

WIPO



PCT/A/XXIV/7

ORIGINAL: English

DATE: August 7, 1997

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Twenty-Fourth Session (11th Ordinary)
Geneva, September 16 to October 1, 1997**

MATTERS CONCERNING THE PCT UNION: REGULATIONS

*(Proposed amendments of the Regulations under the PCT:
nucleotide and amino acid sequence listings; PCT Gazette;
international preliminary examination)*

Document prepared by the International Bureau

TABLE OF CONTENTS

	Paragraphs of the document
Introduction	1 to 7
Nucleotide and amino acid sequence listings	8 to 11
PCT Gazette	12 to 19
International preliminary examination	20 to 27

	Pages of the Annexes
Annex I (Nucleotide and amino acid sequence listings)	
Rule 3.3	1
Rule 5.2	2
Rule 12.1	3
Rule 12.3	4
Rule 13 <i>ter</i> .1	6
Rule 13 <i>ter</i> .2	9
Rule 20.4	11
Rule 23.1	12
Rule 49.5	13
Annex II (PCT Gazette)	
Rule 86.1	1
Rule 86.2	1
Rule 86.5	2
Rule 86.6	2
Rule 86.7	3

	Pages of the Annexes
Annex III (International preliminary examination)	
Rule 53.7	1
Rule 54.2	3
Rule 54.4	4
Rule 56.1	5
Rule 59.3	6
Rule 60.1	9
Rule 60.2	10
Rule 61.1	11
Rule 61.4	11
Rule 62.1	13
Rule 62.2	13
Rule 66.8	15
Rule 69.2	16
Rule 70.7	18
Rule 70.16	19
Rule 70.17	19
Rule 94.1	20
Rule 94.2	21
Rule 94.3	21

INTRODUCTION

1. This document contains proposals, on a number of topics, for amendment of the Regulations¹ 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) *nucleotide and amino acid sequence listings* (see Annex I);
 - (ii) *PCT Gazette* (see Annex II);
 - (iii) *international preliminary examination* (see Annex III).
4. The proposals in this document derive from proposals which were considered by the PCT Committee for Administrative and Legal Matters (only insofar as they relate to item (ii), above), at its sixth session held from April 29 to May 3, 1996, and 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 “[...]”.
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.

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

NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS

(See Annex I; presentation in international applications, language requirements, copy in computer readable form, translation for national phase)

8. The Meeting of International Authorities under the PCT, at its sixth session held from February 17 to 21, 1997, discussed questions relating to the establishment of a common standard for the presentation of nucleotide and amino acid sequence listings in international applications. The discussions were based on a draft common standard under consideration by the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office in the course of their trilateral cooperation. The Meeting agreed with the general approach taken in the draft common standard and asked the International Bureau to further revise it in consultation with the Trilateral Offices, with the aim of finalizing it for consultation with all International Searching and Preliminary Examining Authorities in the first half of 1997 (see document PCT/MIA/VI/16, paragraphs 16 to 19). The International Bureau has now sent a revised draft standard to all members of the Permanent Committee on Industrial Property Information (PCIPI) seeking comments with a view to finalizing the standard.

9. In light of the progress made towards the establishment of a common standard for the presentation of sequence listings in international applications, it is proposed to amend the Regulations, as set out in the Annex, according to the principles outlined below, so as to provide a legal framework for the implementation of the common standard. The common standard would replace the separate standards presently applicable in the case of the various International Searching and Preliminary Examining Authorities under Sections 208 and 513 of, and Annex C to, the Administrative Instructions.

10. The Regulations as proposed to be amended (see Annex I) would require applicants to include any disclosed sequence listing in a "sequence listing part" of the description and, where required for the purposes of the international search by the International Searching Authority, or for the purposes of international preliminary examination by the International Preliminary Examining Authority, to furnish a sequence listing in computer readable form (see Rules 5.2(a) and 13^{ter}.1 as proposed to be amended). Any such listing, in paper or in computer readable form, would, if it complied with the common standard, be accepted by all receiving Offices, International Searching Authorities and International Preliminary Examining Authorities, and, for the purposes of the procedure in the national phase, by all designated and elected Offices (see Rule 13^{ter} and Article 27(1)).

11. Under the proposed system, applicants, by presenting sequence listings complying with the standard, would avoid the need for translating the sequence listing part of the description. The Rules as proposed to be amended would provide for most if not all of the text matter of the sequence listing part of the description to be presented using the language-neutral vocabulary to be defined in the new standard to be provided for in the Administrative Instructions (see Rule 12.1(d)). Where it is not possible for certain text matter of the sequence listing part to be presented using the language-neutral vocabulary, it is proposed that such "free text" would be permitted to be contained in the sequence listing part in another language, preferably in English (see Rules 12.1(d) and 20.4(c)). However, any such free text would also have to be repeated in the main part of the description, in the language thereof (see Rule 5.2(b)). For the purposes of the national phase of processing, a translation of any such

free text contained in the sequence listing part of the description would not be needed, and could not be required, by the designated/elected Offices, provided that any such free text is repeated in the main part of the description (and hence in any translation thereof) (see Rules 5.2(b) and 49.5(a-bis)).

