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TESTING THE DRAFT ADMINISTRATIVE INSTRUCTIONS, INCLUDING THE  
PCT FORMS, FOR THEIR COMPLIANCE WITH PRACTICAL REQUIREMENTS  
THROUGH SIMULATION OF PCT PROCEDURES

Report prepared by the International Bureau

Background

1. At its fifth session in November 1974, the PCT Interim Advisory Committee for Administrative Questions (hereinafter referred to as "the Interim Committee") received a proposal by the State Committee for Inventions and Discoveries of the USSR Council of Ministers (hereinafter referred to as "the State Committee") on the conducting of tests through the processing of sample PCT international applications (hereinafter called the "Test Program") and decided to include the proposal as part of the Interim Committee's program for 1975 (document PCT/AAQ/V/6, paragraph 67(v)).
2. The International Bureau, after consultation with the State Committee, received a new detailed proposal from the Committee for the conduct of the Test Program.
3. The Test Program proposal involved the preparation of two or three test international applications in the English language in which the State Committee would act in the capacity of the applicant and send such applications to another Office, which would assume the role of the receiving Office under the PCT. The State Committee, in turn, would be willing to act as the receiving Office for test international applications generated by other cooperating Offices.
4. All test applications would be deliberately prepared with defects, in order to ensure a variance from PCT formality requirements. This would ensure the wide use of the existing PCT Forms dealing with formality requirements as well as the Administrative Instructions. The International Bureau would assume its functions as the "International Bureau" under the PCT.
5. In February 1975, the German Patent Office expressed its willingness to participate in the Test Program. In May 1975, the State Committee, acting as an applicant, sent the German Patent Office three test international applications to be processed by the latter Office acting as a "receiving Office under the PCT".
6. The International Bureau received the record copies of two test international applications transmitted by the German Patent Office acting in its role as a receiving Office. In turn, the International Bureau notified the applicant, the receiving Office and the designated Offices of the receipt of the record copies of the applications.

7. At its sixth session in 1975, the Interim Committee received a progress report on the Test Program, as far as it had proceeded, from the State Committee (document PCT/AAQ/VI/11) and the International Bureau (document PCT/AAQ/VI/9). The Interim Committee also had before it a letter to the International Bureau from the United States Patent and Trademark Office attaching a copy of a report on a test conducted on PCT procedures, Forms and Administrative Instructions and indicating the interest of that Office in participating in further international testing activities (document PCT/AAQ/VI/12). A detailed discussion of the last-mentioned document was considered by the Interim Committee to be premature, since the Test Program had so far not progressed beyond the initial stage.

8. At its said sixth session, the Interim Committee noted with appreciation the initiative of the Soviet Union in this matter and formed the opinion that the Test Program was of considerable importance and should be actively continued during 1976. Indications were given that the Offices of Austria, Japan, Sweden, Switzerland, the United Kingdom and the United States of America, as well as the International Patent Institute (IIB), intended to participate in the Test Program in addition to the German Patent Office and the State Committee. The International Bureau confirmed its readiness to contribute to the Test Program by assuming its role under the Treaty and by acting as an intermediary for the promotion of the Test Program (document PCT/AAQ/VI/21, paragraph 131): The Interim Committee decided to continue the Test Program in 1976.

#### Contents of Annexes to this Document

9. Attached to the present document are the following annexes:

- Annex A: Summary of the test results prepared by the International Bureau concerning proposals of a general nature and proposals for revision of the Administrative Instructions;
- Annex B: Summary of the test results concerning proposals for new Administrative Instructions;
- Annex C: Summary of the test results prepared by the International Bureau concerning proposals of a general nature on the PCT Forms and proposals for their revision;
- Annex D: Summary of the test results prepared by the International Bureau concerning proposals for new PCT Forms;
- Annex E: Pairings, roles and general ground rules governing the Test Program;
- Annex F: Invitation to submit test results with respect to the Test Program;
- Annex G: Reply received from the Austrian Patent Office concerning test results;
- Annex H: Reply received from the German Patent Office concerning test results;
- Annex I: Reply received from the Japanese Patent Office concerning test results;
- Annex J: Reply received from the State Committee for Inventions and Discoveries of the USSR Council of Ministers concerning test results;
- Annex K: Reply received from the Swedish Patent Office concerning test results;
- Annex L: Reply received from the Patent Office of the United Kingdom concerning test results;
- Annex M: Reply received from the United States Patent and Trademark Office concerning test results;
- Annex N: Reply received from the International Patent Institute (IIB) concerning test results.

The Test Program (1976)Purposes of the Test Program

10. The purpose of conducting the Test Program was:

to test the current draft Administrative Instructions (document PCT/AAQ/VI/2) and some of the PCT Forms (documents PCT/AAQ/VI/3, 4 and 5) thereunder under simulated processing conditions prior to the 1976 session of the Interim Committee.

11. The results of these tests were intended to afford the Interim Committee the opportunity to examine the completeness of PCT procedures as they affect the International Bureau and the various Offices acting as a receiving Office and/or International Searching Authority, as well as to discover certain processing problems that could occur in view of the short time limits under the Treaty.

The Nature of the Test Program

12. The test involved the processing of papers passing between the applicant, the receiving Office, the International Searching Authority and the International Bureau up to and including the preparation and transmittal of the international search report. No attempt was made to "publish" the applications and search reports or to perform any of the application processing steps of the designated Office in the national phase. However, it will be noted that Appendix F of the Draft Guidelines on Publication under the Patent Cooperation Treaty (PCT) (document PCT/AAQ/VII/4) contains a sample published international application and international search report using one of the test international applications.

13. The test international applications. The Test Program involved the two existing test international applications previously prepared by the State Committee and two additional test international applications prepared by the United States Patent and Trademark Office. Certain defects were added in order to present matter that would require correction by the receiving Offices and/or the International Searching Authorities and the International Bureau.

14. Roles to be played. The various participants involved in the Test Program (see paragraph 8 above) played the roles of the applicant, the receiving Office and the International Searching Authority while the International Bureau assumed its role as the "International Bureau" under the PCT.

15. For further clarification of the pairings and roles to be played, mailing of the test applications, addresses and general ground rules governing the Test Program, see Annex E to this document.

Results of the Test ProgramRevised Draft Administrative Instructions (document PCT/AAQ/VI/6)

16. The results of the Test Program (Annexes G to N) were considered by the International Bureau in the elaboration of the revised draft Administrative Instructions (hereinafter referred to as the "Revised Draft", see document PCT/AAQ/VII/6). For the reasons set out in the said document, only those proposals made by the participants in the Test Program that, in the view of the International Bureau, were subject matter appropriate for Administrative Instructions and could be readily agreed upon and incorporated in the Administrative Instructions at the 1976 session of the Interim Committee, were put forward by the International Bureau in its elaboration of the Revised Draft. Furthermore, in accordance with the principles on which the Administrative Instructions were based, consideration was given to dealing, to the extent possible, with matters pertaining to a Form in that Form rather than in the relevant Administrative Instruction.

Proposals Concerning the Administrative Instructions

17. The International Bureau has reported on a number of important proposals contained in Annexes G to N in order to bring a number of problem areas to the attention of the Interim Committee. In this report, the participants in the Test Program

having presented particular proposals are identified by the ICIREPAT two-letter country code of their country or abbreviation of their organization. The report has been divided into two Annexes, as follows:

- (i) Annex A - proposals of a general nature and proposals for the revision of existing Administrative Instructions, together with footnotes, signalled by an asterisk, in the case of those Sections of the Administrative Instructions in relation to which the proposals were taken into consideration, as far as possible, in the preparation of the Revised Draft (document PCT/AAQ/VII/6);
- (ii) Annex B - proposals for new Administrative Instructions.

18. In Annexes A and B, the International Bureau has provided, to the extent possible, abbreviated comments in relation to proposals for the revision of the Administrative Instructions or for new Administrative Instructions. No such comments have, however, been made when a proposal has been reflected in the Revised Draft.

19. The proposals presented by the participants in the Test Program with respect to the Administrative Instructions and which might be considered useful by the Interim Committee, although they are not included in the Revised Draft, could, of course, be further studied, if so desired, with a view to examining their inclusion in the Administrative Instructions at a later stage, once initial experience has been gained of the practical operation of the PCT.

#### Revised PCT Forms (documents PCT/AAQ/VII/7, 8 and 9)

20. For the reasons mentioned in paragraph 16 above, the International Bureau, in its elaboration of the revised PCT Forms (hereinafter referred to as the "Revised Forms", see documents PCT/AAQ/VII/7, 8 and 9), took into consideration the comments of the Interim Committee at its last session (see document PCT/AAQ/VI/21, paragraphs 63 to 70), as well as some of those proposals by the participants in the Test Program which, in its view, might be readily agreed upon at the present session of the Interim Committee and thus help to establish a final version of the revised PCT Forms. For these reasons, it was felt that it would be preferable to defer a detailed examination of a certain number of proposals presented as a result of the Test Program and not included in the Revised Forms but that the proposals could, of course, be further studied, if so desired, with a view to examining their inclusion in the PCT Forms at a later date, once initial experience has been gained of the practical operation of the PCT.

#### Proposals Concerning the PCT Forms

21. For the reasons already indicated, the International Bureau has attempted neither to elaborate all proposals in respect of the PCT Forms, as set forth in Annexes G to N, nor to give detailed evaluations of these proposals. It has concentrated on reporting upon those proposals of the participants in the Test Program which were made with respect to the contents of the Forms and the more important proposals concerning the layout of the Forms. The said proposals, identified by the ICIREPAT two-letter country code for the countries of the participants in the Test Program, have been divided into two further Annexes, as follows:

- (i) Annex C - proposals of a general nature on the PCT Forms and proposals for their revision, together with footnotes, marked by an asterisk in the case of those PCT Forms in relation to which the proposals were taken into consideration, as far as possible, in the preparation of the Revised Forms (documents PCT/AAQ/VII/7, 8 and 9);
- (ii) Annex D - proposals for new PCT forms.

22. In the same manner as was noted in paragraph 18, with respect to the proposals relating to the Administrative Instructions, the International Bureau has provided in Annexes C and D, to the extent possible, abbreviated comments in relation to proposals for the revisions of the Forms or for new Forms. No such comments have, however, been made when a proposal has been reflected in the Revised Forms.

General

23. In order to avoid repetition and delay in presenting the results of the Test Program, the International Bureau has neither attempted to engage in a detailed discussion of the proposals listed in the summary reports (Annexes A to D) nor to add any further proposals to those already submitted by the participants in the Test Program. The Interim Committee's attention is directed to the fact that all proposals not reproduced in the summary reports have been recorded by the International Bureau. They could, if so desired, be considered in due course then the Administrative Instructions and the PCT Forms thereunder are reviewed at a later stage, especially after practical experience has been gained.

24. The International Bureau should like to underline that the Test Program was of particular usefulness to it. Through that program, the International Bureau was able to gain substantial practical experience with respect to the tasks which it is entrusted with under the PCT. In addition, the valuable test results provided by the various participating Offices under the Test Program will immeasurably aid the International Bureau in handling international applications with greater ease and efficiency upon the entry into force of the PCT.

Future Tests

25. With regard to the continuation of the Test Program, the Interim Committee is called upon to express its views on whether the Test Program, on the basis of the experience gained, should continue or whether it is preferable at this stage to wait until a practical test of the Administrative Instructions and Forms is possible, once the Treaty becomes operational. In view of the enormous amount of work still required in order to prepare in time for the operational stage of the Treaty, the latter course of action would seem to be more economical and, therefore, preferable.

26. The Interim Committee is invited to examine the information contained in this document and to provide its advice to the International Bureau.

[Annexes follow]

COMMENTS OF A GENERAL NATURE AND PROPOSALS FOR THE  
REVISION OF THE ADMINISTRATIVE INSTRUCTIONS

General Comments

The general comments received may be summarized in the following three points:

- (DT) (i) all applicable Sections of the Administrative Instructions were found to  
(OE) be very useful;
- (DT) (ii) most applicable Sections of the Administrative Instructions did not show  
any major defects;
- (DT) (iii) all Sections of the Administrative Instructions providing for notifica-  
(SW) tion to an applicant, an International Authority and the International  
Bureau should be annotated with the particular number of the PCT Form  
to be employed.

[Comment: This should be carefully considered before taking a decision, having regard in particular to the need for considerable flexibility in adding, deleting or amending Forms and to any decision that will be made the question of the obligatory nature of the PCT Forms.]

Proposals for Revision of the Draft Administrative Instructions

Section 201 - Dates

- (JA) The Administrative Instructions already provide for the manner in which the  
(US) receiving Office indicates any date in an international application. That form of  
indication of dates should be extended to cover all other documents relevant to  
communication from PCT Authorities, including the dates marked as the date of mail-  
ing on the PCT Forms.

[Comment: Section 201 cannot be applied without modification. It needs to be studied further whether provisions on the dating of documents, other than the international application, and if so, which documents, should be made, and, the nature of such provisions.]

Section 202 - Names of States

- (JA) The Administrative Instructions (Annex A) provide for the indication of the  
(US) name of a State by either its full name or its generally accepted short title.  
The Administrative Instructions should be revised to make provision for the re-  
ceiving Office to ask for clarification of any designation in the cases where the  
applicant's intention is not clear. Additionally, a sanction for lack of response  
to such an inquiry should be provided for in this Section. Annex A should be amended  
to include commonly used names for various States.

[Comment: If there is real confusion, there is a defect under Article 11. In any event, the receiving Office is free to ask for clarification without express provision. If specific provisions are considered necessary, they will have to be made by an amendment of the Regulations. It is not possible to provide for sanctions against the applicant in the Administrative Instructions having regard to the legal nature and the function which they serve (see Article 58(4) and PCT Rule 89).]

\*Section 208 - Arrangement of Elements and Numbering of Sheets of the International Application

- (GB) The Administrative Instructions provide for the sequential numbering of sheets  
(US) and the arrangement of the elements of an international application. Such number-  
ing of sheets should provide for two series of page numbers, one commencing with  
the Request, excluding the fee calculation sheet, and the other commencing with the  
description and including the other parts of the international application (claims,  
drawings and abstract).

\* Reflected in Section 208(b) of the Revised Draft (see document PCT/AAQ/VII/6).

Section 302 - Notification of Priority Claim Considered Not to Have Been Made

(GB) The Administrative Instructions contain provisions dealing with the necessary  
(US) notifications in cases where a priority claim is considered not to have been made.  
Provisions should be made for the case where the earliest or the single priority  
date is withdrawn or changed by the applicant during international processing and  
such withdrawal or change shifts the timing for such processing (see also document  
PCT/AAQ/VI/16).

[Comment: A provision of this kind could only be made by an amendment of the  
Regulations and should be very carefully considered, since any shifting of the  
time limits affects the timing of the procedure. It would appear to be preferable  
to retain the time limits for processing starting from the priority date, even if  
the priority claim is changed later or withdrawn or considered to be withdrawn,  
this also to avoid a possible loss of rights in the phase before the designated  
Offices.]

Section 304 - Corrections Submitted to the Receiving Office concerning Ex-  
pressions, etc., Not to be Used in the International Application

(US) The Administrative Instructions provide a procedure for the case where the  
applicant submits corrections with respect to the prescriptions of PCT Rule 9.1.  
An additional procedure should be provided for in this Section to indicate how a  
notation concerning errors under Rule 9.1, noticed by the receiving Office, and  
how corrections or any response submitted by the applicant under such Rule, should  
be inserted in the original papers of the international application.

[Comment: As to notation of expressions, etc., not to be used, see Form PCT/RO/112.  
As to the entry of corrections, there seems to be no need for additional provisions  
concerning the entry of corrections, since the general procedure under Rule 26.4  
would appear to be sufficient.]

Section 307 - System of Numbering International Applications

(GB) The Administrative Instructions provide for a provisional file number (Sec-  
(OE) tion 307(a)) without "PCT/" and the use of an international application number  
(US) with "PCT/" (Section 307(b)). The provisional numbering system should be eliminated  
as experience has shown that this numbering system requires substantial time since  
it is necessary to first mark the provisional file number on each sheet of each  
copy of the application received and then later, after a positive determination has  
been made under Article 11(1) of the PCT, to stamp "PCT/" before the previously  
marked provisional file number on each page of the application.

[Comment: This would involve reconsideration of the decision made at the last  
session of the Interim Committee to retain the provisional numbering system, for  
reasons set out in paragraph 35 of the report of that session (document  
PCT/AAQ/VI/21). The marking may be by perforation and it is therefore not neces-  
sary to stamp each page.]

Sections 309 and \*310 - Procedure in the Case of Later Submitted Sheets and  
Missing Drawings

(US) The Administrative Instructions provide a procedure for the receiving Office  
with respect to the handling of later submitted sheets and missing drawings. Ex-  
perience has shown that a question exists in respect of these Sections as to the  
method of entering a corrected international filing date or date of receipt into  
the original application papers. Additionally, a procedure is needed for marking,  
in the original papers, the fact that drawings are missing, and for subsequent  
marking of the original papers, after the expiration of the time limit for the  
applicant to submit the missing drawings, that the drawings were received within  
the time limit or that the time limit has expired and no drawings have been re-  
ceived.

[Comment: Further study is required of the matters raised, to the extent that  
they have not been dealt with in the Revised Draft or in the revised PCT Forms, in  
order to determine whether any further provision is necessary, taking into account  
that part of the proposals made would lead to a very complicated procedure.]

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\* Reflected as far as possible in Section 310(d) of the Revised Draft (see docu-  
ment PCT/AAQ/VII/6).

\*Section 311 - Renumbering of Sheets of the International Application

(OE) The Administrative Instructions provide for the renumbering of the sheets of  
(DT) an international application by a receiving Office in the case of the addition,  
(US) deletion or change in the order of the sheets. This Section should be revised  
along the lines suggested by the State Committee for Inventions and Discoveries  
of the USSR Council of Ministers in document PCT/AAQ/VI/13. Such revision, as  
explained in this document, provides a clear procedure on how to proceed in the  
case of deleted, substituted or added sheets of the international application,  
particularly with respect to the manner of marking and notations when renumbering  
the original sheets of the application.

Section 313 - Manner of Making the Necessary Annotations in the Check List

(DT) The Administrative Instructions provide for marking the Request in a certain  
manner whenever a receiving Office itself fills in the check list. This Section  
should be revised to include the situation where the applicant himself incorrectly  
fills in the check list.

[Comment: Rule 3.3(b) and Section 313 would seem to apply at least by analogy as  
regards the corrections made by the receiving Office in the check list. If a  
clarification appears necessary, it would have to be made in Rule 3.3(b)].

Section 403 and 502 - Transmittal of and Protest Against Payment of Additional  
Fee and Decision Thereon

(US) The Regulations and the Administrative Instructions provide a procedure for  
an International Searching Authority and the International Bureau with respect to  
the manner of handling the transmittal of a protest in the case of payment of an  
additional fee under protest (under PCT Rule 40.2(c)). These provisions should be  
revised to indicate to whom and at what time the applicant should submit his re-  
quest to have his protest or any decisions thereon transmitted to the designated  
Offices.

[Comment: Under PCT Rule 40.2(b) and (c), the protest shall accompany the payment  
which must be made to the International Searching Authority within the time limit  
indicated by it. The request for notification to the designated Offices together  
with the international search report can be made either to the International Search-  
ing Authority (see Section 502) or to the International Bureau (Section 403). The  
only time limit for the request is indicated indirectly in Rule 40.2(c), since the  
request must evidently reach the International Bureau before the communication under  
Article 20 is made (together with which the requested notification of the protest  
must be communicated). If it is felt necessary, a recommendation to the applicant  
could be made in the Guidelines for Applicants to submit his request to the Inter-  
national Searching Authority only together with the protest and later preferably  
directly to the International Bureau, but as soon as possible and at the latest  
when he receives his copy of the search report under Rule 44.1.

