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MATTERS CONCERNING THE PCT UNION: REGULATIONS

*(Proposed amendments of the Regulations under the PCT: language of the international application; electronic filing of international applications; priority claims and priority documents; deposits of biological materials; fees)*

*Document prepared by the International Bureau*

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## INTRODUCTION

1. This document contains proposals, on a number of topics, for amendment of the Regulations<sup>1</sup> under the PCT.
2. An outline of the proposals relating to each topic is given in the following paragraphs. Proposed amendments of the Regulations are contained in the Annexes to this document.
3. The amendments relate to the following topics:
  - (i) *language of the international application* (see Annex I);
  - (ii) *electronic filing of international applications* (see Annex II);
  - (iii) *priority claims and priority documents* (see Annex III);
  - (iv) *deposits of biological materials* (see Annex IV);
  - (v) *fees* (see Annex V, and also Annex VI which contains proposals for the modification of the directives given by the Assembly in relation to the fixing of equivalent amounts of certain fees).
4. The proposals in this document derive from proposals which were considered by an ad hoc Advisory Group which met in April and June 1997. Those proposals were revised taking into account the discussions at those meetings. The Advisory Group was convened by the Director General to provide guidance to the International Bureau on proposed amendments of the Regulations with a view to their submission to the Assembly. The Offices invited to the Advisory Group meetings, the proceedings of which were informal, were those of the 10 PCT Contracting States whose nationals or residents filed the largest numbers of international applications in 1996 and any other Office which is an International Searching and/or Preliminary Examining Authority; nine non-governmental organizations closely interested in PCT matters were also invited.
5. In the text of the proposed amendments contained in the Annexes, proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. In a small number of cases, text the need for which, or the precise wording of which, is in doubt is included in square brackets.
6. Parts of affected Rules which are not proposed to be amended, or which are proposed to be amended in connection with another topic, are also included in the Annex concerned where they are particularly relevant to the provisions proposed to be amended. Any parts of a Rule which are not included in the Annex, whether or not they are proposed to be amended in connection with another topic, are replaced by the indication “[...]”.

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1. References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be.

7. Comments and/or examples are included in the Annexes, immediately following the text of the provisions concerned, where it seems that they would be helpful.

## LANGUAGE OF THE INTERNATIONAL APPLICATION

*(See Annex I; requirements for international filing date, receiving Office processing, translation for international search, international publication, international preliminary examination)*

8. The PCT and the Regulations presently make specific provision for the language in which an international application must be filed. The intention behind these and related provisions is to ensure that:

(i) the receiving Office will be able to carry out the necessary checking of the international application at the time of filing;

(ii) the International Searching Authority will be able to carry out an international search on the international application;

(iii) the international application will be published in one of the seven languages in which international applications may be published (“languages of publication,” namely, Chinese, English, French, German, Japanese, Russian and Spanish);

(iv) the International Preliminary Examining Authority will be able to carry out an international preliminary examination on the international application.

9. Article 11(1)(ii) thus provides that, in order to be accorded an international filing date, an international application must be in “the prescribed language.” The relevant prescription is contained in Rules 12.1 and 20.4(c). Rule 12.1 requires, in general, that an international application be filed in the language, or one of the languages, accepted by an International Searching Authority specified as competent by the receiving Office concerned. Rule 20.4(c) requires, for the purpose of according an international filing date, that at least the description and the claims be in a language admitted under Rule 12.1.

10. The languages accepted for international search by the International Searching Authorities are, at present, with the exception of Dutch and certain Nordic languages, also languages of publication. Dutch and certain Nordic languages are accepted for international search because the European Patent Office and the Swedish Patent Office, respectively, are prepared to undertake searches in those languages. In those cases, the international application will be published in English, the translation into that language being prepared, pursuant to Rule 48.3(b), under the responsibility of the International Searching Authority which undertakes the search.

11. It is also to be noted that, under Rule 12.1(c), an International Searching Authority may agree, in certain—very limited—circumstances, to search an international application on the basis of a translation. At present, this possibility applies in practice, for example, to international applications which are filed in Spanish with the Mexican Institute of Industrial Property and where the applicant chooses, as competent International Searching Authority, the

European Patent Office, the Swedish Patent Office or the United States Patent and Trademark Office, none of which accepts Spanish for the purposes of international search.

12. The present requirements as to languages of filing mean that applicants in many countries cannot file an international application in their national language (for example, in the form of a copy of a national application, the priority of which would be claimed in the international application), but must prepare a translation before filing an international application.

13. The PCT Committee for Administrative and Legal Matters, at its sixth session held from April 29 to May 3, 1996, expressed its agreement, in principle, with possible changes outlined by the International Bureau in document PCT/CAL/VI/4. That document referred to the possibility of broadening the existing provisions by also permitting applicants to file international applications in any other language in which the receiving Office is prepared to receive international applications.

14. It is thus proposed to make amendments to the Regulations, as set out in Annex I, according to the following principles.

(a) *For the purposes of receiving an international filing date*, an international application could be filed in any language which the receiving Office is prepared to accept (see Rule 12.1(a)). Every receiving Office would, however, be obliged to accept filings in at least one language which is both a language accepted by the competent International Searching Authority and a language of publication (see Rule 12.1(b)).

(b) *For the purposes of processing the international application*, the existing stipulations as to required languages would be substantially retained, subject to a broadening of the circumstances in which the different stages of processing would be undertaken on the basis of a translation to be furnished by the applicant (see subparagraph (c), below) or to be established under the responsibility of the International Searching Authority (see subparagraph (d), below). Thus, the detailed checking of the international application for compliance with the requirements for an international filing date, the international search and the international preliminary examination would each, as at present, be carried out only in a language accepted by the receiving Office, the International Searching Authority and the International Preliminary Examining Authority, respectively. Moreover, international applications would continue to be published only in one of the seven languages of publication.

(c) If the language of filing of the international application is accepted by the receiving Office but is not accepted by the International Searching Authority and/or the International Preliminary Examining Authority, *the applicant would be required to furnish a translation*. The proposed amended provisions would operate in such a way that only *one translation* would be required under Chapter I of the Treaty for all purposes, that is, for the processing of the international application by the receiving Office, for the international search and for the international publication, so that either the international application in its original language or the translation would be sufficient for each of these stages of the proceedings in the international phase (see Rules 12.3(a) and 48.3(a), (a-bis) and (b)). (The applicant might, in certain—very rare—cases, be required to furnish a second translation under Chapter II of the Treaty specifically for the purposes of international preliminary examination (see Rule 55.2).)



(d) If the language of filing of the international application is accepted by the receiving Office and the International Searching Authority, but is not a language of publication (at present, this is the case only where the international application is filed in Dutch and certain Nordic languages, which are accepted for international search because the European Patent Office and the Swedish Patent Office, respectively, are prepared to undertake searches in those languages; see paragraph 10, above), the international application would, as at present, be published in English, the translation into that language being prepared, pursuant to Rule 48.3(b), under the *responsibility of the International Searching Authority* which undertakes the search.

(e) *The request* would always have to be filed in a language which is accepted by the receiving Office and which is also one of the seven languages of publication, so as to avoid the proliferation of request forms in a variety of languages (see Rule 12.1(c)).

15. In view of the changes proposed, there seems to be no need to retain the present provisions (in Rule 12.1(b)) which expressly permit, in certain cases, the filing of any text matter of the drawings and the abstract in a language which is different from the language in which the description and claims are filed. However, the possibility of correcting those elements without loss of the international filing date, if they do not comply with language requirements, would be retained (see Rule 26.3*ter*).

16. In cases where the applicant fails to furnish, within the applicable time limit, a translation for the purposes of receiving Office processing, international search or international preliminary examination, the proposed provisions provide for the receiving Office or the International Preliminary Examining Authority, as the case may be, to invite the applicant to furnish the missing translation (see Rules 12.3(c) and 55.2(c)), in certain cases subject to the payment of a late furnishing fee (see Rule 12.3(c) to (e)). A separate invitation procedure is provided for the case where the request does not comply with language requirements (see Rule 26.3*ter*(c)). Where the applicant does not furnish the missing translation within the time limit fixed in the invitation, the international application would, subject to certain safeguards for the applicant, be considered withdrawn and the receiving Office would so declare (see Rule 12.3(d)), or the demand would be considered not to have been submitted and the International Preliminary Examining Authority would so declare (see Rule 55.2(d)), as the case may be.

17. In conjunction with the proposal to allow more flexibility for receiving Offices and applicants in relation to the language of filing, it is proposed to broaden the range of circumstances under Rule 19.4 in which an international application may be transmitted by a “non-competent” receiving Office to the International Bureau as receiving Office. The amended provisions would enable such transmittal also in cases where the international application is filed in a language which is not accepted by the Office with which it was first filed but which would be accepted by the International Bureau as receiving Office. Such transmittal would also be possible, under the amended provisions, for any other reason, provided that the receiving Office and the International Bureau so agree and that the transmittal is authorized by the applicant.

## ELECTRONIC FILING OF INTERNATIONAL APPLICATIONS

*(See Annex II: electronic filing, receipt and processing, application of Regulations and Administrative Instructions, transmission of notices, keeping of records and files)*

18. Great benefits for both industrial property Offices and patent applicants would be achieved from the use of modern computer technology for communications between applicants and Offices, including the filing of applications, for communications between Offices, and for processing within Offices, including the keeping of records and files.

19. An electronic filing system would enable applicants to create and file patent applications electronically (and to continue to communicate with the industrial property Office by the same means), thereby reducing errors, time for communication, and processing costs for applicants and Offices. Electronically filed applications would be more readily processed, published and stored than traditionally filed applications in paper form.

20. At its fifth session, held in May 1993, the PCT Committee for Administrative and Legal Matters decided to defer consideration of proposed amendments of the Regulations providing for electronic filing and storage. Some delegations at that session felt that, in addition to a general Rule permitting the electronic filing of international applications, there may be certain important legal questions which should be dealt with in the Regulations, in particular, the question whether the electronic version of an international application would be the authentic version for legal purposes. Development work on these technical and legal aspects related to electronic filing has been undertaken by the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office, in the course of their trilateral cooperation and in cooperation with WIPO. Issues remaining to be addressed include the maintenance of acceptable levels of confidentiality, data integrity, originator authentication, etc.

21. To take advantage of the possibilities provided by electronic filing under the PCT system, appropriate standards for electronic filing need to be adopted, having regard to the languages and practices used in the various PCT Offices and Authorities. Since the Regulations and Administrative Instructions envisage paper as the sole medium for filing applications, changes to them would be needed to enable applicants, Offices and Authorities to take advantage of the possibilities offered by electronic technology. It is envisaged that the standards would provide for the filing of applications in electronic form, such as on diskette, and eventually by electronic means, such as by on-line transmission.

22. Electronic techniques for filing international applications and other documents under the PCT system could be used in at least three different ways, as explained in the following paragraphs.

23. *Electronic transmission producing a document in paper form.* First, a document could be filed by electronic means with the aim of producing a printed document (that is, on paper) in the Office with which it is being filed, in the same way that a facsimile transmission may be used to produce a printed document. The use of all such telecommunication means is already encompassed by the wording of Rule 92.4(a), but it is proposed to amend that Rule to clarify that it is directed to cases where the result of the transmission is the filing of a printed or written document. In such cases, the legally determinative version of the document would be the printout made in the Office concerned (in the case of an international application, the

printout would be the record copy). The remaining provisions of Rule 92.4, relating to defective transmissions, the furnishing of originals, etc., would apply equally to documents filed by electronic transmission, such as a fax sent direct from a computer, as to those filed by other means of telecommunication, such as a facsimile transmission.

24. *Ancillary electronic version of a document in paper form.* The second way in which electronic techniques could be used in the filing of a document involves the furnishing of a computer-readable version of the document (for example, on diskette or by on-line electronic transmission) as well as filing the document on paper. In such a case, the electronic version of the document, which would have to comply with standards to be provided in the Administrative Instructions, would be used to simplify and make more accurate the capture of data, publication, communication of copies, etc., but the legally determinative version of the document would be the paper version. While it would be open to Offices, even under the present wording of the Regulations, to permit or encourage applicants (for example, by charging lower fees in such cases) to furnish such ancillary electronic versions of documents, it is proposed to introduce new Rule 89*ter* to enable receiving Offices to provide for the furnishing of such ancillary electronic versions.