PCT GAZETTE

(See Annex II: contents, languages, translation and making accessible of abstracts)

12. Article 55(4) and Rule 86 provide for the publication of a Gazette. Under Rule 86.1, the Gazette shall contain, for each published international application, certain bibliographic data, and the drawing (if any) appearing on the front page of the pamphlet, and the abstract. Under Rule 86.2, the Gazette is at present required to be published in separate English-language (*PCT Gazette*) and French-language (*Gazette du PCT*) paper editions. Each edition is expected to contain in 1997 about 30,000 pages, that is, a total of 60,000 pages. Because of the great volume of the present format of the Gazette and the availability of PCT abstracts and drawings in electronic form, the number of subscriptions to the English and French editions is decreasing steadily.

13. The volume of the Gazette could be reduced considerably—as it will be seen, by some 78%—if two changes were introduced.

14. One of the changes would be to leave out from the Gazette the abstracts and the drawings. But, although abstracts and drawings would continue to be published in the paper pamphlets in which each international application is published, it is very useful to enable anyone to have access to the abstracts and the drawings separately from the bulky paper pamphlets. It is therefore proposed that the abstracts and the drawings should, together with the bibliographic data, be made accessible on the Internet, on CD-ROM or by other electronic ways or means and that those ways or means be specified in the Administrative Instructions, whose modification requires consultation with the Offices or Authorities which have a direct interest in the proposed modification. Specifying the ways and means in the Administrative Instructions would make it relatively easy to adjust the ways and means in the light not only of technological developments but also in the light of the changing needs and wishes of the patent offices, the users of the PCT system and the general public. It is estimated that leaving out the abstracts and the drawings from the paper Gazette would in itself reduce the volume of each of the two editions by some 60%.

15. The other change proposed in respect of the paper Gazette is to replace the present two separate editions (namely, the English edition *PCT Gazette* and the French edition *Gazette du PCT*) by one, bilingual paper edition, that would have the title *PCT Gazette/Gazette du PCT*. In this Gazette, in respect of each international application, the same data would—with two exceptions—appear as at the present time. The two exceptions are the abstract and the drawing. What would remain are the bibliographic data (which generally require no translation), the title of the invention and certain indications such as the indication that the international application is published with (or without) an international search report. The title of the invention would be published in English and French, next to each other. The untranslated bibliographic data would be accompanied by INID (“Internationally agreed Numbers for the Identification of (bibliographic) Data”) codes where such codes exist or by

other appropriate codes where INID codes do not exist. The meaning of all codes would be indicated in each issue of the bilingual paper Gazette in both English and French. In addition to the 60% reduction in the number of pages of a Gazette without abstracts and drawings, it is estimated that the telescoping of the remaining contents of the English- and French-language versions of the Gazette into a single bilingual Gazette would further reduce the number of pages by an estimated 45% which, when compared to the total number of pages contained in the two versions of the Gazette in its current form, corresponds to a further 18% reduction in the total number of pages to be published per year. It is therefore estimated that publishing a bilingual Gazette without abstracts and drawings would reduce the total number of pages to be published by (60% + 18% =) 78%. Thus, as far as the estimated number of pages to be published in 1997 in the Gazette is concerned, only 13,300 pages would have had to be published instead of an expected 60,000.

16. Having 78% less printing masters to be prepared would mean that much less work for the staff of the International Bureau and would involve significant savings in the actual printing costs as well as in paper, postage and handling.

17. It is to be noted that the present proposals would not cause any changes in respect of the use of the English and French languages and that, consequently, the status of these languages would continue to be *strictly and entirely equal*.

18. It may be interesting to note that the contents of the proposed bilingual paper Gazette would be similar to that of the trilingual paper Gazette of the European Patent Office.

19. Finally, it is to be noted that—although this could be regarded as going without saying—proposed new Rule 86.7 expressly states that not only the timely making accessible of the abstracts but also their translation (into English and French) is to be ensured by the International Bureau.

INTERNATIONAL PRELIMINARY EXAMINATION

(See Annex III; transmittal of demand to competent Authority, right to make demand, making of elections, access to files)

20. *Transmittal of demand to competent Authority.* The PCT and the Regulations presently do not provide for any specific safeguards for applicants if the demand is not filed with the competent International Preliminary Examining Authority (that is, if it is erroneously filed with an International Preliminary Examining Authority which is not competent for carrying out international preliminary examination, or with a receiving Office, an International Searching Authority or the International Bureau). In such a case, elections contained in the demand do not have the effect of postponing entry into the national phase from 20 to 30 months from the priority date. In order for the applicant, in that case, to be able to enter the national phase by performing, before the expiration of 20 months from the priority date, the acts referred to in Article 22, the defect would need to be brought to the applicant's attention in sufficient time to permit any necessary translation to be prepared. In practice, despite the efforts of the International Preliminary Examining Authority, such defect may only be noticed, or the corresponding notification may only reach the applicant, after the 20-month time limit has expired.

