

PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT
PROPOSED MODIFICATIONS OF THE DIRECTIVES OF THE ASSEMBLY RELATING
TO THE ESTABLISHMENT OF EQUIVALENT AMOUNT OF CERTAIN FEES

PROPOSED AMENDMENT OF ARTICLE 11 OF THE AGREEMENTS BETWEEN THE
INTERNATIONAL BUREAU AND OFFICES IN RELATION TO THEIR FUNCTIONING
AS INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING
AUTHORITIES

Matters for consultation prior to submission to the
PCT Assembly at its 40th session
Geneva, September 22 to October 1, 2009

FOR COMMENT BY JULY 6, 2009

1. The PCT Working Group, at its second session held from May 4 to 8, 2009, agreed on a number of proposed amendments of the Regulations under the PCT, proposed modifications of the Directives by the Assembly relating to the establishment of equivalent amounts of certain fees, and proposed amendments of Article 11 of the Agreements between the International Bureau and Offices in relation to their functioning as International Searching and Preliminary Examining Authorities, with a view to their submission to the Assembly for consideration at its next session, to be held in September/October 2009 (see the Summary by the Chair, document PCT/WG/2/13, and the Working Group's draft report, document PCT/WG/2/14 Prov.).
2. The Working Group also agreed that a number of matters should be the subject of further consultation via the Working Group's electronic forum. This paper sets out the Secretariat's proposals on those further matters. Comments are invited by July 6, 2009 (preferably submitted by e-mail to pct.wg@wipo.int), following which the documents for submission to the Assembly will be finalized.

FORM OF AMENDMENTS

3. See paragraphs 97 to 106 of the Working Group's draft report and the proposals considered by the Working Group set out in document PCT/WG/2/9.
4. In order to address the issue outlined in paragraph 101 of the Working Group's draft report, the Secretariat proposes that Rule 70.2 be amended by adding a new paragraph (*c-bis*) as follows:

“(c-bis) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter complying with the requirements under Rule 46.5 as applicable by virtue of Rule 66.8(c), or with the requirements of Rule 66.8(a), as the case may be, the report may be established as if the amendment had not been made, in which case the report shall so indicate.”

ESTABLISHMENT OF EQUIVALENT AMOUNTS OF CERTAIN FEES

5. See paragraphs 126 to 137 of the Working Group's draft report and the proposals considered by the Working Group set out in document PCT/WG/2/2.

6. In order to address the issue outlined in paragraph 134 of the Working Group's draft report, the Secretariat proposes that the Directives set out in Annex II to document PCT/WG/2/2 be further changed to read as follows (the proposed further changes relative to the proposed text appearing in Annex II to document PCT/WG/2/2 are highlighted by shading; a "clean" text of the Directives as they would stand after amendment follows):

Marked up text

"The Assembly establishes in the following terms the directives relating to the establishment of equivalent amounts of the international filing fee, the handling fee, the search fee and the supplementary search fee (see referred to in Rules 15.2(d)(i), 16.1(d)(i), 45bis(3)(b) and 57.2(d)(i)(e)), it being understood that, in the light of experience, the Assembly may at any time modify these directives:

"Establishment of Equivalent Amounts

"(1) The equivalent amounts of the international filing fee and the handling fee in any currency other than Swiss franc, and of the search fee and the supplementary search fee in any currency other than the fixed currency, shall be established by the Director General, in the case of:

"(i) the international filing fee, after consultation with each receiving Office which prescribes payment of those fees in such currency;

"(ii) the search fee, after consultation with each receiving Office which prescribes payment of those fees in such currency;

"(iii) the handling fee, after consultation with each International Preliminary Examining Authority which prescribes payment in such currency.

"In the case of the international filing fee, the search fee and the handling fee, the equivalent amounts shall be established according to the exchange rates prevailing on the day preceding the day on which the consultations are initiated by the Director General. In the case of the supplementary search fee, the equivalent amounts shall be established according to the exchange rates prevailing on the day on which the Director General receives the notification of the amount of the supplementary search fee or prevailing on the day two months prior to the entry into force of the supplementary search fee, whichever is the later.