[Annex B follows]



## ANNEX B

## PROPOSALS FOR NEW ADMINISTRATIVE INSTRUCTIONS

The test results include proposals for new Administrative Instructions to:

- (GB)  
(US) (i) provide a procedure in respect of how and in what manner the payment, non-payment and underpayment of fees (e.g., basic and designation fees) should be handled;
- [Comment: The need for any provision to supplement PCT Rule 15, which already appears adequate, would require further consideration.]
- (GB) (ii) provide a procedure with respect to who refunds the fees;
- [Comment: The need for any provision to supplement PCT Rules 15.6, 16.2 and 16.3, which already appears adequate, would require further consideration.]
- (SW) (iii) provide a procedure wherein a receiving Office can carry out corrections of minor defects in an international application (e.g., sheets not connected as prescribed and sheet numbers which are not properly placed) without an invitation to an applicant for such corrections;
- [Comment: such a procedure, if considered necessary, would require an amendment of the Regulations since such corrections made without obtaining the approval of the applicant might affect the latter's rights.]
- (GB)  
(US) (iv) provide a comprehensive procedure with respect to how different types of amendments should be entered by the receiving Office and the International Bureau;
- [Comment: It should be studied whether the present provisions (Rule 26.4 and 26.5 and Section 206 of the Administrative Instructions) should be supplemented by such an Administrative Instruction.]
- (DT)  
(US) (v) provide a procedure to permit subsequent changes regarding the Applicant, Inventor, Agent, etc., to be recorded in the Request Form;
- [Comment: It would need to be studied to what extent such a provision is actually needed and useful.]
- (DT) (vi) provide a procedure to permit punching the filing date and file number information into all incoming documents;
- [Comment: An express provision does not seem necessary. It is to be assumed that this will be done in the framework of normal processing.]
- (DT) (vii) provide an indication as to whether time limits set by a receiving Office for an applicant to respond to an Article 14 check should be extended or a new time limit set in the case where the International Bureau or the International Searching Authority discovers additional defects in connection with such Article 14 check;
- [Comment: This would have to be done by an amendment of the Regulations.]

- (SW) (viii) provide illustrations which inform applicants how to number sheets and lines of an international application without violating PCT Rule 11.6 on margins;
- [Comment: Information of this kind, if thought necessary, would be more appropriate for inclusion in the Guidelines for Applicants.]
- (SW) (ix) provide for clarification of the concept "reasonably uniform international publication" under PCT Rule 26.3;
- [Comment: This could be better clarified in the Guidelines on Publication under the PCT and appropriate guidance provided in the Guidelines for Applicants and Receiving Offices, if considered necessary.]
- (x) provide applicants with sufficient information with respect to partial payment of designation fees under PCT Rule 15.5(a) i.e., information concerning:
- (1) the number of times an applicant may change those States originally designated in the international application in the case where partial payment of the designation fees is to be applied; and
  - (2) whether an applicant must indicate the specified designated States only in the international application or otherwise.
- [Comment: This might be better studied in relation to Guidelines for Applicants.]
- (JA) (xi) provide for headings at the beginning of each element of the international application, with the exception of the drawings;
- [Comment: The use of appropriate headings should be regarded as following, as a matter of course, from the existence of individual elements of the international application. It should be studied whether provisions on the use of the proposed headings on a uniform basis are necessary.]
- (JA) (xii) provide a separate Section of the Administrative Instructions containing the information presently existing on the supplemental sheet of the Request Form;
- [Comment: It seems unnecessary to repeat in the Administrative Instructions information included in the Request Form.]
- (US) (xiii) make provision for indicating exactly which papers (e.g., forms, responses from applicant, etc.) are to be forwarded by the receiving Offices with the record and search copies of the international application as well as to indicate exactly those papers which must be included in the various copies (e.g., home, search and record copies, certified copies, Article 13, 20, 22 and 25 copies);
- [Comment: Indications already exist in the provisions of the PCT or in the Administrative Instructions and the Forms thereunder regarding the forwarding of papers. A provision of the kind suggested could involve inflexibility which might be undesirable before practical experience has been gained. This matter should therefore best be left to internal instructions in the receiving Offices, or, if uniform rules are considered to be necessary, possibly to a recommendation in the Guidelines for receiving Offices.]

- (US) (xiv) provide for instructions that the international application number shall be placed on every sheet of every PCT form in order to insure correct association of different forms and their respective international applications;

[Comment: The necessity for an Administrative Instruction of this kind appears to be doubtful. If the proposed system were to be retained, provision for the proposed numbering could be made in some appropriate Forms, if thought necessary, without a specific provision in the Administrative Instructions.]

- (IB) (xv) provide for instructions to an International Searching Authority regarding the completion of the international search report Form in the case of "priority claims considered not to have been made";

[Comment: The necessity for an Administrative Instruction of this kind requires further consideration and study, particularly as to whether this could not be better dealt with through notes on the Form or in the Guidelines on Searching.]

- (US) (xvi) provide instructions for the receiving Office to make a notation in the Request Form beside the name of the addressee for mailing purposes;

[Comment: It seems doubtful whether this requires an Administrative Instruction; if desirable, it could be dealt with through appropriate layout of the Request Form.]

- (US) (xvii) provide a procedure concerning powers of attorney and revocations of power of attorney to clarify the question of who may be the addressee in the case of a defective power of attorney or a revocation of power of attorney to take care of the following situations:

- (1) if a power and a revocation are simultaneously submitted and only the revocation is defective;
- (2) if a power and a revocation are simultaneously submitted and only the power of attorney is defective;
- (3) if an agent or attorney withdraws; and
- (4) if a change in common representation takes place, (i.e., to indicate how such change should be effected and, particularly, in the case where the common representative is the first named applicant in the application.)

[Comment: The situations contemplated would rarely occur and in any event would, if necessary, have to be dealt with in the Regulations.]

- (SU) (xviii) provide a procedure for a receiving Office in accordance with which it may draw the attention of the applicant to defects in the international application in spite of the fact that the finding of such defects is a responsibility of the International Searching Authorities.

[Comment: An Administrative Instruction does not seem necessary to enable this to be done.]

[Annex C follows]

## ANNEX C

PROPOSALS OF A GENERAL NATURE ON THE PCT FORMS AND PROPOSALS  
FOR THEIR REVISIONGeneral Comments

General comments and proposals for revision of the current PCT Forms, presented by the participants of the Test Program, may be summarized, as follows:

- (GB) (i) during international testing of Forms, it was found that, in most  
(OE) instances, the Forms were very useful;  
(US)
- (US) (ii) international application numbers should be placed on each sheet of  
every Form;  
[Comment: As to (ii), see comment in relation to item (xiv) in  
Annex B.]
- (GB) (iii) the numbering of Forms should follow the sequence of their use;  
[Comment: This could be inconvenient, particularly in the case of the  
subsequent addition or deletion of Forms. Offices could, in any event,  
group Forms according to different steps in the PCT procedure. The  
question could be studied after some experience has been gained.]
- (GB) (iv) the notes to the Forms should be eliminated and the pertinent Articles,  
(US) Rules and Administrative Instructions cited on the front face of the  
Forms;  
[Comment: This might be difficult from the viewpoint of layout and there-  
fore requires further discussion and study. The inter-relationship of  
various provisions may be more readily understood if they appear in  
logical sequence on the back of the Forms. The notes would seem to  
facilitate in particular the work of smaller Offices acting as receiving  
Office or designated Office.]
- (US) (v) the notes to the Forms should be identified by the particular box to  
which they relate;  
[Comment: This would seem to be a more complicated system and would  
need further study to determine its practicality, even if considered  
desirable.]
- (DT) (vi) the Forms should contain data report groups to facilitate the future use of  
Electronic-Data-Processing Systems;  
[Comment: A study might be necessary to see whether this would be pos-  
sible with differing EDP systems.]
- (DT) \*(vii) the Forms should contain space for the applicant's file number;
- (DT) (viii) provision should be made for automatic addressing of the Forms;  
[Comment: Further study might be required before this could be done, if  
considered desirable.]
- (DT) (ix) the Forms should be assembled according to the different copies required  
for applicants, the International Bureau, the receiving Office, etc., to  
facilitate batch mailing and processing;  
[Comment: See comment under (iii) above. If desirable this could be  
arranged internally by Offices.]

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\* Taken into account in the revision of the PCT Forms.

- (SW) \* (x) the Forms must conform to both vertical and horizontal typewriter spacing;  
(US)  
(SW) \* (xi) the check-boxes on all Forms should be enlarged;  
(SW) \* (xii) the boxes of all Forms should be separated by only a thick black line;  
(US) (xiii) those Forms pertinent to review under Article 25 should include a proviso indicating applicant's right to review;

[Comment: This might tend to encourage a too frequent use by applicants of this exceptional possibility which would be detrimental for the efficiency of the system.]

- (SU) (xiv) those Forms which are filled in by the applicant should be made on white paper (Forms PCT/IB/328 and PCT/IPEA/401).

[Comment: This should be discussed, once a decision has been taken making the color of the Forms mandatory.]

#### Proposals for Revision of Specific Draft PCT Forms

##### PCT/RO/101 - Request

Redesign the content and layout of this Form as follows:

- (US) (i) revise the last sheet to indicate it is clearly the last sheet;  
[Comment: The sheets of the Request Form as now revised have preprinted numbers. The fee calculation sheet which follows carries the indication that it is not part of the international application.]
- (US) \* (ii) revise the Fee Calculation Sheet to indicate that it is not to be counted as part of the international application for fee determination nor numbered in the sequential numbering of sheets in the international application;
- (US) (iii) revise the headings of Boxes I to XI to include references to pertinent Articles, Rules and Administrative Instructions and modify the notes to the Form on a box-by-box basis;  
[Comment: Space consideration may not permit this to be done. See also the comments in respect of items (iv) and (v) under "General Comments" above.]
- (US) (iv) include a statement in the notes to the Form or the Guidelines for Applicants (document PCT/AAQ/VII/2), that such notes should not be sent by the applicant to the receiving Office with the international application;  
[Comment: It would seem to be sufficient to include such a statement in the Guidelines for Applicants, if thought necessary.]
- (OE)  
(SW)  
(US) \* (v) substitute a highly visible check box in each box identified by a roman numeral for the small dotted lines and place a notation beside the check box concerning additional information on the supplemental sheet;
- (SW)  
(US) \* (vi) redesign Box I and all following boxes, as well as the spacing between boxes, to conform to standard vertical typewriter spacing and provide locating marks to aid initial alignment;
- (US) \* (vii) redesign Box IV (Agent) to include a notation for the common representative as well as to point out the addressee for correspondence;  
[Comment: The latter part of this proposal (relating to the addressee for correspondence) is not in compliance with Rule 4.17 and has not been taken up.]

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\* Taken into account, as far as possible, in the revision of the PCT Forms.

- (US) \* (viii) redesign the Box for the international application number by dividing such box horizontally by light face or dotted lines and print the information in those partitions in small light-face characters;  
[Comment: The latter part of this proposal (concerning the printing of information in small light-face characters) has not been implemented since no significant space saving was afforded.]
- (US) \* (ix) locate together all information in Box II (Applicant) with respect to nationality and residence, required by PCT Rule 4;
- (OE) \* (x) redraft Box VI (Priority Claim) to eliminate any confusion on the part of the applicant with respect to completion of this Box and, additionally include a reference to PCT Rule 4.10(b)(i) in the notes to the Form;  
(SW)  
(US)
- (US) (xi) provide for instructions in the notes to the Forms in regard to Box VII (Parent Application or Grant) for an application to distinguish between a parent application and parent grant and how to associate a correct number and date with either type of application or grant or both, and, additionally, modify the headings in this Box.  
[Comment: Provision could be made for this in the Guidelines for Applicants, if thought necessary.]
- (JA) (xii) provide for instructions in the notes to the Forms to clarify the filling of Box IX (Different Applicants for Different Designated States) and Box X (Different Inventors for Different Designated States) (i.e., that Boxes IX and X should be filled in only on the basis of the information taken from Boxes II (Applicant), III (Inventor) and V (Designated States)).  
[Comment: Provision could be made for this in the Guidelines for Applicants, if thought necessary.]
- (US) \* (xiii) redesign the check list Box to provide additional space for item 8 in part "(B)" and additionally include information in the notes to the Forms with respect to other types of documents which may accompany the application on filing;  
[Comment: The latter part of this proposal (relating to inclusion of information in the notes to the Forms with respect to other types of documents which may accompany the application on filing) was not taken up since this would appear to be more appropriately made by internal instructions.]
- (DT) \* (xiv) increase the size of Boxes I and II for longer titles and longer postal addresses;
- (GB) \* (xv) provide for space to indicate applicant's or agent's reference file number;
- (GB) (xvi) adapt this Form for stamping by an accounting machine of the amount of fee paid;  
[Comment: It might be necessary to study whether this is possible having regard to differences in machines.]

PCT/RO/102 - Notification Concerning Payment of Transmittal, Search and International Fees

Redesign the content of this Form as follows:

- ) (i) provide reasons to the applicant why his calculation of fees was incorrect;  
)  
(US) (ii) include information with respect to deposit accounts, and  
)  
) (iii) provide for special adaptation of this Form for different national laws.

[Comment: This might tend to make the Form unduly complicated. It has been provided for by an appropriate footnote indicating that part of the Form is dependent on the provisions of the national law.]

\*PCT/RO/104 - Notification that the Purported International Application is not Treated as an International Application

Redesign the content and layout of this Form as follows:

- (US) vertically align the check boxes and the beginning of the dotted lines on which dates are to be indicated and, additionally, modify the notation at the bottom of the Form to insure that in all cases the Form is sent to the International Bureau.

[Comment: The latter part of this proposal (concerning modification of the notation at the bottom of the Form) has not been taken up since it would need to be discussed whether such a refinement is necessary.]

\*PCT/RO/105 - Notification of the International Application Number and of the International Filing Date

Redesign the layout of this Form as follows:

- (US) modify this Form to include space for the title of the invention and any claimed priority date.

PCT/RO/106 - Invitation to Correct Defects in the International Application

Redesign the content and layout of this Form as follows:

- (i) condense the first two pages into one page to increase the space provided for in Annexes A and B;
- (ii) add a third Annex for indicating additional defects, as well as a continuation sheet;
- (US) (iii) modify the last paragraph of page (b) to provide the applicant with instructions in the case of the defect of lack of signature;
- (iv) indicate a date of receipt and that the application is a purported international application for those receiving Offices which may telescope Article 11 and 14 checks;
- (v) revise Annex B to include the case wherever reference signs in the drawings are not mentioned in the description;
- [Comment: It would need to be discussed whether the further refinements ((i) to (v)) proposed above are necessary.]
- (OE) \*(vi) provide more space for "further specifications" at the bottom of the page in Annexes A and B;
- (DT) (vii) provide for a reference to the exact page of the international application objected to in Annexes A and B and also provide a heading for other defects in the Request or other defects not mentioned in Annexes A and B;
- (GB) (viii) provide for more space for defects than those provided for in Annexes A and B by adding a further Annex C.

[Comment: It would need to be discussed whether the further refinements proposed under items (vii) and (viii) are necessary.]

\*PCT/RO/107 - Notification of Non-Inclusion of Drawings with the International Application

Redesign the layout of this Form as follows:

- (US) modify the second paragraph by splitting it into three parts for the sake of clarity.

---

\* Taken into account in the revision of the PCT Forms.

PCT/RO/108 - Invitation to Request Rectification

Redesign the layout of this Form as follows:

- (US) \* (i) relocate the first paragraph to provide more space for certain errors of transcription.
- (US) (ii) provide information to advise the applicant to which Authority he must request rectification of each specific error.

[Comment: It needs to be studied whether this change is necessary and, if thought desirable, could not be replaced by an appropriate sentence in the relevant Guidelines.]

\*PCT/RO/109 - Notification of Decision Concerning Request for Rectification

Redesign the layout of this Form as follows:

- (US) rearrange items 1 and 2 for more space and say (at the bottom of the form) that the notification should be sent with the attachment, if any.

PCT/RO/110 - Invitation to Correct Priority Date

Redesign the content of this Form as follows:

- (US) provide for an indication of the effects of a cancellation of a priority claim on the time limits based on the priority date by adding to the bottom of the Form that, "... SHOULD THE PRIORITY CLAIM IN QUESTION BE CANCELLED, THE EARLIEST REMAINING PRIORITY CLAIM, IF ANY, OF THE INTERNATIONAL FILING DATE, WILL BE CONSIDERED TO BE THE "PRIORITY DATE" FOR PURPOSES OF CALCULATING TIME UNDER THE TREATY ... ."

[Comment: This would have to be provided for by a change of the Regulations if thought desirable; see comment in Annex A under Section 302.]

PCT/RO/111 - Notification of Corrections or Cancellation of Priority Claim

Redesign the contents of this Form as follows:

provide for an indication of the effects of a cancellation or corrections of a priority claim on the time limits based upon the priority date by adding below the check boxes at the bottom of the Form the following:

"ACCORDINGLY, HENCEFORTH THE NOTE THAT IS CONSIDERED TO BE THE "PRIORITY DATE" FOR PURPOSES OF CALCULATING TIME LIMITS UNDER THE TREATY IS:

- (US) THE CORRECTED DATE INDICATED UNDER (1) ABOVE
- THE INTERNATIONAL FILING DATE OF THE APPLICATION
- THE DATE OF THE EARLIEST PRIORITY CLAIM REMAINING IN THE APPLICATION, THAT IS .....

[Comment: Same as under PCT/RO/110.]

PCT/RO/112 - Notification Concerning Expressions, etc., Not to be Used in the International Application

Redesign the layout of this Form as follows:

- (US) provide for a check list similar to Annexes A and B in Form PCT/RO/106 to permit entry of all defects under PCT Rule 9.

[Comment: This could be achieved by an internal instruction within the receiving Office.]

PCT/RO/113 - Request for the Recording of Change in the Person, Name or Address of Applicant

Redesign the layout and content of this Form as follows:

- (US) \* (i) include a reference to residence and nationality on this Form, and
- (US) (ii) also cover the situation where the indication of the applicant that was previously missing has now been supplied.

[Comment: This could be achieved by internal instructions within the receiving Offices]



\*PCT/RO/116 - Notification of Designations Considered to be Withdrawn

Redesign the layout of this Form as follows:

- (US) provide for more space between the first and second paragraphs to permit entry of numerous withdrawals and include a reference to the right of review under Article 25.

[Comment: As to the second point, see the comment in respect of item (xiii) under "General Comments" above.]

\*PCT/RO/117 - Notification that International Application Considered to be Withdrawn

Redesign the layout of this Form as follows:

- (US) revise the indications that provide for delayed payment of fees due upon filing to permit the use of this Form in the case where national law is inconsistent therewith.

[Comment: This has been provided for by an appropriate footnote indicating that part of the Form is dependent on the provisions of the national law.]

PCT/RO/118 - Notification Concerning Documents Transmitted

Redesign the content of this Form as follows:

- (US) (i) revise to provide for instructions for sake of clarity whenever certain items in the Form are checked.

[Comment: It is doubtful whether this is necessary. See also comment in respect of Forms PCT/RO/123 and 124 below.]

- (US) \*(ii) add an item 10 to accommodate other types of documents.

- (DT) \*(iii) enlarge the column (Applicant) on page (b)

- (OE) \*(iv) enlarge the column for "Type of Document" on page (b) and combine into a single column those columns provided for "International Application No. and International Filing Date."

PCT/RO/120 - Invitation to Pay Fee for Preparation of Copies

Redesign the content of this Form as follows:

- (US) include a penalty for lack of payment on the part of an applicant.

[Comment: This would require an amendment of the Regulations--it is not possible in the Administrative Instructions or the Forms.]

PCT/RO/121 - Notification that Priority Claim Considered Not to have been Made

Redesign the content of this form as follows:

- (US) add a paragraph to explicitly state the date considered to be the "priority date" for purposes of calculating time limits as follows:

ACCORDINGLY, HENCEFORTH THE DATE THAT IS CONSIDERED TO BE THE "PRIORITY DATE" FOR PURPOSES OF CALCULATING TIME LIMITS UNDER THE TREATY IS:

THE INTERNATIONAL FILING DATE OF THE APPLICATION

THE DATE OF THE EARLIEST PRIORITY CLAIM REMAINING IN THE APPLICATION, THAT IS ... .

[Comment: Same as under PCT/RO/110.]

---

\* Taken into account in the revision of the PCT Forms.

PCT/RO/123 - Notification of Power of Attorney or Revocation of Power of Attorney

Redesign the content and layout of this Form as follows:

(US) consider combining this Form with PCT/RO/118 (Notification Concerning Documents Transmitted),

[Comment: A separate Form is considered necessary, having regard to PCT Rule 90.3(b) and 90.4(b).]