25. *Document in electronic form.* The third way in which electronic techniques could be used in the filing of a document, and which is not presently possible under the Regulations, involves the filing of a document electronically whereupon the legally determinative version would be the document, as so filed, in electronic form. Paper versions could be produced for certain aspects of the procedure, but would not be legally determinative of the contents of the document as filed. It is proposed to include new Rule 89*bis* to provide for this possibility.

26. The standards and other details concerning the requirements for the filing and processing of electronically filed international applications for the third purpose just outlined should, at least initially, be set out in the Administrative Instructions, including any details for the procedures for the correction of defects in relation to the standards and other filing requirements. The experience gained with any electronic filing system and the rapidly changing technologies and standards require a solution which permits the making of changes and improvements rapidly whenever required, and this can be done ideally in the Administrative Instructions. Proposed new Rules 89*bis* and 89*ter* would thus not become operational until the necessary modifications to the Administrative Instructions have been made and the entry into force of those Rules would be linked to the promulgation of the implementing Administrative Instructions. Proposals for modification of the Administrative Instructions to introduce the standards and other requirements would be the subject of consultation, as usual, with the interested Offices and Authorities. It is envisaged that the Administrative Instructions would, as technical details of the proposed system are developed, be modified to cover further aspects of the processing of electronically filed international applications under the Treaty, including, but not limited to, the preparation, transmittal and communication of international applications and copies thereof (including the home copy, the search copy and the record copy), international publication, international search, international preliminary examination, and detailed requirements concerning the keeping of records and files.

27. It is envisaged that the draft Patent Law Treaty (PLT) will contain broad provisions dealing with the electronic filing of national and regional applications by reference to the requirements for electronic filing of international applications under the PCT. When amending the PCT Regulations, this future development should be borne in mind.

28. The proposed amendments to the PCT Regulations should be such as to afford applicants the option of electronically filing international applications and other documents and correspondence with those receiving Offices which are prepared to accept such filing (see proposed new Rule 89*bis*.1). However, no Office or Authority would be obliged to receive or process such filings (see proposed new Rule 89*bis*.1(d)), and no applicant would be obliged to depart from the usual (paper-based) procedures for filing international applications (see proposed new Rule 89*bis*.1(a)). Applicants would be informed via the *PCT Gazette*, the *PCT Applicant's Guide* and the *PCT Newsletter* as to which Offices accept the filing of international applications electronically.

29. While, as explained above, the detailed requirements for electronically filed international applications would be dealt with in the Administrative Instructions, most of the existing Regulations should apply *mutatis mutandis* to such applications (see proposed new Rule 89*bis*.1(b)). This means that, for example, Articles 11 and 14 and Rules 20 and 26 would apply to electronically filed international applications, subject to any special provisions specified in the Administrative Instructions. The necessary modifications of the Administrative Instructions would be promulgated only after consultation with the interested Offices and Authorities.

30. Certain other aspects of the PCT procedure are also the subject of proposed amendments to the Regulations in connection with electronic filing. First, it is proposed to provide in new Rule 89*bis*.3 that, where the PCT procedures require or provide for the transmittal of notifications and communications from one Office or Authority to another, those notifications and communications may be transmitted electronically where both the sending and receiving parties agree. In addition, it is proposed to amend Rule 93.4, which permits the storage of reproductions of files and records instead of the originals, to provide for storage as electronic or other reproductions as well as photographic reproductions.

## PRIORITY CLAIMS AND PRIORITY DOCUMENTS

*(See Annex III; contents, correction and addition of priority claims, time limit for furnishing priority documents, certified copies and translations of priority documents )*

31. The present requirements of the Regulations relating to the making of, and in particular the correction of mistakes in, priority claims cause considerable difficulty for many applicants. The proposals contained in this document are designed to liberalize those requirements to make it easier for applicants to correct mistakes, without adversely affecting the interests of third parties, and taking into account the needs of receiving Offices, international Authorities and designated and elected Offices.

32. Broadly, it is proposed to permit applicants to add or correct any priority claim until 16 months from the priority date. Some of the requirements as to the contents of priority claims are also proposed to be simplified.

33. Some rearrangement of the relevant provisions in the Regulations is proposed. The contents of a priority claim would continue to be dealt with in Rule 4.10. Provisions for correcting and adding priority claims would, however, be placed in new Rule 26*bis*, following

Rule 26 which deals with correction of the international application, rather than in Rule 4 which deals with the contents of the request.

34. Consistent with the more liberal approach proposed for making priority claims, it is also proposed to amend certain provisions relating to the furnishing of priority documents.

35. *Contents of priority claims.* Any priority claim would, as at present, have to indicate the filing date and the application number of the earlier application (see proposed Rule 4.10(a)(i) and (ii)). As to the other indications required to be included in a priority claim, it is proposed to adopt a different approach depending on whether the earlier application is a national application, a regional application or an international application.

36. A priority claim based on an earlier *national application* would, as at present, be required to indicate the *country* in which that earlier application was filed (see Rule 4.10(a)(iii)). For the purpose of identifying an earlier *regional application* or *international application*, however, what is needed in practice is not an indication of the country, or one of the (usually several) countries, for which such earlier application was filed (as under the present requirements) but rather an indication of the Office which processes the application. A priority claim based on an earlier *regional application*, therefore, would simply be required to indicate, in addition to the date and application number, the authority entrusted with the granting of regional patents under the regional patent treaty—that is, in practice, the *regional Office* concerned (see Rule 4.10(a)(iv)), and a priority claim based on an earlier *international application* would be required to indicate the PCT *receiving Office* with which it was filed (see Rule 4.10(a)(v)).

37. It needs to be remembered that, while the Paris Convention for the Protection of Industrial Property obliges its member States (which include all PCT Contracting States) to recognize a priority claim indicating date, number and *country*, such States are free to recognize a priority claim which does not indicate the country but rather indicates date, number and *Office*. Under proposed amended Rule 4.10(a), those Paris Convention member States which are also Contracting States of the PCT would be obliged to recognize a priority claim of the latter kind.

38. Where a priority claim is based on an earlier regional application or international application, the requirement to indicate the Office, whether or not a country for which the earlier application was filed is also indicated, would be a formality requirement under the PCT as contrasted with the substantive requirements for priority claims under the Paris Convention. Thus, a priority claim to an earlier regional application or international application which only indicates date, number and country, while containing sufficient indications to be recognized as a priority claim for the purposes of the Paris Convention, would give rise to a formal defect, so far as the PCT procedure is concerned, if it does not, in addition, indicate the Office. The indication of the Office is needed, in a priority claim based on an earlier regional or international application, for the proper identification of that earlier application. Notwithstanding that requirement, the indication of a country in addition to the Office, while not a requirement under the proposed amended provisions, is expressly allowed under Rule 4.10(b)(i). Where the earlier application is an international application, the two-letter code contained in the international application number accorded to that earlier application would, in practice, always indicate the receiving Office with which it was filed. The indication of that Office in such cases would therefore be a mere formality, and non-compliance could be

corrected *ex officio* by adding to the priority claim a specific indication of that receiving Office. It is envisaged that the Receiving Office Guidelines will reflect such a possibility.

39. Concerning the indication of the country, the PCT and all but one of the presently existing regional patent treaties include provisions which restrict membership to countries party to the Paris Convention, so that international applications and regional applications filed under such treaties must necessarily have been filed for at least one country party to the Paris Convention. Where the membership of a regional patent treaty is not so restricted (such as in the case of the African Regional Industrial Property Organization (ARIPO)), a priority claim based on an earlier application under that treaty would be required, by Rule 4.10(b)(ii), to indicate, in addition to the regional Office, a country party to the Paris Convention for which that earlier application was filed.

40. *Correction and addition of priority claims.* Proposed new Rule 26bis provides for the correction and addition of priority claims, for the receiving Office or the International Bureau to invite correction of a priority claim which does not comply with Rule 4.10, and for the consequences of failure to correct a defective priority claim upon invitation.

41. Pursuant to proposed new Rule 26bis.1, the applicant would be allowed, by a notice submitted to the receiving Office or the International Bureau, to correct or add any priority claim provided that the prescribed time limit is met. It would not be possible to correct or add a priority claim later than 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever expires first.

42. Proposed new Rule 26bis.2 provides for the receiving Office or the International Bureau to invite the applicant to correct any priority claim not complying with Rule 4.10. Failure to correct a defect, in response to the invitation, within the time limit under Rule 26bis.1(a) would result in the priority claim being considered, *for the purposes of the procedure under the PCT*, not to have been made (see Rule 26bis.2(b)). Such a finding would not, however, prevent a designated Office from recognizing such a priority claim for the purposes of the national phase if so permitted or required by national law. For example, a designated Office may be prepared, in some circumstances, to recognize a priority date which is earlier than 12 months before the international filing date. The possibility of review by designated Offices of a decision made by the receiving Office or the International Bureau to consider a priority claim not to have been made is dealt with in proposed amended Rule 82ter.1. With these possibilities in mind, express provision is made in Rules 26bis.2(c) and 48.2(a)(ix) for publication with the international application, if the applicant so requests, of information about a priority claim considered not to have been made under Rule 26bis.2(b). Such a publication would serve to warn third parties that a different priority date may apply in certain designated States.

43. *Time limit for furnishing priority documents; certified copies.* Rule 17.1, as proposed to be amended, would provide that in cases where a copy of the priority document is received by the International Bureau after the expiration of the 16-month time limit, if it reaches the International Bureau before international publication, the document shall be considered to have been received on the last day of the 16-month time limit. This would enable the needs of third parties and designated Offices for copies of priority documents to be met. Proposed Rule 17.1(c) would give applicants the assurance that designated States will not disregard a

priority claim which has not complied with the requirements of Rule 17.1(a) and (b) without first giving the applicant an opportunity to furnish the priority document within a reasonable time limit.

44. *Translations of priority documents.* Rules 17.2(a) and 76.4 are proposed to be amended so as to remove the provisions referring to certified translations of priority documents.

## DEPOSITS OF BIOLOGICAL MATERIALS

(See Annex IV)

45. It is proposed to broaden the scope of Rule 13*bis*, which provides for the furnishing of indications concerning deposits of microorganisms, so as also to cover deposits of other biological materials (see also proposed amended Rule 48.2).

## FEES<sup>2</sup>

(See Annexes V and VI; *fixing of equivalent amounts, time limits for payment, amount payable changing before payment, refunds in certain cases, late payment of Chapter II fees*)

46. *Fixing of equivalent amounts.* Three fees that are payable under the PCT for the benefit of the International Bureau, namely, the basic fee, the designation fee and the handling fee, are fixed in Swiss currency by the Assembly and are contained in the Schedule of Fees annexed to the Regulations. The search fee is fixed by each International Searching Authority in its own currency. The basic fee, designation fee and search fee are collected by the receiving Office, and the handling fee is collected by the International Preliminary Examining Authority. In the majority of cases, the basic, designation, search and handling fees are not paid in Swiss currency at the various receiving Offices and International Preliminary Examining Authorities since those Offices and Authorities generally prescribe payment in local currency. In a number of cases, receiving Offices prescribe that payment must be made in a foreign currency (generally in Swiss francs or US dollars). Some Offices and Authorities allow payment in a variety of currencies at the applicant's choice.

47. The establishment of equivalent amounts of the various fees is done according to procedures established in the Regulations: in respect of the basic and designation fees, in Rule 15.2(b) and (d); in respect of the search fee, in Rule 16.1(b) and (d); and in respect of the handling fee, in Rule 57.2(c) and (e). The Regulations also provide for the Assembly to give directives governing the procedures for adjusting the equivalent amounts as exchange rates fluctuate (see Rules 15.2(d), 16.1(d) and 57.2(e)). Such directives were adopted by the Assembly at its third session, held in Geneva from April 25 to May 1, 1979.

48. According to those directives, the Director General is required to consult, at the time of each ordinary session of the Assembly and, between such sessions, when the margin between a

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2. The contents of document PCT/A/XXIV/2, to the extent that they deal with fees, have been incorporated into the present document.

given currency and Swiss currency is plus or minus 10%, with the interested Offices and Authorities (that is, those prescribing payment in the currency concerned). In addition, any interested Office or Authority may ask the Director General to establish new equivalent amounts when the margin between a given currency and Swiss currency is plus or minus 5%.

49. The procedures for consultation in the fixing of equivalent amounts, as set out in the relevant Rules and directives, do not seem to be appropriate in all cases, particularly to the extent that they require consultation with Offices and Authorities which prescribe payment in a currency other than their official currency or the official currency of the country in which they are located.