21. Safeguards have already been introduced in the Regulations in respect of the filing of the international application if it is not filed with a competent receiving Office (namely, the transmittal to the International Bureau as receiving Office under Rule 19.4). It is now proposed to introduce a similar safeguard in respect of the filing of the demand with a consequential amendment in respect of the time limit for the establishment of the international preliminary examination report, taking into account the fact that, as a result of the transmittal to the competent International Preliminary Examining Authority, the start of international preliminary examination would be delayed (see Rules 59.3 and 69.2).

22. *Right to make a demand.* The right to make a demand for international preliminary examination is provided for, in general, in Article 31(2)(a), and, in the case where there are two or more applicants, in Rule 54.2. However, the case where there is only one applicant is not specifically covered in that Rule. It is now proposed to amend Rule 54.2 so that, in accordance with the decision of the Assembly in adopting an amendment to Rule 54.2, which entered into force on July 1, 1992, that Rule would in the future explicitly cover the case where there is only one applicant.

23. *Making of elections.* It is proposed to introduce added flexibility in respect of the indication of elections of States by providing for the automatic election of all eligible States and to amend the Regulations accordingly (see Rules 53.7, 56.1(a), 60.1(a) and (b) and 60.2(b)).

24. *Access to files.* It is proposed to amend Rule 94 in relation to the availability of copies of documents in the files of the International Bureau and the International Preliminary Examining Authority. Express authorization would be given to elected Offices to provide access to documents from the international preliminary examination file, with a view to adopting a more liberal interpretation of Article 38(1). In particular, the exception provided for in Article 38(1) allowing access to the file of the international preliminary examination by elected Offices would no longer be interpreted as limiting that access to the elected Offices themselves. Consistent with this interpretation, elected Offices whose national law makes application files publicly accessible should no longer be required to remove the international preliminary examination file when allowing such access to their files. This will be particularly the case for, although not restricted to, an elected Office which had itself carried out the international preliminary examination in its capacity as an International Preliminary Examining Authority.

25. *Miscellaneous.* It is also proposed to amend certain Rules concerning procedural matters, in particular, those dealing with the sending by the International Preliminary Examining Authority of the demand to the International Bureau (see Rule 61.1), the furnishing to that Authority of copies of amendments under Article 19 and accompanying statement (see Rules 62.1 and 62.2), the form in which amendments under Article 34 should be presented (see Rule 66.8), and the Rule dealing with publication in the Gazette of information relating to the elected States (see Rule 61.4).

26. It is proposed to amend certain Rules dealing with the citation of certain documents in the course of the international preliminary examination procedure (see Rule 70.7).

27. It is proposed to amend Rule 70.16 so as to provide specifically for the inclusion as annexes to the international preliminary examination report of pages of the international application containing rectifications of obvious errors authorized by the Authority.

DECISIONS INVITED

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

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

(ii) to decide that the amended Regulations shall enter into force on January 1, 1998, except those proposed in Annex I to the extent that they relate to nucleotide and amino acid sequence listings, which shall enter into force upon promulgation of the standard for the presentation of nucleotide and amino acid sequence listings in international applications.

[Annexes follow]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS
RELATING TO
NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS

Rule 3

The Request (Form)

[...]

3.3 Check List

(a) The request shall contain a list indicating:

(i) the total number of sheets constituting the international application and the number of the sheets of each element of the international application: ~~(request, description~~ (separately indicating the number of sheets of any sequence listing part of the description), claims, drawings, abstract~~);~~);

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

[...]

Rule 5

The Description

[...]

5.2 Nucleotide and/or Amino Acid Sequence Disclosure

(a) Where the international application contains disclosure of a nucleotide and/or amino acid sequence, the description shall contain a listing of the sequence complying with the standard ~~prescribed by~~ provided for in the Administrative Instructions and presented as a separate part of the description (“sequence listing part”) in accordance with that standard, provided that no such listing is required of any sequence referred to in the description as forming part of the prior art.

(b) Where the sequence listing part of the description contains any text matter which is not presented using the language-neutral vocabulary as defined in the standard provided for in the Administrative Instructions, that text matter shall also appear in the main part of the description in the language thereof.

[COMMENT: See paragraph 11 of the document. Proposed new paragraph (b) would enable applicants to present sequence listings in such a way as to avoid the need for furnishing a translation of the sequence listing part of the description to any designated/elected Office for the purposes of the procedure in the national phase, since any translation of the main part of the description would contain any text matter not presented using language-neutral vocabulary.]