“(2) The amounts so established shall be the equivalent, in round figures,

“(i) of the amount of the international filing fee and of the handling fee, respectively, in Swiss franc set out in the Schedule of Fees;

“(ii) of the amount of the search fee and the supplementary search fee (if applicable) established by the International Searching Authority in the fixed currency.

“They shall be notified by the International Bureau to each receiving Office, International Searching Authority and International Preliminary Examination Authority, as applicable, prescribing payment in the currency concerned and shall be published in the Gazette.

“*Establishment of New Equivalent Amounts Consequential on Changes in the Amount of the Fee Concerned*

“(3) Paragraphs (1) and (2) shall apply *mutatis mutandis* where the amount of the international filing fee, the handling fee, the search fee or the supplementary search fee is changed. The new equivalent amounts in the prescribed currencies shall be applied from the same date as the changed amount of the international filing fee or of the handling fee set out in the amended Schedule of Fees, or from the same date as the changed amount of the search fee or the supplementary search fee in the fixed currency.

“*Establishment of New Equivalent Amounts Consequential on Changes in Exchange Rates*

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

“(5) ~~(2)~~ Where, for more than 4 consecutive Fridays (midday, Geneva time) ~~30 consecutive days,~~ the exchange rate between Swiss franc currency (in the case of the international filing fee and the handling fee) or the fixed currency (in the case of the search fee and the supplementary search fee) and any applicable prescribed ~~other~~ currency is by at least 5% higher, or by at least 5% lower, than the last exchange rate applied,

~~“(i) so far as Rule 15.2(d) is concerned, any receiving Office referred to in the second sentence of Rule 15.2(b) or~~

~~“(ii) so far as Rule 57.2(e) is concerned, any receiving Office or International Preliminary Examining Authority referred to in the second sentence of Rule 57.2(e)~~

~~“may ask the Director General shall, where applicable, after consultations with the Offices or Authorities referred to in paragraph (1), to newly establish the new equivalent amounts of the international filing fee, the search fee, the supplementary search fee and/or the handling fee, as applicable, in that currency according to the exchange rate prevailing on the first Monday following the expiration of the period referred to in the first sentence of this paragraph day preceding the day on which the request is made. The Director General shall proceed accordingly, as provided in Rules 15.2(d) and 57.2(e). The newly established amount shall become applicable two months after the date of its publication in the Gazette, provided that the receiving Offices or the International Preliminary Examining Authorities concerned, as applicable, and the Director General may agree on a date falling during the said two-month period, in which case the said amount shall become applicable from that date.~~

~~“(3) [Deleted] Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 10% higher, or by at least 10% lower, than the last exchange rate applied, the Director General shall,~~

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

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

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

~~“(4) [Deleted] As far as the international filing fee is concerned, the Director General may decide to apply paragraph (3) as if the percentage referred to in that paragraph was 5%.~~

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

“Clean” text:

“The Assembly establishes in the following terms the directives relating to the establishment of equivalent amounts of the international filing fee, the handling fee, the search fee and the supplementary search fee (see Rules 15.2(d)(i), 16.1(d)(i), 45bis(3)(b) and 57.2(d)(i)), it being understood that, in the light of experience, the Assembly may at any time modify these directives:

“Establishment of Equivalent Amounts

“(1) The equivalent amounts of the international filing fee and the handling fee in any currency other than Swiss franc, and of the search fee and the supplementary search fee in any currency other than the fixed currency, shall be established by the Director General, in the case of:

- “(i) the international filing fee, after consultation with each receiving Office which prescribes payment of those fees in such currency;
- “(ii) the search fee, after consultation with each receiving Office which prescribes payment of those fees in such currency;
- “(iii) the handling fee, after consultation with each International Preliminary Examining Authority which prescribes payment in such currency.

“In the case of the international filing fee, the search fee and the handling fee, the equivalent amounts shall be established according to the exchange rates prevailing on the day preceding the day on which the consultations are initiated by the Director General. In the case of the supplementary search fee, the equivalent amounts shall be established according to the exchange rates prevailing on the day on which the Director General receives the notification of the amount of the supplementary search fee or prevailing on the day two months prior to the entry into force of the supplementary search fee, whichever is the later.

