other than English, the publication shall include an English translation of the title of the invention, the abstract, and any text matter pertaining to the figure or figures accompanying the abstract. The translations shall be prepared under the responsibility of the International Bureau.

A translation of the international application as filed and identified as provided in 37 CFR 1.417 submitted for the purpose of obtaining provisional rights pursuant to 35 U.S.C. 154(d)(4) can be relied on to fulfill the translation requirement under 35 U.S.C. 371(c)(2) in a national stage application.

## 1893.01(e) Inventor's Oath or Declaration [R-07.2022]

**35 U.S.C. 371 National stage: Commencement.**

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(c) The applicant shall file in the Patent and Trademark Office –

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(4) an oath or declaration of the inventor (or other person authorized under chapter 11) complying with the requirements of section 115 and with regulations prescribed for oaths or declarations of applicants;

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Pursuant to 35 U.S.C. 371(c)(4), the applicant for a national stage application is required to file an oath or declaration of the inventor (or other person authorized under 35 U.S.C. chapter 11) complying with the requirements of 35 U.S.C. 115 and with regulations prescribed for oaths or declarations of applicants. The America Invents Act (AIA) amended 35 U.S.C. 115 with effect for applications filed on or after September 16, 2012. As a consequence of this change, the oath or declaration requirements for a national stage application differ depending on the international filing date of the national stage application, as set forth below.

### I. NATIONAL STAGE APPLICATIONS HAVING AN INTERNATIONAL FILING DATE ON OR AFTER SEPTEMBER 16, 2012

***37 CFR 1.41 Inventorship***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012]

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(e) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is the inventor or joint inventors set forth in the application data sheet in accordance with § 1.76 filed with the initial submission under 35 U.S.C. 371. Unless the initial submission under 35 U.S.C. 371 is accompanied by an application data sheet in accordance with § 1.76 setting forth the inventor or joint inventors, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under PCT Rule 92 *bis*.

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***37 CFR 1.497 Inventor's oath or declaration under 35 U.S.C. 371(c)(4).***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 on or after September 16, 2012]

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with § 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1, the applicant must file the inventor's oath or declaration. The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration in accordance with the conditions and requirements of § 1.63, except as provided for in § 1.64.

(b) An oath or declaration under § 1.63 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§ 1.63(a), (c) and (g). A substitute statement under § 1.64 will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the requirements of §§ 1.64(b)(1), (c) and (e) and identifies the person executing the substitute statement. If a newly executed inventor's oath or declaration under § 1.63 or substitute statement under § 1.64 is not required pursuant to § 1.63(d), submission of the copy of the previously executed oath, declaration, or substitute statement under § 1.63(d)(1) is required to comply with 35 U.S.C. 371(c)(4).

(c) If an oath or declaration under § 1.63, or substitute statement under § 1.64, meeting the requirements of § 1.497(b) does not also meet the requirements of § 1.63 or § 1.64, an oath, declaration, substitute statement, or application data sheet in accordance with § 1.76 to comply with § 1.63 or § 1.64 will be required.

Applicants entering the national stage under 35 U.S.C. 371 for an international application having an international filing date on or after September 16, 2012 are required to file an inventor's oath or declaration in accordance with 37 CFR 1.497 unless a declaration in compliance with 37 CFR 1.63 was previously submitted in the international phase under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1.

The inventor's oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) if it complies with the minimum requirements set forth in 37 CFR 1.497(b). However, if the inventor's oath or declaration does not satisfy all the requirements of 37 CFR 1.63 or 1.64, the applicant will be required to comply with the outstanding requirements. See 37 CFR 1.497(c).

The filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance if applicant submits an application data sheet in accordance with 37 CFR 1.76 identifying each inventor by his or her legal name, the mailing address where each inventor customarily receives mail, and the residence of each inventor, if the inventor lives at a location which is different from where the inventor customarily receives mail. See 37 CFR 1.495(c)(3). Postponement of the filing of the inventor's oath or declaration pursuant to 37 CFR 1.495(c) will not postpone the requirement to pay the surcharge fee under 37 CFR 1.492(h) for filing the inventor's oath or declaration after the date of commencement. As discussed in MPEP § 706.07(h), subsection I, notwithstanding 37 CFR 1.495(c)(3) permitting postponement, all required inventor's oaths or declarations (or substitute statements) must be filed prior to or with a request for continued examination (RCE) under 37 CFR 1.114. Early national stage entry under 35 U.S.C. 371(f) also requires the submission of the oath or declaration required by 35 U.S.C. 371(c)(4) and submission also may not be postponed in this situation.

If the basic national fee and copy of the international application have been received by the expiration of 30 months from the priority date, but applicant has not submitted 1) the required inventor's oath or declaration, or 2) an application data sheet in compliance with 37 CFR 1.495(c)(3), the Office will send applicant a Notification of Missing Requirements (Form PCT/DO/EO/905) setting a time period to submit the required inventor's oath or declaration or application data sheet and surcharge fee under 37 CFR 1.492(h) unless previously paid. Failure to timely file the required reply will result in abandonment of the application.

The inventor's oath or declaration must be executed by each inventor, except as provided under 37 CFR 1.64. The inventorship of an international application entering the national stage under 35 U.S.C. 371 having an international filing date on or after September 16, 2012, is the inventor or joint inventors set forth in an application data sheet in accordance with 37 CFR 1.76 accompanying the initial submission under 35 U.S.C. 371. If the initial submission under 35 U.S.C. 371 is not accompanied by an application data sheet in accordance with 37 CFR 1.76, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under PCT Rule 92 *bis* . See 37 CFR 1.41(e). Inventorship may be corrected under the procedure set forth in 37 CFR 1.48(a). The name of an inventor may be corrected or updated under the procedure set forth in 37 CFR 1.48(f).

If the inventor is deceased, is under legal incapacity, has refused to execute the oath or declaration under 37 CFR 1.63, or cannot be found or reached after diligent effort, the applicant under 37 CFR 1.43, 1.45 or 1.46 may execute a substitute statement under 1.64 in lieu of an oath or declaration under 37 CFR 1.63.

## II. NATIONAL STAGE APPLICATIONS HAVING AN INTERNATIONAL FILING DATE BEFORE SEPTEMBER 16, 2012

***37 CFR 1.41 (pre-AIA) Applicant for Patent***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111(a) or 363 prior to September 16, 2012]

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(4) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92 *bis* . See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92 *bis* subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

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***37 CFR 1.497 (pre-AIA) Oath or declaration under 35 U.S.C. 371(c)(4).***

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 363 prior to September 16, 2012]

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495 , and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26 *ter*.1, he or she must file an oath or declaration that:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the specification to which it is directed;

(3) Identifies each inventor and the country of citizenship of each inventor; and

(4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b)

(1) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

(c) Subject to paragraph (f) of this section, if the oath or declaration meets the requirements of paragraphs (a) and (b) of this section, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and § 1.495(c). However, if the oath or declaration does not also meet the requirements of § 1.63, a supplemental oath or declaration in compliance with § 1.63 or an application data sheet will be required in accordance with § 1.67.

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92 *bis* subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and

(4) Any new oath or declaration required by paragraph (f) of this section.

(e) The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(f) A new oath or declaration in accordance with this section must be filed to satisfy 35 U.S.C. 371(c)(4) if the declaration was filed under PCT Rule 4.17(iv), and:

(1) There was a change in the international filing date pursuant to PCT Rule 20.5(c) after the declaration was executed; or

(2) A change in the inventive entity was effected under PCT Rule 92 *bis* after the declaration was executed and no declaration which sets forth and is executed by the inventive entity as so changed has been filed in the application.

(g) If a priority claim has been corrected or added pursuant to PCT Rule 26 *bis* during the international stage after the declaration of inventorship was executed in the international application under PCT Rule 4.17(iv), applicant will be required to submit either a new oath or declaration or an application data sheet as set forth in § 1.76 correctly identifying the application upon which priority is claimed.

Applicants entering the national stage under 35 U.S.C. 371 for an international application having an international filing date prior to September 16, 2012 are required to file an oath or declaration of the inventor in accordance with pre-AIA 37 CFR 1.497(a) and (b). If the basic national fee and copy of the international application have been received by the expiration of 30 months from the priority date, but the required oath or declaration has not been filed, the Office will send applicant a Notification of Missing Requirements (Form PCT/DO/EO/905) setting a time period to correct any missing or defective requirements and to submit the surcharge fee required under 37 CFR 1.492(h) unless previously paid. Failure to timely file the required oath or declaration will result in abandonment of the application.