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: Paragraphs (a) to (c) are proposed to be amended in connection with the language of the international application generally; see document PCT/A/XXIV/6, Annex I. Paragraph (a) is reproduced here for convenient reference.]

(d) Notwithstanding paragraph (a), any text matter contained in the sequence listing part of the description shall preferably be presented using the language-neutral vocabulary as defined in the standard provided for in the Administrative Instructions. Any such text matter which is not so presented shall preferably be in English. ~~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 (e).~~

[COMMENT: The standard to be annexed to the Administrative Instructions would contain a definition of the term “language-neutral vocabulary” (scientific terms as prescribed by the leading sequence data banks: “DDBJ/EMBL/GenBank Feature Table” (DNA sequences) and “SWISS PROT Feature Table” (protein sequences)). Any “free text” appearing in the sequence listing part of the description (preferably in English) would have to be repeated in the main part of the description in the language thereof (see Rule 5.2(b)).]

[...]

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.

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

[COMMENT: Rule 12.3(a), which is proposed to be added in connection with the language of the international application generally (see document PCT/A/XXIV/6, Annex I), is reproduced here for convenient reference. Under paragraph (b), the sequence listing part of the description would not have to be translated for the purposes of the international search, noting that any “free text” therein would have to be repeated in the main part of the description in the language thereof (see Rule 5.2(b)).]

[...]

Rule 13ter

Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Sequence Listing for International Authorities

(a) ~~If~~ Where the International Searching Authority finds that the international application contains disclosure of a nucleotide and/or amino acid sequence but: listing

(i) the international application does not contain a listing of that sequence complying does not comply with the standard ~~prescribed~~ provided for in the Administrative Instructions ~~under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, it,~~ that Authority may invite the applicant to furnish to it for the purposes of the international search, within a time limit fixed in the invitation, ~~as the case may be: (i) to furnish to it~~ a listing of the sequence complying with ~~the prescribed~~ that standard; ~~and/or~~

(ii) the applicant has not already furnished a listing of the sequence in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it for the purposes of the international search, within a time limit fixed in the invitation, a listing of the sequence in such a machine readable form complying with that standard. provided for in the Administrative Instructions or, if that Authority is prepared to transcribe the sequence listing into such a form, to pay for the cost of such transcription.

(b) Any sequence listing, which, pursuant to paragraph (f), does not form part of the international application, furnished under paragraph (a) shall be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed. Where no such statement is furnished, the International Searching Authority shall invite the applicant to furnish it within a time limit which shall be reasonable under the circumstances. If the applicant fails to furnish the required statement accordingly, the sequence listing shall be considered not to have been furnished.

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

[COMMENT: See paragraph 10 in the Introduction.]

(d) ~~[Deleted] If the International Searching Authority chooses, under paragraph (a)(ii), to transcribe the sequence listing into a machine-readable form, it shall send a copy of such transcription in machine-readable form to the applicant.~~

(e) ~~The International Searching Authority shall, upon request, make available to the International Preliminary Examining Authority a copy of any sequence listing furnished to it, or as transcribed by it, under paragraph (a).~~ The International Preliminary Examining Authority may invite the applicant, within a time limit fixed in the invitation, to furnish to it:

(i) a copy of any sequence listing furnished to the International Searching Authority under paragraph (a) or transmitted to that Authority under Rule 23.1(c); or

(ii) where no listing of the sequence was furnished or transmitted to that Authority, a listing of that sequence complying with the standard provided for in the Administrative Instructions; paragraph (b) shall apply *mutatis mutandis*.

Paragraph (c) shall apply *mutatis mutandis*.

(f) ~~A~~ Any sequence listing not contained in the international application as filed or any sequence listing in computer readable form ~~furnished to the International Searching Authority, or as transcribed by it, under paragraph (a)~~ shall not form part of the international application.

[COMMENT: See paragraph 10 of the document. The provisions of Rule 13ter.1 are designed to meet the needs of International Searching Authorities and International Preliminary Examining Authorities for sequence listings complying with the prescribed standard, whether on paper or in computer readable form, while ensuring that an applicant who meets the standard will not have to furnish multiple copies of a listing to different Authorities. It is also proposed to no longer provide for the possibility for the International Searching Authority to transcribe a sequence listing, as is the case under present Rule 13ter.1(a)(ii).]

13ter.2 *Sequence Listing for Designated Office*

No designated Office may require from the applicant a listing of any sequence disclosed in the international application if the applicant furnishes:

(i) where the requirements of Rule 5.2(a) are complied with, a copy of the listing in computer readable form as transmitted under Rule 23.1(c), or

(ii) where the requirements of Rule 5.2(a) are not complied with, a copy of the listing as furnished under Rule 13ter.1(a) or (e)(ii),

provided that any listing so furnished to that Office complies with the standard provided for in the Administrative Instructions.