PCT/RO/127 and 128 - Notification of Decision not to issue Declaration that International Application Considered Withdrawn and Invitation to Pay for Requested Documents

(US) Eliminate these Forms and replace with a blank form.

[Comment: These Forms may be useful, at least for some Offices.]

PCT/ISA/201 - International-Type Search Report

Redesign the content of this Form as follows:

(US) (i) rewrite notes "(1)" and "(2)" to contain only information pertinent to an international-type search report;

[Comment: It is considered that the notes concerning international search reports are pertinent.]

(US) \*(ii) provide a space for information similar to information referred to in Box VIII on the Request Form (PCT/RO/101);

(US) \*(iii) include in Box II (Fields Searched) a provision to cite searches made in non-minimum patent documentation or any non-patent literature.

\*PCT/ISA/204 - Invitation to Comment on Abstract

(US) Provide increased space following the first paragraph of this Form relating to the content and form of the abstract.

PCT/ISA/206 - Invitation to Pay Additional Fees

Redesign the content of this Form as follows:

(US) \*(i) provide for more space to enter reasons for lack of unity of invention;

(US) \*(ii) provide for a sentence to indicate any claims considered to be unsearchable under Article 17(2)(b);

(iii) provide instructions that apprise the applicant of his circumstances and rights as to whom he should submit his request to have any protest and decision thereon transmitted to the designated Offices.

[Comment: See comment in Annex A in relation to Sections 403 and 502 of the Administrative Instructions.]

PCT/ISA/208 - Notification of Action Taken Concerning Comments on Draft Translation

Redesign the content of this Form as follows:

(US) revise items 1 and 2 to adequately distinguish those situations where some, all or no comments have been incorporated with respect to the draft English translation of the international application.

[Comment: It is not thought that such a change is necessary.]

---

\* Taken into account in the revision of the PCT Forms.

PCT/ISA/210 - International Search Report

Redesign the content and layout of this Form as follows:

\*Box III

(SW) Enlarge the text and check boxes in Box III (Title, Abstract and Figures of Drawings) as well as Boxes IV and V on the supplemental sheet;

[Comment: The part of this proposal concerning the enlargement of the text has not been implemented since insufficient space was available.]

Box IV

(US) \*(1) Reverse Boxes IV and V on the supplemental sheet for the sake of clarity and also change the wording in these relocated Boxes, as follows:

"This Searching Authority found multiple inventions in this International Application. These inventions and the claims drawn thereto are listed as follows:

(1) As all required additional search fees were timely paid by the applicant, this International Search Report covers all searchable claims of the international application.

(2) As only some of the required additional search fees were timely paid by the applicant, this International Search Report covers only those claims of the international application for which fees were paid, specifically claims:

(US) (3) No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claim numbers:

Remarks on Protest

(1) The additional search fees were accompanied by applicant's protest.

(2) No protest, accompanied by payment of additional search fees."

(ii) indicate in item 2 of Box IV whether a protest has been submitted to the International Searching Authority.

[Comment: It is thought that this indication would seem to be superfluous under "Remarks on Protest"]

\*Box V

The wording of the sentences within Box V should be changed as follows:

"This International Search Report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

(US) (1) Claim numbers----, because they related to subject matter not required to be searched by this Authority, namely:

(2) Claim numbers----, because they relate to parts of the application that do not comply with the prescribed requirements to such an extent that a meaningful search can be carried out, specifically:"

\*Box VI

(SW) Rearrange the text at the bottom of Box VI (Documents Considered to be Relevant) in tabular form.

PCT/ISA/211 - Notification of Transmittal of Requested Copies of Cited Documents

(US) Eliminate this Form.

[Comment: It is thought that this would require further examination.]

PCT/ISA/213 - Notification of Refund of Search Fee

Eliminate this Form, permitting each International Searching Authority to design its own form to its own needs.

[Comment: It is considered that this Form may be useful.]

PCT/ISA/215 - Notification of Certain Defects in the International Application

Incorporate the comments under Form PCT/RO/106, where applicable.

[Comment: It would be desirable to study further whether such a refinement of this Form is necessary.]

PCT/ISA/216 - Invitation to Request Rectification

Redesign the contents of this Form as follows:

provide information for the situation where several errors of transcription are contained in one application and those errors are identified by the International Searching Authority to advise the applicant to which Authority he must request rectification of each specific error.

[Comment: It needs to be studied whether this change is necessary and if thought desirable, could not be replaced by an appropriate sentence in the relevant Guidelines.]

PCT/ISA/218 - Notification Concerning Expressions, etc., Not to be Used in International Applications

(US) Incorporate the comments under Form PCT/RO/112, where applicable.

[Comment: See comments in relation to Form PCT/RO/112.]

PCT/ISA/219 - Notification Concerning Documents Transmitted

(US) Incorporate the comments under Form PCT/RO/118, where applicable.

[Comment: See comments above on Form PCT/RO/118.]

\*PCT/ISA/220 - Notification of Transmittal of the International Search Report or the Declaration

Redesign the content and layout of this Form as follows:

(US) include a check box and note that the protest and decision thereon is being transmitted with the international search report in accordance with the applicant's instruction.

PCT/ISA/221 - Invitations to Pay for Requested Copies of Cited Documents

(US) Abolish this Form.

[Comment: It is considered that this Form may be useful.]

\*PCT/IB/303 - Request for Copy of Papers

(US) Redesign this Form to be similar to PCT/IB/311 so that one or a number of copies of purported international applications may be requested.

PCT/IB/306 - Notification of the Recording of a Change in the Person, Name, or Address of Applicant

(US) Incorporate the comments under Form PCT/RO/113 where applicable.

[Comment: See comments above on Form PCT/RO/113.]

PCT/IB/310 - Notification Concerning Document Transmittal

Redesign the content of this Form as follows:

- (US) provide a parenthetical note for each addressee at the bottom of the page to alert clerical personnel as to whom, and under what circumstances each of the documents mentioned in items 1 to 7 is mailed.

[Comment: Further study seems necessary whether this could not better be dealt with by internal instructions.]

\*PCT/IB/311 - Request for Copy of Translation

Redesign the content of this Form as follows:

- (US) change the title of the first column to singularize "copies" and state the language version of "the copy" requested.

(US) \*PCT/IB/312 - Notification of Transmittal of Requested Copies of Translations

Incorporate the comments under Form PCT/IB/311, where applicable.

PCT/IB/313 - Notification of Certain Defects in the International Application

Incorporate the comments under Form PCT/RO/106 where applicable.

[Comment: see comments above on Form PCT/RO/106.]

PCT/IB/314 - Invitation to Request Rectification

- (US) incorporate the comments under Form PCT/RO/108 where applicable.

[Comment: see comments above on Form PCT/RO/108.]

\*PCT/IB/315 - Notification of Decision Concerning Request for Rectification

- (US) Incorporate the comments under Form PCT/RO/109 where applicable.

PCT/IB/316 - Invitation to Correct Priority Date

- (US) Incorporate the comments under Form PCT/RO/110 where applicable.

[Comment: see comments above on Form PCT/RO/110.]

PCT/IB/317 - Notification of Correction or Cancellation of Priority Claim

- (US) Incorporate the comments under Form PCT/RO/111 where applicable.

[Comment: see comments above on Form PCT/RO/111 and 110.]

PCT/IB/318 - Notification that Priority Claim Considered Not to have been Made

- (US) Incorporate the comments under Form PCT/RO/121 where applicable.

[Comment: see comments above on Form PCT/RO/121 and 110.]

\*PCT/IB/321 - Notification of Facts which should have Precluded the According of an International Filing Date

Redesign the content of this Form as follows:

- (US) include a reference to PCT Rule 30.1 that sets forth the time limit for finding Article 14(4) defects.

---

\* Taken into account in the revision of the PCT Forms.

PCT/IB/325 - Notification that International Application Considered to be  
Withdrawn by the Receiving Office

(US) Include an indication of the applicant's right to review by the designated Offices under Article 25 and of the time limits for such review.

[Comment: see the comment in respect of item (xiii) under "General Comments" above.]

PCT/IB/326 - Notification that International Application Considered to be  
Withdrawn by the International Bureau

(US) Include an indication of the applicant's right to review by the designated Offices under Article 25.

[Comment: see the comment in respect of item (xiii) under "General Comments" above.]

[Annex D follows]

## ANNEX D

## PROPOSALS FOR NEW PCT FORMS

Proposals were made for useful new PCT Forms, as follows:

- (OE) \* (i) a notification to the applicant that any letter of correction submitted by him was unsigned, including information for him on how to correct this particular defect;
- [Comment: It would seem that the latter part of the proposal (on how the applicant should correct particular defects) should better be included in the Guidelines for Applicants, if thought necessary]
- (OE) (DT) \* (ii) a blank Form which could be utilized for those situations not covered  
(OE) (US) by the PCT Forms (e.g., to notify the applicant of the deletion of additional matter in the Request under Section 303 of the Administrative Instructions);
- (US) \*(iii) request for the recording of changes in information concerning the inventor and addresses of attorneys or agents, similar to present Form PCT/RO/113, entitled Request for the Recording of Change in Person, Name or Address of Applicant;
- (US) (iv) notification concerning later submission of designation fees similar to present Form PCT/RO/102, entitled, Notification Concerning Payment of Transmittal, Search and International Fees;
- [Comment: A special Form is not considered to be necessary since it is covered by Form PCT/RO/102 and a reminder notification does not appear to be justified.]
- (v) notification concerning additional physical defects such as non-use of metric designations, improper claim numbering, etc.
- [Comment: A special Form is not considered to be necessary.]
- (SU) (vi) notification to the applicant concerning procedures in the receiving Office in respect of PCT Rule 4.17(b) and corrections of the check-list under PCT Rule 3.3(b).
- [Comment: It would be desirable to study the usefulness of such a form.]

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\* Taken into account in the revision of the PCT Forms.

[Annex E follows]

Test of PCT Procedures through  
Simulated PCT Procedures

JF/pa

let 2585-081.3

November 11, 1975

Dear Mr. Comte,

With reference to the informal meeting held on Monday, November 3, 1975, concerning the program for testing of certain aspects of the PCT procedure through simulated PCT procedures as reflected in documents PCT/AAQ/VI/9, 11, 12 and 21, I am pleased to transmit to you the attached minutes of such meeting as well as the general ground rules of the program.

I should also like to take this opportunity to express my appreciation to the Bureau fédéral de la propriété intellectuelle de Switzerland, on behalf of the IIB International Bureau, for its willingness to participate in this program.

I am, of course, at your disposal for any further information you might wish to obtain regarding the program.

With best wishes,

Sincerely,

J. Franklin  
Counsellor  
Head, PCT Section  
Industrial Property Division

Mr. J. L. Comte  
Directeur-adjoint  
Bureau fédéral de la  
propriété intellectuelle  
Eschmattstrasse 2  
3003 Berne

1. An informal meeting was held on November 3, 1975, among those participants of the PCT Interim Committees interested in participating in the test of certain aspects of PCT procedures through simulated PCT procedures, in a similar manner as reported in documents PCT/AAQ/VI/9, 11 and 12.

2. In this connection, the Delegations of Austria, Japan, Sweden, Switzerland, the United Kingdom, the United States of America and the Representative of the IIB agreed to participate in the test program already under progress between the Patent Office of the Federal Republic of Germany and the State Committee for Inventions and Discoveries of the USSR Council of Ministers.

Test PCT Applications

3. With respect to the make-up of PCT applications, it was agreed that only two of the existing Soviet Office test applications identified by way of example as "A" and "B" and two of the existing test applications of the United States Office, identified as "X" and "Y", would be used.

Roles to be Played

4. The various Offices involved in the test program will play the roles of the applicant, receiving Office and International Searching Authority.

Receipt of Test Applications Prior to  
Commencement of Test Program

5. The Offices of the Soviet Union and the United States of America will, prior to commencement of the test program, directly mail the above identified test applications (referred to in paragraph 3) to each participant in the test program acting as applicant, receiving Office and International Searching Authority. Thereafter, upon commencement of the test program, each

PCT/AAQ/VII/10  
ANNEX E



Office acting as an applicant will file the application in the proper receiving Office, see examples below :

Further Clarification and Illustrations of Pairings and Poles to be Played by Participants in the Test Program

- |    |   |  |
|----|---|--|
| 6. | <u>Applicant</u><br>United Kingdom<br>Files "A" and "X" | <u>Receiving Office</u><br>Switzerland |
|    | <u>Applicant</u><br>Switzerland<br>Files "B" and "Y"    | United Kingdom                         |

For the purpose of the Test Program, the IIB will only act as the International Searching Authority for the Offices of Switzerland and the United Kingdom.

- |    |  |                                   |
|----|--|-----------------------------------|
| 7. | <u>Applicant</u><br>Austria<br>Files "A" and "X" | <u>Receiving Office</u><br>Sweden |
|    | <u>Applicant</u><br>Sweden<br>Files "B" and "Y"  | Austria                           |

For the purpose of the Test Program, the Offices of Austria and Sweden will also act as an International Searching Authority for those applications filed in their Offices.

- |    |   |   |
|----|---|---|
| 8. | <u>Applicant</u><br>Germany (Federal Republic of)<br>Files "X" and "Y"      | <u>Receiving Office</u><br>Soviet Union |
|    | <u>Applicant</u><br>Soviet Union<br>Files "A" and "B"<br>(previously filed) | Germany (Federal Republic of)           |

For the purpose of the Test Program, the Offices of Germany (Federal Republic of) and the Soviet Union will also act as an International Searching Authority for those applications filed in their Offices.

- |    |  |   |
|----|--|---|
| 9. | <u>Applicant</u><br>Japan<br>Files "A" and "B"         | <u>Receiving Office</u><br>United States of America |
|    | <u>Applicant</u><br>United States<br>Files "X" and "Y" | Japan   |

For the purpose of the Test Program, the Offices of Japan and the United States of America will also act as an International Searching Authority for those applications filed in their Offices.

Summary of Mailing of Test Applications by the Soviet Union and the United States of America

10. Prior to commencement of the program and in view of the above illustrations, the Office of the Soviet Union will mail their existing test applications as follows :

| <u>Application</u> | to | <u>Office</u>  |
|--------------------|----|----------------|
| A                  | to | Austria        |
| A & B              | to | Japan          |
| B                  | to | Sweden         |
| B                  | to | Switzerland    |
| A                  | to | United Kingdom |

11. Likewise, the Office of the United States of America will mail their existing test applications as follows :

./.

| <u>Application</u> |    | <u>Office</u>                 |
|--------------------|----|-------------------------------|
| X                  | to | Austria                       |
| X & Y              | to | Germany (Federal Republic of) |
| Y                  | to | Sweden                        |
| Y                  | to | Switzerland                   |
| X                  | to | United Kingdom                |

Names of Addressees Acting as Applicants

11. For the purpose of this report, the following persons have agreed to act as the applicant and receive all correspondence under the test program on behalf of their respective Offices. The Offices were able to give specific names of all persons (acting as applicants), subject to further correction, if any.

12. The addressees acting as applicants are as follows :

Austria

Mr. G. Gall  
Head of Division  
Federal Ministry for Trade and Industry  
Section for Industrial Property  
Kohlmarkt 8-10  
Postfach 95  
A - 1014 Vienna

Germany (Federal Republic of)

Mr. U. C. Hallmann  
Regierungsdirektor  
German Patent Office  
Zweibrückenstrasse 12  
8000 Munich 2

Japan

Mr. K. Hoshikawa  
Counsellor for PCT-TRT  
Administration Department  
Japanese Patent Office  
3-4 Kasumigaseki 3-chome  
Chiyoda-ku  
Tokyo

Soviet Union

Mr. Y. M. Buryak  
Head, International Patent Cooperation Division  
All-Union Research Institute of State Patent Examination  
24 Berezhkovskaya Nab.  
Moscow

Sweden

Ms. B. Sandberg  
Legal Advisor.  
Royal Patent & Registration Office  
Valhallavägen 136  
P.O. Box 5055  
S-102 42 Stockholm 5

Switzerland

Mr. J.-L. Comte  
Directeur-adjoint  
Bureau fédéral de la propriété intellectuelle  
Eschmannstrasse 2  
3003 Berne

United Kingdom

Mr. R. W. Heinink  
Room 308  
The Patent Office  
25 Southampton Buildings  
London WC2A 1AY

United States of America

Commissioner of Patents and Trademarks  
c/o Louis O. Maassel  
Room 3-11D07  
U.S. Department of Commerce  
Patent and Trademark Office  
Washington, D.C. 20231

International Patent Institute (IIB)

Mr. J. A. H. Van Voorthuizen  
Deputy Technical Director  
International Patent Institute  
Patentlaan 2  
Rijswijk (Z.H.)

Assumed Rules Governing Test Program

1. All test applications would be directly forwarded to all participating Offices by the Soviet Union and the United States Offices as soon as possible and as previously summarized in paragraphs 10 and 11, respectively.
2. Some sort of schedule of fees would be assumed to provide training for their computation, but NO fees would be transmitted.
3. Wherever no particular form exists to carry out an essential communication of the Test Program, a blank form would be used to facilitate the test.
4. Any form utilized may be photocopied for economy's sake and to avoid destroying complete sets of forms.
5. The Test Program commences January 5-9, 1976.
6. The Test Program terminates May 15, 1976.
7. Actual searches of the prior art would not be mandatory.
8. Patents, etc. would be cited in the international search report form to gain experience in filling out the form.
9. Names and addresses of applicants would be those listed in paragraph 12.
10. Actual dates of mailing would be used.
11. Actual PCT time limits as governed by the PCT Regulations would apply, if practicable only.
12. Cover letters accompanying the mailing of any forms would not be used.
13. Notwithstanding the fact that corrections on the part of an applicant would not, in practice, be carried out, a simulated communication to that effect would be mailed.
14. The Office playing the part of applicant would fill in the Request form.
15. The final test results arrived at by each Office would be communicated to the WIPO International Bureau as soon as possible after completion of the test program.
16. The WIPO International Bureau would play its role as the International Bureau under the PCT.
17. The program would not include international publication.
18. The number of designated Offices would not exceed 4 or 5, but such Offices would receive the necessary communications in accordance with the PCT.

7.



WORLD INTELLECTUAL PROPERTY ORGANIZATION  
ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

Circular No. 2468  
PCT 081.3

April 7, 1976

Sir,

The PCT Interim Advisory Committee for Administrative Questions, at its sixth session held in Geneva from October 29 to November 3, 1975, expressed the opinion that the testing of the Draft Administrative Instructions, including the PCT Forms, for their compliance with practical requirements, through simulation of PCT procedures (the "test program"), should be actively continued, and placed such test program on its own program for 1976 (paragraphs 131 and 135(vi) of document PCT/AAQ/VI/21).

Upon the conclusion, on May 15, 1976, of the test program, in which your Office has been participating, the International Bureau would appreciate receiving the comments of your Office and any additional information available to it concerning the Administrative Instructions under the PCT (document PCT/AAQ/VI/2) and the Draft Forms under the Administrative Instructions (documents PCT/AAQ/VI/3, 4 and 5), in the light of its experience of the test program.

It would be appreciated if you could send the comments and additional information mentioned above to us by June 15, 1976, in order to facilitate the revision of the Administrative Instructions and the Forms in time for them to be sent to States members of the Interim Committee well before its November 1976 session.

Sincerely yours,

A handwritten signature in cursive script, appearing to read "E. M. Haddrick".

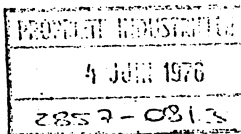
E. M. Haddrick  
Head, PCT Division

[Annexe G suit/Annex G follows]

Wien, am May 31, 1976  
Telefon 333636-0  
627751-0

- 2 -

GR 997/76-29



Mr. Murray Haddrick

World Intellectual  
Property Organization  
Geneve

Dear Mister Haddrick,

I have the honour to communicate to you the comments of the Austrian Patent Office concerning the Administrative Instructions and the Draft Forms under the Administrative Instructions under the PCT in the light of our experiences in the PCT-test program.

