

WIPO



PCT/AAQ/VII/2

ORIGINAL: English

DATE: July 2, 1976

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

**PATENT COOPERATION TREATY**

**INTERIM ADVISORY COMMITTEE FOR ADMINISTRATIVE QUESTIONS**

**Seventh Session**

**Geneva, November 1 to 8, 1976**

**GUIDELINES FOR APPLICANTS FILING UNDER THE  
PATENT COOPERATION TREATY (PCT)**

Revised draft

prepared by the International Bureau

Background of the Guidelines

1. The PCT Interim Advisory Committee for Administrative Questions (hereinafter referred to as "the Interim Committee"), at its fourth session in Tokyo, Japan, in October 1973, invited the International Bureau to prepare a draft of guidelines for applicants using the PCT.
2. In response to that invitation, the International Bureau prepared a first draft of the guidelines which was considered by the Interim Committee at its sixth session in October/November 1975.
3. At its said sixth session, the Interim Committee decided that the form and content of the first draft of the guidelines should, in general, be maintained, including the general introduction on the purpose and principles of the PCT, but that references relevant for particular countries should be eliminated. Furthermore, it was decided that the guidelines should state that further information could be obtained from the receiving Offices and that the guidelines were not meant to replace the valuable assistance of professional representatives (see document PCT/AAQ/VI/21, paragraph 82).
4. The present revised draft of the "Guidelines for Applicants filing under the Patent Cooperation Treaty (PCT)" has been produced taking into account the comments and observations offered by the Interim Committee during its said sixth session. In particular, some parts of the previous document have been expanded and an attempt has been made to simplify the language wherever possible. As in the first draft, the chapter on Phase II of the international procedure is not yet included and will be submitted at a later date.

### Purpose of the Guidelines

5. The purpose of the Guidelines is to give applicants under the Patent Cooperation Treaty (hereinafter referred to as the "Treaty") general information, in a concise form, on aspects of the procedure under the Treaty. Thus, they are neither intended to serve as a comprehensive commentary on the Treaty, nor as an official guide for the professional representative dealing with international applications.

6. To achieve their purpose, the Guidelines provide information concerning those questions which are most likely to be asked by an applicant filing an international application under the Treaty. Many details which would be confusing to most applicants are either omitted or avoided as far as possible.

### In General

7. It is to be noted that the present draft of the Guidelines is of a provisional character, since it is impossible at present to provide information on certain points which would be of direct practical interest to applicants (for example, information on the individual requirements applicable to a particular receiving Office or International Searching Authority, such as the language or languages in which that Office will accept international applications filed with it, the amount of the transmittal fee charged by that Office, the amount of the search fee charged by that Office, etc.). The present draft of the Guidelines meets this situation by referring in a general way to the points on which information may be required and by providing for the inclusion of the information in Appendices to the Guidelines. This approach also serves to avoid congesting the main body of the Guidelines.

8. Later editions of the Guidelines will progressively complete the Appendices as and when the information to be included in them becomes available.

9. Broken lines have been used in the right-hand margins of the pages of the Guidelines to indicate, for the assistance of the Interim Committee, the points on which further information is to be included in the Appendices.

10. The present draft of the Guidelines does not set out the relevant provisions of the Patent Cooperation Treaty and the Regulations and the Administrative Instructions thereunder, but merely contains citations of these provisions in the left-hand margin. In this way, the applicant is not burdened with details from the outset, but is assisted should he wish to consult these texts in order to obtain more detailed information.

11. The Interim Committee is invited to examine, and comment on, the revised draft Guidelines annexed hereto.

[Annex follows]

DRAFT  
GUIDELINES FOR APPLICANTS  
FILING UNDER THE  
PATENT COOPERATION TREATY (PCT)

Table of Contents

	<u>page</u>
I. INTRODUCTION . . . . .	1
II. BRIEF EXPLANATION OF THE CONTENTS OF THE GUIDELINES . . . . .	2
III. SUMMARY OF THE TREATY AND ITS ADVANTAGES . . . . .	2
IV. PHASE I OF THE INTERNATIONAL PROCEDURE (Chapter I) . . . . .	3
A. The International Application . . . . .	3
B. Procedure Before the Receiving Office . . . . .	9
C. Procedure Before the International Searching Authority . . . . .	10
D. Procedure Before the International Bureau . . . . .	13
V. THE "NATIONAL" PHASE . . . . .	14
Procedure Before the Designated Offices . . . . .	14
VI. PHASE II OF THE INTERNATIONAL PROCEDURE (Chapter II) . . . . .	15
VII. APPENDICES . . . . .	16

## I. INTRODUCTION

1. These Guidelines are designed to give an applicant (or a prospective applicant) under the Patent Cooperation Treaty (hereinafter referred to as the "Treaty" or as the "PCT") a basic understanding of the Treaty and the procedure thereunder as far as relevant for him.

2. The main body of the Guidelines contains brief and general information on those features of the Treaty which are likely to be the subject of questions from an applicant contemplating the filing and subsequent prosecution of an international application under the Treaty\*.

3. Additionally, the Appendices contain information on various questions of direct practical interest which will supplement the more general information in the main body of the Guidelines.

4. It is stressed that these Guidelines are not to be regarded as a complete or official commentary. Nor is it the purpose of the Guidelines to serve as a replacement for the services of a professional representative. Furthermore, an applicant may obtain additional information from the receiving Office with which he is contemplating the filing of an international application under the Treaty.

5. In the left margins of the various parts of the Guidelines references are made to "Articles", "Rules" or "Sections" of the Treaty, the Regulations or Administrative Instructions under the Treaty, respectively. Should an applicant wish to acquire a more detailed understanding of matters in the Guidelines, he can do so by consulting the texts referred to.