An oath or declaration satisfying the requirements of pre-AIA 37 CFR 1.497(a) - (b) will be sufficient for the purposes of entering the U.S. national phase. However, if the oath or declaration fails to also comply with the additional requirements for oaths and declarations set forth in 37 CFR 1.63, applicants will need to submit a supplemental oath or declaration, or an application data sheet where permitted under 37 CFR 1.63(c), to correct the deficiency. See 37 CFR 1.497(c).

In general, the requirement for an oath or declaration in compliance with 37 CFR 1.497(a) - (b) will have been previously satisfied if a declaration in compliance with PCT Rule 4.17(iv) executed by all the inventors was submitted within the time limits provided in PCT Rule 26 *ter*.1 in the international phase. However, if the inventorship was changed in the international application under PCT Rule 92 *bis*

such that the inventorship identified in the PCT Rule 4.17(iv) declaration no longer corresponds to that of the international application (see pre-AIA 37 CFR 1.41(a)(4)), then a new oath or declaration in accordance with 37 CFR 1.497(a) - (b) may be required to enter the national stage. See pre-AIA 37 CFR 1.497(f)(2). Similarly, a new oath or declaration in compliance with 37 CFR 1.497(a) - (b) is required where the PCT Rule 4.17(iv) declaration was executed prior to a change in the international filing date pursuant to PCT Rule 20.5(c). See pre-AIA 37 CFR 1.497(f)(1). In addition, where a priority claim has been corrected or added pursuant to PCT Rule 26.2 *bis* after execution of the PCT Rule 4.17(iv) declaration, then a supplemental oath or declaration, or an application data sheet, identifying the correct priority claim will be required. See pre-AIA 37 CFR 1.497(g).

The inventorship of an international application entering the national stage under 35 U.S.C. 371 having an international filing date before September 16, 2012 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92 *bis* . See pre-AIA 37 CFR 1.41(a)(4). Accordingly, an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the inventorship is corrected. See the procedures set forth in pre-AIA 37 CFR 1.497(d) and 37 CFR 1.48(a) for correcting inventorship. If an inventor refuses to execute the oath or declaration or cannot be found or reached after diligent effort, applicant may file an oath or declaration and a petition in accordance with pre-AIA 37 CFR 1.47. Similarly, where an inventor is deceased or legally incapacitated, an oath or declaration may be made in accordance with the provisions of pre-AIA 37 CFR 1.42 or 1.43. See pre-AIA 37 CFR 1.497(b).

Where there has been no change of inventorship but there is a discrepancy between the name of an inventor as indicated in the international application during the international phase and the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, correction will be required to accept the oath or declaration with the different name. Effective September 16, 2012, the procedure set forth in 37 CFR 1.48(f) may be used to correct or update the name of an inventor in a nonprovisional application. In applications where the procedure under 37 CFR 1.48(f) is not available, correction may be made by way of petition under 37 CFR 1.182 to accept the oath or declaration with the different name.

## 1893.02 Abandonment [R-07.2022]

If the requirements for the submission of the basic national fee and a copy of the international application (if necessary) prior to the expiration of 30 months from the priority date are not satisfied, then the international application becomes abandoned as to the United States. 37 CFR 1.495(h). Should online filing and/or fee payment via the USPTO patent electronic filing system become unavailable due to a system outage, applicant may need to use an alternative filing method such as hand-delivery to the USPTO or the Priority Mail Express® service of the United States Postal Service (USPS) in accordance with 37 CFR 1.10 to meet the requirements of 37 CFR 1.495(b). For more information about filing via the USPTO patent electronic filing system, see the Legal Framework for Patent Electronic System available from **www.uspto.gov/patents/apply/filing-online/legal-framework-efs-web**.

If the requirements under 37 CFR 1.495(b) are timely met, but the requirements under 37 CFR 1.495(c) for an English translation of the international application, oath/declaration, search fee, examination fee and application size fee are not met within a time period set in a notice provided by the Office, then the application will become abandoned upon expiration of the time period set in the notice. See 37 CFR 1.495(c)(2).

Examiners and applicants should be aware that sometimes papers filed for the national stage are deficient and abandonment results. For example, if the fee submitted does not include at least the amount of the basic national fee that is due, the application becomes abandoned.

Applicant may file a petition to revive an abandoned application in accordance with the provisions of 37 CFR 1.137. See MPEP § 711.03(c). For applicant's convenience, applicant may use Form

PTO/SB/64PCT for this purpose. This form is available online at **www.uspto.gov/patent/patents-forms**.

## 1893.03 Prosecution of U.S. National Stage Applications Before the Examiner [R-07.2015]

***37 CFR 1.496 Examination of international applications in the national stage.***

National stage applications having paid therein the search fee as set forth in § 1.492(b)(1) and examination fee as set forth in § 1.492(c)(1) may be amended subsequent to the date of commencement of national stage processing only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications will be advanced out of turn for examination.

An international application which enters the national stage will be forwarded to the appropriate Technology Center (TC) for examination in turn based on the date of entry into the national stage. See MPEP § 1893.01(a). This is commonly referred to as the "35 U.S.C. 371(c)" date of the application.

If an international preliminary examination report (IPER) prepared by the United States International Preliminary Examining Authority or a written opinion on the international application prepared by the United States International Searching Authority states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) - (4) have been satisfied for all of the claims presented in the application entering the national stage, the national stage search fee is reduced and the national stage examination fee is reduced. See 37 CFR 1.492(b)(1) and 37 CFR 1.492(c)(1). Such applications may be amended only to the extent necessary to eliminate objections as to form or cancel rejected claims, and they will be advanced out of turn for examination. See MPEP § 708 for a discussion of the order of examination of applications by examiners.

Once the national stage application has been taken up by the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that:

(A) the international filing date (or, if appropriate, the priority date) is the date to keep in mind when searching the prior art; and

(B) unity of invention proceeds as under 37 CFR 1.475.

## 1893.03(a) How To Identify That an Application Is a U.S. National Stage Application [R-01.2024]

Applicant's initial submission under 35 U.S.C. 371 must be identified as a submission to enter the national stage under 35 U.S.C. 371. See 37 CFR 1.495(g). If the initial submission does not include any indication that the submission is made under 35 U.S.C. 371, the application will be treated as an application filed under 35 U.S.C. 111(a) (unless the submission is clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4) for the purpose of obtaining provisional rights). See 37 CFR 1.417. Thus, if applicant wishes the application to be treated as a filing under 35 U.S.C. 111(a), the originally filed application papers need indicate simply that the papers are for a new U.S. patent application. If, however, applicant is submitting papers for entry into the national stage of a PCT application, or to establish an effective date for provisional rights resulting from the filing of a PCT application under 35 U.S.C. 154(d), applicant must so state.

When filing an application via the USPTO patent electronic filing system, the "File new submission" screen allows the user to select the type of filing being made, e.g., "Utility Nonprovisional" or "371 National Stage." Selecting "371 National Stage" as the type of filing on this screen will serve to identify the submission as a national stage submission under 35 U.S.C. 371. Applicants seeking to enter the national stage are also advised to use transmittal Form PTO-1390, as this form clearly indicates that the submission is under 35 U.S.C. 371. The inclusion with the initial application submission of an inventor's oath or declaration identifying the international application by international application number as the application to which the oath or declaration is directed is considered an indication that the application was submitted under 35 U.S.C. 371. However, claiming priority of an international application in an oath or declaration will not serve to indicate a submission under 35 U.S.C. 371.

Examination of the original application papers occurs in the Office of Patent Application Processing

(OPAP) where it is determined whether applicant has asked that the papers be treated as a submission to enter the national stage under 35 U.S.C. 371. If the application is accepted for entry into the national stage, the file wrapper will contain a "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903) indicating acceptance of the application as a national stage submission under 35 U.S.C. 371. Patent Data Portal records will indicate that the application is a national stage entry of the PCT application (e.g., under "Continuity & foreign data"). Initially, the examiner should check the application file for the presence of Form PCT/DO/EO/903 and review the bib-data sheet for an indication that the application is a national stage entry (371) of the PCT application. If neither of these indications are present, in the absence of evidence to the contrary (i.e., an indication in the originally filed application papers that processing as a national stage is desired), the application may be treated as a filing under 35 U.S.C. 111(a). If both indications are present, the application should be treated as a submission under 35 U.S.C. 371.