50. It is therefore proposed to amend Rule 15.2(b) so as to provide that, in setting equivalent amounts of the basic fee and designation fee in a particular currency, the Director General shall consult (only) the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as that particular currency. A similar amendment is proposed to Rule 16.1(b) in respect of equivalent amounts of the search fee. It is also proposed to amend Rule 57.2(c) so as to provide that, in setting equivalent amounts of the handling fee in a particular currency, the Director General shall consult (only) the receiving Office consulted, under Rule 15.2(b) as proposed to be amended, in respect of the setting of equivalent amounts in that particular currency so far as the basic and designation fees are concerned or, if there is no such Office, the International Preliminary Examining Authority which prescribes payment in that particular currency. Any other Offices and Authorities which prescribe payment in a currency whose equivalent amount has been so fixed would simply be notified by the Director General of the equivalent amounts fixed as a result of each consultation. In relation to adjustments when exchange rates fluctuate, it is proposed to amend Rules 15.2(d), 16.1(d) and 57.2(e) along the same lines as Rules 15.2(b), 16.1(b) and 57.2(c).

51. It is also proposed that the Assembly's directives be modified along similar lines. The proposed modified directives (see Annex VI) also provide for the Director General to be able to initiate the consultation process with a view to establishing new equivalent amounts of the search fee, as at present, when the exchange rates fluctuate by plus or minus 10% or, under the proposed modifications, when the exchange rates fluctuate by plus or minus 5% but then only where that fee, expressed in its Swiss franc equivalent, is equal to or more than 1,000 Swiss francs. In other words, if the search fee, expressed in its Swiss franc equivalent, is less than 1,000 Swiss francs, a new equivalent is not established when the exchange rates fluctuate by less than plus or minus 10% (it is noted that consultation by the Director General on the basis of 5% fluctuations is the existing practice so far as the search fee charged by the European Patent Office is concerned).



52. *Time limits for payment.* At present, applicants make mistakes in paying fees because different fees have different time limits for payment. It is therefore proposed to amend the Regulations so as to fix, where possible, the same time limit, namely, one month from the date of receipt of the international application, for payment of all fees due upon filing of the application (with the exception of the designation fee). It is noted that such a one-month time limit is already provided for in respect of the basic fee and applies in practice to the transmittal fee. Similarly, a one-month time limit is proposed for fees payable upon filing a demand for international preliminary examination. Special provision would be made for those cases where the international application is transmitted to the International Bureau as receiving Office under Rule 19.4. The proposed amendments relate to Rules 14.1, 15.4(a) and (b), 16.1(f), 16*bis*.1, 57.3(a) and 58.1(b).

53. *Amount payable changing before payment.* It often happens, because of the fixing of new fees or because of variations in exchange rates, that the amount of a fee payable for the benefit of the International Bureau, as at the date of filing the international application or a demand, is different from the amount as at the date of payment. The Regulations make some special provisions in this respect, but only for the cases where the amount has increased between filing and payment. It has happened recently that the amounts of some fees in certain currencies have decreased between filing and payment. It is therefore proposed to amend the Regulations to cover all cases where the amounts of fees change (that is, cases involving both increases and decreases). The proposed amendments relate to Rules 15.4(c), 16.1(f) and 57.3(b).

54. *Refunds in certain cases.* At present, the Regulations do not provide for a refund of the international fee and search fee in the case where the international application is not treated as such due to reasons of national security, even though, in practice, since the record copy and the search copy are not transmitted to the International Bureau and the International Searching Authority, respectively, the situation is identical to that where the application is not accorded an international filing date or is withdrawn or considered withdrawn before the above-mentioned transmittals. It is therefore proposed to amend the Regulations so as to provide for refunds of the international fee and of the search fee in these circumstances (see Rules 15.6 and 16.2).

55. *Late payment of Chapter II fees.* It is proposed to amend the existing Rules dealing with non-payment of fees due when a demand is filed, aligning the approach, so far as possible, to that followed in relation to the non-payment of fees in respect of the filing of the international application (see Rules 57.4, 58.2, 58*bis*, 61.1(b) and 69.2).

56. *Other proposals relating to fees.* It is proposed to amend certain Rules so as to clarify the present wording or the practice relating to certain matters, including: the maximum number of designations for which a designation fee is payable under the Schedule of Fees (see Rule 15.1(ii)); the requirement of a designation fee and a confirmation fee in respect of each and every precautionary designation being confirmed (see Rule 15.5(a)); the maximum amount of the late payment fee under Rule 16*bis*.2; the fixing of the confirmation fee (see Rule 15.5(a) and the Schedule of Fees, item 3).

DECISIONS INVITED

57. *The Assembly of the PCT Union is invited:*

*(i) to adopt the amendments of the Regulations under the Patent Cooperation Treaty as proposed in Annexes I to V;*

*(ii) to modify its directives relating to the establishment of new equivalent amounts of certain fees as proposed in Annex VI;*

*(iii) to decide that the amended Regulations and modified directives shall enter into force on January 1, 1998, except Rules 89bis and 89ter, which shall enter into force upon promulgation of the Administrative Instructions implementing those Rules.*

[Annexes follow]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS  
RELATING TO  
LANGUAGE OF THE INTERNATIONAL APPLICATION

**Rule 11**

**Physical Requirements of the International Application**

[...]

11.14 *Later Documents*

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

## Rule 12

### Language of the International Application

#### and Translation for the Purposes of International Search

##### 12.1 ~~Admitted~~ Languages Accepted for the Filing of International Applications

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

*COMMENT: Paragraph (a) would allow each receiving Office to decide which languages it is prepared to accept for the filing of international applications. For example, the Portuguese National Institute of Industrial Property as receiving Office could decide to accept international applications filed in Portuguese; the Italian Patent and Trademark Office could decide to accept international applications filed in Italian; and so on. In such cases, a translation would have to be filed in a language accepted for international search by the competent International Searching Authority (see Rule 12.3(a)). For example, where the European Patent Office is the competent International Searching Authority, a translation into English, French or German would be required.]*

(b) Each receiving Office shall, for the filing of international applications, accept at least one language which is both:

(i) a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office, and

(ii) a language of publication.

~~Notwithstanding paragraph (a), the request, any text matter of the drawings, and the abstract need not be in the same language as other elements of the international application, provided that:~~

~~(i) the request is in a language admitted under paragraph (a) or in the language in which the international application is to be published;~~

~~(ii) the text matter of the drawings is in the language in which the international application is to be published;~~

~~(iii) the abstract is in the language in which the international application is to be published.~~

*[COMMENT: Paragraph (b) would ensure that at least one of the languages accepted by the receiving Office under paragraph (a) is both a language accepted by the International Searching Authority concerned and one of the languages of publication (see Rule 48.3(a)), so that the applicant would always have the option of filing the international application in a language such that no translation would be required for either search or publication purposes. In addition to that language, any other language could, of course, also be accepted by the receiving Office under paragraph (a), including any other language accepted by the International Searching Authority, whether a language of publication or not.]*

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

*[COMMENT: In order to avoid the proliferation of request forms in a variety of languages, it is proposed that the request would always have to be in a language which is both accepted by the receiving Office under paragraph (a) and a language of publication. Where the request does not comply with paragraph (c), the according of an international filing date would not be affected (see Rule 20.4(c))—except in the case of an international application filed with a receiving Office which has made a reservation under Rule 20.4(d)—and correction would be invited under Rule 26.3ter(c).]*

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

*[COMMENT: The present text of paragraph (d) is proposed to be deleted and replaced by an amendment relating to sequence listings, to be dealt with in document PCT/A/XXIV/7.]*

## 12.2 Language of Changes in the International Application

(a) Any ~~changes in amendment of~~ the international application, ~~such as amendments and corrections,~~ shall, subject to Rules 46.3, 55.3 and 66.9, be in the ~~same~~ language ~~as the said in~~ which the application is filed.

*[COMMENT: Paragraph (a) provides that, in general, any amendment to the international application (that is, furnished under Article 19 or 34) would be in the language of the international application as filed. However, where the international application is published in a language different from the one in which it is filed, that is, where a translation has been furnished by the applicant under Rule 12.3(a) (for search and publication purposes) or has been established under the responsibility of the International Searching Authority under Rule 48.3(b) (for publication purposes only), any amendment under Article 19 would have to be furnished in the language in which the international application is published, that is, in the language of the translation furnished by the applicant (see Rule 46.3). Where a translation has been furnished by the applicant under Rule 55.2 for the purposes of international preliminary examination, any amendment under Article 34 would have to be furnished in the language of that translation (see Rules 55.3 and 66.9).]*

(b) Any rectification under Rule 91.1 of an obvious error in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), 48.3(b) or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language of the application and the language of that translation;

(ii) where a translation of the request is required under Rule 26.3ter(c), rectifications referred to in Rule 91.1(e)(i) need only be filed in the language of that translation.

*[COMMENT: Paragraph (b) has been added to ensure that both the record copy and any translation furnished by the applicant for the purposes of international search, international*

*publication and/or international preliminary examination would contain any rectifications of obvious errors under Rule 91, with the exception that rectifications of obvious errors in the request (see Rule 91.1(e)(i)) or in any paper, other than the international application or amendments or corrections to that application (see Rule 91.1(e)(iv)), would need to be furnished only in the language in which the international application is to be published.]*

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or 55.2(a), or in a translation of the request furnished under Rule 26.3ter(c), shall be in the language of the translation.

*[COMMENT: Paragraph (c) deals with the language in which corrections of defects under Rule 26 have to be filed; as to the circumstances in which corrections will be required to either the international application as originally filed or any translation furnished under Rule 12.3, see Rule 26.3.]*

### 12.3 Translation for the Purposes of International Search

(a) Where the language in which the international application is filed is not accepted by the International Searching Authority that is to carry out the international search, the applicant shall, within one month from the date of receipt of the international application by the receiving Office, furnish to that Office a translation into a language which is all of the following:

(i) a language accepted by that Authority, and

(ii) a language of publication, and



(iii) a language accepted by the receiving Office under Rule 12.1(a), unless the international application is filed in a language of publication.

*[EXAMPLE 1: International application filed in a language which is a language of publication but is not a language accepted by the International Searching Authority. A translation into a language which is a language accepted by the competent International Searching Authority and a language of publication would then be required. For example, international application filed in Spanish with the Mexican Institute of Industrial Property: the applicant chooses the United States Patent and Trademark Office as International Searching Authority; a translation into English would be required for search purposes; international publication would be in the language of filing (that is, in Spanish—see Rule 48.3(a)).*

*EXAMPLE 2: International application filed in a language which is neither accepted by the International Searching Authority nor a language of publication: a translation would then be required into any language which is a language accepted by the competent International Searching Authority and a language of publication and a language accepted by the receiving Office. For example, international application filed in Italian with the Italian Patent and Trademark Office: the European Patent Office is the competent International Searching Authority; a translation would be required into English, French or German; international publication would be in the language of that translation (see Rule 48.3(a-bis)).]*

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

*[COMMENT: Amendments relating to sequence listings will be dealt with in document PCT/A/XXIV/7. As to the language of the request, see Rules 12.1(c) and 26.3ter(c).]*

(c) Where, by the time the receiving Office sends to the applicant the notification under Rule 20.5(c), the applicant has not furnished a translation required under paragraph (a), the receiving Office shall, preferably together with that notification, invite the applicant:

(i) to furnish the required translation within the time limit under paragraph (a);

(ii) in the event that the required translation is not furnished within the time limit under paragraph (a), to furnish it and to pay, where applicable, the late furnishing fee referred to in paragraph (e), within one month from the date of the invitation or two months from the date of receipt of the international application by the receiving Office, whichever expires later.

(d) Where the receiving Office has sent to the applicant an invitation under paragraph (c) and the applicant has not, within the applicable time limit under paragraph (c)(ii), furnished the required translation and paid any required late furnishing fee, the international application shall be considered withdrawn and the receiving Office shall so declare, provided that:

(i) that time limit may be extended by the receiving Office at any time before a decision is taken;

(ii) any translation and any payment received by the receiving Office before that Office makes the declaration under paragraph (d) shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to 50% of the basic fee.

*[COMMENT: The late furnishing fee appears to be necessary to deter applicants from deliberately delaying the furnishing of a translation until after having received an invitation by the receiving Office. A delay in furnishing the translation will delay issuance of the international search report.]*

## Rule 19

### The Competent Receiving Office

[...]