~~(a) Once the processing of the international application has started before a designated Office, that Office may require the applicant to furnish to it a copy of any sequence listing furnished to the International Searching Authority, or as transcribed by that Authority, under Rule 13ter.1(a).~~

~~(b) If a designated Office finds that a nucleotide and/or amino acid sequence listing does not comply with the standard prescribed in the Administrative Instructions under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, and/or no listing of the sequence was furnished to the International Searching Authority, or transcribed by that Authority, under Rule 13ter.1(a), that Office may require the applicant:~~

~~(i) to furnish to it a listing of the sequence complying with the prescribed standard,
and/or~~

~~(ii) to furnish to it a listing of the sequence in a machine readable form provided for
in the Administrative Instructions or, if that Office is prepared to transcribe the sequence listing
into such a form, to pay for the cost of such transcription.~~

[COMMENT: Rule 13ter.2 as proposed to be amended would ensure that the applicant himself would be required to furnish a copy of the written sequence listing to the designated Office only where such listing was not contained in the international application as filed or subsequently furnished to the International Searching Authority or International Preliminary Examining Authority, as the case may be. Moreover, it would ensure that, where the applicant furnished during the international phase a sequence listing in computer readable form complying with the standard, he could only be required to furnish a copy of such listing in computer readable form. It is only where such a listing was not furnished together with the international application, or subsequently to the Authority concerned, that a (new) listing could be required by the designated Office.]

Rule 20

Receipt of the International Application

[...]

20.4 Determination Under Article 11(1)

[...]

(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: See document PCT/A/XXIV/6, Annex I, for amendments of Rule 20 in connection with the language of the international application generally. Under paragraph (c), the sequence listing part of the description would not be subject to the language requirements applicable to the description and claims for the purposes of according an international filing date (see also Rules 5.2(b), 12.1(d) and 12.3(b)).]

[...]

Rule 23

Transmittal of the Search Copy, Translation and Sequence Listing

23.1 *Procedure*

[...]

(c) Any sequence listing in computer readable form which is furnished to the receiving Office shall be transmitted by that Office, together with any accompanying statement of the kind referred to in Rule 13^{ter}.1(b), to the International Searching Authority.

Rule 49

Copy, Translation and Fee Under Article 22

[...]

49.5 *Contents of and Physical Requirements for the Translation*

(a) For the purposes of Article 22, the translation of the international application shall contain the description [\(subject to paragraph \(a-bis\)\)](#), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (c-bis) and (e),

[...]

[\(a-bis\) No designated Office shall require the applicant to furnish it with a translation of any text matter contained in the sequence listing part of the description which is presented using the language-neutral vocabulary as defined in the standard provided for in the Administrative Instructions as referred to in Rule 12.1\(d\) or, if the description complies with Rule 5.2\(b\), of any text matter contained in that part which is not so presented.](#)

[COMMENT: Proposed new paragraph (a-bis) would ensure that no designated/elected Office would be able to require a translation of the sequence listing part of the description for the purposes of national phase processing, noting that any text matter not presented using the language-neutral vocabulary is required to be repeated in the main part of the description (and hence in any translation thereof).]

[...]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS
RELATING TO
THE PCT GAZETTE

Rule 86

The Gazette; Translation and Publication of Abstracts

86.1 ~~Contents~~ The Gazette

The Gazette referred to in Article 55(4) shall contain:

(i) for each published international application, the data specified by the Administrative Instructions taken from the front page of the pamphlet published under Rule 48, ~~the drawing (if any) appearing on the said front page, and the abstract,~~

[...]

86.2 *Languages*

~~(a)~~ The Gazette shall be published in a bilingual (English and French) edition. ~~an English-language edition and a French-language edition. It shall also be published in editions in any other language, provided the cost of publication is assured through sales or subventions.~~

~~(b)~~ [Deleted] ~~The Assembly may order the publication of the Gazette in languages other than those referred to in paragraph (a).~~

[...]

86.5 *Title*

The title of the Gazette shall be "PCT Gazette/Gazette du PCT." ~~determined by the
Director General.~~

86.6 *Further Details*

Further details concerning the Gazette may be provided for in the Administrative
Instructions.

86.7 Translation and Making Accessible of Abstracts

In addition to its publication in the pamphlet under Rule 48, the abstract of each international application shall be made accessible in English and French to anyone on the Internet, on CD-ROM or by other electronic ways and means specified in the Administrative Instructions. The necessary translations shall be ensured in English and French. The International Bureau shall also ensure that the making accessible by electronic ways and means shall be effected on the same date, or promptly after the date, on which the pamphlet containing the international application is or was published.

[Annex III follows]

ANNEX III

PROPOSED AMENDMENTS OF THE PCT REGULATIONS
RELATING TO
INTERNATIONAL PRELIMINARY EXAMINATION

Rule 53

The Demand

[...]