---

\* The draft is for the time being limited to Chapter I of the Treaty, as far as the more detailed explanation of the procedure is concerned.

## II. BRIEF EXPLANATION OF THE CONTENTS OF THE GUIDELINES

6. The Guidelines first explain the Treaty with particular reference to the advantages the Treaty offers to an applicant.

7. This explanation is followed by information on matters relating to the contents and format of the international application and the filing of it.

8. Next, the applicant is introduced to the procedures before the receiving Office, the International Searching Authority and the International Bureau.

9. The Guidelines then proceed to deal with matters which arise when the applicant's international application leaves the international phase and enters the phase before the designated Offices.

10. Finally, the Guidelines contain Appendices giving necessary practical information to supplement that contained in the main body of the Guidelines.

## III. SUMMARY OF THE TREATY AND ITS ADVANTAGES

### Patent Cooperation Treaty

11. The Patent Cooperation Treaty gives to applicants seeking to protect an invention in a number of countries distinct advantages over the method of obtaining such protection by filing separately in each of the countries. Furthermore, the Treaty may be used as a vehicle for seeking regional patent protection granted under regional patent treaties (see paragraphs 59 to 61).

12. The Treaty has four main features of an international nature : international application, international search, international publication, and international preliminary examination. The first two are mandatory in the sense that normally all international applications filed become the subject of international search; in almost all cases such applications are also the subject of international publication. These three features, together, are referred to as Chapter I (Phase I) of the Treaty. The filing of an international application under the Treaty does not in and of itself result in the grant of a patent. Further additional action will be required upon completion of the international phase, such as processing and examination by the respective designated Offices.

13. The fourth feature--international preliminary examination--is optional. A Contracting State may make a reservation excluding the application of the Chapter of the Treaty providing for international preliminary examination. Moreover, even when the Chapter is applicable, an applicant can decide for himself whether he wants to take advantage of international preliminary examination. Naturally, for applicants choosing not to use Chapter II (Phase II), Chapter I (Phase I) is the only international phase.

### Advantages offered by the Treaty

14. By a single act of filing an international application under the Treaty, it is possible to secure the same effect as, without the Treaty, would require as many acts of filing a separate application as there are countries in which the applicant seeks protection.

15. The filing of an international application is in one of several recognized languages; for many applicants that will be the language, or one of the languages, used by the industrial property Office of, or acting for, their country.

16. The international application is filed in a single place; for an applicant of a given country the international application is generally filed in that country's national industrial property Office or a regional industrial property Office competent for that country.

17. The international application, in Phase I, is subject to the payment of a single international fee and possibly one or two additional fees. The hazards of incorrect payment of many fees and the need to rely on many agents or attorneys in many different countries are considerably reduced.

References

18. The filing of the international application permits filing under a single standardized format. There is no need to comply with a great variety of widely differing formal requirements in the many countries in which protection is sought.

19. The need to prepare translations is considerably delayed beyond the twelve-month priority period until the twentieth month from the priority date, that is, until an applicant has a much better idea of what the protection sought should be and what the commercial possibilities are. Thus, he is in a more advantageous position for selecting those countries in which he desires to continue seeking protection of his invention. As a result, substantial savings are to be made both on the costs of translation and filing in those countries which no longer are of interest.

20. The applicant's views are able to mature to a greater extent than otherwise would be possible without the Treaty, not only because he has more time, but also because the international search report constitutes a solid basis for determining his chances of obtaining the patent protection he is seeking.

21. An international search report which is favorable from the applicant's viewpoint strengthens his position vis-à-vis the various national or regional industrial property Offices and his arguments for the grant of a patent by those Offices become much more convincing.

22. If the international search report is partly favorable and partly adverse, the applicant can so modify his claims that he maintains only those which are likely to result in the grant of a patent.

23. If the international search report is adverse and, as a consequence, the applicant decides not to proceed any further, he saves the cost of processing the application for all designated countries. These costs could not be saved if the system of national applications rather than that of the Treaty were used, except perhaps in the rare cases where a national search report could be obtained sufficiently early in the priority year.

24. Moreover, an international search report should significantly reduce the searching tasks of the national or regional industrial property Offices and lead to savings in search time. This may result in savings of search cost to the applicant through the elimination or reduction of search fees the applicant would otherwise pay in the procedure before those Offices.

25. The applicant may, as a result of the international publication of his international application, further realize savings in certain national or regional fees which he would otherwise have to pay. This follows from the fact that, in some cases, the designated Offices could adopt the centralized international publication in lieu of making, and thereby incurring the cost of, their own publication of that application.

IV. PHASE I OF THE INTERNATIONAL PROCEDURE (Chapter I)

A. The International Application

(What it is - Who may file - Where to file - Language - Contents - Form - Copies to be filed - Priority Claim - Representation - Inventor as Applicant - Naming of Inventor - Regional Patent - International Filing Date)

Concept of an "international application"

Art. 3, 4(1)(ii) 26. An international application under the Treaty is an application for the protection of an invention filed in or for at least one of the States party to the Treaty, i.e., a Contracting State. Upon filing, the international application has the same effect as a regular national or regional application for the protection of the invention in each of the Contracting States which are designated in the application. An applicant may designate any Contracting State in which protection is desired by indicating the name of that State in the request part of his international application. A list of the States which are parties to the Treaty is set forth in Appendix I.

11(3)  
Rule 4.9.  
Administrative  
Instructions  
Section 202

References

Right to file an international application

Art. 9  
Rule 18

27. Any resident or national of a State party to the Treaty may file an international application. The Treaty also provides for the possibility of granting the residents or the nationals of countries which are not Contracting States, but which are party to the Paris Convention for the Protection of Industrial Property, the right to file international applications. A listing of such countries is set forth in Appendix I.