#### 19.4 *Transmittal to the International Bureau as Receiving Office*

(a) Where an international application is filed with a national Office which acts as a receiving Office under the Treaty ~~by an applicant who is a resident or national of a Contracting State,~~ but

- (i) that national Office is not competent under Rule 19.1 or 19.2 to receive that international application, or
- (ii) that national Office and the International Bureau agree, having regard to the language of the international application as filed or for any other reason, and with the authorization of the applicant, that the procedure under this Rule should apply.

that international application shall, subject to paragraph (b), be considered to have been received by that Office on behalf of the International Bureau as receiving Office under Rule 19.1(a)(iii).

*[COMMENT: It is proposed to expand the applicability of Rule 19.4 to cases where the language in which the international application is filed is not accepted by the Office with*

*which it is filed, regardless of the nationality or residence of the applicant. It is also proposed to permit the transmittal of an international application to the International Bureau as receiving Office in any other case, even if the receiving Office is competent, provided that the receiving Office and the International Bureau agree to do so and that the applicant authorizes the transmittal.*

*EXAMPLE 1: International application filed in French with the Australian Patent Office by two co-applicants having, respectively, Australian nationality and residence and Canadian nationality and residence. The Australian Patent Office, which is the competent International Searching Authority, does not accept French for international search. However, the international application could equally have been filed with the Canadian Intellectual Property Office, in which case the competent International Searching Authority would have been the European Patent Office, which does accept French for international search. Under proposed amended Rule 19.4, the Australian Patent Office could transmit the international application to the International Bureau as receiving Office, if both agree and the applicant authorizes the transmittal. The European Patent Office would then be available as competent International Searching Authority under Rule 35.3. No translation would then need to be furnished by the applicant under Rule 12.3.*

*EXAMPLE 2: International application filed in English with the Australian Patent Office by two co-applicants having, respectively, Australian nationality and residence and Canadian nationality and residence. The applicants purport to specify the European Patent Office as International Searching Authority, but the European Patent Office is not a competent International Searching Authority for international applications filed with the Australian Patent Office. However, if the application had been filed with the Canadian Intellectual Property Office, the European Patent Office would have been competent. Under proposed amended Rule 19.4, the Australian Patent Office could transmit the international application to the International Bureau as receiving Office, if both agree and the applicant authorizes the transmittal. The European Patent Office would then be available as competent International Searching Authority under Rule 35.3, and no change would be required to the choice of International Searching Authority made by the applicants.*

*EXAMPLE 3: International application filed with Canadian Intellectual Property Office by two co-applicants having, respectively, Australian nationality and residence and Canadian nationality and residence; the applicants purport to appoint as agent a person who is not entitled to practice before the Canadian Intellectual Property Office but who would be entitled to practice before the International Bureau as receiving Office having regard to Rule 83.1bis. Under proposed amended Rule 19.4, the Canadian Intellectual Property Office could transmit the international application to the International Bureau as receiving Office, if both agree and the applicant authorizes the transmittal. The appointed agent could then represent the applicants.*

*EXAMPLE 4: An international application is filed with the national Office of a Contracting State which only recently joined the PCT. If the staff of that Office are not yet sufficiently experienced in PCT procedures, that Office may prefer to ask the International Bureau as*

*receiving Office to accept the transmittal of the international application under proposed amended Rule 19.4, provided the applicant authorizes the transmittal.]*

[...]

## Rule 20

### Receipt of the International Application

[...]

#### 20.4 Determination Under Article 11(1)

(a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers comply with the requirements of Article 11(1).

(b) For the purposes of Article 11(1)(iii)(c), it shall be sufficient to indicate the name of the applicant in a way which allows his identity to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

(c) For the purposes of Article 11(1)(ii), it shall be sufficient that the ~~elements referred to in Article 11(1)(iii)(d) and (e)~~ part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims be in a language ~~admitted~~ accepted by the receiving Office under Rule 12.1(a) ~~or (e)~~.

*[COMMENT: Amendments relating to sequence listings will be dealt with in document PCT/A/XXIV/7.]*

(d) If, on ~~July 12, 1991~~ October 1, 1997, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by ~~December 31, 1991~~ November 15, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: It should be understood that each Office making a reservation under paragraph (d) should undertake the necessary measures to make the national law compatible with paragraph (c) as soon as possible.]*

[...]

**Rule 22**

**Transmittal of the Record Copy and Translation**

22.1 *Procedure*

[...]

(h) Where the international application is to be published in the language of a translation furnished under Rule 12.3, that translation shall be transmitted by the receiving Office to the International Bureau together with the record copy under paragraph (a) or, if the receiving Office has already transmitted the record copy to the International Bureau under that paragraph, promptly after receipt of the translation.

[...]



**Rule 23**

**Transmittal of the Search Copy, Translation and Sequence Listing**

23.1 *Procedure*

(a) The search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau unless no search fee has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.

(b) Where a translation of the international application is furnished under Rule 12.3, a copy of that translation and of the request, which together shall be considered to be the search copy under Article 12(1), shall be transmitted by the receiving Office to the International Searching Authority.

*[COMMENT: Other amendments, relating to sequence listings, will be dealt with in document PCT/A/XXIV/7.]*

## Rule 26

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

[...]

#### 26.3 *Checking of Physical Requirements Under Article 14(1)(a)(v)*

(a) Where the international application is filed in a language of publication, the receiving Office shall check:

(i) the international application for compliance with the ~~The~~ physical requirements referred to in Rule 11 ~~shall be checked~~ only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;

(ii) any translation furnished under Rule 12.3 for compliance with the physical requirements referred to in Rule 11, but only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.

*[EXAMPLE 1: International application filed in English; the receiving Office is required, as at present, to check the international application for compliance with Rule 11 to the extent necessary for the purpose of reasonably uniform international publication (see paragraph (a)(i)).*

*EXAMPLE 2: International application filed in Spanish with the Mexican Institute of Industrial Property and the applicant chooses the United States Patent and Trademark Office as International Searching Authority. A translation into English is required for search purposes, under Rule 12.3(a), but the international application will be published, under Rule 48.3(a), in Spanish. The receiving Office is required to check the international*

*application as filed in Spanish for compliance with Rule 11 to the extent necessary for the purpose of reasonably uniform international publication, but the translation into English (which will not be used for international publication, but only for the purposes of international search) is required to be checked for compliance with Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction (see paragraph (a)(ii).]*

(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:

(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction;

(ii) any translation furnished under Rule 12.3 and the drawings for compliance with the physical requirements referred to in Rule 11, but only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

*[EXAMPLE: International application filed in Italian with the Italian Patent and Trademark Office as receiving Office; the European Patent Office is the competent International Searching Authority; a translation is required, under Rule 12.3(a), into English, French or German. The receiving Office is required to check the translation (which will be used for the purposes of both international search and international publication) for compliance with Rule 11 to the extent necessary for the purpose of reasonably uniform international publication (see paragraph (b)(ii)), but the international application as filed is required to be checked for compliance with Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction (see paragraph (b)(i)).]*

26.3bis Invitation to Correct Defects Under Rule 11 ~~Article 14(1)(b)~~

The receiving Office shall not be required to issue the invitation to correct a defect under ~~Article 14(1)(a)(v)~~ Rule 11 where the physical requirements referred to in that ~~Rule 11~~ are complied with to the extent ~~necessary for the purpose of reasonably uniform international publication~~ required under Rule 26.3.

26.3ter Invitation to Correct Defects Under Article 3(4)(i)

(a) Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, ~~any element of the international application, other than those referred to in Article 11(1)(iii)(d) and (e), does not comply with Rule 12.1,~~ the receiving Office shall, unless

(i) a translation of the international application is required under Rule 12.3(a), or

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published,

invite the applicant to ~~file the required correction~~ furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published. Rules 26.1(a), 26.2, 26.3, 26.3bis, 26.5 and 29.1 shall apply *mutatis mutandis*.

*[COMMENT: Where the abstract is in a different language from that of the description and claims, a translation of the abstract will, in general, be required under paragraph (a). Such*

*translation will have to be into the language in which the international application is to be published. However, no translation of the abstract would be required if a translation of the international application is required under Rule 12.3(a), since the abstract would need to be included in the translation furnished under that Rule. Nor would a translation of the abstract be required if it is already in the language in which the international application is to be published, even if the description and claims are filed in another language. The position in relation to translations of any text matter in the drawings is the same as that just explained in relation to the abstract.*

*EXAMPLE 1: Description and claims filed in German with the German Patent Office; abstract filed in French. The European Patent Office is the competent International Searching Authority; the international application will be published in German. A translation of the abstract into German is required.*

*EXAMPLE 2: Description and claims filed in Italian with the Italian Patent and Trademark Office; text matter in drawings is in French. The European Patent Office is the competent International Searching Authority. Under Rule 12.3(a), a translation of the (entire) international application, including the text matter in the drawings, is required for the purposes of international search and international publication (that translation may be into English, French or German). A translation of that text matter into Italian is not required.*

*EXAMPLE 3: Description and claims filed in Dutch with the Netherlands Industrial Property Office; abstract filed in German. The European Patent Office as competent International Searching Authority accepts Dutch for the purpose of international search of such an international application, but the international application will be published in English (see Rule 48.3(b) as proposed to be amended). The receiving Office will, under Rule 26.3ter(a), invite the applicant to furnish a translation of the abstract into English. A translation of the (entire) international application into English will later be required under Rule 48.3(b) for the purposes of international publication. If, in the same case, the abstract had been filed in English, no translation of the abstract would have been required under Rule 26.3ter(a).*

*COMMENT: Rules 26.1(a) and 26.2 apply mutatis mutandis as to the time within which the receiving Office is required to issue an invitation under Rule 26.3ter(a) and the time limit within which the applicant would have to furnish the required translation. Pursuant to Rule 26.2, that time limit may be extended by the receiving Office at any time before a decision is taken. Rules 26.3 and 26.3bis would apply mutatis mutandis so that a translation of the abstract or any text matter in the drawings furnished under Rule 26.3ter(a) would need to be checked for compliance with Rule 11 to the extent necessary for the purpose of reasonably uniform international publication. Rules 26.5 and 29.1 apply mutatis mutandis where the applicant does not furnish a required translation within the time limit fixed in the invitation under Rule 26.3ter(a) (or as extended by the receiving Office): the application would be considered withdrawn and the receiving Office would so declare.]*

(b) If, on ~~July 12, 1991~~ October 1, 1997, paragraph (a) is not compatible with the national law applied by the receiving Office, paragraph (a) shall not apply to that receiving

Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by ~~December 31, 1991~~ November 15, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: It should be understood that each Office making a reservation under paragraph (b) should undertake the necessary measures to make the national law compatible with paragraph (a) as soon as possible.]*

(c) Where the request does not comply with Rule 12.1(c), the receiving Office shall invite the applicant to file a translation into a language as required by that Rule. Rules 3, 26.1(a), 26.2, 26.5 and 29.1 shall apply mutatis mutandis.

*[COMMENT: A translation of the request furnished pursuant to Rule 26.3ter(c) would have to be in the usual form for the request as provided by Rule 3, which applies here mutatis mutandis. Rules 26.1(a) and 26.2 would apply mutatis mutandis as to the time within which the receiving Office would be required to issue an invitation and to the time limit within which the applicant would have to furnish the required translation of the request. Pursuant to Rule 26.2, that time limit may be extended by the receiving Office at any time before a decision is taken. Rules 26.5 and 29.1 would apply mutatis mutandis where the applicant does not furnish the required translation within the time limit fixed in the invitation: the application would be considered withdrawn and the receiving Office would so declare.]*

(d) If, on October 1, 1997, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 15, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: It should be understood that each Office making a reservation under paragraph (d) should undertake the necessary measures to make the national law compatible with paragraph (c) as soon as possible.]*

[...]

## Rule 29

### International Applications or Designations Considered Withdrawn

~~under Article 14(1), (3) or (4)~~

#### 29.1 *Finding by Receiving Office*

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) the receiving Office shall transmit the record copy (unless already transmitted), and any correction offered by the applicant, to the International Bureau;

(ii) the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall in turn notify each designated Office which has already been notified of its designation;

(iii) the receiving Office shall not transmit the search copy as provided in Rule 23, or, if such copy has already been transmitted, it shall notify the International Searching Authority of the said declaration;



(iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy.

[...]

**Rule 37**

**Missing or Defective Title**

[...]

*37.2 Establishment of Title*

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with Rule 4.3, it shall itself establish a title. Such title shall be established in the language in which the international application is [to be](#) published or, if a translation [into another language](#) was transmitted under Rule ~~12.1(e)~~ [23.1\(b\)](#) and the International Searching Authority so wishes, in the language of that translation.

**Rule 38**

**Missing or Defective Abstract**

[...]