In general, both the Administrative Instructions and the Draft Forms were found to be very useful and there are just a few remarks to be made:

1) Administrative Instructions:

a) As to Section 307, we agree with the opinion of the US-Patent Office expressed in Document PCT/AAQ/VI/12 that the concept of a provisional numbering system could be dropped.

b) Section 311: the proposal of the State Committee for Inventions and Discoveries of the USSR Council of Ministers (Document PCT/AAQ/VI/13) concerning another system of numbering of sheets of the international application in a provisional manner seems to be useful.

2) Draft Forms:

a) A form for notification of the applicant that his letter of correction was unsigned and informing him how to correct this defect might be useful.

b) In Form PCT/RO/106, annex the space provided for "further specifications" was found to be too small.

c) In Form PCT/RO/101 the "check boxes" referring to additional information on the supplemental sheet being too small are easily overlooked.

d) In Form PCT/RO/118(b) the column provided for "Type of Document" should be wider, the columns provided for "International Application Nr." and "International Filing Date" could therefore be combined to one single column.

e) In Form PCT/RO/101, box VI, the free space after the sentence "the priority of the following earlier application is claimed" should be avoided as the applicant might take this as an invitation to fill in there the title of the priority application.

f) A "blank" form including only the boxes for the address, identification etc. could be applied for cases not covered by special forms.

Sincerely yours,

*Dr. Schmeiser*

Dr. Schmeiser  
Vizepräsident

DEUTSCHES PATENTAMT

Der Leiter  
der Rechtsabteilung

8000 MÜNCHEN 2, den June 24, 1976  
Zweibrückenstraße 12  
Fernruf (0811) 21951 Fernschreiber 05-23534  
Fernmeldedurchwahl (0811) 2195 Hausruf

PROPRIÉTÉ INDUSTRIELLE  
28 JUN 1976

9330/10 (11) - 3.1.3. Bd XIII 9a

Mr. E.M. Haddrick  
Head of PCT Division  
World Intellectual Property  
Organization (WIPO)  
32, chemin des Colombettes  
CH - 1211 Genève 20  
- Schweiz -

PROPRIÉTÉ INDUSTRIELLE  
28 JUN 1976  
PCT 28610 & 1.2

"A Reading Attachment For Beds That Allows Patients To  
Read Without Sitting Up And Makes Use Of A Multi-Purpose  
Light Source"  
file number PCT/SU 76/00004

3) as "designated Office"  
for the patent applications

- |                 |                 |
|-----------------|-----------------|
| PCT/GB 76/00001 | PCT/JA 76/00002 |
| PCT/GB 76/00002 | PCT/CH 76/00001 |
| PCT/SW 76/00002 | PCT/US 76/00002 |
| PCT/DT 75/00002 | PCT/OE 76/00002 |
| PCT/DT 75/00003 | PCT/SU 76/00004 |
|                 | PCT/SU 76/00005 |

Re: PCT Test Program  
Ref.: WIPO Circular 2583-031.3 of November 11, 1975 and  
2468-031.3 of April 7, 1976

Dear Sir,

In the framework of the above-mentioned Test Program the  
German Patent Office participated in the following test  
applications:

- 1) as "receiving Office"  
for the Russian patent applications  
"Cyanuric Acid Derivative Containing Oxogroup",  
file number PCT/DT/00002 and  
  
"The Coal Plough"  
file number PCT/DT/00003
- 2) as "applicant"  
for the two US patent applications  
"A Self-locking Pipe Clamp Field Welding"  
file number PCT/SU 76/00005 and

As to 1) The German Patent Office has examined both Russian  
patent applications according to the provisions of  
the PCT-Treaty and conducted the necessary corres-  
pondence with the "applicant" using the PCT-forms.

Moreover, the Berlin Branch Office of the German  
Patent Office has carried out two test searches in  
its capacity as "International Searching Authority".

As to 2) The German Patent Office has filed the said US patent  
applications with the State Committee of the Council  
of Ministers of the USSR for Inventions and Discov-  
eries by using the prescribed PCT-forms and has con-  
ducted the necessary correspondence with the "receiv-  
ing Office".

As to 3) The German Patent Office has reviewed the information  
received by the International Bureau on the designa-  
tion as "designated Office". Copies of the respective

PCT/AAQ/VII/10  
ANNEXE H/ANNEX H

applications have not been submitted to the German Patent Office within the Test Program.

Upon conclusion of this Test Program the experiences gained therefrom may be summarized as follows:

A) Forms

Principally it may be said that the current draft PCT forms are only conditionally suitable for treatment in the German Patent Office. This is due to the fact that the draft forms are set up in accordance with the Treaty, i.e. they correspond essentially to the procedure provided for in the Treaty, the Regulations and the Administrative Instructions whereas the national Offices are not organized for the procedure of international applications under PCT, they are in their organization rather adapted to the national procedure. For this reason and in order to guarantee a rational processing, the forms should not be prescribed to the national Offices as mandatory. This would moreover have the advantage that those forms for which, by reason of the number of new PCT applications to be expected, there will be no printed forms, could be prepared in the framework of the computerized text processing. Moreover the national Offices must have the possibility of maintaining their proven forms of organization and operational sequence also as far as the international procedure is concerned. Exceptions could be made for the request (PCT/RO/101), the search report form (PCT/ISA/210), the request for the international preliminary examination (PCT/IPEA/401) as well as for the international preliminary examination report (PCT/IPEA/409).

As far as the contents of the forms is concerned, the adoption of the individual texts as binding formulation is possible.

Regardless of whether the forms should be adopted as mandatory for all national Offices or whether they could be adapted to the respective national requirements, the following comment is given on the forms based on the experiences gained during the Test Program:

- a) They do not contain any data report groups which would facilitate the future use of EDP-systems.
- b) There is no space for any possible file numbers of the applicant.
- c) In the case of longer titles column I of the forms PCT/RO/101 and PCT/IPEA/401 is too small; the "address" box in column II is not sufficient for the correct postal address.
- d) An automatic addressing of the forms is not possible.
- e) On the form PCT/RO/106a Annex A and B no reference is possible e.g. to the exact page objected against or to the enclosed photostats. To facilitate the work the indication of the numbers of pages would be desirable.  
  
The form PCT/RO/106a should have a box for "other defects" as for example errors in the "Check list", the request or other not specifically mentioned defects.
- f) The column "Applicant" in the form PCT/RO/118b is too small; if the form, as obviously planned, is

used for collective dispatches, the specific evidence of the dispatch or the date thereof is missing in the respective files.

- g) A blank form with the standard information of the respective applications should be established for those cases which were not yet covered by forms.
- h) It should be considered, whether forms of which different copies are required for applicants, the International Bureau, the receiving Office, file etc. could be combined to sets of forms so that required copies could be prepared in one process.
- i) In a number of forms the column "Name and Mailing Address" is too small.
- j) The form 118a contains the following printing errors:
  - 1) Under item 5 either the reference to Rule 26.4c is wrong or it should read "which have not been considered withdrawn";
  - 2) Under item 8 the Sections of the Administrative Instructions cited ought to read correctly 309 b iii and c ii;
  - 3) Under item 9 reference to the Administrative Instructions should read 310 b iii and c ii.

B) Administrative Instructions

In the course of the Test Program it became apparent that the Administrative Instructions in the version of the third revised draft including the changes adopted during the Sixth Session of the Interim Advisory Committee for Administrative Questions did not show any major defects.

Some suggestions and proposals of amendment are mentioned below:

- a) Section 313 does not provide for the case that the control list is filled in by the applicant, however, the information contained therein is not consistent with the actually submitted documents. In such a case the receiving Office should correct the indications and inform the applicant accordingly (see also "forms" item e)).
- b) From Section 311 it is not quite clear how to proceed in the case of exchanged or newly added pages, in particular which marks and notes the original pages should contain. A redrafting of this Section would be desirable.
- c) The Administrative Instructions do not provide that subsequent changes in the person or the address of the applicant and representative should also be recorded in the original request. For reasons of work simplification the most current state of these data should always result from the request, either by correcting the request itself or by indicating the page number of the request for the amendment.



- d) In order to facilitate the introduction of and a uniform handling of the Administrative Instructions it is suggested to indicate in all Sections providing for a notification of the applicant, of an international authority or of the International Bureau, the number of the form to be used.
- c) The Administrative Instructions should provide for the possibility of punching into all incoming documents the filing date in the form of Arabic numerals of the day, of the month and of the last two digits of the year and possibly also of the file number.

C) Miscellaneous

- a) In the course of the Test Program it showed that in respect to objections according to Article 14 the following situation might result:

The receiving Office notifies the applicant of any objections according to Article 14 PCT on form PCT/RO/106a and forwards to the International Bureau and to the International Searching Authority the "record copy" or the "search copy", respectively. Still during the time limit granted by the receiving Office for the correction of the defects according to Article 14, the International Bureau, on form PCT/IB/313, and possibly the International Searching Authority, on form PCT/ISA/215, communicate any defects noted by them according to Article 14, which will mostly be consistent with those of the receiving Office. Therefore, in most

[Annexe I suit/Annex I follows]

of the cases duplication of work could be avoided, if the International Bureau and the Searching Authority would be informed in addition to the communication provided for in Rule 26.1 b) on all defects already objected against by the receiving Office (eventually by a copy of form PCT/RO/106a).

If, however, the International Bureau or the International Searching Authority discover additional defects, then it will have to be clarified whether the time limit already granted by the receiving Office could be extended by reason of the new notification according to Article 14, or if new time limits for the answer (in the most unfavorable case up to three simultaneously running time limits) have to be granted.

- b) In order to facilitate the work of the applicants and of the respective international authorities it is suggested to enclose with the application guidelines samples of a filled-in request and of a request for preliminary international examination.

Sincerely yours,

*Ulrich C. Hallmann*

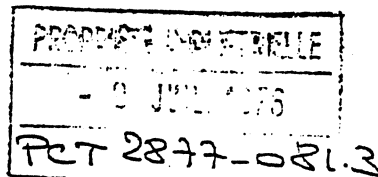
Hallmann

PATENT OFFICE  
JAPANESE GOVERNMENT

4-3, Kasumigaseki 3-chome  
Chiyoda-ku, Tokyo, Japan

TOKU SO 720/51  
July 5, 1976

Mr. E.M. Haddrick  
Head, PCT Division  
World Intellectual Property Organization  
32, chemin des Colombettes  
1211 Geneva 20, Switzerland



Dear Sir:

I have the pleasure of presenting our comments on the PCT test program as requested by your Circular No. 2468 PCT 081.3 of April 7, 1976.

We believe the program has been very meaningful as, by the test, many problems were discovered in the Draft Administrative Instructions.

By carrying out the test program, we arrived at the conclusion that new provisions as mentioned in the separate enclosure are desirable.

We have always insisted that the number of forms of obligatory nature should be limited and by the implementation of the test program, we feel that our stand was confirmed to be correct.

It seems that in the interpretation for incomplete mention concerning the inventor, and for judging whether the physical requirements in PCT Art. 14 (1) (a) (v) are fulfilled (Rule 11), there seem to be some differences between our Office and other Offices.

For the former problem, we understand that by the PCT regulations, the receiving Office is not obliged to check the incomplete mention concerning the inventor; and for the latter problem, we believe we should always keep in mind the existence of the provision of Rule 26.3 in making the decision.

Yours truly,

*K. Hoshikawa*

Kazuo Hoshikawa  
Counsellor in charge of PCT-TRT  
General Administration Department

1) Provisions concerning the procedure for the receiving Office, should there be defects in the mention of the designated states by the applicant in the application paper:

i) When an indication of designated states is ambiguous and a receiving Office cannot judge what that indication is meant to designate in the application paper, that receiving Office can ex officio delete such an indication and notify the applicant of the fact.

ii) If the defect in the indication is slight (for instance, a misspelling) the receiving Office may correct it ex officio and notify the applicant of the fact.

2) Provisions for the following instances, if the applicant specifies the states (designated) mentioned in PCT Rule 15.5 (a):

i) For the period or the number of times the applicant specify the states (in connection with the time of payment of the designation fee, in particular).

ii) For a concrete method of specifying the states (whether in the application paper or otherwise).

iii) For the case when specifying of states is done on other than the application paper, and the designated state indicated in the application paper and that indicated in other paper are not identical.

3) Provision concerning the mention of designated states running over to the continuation sheet:

i) When the designated states are mentioned onto the continuation sheet, such countries should be given successive numbers following those on

the first sheet in the same box as on the first sheet.

4) Provision concerning the indication of the title of each element of an international application:

i) At the beginning of each element of an international application, with the exception of drawings, a title of each element should be mentioned.

5) Provision for filling in Box IX (Different Applicants for Different Designated States) and Box X (Different Inventors for Different Designated States):

i) What should be mentioned in Box IX and Box X such as the applicants, the inventors and the designated states should previously be mentioned in their corresponding boxes, that is, Box II for the applicant, Box III for the inventor and Box V for the designated state.

6) Further provision for the indication of dates:

Detailed rules must be made in Part 1 of Administrative Instructions for indication of dates in connection with an international application when each international authority indicates dates.

7) Provision concerning the notes to be indicated to top of the continuation sheet:

The above notes should be specified as an independent section in the Administrative Instructions.

Translation

State Committee for Inventions and Discoveries of the USSR  
Council of Ministers, Moscow

No. 45-6/444  
YG/ip

July 19, 1976

Dear Mr. Haddrick,

In response to your letter of April 7, 1976, No. 2468, I am sending you the observations of the State Committee for Inventions and Discoveries of the USSR Council of Ministers in respect of draft Administrative Instructions under the PCT and PCT Forms arising from the practice of participation in PCT Test Program.

Sincerely yours,

V. Bakastov  
Head of Examination  
Department  
of the State Committee

Mr. M. Haddrick  
Head of PCT Division  
WIPO  
Geneva  
Switzerland

Observations of the State Committee for Inventions and Discoveries of the USSR Council of Ministers in Respect of Draft Administrative Instructions under the PCT and PCT Forms Arising from the Practice of Participation in PCT Test Program

In the opinion of the State Committee for Inventions and Discoveries of the USSR Council of Ministers implementation of the PCT Test Program, contemplated by the sixth session of the PCT Interim Committee for Administrative Questions in October-November 1975 was an extremely useful activity, promoting both the preparation of further proposals in respect of perfection of the Administrative Instructions under PCT and PCT Forms, and preparation of Offices to use PCT procedure.

In particular, the PCT Test Program in our Office was implemented by a group of officials, organized to carry out functions of a "receiving Office" and PCT formalities in addition to the group established earlier to organize the international search and examination. All this allowed to train a newly established group to carry out the work under the PCT.

The State Committee for Inventions and Discoveries of the USSR Council of Ministers making in addition to the proposals introduced earlier (see documents PCT/AAQ/VI/13 and 14) certain proposals concerning amending of Administrative Instructions under the PCT and PCT Forms as well as certain observations relating to Regulations under the PCT at the same time considers that at the present stage of an active preparation for PCT implementation it could be very important to establish the final drafts of the Administrative Instructions under the PCT and PCT Forms by means of a reasonable mutual compromise of the Offices participating in the discussion. It could allow to start preparation for publication of the PCT Forms in working languages of the PCT.

Comments on Regulations and Patent Cooperation Treaty

(i) Rule 11.7(b) determines that the numbers of the sheets of international application should be placed at the top of the sheet in the middle but not in the top margin (see in particular French text). Taking into account Rules 11.7(a) and 11.6(a) and (b) it could mean that numbers of the first sheet of elements of international application should be placed considerably lower than the numbers of the rest of the sheets and it will create difficulties for processing of the applications.

It could be useful in future to establish the same place to put numbers for all sheets of the international application.

(ii) Rule 11.9(d) admits in principle typing of the text of the application by different characters (for instance by using capital letters to draw attention to certain sentences and passages of the description).

Although such marking does not prevent reproduction it creates difficulties for processing of the application and in general does not comply with the usual practice of the publication of the descriptions of the inventions.

It could be useful in future to recommend to use one character to type the text of a given international application.

Comments on the Administrative Instructions under the PCT (document PCT/AAQ/VI/2)

In our opinion it could be useful that the receiving Office if it finds that the application contains certain defects which this Office is not obliged to note (for instance non-compliance

with consistency of units of weights and measures, temperatures etc., as well as vagueness and insufficiency of description and claims) should inform the applicant about this fact in order that to allow the applicant to decide whether he will meet with corresponding observations of International Searching Authority.

For this purpose it is proposed to insert in the Administrative Instructions Section 317 as follows:

"If a receiving Office during processing of the application finds defects, finding of which is a responsibility of the International Searching authority, it may inform the applicant of its finding."

Comments on PCT Forms (document PCT/AAQ/VI/3, 4 and 5)

(i) It is proposed to draft a new Form to cover the case provided in Section 303 of the Administrative Instructions concerning notification of the applicant about procedures in the receiving Office under Rule 4.17(b). The same Form could contain information in respect of filling by the receiving Office of the check-list in the Request under Rule 3.3(b), when this list was not filled by the applicant or in respect of correction of the list when the number of the sheets received in the international application does not correspond to the number of sheets indicated in the check-list. Such information could be useful for the applicant as an additional check for completeness of his international application.

(ii) In the opinion of the State committee for Inventions and Discoveries of the USSR Council of Ministers the Forms PCT/IB/328 and PCT/IPEA/401 should be drafted on white paper since they should be filled by the applicant.

The recommendation adopted earlier in respect of the desirability to have forms of different colors concerned the forms used by different PCT Authorities and such a recommendation should not apply to the applicant.

In addition, use of different color forms will create difficulties to find in the file of the application documents originating from the applicant.

(iii) Specific observations of the drafting nature were made by hand on the annexed forms PCT/RO/120, PCT/ISA/216, PCT/ISA/222, PCT/IB/304, PCT/IB/336, PCT/IPEA/408, PCT/IPEA/413.