Filing of an international application

Article 10  
Rule 19.1

28. An applicant must file his international application with the receiving Office of or acting for the Contracting State of which he is a resident or a national. For most Contracting States, the receiving Office will be its national industrial property Office; it may also be a regional industrial property Office. The names and addresses of the receiving Offices of or acting for the Contracting States are indicated in Appendix II.

Language of the international application

Art. 3(4)(i)  
Rule 12.1

29. The language in which an applicant must submit his international application is frequently the same language as that used by his national or regional industrial property Office. Some receiving Offices permit the applicant to file his application in any one of several languages. The language (or languages) in which international applications must be submitted to each receiving Office is (are) indicated in Appendix II.

Contents of the international application

Art. 3(2)

30. An international application contains the following elements : a request, a description, one or more claims, one or more drawings (if drawings are required) and an abstract.

Art. 4  
Rules 3 and 4

31. The request must be made on a printed form which provides space for the entry of various bibliographic data, i.e. items of information serving to identify the international application, the persons associated with the application, the subject matter contained in the application and the type and geographical scope of the protection sought on the basis of it. More specifically, such data includes the identification of the applicant, the inventor, and the agent; an indication of the title of the invention; an indication whether a patent or some other form of protection is sought and a designation of the States in which protection is sought; and the claims of priority. An applicant can obtain the printed form to be used for the request from a receiving Office or, in some instances, from the International Bureau. The name and address of the appropriate receiving Office can be obtained from Appendix II.

Art. 5  
Rule 5  
Administrative Instructions  
Sección 205

32. The description contains a disclosure of the invention. It is divided into six distinct parts. These parts contain matter relating to : the technical field of the invention, the background art, the disclosure of the invention, a brief description of the drawings, if any, the best mode for carrying out the invention, and the industrial applicability of the invention. The applicant should label each part with its proper heading.

Art. 6  
Rule 6

33. The claims define the matter for which protection is sought. The applicant is to construct the claims in two parts. The first part indicates those technical features of the invention which are necessary for the definition of the claimed subject matter, but which are part of the prior art. The second part indicates the technical features of his invention which the applicant seeks to protect.

Art. 7,  
17(2)(a)(ii)  
Rule 7

34. Drawings, including flow sheets and diagrams, must be submitted when they are necessary for the understanding of the invention. Moreover, whenever the nature of the invention admits of drawings, the applicant may include them in the international application. This would help to ensure a better understanding of the invention.

Rule 8

35. The abstract is a concise summary of the disclosure as contained in the description, the claims and the drawings (if any). It should be designed to facilitate searching in the particular art, especially by assisting the scientist, engineer or researcher in formulating an opinion on whether there is need to consult the international application itself.

References

Art. 3(2)  
Rule 11.7  
Administrative  
Instructions  
Section 208

36. The elements of the international application are to be arranged in the following order : the request, the description, the claims, the drawings and the abstract. All the sheets contained in the international application must be numbered in consecutive arabic numerals.

Form of the international application

Art. 14(1)(a)  
(v)  
Rules 9, 10, 11  
Administrative  
Instructions  
Section 205

37. The formal requirements applicable in respect of international applications, in particular, as to expressions not to be used and as to terminology and signs and the physical requirements governing the formal presentation of the text matter and drawings contained in the international application (e.g. such matters as the type of paper to be used, size of sheets, margins (numbering of sheets, etc.) are set forth in detail in the Regulations under the Treaty. The international application must meet all these requirements. While, during the international phase of the procedure, only those of the physical requirements will be enforced which are essential in order to ensure a reasonably uniform international publication of the international application, compliance with all these requirements will be enforced, at the latest, when entering the procedure before the designated Offices. Full compliance with these requirements at the time of filing is therefore highly advisable.

Number of copies of the international application to be filed

Rules 11(1), 21

38. Ordinarily the international application is to be filed in one copy. However, a receiving Office may require that the international application and most documents accompanying the application be filed in two or three copies. If the international application is filed in less than the number of copies required, the receiving Office is responsible for the prompt preparation of the number of copies required and may fix and collect a fee from the applicant for performing that task. Appendix II indicates those receiving Offices which require the international application to be filed in more than one copy, the number of copies they require and the amount of any fee charged for the preparation of additional copies.

Art. 12(1)

39. The reason why several copies of the international application may be required is that one copy, which is called the "home copy", is kept by the receiving Office, another copy, which is called the "record copy", is transmitted to the International Bureau, and a third copy, which is called the "search copy", is transmitted by the receiving Office to the International Searching Authority.

Fees to be paid at the time of filing an international application

40. There are three prescribed fees which an applicant may have to pay at the time of filing his international application. These fees are as follows;

- Rule 14
- (i) a transmittal fee for the benefit of the receiving Office for receiving, performing its tasks in connection with, and transmitting copies of, the international application (Appendix III indicates the amount of the transmittal fee charged by each receiving Office requiring such fee);
- Rule 16
- (ii) a search fee for the benefit of the International Searching Authority for carrying out the international search and for performing the other tasks entrusted to that Authority under the Treaty (Appendix III indicates the amount of the search fee charged by each International Searching Authority requiring such fee);
- Rule 15
- (iii) the international fee, which includes a basic fee and a designation fee for each State designated in the international application, for the benefit of the International Bureau for performing the necessary tasks entrusted to it under the Treaty (Appendix III indicates the amount of the international fee charged by the International Bureau).

41. All these fees are paid by the applicant at one central place--the receiving Office--which, in turn, transmits the international fee and the search fee to the International Bureau and the International Searching Authority, respectively.