*38.2 Establishment of Abstract*

(a) If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is to be published or, if a translation into another language was transmitted under Rule ~~12.1(e)~~ 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[...]

**Rule 43**

**The International Search Report**

[...]

43.4 *Language*

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is [to be](#) published or, if a translation [into another language](#) was transmitted under Rule ~~12.1(e)~~ [23.1\(b\)](#) and the International Searching Authority so wishes, in the language of that translation.

[...]

**Rule 46**

**Amendment of Claims Before the International Bureau**

[...]

*46.3 Language of Amendments*

If the international application has been filed in a language other than the language in which it is published, any amendment made under Article 19 shall be in the language of publication.

[...]

*[COMMENT: No change to Rule 46.3 seems to be necessary.]*

**Rule 47**

**Communication to Designated Offices**

[...]

47.3 *Languages*

(a) The international application communicated under Article 20 shall be in the language in which it is published. ~~provided that if that language is different from the language in which it was filed it shall, on the request of the designated Office, be communicated in either or both of these languages.~~

(b) Where the language in which the international application is published is different from the language in which it was filed, the International Bureau shall furnish to any designated Office, upon the request of that Office in relation to a specified international application, a copy of that application in the language in which it was filed.

[...]

## Rule 48

### International Publication

[...]

#### 48.3 *Languages of Publication*

(a) If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(a-bis) If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3, that application shall be published in the language of that translation.

*[EXAMPLE: International application filed in Portuguese with the Portuguese National Institute of Industrial Property. A translation for the purposes of international search by the European Patent Office as competent International Searching Authority will be required (into English, French or German) under proposed new Rule 12.3; international publication will, under Rule 48.3(a-bis), be in the language of that translation.]*

(b) If the international application is filed in a language ~~other than Chinese, English, French, German, Japanese, Russian or Spanish~~ which is not a language of publication and no translation into a language of publication has been furnished under Rule 12.3, that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready

in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

*[EXAMPLE: International application filed in Danish with the Danish Patent Office; the applicant chooses the Swedish Patent and Registration Office, which accepts Danish for the purposes of international search, as competent International Searching Authority. No translation for international search is required under Rule 12.3(a) as proposed to be amended. A translation into English must then be prepared, under Rule 48.3(b), under the responsibility of the International Searching Authority, and the international application will be published in English.]*

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in



that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

[...]

## Rule 55

### Languages (International Preliminary Examination)

#### 55.1 *Language of Demand*

The demand shall be in the language of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication. However, if a translation of the international application is required under Rule 55.2, the demand shall be in the language of that translation.

#### 55.2 *Translation of International Application*

(a) Where neither the language in which the international application is ~~neither~~ filed nor the language in which the international application is published ~~in the language, or one of the languages, specified in the agreement concluded between the International Bureau and is~~ accepted by the International Preliminary Examining Authority ~~competent for that is to carry out~~ the international preliminary examination, ~~of that application, that Authority may require that, subject to paragraph (b),~~ the applicant shall, subject to paragraph (b), furnish with the demand a translation of the international application into ~~the a language, or one of the languages, specified in the said agreement~~ which is both:

(i) a language accepted by that Authority, and

(ii) a language of publication.

*[COMMENT: Paragraph (a) is proposed to be amended for consistency with the wording of proposed amended Rule 12.3(a).]*

(b) Where a translation of the international application into a language referred to in paragraph (a) was transmitted to the International Searching Authority under Rule ~~12.1(e)~~ [23.1\(b\)](#) and the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the applicant need not furnish a translation under paragraph (a). In such a case, unless the applicant furnishes a translation under paragraph (a), the international preliminary examination shall be carried out on the basis of the translation transmitted under Rule ~~12.1(e)~~ [23.1\(b\)](#).

(c) If the requirement of paragraph (a) is not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant complies with the invitation within the time limit under paragraph (c), the said requirement shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted [and the International Preliminary Examining Authority shall so declare.](#)

*[COMMENT: It is proposed to amend paragraph (d) so as to make it consistent with the corresponding provisions of Rule 12.3(d) as proposed to be amended.]*

(e) ~~[Deleted] Paragraphs (a) to (d) shall apply only where the International Preliminary Examining Authority has declared, in a notification addressed to the International Bureau, that it accepts to carry out international preliminary examination on the basis of the translation referred to in those paragraphs.~~

*[COMMENT: See the corresponding provisions of present Rule 12.1(d), which is also proposed to be deleted.]*

### 55.3 Translation of Amendments

(a) Where a translation of the international application is required under Rule 55.2, any amendments which are referred to in the statement concerning amendments under Rule 53.9 and which the applicant wishes to be taken into account for the purposes of the international preliminary examination, and any amendments under Article 19 which are to be taken into account under Rule 66.1(c), shall be in the language of that translation. Where such amendments have been or are filed in another language, a translation shall also be furnished.

(b) Where the required translation of an amendment referred to in paragraph (a) is not furnished, the International Preliminary Examining Authority shall invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(c) If the applicant fails to comply with the invitation within the time limit under paragraph (b), the amendment shall not be taken into account for the purposes of the international preliminary examination.

*[COMMENT: No change to Rule 55.3 seems to be necessary.]*

## **Rule 66**

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

[...]

#### *66.9 Language of Amendments*

(a) Subject to paragraphs (b) and (c), if the international application has been filed in a language other than the language in which it is published, any amendment, as well as any letter referred to in Rule 66.8(a), shall be submitted in the language of publication.

(b) If the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, any amendment, as well as any letter referred to in paragraph (a), shall be submitted in the language of that translation.

(c) Subject to Rule 55.3, if an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall, if practicable having regard to the time limit for establishing the international preliminary examination report, invite the applicant to furnish the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances.

(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails

to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

*[COMMENT: No change to Rule 66.9 seems to be necessary.]*

## Rule 69

### Start of and Time Limit for International Preliminary Examination

[...]

#### 69.2 Time Limit for International Preliminary Examination

The time limit for establishing the international preliminary examination report shall be:

- (i) 28 months from the priority date, or ~~if the demand was filed prior to the expiration of 19 months from the priority date;~~
- (ii) ~~nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date~~ eight months from the date of payment of the fees referred to in Rules 57.1 and 58.1(a), or
- (iii) eight months from the date of receipt by the International Preliminary Examining Authority of the translation referred to in Rule 55.2(a) and (c),

whichever expires last.

*[COMMENT: It is proposed to amend Rule 69.2 to provide that the time limit for establishment of the report would be eight months from the date on which the handling and preliminary examination fees are paid (see Annex V) or the date on which a translation required under Rule 55.2(a) is furnished, so as to take into account the cases where the start*



*of international preliminary examination is delayed due, for example, to late payment of the relevant fees or to late furnishing of the said translation. The period of eight months gives the International Preliminary Examining Authority, in practice, at least the same time for carrying out the international preliminary examination as the period provided by Rule 69.2(i).]*

**Rule 70**

**The International Preliminary Examination Report**

[...]

*70.17 Languages of the Report and the Annexes*

~~(a)~~ The report and any annex shall be in the language in which the international application to which they relate is published, or, if the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, in the language of that translation.

~~(b)~~

## Rule 92

### Correspondence

[...]

#### 92.2 *Languages*

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule ~~12.1(e)~~ [23.1\(b\)](#) or furnished under Rule 55.2(a) or (c), the language of such translation shall be used.

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

[...]

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

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

[...]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS  
RELATING TO  
ELECTRONIC FILING OF INTERNATIONAL APPLICATIONS

**PART F**

**Rules Concerning Several Chapters of the Treaty**

**Rule 89bis**

**Filing, Processing and Transmission of**

**International Applications and Other Documents in Electronic Form**

89bis.1 International Applications

(a) International applications may, subject to paragraphs (b) to (e), be filed and processed in electronic form, in accordance with the Administrative Instructions, provided that any receiving Office shall permit the filing of international applications on paper.

*[COMMENT: Proposed Rule 89bis.1(a) would be the general enabling provision allowing for electronic filing and processing. The legally determinative version of an international application in electronic form would be the electronic version, rather than any printout on paper which may be produced. This provision also requires that all PCT receiving Offices permit applicants to use paper to file their international applications.]*

(b) These Regulations shall apply *mutatis mutandis* to international applications filed in electronic form, subject to any special provisions of the Administrative Instructions.

*[COMMENT: It is clear that certain Rules cannot directly apply in the circumstance where international applications are filed in electronic form. For example, the operation of any Rule which refers to “papers” or “sheets” should desirably be clarified in the Administrative*

*Instructions as to its operation to international applications filed in electronic form. However, the general principles according to which international applications are processed, accorded an international filing date, and so on, would apply—notably, those which apply under Articles 11 and 14 and Rules 20 and 26.]*

(c) The Administrative Instructions shall contain detailed requirements in relation to the filing and processing of international applications filed, in whole or in part, in electronic form, for example, in relation to the acknowledgment of the receipt of such international applications, the according of an international filing date, the physical requirements for such international applications and the consequences of non-compliance with those requirements, the signature of documents, and the operation of Article 12 in relation to the home copy, the record copy and the search copy, and may contain different requirements for such international applications filed in different languages.

*[COMMENT: It is envisaged that the Administrative Instructions may initially provide for the electronic filing of only certain elements of the international application (such as the request). Details to be covered would include, for example, the format of the request in electronic form and as a computer printout, provisions for electronic “signature,” procedures for making changes to the international application, provisions for the mailing and labelling of computer diskettes, information on how to obtain any authorized electronic filing software, etc. These provisions would be supplemented once on-line filing (through the Internet or otherwise) becomes available.]*

(d) No national Office or intergovernmental organization shall be obliged to receive or process international applications filed in electronic form unless it has notified the International Bureau that it is prepared to do so. The International Bureau shall publish the information so notified in the Gazette.

(e) No receiving Office which has given the International Bureau a notification under paragraph (d) may refuse to process an international application filed in electronic form which complies with the applicable requirements under the Administrative Instructions.

#### 89bis.2 Other Documents

Rule 89bis.1 shall apply *mutatis mutandis* to other documents and correspondence relating to international applications.

*[COMMENT : Proposed Rule 89bis.2 would extend the provisions concerning electronic filing to apply to other documents (such as amendments) and correspondence relating to international applications.]*

#### 89bis.3 Transmittal Between Offices

Where the Treaty, these Regulations or the Administrative Instructions provide for documents, notifications, communications or correspondence to be transmitted by one national Office or intergovernmental organization to another, such transmittal may, where so agreed by both the sender and the receiver, be effected in electronic form.

*[COMMENT : Proposed Rule 89bis.3 would introduce into the Regulations the content of existing Section 114 of the Administrative Instructions, which provides for notifications and communications from one national Office or intergovernmental organization to another to be effected electronically with the agreement of both.]*

**Rule 89ter**

**Copies in Electronic Form of Documents Filed on Paper**

*89ter.1 Copies in Electronic Form of Documents Filed on Paper*

Any national Office or intergovernmental organization may provide that, where an international application or other document relating to an international application is filed on paper, a copy thereof in electronic form, in accordance with the Administrative Instructions, may be furnished by the applicant.

*[COMMENT: See paragraph 24 of the document.]*



## Rule 92

### Correspondence

[...]

#### 92.4 *Use of Telegraph, Teleprinter, Facsimile Machine, Etc.*

(a) A document making up the international application, and any later document or correspondence relating thereto, may, notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraph (h), be transmitted, to the extent feasible, by telegraph, teleprinter, facsimile machine or other like means of communication [resulting in the filing of](#) ~~producing~~ a printed or written document.

*[COMMENT: The proposed amendment of Rule 92.4(a) makes it clear that the Rule deals with transmissions by means of telecommunication which result in the filing of a document in paper form, as distinct from the filing of a document in electronic form under proposed new Rule 89bis. While electronic means would invariably be used to transmit documents under Rule 92.4, it is the printout on paper at the intended destination which is legally determinative. Apart from telegraph, teleprinter and facsimile transmission as mentioned in the text of the Rule itself, the Rule would also encompass, for example, the sending of a fax from a computer.]*

[...]

## Rule 93

### Keeping of Records and Files

[...]

#### 93.4 Reproductions

For the purposes of this Rule, records, copies and files may be kept as ~~shall also mean~~ photographic, electronic or other reproductions, ~~of records, copies, and files, whatever may be the form of such reproductions (microfilms or other)~~ provided that the reproductions are such that the obligations to keep records, copies and files under Rules 93.1 to 93.3 are met.