The examiner is advised to consult the International Patent Legal Administration if there is any question as to whether the application should be treated under 35 U.S.C. 111(a) or 371.

**CONFLICTING INSTRUCTIONS**

Where applicant's initial submission under 35 U.S.C. 371 contains conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be treated in accordance with 37 CFR 1.495(g). Note that 37 CFR 1.495(g) in effect prior to September 16, 2012, provided that an application submission containing conflicting instructions as to treatment under 35 U.S.C. 371 or 111(a) was to be treated under 35 U.S.C. 111(a). However, 37 CFR 1.495(g) was amended with effect on September 16, 2012 to provide that conflicting indications will result in the application being treated as a national stage submission under 35 U.S.C. 371.

A conflicting instruction will be present, for example, where applicant, in the initial submission under 35 U.S.C. 371, selects "Utility Nonprovisional" as the new submission type when submitting the application in the USPTO patent electronic filing system, includes a "Utility Patent Application Transmittal" (Form PTO/AIA/15 or PTO/SB/05), or includes a benefit claim under 35 U.S.C. 120 to the international application. As additional examples, a conflicting instruction will be present where applicant includes in an initial filing under 35 U.S.C. 111(a) a "Transmittal Letter To The United States Designated/Elected Office (DO/EO/US) Concerning A Submission Under 35 U.S.C. 371" (Form PTO-1390) or an indication (for example, on the application data sheet) that the application is the national stage (or 371) of an international application.

The examiner is advised to contact the International Patent Legal Administration if there is any question as to whether an application has been properly treated, or should have been treated, as a national stage application under 35 U.S.C. 371.

## 1893.03(b) The Filing Date of a U.S. National Stage Application [R-01.2024]

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application. Specifically, 35 U.S.C. 363 provides that

> An international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office.

Similarly, PCT Article 11(3) provides that

> ...an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

National stage applications are ordinarily taken up for action based on the date of entry into the national phase. See MPEP § 1893.01 regarding entry into the national stage. Because the date of entry is dependent upon receipt of certain items required under 35 U.S.C. 371(c), this date is also referred to as the "371(c) date." The 371(c) date, not the international filing date, is the date that appears in the "Filing or 371(c) Date" box on the filing receipt and the application data sections of the Patent Data Portal and the USPTO patent electronic filing system.

The NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) indicates the 371(c) date of the national stage application. Because of changes implemented pursuant to the America Invents Act (AIA), and in particular, the ability to postpone the submission of the oath or declaration required under 35 U.S.C. 371(c)(4) under certain conditions, the requirements for entry into the national stage, and thus the determination of the 371(c) date, are different based on the international filing date of the national stage application. See MPEP § 1893.03. Form PTO/DO/EO/903 in a national stage application having an international filing date prior to September 16, 2012 identifies the 371(c) date as the date of receipt of the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements, while Form PTO/DO/EO/903 in a national stage application having an international filing date on or after September 16, 2012 identifies the 371(c) date as the date of receipt of the 371(c)(1) and (c)(2) requirements. Filing receipts are mailed concurrently with the mailing of the Form PCT/DO/EO/903.

The "Date of Completion of all 35 U.S.C. 371 Requirements" included on the NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) in pre-AIA national stage applications is relevant for purposes of patent term adjustment under former 35 U.S.C. 154(b)(1)(A)(i)(II) when the Office has failed to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the requirements under 35 U.S.C. 371 were fulfilled. This date is the latest of:

(A) the date of submission of the basic national fee;

(B) the date of submission or communication of the copy of the international application;

(C) the date of submission of the translation of the international application if the international application is not in the English language;

(D) the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371(c)(4);

(E) the earlier of 30 months from the priority date or the date of request for early processing under 35 U.S.C. 371(f) if requested prior to 30 months from the priority date (Form PCT/DO/EO/903 will indicate the date early processing was requested);

(F) if a request for early processing has not been requested prior to 30 months from the priority date, the date of submission of any translation of the annexes to the international preliminary examination report if the translation of the annexes are filed within the time period set in a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring either an English translation of the international application or an oath or declaration; and

(G) the date of submission of any surcharge for submitting the oath or declaration later than 30 months from the priority date.

The AIA Technical Corrections Act, enacted on January 14, 2013, amended 35 U.S.C. 154(b)(1)(A)(i)(II) to change "the date on which an international application fulfilled the requirements of section 371" to "the date of commencement of the national stage under section 371 in an international application." See Public Law 112-274, 126 Stat. 2456 (2013). Thus, under the AIA Technical Corrections Act, the fourteen-month period in 35 U.S.C. 154(b)(1)(A)(i) for a national stage application is measured from the date of commencement of the national stage under 35 U.S.C. 371 in an international application.

## 1893.03(c) The Priority Date, Priority Claim, and Priority Papers for a U.S. National Stage Application [R-10.2019]

A U.S. national stage application may be entitled to: (A) a right of priority under 35 U.S.C. 119(a) and 365(b) based on a prior foreign application or international application designating at least one country other than the United States; and (B) the benefit of an earlier filed U.S. national application or international application designating the United States pursuant to 35 U.S.C. 119(e) or 35 U.S.C. 120 and 365(c).

### I. RIGHT OF PRIORITY UNDER 35 U.S.C. 119(a) and 365(b)

Pursuant to 35 U.S.C. 365(b) a U.S. national stage application shall be entitled to a right of priority based on a prior foreign application or international application designating at least one country other than the United States in accordance with the conditions and requirements of 35 U.S.C. 119(a) and the treaty and the PCT regulations. See in particular PCT Article 8 and PCT Rules 4.10 and 26 *bis* . To obtain priority in the U.S. national stage application to such applications, the priority must have been timely claimed in the international stage of the international application. See 37 CFR 1.55(d)(2). In the event that a claim of foreign priority is not timely made in the international stage, the priority claim may be made in the U.S. national stage application upon petition under 37 CFR 1.55(e), if the entire delay between the date the priority claim was due under PCT Rule 26 *bis* and the date the claim is filed is unintentional.

Note that in U.S. national stage applications it is permissible, but not required, to present the claim for priority in an application data sheet. A proper claim for priority will be acknowledged (subject to the paragraph below) and the national stage application file will then be checked to see if the file contains a copy of the certified copy of the priority document submitted to the International Bureau. See subsection II below for further information concerning the certified copy of the priority document.

International applications filed on or after April 1, 2007 are subject to amended PCT Rules permitting restoration of a right of priority. See MPEP § 1828.01. Consequently, international applications filed on or after April 1, 2007 may claim priority to a foreign application filed more than 12 months before the filing date of the international application. Such a priority claim will be effective in the U.S. national stage if the right of priority has been restored under PCT Rule 26 *bis*.3 during the international stage. See 37 CFR 1.55(c).

Furthermore, the right of priority may be restored in a U.S. national stage application upon petition under 37 CFR 1.55(c). Restoration of the right of priority upon petition under 37 CFR 1.55(c) is not limited to applications having an international filing date of April 1, 2007 or later. It should be noted that where a petition under 37 CFR 1.55(c) is necessary to restore the right of priority in a U.S. national stage application, a petition under 37 CFR 1.55(e) to add a delayed priority claim will also be required where the priority claim was not properly made within the time limit set forth in the PCT and the Regulations under the PCT. 37 CFR 1.55(d)(2).

For a comparison with 35 U.S.C. 119(a) - (d) priority claims in a national application filed under 35 U.S.C. 111(a), see MPEP § 1895.01.