References

Rule 15.4 42. The basic portion of the international fee and the search fee are due at the time of receipt of the international application by the receiving Office. However, there is a possibility of later payment of the basic fee to the receiving Office, if that Office so permits. In any case, the payment may not be made later than one month after receipt of the international application. The designation fees may be paid at the time of receipt of the international application or at a later date, but must be paid in any case before the expiration of one year from the priority date.

Rule 29.1(a) 43. Failure to pay the required fees within their respective time limits will result in the international application being considered as withdrawn.

Claiming priority of an earlier application

Art. 8 44. An applicant who claims the priority of an earlier application or applications  
Rule 4.10(a) for the same invention must, in relation to each such application, indicate in the  
4.10(c) request, at the time of filing his international application, the country in or  
for which the application was filed, the date on which it was filed and the  
application number of the earliest application. If he cannot indicate the number  
in the request at the time of filing of the international application, it must  
be furnished to the International Bureau at the latest by the expiration of 16  
months from the priority date. If any of these requirements are not met, the  
applicant risks that, in the case of lack of indication of country or date, his  
priority claim is, for the international phase of the procedure, considered not to  
have been made and that, in the case of lack of any of the required indications,  
the designated Offices will not recognize his priority claim.

Rule 17.1 45. A copy of each earlier application, the priority of which is claimed, certified by the authority with which it is filed, if not submitted to the receiving Office at the time of filing of the international application, must be submitted to the International Bureau not later than 16 months after the priority date. If the applicant fails to comply with the requirement for submission of the priority application, any designated State may disregard the claim for priority.

Representation

Art. 27(7) 46. Unless the receiving Office requires that the applicant be represented by an agent, the applicant has the right to prepare and file his own international application and to carry on himself the prosecution of that application before the international authorities. In view of the importance of a careful preparation of the international application and of its proper processing before the international authorities, it is, however, highly advisable for an inexperienced applicant to use the services of a professional representative already for the international phase of the procedure. For the continuation of the procedure before the designated Offices, the law applicable for each such Office determines whether the applicant must have an agent. Appendix IV lists those receiving Offices which require the applicant to be represented by an agent. Additionally, Appendix IV indicates the Contracting States which, if designated in the international application, require that the applicant be represented by an agent during the phase before the designated Office.

Art. 4(1)(iii) 47. Should the applicant be required, or desire, to designate or appoint an agent  
Rules 4.7, to represent him, he can do so either by designating an agent in the request of the  
90.3 international application or by appointing an agent by a separate signed power of attorney submitted either to the receiving Office or to the International Bureau. Powers of attorney should be submitted to the International Bureau only after the applicant has received from the International Bureau notice of its receipt of the record copy of the international application.

Art. 4(i)(iii) 48. If there are several applicants and the applicants designate an agent in the  
Rules 4.7, 90.3 request of the international application or appoint an agent by a separate power  
Administrative of attorney signed by all applicants, then that agent is their common agent, that  
Instructions is, he represents all the applicants.  
Section 106

Rule 4.8 49. If the several applicants do not wish to be represented by a common agent, they should at least designate in the request one among them having the right to file an international application (see paragraph 27) to act as the common representative for all the applicants. If they fail to designate a common representative, then the applicant first named in the request having the right to file an international application automatically becomes the common representative.



References

Inventor as applicant

50. The answer to the question whether or not the applicant must be the inventor depends upon the law of each State which is designated in the international application.
- Art. 27(3)  
Rule 18.4 51. The law of any designated State may require that, for the purposes of that State, one of the applicants must be the inventor or else the international application will be rejected when it enters the phase of the procedure before the designated Office of or acting for that State.
- Rule 86 52. Information on the relevant provisions applicable in the Contracting States making use of that faculty can be found in the Gazette published by the International Bureau. A summary of this information is given in Appendix V.

Naming of inventor

- Rule 4.1(a)(v) 53. Even in the case where the law of any designated State does not require that the inventor be the applicant or one of the applicants, the law of such State may, nevertheless, require that the inventor be identified in the international application.
54. The various laws applicable in the Contracting States in respect of the naming of the inventor fall into one of the following categories:
- (i) those that require the inventor to be identified at the time of filing of a national application;
  - (ii) those that require the inventor to be identified but allow the identification to be made at a time later than that of the filing of the application; and
  - (iii) those that do not require the inventor to be identified.
- Art. 4(1)(v),  
4(4) 55. If the law of any designated State requires that the inventor be identified at the time of filing of the application, then the inventor must be identified in the request of the international application at the time it is filed. Failure to do so, however, will have no consequence in those designated States whose laws either do not require that the inventor be identified or allow the inventor to be identified at a time later than that of the filing of the application.
- Art. 4(1)(v),  
4(4),  
22 56. If the law of any designated State requires that the inventor be identified but allows the identification to be made at a time later than that of the filing of the application, then the inventor may be identified either in the request at the time of filing of the international application or in a separate notice addressed to the designated Office. If this is done by a separate notice, the notice must be furnished by the time the international application enters the procedure before that Office. Failure to do so, however, will have no consequence in the designated States whose laws do not require that the inventor be identified.
- Rules 4.1(a)(v),  
86 57. An applicant can obtain information on the various applicable laws in respect of the requirement to identify the inventor and the time at which that identification must be made from the Gazette published by the International Bureau. A summary of this information is given in Appendix V.
- Rules 4.4,  
4.6 58. Where the applicable law requires the identification of the inventor, an applicant must indicate both the name and the address of the inventor.