53.7 Election of States

(a) The demand shall be considered to contain an indication that all designated States, including any State whose designation is confirmed under Rule 4.9(c), whether before or after the demand is made, and which are bound by Chapter II of the Treaty (“eligible States”) are elected, except for any State expressly not elected. ~~The demand shall indicate at least one Contracting State, from among those States which are designated and are bound by Chapter II of the Treaty (“eligible States”), as an elected State.~~

(b) ~~[Deleted] Election of Contracting States in the demand shall be made:~~

~~(i) by an indication that all eligible States are elected, or,~~

~~(ii) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States that are elected, and, in the case of States which have been designated for the purpose of obtaining a regional patent, by an~~

~~indication of the regional patent concerned together with either an indication that all eligible States party to the regional patent treaty concerned are elected or an indication of those among the said States that are elected.~~

[COMMENT: Proposed amended Rule 53.7 would effect the automatic election of all eligible States when a demand is filed, without the need for any specific indication to be made by the applicant. This would be a reflection of the present situation whereby almost all applicants choose to elect all eligible States. It is envisaged, however, that the demand would continue, for the sake of clarity, to contain a statement to the effect that all eligible States are elected; it is also envisaged that that statement would be moved to the first page of the demand form.]

[...]

Rule 54

The Applicant Entitled to Make a Demand

[...]

54.2 Right to Make a Demand ~~Two or More Applicants~~

~~If there are two or more applicants, the~~ The right to make a demand under Article 31(2)(a) shall exist if the applicant making the demand or, if there are two or more applicants, at least one of ~~the applicants making the demand~~ them is (i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II. ~~, or (ii) a person entitled to make a demand under Article 31(2)(b) and the international application has been filed as provided in the decision of the Assembly.~~

[COMMENT: The right to make a demand for international preliminary examination is provided for, in general, in Article 31(2)(a). At its first session held in 1990, the Meeting of International Authorities under the PCT agreed “that Article 31(2)(a) should be interpreted in such a way that it permits each applicant who is a national or resident of a Contracting State bound by Chapter II and whose international application was filed with the receiving Office of or acting for a Contracting State bound by Chapter II, to file a demand and to make elections under [the former text of] Rule 54.3(a)(i).” The Meeting further agreed that that interpretation would apply even without an amendment of the Regulations, but that appropriate proposals for amending the Regulations should be made. Rule 54 was subsequently amended, with effect from July 1, 1992, such that Rule 54.2 now expressly covers the situation in the case where there are two or more applicants. In amending Rule 54.2, the Assembly agreed that the adopted minimum requirements for filing a demand were consistent with Article 31(2)(a). It is now proposed that Rule 54.2 be further amended to cover expressly the case where there is a sole applicant as well as that where there are two or more applicants.]

[...]

54.4 *Applicant Not Entitled to Make a Demand*

~~(a)~~ If the applicant does not have the right to make a demand or, in the case of two or more applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.

~~(b)~~

[COMMENT: Merely a drafting change.]

Rule 56

Later Elections

56.1 Elections Submitted Later than the Demand

(a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice submitted to the International Bureau. The notice shall identify the international application and the demand, and shall include an indication ~~as referred to in~~ [Rule 53.7\(b\)\(ii\) of the States concerned](#).

[COMMENT: The proposed amendment to Rule 56.1(a) is consequential on the proposed amendment to Rule 53.7.]

[...]

Rule 59

The Competent International Preliminary Examining Authority

[...]

59.3 Transmittal of Demand to the Competent International Preliminary Examining Authority

(a) If the demand is submitted to a receiving Office, an International Searching Authority, or an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, that Office or Authority shall mark the date of receipt on the demand and, unless it decides to proceed under paragraph (f), transmit the demand promptly to the International Bureau.

(b) If the demand is submitted to the International Bureau, the International Bureau shall mark the date of receipt on the demand.

(c) Where the demand is transmitted to the International Bureau under paragraph (a) or submitted to it under paragraph (b), the International Bureau shall promptly:

(i) if there is only one competent International Preliminary Examining Authority, transmit the demand to that Authority and inform the applicant accordingly, or

(ii) if two or more International Preliminary Examining Authorities are competent, invite the applicant to indicate, within 15 days from the date of the invitation or 19 months from the priority date, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

(d) Where an indication is furnished as required under paragraph (c)(ii), the International Bureau shall promptly transmit the demand to the competent International Preliminary Examining Authority indicated by the applicant. Where no indication is so furnished, the demand shall be considered not to have been submitted and the International Bureau shall so declare.

(e) Where the demand is transmitted to a competent International Preliminary Examining Authority under paragraph (c), it shall be considered to have been received on behalf of that Authority on the date marked on it under paragraph (a) or (b), as applicable, and the demand so transmitted shall be considered to have been received by that Authority on that date.