PATENT COOPERATION TREATY

|  |  |   |  |
|--|--|---|--|
| TO   |  | FROM                                    | the RECEIVING OFFICE<br><small>Identified at the bottom of this page</small> |
| INVITATION TO PAY FEE FOR<br>PREPARATION OF COPIES<br><small>Issued pursuant to PCT Rule 21.1(e) <sup>(3)</sup></small>  |  |   |  |
| <small>Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT <sup>(1)</sup></small>  |  | DATE OF MAILING by the Receiving Office |  |
| IDENTIFICATION OF THE INTERNATIONAL APPLICATION  |  |   |  |
| International Application No.  |  | International Filing Date               |  |
| Applicant (Name)   |  |   |  |
| INVITATION   |  |   |  |
| <p>This Receiving Office calls applicant's attention to the fact that the filing of the above-identified international application in ..... (number of) copies which is less than the number of copies required <sup>(2)</sup> necessitated the preparation of ..... (number of) additional required copies for which a fee in the amount of ..... is due. <sup>(3)</sup></p> <p>CONSEQUENTLY THE APPLICANT IS HEREBY INVITED TO PAY TO THIS RECEIVING OFFICE THE AMOUNT DUE WITHIN ..... (MONTH) (DAYS) FROM THE DATE OF MAILING INDICATED ABOVE. <sup>(3)</sup> PAYMENT BY <input checked="" type="checkbox"/> CHEQUE, POSTAL MONEY ORDER, BANK DRAFT, CASH, REVENUE STAMPS, DEBITING DEPOSIT ACCOUNT NO. ...., COUPONS, ETC. <input checked="" type="checkbox"/> SHOULD BE MADE TO <input checked="" type="checkbox"/> THE ACCOUNT OF, ACCOUNT INDICATED BELOW OF, ORDER OF <input checked="" type="checkbox"/> THIS RECEIVING OFFICE.</p> <p>Computation of the time limit starts on the day following the date of mailing of the present invitation. <sup>(4)</sup> Within this time limit the required amount has to be paid to this Receiving Office.</p> <p><i>Failure to do so shall result in the international application being considered withdrawn (Art. 17(1)(b))</i></p> |  |   |  |
| THE RECEIVING OFFICE   |  |   |  |
| Name and Mailing Address   |  | Authorized Officer                      |  |

PATENT COOPERATION TREATY

|  |  |  |   |
|--|--|--|---|
| TO   |  | FROM   | the INTERNATIONAL SEARCHING AUTHORITY<br><small>Identified at the bottom of this page</small> |
| INVITATION TO REQUEST RECTIFICATION<br><small>Issued pursuant to PCT Rule 91.1(d), second sentence <sup>(2)</sup></small>  |  |  |   |
| <small>Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT <sup>(1)</sup></small>  |  | DATE OF MAILING by the International Searching Authority |   |
| IDENTIFICATION OF THE INTERNATIONAL APPLICATION  |  |  |   |
| International Application No.  |  | International Filing Date                                |   |
| Applicant (Name)   |  |  |   |
| INVITATION   |  |  |   |
| <p>This International Searching Authority has discovered in the above-identified international application/in other papers submitted by the applicant that appears to be an obvious error of transcription as specified hereafter:</p> <p style="text-align: center;">THE APPLICANT IS HEREBY INVITED TO REQUEST THE RECTIFICATION OF THE SAID ERROR <sup>(2)</sup></p> <p>The request for rectification is to be submitted to: <sup>(3)</sup></p> <p><input type="checkbox"/> the Receiving Office (at the following address)</p> <p><input checked="" type="checkbox"/> <i>this</i> the International Searching Authority</p> <p><input type="checkbox"/> the International Bureau (at the following address)</p> <p>WIPO<br/>32 chemin des Colombettes<br/>1211 Geneva 20<br/>Switzerland</p> |  |  |   |
| THE INTERNATIONAL SEARCHING AUTHORITY  |  |  |   |
| Name and Mailing Address   |  | Authorized Officer                                       |   |

PATENT COOPERATION TREATY

TO   FROM THE INTERNATIONAL SEARCHING AUTHORITY  
Identified at the bottom of this page

INVITATION TO PAY FEE FOR PREPARATION OF DRAFT TRANSLATION

Issued pursuant to PCT Rule 48.3(b) <sup>(2)</sup>

DATE OF MAILING by the International Searching Authority:  

Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT <sup>(1)</sup>  

IDENTIFICATION OF THE INTERNATIONAL APPLICATION

|                               |                           |
|-------------------------------|---------------------------|
| International Application No. | International Filing Date |
| Applicant (Name)              |                           |

INVITATION

This International Searching Authority will, upon receipt of payment of a fee in the amount of \_\_\_\_\_, undertake the responsibility of preparing a draft translation of the above-identified international application into the English language. <sup>(2)</sup>

THE APPLICANT IS HEREBY INVITED TO PAY THE FEE WITHIN ..... (DAYS) (MONTHS) FROM THE DATE OF MAILING INDICATED ABOVE. <sup>(2)</sup> PAYMENT MAY BE MADE BY [CHEQUE, POSTAL MONEY ORDER, BANK DRAFT, CASH, REVENUE STAMPS, DEBITING DEPOSIT ACCOUNT NO. ...., COUPONS, ETC.] TO THE [ACCOUNT OF, ACCOUNT INDICATED BELOW OF, ORDER OF] THE INTERNATIONAL SEARCHING AUTHORITY.

Computation of the time limit starts on the day following the date of mailing of the present invitation. <sup>(3)</sup> Within this time limit the payment has to reach this International Searching Authority.

*Failure to do so shall result in the International Searching Authority will notify the concerned office that it should make the finding that the international application is to be considered withdrawn (Art. 17.2)*

| THE INTERNATIONAL SEARCHING AUTHORITY |                    |
|---------------------------------------|--------------------|
| Name and Mailing Address              | Authorized Officer |

PATENT COOPERATION TREATY

TO   FROM THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

NOTIFICATION CONCERNING SUBMISSION OF PRIORITY DOCUMENT

Issued pursuant to PCT Rule 17.1 (c) <sup>(3)</sup> and Administrative Instructions, Section 411 <sup>(2)</sup>

DATE OF MAILING by the International Bureau  

Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT <sup>(1)</sup>  

IDENTIFICATION OF THE INTERNATIONAL APPLICATION

|                               |                           |                       |
|-------------------------------|---------------------------|-----------------------|
| International Application No. | International Filing Date | Priority Date Claimed |
| Applicant (Name)              |                           |                       |

NOTIFICATION

The applicant is hereby notified that, in respect of the certified copy of the priority document which is required to be submitted:

1.  the prescribed time limit has expired and no such copy has been submitted to the International Bureau <sup>(2)</sup> and any Designated State may disregard the priority claim.
2.  that copy has been received by the International Bureau on <sup>(3)</sup> \_\_\_\_\_

.....  
 (date of receipt of the certified copy)

That date of receipt was:

- a.  within the prescribed time limit <sup>(4)</sup>
- b.  not within the prescribed time limit and any Designated State may disregard the priority claim <sup>(4)</sup>

A copy of this notification has been sent <sup>(3)</sup> to:

all designated Offices

| THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION |                    |
|--|--------------------|
| Mailing Address<br>WIPO<br>32 chemin des Colombettes<br>1211 Geneva 20   | Authorized Officer |



PATENT COOPERATION TREATY

TO

FROM the INTERNATIONAL BUREAU of the  
WORLD INTELLECTUAL PROPERTY ORGANIZATION

NOTIFICATION OF DEFECTS IN DEMAND

Issued pursuant to PCT Rule 60.1(d)

|  |   |
|--|---|
| IN ITS CAPACITY AS INTERNATIONAL<br>PRELIMINARY EXAMINING AUTHORITY  | DATE OF MAILING by the International Bureau |
| IDENTIFICATION OF THE INTERNATIONAL APPLICATION  |   |
| International Application No.  | International Filing Date                   |
| Applicant (Name)   |   |
| NOTIFICATION   |   |
| <p>The International Bureau has found that the Demand for the international preliminary examination of the above-identified international application is defective for the reasons indicated below.</p> <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> It does not contain the required petition. (Rules 53.2(a)(1), 53.3)</li> <li>2. <input type="checkbox"/> It does not contain the required indications concerning the applicant. (Rules 53.2(a)(11), 53.4)</li> <li>3. <input type="checkbox"/> It does not contain the required indications concerning the agent. (Rules 53.2(a)(11), 53.5)</li> <li>4. <input type="checkbox"/> It does not contain the required indications concerning the international application. (Rules 53.2(a)(11), 53.6)</li> <li>5. <input type="checkbox"/> It does not contain the election of at least one Contracting State bound by Chapter II. (Rule 53.2(a)(iv), 53.7)</li> <li>6. <input type="checkbox"/> It does not contain the required signature. (Rules 53.2(b)(iv), 53.8)</li> <li>7. <input type="checkbox"/> It is not submitted in the required language. (Rule 55.1)</li> <li>8. <input type="checkbox"/> It is not submitted in the required two identical copies. (Rule 53.1(d))</li> <li>9. <input type="checkbox"/> It is not made on the required printed form. (Rule 53.1(a))</li> </ol> <p>Other possible observations by the International Bureau concerning above-noted defects. (Specify)<br/><i>Consequently, the International Preliminary Examination Authority shall proceed as provided in the rule 60.1, par (a) to (e) (Rule 60.1(d))</i></p> |   |
| THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION   |   |
| Mailing Address<br>WIPO<br>32 chemin des Colombettes<br>1211 Geneva 20<br>Switzerland  | Authorized Officer                          |

PATENT COOPERATION TREATY

TO

FROM the INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY  
identified below

WRITTEN OPINION

Issued pursuant to PCT Rules 66.2(a)(b)<sup>(2)</sup> and 66.4(a)<sup>(3)</sup>

|  |  |
|--|--|
| Inscribe NAME and ADDRESS of the AGENT and if there<br>is no agent, of the APPLICANT <sup>(1)</sup>  | DATE OF FILING<br>by the International Preliminary Examining Authority |
| IDENTIFICATION OF THE INTERNATIONAL APPLICATION  |  |
| International Application No.  | International Filing Date  |
| Applicant (Name)   |  |
| Receiving Office   | Priority Date Claimed  |
| WRITTEN OPINION  |  |
| <p>With reference to the above-identified international application, this constitutes the (first, etc.)<sup>(3)</sup> written opinion by this International Preliminary Examining Authority.</p> <p>I. BASIS OF OPINION<sup>(4)</sup></p> <p>This written opinion has been established as if the following noted amendments had not been made since, for the reasons indicated, they have been considered as going beyond the disclosure as filed.</p> <p>II. NON-ESTABLISHMENT OF OPINION OF NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY<sup>(5)</sup></p> <p>The question whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable will not for the reasons indicated below be gone into in respect of:</p> <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> the above-identified international application.</li> <li>2. <input type="checkbox"/> claims Nos. _____ (specify particular claims).<br/><input type="checkbox"/> Said international application, or said claims Nos. _____ relate to the following subject matter<sup>(6)</sup> which does not require an international preliminary examination. (specify)</li> <li><input type="checkbox"/> The description, claims, or drawings (indicate particular elements) or said claims Nos. _____ are so unclear that no meaningful opinion could be formed.<sup>(7)</sup></li> <li><input type="checkbox"/> The claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed.<sup>(7)</sup></li> </ol> <p>III. NEGATIVE STATEMENT IN REGARD TO NOVELTY, INVENTIVE STEP AND INDUSTRIAL APPLICABILITY OF CLAIMS<sup>(8)</sup></p> <p>The statement under Article 35(2) should be negative in respect of the claims indicated below. The criteria not satisfied in respect of such claims are indicated by the letter abbreviation: N (for Novelty); IS (for Inventive Step); and IA (for Industrial Applicability).</p> |  |

IV. CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION<sup>(9)</sup>

Def. of Claim / Relevant Supporting Documents Cited/ Explanation

V. CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION<sup>(10)</sup>

The following defects in the form or contents of the above-identified international application under the Treaty or the Regulations have been noted.

VI. CERTAIN OBSERVATIONS ON THE INTERNATIONAL APPLICATION<sup>(11)</sup>

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, have been noted.

APPLICANT IS INVITED<sup>(12)</sup> TO SUBMIT A WRITTEN REPLY ACCOMPANIED BY AMENDMENTS OR CORRECTIONS<sup>(13)</sup>, WHERE APPROPRIATE, WITHIN \_\_\_\_\_ (MONTHS) (DAYS)<sup>(14)</sup> OF THE DATE OF MAILING INDICATED ON THE PREVIOUS PAGE.

THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

Name and Mailing Address

Authorized Officer

NOTICE TO APPLICANT BY LAW OFFICE OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

NOTIFICATION OF THE TOTAL OF REPRODUCED COPIES OF DOCUMENTS IN FILE (Text to be sent to IPEA only)

NOTIFICATION OF THE TOTAL OF REPRODUCED COPIES OF DOCUMENTS IN FILE (Text to be sent to IPEA only)

NOTIFICATION OF THE TOTAL OF REPRODUCED COPIES OF DOCUMENTS IN FILE (Text to be sent to IPEA only)

NOTIFICATION OF THE TOTAL OF REPRODUCED COPIES OF DOCUMENTS IN FILE (Text to be sent to IPEA only)

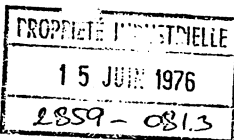
NOTIFICATION

This International Preliminary Examining Authority, in response to the request received, transmits herewith \_\_\_\_\_ (number of) copies of the following documents contained in the file of the above-identified international application.<sup>(2)</sup>

[Annexe K suit/Annex K follows]

PCT/AAQ/VIII/10  
Annexe J/Annex J  
page 7

1976-06-11



1 (3)

RY

PCT  
 E.M. Haddrick  
 Head, PCT Division  
 Industrial Property Division  
 32, chemin des Colombettes  
 1211 Genève 20 Schweiz

Dear Sir,

In reply to your letter of April 7, 1976 (Circular No. 2468/PCT 081.3) I want to express our appreciation of the initiative and realization of the testing of the Draft Administrative Instructions, including the PCT Forms, for their compliance with practical requirements through simulation of PCT procedures. We think that this "test program" has been of great value in general but has also brought the participating Patent Offices new interesting experience.

Our experience with the "test program" has caused us to make the following comments to the Administrative Instructions:

1. Where it does not have a substantial impact on the application the receiving Office in the Administrative Instructions ought to be given express authority to carry out unimportant corrections of a formal nature in the international application without any communication to the applicant, see e.g. form RO/106 Annex A: (g) The sheets are not connected as prescribed, (k) The sheet numbers are not properly placed, etc. As a comparison it may be pointed out that AI section 311 in the very last part of the sentence the receiving Office is already given the authority to renumber the sheets of the international application "for any other reason", i.e. reasons not specifically mentioned in the section.

2. Rules 11.7 and 11.8 of the Implementing Regulations are difficult to apply. The rules ought to be illustrated by models which show the applicants how to number sheets and lines without to encroach on the margins or to under-size them. It is suggested that the models shall be included in the Administrative Instructions.

3. If a receiving Office strictly follows the PCT-Convention the receiving Office shall according to art. 12 and rule 22 transmit the record copy to the International Bureau as soon as possible, or not later than thirteen months from the priority date. If the applicant has made full use of his priority year it is very likely that the receiving Office at this time already has made the art. 14-check of the application and also given the applicant an invitation to correct formal defects. But the applicant has not yet given the receiving Office his corrections, because the time limit of the invitation has not ended. Therefor the International Bureau may get defect record copies.

2

Anyhow by rule 28.1 the International Bureau gets the opportunity to notify the receiving Office of the deficiencies as evident from the record copy transmitted. During the "test-program" the experience as a receiving Office was that the examiner gave the applicant an invitation to correct some defects and at the same time transmitted the record copy without waiting for answer from the applicant. When the International Bureau got the record copy, the Bureau immediately started an art. 14-check of its own and notified the receiving Office its findings.

It would be more rational for the International Bureau to await the transmittal by the receiving Office of the corrections from the applicant whereupon it would notify the receiving Office of eventual defects still existing in the application. A recommendation to the International Bureau to proceed in this manner may be given in the Administrative Instructions.

4. Rule 26.3 says that the formal requirements according to rule 11 "shall be checked to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication". This gives rise to the following question. What does a "reasonable uniform international publication" mean? It seems advisable that a sort of standard is given in the Administrative Instructions which tells the receiving Offices the minimum and the maximum requirements according to rule 11 so that "the purpose of reasonably uniform international publication" will be established.

5. It is suggested that the indications of the forms (for ex RO/116) are put beside those sections of the Administrative Instructions which relate to a notification or an invitation to an applicant or an authority. The indication may be written immediately after the sentence which relates to the notification or invitation, or in the margin.

Comments to the Forms:

In some boxes the space is very narrow. We think that space could be saved if the space now existing between every box could be replaced by a thicker black line. This observation concerns especially the first pages of the Request Form and the International Search Report.

Further, the cross-boxes placed on the forms are too small. This fact causes the typists some trouble. When reading a form, it is often hard to distinguish a cross in a crossbox, especially on a fotocopy.

Further the spacing used in the forms does not conform with typewriter standards

Concerning the particular forms, the following details are suggested:

The Request.

1. The applicant has to specify the number of applicants,

ponse à signer

M. \_\_\_\_\_

ponse à préparer

M. \_\_\_\_\_

de priorité en

*S. Haddrick*

*H. Haddrick*

*E. Haddrick*

.....

.....

inventors etc at a place marked out by three dots followed by a sentence. It may not be clear to some applicants that it is the number of applicants, inventors etc which are to be given here, especially when the following sentence starts with a capital letter.

2. Box V concerns Designation of States. The box is prepared for the applicant to design seven (7) states. Anyhow it is hard for the typist to squeeze in the names of seven states in this space. It is suggested that box V will be prepared for six (6) designated states instead of seven.

3. Box VI concerns Priority Claim. The text on line two "The priority of the following earlier application is claimed:" ought to be moved to the middle of the line. Otherwise the applicant may be led to give some irrelevant information on this line.

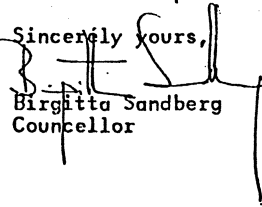
The International Search Report.

1. Box III concerns Title, Abstract and Figures of Drawing. The printed text in the box is too small, the crossboxes are too small and placed too narrowly. The box is not well designed for type-writing.

2. Boxes IV and V (supplemental sheet). See the same remarks made under the preceding part.

3. Box VI (last sheet). It is suggested that the final text in this box namely "Categories of cited documents:..." etc shall be placed in table form for easier readability.

Sincerely yours,

  
Birgitta Sandberg  
Councillor

[Annexe I suit/Annex I follows]

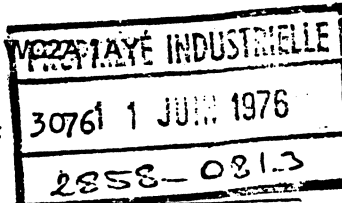


**THE PATENT OFFICE**

25 Southampton Buildings London

Telegrams Patoff London WC2

Telephone 01-405 8721 ext



**E M Haddrick Esq**  
**Head, PCT Division**  
**WIPO**  
**32 Chemin des Colombettes**  
**1211 GENEVA 20**  
**SWITZERLAND**

Your reference

Our reference **IPCD/41078**

Date **8th June 1976**

**Dear Mr Haddrick**

**PCT Simulated Test Procedure**

Further to your letter of 7th April 1976, I have pleasure in forwarding the comments of UK Patent Office, together with samples of our current file covers.

Yours sincerely

**R W Hsinink**

UNITED KINGDOM AS RECEIVING OFFICE

1. Test applications were received from Swiss Patent Office who were acting as applicants.
2. Numbering of documents - Current Administrative Instructions ( 307 ) call for documents to be numbered twice - the first time for provisional application and secondly after positive determination of date when the letters PCT have to be added in front of the provisional number. This can lead to confusion and in fact on one test application the letters PCT were placed on the front page only of the Request and omitted from the remainder of the pages. As an application is in the "provisional" stage for a very short time we think it would be better if an application could be numbered PCT from the outset and the provisional stage dropped.
3. Margins - the 2cm margin ( Rule 11.6 ) at the top of each sheet is insufficient to accommodate International Application number, date and office stamp on replacement sheets ( Administrative Instruction 307 ( b ) ). A top margin of at least 5cm on all sheets, except the front sheet of the description which can remain at 8cm would be preferable. The increased depth of margin would prevent the possibility of matter being defaced by office stamps and dates.
4. Renumbering of Forms - we suggest that the Receiving Office Forms 101 - 128 should be arranged in a more logical order. RO/101 is the Request and one of the first forms to be sent to the applicant is the receipt (Form RO/125) closely followed by the notification of International Application Number and date (Form RO/105). It is suggested that these forms be renumbered 102 and 103 respectively. The remainder of the forms could follow on from there.
5. Receiving Office Forms - these Forms were found generally useful but until one is familiar with them time can be wasted searching for one to fit a particular purpose, and some need adapting to meet the needs of each application problems and defects as they arise. For example, RO/106 leaves very little room for comments and there should be more room to point out other defects

than those allowed for in Annex A and B., such as when, to give a few examples, designation of states is not as prescribed, where inventors initials are given instead of full name (s), to point out that extraneous matter on Request has been deleted, or when the Request purports to appoint an agent but fails to file the power of attorney. These problems could be overcome by having a further Annex "C" ( mock-up "A" attached ) for use as and when required and adding an additional box referring to other defects on the second page of RO/106. The test also proved that it is a practical impossibility to design forms for all eventualities, and the need for a composite "blank" form becomes apparent. It is suggested that this composite "blank" form have the standard headings and the remainder left blank to enable it to be completed as required. (mock-up "B" attached).

6. Notes on Forms - while the notes proved very useful in these preliminary tests, we doubt whether they will be required once PCT gets under way, as most people who complete the Request and Forms will be "professionals" and will be familiar with the Treaty, Regulations and Administrative Instructions. It could be a considerable saving in printing and reproduction costs if Forms only cited the relevant Article, Rule or Administrative Instruction on the face of the form where appropriate and the notes were dispensed with.

7. Fees - current practice in the UK is to indicate the amount of fee paid by stamping the appropriate form in the top right hand corner by means of an accounting machine. There is no provision on the Request ( RO/101 ) for such a procedure, which would not appear to be allowable under PCT procedures. Thus, the only indication one has that fees have been paid is the fee receipt. The fee calculation sheet is a guide as to what should be paid, but if, for example, each fee is correctly shown but the payment is deficient how does one tell which fee is underpaid? Again if the amount of the basic fee were incorrectly shown but the designation fees were enough to pay it in full, should the basic fee be regarded as having been paid in full and one or more designation fees as being defective? Where an underpayment occurs the applicant could be in trouble and left with very little time to put matters right.