Regional patents

- Art. 4(1)(ii)  
45 59. An applicant may also use the international application as a means for seeking regional patents granted under the various regional patent treaties.
- Rule 4.1(b)(iv)  
Administrative  
Instructions  
Section 204 Appendix VI identifies the regional patent treaties which permit the applicant to seek a regional patent on the basis of his international application and the Contracting States of the PCT which are also parties to such regional patent treaties. Except for any State whose national law automatically gives the designation of that State in the international application the effect of an application for a regional patent, the application must, if he wishes to obtain a regional patent for any State which he has designated in his international application and for which a regional patent is available, expressly indicate this wish, in the

References

request of the international application, in respect of such State. Appendix VI identifies also the Contracting States of the PCT whose national laws provide the said automatic effect.

Art. 4(1)(ii) 60. If a regional patent treaty provides that an application cannot be limited to less than all of the States party to that treaty, then, where the applicant designates any one of those States in his international application and expressly indicates in respect of that State the wish to obtain a regional patent, that designation is treated as if the applicant had designated in his international application all of the States party to the regional patent treaty. Appendix VII identifies the regional patent treaties containing such a provision and the Contracting States of the PCT which are also parties thereto.

Art. 10 61. Whether an international application to be filed in a State party to a regional patent treaty and seeking a regional patent must be filed with the regional patent Office or the national patent Office, depends on the relevant provisions under the regional treaty (see paragraph 28 and the Appendix referred to thereunder).

International filing date

Art. 11(1) 62. The "international filing date" is the date on which an application filed as an international application fulfills certain prescribed requirements enabling it to be acknowledged as an international application by the receiving Office with which the application was filed. An international application must meet the following prescribed requirements in order to be accorded an international filing date:

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

(ii) the international application must be in the prescribed language;

(iii) the international application must contain at least the following elements:

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

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

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

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

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

Art. 11(2)  
Rule 20.6 63. If the application as filed does not fulfill the prescribed requirements, the applicant is notified of the requirements which are not met and is invited to submit, where possible, the necessary corrections. If the defects are correctable, (that is, defects other than those relating to the right to file the international application (see paragraph 62(i) above)), only the date on which all corrections necessary to fulfill the requirements are submitted will be accorded as the international filing date.

Art. 11(2)  
Rules 15.6(a),  
16.2, 20.7 64. Should the applicant fail to submit all corrections necessary to fulfill the requirements after having been invited to do so, the application will not be treated as an international application. In this case, any payment of the search fee and the international fee which the applicant has made will be refunded.

References

B. Procedure Before the Receiving Office

(What it is - Functions - Language used - Transmittal of Record Copy - Declaration of Withdrawal - Time Limit for Response - Payment of Fees)

Receiving Office

Art. 10  
Rule 19.1

65. A "receiving Office" is the Office which is authorized to receive international applications for one or more Contracting States. For most Contracting States not parties to regional patent treaties, the receiving Office will be the national industrial property Office. The names and addresses of the receiving Offices of or acting for the Contracting States are indicated in Appendix II.

Functions of the receiving Office

66. In connection with the international application, the receiving Office is responsible for performing tasks related to:

(i) the receipt of the application;

(ii) the checking of the application to determine whether it meets the requirements governing the form and contents of the international application (the checks performed by the receiving Office are of a formal nature and are not intended to go into the substance of the invention);

(iii) communicating with the applicant in order to obtain the necessary corrections where the checks have shown that the international application does not meet certain requirements as to form and contents; and

(iv) the transmittal of copies of the international application and other documents related thereto to the International Searching Authority and to the International Bureau so that they may carry out their functions in the further processing of the international application.

Language of correspondence

Administrative  
Instructions  
Section 104

67. The applicant must use the language of the international application, or such other language as may be expressly authorized by the receiving Office, as far as correspondence with the receiving Office is concerned.

Transmittal of record copy

Art. 12(3)  
Rule 22.3

68. The transmittal of the record copy of the international application from the receiving Office to the International Bureau is an important step in the PCT procedure because, if the record copy has not been received by that Bureau as a rule before the expiration of 14 months from the priority date, the international application will be considered withdrawn.

69. The Treaty provides for two alternative procedures for the transmittal of the record copy.

70. Under the first alternative constituting the normal procedure, the transmittal of the record copy is effected by the receiving Office, and the International Bureau, upon receipt, promptly notifies the applicant that it has received the record copy.

Rules 22.1(b)  
22.3

71. However, if the applicant has not received that notification within 13 months and 10 days from the priority date, he may assume that the record copy has not reached the International Bureau and he may ask the receiving Office to give him the record copy or a certified copy based on the home copy and send it himself to the International Bureau. The record copy must, in that case, reach the International Bureau not later than 14 months from the priority date.

Rule 22.2

72. Under the second alternative requiring, as an exceptional procedure, express provision by the competent receiving Office, the applicant may, at his option, effect the transmittal of the record copy himself. Appendix VIII indicates those receiving Offices which have introduced the said exceptional procedure.

References

Declaration that application considered withdrawn

- Art. 14(1) 73. The receiving Office may declare that the international application is considered withdrawn if it finds:
- Art. 3(2),  
4(1)(iv),  
14(1)  
Rules 4.1(d),  
4.3, 4.5, 4.15
- (1) that the international application contains any of the defects set forth below and that the applicant did not comply, within the prescribed time limit, with the invitation to correct the defects, such defects being as follows:
- (i) it is not signed as provided in the Regulations;
  - (ii) it does not contain the prescribed indications concerning the applicant;
  - (iii) it does not contain the title of the invention;
  - (iv) it does not contain an abstract;
  - (v) it does not comply to the extent provided in the Regulations with the prescribed physical requirements (see paragraph 37).
- Art. 14(3)(a)  
Rule 27
- (2) that the prescribed fees (i.e., the transmittal fee, the search fee, and the international fee) have not been paid within the prescribed time limit;
- Art. 14(4)
- (3) that, in cases where an international filing date has already been accorded, any of the requirements necessary for the according of that filing date were not, in fact, complied with.