### II. THE CERTIFIED COPY

The requirement in PCT Rule 17 for a certified copy of the foreign priority application is normally fulfilled by applicant providing a certified copy to the receiving Office or to the International Bureau, or by applicant requesting the receiving Office to prepare and transmit the priority document to the International Bureau if the receiving Office issued the priority document, or by applicant requesting the International Bureau to obtain the priority document from a digital library. Pursuant to PCT Rule 17.1(a), (b) or (b- *bis*), applicant must submit the certified copy, request the receiving Office to prepare and transmit the certified copy or request the International Bureau to obtain the priority document from a digital library, within 16 months from the priority date. Where applicant has complied with PCT Rule 17, the International Bureau will forward a copy of the certified priority document to each

Designated Office that has requested such document with an indication that the priority document was submitted in compliance with the rule and the date the document was received by the International Bureau. This indication may be in the form of either a cover sheet attached to the copy of the priority document or a WIPO stamp on the face of the certified copy. The U.S. Patent and Trademark Office, as a Designated Office, will normally request the International Bureau to furnish the copy of the certified priority document upon receipt of applicant's submission under 35 U.S.C. 371 to enter the U.S. national phase. The copy from the International Bureau is placed in the U.S. national stage file. The copy of the priority document received from the International Bureau with either of the indications above is acceptable to establish that applicant has filed a certified copy of the priority document in compliance with 37 CFR 1.55(f). The examiner should acknowledge in the next Office action that the copy of the certified copy of the foreign priority document has been received in the national stage application from the International Bureau.

On the following pages, note the examples of acceptable indications in the form of:

(A) a cover sheet indicating receipt by the International Bureau on 12 April 2018 (12.04.2018) and compliance with PCT Rule 17.1(a), (b) or (b- *bis*) in the "Remark" section; and

(B) the stamp (box) in the upper right hand section indicating receipt by the International Bureau (WIPO) on 30 December 2002 and the stamped indication "PRIORITY DOCUMENT SUBMITTED OR TRANSMITTED IN COMPLIANCE WITH RULE 17.1(a) OR (b)."

WIPO
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## DOCUMENT MADE AVAILABLE UNDER THE PATENT COOPERATION TREATY (PCT)

| | | |
|---|---|---|
| International application number: | | **PCT/JP2018/012345** |
| International filing date: | | **27 March 2018 (27.03.2018)** |
| Document type: | | **Certified copy of priority document** |
| Document details: | Country/Office: | **JP** |
| | Number: | **2017-075548** |
| | Filing date: | **05 April 2017 (05.04.2017)** |
| Date of receipt at the International Bureau: | | **12 April 2018 (12.04.2018)** |

Remark: Priority document submitted or transmitted to the International Bureau in compliance with Rule 17.1(a),(b) or (b-*bis*)

34, chemin des Colombettes
1211 Geneva 20, Switzerland
www.wipo.int

PCT/AU02/01658

REC'D 30 DEC 2002
WIPO PCT

**PRIORITY DOCUMENT**
SUBMITTED OR TRANSMITTED IN COMPLIANCE WITH RULE 17.1(a) OR (b)

**Patent Office**
**Canberra**

I, JONNE YABSLEY, TEAM LEADER EXAMINATION SUPPORT AND SALES hereby certify that annexed is a true copy of the Complete specification in connection with Innovation Patent No. 2001100629 for a patent by WESTAFLEX (AUSTRALIA) PTY. LTD. as filed on 07 December 2001.


WITNESS my hand this
Nineteenth day of December 2002

J R Yabsley

JONNE YABSLEY
TEAM LEADER EXAMINATION
SUPPORT AND SALES

If the International Bureau is unable to forward a copy of the certified priority document to the U.S. Patent and Trademark Office, then applicant must provide a certified copy of the priority document during the national stage, unless the requirements of 37 CFR 1.55(h) or 37 CFR 1.55(i) have been met. For international applications in which the U.S. national stage commenced under 35 U.S.C. 371 on or after December 18, 2013, applicant must submit the certified copy within the later of four months from the date of entry into the U.S. national stage as set forth in 37 CFR 1.491 or sixteen months from the filing date of the prior-filed foreign application. See 37 CFR 1.55(f)(2). A delay in filing the certified copy under 37 CFR 1.55(f)(2) may be excused upon petition under 37 CFR 1.55(f)(3). The International Bureau may not forward a copy of the priority document because the certified priority document was not furnished in compliance with PCT Rule 17.1(a), (b) or (b *-bis*) or applicant requested examination to begin pursuant to 35 U.S.C. 371(f) prior to availability of the priority document from the International Bureau. If the priority claim was not in accordance with PCT Rule 4.10 or the priority document was not provided in accordance with PCT Rule 17.1(a), (b) or (b *-bis*), the copy of the priority document will not have been provided by the International Bureau. If a copy of the foreign priority document is not in the national stage application file but applicant asserts that a certified copy of the priority document was timely furnished under PCT Rule 17 in the international phase, then the examiner should consult with a Quality Assurance Specialist in his or her Technology Center or a PCT Special Program Examiner.

### III. BENEFIT CLAIM UNDER 35 U.S.C. 119(e), OR 120 AND 365(c)

A national stage application may include a benefit claim under 35 U.S.C. 119(e), or 120 and 365(c) to a prior U.S. national application or under 35 U.S.C. 120 and 365(c) to a prior international application designating the U.S. The conditions for according benefit under 35 U.S.C. 120 are as described in MPEP §§ 201.07, 201.08, and 211 *et seq.* and are similar regardless of whether the U.S. national application is a national stage application submitted under 35 U.S.C. 371 or a national application filed under 35 U.S.C. 111(a).

The conditions for according benefit of a provisional application under 35 U.S.C. 119(e) are also similar for national stage applications and applications filed under 35 U.S.C. 111(a), and the conditions are described in MPEP § 211.01(a).

In order for a national stage application (of international application "X") to obtain benefit under 35 U.S.C. 119(e) of a prior U.S. provisional application, the national stage application must comply with the requirements set forth in 37 CFR 1.78(a). 37 CFR 1.78(a)(2) requires that the prior provisional application must be entitled to a filing date as set forth in 37 CFR 1.53(c), and the basic filing fee set forth in 37 CFR 1.16(d) must be paid on the provisional application within the time period set forth in 37 CFR 1.53(g). Additionally, the provisional application must name as an inventor at least one inventor named in the later filed international application "X" and disclose the named inventor's invention claimed in at least one claim of the national stage application in the manner provided by the first paragraph of 35 U.S.C. 112. The national stage application must contain a reference to the provisional application identifying it as a provisional application, and including the provisional application number (series code and serial number). If the national stage application has an international filing date prior to September 16, 2012, then the reference must be in either an application data sheet (37 CFR 1.76) or in the first sentence(s) of the specification. See pre-AIA 37 CFR 1.78(a)(5)(iii). If the national stage application has an international filing date that is on or after September 16, 2012, then the reference must be in an application data sheet (37 CFR 1.76). See 37 CFR 1.78(a)(3). However, the requirement for inclusion of the benefit claim in an application data sheet will be satisfied in a U.S. national stage application by the presentation of such benefit claim in the PCT request form contained in the international application or the presence of such benefit claim on the front page of the published international application. See 37 CFR 1.76(g). The required reference to the earlier provisional application must be submitted within the time period provided by 37 CFR 1.78(a)(4). This time period is not extendable. However, if the entire delay, between the date the claim was due under 37 CFR 1.78(a)(4) and the date the claim was filed, was unintentional, a petition under 37 CFR 1.78(c) may be filed to

accept the delayed claim. If the provisional application was filed in a language other than English, an English-language translation of the non-English language provisional application and a statement that the translation is accurate will be required. See MPEP § 211.01(a). If the translation and statement that the translation is accurate were not filed in the provisional application or in the later-filed national stage application before November 25, 2005, applicant will be notified and given a period of time within which to file an English-language translation and a statement that the translation is accurate in the provisional application, and a reply in the national stage application that the translation and statement were filed in the provisional application. Failure to timely reply to such a notice will result in abandonment of the national stage application. See 37 CFR 1.78(a)(5).

Public Law 106-113 amended 35 U.S.C. 119(e) to eliminate the copendency requirement for a nonprovisional application claiming benefit of a provisional application. 35 U.S.C. 119(e)(2) as amended became effective on November 29, 1999 and applies to provisional applications filed on or after June 8, 1995. An international application claiming benefit under 35 U.S.C. 365(c) and 35 U.S.C. 119(e) to a prior filed provisional application must be filed within twelve months of the filing date of the provisional application. The Director may extend the twelve month statutory period by an additional two months in situations where the failure to file the international application under 35 U.S.C. 363 was unintentional. See 35 U.S.C. 119(e).