- 3 -

Applicant is told if he has overpaid his fees ( Form RO/102 )but who refunds the overpayment - there appears to be no provision for this ( Form RO/119 does not fit this bill ),

8. Amendments - our present UK practice is to allow amendments to be made in manuscript in the specification but under Rule 11.12 this will not be allowed except under exceptional circumstances, so for even minor amendments a new sheet will be required. This will be very time consuming, both from the applicants viewpoint and that of the office, as each new sheet will have to be checked. During a recent check on UK specifications which were in order for acceptance, (average length of each specification being 16.8 pages) more than 50% had 5 or less minor amendments in manuscript. A minor amendment was considered to be of up to 5 words per page. To avoid the necessity of new sheets for minor amendments it is suggested that provision be made under PCT Rules to allow minor amendments in manuscript, thereby saving both time and trouble. Under Receiving Office guidelines (AAQ/VI/Part 7 RO 10.3 and 12.4) RO can enter or effect corrections received from the applicant into the International Application.

9. File Covers - the test showed that present type of UK "shell" or file cover with single tag fastening could cope very well with the amount of paper comprising an application, providing the 2.5 margin on top left hand side is strictly adhered to. A sample file cover is attached.

UNITED KINGDOM AS APPLICANT

1. Specifications were received from the Soviet Union and United States of America and these were made into "applications" and sent to Swiss Patent Office who were acting as Receiving Office.
2. Request - It is not clear whether the fee calculation sheet should be regarded as part of the request and counted as a page for numbering. This could lead to confusion when completing the check list. It is also not clear in what order the sheets of the Request should be, as either the Supplemental or Continuation sheet could be counted as sheet 2,3 or 4.
3. Applicant's reference number - in one of our test cases we inserted the applicant's reference number on the Request Form in box II alongside the note re additional applicants, and although it was deleted by the Receiving Office under Rule 4.17 (b) it was quoted on receipt (Form RO/125) and therefore served its purpose. It would be most useful if this spare space could be utilised for the applicant's or agent's reference.
4. Priority dates - if an application in which the applicant has made an error with his priority date is delayed for any reason by the Receiving Office the applicant is left with very little or no time in which to put matters right. For example, in one of our test cases an interesting point arose whereby the priority date claimed was wrong and the application would have been out of time when received by the Receiving Office. However, they in turn also made an error and gave the application a date which put it back in time. No mention of the wrong priority date was made when the Receiving Office notified us of the date accorded the application on Forms RO/105 and RO/125, nor when we received Form RO/106 pointing out other defects. The first intimation we had that all was not well was a communication from the International Bureau ( some 12 weeks after the application was despatched to Receiving Office ) on Form IB/326 giving notification that the application was withdrawn, as the Record copy of the International application was received after expiration of the time limit. Although the applicant could exercise his rights under Rules 22.1 (b) and 22.2 (b)

and send copies of his application direct to the International Bureau, he would not appear to have any redress against the Receiving Office for delaying sending of Record copy.

5. Administrative Instruction references.- the A.I. references on Form RO/118 need amending.

INVITATION (Continued)

The international application

does not contain an indication of the title of the invention <sup>(8)</sup>

The international application

does not contain an abstract <sup>(9)</sup>

As to the prescribed physical requirements of the international application <sup>(10)</sup>

defects exist in the presentation of the text matter as specified in Annex A to the present invitation

defects exist in the presentation of the drawings as specified in Annex B to the present invitation

further defects exist in the presentation of the text matter/drawings as specified in Annex C to the present invitation

THE APPLICANT IS HEREBY INVITED TO CORRECT THE INTERNATIONAL APPLICATION WITHIN A TIME LIMIT OF ..... (DAYS) (MONTHS). <sup>(11)</sup> FAILURE TO DO SO SHALL RESULT IN THE INTERNATIONAL APPLICATION BEING CONSIDERED WITHDRAWN. <sup>(12)</sup>

This time limit counts from the date of mailing of the present invitation as indicated on the top of this page. Within the time limit the correction has to reach the undersigned Receiving Office.

Any correction offered to this Receiving Office may be stated in a letter provided that the correction is of such a nature that it can be transferred from the letter to the record copy without adversely affecting the clarity and the direct reproductibility of the sheet onto which the correction is to be transferred; otherwise, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

THE RECEIVING OFFICE

Name and Mailing Address

Authorized Officer



"B"

"A"

PATENT COOPERATION TREATY

PATENT COOPERATION TREATY

10

FROM the RECEIVING OFFICE identified at the bottom of this page

ANNEX C

OTHER DEFECTS IN THE PRESENTATION OF THE TEXT MATTER/ DRAWINGS OF THE INTERNATIONAL APPLICATION

|   |   |
|---|---|
| Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT | DATE OF MAILING by the Receiving Office |
|---|---|

| IDENTIFICATION OF THE INTERNATIONAL APPLICATION |                           |
|---|---------------------------|
| International Application No.                   | International Filing Date |
| Applicant (Name)                                |                           |

| NOTIFICATION |
|--------------|
|              |

| THE RECEIVING OFFICE     |                    |
|--------------------------|--------------------|
| Name and Mailing Address | Authorized Officer |

|  |
|--|
|  |
|--|

PCT/AAQ/VIII/10  
Annexe I/Annex I  
page 5

[Annexe M suit/Annex M follows]

PCT/AAQ/VII/10  
ANNEXE M/ANNEX M

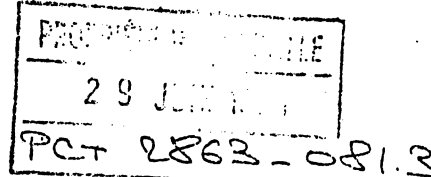


U.S. DEPARTMENT OF COMMERCE  
Patent Office

Address Only: COMMISSIONER OF PATENTS  
Washington, D.C. 20231

JUN 25 1976

Mr. E. M. Haddrick  
Head, PCT Division  
World Intellectual Property  
Organization  
32 chemin des Colombettes  
1211 Geneva 20  
Switzerland

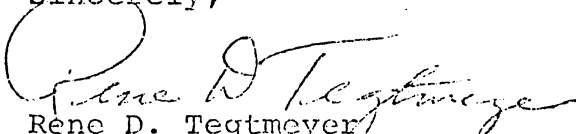


Dear Mr. Haddrick:

These comments and suggestions are being presented to WIPO for incorporation in the revision of the Administrative Instructions and forms that will be considered by the Interim Committee on Administrative Questions during its 1976 session. Extensive international, as well as in-house testing, of the PCT forms and procedures during the simulation of PCT procedures (the "test program") provided the basis for these comments and suggestions. As PCT will become operational in the near future, many comments relate to the further definition or clarification of procedures in anticipation of PCT implementation.

It is believed that the value of PCT will be in a large part determined by the relative ease and efficiency in handling of international applications by national offices at the Designated Office stage. Positive value can only be assured by consistent and efficient procedures at the earlier Receiving Office and International Search Authority stages. As much of the work of the Receiving Office and the support functions of the Searching Authority will be handled by personnel who will not have had a thorough grounding in the requirements of the Treaty, Regulations, and Administrative Instructions, many suggestions have been made in order to clarify the forms and procedures for PCT operational personnel. Processing areas where new Administrative Instructions are needed have been identified.

Sincerely,

  
Rene D. Tegtmeier  
Assistant Commissioner  
for Patents

COMMENTS ON THE ADMINISTRATIVE INSTRUCTIONS

Sec. 102. USE OF THE FORMS

Our comments on the optional and mandatory categories of forms will be forwarded as a separate paper.

Sec. 105. SEVERAL APPLICANTS

A sentence may be added to this section, stating --The name of the applicant first named should be followed by the phrase, "et al."--.

Sec. 106. COMMON AGENTS FOR SEVERAL APPLICANTS

The present wording of this section does not cover the situation where different applicants choose different agents or representatives. An appropriate reference to Rule 4.8(b) should be added to this section. See paragraphs 20, 21 and 22 of document PCT/AAQ/VI/21.

Sec. 201. DATES

In the international testing of PCT forms, there was great variety in the manner of indicating dates in the "date of mailing" boxes on each of the forms. As there will be a number of languages used in the forms, and that the date of mailing of a form may be one item of information that is to be reviewed by another authority or deciphered by the International Bureau, this section should be extended to cover those dates marked in the date of mailing boxes on the forms.

Sec. 202. NAMES OF STATES

The applicant has only one opportunity to designate those states in which it desires patent protection, and, in some cases, the full names or short titles as appearing in Annex A may be unfamiliar or not commonly used by the applicant. Therefore, the word "shall" in the first line of the first paragraph should be changed to the word --should-- and a paragraph added, stating that the Receiving Office shall ask the applicant for clarification of his designation in cases where there is confusion as to the applicant's intent. The penalty for lack of response to such inquiry would be cancellation of the designation. Additionally, Annex A could be amended to include commonly used names for various states.

Sec. 203. KIND OF PROTECTION

No "appropriate space" is provided on the Request form for the entry of the kind of protection under paragraph (b). Also, there is a lack of consistency between paragraphs (a) and (b) regarding placement of information. It would appear to be good practice to provide a single location for indicating the kind or kinds of protection sought.

Sec. 206. NUMBERING OF CLAIMS UPON AMENDMENT

The use of the words "previously" and "previous" in this section are unnecessary and potentially confusing. We suggest they be dropped.

This section assumes that any amendment to a claim will be submitted as a total rewriting of the claim on a separate sheet of paper. The amended portion, however, may consist only of a few words which can easily be transferred directly onto the original papers. Moreover, this section offers no guidance in how such amendments should be entered into the original case. For example, should the replacement sheet on which a single claim is rewritten be entered directly after the last sheet of claims or should a replacement sheet on which is contained the amended claim as well as relevant portions of the preceding or following claims be entered in place of the original sheet? If each amended claim is to be submitted on a separate sheet of paper inserted after the last original claim, how, upon initial reading of the text, is the reader's attention to be drawn to the fact that these claims have been amended? The original claim should be marked in some way to show that it has been replaced.

In the procedure required by this section, it is not clear if a notation "cancelled" is to be marked on the original sheet or if the notation is to appear as a single entry on a replacement sheet. The submission of a clean sheet of paper on which is written the claim number and the word "(Cancelled)" seems to be an unnecessary waste of paper and postage.

A standard method of entering this, as well as all types of amendments, should be clearly stated in the Administrative Instructions.

Sec. 207. COMMON REPRESENTATIVE DESIGNATED IN THE REQUEST

The common representative or the addressee should be indicated on the front sheet of the Request form. See paragraph 31 of document PCT/AAQ/VI/21.

Sec. 208. ARRANGEMENTS OF ELEMENTS AND NUMBERING OF SHEETS OF THE INTERNATIONAL APPLICATION

Because the Request form and the textual elements of the application may be typed at two different times or by different persons, and, in such instances the seemingly small details such as page numbering are often overlooked, consideration should be given to having two series of page numbers in each international application, one beginning with the Request; the other beginning with the description and including the other portions of the international application.

Sec. 302. NOTIFICATION OF PRIORITY CLAIM CONSIDERED NOT TO HAVE BEEN MADE

The problems involved in shifting the basis of timing of the application to a later priority date or the filing date when the earliest or the single priority date is withdrawn or changed by the applicant during international processing, and the implications of such a shift for searching and subsequent processing, should be thoroughly explored and procedures to be followed set forth in additional Administrative Instructions.

Sec. 303. DELETION OF ADDITIONAL MATTER IN THE REQUEST

It is noted that no form is provided for notifying the applicant under this section. In this situation, as well as others, a blank form having only the standard arrangement for addressee, application and Receiving Office identification and signature could be used with a short explanation merely being typed in. It may also be helpful to identify this blank form by using an unassigned form number, for example, PCT/RO/130.

Sec. 304. CORRECTIONS SUBMITTED TO THE RECEIVING OFFICE CONCERNING EXPRESSIONS, ETC., NOT TO BE USED IN THE INTERNATIONAL APPLICATION

Corrections submitted under this section will most often entail the deletion or change in a small portion of the Description. No procedures are given on how to indicate in the original papers that a deletion or change in wording has occurred. It would be of assistance to the International Bureau in preparing for publication if the Receiving Office would, upon identification of errors under Rule 9.1, make a notation in the right margin adjacent to such errors, and indicate any response from the applicant also in the right margin should the applicant submit corrections before the Record Copy is sent.

Sec. 307. SYSTEM OF NUMBERING INTERNATIONAL APPLICATIONS

The international testing of PCT forms and procedures has reinforced our opinion that the separate marking of "PCT/" before the provisional file number on all pages of the international application in order to convey filing date status

appears to be a complete waste of effort. In paragraph 35 of document PCT/AAQ/VI/21, the inclusion of "PCT/" in the international application number was pointed out as an extremely useful device in order to identify clearly the specific treaty under which the application originated. However, for those few applications which fail Article 11.1 and are reviewed by designated offices under Article 25, this notation "PCT/" will not appear.

We are of the strong opinion that an application number should not be used to convey status and that the notation "PCT/" should be placed in front of the international application number and the provisional file number. Should it be desirable to distinguish applications which fail Article 11.1 from those which have a filing date, the indication "PCT/" for those applications failing Article 11.1 could carefully be lined through. In this way, the majority of applications, i.e., those which pass Article 11.1 checks, will not have to undergo a second numbering of all pages of the application in order to place the notation "PCT/" in front of the originally stamped provisional file number.

Sec. 309. PROCEDURE IN THE CASE OF LATER SUBMITTED SHEETS

The question of the manner of presenting dates arises again under this section. Should abbreviations in the name of the month, or should an apostrophe instead of the first two digits

for the year be allowed? As it is the International Bureau that must decipher the various dating schemes of the many receiving offices, their processing needs, as well as the traditions and practices of the various receiving offices, should be considered.

A question also exists as to the method of entering a corrected filing date or date of receipt into the original application papers.

Sec. 310. PROCEDURE IN THE CASE OF MISSING DRAWINGS

It may be helpful to institute a procedure where the Receiving Office marks in the original papers the fact that drawings are missing and, after the expiration of the time limit for the applicant to submit the drawings, enters below the first markings either the fact that drawings were received on a certain date or the time limit has expired and no drawings were received.

Sec. 311. RENUMBERING OF SHEETS OF THE INTERNATIONAL APPLICATION

This section should be revised along the lines suggested by the Soviet Union in document PCT/AAQ/VI/13.

In the existing wording of the section, line 3, delete "any", and change "reason" to --reasons-- as the current wording connotes arbitrariness.

Sec. 312. NOTIFICATION OF DECISION NOT TO ISSUE DECLARATION THAT THE INTERNATIONAL APPLICATION IS CONSIDERED WITHDRAWN

The communication called for in this section may be adequately

handled by a blank form on which the Receiving Office could easily enter one or two lines of standard text. See comments relative to Section 303.

Sec. 406. PAMPHLETS AND SECTION 407, THE GAZETTE

It would be extremely helpful for the purposes of PCT planning if the International Bureau would make as one of the agenda items for this 1976 Interim Committee meeting a document describing the planned printing methods and format for the pamphlets and the Gazette. The system of printing to be used would determine the preferred method of entering amendments in the international application.

Sec. 502. PROTEST AGAINST PAYMENT OF ADDITIONAL FEE AND DECISION THEREON

Neither this section, nor Section 403, nor form PCT/ISA/212, Notification of Decision on Protest, gives the applicant any guidelines as to whom and at what times he should submit his request to have the protest on the payment of additional fees sent to the designated offices.

This section should be expanded or a new section written to the effect that the notification of the lack of unity in the invention include an instruction to the applicant as to whom he should submit a request to have his protest or any decision thereon transmitted to the designated offices with the Search Report. Rule 40.2(c) does not speak to this point.

As the applicant may await the decision on his protest before submitting his request, and as the decision may only be sent to the applicant with the Search Report itself, it would be helpful and reasonable to include in the notification of the lack of unity of invention an instruction to the applicant to submit any request for the transmittal of the protest and the decision thereon to the designated offices, either:

- 1) To the ISA until the issuance of the Search Report and to the IB thereafter; or
- 2) To the IB in all cases, as the IB by this time in processing has a well established file on the case.

Annex A.

See comments under Section 202.

Subject Matter for Additional Administrative Instructions

1. An indication as to which papers (forms, applicant responses, etc.) are to be forwarded by the receiving offices with the Record and Search Copies of the international application.

2. The procedure for indicating in the Request or elsewhere those designation fees which have been paid and those unpaid at the end of twelve months after the priority date.
3. Procedure for entry of amendments under Article 14, Rule 9, Rule 91, etc. These procedures should be standard in order that publication may be uniform and that the designated offices can uniformly interpret the markings of different Receiving Offices and the International Bureau.
4. An indication of the contents of the copies of international applications which may be transmitted under PCT. Exactly which papers (original sheets, replacement sheets, forms, responses from applicant, etc.) must be included in the various copies? Examples of such copies are: Home, Search and Record copies, certified copies, Article 13, 20, 22 and 25 copies, etc.
5. An instruction that the international application number be placed on each sheet of every form. Such identification is necessary in order to insure correct association of forms and applications.
6. Procedure for marking the Request form to indicate that information regarding the Applicant, Inventor, Agent, etc. has been changed. This marking may include either a transcription of new information or a note referring to a paper containing the new information.

COMMENTS ON DRAFT PCT FORMS

PCT/RO/101. REQUEST FORM

General Comments

Re page numbering -- The last sheet of the Request form, containing the box for applicant(s) signature and the checklist, should contain a parenthetical statement beside the space for the indication of the page number that clearly indicates this sheet is the last sheet of the Request form.

The Annex or Fee Calculation sheet should contain an indication in bold-face type in the upper margin that this sheet is not to be counted as part of the international application for fee determination nor numbered in the sequential numbering of sheets in the international application.

Re notes to the forms -- The footnotes, although offering helpful information, would be much more informative and more easily understood if written in an instructional manner on a box-by-box basis, in a conversational tone and only citing Articles, Rules and Administrative Instructions. The mere citation of Articles, Rules and Administrative Instructions could then appear on the front of the form. For example, the heading of the note to Box II, would be "APPLICANT: (Rule 4.4 and 4.5)". The note would be as follows:

Box II, APPLICANT (Rule 4.4 and 4.5)

"The name of the applicant placed in this box will be the name

used in identifying the international application for PCT processing (Administrative Instruction Section 105). If there is more than one applicant, the number of additional applicants should be placed on the dotted line following "II, APPLICANT", and the specific identifying information for each additional applicant should be placed on the supplemental sheet in the same order and format as is shown in this box. Additionally, if there are more, less or different applicants for certain of the designated States, place the identifying information for these applicants and the name of the specific designated State in Box X.

"NAME

Names must be presented in the order, last name, first name, any middle name or initial, if the applicant is a natural person; and, by full official title, if the applicant is a legal entity (Rule 4.4(a) and (b)).

"ADDRESS

The full street address including the house number, if any, is required. Any box number, apartment number or other special indication must also be included. Standard abbreviations for the words, street, avenue, South, Northwest, etc., are permitted. The name of the city and state or province must be spelled out. A postal code number, if any, must be included. Include as a last line of any address the name of the country,



either the full official title or an authorized shorter version of the country's name as in Annex A to the Administrative Instructions (Rule 4.4(d)).

"NATIONALITY

As in the last line of the address, the full name of the country or the generally accepted short title of that country as listed in Annex A to the Administrative Instructions must be used (Rule 4.5(b), Administrative Instruction Section 202)...."

Notes to Form -- The applicant instructions should clearly state that the notes to PCT/RO/101 should not be sent to the Receiving Office with the international application. In fact, consideration should be given to making the notes to this form part of the Applicant Guidelines so as to reduce the size and, therefore, the cost of producing and mailing the Request forms.