The declaration that the international application is considered withdrawn is subject to review under certain circumstances (see paragraph 99).

Time limit for response

- Rules 20.6(b),  
20.7(i), 26.2,  
29.1(a)
74. The response of an applicant to an invitation from the receiving Office to correct certain defects in the international application must be made within a prescribed time limit. The usual period for response to an invitation to correct defects relating to matters of a formal nature is one or two months. However, a shortened time limit for response may be imposed which may be as short as ten days from the date of the invitation to correct. If no response is received within the time limit, the application will not be treated as an international application or will be considered withdrawn, as the case may be.

C. Procedure Before the International Searching Authority

(What it is - Functions - Language used - International Search - Situations where no International Search carried out - Subject Matter not searched - Unity of Invention - Refund of Search Fee - International Search Report)

International Searching Authority

- Art. 16  
Rules 33, 34  
35, 36
75. An "International Searching Authority" is that Authority which carries out international search of the international applications filed with any given receiving Office which has specified that Authority as competent for the searching of applications filed with it. The International Searching Authorities are those national or regional industrial property Offices which have been appointed for that purpose by the Assembly, i.e. the highest administrative body set up under the Treaty. Appointment as an International Searching Authority has been made subject to the conclusion of an agreement between the national or regional industrial property Office and the International Bureau. This agreement spells out the obligations of that Office, in particular, the formal undertaking by that Office to apply and observe all the common rules of international search. Any Office which has been appointed as an International Searching Authority has met, at least, the requirements set forth in the Treaty in respect of the number of technically qualified employees to carry out searches, the technical fields in which searches are carried out, the documentation to be searched and the language facilities to deal with that documentation. Such requirements are designed to ensure that the international search reports which the applicants receive from these Offices are of a uniformly high quality. The names and addresses of the various International Searching Authorities are listed in Appendix IX together with an indication for each of them for which receiving Office or Offices they carry out international searches.

References

Functions of the International Searching Authority

Art. 15, 18 76. The major responsibilities of the International Searching Authority are the making of an international search and the preparing of the international search report.

Rules 12,  
92(a) and (b) Language of correspondence

77. In general, the applicant must use the language of the international application as far as correspondence with the International Searching Authority is concerned. Appendix IX specifies the language or languages of the international application in which the different International Searching Authorities carry out international searches.

International search

Art. 15  
Rules 33, 34 78. The international search is conducted by the International Searching Authority on the basis of at least the prescribed minimum documentation. The objective of the international search is to discover relevant prior art. Such prior art consists of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining whether the claimed invention is new and whether it involves an inventive step (i.e., that it is not obvious), provided that the making available to the public occurred prior to the international filing date.

Situations where no international search is carried out

Art. 17(2)(a) 79. The International Searching Authority is not required to carry out an international search on an international application if:

(i) the international application relates to a subject matter which it is not required to search and which it decides not to search (see paragraph 80); or

(ii) the description, the claim, or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out.

In such case, it notifies the applicant that no international search report will be established.

Subject matter not required to be searched

Art. 17(2)(a) 80. An International Searching Authority is not required (but may still admit) to  
(1) search international applications relating to the following subject matter:

Rule 39

(i) scientific and mathematical theories;

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

(iii) schemes for, or rules or methods of, doing business, performing purely mental acts or playing games;

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

(v) mere presentations of information;

(vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

Appendix IX specifies for which of the above subject matter the various International Searching Authorities do not accept to search international applications.

References

Unity of invention

- Art. 3(4) 81. The search fee which the applicant is required to pay is intended to compensate  
(iii) the International Searching Authority for carrying out an international search on  
Rule 13 his international application, but only where the international application meets  
the "requirement of unity of invention". That means that the international appli-  
cation must relate to only one invention or must relate to a group of inventions  
which are so linked as to form a single general inventive concept.
- Art. 17(3)(a) 82. If the International Searching Authority finds that the international appli-  
cation does not comply with the requirement of unity of invention, it can invite  
the applicant to pay additional fees. If the applicant does not comply with the  
invitation, the International Searching Authority then establishes the international  
search report only on those parts of the international application which relate to  
the invention first mentioned in the claims ("main invention"). Appendix IX  
indicates the amount of the additional fees charged by each International Searching  
Authority.
- Rule 40.2(c) 83. Any applicant may pay the additional fee under protest, that is, accompanied  
by a reasoned statement to the effect that the international application complies  
with the requirement of unity of invention or that the amount of the required  
additional fee is excessive. This protest will be examined by a three-member  
board or other special instance of the International Searching Authority or any  
competent higher authority, and a decision will be taken thereon. To the extent  
that the applicant's protest is found justified, total or partial reimbursement  
of the additional fees will be made.

Refund of search fee

- Rules 16.3, 84. The applicant may be entitled to a refund of the search fee where the  
41 invention disclosed in the international application has already been the subject  
of an earlier search by the same International Searching Authority, conducted on  
an earlier international application the priority of which he claims. Another  
possibility of entitlement to this refund arises when the earlier search was a  
search similar to an international search (international-type search) carried out  
by the competent International Searching Authority, if the law applicable for the  
Contracting State so permits. In both cases, the amount of the refund depends upon  
the extent to which the results of that earlier search can be wholly or partly used.

International search report

- Rule 43, 85. The main objective of the international search report is to provide the  
citation of the prior art documents considered to be relevant. Thus, it gives the  
applicant a clear basis upon which he can decide whether it is worthwhile to con-  
tinue the procedure before the designated Offices in seeking protection of his  
invention. If, in the light of the international search report, which will be  
sent to him by the International Searching Authority, he decides that it is not  
worthwhile, he saves all subsequent costs. The international search report also  
contains other information of value to an applicant, for example, the classi-  
fication of the subject matter (at least according to the International Patent  
Classification) and an indication of the fields searched by the International  
Searching Authority.