“(2) The amounts so established shall be the equivalent, in round figures,

- “(i) of the amount of the international filing fee and of the handling fee, respectively, in Swiss franc set out in the Schedule of Fees;
- “(ii) of the amount of the search fee and the supplementary search fee (if applicable) established by the International Searching Authority in the fixed currency.

“They shall be notified by the International Bureau to each receiving Office, International Searching Authority and International Preliminary Examination Authority, as applicable, prescribing payment in the currency concerned and shall be published in the Gazette.

“Establishment of New Equivalent Amounts Consequential on Changes in the Amount of the Fee Concerned

“(3) Paragraphs (1) and (2) shall apply *mutatis mutandis* where the amount of the international filing fee, the handling fee, the search fee or the supplementary search fee is changed. The new equivalent amounts in the prescribed currencies shall be applied from the same date as the changed amount of the international filing fee or of the handling fee set out in the amended Schedule of Fees, or from the same date as the changed amount of the search fee or the supplementary search fee in the fixed currency.

“Establishment of New Equivalent Amounts Consequential on Changes in Exchange Rates

“(4) In the month of October of each year, the Director General shall, where applicable, after consultations with the Offices or Authorities referred to in paragraph (1), establish new equivalent amounts of the international filing fee, the handling fee, the search fee and the supplementary search fee according to the exchange rates prevailing on the first Monday in the month of October. Unless otherwise decided by the Director General, any adjustment under this paragraph shall enter into force on the first day of the subsequent calendar year.

“(5) Where, for more than 4 consecutive Fridays (midday, Geneva time), the exchange rate between Swiss franc (in the case of the international filing fee and the handling fee) or the fixed currency (in the case of the search fee and the supplementary search fee) and any applicable prescribed currency is by at least 5% higher, or by at least 5% lower, than the last exchange rate applied, the Director General shall, where applicable, after consultations with the Offices or Authorities referred to in paragraph (1), establish new equivalent amounts of the international filing fee, the search fee, the supplementary search fee and/or the handling fee, as applicable, according to the exchange rate prevailing on the first Monday following the expiration of the period referred to in the first sentence of this paragraph. The newly established amount shall become applicable two months after the date of its publication in the Gazette, provided that the receiving Offices or the International Preliminary Examining Authorities concerned, as applicable, and the Director General may agree on a date falling during the said two-month period, in which case the said amount shall become applicable from that date.”

7. In order to address the issue outlined in paragraph 135 of the Working Group’s draft report, the Secretariat proposes that, in addition to the proposed amendments of Article 11(4) appearing in Annex III to document PCT/WG/2/2, Article 11(2) of the agreements under PCT Article 16(3) between the International Bureau and Offices in relation to their functioning as International Searching and Preliminary Examining Authorities be amended to read as follows:

“(2) Without prejudice to ~~paragraphs~~ ~~paragraph~~ (3) and (4), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.”

8. Such amendment of Article 11(2) of the agreements under PCT Article 16(3) would clarify that, if so agreed between the Director General and the Authority, any change in the currency or amount of fees and charges may take effect earlier than two months from the date on which an Authority has notified the Director General of any such change (see Article 11(4)).

SUPPLEMENTARY INTERNATIONAL SEARCH

9. See paragraphs 152 to 156 of the Working Group's draft report (document PCT/WG/2/14 Prov.) and the proposals considered by the Working Group set out in document PCT/WG/2/10.
10. In order to address the issue outlined in paragraph 156 of the Working Group's draft report, the Secretariat proposes that Rules 45*bis*.5(g) and 45*bis*.9(c) be further changed to read as follows (the proposed further changes relative to the proposed text appearing in paragraph 155 of the Working Group's draft report are highlighted by shading):

Rule 45*bis*.5(g)

“(g) If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation referred to in Rule 45*bis*.9(a), other than a limitation under Article 17(2) as applicable by virtue of Rule 45*bis*.5(c), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.”

Rule 45*bis*.9(c)

“(c) The limitations referred to in paragraph (a) may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, other than limitations beyond those which would apply under Article 17(2) as applicable by virtue of Rule 45*bis*.5(c) to the international search, and limitations as to the total number of supplementary international searches which will be carried out in a given period, and limitations to the effect that the supplementary international searches will not extend to any claim beyond a certain number of claims.”