(f) Where an Office or Authority to which the demand is submitted under paragraph (a) decides to transmit that demand directly to the competent International Preliminary Examining Authority, paragraphs (c) to (e) shall apply *mutatis mutandis*.

[COMMENT: The Regulations do not provide for a procedure in case a demand is filed with an International Preliminary Examining Authority which is not, for whatever reason (having regard to the nationality and residence of the applicant, the specification of competent International Preliminary Examining Authorities by the receiving Office, or the language of the international application), competent to perform the international preliminary examination of the international application in question; neither do the Regulations provide for such a procedure in case a demand is erroneously filed with a receiving Office, an

International Searching Authority or the International Bureau. Under amendments of the Regulations which have come into force in recent years, the filing of an international application with a “non-competent” receiving Office, or the filing of a later election with the International Preliminary Examining Authority rather than the International Bureau, is now capable, in many cases, of remedy without loss of rights to the applicant (see Rules 19.4 and 56.1(f), respectively). It is now proposed to take a similar approach also in relation to the demand. Proposed new Rule 59.3 would require that, where a demand is submitted to a non-competent International Preliminary Examining Authority or to a receiving Office or an International Searching Authority, that Office or Authority would forward it directly to the International Bureau, which would in turn take the necessary action to transmit the demand to the competent International Preliminary Examining Authority (the demand could alternatively, at the option of the Office or Authority concerned, be transmitted direct to the competent International Preliminary Examining Authority under proposed Rule 59.3(f)). The proposed new Rule would also cover the case where a demand is submitted directly to the International Bureau.]

Rule 60

Certain Defects in the Demand or Elections

60.1 *Defects in the Demand*

(a) If the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to [53.6](#), 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted ~~contained at least one election and~~ permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted [and the International Preliminary Examining Authority shall so declare.](#)

[...]

60.2 *Defects in Later Elections*

(a) If the notice effecting a later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Bureau at any time before a decision is taken.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had been received on the actual filing date, provided that the notice as submitted ~~contained at least one election and~~ permitted the international application to be identified; otherwise, the notice shall be considered as if it had been received on the date on which the International Bureau receives the correction.

(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted and the International Bureau shall so declare.

[...]

[COMMENT: Under the proposed amendment to Rule 53.7 pursuant to which election of eligible States would be automatic upon filing the demand, there would be no defect in the demand if no election was specifically made. Consequently, it is proposed to remove from Rule 60.1(a) the reference to Rule 53.7 and from Rules 60.1(b) and 60.2(b) the requirement for at least one election to be made in the demand. It is also proposed to include in Rules 60.1(c) and 60.2(c) provision for the International Preliminary Examining Authority and the International Bureau, respectively, to make the relevant declaration where the demand or later election is considered as if it had not been submitted.]

Rule 61

Notification of the Demand and Elections

61.1 *Notification to the International Bureau and the Applicant*

(a) The International Preliminary Examining Authority shall indicate on the demand the date of receipt or, where applicable, the date referred to in Rule 60.1(b). The International Preliminary Examining Authority shall promptly either send the demand to the International Bureau, and ~~shall prepare and~~ keep a copy in its files or send a copy to the International Bureau and keep the demand in its files.

[COMMENT: The proposed amendment to Rule 61.1(a) would permit the International Preliminary Examining Authority to send to the International Bureau either the demand itself (as at present) or a copy thereof (for example, by facsimile transmission, so as to expedite processing).]

[...]

61.4 *Publication in the Gazette*

Where a demand has been filed before ~~prior to~~ the expiration of ~~the 19th month~~ 19 months from the priority date, the International Bureau shall, promptly after the filing of the demand but not before the international publication of the international application, publish ~~a notice of that fact~~ in the Gazette information on the demand and the elected States concerned, as provided in the Administrative Instructions. ~~promptly after the filing of the demand, but not~~

~~before the international publication of the international application. The notice shall indicate all designated States bound by Chapter II which have not been elected.~~

[COMMENT: The proposed amendment to Rule 61.4 would allow for the precise wording of the notice in the Gazette to be left to the Administrative Instructions. It could, for example, be worded, in a positive manner, along the following lines "...election before the expiration of 19 months...of all eligible States except..." instead of the present negative wording "States ...which have not been elected in the demand" prior to the expiration of the 19th month from the priority date.]

Rule 62

Copy of Amendments Under Article 19 for the International Preliminary Examining Authority

62.1 Amendments Made Before the Demand is Filed

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit a copy of any amendments under Article 19, and any statement referred to in that Article, to that Authority, unless that Authority has indicated that it has already received such a copy.

[COMMENT: It is proposed to amend Rule 62.1 to take into account the proposed amendment to Rule 61.1(a) and to clarify that any statement made by the applicant under Article 19 should also be sent by the International Bureau to the International Preliminary Examining Authority.]