Copies of the documents cited in the international search report

- Art. 20(3) 86. The applicant may obtain copies of the documents cited in the international  
Rule 44.3 search report by requesting such copies from the International Searching Authority.  
However, the latter may require payment of the cost of preparing and mailing the  
copies. Appendix IX indicates the rates charged by each International Searching  
Authority for furnishing such copies.

References

D. Procedure Before the International Bureau

(What it is - Functions- Language used - Amendments of claims - Withdrawal - International publication - Communication of international application)

International Bureau

87. The "International Bureau" means the International Bureau of the World Intellectual Property Organization situated at 32, chemin des Colombettes, 1211 Geneva 20, Switzerland.

Functions of the International Bureau

88. In general, the International Bureau, after the international application has undergone the processing before the receiving Office in respect of matters of form and presentation and after an international search has been carried out on that application by the International Searching Authority, is responsible for the international publication of that application together with the international search report relating to it, and for the transmittal of the application and the search report to the designated Offices. Thus, the International Bureau can be looked upon as performing a central role between the receiving Office and the International Searching Authority, on the one hand, which process the international application during its international phase under the Treaty, and the designated Offices, on the other hand, which continue to process the international application on the basis of the results of the international phase with a view to granting or refusing a patent.

Language of correspondence

Rule 92.2(d) 89. The applicant must use either English or French for correspondence with the  
Administrative International Bureau.  
Instructions  
Section 104(b)

Amendment of claims

Art. 19 90. The applicant is entitled to one opportunity to amend the claims of his  
Rule 46 international application after he has received the international search report. The amendments are to be submitted to the International Bureau. They must be in the same language as the international application itself, and they may be accompanied by a brief statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings. In general, the amendments must not go beyond the disclosure in the international application as filed.

Withdrawal by applicant

Rule 32 91. The applicant may withdraw his international application or the designation of any State by means of a signed notice addressed to the International Bureau or, if the record copy has not yet been sent to the International Bureau, to the receiving Office. In general, withdrawal may only be effected prior to the expiration of 20 months from the priority date.

International publication

Art. 21, 92. The international publication is the publication of the international appli-  
64(3) cation by the International Bureau which, in general, takes place promptly after  
Rule 48 the expiration of 18 months from the priority date of that application. Where an international search report has been established on the international application, the international publication will, as a rule, also include that report. Disregarding exceptional situations, there will be no international publication only if the international application is voluntarily withdrawn by the applicant or is declared to be considered withdrawn by one of the international authorities before the technical preparations for publication have been completed, or when only States are designated which have declared that, as far as they are concerned, international publication of the international application is not required.

References

Art. 21  
Rule 48.4 93. On the request of the applicant, the International Bureau will publish the international application at any time prior to the expiration of 18 months from the priority date.

Communication of the international application

Art. 20  
Rules 45, 47 94. Unless a designated Office waives the communication entirely or in part, the International Bureau communicates to each designated Office the international application together with the international search report, if one has been established. The communication also includes, where applicable, the translation of that report and the amended claims. Appendix X indicates those designated Offices which have decided to waive the communication under Article 20.

V. THE "NATIONAL" PHASE

Procedure Before the Designated Office

(Entering "National" Phase - Representation - Amendments)

Entering the "national" phase

95. The so-called "national" phase of the PCT procedure comprises the procedure before the designated Offices. Since those Offices may either be national or regional Offices, the term "national" must in this case be understood in a broader context, comprising also the procedure before a regional Office, where applicable.

Art. 22  
Rule 49.1 96. The applicant must pay the fees and furnish the translations of the international application which are required by the designated Offices upon entering the "national" phase. This must, unless the law of the designated Office provides for a longer time limit, occur not later than at the expiration of 20 months from the priority date. The applicant may consult the Gazette published by the International Bureau for information on the time limits which any particular designated State applies in respect of the furnishing of a translation and the paying of fees and in respect of the language of that translation and the amounts of those fees. A summary of this information is given in Appendix XI.

Art. 13(2)  
Rule 31 97. The applicant may, however, at any earlier time during the international phase, transmit a copy of his international application to any designated Office, or ask the International Bureau to do so.

Art. 23 98. As a rule, processing of the international application by the designated Office may start only upon the expiration of the time limit referred to in paragraph 96. Any designated Office may, however, on the express request of the applicant, process or examine the international application at any earlier time.

Art. 25  
Rule 51 99. The applicant also has the right to enter the "national" phase early in order to seek review before the designated Offices concerned if either his international application or the designation of any given State is considered to be withdrawn in the international phase. For example, if the receiving Office does not accord his application an international filing date, or if any of the situations occur where either the receiving Office or the International Bureau decides to declare that the international application or the designation of any given State is to be considered withdrawn, the applicant has the right to request the designated Offices concerned to review that decision.

More favorable national requirements

Art. 27(4) 100. Where the national law of any State permits, the designated Office may apply to an international application requirements with respect to the form and contents of national applications which are more favorable to the applicant than the requirements prescribed under the Treaty.



References

Representation

Art. 27(7)

101. Once the application has entered the "national" phase and the processing of that application has started in the designated Office, it is a question of the applicable law as to whether the applicant himself has the right to prosecute his application before the designated Office, or whether he must be represented by an agent having the right to practice before that Office. Appendix IV indicates the Contracting States which, if designated in the international application, require that the applicant be represented by an agent during the procedure before the designated Office.