International applications filed on or after April 1, 2007 are subject to amended PCT Rules permitting restoration of a right of priority. See MPEP § 1828.01. Consequently, international applications filed on or after April 1, 2007 may claim the benefit of a provisional application filed more than 12 months before the filing date of the international application. Such a benefit claim will be effective in the U.S. national stage if the benefit of the provisional application has been restored under PCT Rule 26 *bis*.3 during the international stage. See 37 CFR 1.78(b).

Furthermore, the benefit of a provisional application may be restored in a U.S. national stage application upon petition under 37 CFR 1.78(b). Restoration of the benefit of a provisional application upon petition under 37 CFR 1.78(b) is not limited to applications having an international filing date of April 1, 2007 or later. It should be noted that where a petition under 37 CFR 1.78(b) is necessary to restore the benefit of a provisional application in a U.S. national stage application, a petition under 37 CFR 1.78(c) to add a delayed benefit claim will also be required, unless the benefit claim was timely made under 37 CFR 1.78(a)(4) (which includes, *inter alia*, making the benefit claim during the international stage).

In order for a national stage application (of international application "X") to obtain benefit under 35 U.S.C. 120 and 365(c) of a prior filed copending nonprovisional application or prior filed copending international application designating the United States of America, the national stage application must comply with the requirements set forth in 37 CFR 1.78(d). The prior nonprovisional application or international application must name as an inventor at least one inventor named in the later filed international application "X" and disclose the named inventor's invention claimed in at least one claim of the national stage application in the manner provided by the first paragraph of 35 U.S.C. 112. The national stage application must contain a reference to the prior nonprovisional or international application identifying it by application number (series code and serial number) or international application number and international filing date and indicating the relationship of the applications. If the national stage application has an international filing date prior to September 16, 2012, then the reference must be in either an application data sheet (37 CFR 1.76) or in the first sentence(s) of the specification. See pre-AIA 37 CFR 1.78(a)(2)(iii). If national stage application has an international filing date that is on or after September 16, 2012, then the reference must be in an application data sheet (37 CFR 1.76). See 37 CFR 1.78(d)(2). However, the requirement for inclusion of the benefit claim in an application data sheet will be satisfied in a U.S. national stage application by the presentation of such benefit claim in the PCT Request form contained in the international application or the presence of such benefit claim on the front page of the published international

application. See 37 CFR 1.76(g). The required reference to the earlier filed application must be submitted within the time period set forth in 37 CFR 1.78(d)(3). This time period is not extendable and failure to timely submit the required reference to the earlier application will be considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. See 37 CFR 1.78(d)(3). However, if the entire delay, between the date the claim was due under 37 CFR 1.78(d)(3) and the date the claim was filed, was unintentional, a petition under 37 CFR 1.78(e) may be filed to accept the delayed claim.

A prior filed nonprovisional application is copending with the national stage application if the prior U.S. national application was pending on the international filing date of the national stage application.

A prior-filed international application designating the United States of America is copending with the national stage application if the prior international application was not abandoned or withdrawn, either generally or as to the United States, on the international filing date of the national stage application.

Note: a national stage application submitted under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the international filing date of the international application. See also MPEP § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a benefit claim under 35 U.S.C. 120 in the national stage to the international application is inappropriate.

For a comparison with 35 U.S.C. 120 benefit claims in a national application filed under 35 U.S.C. 111(a), see MPEP § 1895.

## 1893.03(d) Unity of Invention [R-01.2024]

***37 CFR 1.499 Unity of invention during the national stage***

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

PCT Rule 13 was amended effective July 1, 1992. 37 CFR 1.475 was amended effective May 1, 1993 to correspond to PCT Rule 13.

Examiners are reminded that unity of invention analysis (not an independent and distinct analysis) is applicable in national stage applications submitted under 35 U.S.C. 371. Restriction practice in accordance with 37 CFR 1.141-1.146 continues to apply to U.S. national applications filed under 35 U.S.C. 111(a), even if the application filed under 35 U.S.C. 111(a) claims benefit under 35 U.S.C. 120 and 365(c) to an earlier international application designating the United States or to an earlier U.S. national stage application submitted under 35 U.S.C. 371.

The sections of the MPEP relating to double patenting rejections (MPEP § 804), election and reply by applicant (MPEP § 818), and rejoinder of nonelected inventions (MPEP § 821.04) generally also apply to national stage applications submitted under 35 U.S.C. 371. See MPEP § 823. Review of a lack of unity requirement is provided for under 37 CFR 1.143 and 1.144. See 37 CFR 1.499 and MPEP § 1002.02(c).

When making a lack of unity requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group. The examiner may make a lack of unity requirement in a national stage application even if no such requirement was made by the ISA or IPEA.

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. See MPEP § 1850 for a detailed discussion of Unity of Invention. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that

applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. Note also the examples contained in Chapter 10 of the International Search and Preliminary Examination Guidelines which can be obtained from the Patent Examiner's Toolkit or WIPO's website (**www.wipo.int/pct/en/texts/gdlines.html**).

A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process.

An apparatus or means is specifically designed for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process. The expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor does it imply that the process could not be carried out using an alternative apparatus or means.

Note: the determination regarding unity of invention is made without regard to whether a group of inventions is claimed in separate claims or as alternatives within a single claim. The basic criteria for unity of invention are the same, regardless of the manner in which applicant chooses to draft a claim or claims.

If an examiner (1) determines that the claims do not meet the unity of invention requirement and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable (i.e., meet the requirements of 35 U.S.C. 101, 102, 103 and 112), the nonelected invention(s) should be considered for rejoinder. Any nonelected product claim that requires all the limitations of an allowable product claim, and any nonelected process claim that requires all the limitations of an allowable process claim, should be rejoined. See MPEP § 821.04. Any nonelected processes of making and/or using an allowable product should be considered for rejoinder. The examiner should notify applicants of potential rejoinder of non-elected process claims by placing form paragraph 8.21.04 at the end of any lack of unity determination made between a product and a process of making the product or between a product and a process of using the product.

## FORM PARAGRAPHS FOR LACK OF UNITY IN NATIONAL STAGE APPLICATIONS

**¶ 18.18 Heading for Lack of Unity Action in National Stage Applications Submitted Under 35 U.S.C. 371 (Including Species)**

REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR 1.475(a), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

When Claims Are Directed to Multiple Categories of Inventions:

As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

**Examiner Note:**

1. Begin all Lack of Unity actions in national stage applications submitted under 35 U.S.C. 371 (including species) with this heading.

2. Follow with form paragraph 18.19 or 18.20, as appropriate.

3. For lack of unity during the international phase, use form paragraph 18.05 instead of this form paragraph.

**¶ 18.19 Restriction Requirement in National Stage Applications Submitted Under 35 U.S.C. 371**

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Examiner Note:**

1. This form paragraph is to be used when making a restriction requirement in a national stage application submitted under 35 U.S.C. 371.

2. This form paragraph is to be followed by form paragraphs 18.06 - 18.06.02, as appropriate, and by form paragraphs 18.07 - 18.07.02, as appropriate.

3. All restriction requirements between a product/apparatus and a process of making the product/apparatus or between a product and a process of using the product should be followed by form paragraph 8.21.04 to notify the applicant that if all product/apparatus claims are found allowable, process claims that require all the limitations of the patentable product/apparatus should be considered for rejoinder.

4. When all of the claims directed to the elected invention are in condition for allowance, the propriety of the restriction requirement should be reconsidered to verify that the non-elected claims do not share a same or corresponding technical feature with the allowable claims.

**¶ 8.21.04 Notice of Potential Rejoinder of Process Claims**

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product/apparatus, and all product/apparatus claims are subsequently found allowable, withdrawn process claims that include all the limitations of the allowable product/apparatus claims should be considered for rejoinder. All claims directed to a nonelected process invention must include all the limitations of an allowable product/apparatus claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product/apparatus claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product/apparatus are found allowable, an otherwise proper restriction requirement between product/apparatus claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product/apparatus claim will not be rejoined. See MPEP § 821.04. Additionally, in order for rejoinder to occur, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product/apparatus claims. **Failure to do so may result in no rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

**Examiner Note:**

This form paragraph should appear at the end of any requirement for restriction between a process and a product/apparatus for practicing the process (see form paragraph 8.17), a product/apparatus and a process of making the product/apparatus (see form paragraph 8.18) or between a product/apparatus and a process of using the product/apparatus (see form paragraph 8.20). See MPEP § 821.04 for rejoinder practice.