62.2 Amendments Made After the Demand is Filed

~~(a)~~ If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments and any statement referred to in that Article. ~~with the International Preliminary Examining Authority~~. In any case, the International Bureau shall promptly transmit a copy of such amendments and statement to that Authority.

~~(b)~~

[COMMENT: It is proposed to amend Rule 62.2 to take into account the proposed amendment to Rule 62.1.]

Rule 66

Procedure Before the International Preliminary Examining Authority

[...]

66.8 *Form of Amendments*

(a) Subject to paragraph (b), the ~~The~~ applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, ~~it may be made on~~ the replacement sheet referred to in paragraph (a) may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

[COMMENT: It is proposed to amend Rule 66.8 so as to clarify that the letter accompanying amendments under Article 34 should explain the reasons for the amendments, as is provided for in the PCT Preliminary Examination Guidelines, Chapter VI, paragraph 4.12.]

[...]

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 establishing the report would be eight months from the date on which the handling and preliminary examination fees are paid (see document PCT/A/XXIV/6, Annex V) or the date on which a translation required under Rule 55.2(a) is furnished (see document PCT/A/XXIV/6,

Annex I), 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

[...]

70.7 Citations Under Article 35(2)

(a) The report shall cite the documents considered to be relevant for supporting the statements made under Article 35(2), whether or not such documents are cited in the international search report. Documents cited in the international search report need only be cited in the report when they are considered by the International Preliminary Examining Authority to be relevant.

[COMMENT: It is proposed to amend Rule 70.7(a) to make it clear that all relevant documents must be cited in the international preliminary examination report, and not only those which were not already cited in the international search report, and to provide a basis for the International Preliminary Examining Authority to cite in the international preliminary examination report only those documents already cited in the international search report which are considered relevant by that Authority.]

(b) The provisions of Rule 43.5(b) and (e) shall apply also to the report.

[...]

70.16 Annexes ~~of~~ to the Report

Each replacement sheet under Rule 66.8(a) or (b), ~~and~~ each replacement sheet containing amendments under Article 19 and each replacement sheet containing rectifications of obvious errors authorized under Rule 91.1(e)(iii) shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8(a) shall not be annexed.

[COMMENT: It is proposed to amend Rule 70.16 so as to clarify that replacement sheets containing rectifications of obvious errors authorized by the International Preliminary Examining Authority would have to be included as annexes and that any sheet cancelled under proposed amended Rule 66.8(b), second sentence, would not need to be included.]

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)~~

[COMMENT: Merely a drafting change.]

Rule 94

~~**Furnishing of Copies by the International Bureau
and the International Preliminary Examining Authority**~~

Access to Files

94.1 ~~*Obligation to Furnish*~~ *Access to the File Held by the International Bureau*

(a) At the request of the applicant or any person authorized by the applicant, the International Bureau ~~and the International Preliminary Examining Authority~~ shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in ~~the its~~ file of the applicant's international application or purported international application.

[COMMENT: It is proposed to separate the present provisions of Rule 94.1 into proposed amended Rules 94.1(a) and 94.2, according to the Authority concerned, that is, the International Bureau and the International Preliminary Examining Authority.]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file other than any document referred to in Rule 94.2.

[COMMENT: It is proposed to provide for the International Bureau to allow access, after international publication, to any document in the file of the international application other than, in view of Article 38(1), any document contained in the file of the international preliminary examination; the access to the file of the international preliminary examination would be made available only through the elected Offices which, under Article 38(1), have access to it (see Rules 94.2 and 94.3).]

94.2 Access to the File Held by the International Preliminary Examining Authority

At the request of the applicant or any person authorized by the applicant, or, once the international preliminary examination report has been established, of any elected Office, the International Preliminary Examining Authority shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

[COMMENT: See comment on proposed amended Rule 94.1(a), noting that the wording of proposed new Rule 94.2 follows that of Article 38. It is proposed to make it clear in proposed new Rule 94.2 that an International Preliminary Examining Authority which furnishes copies of documents contained in its files would be entitled to request reimbursement of the cost of the service in all cases, including where the requester is an elected Office.]

94.3 Access to the File Held by the Elected Office

Any elected Office whose national law allows access by third parties to the file of a national application may allow access to any documents relating to the international application, including any document relating to the international preliminary examination, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the international publication of the international application. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

[COMMENT: Under the current interpretation of Article 38, elected Offices are not able to use certain kinds of material from the international preliminary examination file during the national examination procedure, particularly in cases where the elected Office had acted as the International Preliminary Examining Authority. It is therefore proposed to add new Rule 94.3 so as to include in the Regulations the legal basis for elected Offices to allow access to documents in the file; the proposed new Rule would also provide for the right for any elected Office to request reimbursement of the cost of the service offered—particularly in

cases where that Office did not carry out the international preliminary examination—of obtaining a copy of the file, of allowing access to the file, and of furnishing copies of documents contained in the file.]

[End of Annex and of document]