*[COMMENT : Rule 93.4 permits records, copies and files to be kept as reproductions rather than in their original form (which presently is always on paper). The present limitation in Rule 93.4 to photographic reproductions, which could be on paper or in another form such as microfilm, has become out of date in the light of technological advances which have facilitated the storage of records and files on computer disks, on optical disks or in microform. In addition, Rule 93.4 should take into account proposed new Rule 89bis which would provide for the possibility of filing international applications in electronic form. It is therefore proposed that Rule 93.4 be amended to add provisions allowing for storage as electronic or other reproductions.]*

[Annex III follows]

ANNEX III

PROPOSED AMENDMENTS OF THE PCT REGULATIONS  
RELATING TO  
PRIORITY CLAIMS AND PRIORITY DOCUMENTS

**Rule 4**

**The Request (Contents)**

[...]

4.10 *Priority Claim*

(a) ~~The~~ Any declaration referred to in Article 8(1) (“priority claim”) shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date;

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

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

~~(ii) the date on which it was filed,~~

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

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

*[COMMENT: See paragraphs 35 to 38 of the document. Proposed amended Rule 4.10(a) would not require a priority claim based on an earlier regional application to indicate any country “for which” that earlier application was filed but, rather, it would be necessary, under item (iv), for such a priority claim to indicate the regional Office concerned. Similarly, a priority claim based on an earlier international application would not have to indicate any country for which that earlier application was filed but would rather have to indicate the receiving Office with which it was filed. However, the indication of one or more countries for which the earlier application was filed would continue to be allowed (and, in the case of earlier applications for ARIPO patents, to be required), under proposed amended Rule 4.10(b). As to checking, correction and addition of priority claims, see proposed new Rule 26bis.]*

(b) In addition to any indication required under paragraph (a)(iv) or (v):

(i) where the earlier application is a regional application or an international application, the priority claim may indicate one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed;

(ii) where the earlier application is a regional application and the countries party to the regional patent treaty are not all party to the Paris Convention for the Protection of Industrial Property, the priority claim shall indicate at least one country party to that Convention for which that earlier application was filed.

*[COMMENT: See paragraphs 38 and 39 of the document.]*

~~If the request does not indicate both~~

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

~~(ii) the date on which the earlier application was filed,~~

~~the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made. However, where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous, the receiving Office may, at the request~~

~~of the applicant, make the necessary correction. The error shall be considered as an obvious error whenever the correction is obvious from a comparison with the earlier application. Where the error consists of the omission of the indication of the said date, the correction can only be made before the transmittal of the record copy to the International Bureau. In the case of any other error relating to the indication of the said date or in the case of any error relating to the indication of the said country, the correction can only be made before the expiration of the time limit under Rule 17.1(a) computed on the basis of the correct priority date.~~

*[COMMENT: As to correction of priority claims, see proposed new Rule 26bis.]*

(c) For the purposes of paragraphs (a) and (b), Article 2(vi) shall not apply. ~~If the application number of the earlier application is not indicated in the request but is furnished by the applicant to the International Bureau or to the receiving Office prior to the expiration of the 16th month from the priority date, it shall be considered by all designated States to have been furnished in time.~~

*[COMMENT: Paragraph (c) is necessary to clarify that “national application” in proposed amended Rule 4.10(a) and (b) does not include “regional application.”]*

(d) [Deleted] ~~If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so~~

~~indicated. If the applicant fails to act accordingly within one month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled *ex officio*.~~

*[COMMENT: As to correction of priority claims, see proposed new Rule 26bis.]*

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

[...]

## Rule 17

### The Priority Document

#### 17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under Article 8, ~~in the international application,~~ a copy of ~~the~~ that earlier ~~said national~~ application, certified by the authority with which it was filed (“the priority document”), shall, unless already filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraph (b), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application. ~~or, in the case referred to in Article 23(2), not later than at the time the processing or examination is requested.~~

*[COMMENT: It is proposed to make paragraph (a) equally applicable to both national (including regional—see Article 2(vi)) and international applications. The preparation of a certified copy of an earlier international application used as the basis of a priority claim is the responsibility of the receiving Office with which that earlier application was filed (see Rule 20.9).]*

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not



later than ~~the expiration of the applicable time limit referred to under paragraph (a)~~ 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(c) If the requirements of neither of the two preceding paragraphs are complied with, any designated State may disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

*[COMMENT: Proposed amended paragraph (c) would give the applicant the opportunity to furnish a copy of the priority document direct to a designated Office during the national phase where he has not complied with paragraph (a) or (b). A designated Office would be entitled to disregard the priority claim in such a case only after first giving the applicant an opportunity to furnish the priority document within a reasonable time limit.]*

## 17.2 Availability of Copies

(a) ~~The~~ Where the applicant has complied with Rule 17.1(a) or (b), the International Bureau shall, at the specific request of the designated Office, promptly but not ~~before the expiration of the time limit fixed in Rule 17.1(a)~~ prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. ~~except where it requires the furnishing of a copy of the priority document together with a certified translation thereof.~~ The applicant shall not be required to furnish a ~~certified~~ translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific

request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

*[COMMENT: This amendment will have the effect of deleting from Rule 17.2(a) the possibility that a designated Office may require the furnishing of a copy of the priority document together with a certified translation thereof.]*

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

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

(i) the international application was withdrawn,

(ii) the relevant priority claim was withdrawn or considered, under Rule ~~4.10(b)~~ 26bis.2(b), not to have been made. ~~or~~

~~(iii) the relevant declaration under Article 8(1) was cancelled under Rule 4.10(d).~~

*[COMMENT: The changes to paragraph (c) are consequential on the proposed amendments of Rule 4.10 and proposed new Rule 26bis.]*

~~(d) [Deleted] Paragraphs (a) to (c) shall apply also to any earlier international application whose priority is claimed in the subsequent international application.~~

Rule 26bis

Correction or Addition of Priority Claim

26bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct or add any priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever expires first.

*[COMMENT: See paragraphs 40 and 41 of the document.]*

(b) Any notice referred to in paragraph (a) received by the receiving Office or the International Bureau after the applicant has made a request for early publication under Article 21(2)(b) shall be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed.

(c) Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date resulting from the correction or addition.

*[COMMENT: The wording of paragraph (c) derives from that of Rule 90bis.3(d), which concerns the effects of the withdrawal of a priority claim. Where the correction or addition of a priority claim causes a change to a priority date, the applicant may find himself in the position of being outside the time limit for paying designation fees under Rule 15.4(b), so that the receiving Office would send an invitation under Rule 16bis to pay those fees together with*

*a late payment fee. It also needs to be recognized, where an earlier priority date results from the operation of paragraph (c), that there may be insufficient time in practice for the International Searching Authority to establish the international search report within the time limit set out in Rule 42.1, and international publication may therefore take place prior to the establishment of the international search report.]*

26bis.2 Invitation to Correct Defects in Priority Claims

(a) The receiving Office or, if the receiving Office fails to do so, the International Bureau, shall invite the applicant to correct any priority claim which does not comply with the requirements of Rule 4.10.

*[COMMENT: See paragraph 42 of the document.]*

(b) If, in response to an invitation under paragraph (a), the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim so as to comply with the requirements of Rule 4.10, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly.

*[COMMENT: See paragraph 42 of the document.]*

(c) Where the receiving Office or the International Bureau has made a declaration under paragraph (b), the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for

international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish information concerning the priority claim which was considered not to have been made together with the international application. A copy of that request shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

*[COMMENT: See paragraph 42 of the document. The wording of this provision derives from that of Rule 91.1(f). See also proposed new Rule 48.2(a)(ix).]*

## Rule 48

### International Publication

[...]

#### 48.2 Contents

(a) The pamphlet shall contain:

[...]

(viii) [the essence of](#) any indications in relation to a deposited ~~microorganism~~ [biological material](#) furnished under Rule 13*bis* separately from the description, together with an indication of the date on which the International Bureau received such indications.

[\(ix\) any information concerning a priority claim considered not to have been made under Rule 26\*bis\*.2\(b\), the publication of which is requested under Rule 26\*bis\*.2\(c\).](#)

*[COMMENT: In respect of proposed amended Rule 48.2(a)(viii), see Annex IV of the document. In respect of proposed amended Rule 48.2(a)(ix), see paragraph 42 of the document.]*

[...]

**Rule 76**

**Copy, Translation and Fee Under Article 39(1); Translation of Priority Document**

[...]

*76.4 Time Limit for Translation of Priority Document*

The applicant shall not be required to furnish to any elected Office a **certified** translation of the priority document before the expiration of the applicable time limit under Article 39.

*[COMMENT: This proposed amendment will have the effect that designated Offices may no longer require certified translations of priority documents.]*

[...]

**Rule 82ter**

**Rectification of Errors Made by the Receiving Office or by the International Bureau**

*82ter.1 Errors Concerning the International Filing Date and the Priority Claim*

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the ~~declaration made under Article 8(1) priority claim~~ has been erroneously considered cancelled ~~or corrected~~ by the receiving Office or the International Bureau not to have been made, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the ~~declaration made under Article 8(1) priority claim~~ had not been ~~cancelled or corrected, as the case may be~~ considered not to have been made.

[Annex IV follows]



ANNEX IV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS  
RELATING TO  
DEPOSITS OF BIOLOGICAL MATERIALS

**Rule 13bis**

**Microbiological Inventions** [Relating to] [in Respect of] Biological Material

13bis.1 *Definition*

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

*[COMMENT: It is proposed to amend Rule 13bis by replacing the word “microorganism” by the words “biological material” throughout, so as to take into account recent developments in the field of biotechnology. The title of the Rule would be amended along the same lines.]*

13bis.2 *References (General)*

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

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

- (a) A reference to a deposited ~~microorganism~~ biological material shall indicate~~;~~:
- (i) the name and address of the depositary institution with which the deposit was made;
  - (ii) the date of deposit of the ~~microorganism~~ biological material with that institution;
  - (iii) the accession number given to the deposit by that institution; and
  - (iv) any additional matter of which the International Bureau has been notified pursuant to Rule 13bis.7(a)(i), provided that the requirement to indicate that matter was published in the Gazette in accordance with Rule 13bis.7(c) at least two months before the filing of the international application.
- (b) Failure to include a reference to a deposited ~~microorganism~~ biological material or failure to include, in a reference to a deposited ~~microorganism~~ biological material, an indication in accordance with paragraph (a)~~;~~ shall have no consequence in any designated State whose national law does not require such reference or such indication in a national application.

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

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

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

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

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

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

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

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

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

(ii) if the indication was received after the technical preparations for international publication have been completed, notify that date and the essence of any such indication to the designated Offices.

*[COMMENT: It is proposed to restructure Rule 13bis.4 by separating the present text into four paragraphs, subject to editorial changes. In addition, it is proposed to introduce the same provision so far as the time limit for furnishing indications is concerned, as that presently in Rule 46.1 (in respect of amendments under Article 19) and Rule 91.1(g-bis) (in respect of rectifications of obvious errors), and in Rule 17.1(a) (in respect of priority documents) as proposed to be amended—see Annex III. It is also proposed to include, as new paragraph (d)(ii), the basis for the present practice of the International Bureau in notifying designated Offices of the date of receipt of indications under Rule 13bis.3 where that date is after the completion of technical preparations for international publication.]*

*13bis.5 References and Indications for the Purposes of One or More Designated States;*

*Different Deposits for Different Designated States; Deposits with Depositary*

*Institutions Other than Those Notified*

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

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

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

*[COMMENT: Merely a drafting change.]*

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

(a) [Deleted] ~~Where the international application contains a reference to a deposited microorganism, the applicant shall, upon the request of the International Searching Authority or the International Preliminary Examining Authority, authorize and assure the furnishing of a sample of that microorganism by the depositary institution to the said Authority, provided that the said Authority has notified the International Bureau that it may require the furnishing of samples and that such samples will be used solely for the purposes of international search or international preliminary examination, as the case may be, and such notification has been published in the Gazette.~~

*[COMMENT: It is proposed to delete Rule 13bis.6(a) since all International Searching and Preliminary Examining Authorities indicated during the sixth session of the Meeting of International Authorities in February 1997 that they had never made use of the possibility of requiring the furnishing of a sample under that Rule and that they would agree to its deletion.]*

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

*13bis.7 National Requirements: Notification and Publication*

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

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

(ii) that one or more of the indications referred to in Rule 13bis.3(a) are required to be included in a national application as filed or are required to be furnished at a time specified in the notification which is earlier than 16 months ~~after~~ from the priority date.