**¶ 18.20 Election of Species in National Stage Applications Submitted Under 35 U.S.C. 371**

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

**[1]**

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Currently, the following claim(s) are generic: **[2]**.

**Examiner Note:**

1. This form paragraph is to be used when making an election of species requirement in a national stage application submitted under 35 U.S.C. 371.

2. In bracket 1, identify the species from which an election is to be made.

3. In bracket 2, identify each generic claim by number or insert the word --NONE--.

4. This form paragraph is to be followed by form paragraphs 18.07 - 18.07.03, as appropriate.

**¶ 18.21 Election by Original Presentation in National Stage Applications Submitted Under 35 U.S.C. 371**

Newly submitted claim **[1]** directed to an invention that lacks unity with the invention originally claimed for the following reasons: **[2]**

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim **[3]** withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

To preserve a right to petition, the reply to this action must distinctly and specifically point out supposed errors in the restriction requirement. Otherwise, the election shall be treated as a final election without traverse. Traversal must be timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are subsequently added, applicant must indicate which of the subsequently added claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 or pre-AIA 35 U.S.C. 103(a) of the other invention.

**¶ 18.22 Requirement for Election and Means for Traversal in National Stage Applications Submitted Under 35 U.S.C. 371**

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 or pre-AIA 35 U.S.C. 103(a)of the other invention.

**Examiner Note:**

1. This form paragraph should be used when requiring restriction (including an election of species) in an application that entered the national stage under 35 U.S.C. 371.

2. This form paragraph should follow form paragraph 8.23.01 when a telephone call was made that did not result in an election being made.

## 1893.03(e) Documents Received from the International Bureau and Placed in a U.S. National Stage Application File [R-01.2024]

The national stage application includes documents communicated by the International Bureau and submissions from applicant. Some of the documents from the International Bureau are identified in this section with a brief note as to their importance to the national stage application. The examiner should review each such document and the important aspect indicated.

### I. THE PUBLICATION OF THE INTERNATIONAL APPLICATION

The publication of the international application includes

(A) a cover page with the applicant/inventor data, the application data (application number, filing date, etc.) and the Abstract (and, if appropriate, a figure of drawing),

(B) the description, claims and drawing parts of the international application, and

(C) the search report (Form PCT/ISA/210), if available.

The publication may also include other items as set forth in PCT Rule 48.

The cover page is important as a source of the correct application data, most importantly the filing date and priority date accorded to the international application. If the international application is published in English, the Office will use the description, claims, abstract and drawings as published in the pamphlet for the U.S. national stage application under 35 U.S.C. 371. The description, claims and drawing parts of the international application reflect the application subject matter on the international filing date and are important for comparison with any amendments to check for new matter. The search report reflects the International Searching Authority's opinion regarding the prior art.

The abstract is reproduced on the cover page of the publication, even though it appears on a separate sheet of the international application in accordance with PCT Rule 11.4(a). The requirement of 37 CFR 1.52(b) that the abstract "commence on a separate physical sheet or electronic page" does not apply to the copy of the published international application communicated to the designated Offices by the International Bureau under PCT Article 20. Accordingly, it is improper for the examiner of the U.S. national stage application to require the applicant to provide an abstract commencing on a separate sheet if the abstract does not appear on a separate sheet in the publication of the international application. Unless the abstract is properly amended under the U.S. rules during national stage processing, the abstract that appears on the cover page of the published international application will be the abstract published by the USPTO under 35 U.S.C. 122(b) and in any U.S. patent issuing from the application.

## II. THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT AND THE INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (CHAPTER I AND II)

When an international preliminary examination is performed by an International Preliminary Examining Authority (IPEA), an international preliminary examination report (IPER) is prepared on Form PCT/IPEA/409 by the IPEA and sent to the elected Offices. This report reflects the IPEA's non-binding opinion regarding lack of unity of invention, novelty, inventive step and industrial applicability. The IPER bears the title "International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)".

If the applicant did not timely file a demand for international preliminary examination with the IPEA, then an "International Preliminary Report on Patentability (Chapter I of the Patent Cooperation Treaty)" reflecting the International Searching Authority's (ISA's) non-binding opinion regarding lack of unity of invention, novelty, inventive step and industrial applicability is sent to the designated Offices.

The examiner may adopt any portion or all of the report on patentability of the IPEA or ISA upon consideration in the national stage so long as it is consistent with U.S. practice. The first Office action on the merits should indicate the report on patentability of the IPEA or ISA has been considered by the examiner. The indication may be a mere acknowledgement.

The IPER may include annexes, i.e., amendments to the international application that were made during the international phase. See MPEP § 1893.01(a)(3). These annexes will be placed in the U.S. national stage application file. Consequently, if the international application has been extensively amended during the international stage, there may be a number of different copies of the description, claims and drawings present in the national stage application file. The IPER may be consulted in Box No. I "Basis of the report" to determine what pages the report was based upon. Using the IPER as a roadmap of what happened during Chapter II examination will help determine which version should be examined.

Original sheets, substitute sheets, rectified sheets, and sheets that were incorporated by reference and included as part of the application examined under Chapter II are listed in the IPER as "originally filed/furnished." Replacement sheets showing amendments made under PCT Article 19 or 34 and considered during Chapter II are also listed. See

MPEP § 1879. If the IPER was established in a language other than English, the International Bureau will translate the IPER into English. However, the International Bureau will not translate the annexes to the IPER into English. Unless proper and timely translations are furnished by the applicant, foreign language annexes will be considered canceled. See MPEP § 1893.01(a)(3). All replacement sheets in the international application are marked with the international application number and the date of receipt in the upper right-hand corner. Replacement sheets that contain changes in format only and are accepted by the receiving Office are marked as "SUBSTITUTE SHEET" at the bottom of the page. Replacement sheets that contain a rectification of an obvious error or mistake and are accepted by either the ISA or the IPEA are marked as "RECTIFIED SHEET (RULE 91)" at the bottom of the page. Sheets that were incorporated by reference and accepted by the receiving Office are marked as "INCORPORATED BY REFERENCE (RULE 20.6)." Additionally, replacement sheets to the claims submitted to the International Bureau as Article 19 Amendments will be marked as "AMENDED SHEET (Article 19)" at the bottom of the page. Furthermore, replacement sheets to the description, claims and drawings submitted to the IPEA as Article 34 Amendments will be marked as "AMENDED SHEET" at the bottom of the page. The IPER will indicate in "Box No. I Basis of the Report" that claim numbers submitted under either PCT Article 19 or 34 have been considered and will indicate the date they were received and the replacement sheets will be annexed to the IPER. The NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) should also be consulted, as it will indicate if the annexes or their translation have not been entered.

**III. THE PRIORITY DOCUMENT**

See the discussion in MPEP § 1893.03(c).

**IV. NOTIFICATION OF WITHDRAWAL**

If the national stage application papers include an indication that the international application or US designation has been withdrawn, then the application should be brought to the attention of the International Patent Legal Administration to determine whether the withdrawal occurred prior to completion of the requirements under 35 U.S.C. 371(c). If the withdrawal occurred prior to completion of the requirements under 35 U.S.C. 371(c), then entry into the U.S. national stage is prohibited. See 35 U.S.C. 366. The indication of withdrawal may appear on a Notification of Withdrawal (PCT/IB/307 or PCT/RO/136), a Notification that International Application Considered to Be Withdrawn (Form PCT/RO/117), or other notification.

## 1893.03(e)(1) Title of the Invention [R-08.2012]

In the absence of an application data sheet (37 CFR 1.76) or preliminary amendment changing the title, the Office will use the title of the invention that appears on the first page of the description of the published international application (if published under PCT Article 21 in English) or the title that appears on the first page of the description of the English translation of the international application (if not published under PCT Article 21 in English) in preparing the official filing receipt. If the title does not appear on the first page of the description, and an application data sheet or preliminary amendment changing the title has not been furnished, then the title will be taken from the cover page of the published international application. If applicant furnishes an application data sheet or preliminary amendment changing the title, the Office will use the title as indicated in such document in preparing the official filing receipt. If applicant submits both an application data sheet and a preliminary amendment, the later filed document will govern. See 37 CFR 1.76(d)(1). An application data sheet will govern over a concurrently filed preliminary amendment. See 37 CFR 1.76(d)(2).