Re continuation of information on supplemental sheet -- The small dotted line on which must be placed the number of additional items of information overflowing from any Box onto the supplemental sheet is confusing. No notes refer to this line or to the information that should be placed thereon. Additionally, the indication of the number of additional items of information that overflow onto the supplemental sheet does not seem to be especially useful; in fact, it seems to invite errors. For example, in some Boxes such as VI, PRIORITY CLAIM, there is enough room to identify the date and number of a

single application, but there may not be enough room to indicate all the States for which that single application was filed, such as where the earlier filing was a regional or international application. The dotted line in this Box refers to additional priority claims and is, therefore, confusing to the applicant who only wishes to use the supplemental sheet to indicate the fourth, fifth and sixth State for which his single regional or international application was filed.

Therefore, we suggest that in each Box identified by a Roman numeral, a check box that is highly visible to both the applicant and the Receiving Office be substituted for the small dotted line. Such boxes would preferably be placed at the right margin to insure visibility. The notation beside the check box should be general, i.e., it should state --Additional information is contained on the supplemental sheet--.

Re spacing between boxes -- Although the vertical spacing within each box conforms to standard typewriter spacing, the vertical spacing between boxes, especially between Box V and VI, does not; and, therefore, the typist must manually align the form before Box VI is typed. We suggest that the form be designed so that when the first line of information is entered in Box one, all following boxes conform to standard vertical typewriter spacing. To aid the typist in the initial alignment of the form, small "dingbats" or locating marks can be

preprinted in the upper right and left margins; once the "dingbats" are aligned, the typist is assured all lines of type will be properly placed.

Re name of common representative or addressee -- The front page of the Request contains the most frequently used bibliographic data. What it may not include is the name of the party to whom correspondence should be sent, as in the case of one of the additional applicants listed on the supplemental sheet being named as the common representative.

Some means should be provided to point out the addressee for correspondence, for example, by redesigning Box IV, AGENT, to include the appointment of a common representative, or by providing in the Administrative Instructions that the Receiving Office make a notation in the margin beside the name of the addressee for mailing purposes.

#### Specific Comments

Box for international application number -- To allow more room for the entry of information and to provide guidelines so that this information may be entered more neatly than at present, the box should be divided horizontally by light-face or dotted lines. In the upper left-hand corner of each partition, an indication of the type of information to be placed in that partition should be printed in small light-face characters. The notation that this box is for official use only should remain.

#### Box II, APPLICANT

The spaces for indicating nationality and residence should be placed directly under the spaces for "Name" and "Address" so that all information required by Rule 4 is physically located together.

After "telegraphic address" and "teletype address", add --(if any)--, as these items of information are not mandatory.

#### Box III, INVENTOR

The meaning of the phrase "(Applicant is also the inventor )" may be confusing except in the instance when all applicants are also all inventors. We suggest that the Applicant instructions and the Receiving Office guidelines clearly speak to how and when this box is to be filled in and how the Receiving Office is to interpret it.

#### Box IV, AGENT

The current version of Applicant Guidelines does not draw attention to the fact that some countries, such as the United States, have very specific requirements concerning the appointment of an agent or attorney. We suggest that this fact be included in the Guidelines for the applicant as well as a listing of those countries which have such specific requirements.

#### Box V, DESIGNATION OF STATES

See General Comment under "Re spacing between boxes" supra on page 14.

The sentence "...Additional designations are indicated on supplemental sheet)" may be confusing in that the applicant may not wish to indicate additional designations but may wish to indicate only a certain kind of protection, such as "Inventors Certificate of Addition" for the designation "Union of Soviet Socialist Republics". The sentence itself refers to additional complete designations on the supplemental sheet. See General Comment under continuation of information on supplemental sheet supra.

#### Box VI, PRIORITY CLAIM

The space to the right of the phrase "The priority of the following earlier application is claimed:" may be confusing to the applicant. In our informal testing, the applicant inserted the title of the earlier application in this space. We suggest that the "Application Number" sub-box be moved up to directly follow the colon.

The wording within the sub-box labeled "Country" should be changed somewhat to conform to the requirements of Rule 4.10(b)(i). We suggest the word "all" be changed to --those-- and a corresponding note be added to the instructions to the form to take into consideration Rule 4.10(b)(i).

The wording of the lower right-hand sub-box should be amended as follows: in line 1, cancel "earlier application was" and in line 3, cancel "the earlier application was".

#### Box VII, PARENT APPLICATION OR GRANT

The words "Title or" in the portion of the box labeled "Title or Treatment Desired" are questioned. It is likely that --Type of-- was meant.

In the portion of the box labeled "Title and Number of the Parent Application or Grant", there is little room to indicate both the title and number of the parent application and grant. As Rule 4.13 asks only that the parent be "identified", the number of the parent case would be sufficient.

In the two right-most portions of this box, a problem could exist in distinguishing (a) between the number of an application and that of a grant and (b) between the date of an application and that of a grant. We suggest that instructions to the applicant contain information on how to distinguish between a parent application and a parent grant as well as how to associate a correct number and date with either a parent application or parent grant, or both.

The Applicant Guidelines should also contain a reference to a specific practice of various national offices as regards the requirement to furnish dates and numbers of parent cases.

#### Box IX, DIFFERENT APPLICANTS FOR DIFFERENT DESIGNATED STATES and Box X, DIFFERENT INVENTORS FOR DIFFERENT DESIGNATED STATES

In both boxes, only the name of the applicant is called for

on the form with no reference to address, nationality or residence. In order to avoid confusion and possible loss of rights at the designated office stage because of insufficient data, we suggest that these indications be changed to read -- Applicant Indications-- and --Inventors Indications--.

#### CHECK LIST

In part "(A)", the dotted lines could be broken in the middle, so that the portion of the line on which the numbers of sheets are to be placed is clearly identifiable.

In part "(B)", there is little room after "8.  Other (specify)" to type in the identification of one document and insufficient space to type in two or more document identifications. We suggest that (1), the checklist be labeled --XII.--, and (2) a check box referring to the supplemental sheet for additional information be added after the words "check list". The instructions to the applicant for filling out this portion of the Request form should include reference to the other types of documents which may accompany the application on filing, for example, a request that alternate Rule 22.2 procedures for the transmittal of the Record Copy be used, or an assignment of ownership or fee calculation sheet, etc.

#### PCT/RO/101/Annex

#### Fee Calculation Sheet

See General Comment on page numbering supra on page 11.

This annex has no provision for entering the amount of the fees actually submitted with the application, and is of limited value for the Receiving Office in its processing of fees, especially in the case where the application is filed early in the priority year or without a priority claim and the applicant chooses not to pay all designation fees on filing.

We suggest that the Applicant Guidelines contain a listing of the specific designation fees for each country.

Under the "designation fees" portion of the annex, a reference to Article 13 should be inserted before the word "copy" in each indication of states "which require transmittal of a copy".

#### PCT/RO/102. NOTIFICATION CONCERNING PAYMENT OF TRANSMITTAL, SEARCH AND INTERNATIONAL FEES

#### General Deficiencies

This three-page form is very lengthy and does not easily lend itself to the purpose of notifying the applicant of payment of designation fees at a time later than filing. An additional shortened version of this form for use upon a later submission of designation fees would aid the work of the Receiving Office and give a clear picture of fee payment to the applicant.

This form gives no information to the applicant as to why his calculation of the fees may be in error. Such errors may be

due to 1) a miscalculation in the number of sheets in the international application for determining the basic portion of the international fee; 2) a miscalculation in the specific designation fees for each country; 3) an incorrect naming of designated countries leading to a cancellation of one or more designations. Also, in the case where designation fees submitted do not equal the total due for all designated States and the applicant lists the order in which designation fees are to be applied to designated States on an attached sheet the form does not provide for an indication of which fees have been paid.

Specific Problems for the RO/US in using this form

Under current United States law and the PCT implementing amendments thereto, the basic, search and transmittal fees must be paid on filing. This form, containing indications that later payment of these fees is allowed, cannot be used.

Deposit accounts are expected to be used frequently under United States practice. This form does not provide spaces for 1) authorization to use deposit account; 2) instructions that an overpayment of fees be credited to an account; or 3) that any deficiency in fees due upon filing be charged against the account.

The layout of the form suggests that three different time periods for response may be set for the fees due upon filing.

For United States practice, fees will be due at two times: upon filing and one year from the priority date.

PCT/RO/104. WITHDRAWAL NOTICE UNDER ARTICLE 11

The check boxes and the beginning of each dotted line should be vertically aligned for typing ease. The notation --(in all cases sent as a separate document)-- should be added to the end of the addressee notification at the bottom of the form to alert Receiving Office personnel that the form is sent in all cases to the International Bureau.

PCT/RO/105. NOTIFICATION OF APPLICATION NUMBER AND FILING DATE

As this may be the first form an applicant receives after filing an international application, it should contain spaces for indicating the title of the invention and any claimed priority date. It is noted that the procedure which uses form PCT/RO/125 is optional.

PCT/RO/106. INVITATION TO CORRECT PHYSICAL DEFECTS UNDER ARTICLE 14

Although the first two pages of the form contain much unused space, the annexes contain far too little space to indicate further identifications of the defects noted by the check boxes. A redesign such as that in document PCT/AAQ/VI/17 is suggested: condense the first two pages into one page on which is set forth the general defect, the time limit for

response, the paragraph on computation of time limits, and the paragraph indicating how corrections are to be submitted to the Receiving Office. Specifics of the defects could be set forth in three annexes: the current annexes A and B changed to B and C, and a new Annex A, comprising specific defects relating to signature, applicant indications, title and abstract. A continuation sheet for a further identification of defects noted in the annexes could be supplied.

As this is a multi-page form, a space should be provided on each page for the international application number for easy correlation of the form with the case, should the various pages of the form become separated.

The last paragraph on page (b) relating to the applicant's submission of corrections, should be amended, line 1, after the word "Office", insert --, other than a correction of lack of signature-- . A paragraph should be added after the last sentence stating --For the correction of the defect of lack of signature, a copy of the Request form has been attached. Attention is called to the method of correction prescribed by Administrative Instruction 316.--.

On page (a) under "As to signature" the third box item should be amended by, in line 2, changing "contain the" to --contain a proper-- and in line 3, inserting --proper-- after "a".

As some Receiving Offices will perform Article 11 and Article 14 checks at the same processing step, indications for a date of receipt and a purported international application should be placed on the identifying information to the form.

It is not clear at present what penalty or procedures are to be used if the applicant fails to submit a sheet calling attention to the differences between replacement and original sheets.

Annexes A and B to PCT/RO/106.

The check boxes do not conform to standard vertical typewriter spacing.

Annex A

This form does not cover such physical defects as 1) non-use of metric indications, 2) lack of printed Request form, or 3) improper claim numbering. Although the Treaty has specific requirements relating to these items, it does not indicate a penalty for lack of compliance therewith. Currently no form invites the applicant to remedy these defects nor discusses the penalty for the lack of compliance therewith. It is suggested that these defects be indicated either on form PCT/RO/106 or on a blank form. The penalty for non-correction should be withdrawal of the application as for other formal defects such as those under Article 14.

We note that, should a Request form be reproduced improperly and then submitted to the Receiving Office, defects under (d), (f), (h), and (i) could result. The check boxes for these items should be restored.

#### Annex B

For clarity, change Item II(e) to read -- containing cross sections not properly indicated by oblique hatching--.

Under "II(q)", only one situation under Rule 11.13(1) is covered. It is suggested that the current point "II(r)" be changed to --II(s)-- and a new --II(r)-- be inserted, reading --do not contain reference signs that are mentioned in the description--. We note that the Receiving Office must carefully compare the "Brief Description of Drawings" portion of the Description and the drawings themselves to determine whether drawings or figures of drawings are missing under Article 14(2) or are misnumbered under Article 14(1), as the consequences of deficiency under the two provisions are very different: Article 14(2), possible change in filing date; Article 14(1), possible withdrawal of the application itself.

#### PCT/RO/107

The second paragraph of the form should be split into three parts for clarity: sentence 1, sentence 2 and the remaining sentences.

Sentence 2 should be revised by adding after "TIME LIMIT" the phrase --THE DRAWINGS WILL BE INCLUDED IN THE INTERNATIONAL APPLICATION AND-- to explicitly state the effects of a timely receipt of missing drawings.

Sentence 3 and 4 should be combined by substituting a comma for the period after "NON-EXISTENT" in sentence 3, inserting the word --AND-- after the comma and deleting "IN THE LATTER CASE," at the beginning of sentence 4.

These changes draw attention to the dual effect of a submission of late drawings, and present the effects in a clear readable manner.

We note that, if for some reason the priority date of the application is in question at the time the form is sent, the check box and paragraph referring to the fact that the time limit for this form expires later than one year from the filing date of the priority application may be confusing to the applicant. We suggest that in this sentence, line 2, the word "expires" be followed by the alternative expression --(may expire)-- to clarify the situation for the applicant.

PCT/RO/108. NOTIFICATION OF RULE 91 ERRORS OF TRANSCRIPTION  
The first paragraph should be moved upwards and the remainder of the text of the form moved downwards to provide more space for the listing of several errors of transcription.

After the phrase "this Receiving Office" in the addressee notifications at the bottom of the form, add the phrase --(if the error is in the Request)--; after the phrase "International Searching Authority", add the phrase --(if the error is in the body of the application)--; and after the phrase "International Bureau", quote the phrase under Rule 91.1(e)(iv).

PCT/RO/109. NOTIFICATION OF DECISION ON REQUEST FOR RECTIFICATION

Point "1." should be placed closer to the first paragraph in order to allow more room for the entry of information under both point "1." and point "2.".

In the address notification at the bottom of the form after the word "notification", add the phrase --, with any attachment--, to assist the clerical staff in both filling out and mailing the form.

PCT/RO/110. INVITATION TO CORRECT THE PRIORITY DATE

When this form is sent to the applicant, the claimed priority date of the application is in question; and, therefore, time limits which depend on that priority date, for example, transmittal of the Record copy, publication and Article 20 transmittals to the designated offices, are also in question. The applicant and authorities are not advised on this form or in the Administrative Instructions of the consequences of a cancellation of the claimed priority date on the various above-

mentioned time periods. This form should contain an indication of the effects of a cancellation of a priority claim on certain time limits based on the priority date. Such an indication should be printed in bold-face capital letters at the bottom of this form and should read:

--SHOULD THE PRIORITY CLAIM IN QUESTION BE CANCELLED, THE EARLIEST REMAINING PRIORITY CLAIM, IF ANY, OR THE INTERNATIONAL FILING DATE, WILL BE CONSIDERED TO BE THE "PRIORITY DATE" FOR PURPOSES OF CALCULATING TIME UNDER THE TREATY.--.

PCT/RO/111. NOTIFICATION OF CORRECTION OR CANCELLATION OF PRIORITY CLAIM

This form does not clearly state that the corrected date of the earlier application or, if that date has been cancelled, the international filing date, is now considered to be the "priority date" for the purposes of calculating time limits under the Treaty. A sentence, in bold-face capital letters should be added to the form below the check boxes, reading:

--ACCORDINGLY, HENCEFORTH THE DATE THAT IS CONSIDERED TO BE THE "PRIORITY DATE" FOR PURPOSES OF CALCULATING TIME LIMITS UNDER THE TREATY IS:

- THE CORRECTED DATE INDICATED UNDER (1) ABOVE.
- THE INTERNATIONAL FILING DATE OF THE APPLICATION.
- THE DATE OF THE EARLIEST PRIORITY CLAIM REMAINING IN THE APPLICATION, THAT IS, \_\_\_\_\_.--.



To alert the Receiving Office personnel as to specific addressees under certain conditions, the phrase "Where required" should be removed from the beginning of the addressee notice at the bottom of the page, and after the phrase "International Searching Authority" should be added the parenthetical indication --(only when the Search Copy has been sent)-- and after the words "International Bureau" should be added the parenthetical phrase --(only when the Record Copy has been sent)--.

PCT/RO/112. NOTIFICATION OF RULE 9 DEFECTS

This form allows for the entry of only one specific type of Rule 9 defect per application. The one-line entries under each of the five specific defects should be removed from the form, and specific identification such as that used in the Annexes to form PCT/RO/106 should be substituted. For example, after the five points, the following phrase should be inserted:

--Identification of the Rule 9 expressions:

Under ( ):

Under ( ):

Under ( ):--.

To alert the Receiving Office personnel to specific addressees, insert after "International Searching Authority" the phrase --(sent in all cases, with Search Copy or as separate document)-- and after "International Bureau" the phrase --(sent in all cases, with Record Copy or as a separate document)--.

PCT/RO/113. REQUEST FOR RECORDING A CHANGE RE APPLICANT

The changes in applicant indications that are conveyed by this form act as substitutes for information on the Request, and, as these changes may include the residence and nationality, especially under point "5.", boxes for the entry of residence and nationality should be included on this form, possibly located in the right-hand portion of the current "Name" box.

A sixth point should be added to the form to cover the situation where information concerning the applicant that was previously missing has now been supplied. For example, --The applicant has supplied the information recorded below that was previously missing.--.

Consideration should be given to providing similar forms to indicate changes in information concerning the inventor and changes in addresses of agents or attorneys.

PCT/RO/114. NOTIFICATION OF NON-COLLECTION OF RECORD COPY

In line 4, change "prior to" to --by-- to parallel the language of Rule 22.2(d).

To aid the Receiving Office personnel in its clerical tasks in the addressee indications at the bottom of the page, after "International Bureau" add the phrase --(sent in all cases as a separate document)--.

PCT/RO/116. NOTIFICATION OF WITHDRAWN DESIGNATIONS

More space should be allowed between the first and second paragraphs in order to allow room for the entry of many withdrawn designations. This form should include a reference to the applicant's right of review before the designated offices under Article 25.

To aid the Receiving Office personnel, at the bottom of the page, after the addressee indication "International Bureau" add the phrase --(sent in all cases, with Record Copy or as a separate document)--.

PCT/RO/117. NOTIFICATION OF WITHDRAWAL UNDER ARTICLE 14

The United States cannot use this form under current law and PCT implementing amendments thereto because the transmittal, search and basic fees must be paid upon filing. No invitation for later payment of these fees can be sent. In order for the United States to be able to use this form, it would be necessary to add a new paragraph under point "2.", stating that the application has been declared withdrawn for failure to pay the transmittal, search or basic fees on filing.

Each of the three points on the form mentions that an invitation to correct was mailed to the applicant. We suggest that the word "invitation" under each point be followed by an indication of the number of the form that was mailed to the applicant.

This form should also contain an indication of the applicant's right to review by the designated offices under Article 25.

The paragraph at the bottom of the page "(h)" indicating other addressees should be revised along the lines suggested for previous forms.

PCT/RO/118. RECEIVING OFFICE COVER LETTER

This form can be very confusing in situations where later supplied sheets and drawings and corrections under Article 14 are also transmitted with Record Copies of the cases. We assume that if number "1." is checked, numbers "6."-"9." (items which may accompany the Record Copy) need not be checked.

An additional point, --10.-- should be added to accommodate other types of documents which may be mailed to the International Bureau.

To assist the Receiving Office in its clerical processing, in the addressee listing at the bottom of the form, add after "International Searching Authority" --(if (2) checked; see instructions on accompanying forms if (6), (7), (8) or (9) checked)-- and after "International Bureau" add the phrase --(if (1), (3), (4), (5), (6), (7), (8) or (9) are checked)--.

However, we are of the opinion that this form could be condensed to a one-page listing of the specific documents being transmitted without losing any information value whatever.

PCT/RO/120. INVITATION TO PAY FEE FOR PREPARATION OF COPIES

We note that no penalty is indicated for lack of response to this form.

PCT/RO/121. NOTIFICATION THAT PRIORITY CLAIM CONSIDERED NOT TO HAVE BEEN MADE

A new paragraph should be added to this form to explicitly state the date that will be considered to be the "priority date" for purposes of calculating time limits. Such a paragraph should read:

--ACCORDINGLY, HENCEFORTH THE DATE THAT IS CONSIDERED TO BE THE "PRIORITY DATE" FOR PURPOSES OF CALCULATING TIME LIMITS UNDER THE TREATY IS:

- THE INTERNATIONAL FILING DATE OF THE APPLICATION.
- THE DATE OF THE EARLIEST PRIORITY CLAIM REMAINING IN THE APPLICATION, THAT IS, \_\_\_\_.