*[COMMENT: Merely a drafting change.]*

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

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



**Rule 48**

**International Publication**

[...]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) a standardized front page,

(ii) the description,

(iii) the claims,

(iv) the drawings, if any,

(v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a); the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet,

(vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4,

(vii) any request for rectification referred to in the third sentence of Rule 91.1(f),

(viii) the essence of any indications in relation to a deposited ~~microorganism~~

biological material furnished under Rule 13bis separately from the description, together with an indication of the date on which the International Bureau received such indications.

*[COMMENT: It is proposed to amend Rule 48.2(a)(viii) so as to align it to proposed amended Rule 13bis in which the word “microorganism” would be replaced by the words “biological material” and to reflect the wording of proposed Rule 13bis.4(d) in relation to publication of “the essence” of indications furnished separately from the description.]*

[...]

[Annex V follows]

ANNEX V

PROPOSED AMENDMENTS OF THE PCT REGULATIONS  
RELATING TO  
FEES

**Rule 14**

**The Transmittal Fee**

14.1 *The Transmittal Fee*

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

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

(c) The transmittal fee shall be paid within one month from the date of receipt of the international application, provided that, where the international application is transmitted to the International Bureau under Rule 19.4(b), that fee shall be paid within one month from the date of actual receipt of the international application by the International Bureau. For the purposes of this paragraph, the last sentence of Rule 19.4(b) shall not apply.

*[COMMENT: It is proposed to amend Rule 14.1(b) and add new Rule 14.1(c) to provide for a uniform time limit for payment of the transmittal fee for all receiving Offices, namely, one month from the date of receipt of the international application (that is, the same time limit as*

*that applicable in respect of the international fee and the search fee). In the case where the international application is transmitted to the International Bureau under Rule 19.4, the time limit would be calculated from the date of receipt by the latter.]*

## Rule 15

### The International Fee

#### 15.1 *Basic Fee and Designation Fee*

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

(i) a “basic fee,” and

(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a) ~~by the applicant in the international application~~, except that, where Article 44 applies in respect of a designation, only one designation fee shall be due for that designation, and that the Schedule of Fees may indicate a maximum number of designation fees payable.

*[COMMENT: It is proposed to amend Rule 15.1(ii) to include a reference to the maximum number of designation fees payable under the Schedule of Fees.]*

#### 15.2 *Amounts*

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

(b) The basic fee and the designation fee shall be payable in the currency or one of the currencies prescribed by the receiving Office (“prescribed currency”), it being understood that, when transferred by the receiving Office to the International Bureau, they shall be freely convertible into Swiss currency. The amounts of the basic fee and of the designation fee shall be established, for each receiving Office which, ~~under Rule 15.3,~~ prescribes the payment of those fees in a any currency ~~or currencies~~ other than Swiss currency, by the Director General after consultation with ~~that~~ the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as and in the prescribed currency. ~~or currencies prescribed by that Office (“prescribed currency”).~~ The amounts so established ~~in each prescribed currency~~ shall be the equivalents, in round figures, of the amounts in Swiss currency set out in the Schedule of Fees. They shall be notified by the International Bureau to each receiving Office prescribing payment in that prescribed currency and shall be published in the Gazette.

*[COMMENTS: It is proposed to delete the existing text of Rule 15.3 and to include it (with minor changes) as the first sentence of Rule 15.2(b), so as to parallel Rule 16.1(b) relating to the search fee. A number of receiving Offices have prescribed payment of the fees in currencies other than their official currency (for example, US dollars, Swiss francs). It is proposed to make it clear that, for the purposes of establishing equivalent amounts of the basic fee and the designation fee in such a currency, the Director General would consult only the Office for which the currency concerned is the official currency. Similar amendments are proposed in relation to the fixing of equivalent amounts of the search fee under Rule 16.1 and the handling fee under Rule 57.2.]*

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

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

*[COMMENT: It is proposed to amend Rule 15.2(d) consequential on the proposed amendment of Rule 15.2(b). It is also proposed to invite the Assembly to modify its directives; see Annex VI.]*

#### 15.3 ~~[Deleted]~~ *Mode of Payment*

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

*[COMMENT: See comment on Rule 15.2(b).]*

#### 15.4 Time Limit for ~~of~~ *Payment*

(a) The basic fee shall be paid within one month from the date of receipt of the international application, provided that, where the international application is transmitted to the International Bureau under Rule 19.4(b), the basic fee shall be paid within one month from the

date of actual receipt of the international application by the International Bureau. For the purposes of this paragraph, the last sentence of Rule 19.4(b) shall not apply.

(b) The designation fee shall be paid: within a time limit of one year from the priority date or of one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date, provided that, where the international application is transmitted to the International Bureau under Rule 19.4(b), that fee shall be paid within one month from the date of actual receipt of the international application by the International Bureau, if that month expires later than that time limit. For the purposes of this paragraph, the last sentence of Rule 19.4(b) shall not apply.

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

~~(ii) where the international application contains a priority claim under Article 8, within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date.~~

*[COMMENT: The Rule has been redrafted so as to simplify the wording. Otherwise, see comment on Rule 14.1(c).]*

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



~~it was~~ from that applicable on the date on which the international application was received (“the ~~lower~~ previous amount”),

(i) the ~~lower~~ previous amount shall be due, provided that the revised amount may, even if it is lower than the previous amount, be paid if payment is made if the fee is paid within one month from the date of receipt of the international application. ~~;~~

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

*[COMMENT: Rule 15.4(c) presently covers only the situation where the amount of a fee in a given currency increases. However, it also happens that the amount decreases. It is proposed to amend the Rule so as, in effect, to cover both increases and decreases. In the interests of certainty, the general rule would be that the previous amount would be payable. If a fee increases, that original (lower) amount would be payable, even if payment is made after the one-month time limit for payment, noting that late payment is in any event subject to a 50% late payment fee. However, if a fee decreases, the applicant would be entitled to pay the revised (lower) amount, but only if payment is made within the one-month time limit for payment.]*

#### 15.5 Fees Under Rule 4.9(c)

(a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(c) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office), ~~as set out in the Schedule of Fees~~ equal to 50% of the sum of the designation fees payable under this paragraph. Such fees

shall be payable in respect of each designation so confirmed, even if the maximum number of designation fees referred to in item 2(a) of the Schedule of Fees is already payable or if a designation fee is already payable in respect of the designation under Rule 4.9(a) of the same State for a different purpose.

*[COMMENT: It is proposed to spell out in Rule 15.5 itself, rather than in the Schedule of Fees, what is the amount of the confirmation fee for designations confirmed under Rule 4.9(c). It is also proposed to make it clear, in line with the present understanding, that designation and confirmation fees are due in all cases irrespective of the purpose of the designation and of whether there is already a designation of the State concerned for a different purpose, such as, but not limited to, obtaining a national or regional patent and obtaining a kind of protection other than a patent.]*

(b) Where moneys paid by the applicant within the time limit under Rule 4.9(b)(ii) are not sufficient to cover the fees due under paragraph (a), the receiving Office shall allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.

#### 15.6 Refund

The receiving Office shall refund the international fee to the applicant:

- (i) if the determination under Article 11(1) is negative, ~~or~~
- (ii) if, before the transmittal of the record copy to the International Bureau, the international application is withdrawn or considered withdrawn, or

(iii) if, due to prescriptions concerning national security, the international application is not treated as such.

*[COMMENT: It is proposed to amend Rule 15.6 so as to make it mandatory for the receiving Office to refund the international fee where reasons of national security prevent the international application from being treated as such. It is proposed to amend Rule 16.2 along the same lines in respect of refund of the search fee.]*

## Rule 16

### The Search Fee

#### 16.1 *Right to Ask for a Fee*

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

(b) The search fee shall be collected by the receiving Office. The said fee shall be payable in the currency or one of the currencies prescribed by that Office (“~~the~~ receiving Office currency”), it being understood that, if any receiving Office currency is not that, or one of those, in which the International Searching Authority has fixed the said fee (“~~the~~ fixed currency ~~or currencies~~”), it shall, when transferred by the receiving Office to the International Searching Authority, be freely convertible into the currency of the State in which the International Searching Authority has its headquarters (“~~the~~ headquarters currency”). The amount of the search fee in any receiving Office currency, other than the fixed currency ~~or currencies~~, shall be established by the Director General after consultation with ~~that~~ the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as the receiving Office currency. The amounts so established shall be the equivalents, in round figures, of the amount established by the International Searching Authority in the headquarters currency. They shall be notified by the International Bureau to each receiving Office prescribing payment in that receiving Office currency and shall be published in the Gazette.

*[COMMENT: It is proposed to amend Rule 16.1(b) along the same lines as Rule 15.2(b) so far as the question of establishing equivalent amounts of the search fee in certain currencies is concerned.]*

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

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

*[COMMENT: It is proposed to amend Rule 16.1(d) consequential on the proposed amendment of Rule 16.1(b). It is also proposed to invite the Assembly to modify its directives; see Annex VI.]*

(e) Where, in respect of the payment of the search fee in a receiving Office currency, other than the fixed currency or currencies, the amount actually received by the International Searching Authority in the headquarters currency is less than that fixed by it, the difference will

be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) As to the time limit for ~~of~~ payment of the search fee, the provisions of Rule 15.4(a) and (c) relating to the basic fee shall apply.

*[COMMENT: It is proposed that Rule 16.1(f), in respect of the time limit for payment of the search fee, operate along the same lines as Rules 14.1(c) and 15.4(a).]*

## 16.2 Refund

The receiving Office shall refund the search fee to the applicant:

- (i) if the determination under Article 11(1) is negative, ~~of~~
- (ii) if, before the transmittal of the search copy to the International Searching Authority, the international application is withdrawn or considered withdrawn, or
- (iii) if, due to prescriptions concerning national security, the international application is not treated as such.

*[COMMENT: It is proposed to amend Rule 16.2 along the same lines as Rule 15.6 in respect of refund of the search fee in cases where national security provisions would apply.]*

[...]

**Rule 16bis**

**Extension of Time Limits for Payment of Fees**

*16bis.1 Invitation by the Receiving Office*

(a) Where, by the time they are due under Rules ~~14.1(b)~~ 14.1(c), ~~Rule~~ 15.4(a) and ~~Rule~~ 16.1(f), the receiving Office finds that ~~in respect of an international application~~ no fees were paid to it, ~~by the applicant~~, or that the amount paid to it ~~by the applicant~~ is less than what is necessary to cover the transmittal fee, the basic fee and the search fee, the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

(b) Where, by the time they are due under Rule 15.4(b), the receiving Office finds that ~~in respect of an international application~~ the payment made ~~by the applicant~~ is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) or (b) and the applicant has not, within ~~one month from the date of the invitation~~ the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall, subject to paragraph (d):

(i) allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions,

(ii) make the applicable declaration under Article 14(3), and

(iii) proceed as provided in Rule 29.

(d) Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) or (b) shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.4(a) or (b) or 16.1(f), as the case may be.

(e) Any payment received by the receiving Office before that Office makes the applicable declaration under Article 14(3) shall be considered to have been received before the expiration of the time limit referred to in paragraph (a) or (b).

*[COMMENT: It is proposed to amend Rule 16bis.1(a) and (b) so as to refer to Rule 14.1(c) instead of Rule 14.1(b), following the amendment to Rule 14.1. It is also proposed to amend Rule 16bis.1(c) and add new Rule 16bis.1(d) and (e) to recognize payments as being timely if they are received before the receiving Office sends an invitation or declares the international application to be considered withdrawn, as applicable.]*

#### *16bis.2 Late Payment Fee*

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) or (b) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:



(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of the basic fee [referred to in item 1\(a\) of the Schedule of Fees](#).

*[COMMENT: It is proposed to amend Rule 16bis.2(a) so as to clarify that the late payment fee is for the benefit of the receiving Office and Rule 16bis.2(b) so as to clarify that the maximum amount of the late payment fee would be the basic fee for an international application containing 30 pages.]*

**Rule 57**

**The Handling Fee**

57.1 *Requirement to Pay*

(a) Each demand for international preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau (“handling fee”) to be collected by the International Preliminary Examining Authority to which the demand is submitted.

(b)

*[COMMENT: The proposed amendments to Rule 57.1 are of a merely editorial nature.]*

57.2 *Amount*

(a) The amount of the handling fee is as set out in the Schedule of Fees.