Amendments

Art. 28  
Rule 52

102. The applicant has the opportunity to amend the claims, the description and the drawings before the designated Offices. Any amendments must be submitted within a given time limit. The amendments must not go beyond the disclosure in the international application as filed unless the law of the designated Office permits them to go beyond the said disclosure. The amendments must be in accordance with the law of the designated Office in all respects not provided for in the PCT. The amendments must be presented in the language of the translation of the international application if a translation is required.

VI. PHASE II OF THE INTERNATIONAL PROCEDURE (Chapter II)

(to be submitted later)

APPENDICES

[An exemplary list of Appendices with titles indicating the contents of the general information<sup>1</sup> contained in the main body of the Guidelines is given below.]

- APPENDIX I, TITLE: LIST OF STATES WHICH ARE PARTIES TO THE PCT, AND OF COUNTRIES, PARTY TO THE PARIS CONVENTION, BUT NOT CONTRACTING STATES OF THE PCT, THE RESIDENTS OR NATIONALS OF WHICH HAVE THE RIGHT TO FILE INTERNATIONAL APPLICATIONS
- APPENDIX II, TITLE: LIST OF NAMES AND ADDRESSES OF THE RECEIVING OFFICES OF OR ACTING FOR THE CONTRACTING STATES UNDER THE PCT, INDICATING FOR EACH RECEIVING OFFICE THE LANGUAGE OR LANGUAGES IN WHICH INTERNATIONAL APPLICATIONS MUST BE SUBMITTED AND THE NUMBER OF COPIES OF THE INTERNATIONAL APPLICATION TO BE FILED AS WELL AS THE AMOUNT OF THE FEE CHARGED FOR PREPARATION OF ANY ADDITIONAL COPIES
- APPENDIX III, TITLE: LIST INDICATING FOR EACH RECEIVING OFFICE AND INTERNATIONAL SEARCHING AUTHORITY THE AMOUNT OF THE TRANSMITTAL FEE AND THE AMOUNT OF THE SEARCH FEE CHARGED BY THE AUTHORITY CONCERNED AS WELL AS THE INTERNATIONAL FEE CHARGED BY THE INTERNATIONAL BUREAU
- APPENDIX IV, TITLE: LIST OF AGENT REQUIREMENTS, INDICATING THOSE RECEIVING OFFICES WHICH REQUIRE THE APPLICANT TO BE REPRESENTED BY AN AGENT AND THOSE CONTRACTING STATES WHICH, IF DESIGNATED IN THE INTERNATIONAL APPLICATION, WOULD REQUIRE THE APPLICANT TO BE REPRESENTED BY AN AGENT BEFORE THE DESIGNATED OFFICE
- APPENDIX V, TITLE: LIST OF THOSE CONTRACTING STATES, THE NATIONAL LAW OF WHICH REQUIRES THE APPLICANT TO BE THE INVENTOR OR REQUIRES IDENTIFICATION OF THE INVENTOR
- APPENDIX VI, TITLE: LIST OF REGIONAL PATENT TREATIES PERMITTING THE APPLICANT TO SEEK A REGIONAL PATENT ON THE BASIS OF AN INTERNATIONAL APPLICATION WITH AN INDICATION OF THOSE CONTRACTING STATES OF THE PCT PARTIES TO THESE TREATIES
- Note: The names of the Contracting States which automatically give the international application the effect of an application for a regional patent have been marked with an asterisk.
- APPENDIX VII, TITLE: LIST OF REGIONAL PATENT TREATIES PROVIDING THAT THE EFFECT OF A DESIGNATION OF AN INTERNATIONAL APPLICATION CANNOT BE LIMITED TO LESS THAN ALL OF THE CONTRACTING STATES OF THE PCT WHICH ARE PARTIES TO THE TREATY CONCERNED
- APPENDIX VIII, TITLE: LIST OF THOSE RECEIVING OFFICES WHICH PERMIT THE APPLICANT TO TRANSMIT THE RECORD COPY HIMSELF

---

<sup>1</sup> [The information to be contained in the Appendices will be progressively completed at such time as that information becomes available.]

- APPENDIX IX, TITLE: LIST OF INTERNATIONAL SEARCHING AUTHORITIES TOGETHER WITH THEIR ADDRESSES, INDICATING FOR EACH OF THEM THE NAMES OF THOSE RECEIVING OFFICES FOR WHICH THE SAID AUTHORITIES CARRY OUT INTERNATIONAL SEARCHES, THE LANGUAGE OR LANGUAGES IN WHICH THE AUTHORITY CONCERNED CARRIES OUT INTERNATIONAL SEARCHES, THE SUBJECT MATTER WHICH THE AUTHORITY DOES NOT SEARCH, THE AMOUNT OF THE ADDITIONAL FEES CHARGED BY THE AUTHORITY CONCERNED IN RESPECT OF LACK OF COMPLIANCE WITH THE REQUIREMENT OF UNITY OF INVENTION, AND THE RATES CHARGED BY THE AUTHORITY CONCERNED FOR FURNISHING COPIES OF THE DOCUMENTS CITED IN THE INTERNATIONAL SEARCH REPORT
- APPENDIX X, TITLE: LIST OF DESIGNATED OFFICES WHICH HAVE DECIDED TO WAIVE THE COMMUNICATION UNDER ARTICLE 20
- APPENDIX XI, TITLE: LIST OF THE CONTRACTING STATES, INDICATING FOR EACH OF THEM, IF DESIGNATED IN THE INTERNATIONAL APPLICATION, THE TIME LIMITS FOR FURNISHING THE TRANSLATION AND PAYMENT OF NATIONAL FEES AS WELL AS THE LANGUAGE OF THAT TRANSLATION AND THE AMOUNTS OF THOSE FEES

[End of Annex]  
[End of document]