## 1893.03(f) Drawings and PCT Rule 11 [R-07.2022]

The USPTO may not impose drawing requirements during the examination of a national stage application beyond those imposed by the Patent Cooperation Treaty (e.g., PCT Rule 11). However, the examiner does have the authority to require new drawings if the drawings were published without

meeting all requirements under the PCT for drawings.

An applicant may file amended drawings in accordance with 37 CFR 1.84 and 1.121(d) during the national stage. This includes an amendment seeking to replace black and white drawings with color drawings accompanied by a grantable petition to accept a color drawing and the necessary petition fee. Guidance on review of a petition to accept color drawings is provided in MPEP § 608.02, subsection VIII. In the event that an International Application was filed with color drawings and published by the International Bureau with only black and white drawings, the applicant is entitled to rely on the color drawings that were present on the international filing date to determine if a subsequent amendment seeking to add color drawings during the national stage includes new matter.

### 1893.03(g) Information Disclosure Statement in a National Stage Application [R-07.2015]

An extensive discussion of Information Disclosure Statement practice is to be found in MPEP § 609. Although not specifically stated therein, the duty to disclose information material to patentability as defined in 37 CFR 1.56 is placed on individuals associated with the filing and prosecution of a national stage application in the same manner as for a domestic national application. The averment with respect to the duty under 37 CFR 1.56 required under 37 CFR 1.63(b)(3) in an oath or declaration is applicable to oaths and declarations filed in U.S. national stage applications. See 37 CFR 1.497(c).

When an international application is filed under the Patent Cooperation Treaty (PCT), prior art documents may be cited by the examiner in the international search report and/or the international preliminary examination report. It is desirable for the U.S. examiner to consider the documents cited in the international application when examining the U.S. national stage application or when examining an application filed under 35 U.S.C. 111(a) which claims the benefit of the international application under 35 U.S.C. 365(a) or (c).

When all the requirements for a national stage application have been completed, applicant is notified (Form PCT/DO/EO/903) of the acceptance of the application under 35 U.S.C. 371, including an itemized list of the items received. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner will consider the documents cited in the international search report and any supplementary international search report under PCT Rule 45 *bis* , without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report (or supplementary international search report under PCT Rule 45 *bis* ) and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form. See form paragraphs 6.53, 6.54, and 6.55 (reproduced in MPEP § 609.03). Otherwise, applicant must follow the procedure set forth in 37 CFR 1.97 and 1.98 in order to ensure that the examiner considers the documents cited in the international search report.

This practice applies only to documents cited in the international search report relative to a national stage application filed under 35 U.S.C. 371. It does not apply to documents cited in an international preliminary examination report that are not cited in the search report. It does not apply to applications filed under 35 U.S.C. 111(a) claiming the benefit of an international application filing date.

### 1894 [Reserved]

### 1895 A Continuation, Divisional, or Continuation- in- Part Application of a PCT Application Designating the United States [R-07.2015]

It is possible to file a U.S. national application under 35 U.S.C. 111(a) during the pendency (prior to the abandonment) of an international application which designates the United States without completing the requirements for entering the national stage under 35 U.S.C. 371(c). The ability to take such action is based on provisions of the United States patent law. 35 U.S.C. 363 provides that "[a]n international application designating the United States shall have

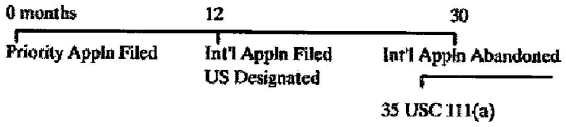
the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office....” 35 U.S.C. 371(d) indicates that failure to timely comply with the requirements of 35 U.S.C. 371(c) “shall be regarded as abandonment... by the parties thereof....” It is therefore clear that an international application which designates the United States has the effect of a pending U.S. application from the international application filing date until its abandonment as to the United States. The first sentence of 35 U.S.C. 365(c) specifically provides that “[i]n accordance with the conditions and requirements of section 120 of this title,... a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States.” The condition of 35 U.S.C. 120 relating to the time of filing requires the later application to be filed before the patenting or abandonment of or termination of proceedings on the first application. The filing of a continuation, divisional, or continuation-in-part application of a PCT application designating the United States is known as a “bypass” application.

Continuation-in-part applications are generally filed in instances where applicants seek to add matter to the disclosure which is not supported by the disclosure of the international application as originally filed, as new matter may not be added to a U.S. national stage application. See 37 CFR 1.121(f).

## 1895.01 Handling of and Considerations in the Handling of Continuations, Divisions, and Continuations-In-Part of PCT Applications [R-07.2022]

Pursuant to 35 U.S.C. 365(c), a regular national application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) (not under 37 CFR 1.53(d)) may claim benefit of the filing date of an international application which designates the United States. Thus, rather than submitting a national stage application under 35 U.S.C. 371, applicant may file a continuation, divisional, or continuation-in-part of the international (PCT) application under 35 U.S.C. 111(a). Such applications are often referred to as “bypass” applications.

A typical time line involving a continuing application filed during the pendency of an international application is illustrated as follows:




To obtain benefit under 35 U.S.C. 120 and 365(c) of a prior international application designating the U.S., the continuing application must:

(A) include a specific reference to the prior international application

(B) be copending with the prior international application, and

(C) have at least one inventor in common with the prior international application.

With regard to (A), if the continuing application was filed prior to September 16, 2012, the specific reference to the international application required under 35 U.S.C. 120 and 365(c) must either be contained in the first sentence(s) of the specification following the title or included in an application data sheet. See 37 CFR 1.78(d)(2) and 37 CFR 1.78(h). If the continuing application was filed on or after September 16, 2012, the specific reference to the international application required under 35 U.S.C. 120 and 365(c) must be contained in an application data sheet. 37 CFR 1.78(d)(2). The specific reference must identify the parent international application by international application number and international filing date and indicate the relationship of the applications (i.e., continuation, continuation-in-part, or division). See 37 CFR 1.78(d)(2) and MPEP § 211.02. The required reference must be submitted within the time period provided by 37 CFR 1.78(d)(3). This time period is not extendable. A certified copy of the international application (and an English translation of the international application) may be required by the examiner to perfect the claim for benefit under 35 U.S.C. 120 and 365(c) if the international application did not

originate in the United States and such is necessary, for example, where an intervening reference is found and applied in a rejection of one or more claims. If the international application was published by the International Bureau pursuant to PCT Article 21, then a certified copy would not normally be necessary.

If benefit under 35 U.S.C. 119(e), and/or under 35 U.S.C. 120 and 365(c) is being claimed to an earlier filed national application (or international application designating the U.S.) via an intermediate international application designating the U.S., then the intermediate international application must contain a specific reference to the earlier application, as required under 37 CFR 1.78. The specific reference will usually be included on the cover page of the published international application and/or may appear in the first sentence(s) of the description of the published application. A lack of a proper reference in the published international application does not necessarily mean that a proper reference is not contained in the intermediate international application. Accordingly, the international application file (if the USPTO was the receiving Office) may have to be inspected to determine whether the requirements under 37 CFR 1.78 were satisfied after publication of the international application. For example, the intermediate international application file may contain the specific reference in a separate paper filed after publication but during the pendency of the international application, or a decision granting a petition to accept a late benefit claim may be present in the application file. See MPEP § 211.04. The examiner may contact the International Patent Legal Administration for assistance.