To assist the Receiving Office in its clerical processing, the addressee notice at the bottom of the form should be changed as follows: The words "Where required" should be cancelled; after "International Searching Authority" the phrase --(only if Search Copy has been sent)-- should be added; and after "International Bureau" the phrase --(only if Record Copy has been sent)-- should be added.

PCT/RO/123. NOTIFICATION OF POWER OR REVOCATION OF POWER

To assist the Receiving Office in its clerical processing, in the addressee notifications at the bottom of the page, after

"International Searching Authority" add the phrase --(sent in all cases, with Record Copy or as separate document)-- and after "International Bureau" add the phrase --(sent in all cases with Record Copy or as a separate document)--.

Consideration may be given to combining this form with PCT/RO/118, the Receiving Office transmittal letter. It is noted that this form is a transmittal letter for a complete document, i.e., a Power of Attorney or Revocation of Power of Attorney.

PCT/RO/124. NOTIFICATION OF DEFECTIVE POWER OR DEFECTIVE REVOCATION

An additional point --d.-- should be added to this form to notify the applicant of his failure to enclose a Power of Attorney document with the application on filing that confirms indications made in Box IV of the Request.

This form gives occasion to raise several problems concerning Powers of Attorney and Revocations of Powers of Attorney:

1. If both a power and revocation are submitted at the same time and only the revocation is defective, to which agent, then, is this form sent?
2. If both a power and revocation are submitted at the same time and the power of attorney is defective, the first-named applicant receives

INTERNATIONAL SEARCHING AUTHORITY FORMS

form PCT/RO/124 and not the intended agent. This may lead to complications.

3. If an agent withdraws from the case, who receives this form?
4. In the case of a change in the common representative, it is not clear from Rule 90 or from Rule 4.8 whether a power of attorney or a revocation of a power of attorney per se is needed. If the first-named applicant is the common representative who has been revoked, who receives this form and any subsequent correspondence?

PCT/RO/126. NOTIFICATION CONCERNING LATER SUBMITTED SHEETS OR DRAWINGS

In point "1.(a)", line 2, change "correct" to --corrected--.

To assist clerical processing in the Receiving Office, in the addressee indications at the bottom of the page, insert after "International Searching Authority" the phrase --(sent only if 1.(a) or 1.(b) has been checked, with Search Copy or as a separate document)-- and after "International Bureau" add the phrase --(sent in all cases, with Record Copy or as separate documents with attached sheets and drawings)--.

PCT/RO/127 and PCT/RO/128. Since the text on these forms is short, the text could be typed on blank forms.

General Comment on All Forms:

The bright yellow color of the ISA form is irritating to the eyes and does not reproduce well. A softer shade of yellow is recommended.

PCT/ISA/201

Notes "(1)" and "(2)" to the form are confusing in that they recite rules relating to PCT/ISA/210, many parts of which do not apply to an International type search report. In this specific instance, the notes should be rewritten to contain only information pertinent to the International type search report.

In the box labeled "Identification of Application" the words --national or regional-- should be inserted before "application number" and "filing date".

This form should provide a space for a "Date of Request for Search" and for an "International Type Search Number" as referred to in Box VIII on Request form, PCT/RO/101.

Under Box II, Fields Searched, there is no provision to cite searches made in non-minimum patent documentation or on any non-patent literature.

The page numbers on the supplemental and last sheet should be placed at the center top of the pages to be uniform with Rule 11.7(b).

Comments made with regard to form PCT/ISA/210 should be adopted for this form whenever applicable.

PCT/ISA/202, NOTIFICATION OF RECEIPT OF SEARCH COPY:

The addressee notification at the bottom of the page should contain a parenthetical note after "International Bureau" that this form is always sent. After "Receiving Office" the additional note should read --(sent only if Receiving Office is a different office from the International Searching Authority.)--.

PCT/ISA/203, ARTICLE 17(2) DECLARATION:

Under point number 2, as the applicant would probably want to know why a meaningful search could not be carried out on his application, a space for comments for the International Searching Authority should be made at the bottom of the form.

PCT/ISA/204, INVITATION TO COMMENT ON ABSTRACT:

The space following the first paragraph where "reasons" are to be entered may not allow sufficient space. It may be necessary in cases to type the Abstract established by the International Searching Authority on a separate sheet.

For clarity, the computation paragraph at the bottom of the page should be amended as follows: line 2, after "comments", insert --that are to be considered must-- and in line 3, cancel the words "have to".

PCT/ISA/205, NOTIFICATION OF DEFINITIVE ABSTRACT:

The addressee notice at the bottom of this form should contain after the words "International Bureau" the parenthetical note that this form is sent as a separate document only if the abstract is established after the Search Report has been issued. Additionally, the first line of this paragraph should be amended as follows: after the word "notification" insert --and any attachment--.

PCT/ISA/206, INVITATION TO PAY ADDITIONAL FEES

More room should be provided to enter reasons for lack of unity of invention. This could be somewhat accomplished by:

- 1) Increasing the length of each line of text;
- 2) In the first paragraph, sentence one, line 3, place a period after the word "invention" and cancel the words "for the following reasons". In the same line, remove the parentheses from the next sentence and rewrite it as follows: --Reasons, with relevant claims for each invention, are:--.
- 3) In paragraph two, line 4, cancel "This International Searching Authority will further establish" and capitalize the --t-- in "the". In line 5, add --will be established-- after the word "report". In line 6, place a period after the word "paid", and cancel "to it by the applicant".
- 4) In paragraph four for clarity, the phrase --if additional inventions are to be searched-- should be added to the second sentence.

- 5) Paragraph five could be condensed to two lines,  
or for some Authorities, deleted altogether.

When some claims have been found to be unsearchable under Article 17 (2)(b) the numbers of these unsearched claims will not appear in the groupings of claim numbers listed on this form. This may be confusing to the applicant. We recommend that a sentence be added to this form to indicate any claims considered to be unsearchable under Article 17 (2)(b). Such a sentence could read: --Claim number(s) \_\_\_\_\_ have been found to be unsearchable under Article 17 (2)(b) because of defects under Article 17 (2)(a) and therefore have not been included with any invention. This form should include adequate instructions to the applicant as to whom he should submit his request to have any protest and the decision thereon transmitted to the designated offices. The outcome of the discussion on Section 503 should determine the wording of this note to the applicant. In order to include these additions that apprise the applicant of his circumstances and rights it will be necessary to expand this form to two pages.

PCT/ISA/208, ACTION TAKEN ON DRAFT TRANSLATION:

Points "1" and "2" on this form do not adequately distinguish among the three situations where some, all, or no comments have been incorporated. Under items 2, if all comments are rejected, the reasons must be explained; yet, under item 1, no reasons must be given for a partial rejection of comments. Items 1 and 2 should be renumbered and subpoints added to each so that item 1 refers to comments that have been considered,

subpoint (a) being the case where all comments have been incorporated; subpoint (b), the case where no comments are agreed to, reasons explained; and subpoint (c), the case where comments are partially incorporated and partially not incorporated, with reasons explained. Item 2 should cover non-consideration of comments; subpoint (a), being the case of non-consideration due to the lack of time; subpoint (b), the case where comments were untimely submitted. Items 1 and 2 and their respective subpoints should each have a checkbox.

PCT/ISA/210, INTERNATIONAL SEARCH REPORT:

Boxes IV and V on supplemental sheet -- These two boxes should be reversed on the page in order to more logically present the information contained therein. As the form now reads, if number 1.a under Box IV, "Unity of Invention" is checked, it initially seems to the reader that all claims in the application were searched; the reader does not know that the word "all" may, in fact, mean "all claims not otherwise found unsearchable" until after he reads Box V on the lower half of the page.

Therefore, the first box of the supplemental sheet should be the current Box V, Certain Claims were Found Unsearchable, in order to define those claims in the application on which the search could be based. Then, once the claims on which the search could be based are defined for the reader, it can be assumed that any holding of lack of unity of invention can only be used in reference to claims that are searchable.

The wording of the sentences within the revised Box V should be changed as follows:

--This international search report has not been established in respect of certain claims under Article 17(2) for the following reasons:

- 1)  Claim numbers -----, because they related to subject matter not required to be searched by this Authority, namely:
- 2)  Claim numbers -----, because they relate to parts of the application that do not comply with the prescribed requirements to such an extent that a meaningful search can be carried out, specifically: --.

It should be noted that the wording of point "2" has been revised to conform to Article 17(2)(a)(ii) in that the parts of the application that may fail to comply with physical requirements include the description and drawing as well as the claims.

Box IV Observations Where Unity of Invention is Lacking.

The language within this box should be changed to read --This Searching Authority found multiple inventions in this International Application. These inventions and the claims drawn thereto are listed as follows:

- 1)  As all required additional search fees were timely paid by the applicant, this International Search Report covers all searchable claims of the international application.
- 2)  As only some of the required additional search fees were timely paid by the applicant, this International Search Report covers only those claims of the international application for which fees were paid, specifically claims:
- 3)  No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claim numbers:

Remarks on Protest:

- 1) The additional search fees were accompanied by applicant's protest.
- 2) No protest accompanied the payment of additional search fees.--.

Sentence "2" in the present version of the form has been deleted, as it limits the rights of the applicant. Neither Rule 40.2(c) nor Sections 403 or 502 state that the protest and decision thereon shall be annexed to the Search Report. Nowhere in Rule 43.9, that sets forth the specific limits on

contents of the Search Report, is the protest mentioned. If the protest is annexed, it becomes part of the Report, and it is assumed, would be published. The applicant may not wish the protest to be published. If the search report is printed by direct camera-copy off-set methods, even if the protest is detached, sentence "2" referring to its annexation will appear in publication, and the reader may be confused.

Recognizing that there is a practical need for some indication of whether a protest has been submitted to the Search Authority, in view of Section 502 that requires that the Searching Authority transmit the protest with the search report to the International Bureau, a simple statement on the search report that a protest was filed would alert the International Bureau, while not affecting the applicant's rights. Such a simple statement would not seem to be in conflict with Rule 43.9.

PCT/ISA/211, TRANSMITTAL OF CITED DOCUMENTS:

As this form will probably be mailed by a service unit which handles requests for many different types of documents, and, as this form in no way affects the processing of an international application, there seems to be little use for a standardized form in this situation.

PCT/ISA/212, NOTIFICATION OF DECISION ON PROTEST:

The line in subpoint 1.b on which is to be entered the amount of reimbursement should be moved to the left margin directly under the checkbox of item 1.b to assist clerical personnel in filling out the form.

This form should include instructions to the applicant in bold face type on the front of the form as to whom and when he should submit his request for transmittal of the protest and decision thereon to the designated offices if he has not already done so.

PCT/ISA/213, NOTIFICATION OF REFUND OF SEARCH FEE:

This form does not allow for certain specific processing needs of International Searching Authorities, for example, the crediting of refunds to deposit accounts. As this form is sent only to the applicant, it would seem that each international searching authority should be able to tailor the form to its own needs.

PCT/ISA/215, NOTIFICATION OF DEFECTS IN THE INTERNATIONAL APPLICATION:

Comments on form PCT/RO/106 and its Annexes should be incorporated in this form where applicable.

PCT/ISA/216, INVITATION TO REQUEST RECTIFICATION:

It is possible that the International Searching Authority may identify several errors of transcription in one application, and these errors may have different authorities responsible for their correction. Some provision should be made to advise the applicant to which authority he must request rectification of each specific error. For example, each error could be numbered and the expression --for \_\_\_\_\_-- added after each Authority at the bottom of the form. The numbers of the errors would be placed on the lines following the appropriate Authorities.



In the addressee notification at the bottom of this form, the word "the" should be changed to --this-- before the words "International Searching Authority".

PCT/ISA/218, NOTIFICATION CONCERNING RULE 9 EXPRESSIONS:

Comments under PCT/RO/112 should be incorporated in this form wherever possible.

In the addressee notices at the bottom of the page, after each addressee, add the parenthetical note --(sent in all cases)--.

PCT/ISA/219, ISA TRANSMITTAL LETTER:

Comments under form PCT/RO/118 should be incorporated in this form whenever possible.

PCT/ISA/220, TRANSMITTAL LETTER FOR SEARCH REPORT OR DECLARATION:

This form should include instructions to the applicant as to whom he should submit any request that his protest and a decision thereon be transmitted to the designated offices.

The form may further include a checkbox and a note that the protest and decision thereon is being transmitted with the Search Report per his instructions.

PCT/ISA/221, INVITATION TO PAY FOR CITED DOCUMENTS:

Note comments relative to form PCT/ISA/211.

INTERNATIONAL BUREAU FORMS

General comments:

Where applicable, the changes suggested for Receiving Office and International Searching Authority forms should be adopted for the corresponding International Bureau forms.

Each form that contains a checklist for addressees should have each addressee followed by a parenthetical note stating if the form is sent in all cases or only under special circumstances. This is to aid clerical processing by the International Bureau.

Specific Comments:

PCT/IB/301, NOTIFICATION OF RECEIPT OF RECORD COPY:

This form is sent to both addressees in all cases.

PCT/IB/303, REQUEST FOR COPY OF PAPERS:

Consideration may be given to redesigning this form so that one or a number of copies of proported international applications may be requested. A pattern for this redesign could be form PCT/IB/311.

PCT/IB/304, NOTIFICATION CONCERNING SUBMISSION OF PRIORITY DOCUMENT:

In note "(2)" to this form the title and the text of Section 411 are run together. The first portion of the sentence up to the word "where" should be cancelled.

This form is sent to designated offices in all cases.

PCT/IB/305, NOTIFICATION OF LATE SUBMISSION OF PRIORITY APPLICATION NUMBER:

This form is sent to all designated offices under all circumstances.

PCT/IB/306, NOTIFICATION OF A CHANGE RE APPLICANT:

See comments under PCT/RO/113.

PCT/IB/307, NOTIFICATION OF WITHDRAWAL BY APPLICANT:

In the addressee notice, it could be mentioned that this form is sent to the International Searching Authority only if the search report or declaration has not issued, but is sent to the Receiving Office and designated offices always.

PCT/IB/309, INVITATION TO PAY FOR COPIES OF DOCUMENTS IN FILE:

Under note "(1)" to the form, Section 108(b) is quoted, yet, in the current Administrative Instructions, there is no Section 108(b).

PCT/IB/310, INTERNATIONAL BUREAU TRANSMITTAL LETTER:

Each addressee at the bottom of the page should be followed by a parenthetical note to alert clerical personnel as to whom and under what circumstances each of the above-mentioned documents is mailed.

PCT/IB/311, REQUEST FOR COPY OF TRANSLATION:

The title of the first column on the form is "Number of Copies". Rule 95.1(a), however, states "a copy"; and in the case where an application has been translated into several languages by

the designated or elected office, it would be more appropriate to state the language versions requested in this column.

PCT/IB/312, NOTIFICATION OF TRANSMITTAL OF COPIES OF TRANSLATIONS:

Consideration may be given to redesigning this form along the lines of PCT/IB/311 to allow for transmittal of copies of translations of more than one international application.

PCT/IB/313, NOTIFICATION OF CERTAIN DEFECTS IN THE INTERNATIONAL APPLICATION

See comments on form PCT/RO/106.

PCT/IB/314, INVITATION TO REQUEST RECTIFICATION:

See comments on PCT/RO/108.

PCT/IB/315, NOTIFICATION OF DECISION CONCERNING REQUEST FOR RECTIFICATION:

See comments on PCT/RO/109.

PCT/IB/316, INVITATION TO CORRECT PRIORITY DATE:

See comments on PCT/RO/110.

PCT/IB/317, NOTIFICATION OF CORRECTION OR CANCELLATION OF PRIORITY CLAIM:

See comments under PCT/RO/111.

PCT/IB/318, NOTIFICATION THAT PRIORITY CLAIM CONSIDERED NOT TO HAVE BEEN MADE:

See comments under PCT/RO/121.

This form is sent to both addressees in all cases.

PCT/IB/320, NOTIFICATION OF DEFECTIVE POWER OF ATTORNEY OR REVOCATION:

See comments under PCT/RO/124.

PCT/IB/321, NOTIFICATION OF RULE 14.4 DEFECTS:

This form should contain a reference to Rule 30.1 that sets forth the time limit for finding Article 14(4) defects.

PCT/IB/325, NOTIFICATION OF WITHDRAWAL BY THE RECEIVING OFFICE:

This form should contain an indication reminding the Designated Offices that applicant has a right to review under Article 25 and the time limits for such review.

PCT/IB/326, NOTIFICATION THAT INTERNATIONAL APPLICATION CONSIDERED WITHDRAWN BY THE IB:

This form should contain an indication of the applicant's right to review by the Designated Offices under Article 25. This form is always sent to both addressees.

PCT/IB/328 - 341, CHAPTER II FORMS:

No specific comments.

INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY FORMS

We have no comments on these forms as they were not part of the test program. We assume that any suggestions made for Chapter I forms will be applied to analogous Chapter II forms where appropriate.

SUMMARY:

In both the international and informal testing of PCT procedures and forms we found that, in most instances, the forms

were very useful. Our comments as presented in this paper are offered to further perfect them for use under PCT should the various offices desire to use them in effecting communications under PCT.

In reviewing the Administrative Instructions we find that several practical areas of processing must yet be spoken to, for example, the content of various copies of international applications and methods for entering corrections. One area of concern that arose during the test proceedings, that, although not mentioned in the body of this document, deserves attention, perhaps in the Guidelines for Searching, is unity of invention practice. We look forward to reviewing any documents on this topic that may be issued by WIPO for the Fall Interim Committee meetings.

As a final point, generalizing from our comments on the notes to form PCT/RO/101, we would like to state again that we believe the citation of Treaty Articles and Rules on the front of the form, as on form PCT/IB/321, is much preferred to the use of footnote numbers with full quotation of Treaty text on the back of the forms, as on form PCT/IB/322. As two-sided copiers are the exception rather than the rule and as the footnote to several forms extend to continuation sheets, under actual PCT operations, there will be a tendency to reduce time and cost of copying by reproducing only the front of the form. In the current footnote system, this tendency will render the footnote numbers meaningless without the accompanying footnote text. The system of citing Articles and Rules on the front of the form should be extended to all forms.



INSTITUT INTERNATIONAL DES BREVETS

INSTITUT INTERNATIONAL DES BREVETS

2.

Service Technique

JVV/MB.

PROPRIÉTÉ INDUSTRIELLE  
- 5 JUL 1976  
PCT 9276-0213

Mr. M. HADDRICK,  
Head PCT Division,  
WIPO,  
32, Chemin des Colombettes,  
1211 GENEVE 20-SUISSE.

TELEPHONE:  
906729  
ADRESSE TELEGRAPHIQUE:  
BREV/PATENT.  
TELEX No. 31651  
ADRESSE:  
PATEENTLAAN 2, RIJSWIJK (Z.H.)  
(PAYS-BAS)

JVV/MB.

RIJSWIJK (Z.H.), le July 2, 1976.

Dear Mr. Haddrick,

In reply to your circular N° 2468 of 7 April 1976, we offer the following comments concerning the PCT "test program".

1. As it appeared from the check-lists of the Requests that in no case a signed power of attorney has been submitted by the applicants, we have addressed all documents to the first mentioned applicant. However, even when the appropriate box in the check-list is marked, the ISA will not know whether the document in fact has been submitted and found correct by the RO.
2. In cases where the abstract was found defective by us, in order to gain time, we have not sent an invitation to the applicant to comment upon the abstract established, but have assumed that the applicant has failed to reply within the prescribed time limit.
3. For PCT/CH76/00002 no search has been carried out, in view of the fact, that the International Bureau has declared that the application must be considered as withdrawn.
4. Concerning PCT/GB76/00001, we received from the RO, on 10 May 1976 a copy of a letter of corrections by the applicant. In this letter reference was made to changes suggested by the RO in a notification of 8 April 1976. As the content of this notification was not known to us, these changes could not be taken into account when establishing the search report.

5. Concerning PCT/GB76/00002, the RO has notified the applicant that one of the priority claims is considered not to have been made. It is not clear however if consequently the ISA has to omit from the search report the indication of this priority claimed by the applicant.

Please accept our apologies for the fact that we could not keep to the dead-line mentioned in your circular.

Sincerely yours,

J.A.H. Van Voorthuizen.  
Dep. Technical-Director.

PCT/AAQ/VII/10  
ANNEXE N/ANNEX N

.../...