(b) *[Remains deleted]*

(c) The handling fee shall be payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority (“prescribed currency”), it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency. The amount of the handling fee shall be established, in each prescribed currency, for each International Preliminary Examining Authority which, ~~under~~

~~Rule 57.3(e)~~, prescribes the payment of the handling fee in a any currency ~~or currencies~~ other than Swiss currency, by the Director General after consultation ~~with that Authority and in the currency or currencies prescribed by that Authority (“prescribed currency”)~~ with the Office with which consultation takes place under Rule 15.2(b) in relation to that currency, or, if there is no such Office, with the Authority which prescribes payment in that currency. The amount so established ~~in each prescribed currency~~ shall be the equivalent, in round figures, of the amount ~~of the handling fee~~ in Swiss currency set out in the Schedule of Fees. ~~The~~ It shall be notified by the International Bureau to each International Preliminary Examining Authority prescribing payment in that ~~amounts in the~~ ~~prescribed currencies~~ currency and shall be published in the Gazette.

*[COMMENT: It is proposed to delete the existing text of Rule 57.3(c) and to include it (with minor changes) as the first sentence of Rule 57.2(c), so as to parallel Rules 15.2(b) and 16.1(b) relating to the basic and designation fees and the search fee, respectively. The other proposed amendments of Rule 57.2(c) are along similar lines to those proposed to Rules 15.2(b) and 16.1(b), and for similar reasons.]*

(d) Where the amount of the handling fee set out in the Schedule of Fees is changed, the corresponding amounts in the prescribed currencies shall be applied from the same date as the amount set out in the amended Schedule of Fees.

(e) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new amount in the prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that the interested International Preliminary Examining Authority and the

Director General may agree on a date falling during the said two-month period, in which case the said amount shall become applicable for that Authority from that date.

*[COMMENT: Merely a drafting change.]*

### 57.3 Time Limit for ~~and Mode of~~ Payment

(a) The handling fee shall be ~~due at the time~~ paid within one month from the date on which the demand is submitted.

*[COMMENT: It is proposed to change the time limit for payment of the handling fee to be one month from the date of receipt of the demand, noting that the time limit for payment of the preliminary examination fee would be changed similarly (by way of a reference, in Rule 58.1, to Rule 57.3).]*

(b) Where the handling fee is paid later than the date on which the demand was received and where the amount of that fee is, in the currency in which it is payable, different on the date of payment (“the revised amount”) from that applicable on the date on which the demand was received (“the previous amount”), the previous amount shall be due, provided that the revised amount may, even if it is lower than the previous amount, be paid if payment is made within one month from the date of receipt of the demand.

*[COMMENT: Proposed new Rule 57.3(b) follows the proposal for amendment of Rule 15.4(c).]*

~~(e) [Deleted] The handling fee shall be payable in the currency or currencies prescribed by the International Preliminary Examining Authority to which the demand is submitted, it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency.~~

*[COMMENT: The present text of Rule 57.3(c) (with minor changes) is proposed to be moved as the first sentence of Rule 57.2(c), following the proposals for amendment of Rules 15.2(b) and 15.3.]*

57.4 ~~[Deleted] Failure to Pay~~

~~(a) Where the handling fee is not paid as required, the International Preliminary Examining Authority shall invite the applicant to pay the fee within one month from the date of the invitation.~~

~~(b) If the applicant complies with the invitation within the one month time limit, the handling fee shall be considered as if it had been paid on the due date.~~

~~(c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.~~

*[COMMENT: See proposed new Rule 58bis dealing with late payment of both the handling fee and the preliminary examination fee.]*

[...]

## Rule 58

### The Preliminary Examination Fee

#### 58.1 *Right to Ask for a Fee*

(a) Each International Preliminary Examining Authority may require that the applicant pay a fee (“preliminary examination fee”) for its own benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.

(b) The amount ~~and the due date~~ of the preliminary examination fee, if any, shall be fixed by the International Preliminary Examining Authority.  ~~, provided that the said due date shall not be earlier than the due date of the handling fee.~~ As to the time limit for payment of the preliminary examination fee, the provisions of Rule 57.3 relating to the handling fee shall apply.

*[COMMENT: As to the time limit for payment of the preliminary examination fee, it is proposed to refer to the time limit applicable for the payment of the handling fee by including in Rule 58.1(b) a simple reference to Rule 57.3; in addition, the provisions of Rule 57.3(b) in respect of which amount is payable in case of a change of amount between the date of filing the demand and the date of payment would also be included by reference in respect of the preliminary examination fee.]*

(c) The preliminary examination fee shall be payable directly to the International Preliminary Examining Authority. Where that Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental

organization is located or in any other currency which is freely convertible into the currency of the said State.

58.2 ~~[Deleted]~~ *Failure to Pay*

~~(a) Where the preliminary examination fee fixed by the International Preliminary Examining Authority under Rule 58.1(b) is not paid as required under that Rule, the International Preliminary Examining Authority shall invite the applicant to pay the fee or the missing part thereof within one month from the date of the invitation.~~

~~(b) If the applicant complies with the invitation within the prescribed time limit, the preliminary examination fee will be considered as if it had been paid on the due date.~~

~~(c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.~~

*[COMMENT: It is proposed to delete the existing text of Rule 58.2 and to deal with the matter of late payment of the preliminary examination fee in proposed new Rule 58bis, which would deal also with the late payment of the handling fee; that proposed new Rule would parallel existing Rule 16bis for late payment of fees payable in connection with the filing of the international application.]*

58.3 *Refund*

The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund

any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted, and the International Bureau shall promptly publish such information.



**Rule 58bis**

**Extension of Time Limits for Payment of Fees**

58bis.1 Invitation by the International Preliminary Examining Authority

(a) Where, by the time they are due under Rules 57.3 and 58.1(b), the International Preliminary Examining Authority finds that no fees were paid to it, or that the amount paid to it is less than what is necessary to cover the handling fee and the preliminary examination fee, the Authority shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 58bis.2, within a time limit of one month from the date of the invitation.

(b) Where the International Preliminary Examining Authority has sent an invitation under paragraph (a) and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under Rule 58bis.2, the demand shall, subject to paragraph (c), be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(c) Any payment received by the International Preliminary Examining Authority before that Authority sends the invitation under paragraph (a) shall be considered to have been received before the expiration of the time limit under Rule 57.3 or 58.1(b), as the case may be.

(d) Any payment received by the International Preliminary Examining Authority before that Authority proceeds under paragraph (b) shall be considered to have been received before the expiration of the time limit under paragraph (a).

58bis.2 Late Payment Fee

The payment of fees in response to an invitation under Rule 58bis.1(a) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a late payment fee equal to the handling fee.

*[COMMENT: Following proposals to provide, in respect of payment of fees relating to the demand, for a procedure parallel to that of Rule 16bis for payment of fees relating to the filing of the international application, it is proposed to delete present Rules 57.4 and 58.2 and add new Rule 58bis which would deal with all matters relating to extension of the time limit to pay the fees concerned and a late payment fee, along the same lines as Rule 16bis as proposed to be amended. It is also proposed, so as to clarify the situation, to provide for the International Preliminary Examining Authority to declare that the demand is considered as if it had not been submitted in the event of non-payment of fees in response to an invitation (the procedure would be parallel to that under Article 14(3) in respect of non-payment of fees under Chapter I).]*

## Rule 61

### Notification of the Demand and Elections

#### 61.1 *Notification to the International Bureau and the Applicant*

[...]

(b) The International Preliminary Examining Authority shall promptly ~~inform~~ notify the applicant ~~in writing~~ of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 55.2(d), ~~57.4(e), 58.2(e)~~ 58bis.1(b) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 60.1(d) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

*[COMMENT: This change is consequential on the proposed deletion of Rules 57.4(c) and 58.2(c) and the inclusion of proposed new Rule 58bis.]*

[...]

## Rule 69

### Start of and Time Limit for International Preliminary Examination

[...]

#### 69.2 Time Limit for International Preliminary Examination

The time limit for establishing the international preliminary examination report shall be:

- (i) 28 months from the priority date, or ~~if the demand was filed prior to the expiration of 19 months from the priority date;~~
- (ii) ~~nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date~~ eight months from the date of payment of the fees referred to in Rules 57.1 and 58.1(a), or
- (iii) eight months from the date of receipt by the International Preliminary Examining Authority of the translation referred to in Rule 55.2(a) and (c),

whichever expires last.

*[COMMENT: The proposed amendments of Rule 69.2 are identical to those appearing in Annex I; they are reproduced here for convenient reference. So far as those amendments relate to the fees payable under Chapter II, it is proposed to amend Rule 69.2(ii) to provide that the time limit for establishment of the report would be eight months from the date on*

*which the handling and preliminary examination fees are paid. The period of eight months would give the International Preliminary Examining Authority, in practice, at least as much time for carrying out the international preliminary examination as in the cases covered by Rule 69.2(i).]*

## SCHEDULE OF FEES

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	762 Swiss francs
(b) if the international application contains more than 30 sheets	762 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	185 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 11 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	185 Swiss francs per designation
<del>3. Confirmation Fee: (Rule 15.5(a))</del>	<del>50% of the sum of the designation fees payable under item 2(b)</del>
<u>3.4.</u> Handling Fee: (Rule 57.2(a))	233 Swiss francs

All fees are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

*[COMMENT: See Rule 15.5(a). Proposed amendments relating to the amount of certain fees are dealt with in document PCT/A/XXIV/5; they are independent from the proposed amendments shown above.]*

[Annex VI follows]

ANNEX VI

PROPOSED MODIFIED  
DIRECTIVES OF THE PCT ASSEMBLY RELATING TO THE ESTABLISHMENT OF  
NEW EQUIVALENT AMOUNTS OF CERTAIN FEES

The Assembly established in the following terms the directives referred to in Rules 15.2(d), 16.1(d) and 57.2(e), it being understood that, in the light of experience, the Assembly may at any time modify these directives:

(1) At the time of each ordinary session of the Assembly, the Director General shall ~~proceed to~~ undertake consultations along the lines of the consultations referred to in Rules 15.2(b) and 57.2(c) and shall establish ~~the~~ new equivalent amounts of the ~~fees~~ basic fee, designation fee and handling fee in currencies other than Swiss francs according to the exchange rates applicable on the first day of that session, so that their amounts correspond to the amounts of the fees expressed in Swiss currency. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it. Unless otherwise decided by the Assembly, any adjustment under this paragraph shall enter into force on the first day of the calendar year subsequent to the ordinary session referred to above.

*[COMMENT: Paragraph (1) as proposed to be modified reflects the procedure required to be followed under the relevant Rules.]*

(2) Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 5% higher, or by at least 5% lower, than the last exchange rate applied, ~~any interested Office or Authority using that currency~~

(i) so far as Rule 15.2(d) is concerned, after consultation with the receiving Office referred to in the second sentence of Rule 15.2(b) or



(ii) so far as Rule 57.2(e) is concerned, after consultation with the receiving Office or International Preliminary Examining Authority referred to in the second sentence of Rule 57.2(c)

and as provided in Rules 15.2(d) and 57.2(e), as the case may be, newly establish the amount of ~~fees~~ the basic fee, designation fee and/or handling fee in that currency according to the exchange rate prevailing on the day preceding the day on which the consultation is initiated by the Director General. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it.

*[COMMENT: Paragraph (3) as proposed to be modified reflects the procedure required to be followed under the relevant Rules as proposed to be amended.]*

(4) As far as ~~the establishment of~~ the search fee of any International Searching Authority in any currency other than the currency or currencies fixed by that Authority is concerned, ~~the provisions of~~ paragraphs (1) to (3) shall, to the extent applicable, ~~be applied~~ apply mutatis mutandis, except in the case where the equivalent amount of that fee in Swiss francs is equal to or more than 1,000 Swiss francs, in which case the Director General [shall] [may] decide to apply paragraph (3) as if the percentage referred to in that paragraph was 5%.

*[COMMENT: Paragraph (4) as proposed to be modified would provide for the Director General to be able to initiate the consultation process with a view to establishing new equivalent amounts of the search fee, as at present, when the exchange rates fluctuate by plus or minus 10% or, under the proposed modifications, when the exchange rates fluctuate by plus or minus 5% but then only where that fee, expressed in its Swiss francs equivalent, is equal to or more than 1,000 Swiss francs. In other words, if the search fee, expressed in its Swiss francs equivalent, is less than 1,000 Swiss francs, a new equivalent is not established when the exchange rates fluctuate by less than plus or minus 10% (it is noted that consultation by the Director General on the basis of 5% fluctuations is the existing practice so far as the search fee charged by the European Patent Office is concerned).]*

[End of Annex and of document]