With regard to (B), a U.S. national application is considered copending with a prior international application designating the U.S. if the international application was pending on the filing date of the U.S. national application. Generally, except in cases where the international application has been withdrawn (either generally or as to the United States), an international application becomes abandoned as to the United States upon expiration of 30 months from the priority date (i.e., the priority date claimed in the international application or, if no priority is claimed, the international filing date) unless a proper submission under 35 U.S.C. 371 to enter the U.S. national phase is filed prior to the expiration of this 30-month period. See MPEP §§ 1893.01(a)(1) and 1893.02. However, if the international application is one where the 20-month period from the priority date expired before April 1, 2002, then it was necessary to file a demand electing the United States prior to the expiration of 19 months from the priority date in order to extend the international phase to 30 months from the priority date. If such a demand was not timely filed, then under former 37 CFR 1.494, such an international application became abandoned at the expiration of 20 months from the priority date unless a proper submission under 35 U.S.C. 371 to enter the U.S. national phase was made prior to the expiration of 20 months from the priority date. Accordingly, if the international application is not subject to the filing of a demand in order to delay entry into the U.S. national phase to 30 months from the priority date, then a national application filed prior to the expiration of this 30 month period will be copending with the international application unless the international application was withdrawn, either generally or as to the United States, prior to the filing of the national application. To determine whether the application was withdrawn, the examiner must either review the Home Copy of the international application file (if the USPTO was the receiving Office), or require applicant to certify that the international application was not withdrawn or considered to be withdrawn, either generally or as to the United States, prior to the filing date of the national application claiming benefit under 35 U.S.C. 120 and 365(c) to such international application. In order to expedite examination, applicant should certify at the time of filing a national application claiming benefit under 35 U.S.C. 120 and 365(c) to an international application that the international application has not been withdrawn. If the national application claiming benefit to the international application was filed after the expiration of this 30-month period, then there will be no copendency in the absence of a timely and proper submission to enter the U.S. national phase under 35 U.S.C. 371. The existence of a national stage application may be checked through the Patent Data Portal and the records of the national stage application should be consulted to verify copendency. Additionally, if the 20-month period from the priority date of the

international application expired before April 1, 2002 and the national application claiming benefit under 35 U.S.C. 120 and 365(c) was filed later than 20 months from the priority date of the international application, the applicant may be required to submit proof of the filing of a demand electing the United States within 19 months from the priority date. This proof may be in the form of a copy of the "Notification of Receipt of Demand by Competent International Preliminary Examining Authority" (Form PCT/IPEA/402) showing the demand was received prior to the expiration of 19 months from the priority date, and a copy of the "Notification Concerning Elected Offices Notified of Their Election" (Form PCT/IB/332) showing the election of the United States. If the parent international application was not copending (i.e., abandoned or withdrawn), benefit under 35 U.S.C. 120 is not possible.

With regard to (C), inventors will normally be identified on the cover page of the published international application. In addition, such information is indicated in the *PCT Gazette* , which is available in electronic form from WIPO's website (**www.wipo.int/pct/en/official_notices**).

**PRIORITY CLAIMS UNDER 35 U.S.C. 119 (a)-(d)**

A claim for foreign priority under 35 U.S.C. 119(a) - (d) must be made in the continuing application in order to obtain the benefit of the filing date of the prior filed foreign application. This is true regardless of whether such a claim was made in the parent international application. A foreign priority claim is proper in the continuing application if the continuing application or the parent international application was filed not later than 12 months after the filing date of the foreign application. See 37 CFR 1.55(b). In addition, a foreign priority claim is proper in the continuing application if the continuing application or the parent international application was filed after expiration of the 12 month period set forth in 37 CFR 1.55(b) but within two months from such expiration, if the right of priority is restored under 37 CFR 1.55(c). The required claim must be made within the time period set forth in 37 CFR 1.55(d)(1). This time period is not extendable. See MPEP § 214.01. A certified copy of any foreign priority document must be provided by the applicant unless the requirements of 37 CFR 1.55(h) or 37 CFR 1.55(i) have been met or the parent international application has entered the national stage under 35 U.S.C. 371 and the national stage application contains the priority document from the International Bureau. See MPEP § 1893.03(c). In the latter case, the applicant, in the continuing application, may state that the priority document is contained in the national stage application.

For a discussion of U.S. national applications filed under 35 U.S.C. 111(a) having foreign priority claims under 35 U.S.C. 119(a) - (d) and 365(a) to a prior international application designating at least one country other than the United States, see MPEP § 213.01.

## 1896 The Differences Between a National Application Filed Under 35 U.S.C. 111(a) and a National Stage Application Submitted Under 35 U.S.C. 371 [R-01.2024]

The following section describes some differences between a U.S. national application filed under 35 U.S.C. 111(a), including those claiming benefit of a PCT application under 35 U.S.C. 120 (a **continuation, division,** or a **continuation-in-part** of a PCT application), and a U.S. **national stage application** (submitted under 35 U.S.C. 371).

***Chart of Some Common Differences***

| | **National Applications (filed under 35 U.S.C. 111(a) )** | **National Stage Applications (submitted under 35 U.S.C. 371)** |
|---|---|---|
| Filing Date | see 37 CFR 1.53(b) | International filing date of PCT application |
| 35 U.S.C. 119(a) - (d) Priority Requirement | Claim for priority in accordance with 37 CFR 1.55(d)(1) Certified copy provided by applicant in accordance with 37 CFR 1.55(f)(1), unless | Claim for priority in accordance with 37 CFR 1.55(d)(2) Copy of certified priority document provided by the International Bureau or in accordance with |

| | National Applications (filed under 35 U.S.C. 111(a) ) | National Stage Applications (submitted under 35 U.S.C. 371) |
|---|---|---|
| | the requirements of 37 CFR 1.55(h) or (i) have been met | 37 CFR 1.55(f)(2). |
| Unity of Invention | U.S. restriction practice under 37 CFR 1.141-1.146 | Unity of invention practice under 37 CFR 1.499 |
| Filing Fees | 37 CFR 1.16 | 37 CFR 1.492 |

The differences between a national application filed under 35 U.S.C. 111(a) and a national application submitted under 35 U.S.C. 371 are often subtle, but the differences are important.

## I. FILING DATE

The filing date of a 35 U.S.C. 111(a) application is, except as provided in 35 U.S.C. 111(c), the date when a specification is received in the USPTO. See 37 CFR 1.53(b) and 37 CFR 1.57(a).

The filing date of a PCT international application is the date applicant satisfies Article 11 requirements, i.e., includes a description, a claim, names at least one applicant who is a resident or national of a PCT Contracting State, filed in the prescribed language, and designates at least one Contracting State. See MPEP § 1810. By virtue of 35 U.S.C. 363, the U.S. filing date of an international application that designates the United States is, for most legal purposes, the international filing date. See MPEP § 1893.03(b).

## II. 35 U.S.C. 119(a)-(d) AND 365(b) PRIORITY REQUIREMENTS

In a U.S. national application filed under 35 U.S.C. 111(a), the claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(d). The certified copy of the foreign priority application must be provided to the Office by applicant within the time period set forth in 37 CFR 1.55(f), which is the later of four months from the actual filing date of the application or sixteen months from the prior foreign application, unless the requirements of 37 CFR 1.55(h) or 37 CFR 1.55(i) have been met. See MPEP § 1895.01.

In a U.S. national stage application submission under 35 U.S.C. 371, where applicant filed an international application claiming priority to an earlier filed national application, the claim for priority must be made and the certified copy of the priority application must be furnished during the international stage within the time limit set forth in the PCT and Regulations under the PCT. The International Bureau sends a copy of the certified priority document to each designated office that has requested to receive such documents. Upon receipt of applicant's submission to enter the U.S. national stage under 35 U.S.C. 371, the USPTO will request from the International Bureau a copy of the certified priority document submitted in the international stage. Upon receipt of the priority document, the USPTO will place the document in the image file wrapper of the national stage application. Such a copy from the International Bureau is acceptable in a U.S. national stage application to establish that applicant has filed a certified copy of the priority document in compliance with 37 CFR 1.55(f)(2). For procedures when the certified priority document was not provided during the international stage, see MPEP § 1893.03(c).

## III. UNITY OF INVENTION

U.S. national applications filed under 35 U.S.C. 111(a) are subject to restriction practice in accordance with 37 CFR 1.141-1.146. See MPEP § 803. U.S. national stage applications are subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499. See MPEP § 1893.03(d).

## IV. FILING FEES

U.S. national applications filed under 35 U.S.C. 111(a) are subject to the national application filing fees set forth at 37 CFR 1.16. Submissions to enter the U.S. national stage under 35 U.S.C. 371 are subject to the national stage fees prescribed at 37 CFR 1.492.