PROPOSED DECISIONS RELATING TO ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

11. As regards the proposed amendments of the Regulations relating to the supplementary search system (proposed amendments of Rules 45*bis*.1, 45*bis*.2, 45*bis*.3, 45*bis*.5, 45*bis*.6, 45*bis*.9 and 96.1), the Secretariat proposes that those amendments should enter into force on July 1, 2010, and should apply to any international application, regardless of its international filing date, in respect of a supplementary search request under Rule 45*bis*.1(a) made on or after July 1, 2010.
12. As regards the proposed amendments of the Regulations relating to the form of amendments (proposed amendments of Rules 46.5 and 66.8, and proposed addition of new Rule 70.2(c-*bis*)), the Secretariat proposes that those amendments should enter into force on July 1, 2010, and should apply to any international application, regardless of its international filing date, in respect of an amendment of the claims, description or drawings made on or after July 1, 2010.

13. As regards the proposed amendments of the Regulations relating to the establishment of equivalent amounts of certain fees (proposed amendments of Rules 15.2, 15.3, 15.4, 15.5, 15.6, 16.1, 19.4, 57.2, 57.4, 57.5 and 57.6) and the proposed modifications of the Directives of the Assembly Relating to the Establishment of Equivalent Amounts of Certain Fees, the Secretariat proposes that these amendments and modifications should enter into force on July 1, 2010, and apply to the establishment of equivalent amounts which, in accordance with the Regulations and the Directives as in force as of July 1, 2010, are established according to an exchange rate prevailing on, or a date after, July 1, 2010. It is proposed that the proposed amendments should not apply to the establishment of equivalent amounts which, in accordance with the Regulations and the Directives as in force prior to July 1, 2010, are established according to an exchange rate prevailing on a date prior to July 1, 2010; in respect of the establishment of such equivalent amounts, the Regulations and the Directives as in force prior to July 1, 2010 should continue to apply until the new equivalent amounts so established become applicable

14. As regards the proposed amendments of Article 11(2) and (4) of the agreements under PCT Article 16(3) between the International Bureau and Offices in relation to their functioning as International Searching and Preliminary Examining Authorities, the Secretariat proposes that the Assembly be invited to approve the inclusion of Article 11(2) and (4) as amended in the applicable agreements under PCT Article 16(3), with effect from a date to be agreed upon by each Authority and the Director General. In addition, the Secretariat proposes that the Assembly be invited to recommend that such amendments should be made to the applicable agreements and should, where possible, become effective on July 1, 2010.

15. It is thus proposed to recommend to the Assembly that it adopt the following decisions relating to entry into force and transitional arrangements:

“1. The amendments of the PCT Regulations relating to the supplementary search system (amendments of Rules 45*bis*.1, 45*bis*.2, 45*bis*.3, 45*bis*.5, 45*bis*.6, 45*bis*.9 and 96.1) set out in Annex I [*of document PCT/A/39/...*] shall apply to any international application, regardless of its international filing date, in respect of a supplementary search request under Rule 45*bis*.1(a) made on or after July 1, 2010.

“2. The amendments of the PCT Regulations relating to the form of amendments (amendments of Rules 46.5 and 66.8, and new Rule 70.2(c-*bis*)) set out in Annex II [*of document PCT/A/39/...*] shall apply to any international application, regardless of its international filing date, in respect of an amendment of the claims, description or drawings made on or after July 1, 2010.

“3. The amendments of the PCT Regulations relating to the establishment of equivalent amounts of certain fees (amendments of Rules 15.2, 15.3, 15.4, 15.5, 15.6, 16.1, 19.4, 57.2, 57.4, 57.5 and 57.6) set out in Annex III [*of document PCT/A/39/...*] and the proposed modifications of the Directives of the Assembly Relating to the Establishment of Equivalent Amounts of Certain Fees set out in Annex IV [*of document PCT/A/39/...*]:

“(a) shall enter into force on July 1, 2010, and shall apply to the establishment of equivalent amounts which, in accordance with the Regulations and the Directives as in force as of July 1, 2010, are established according to an exchange rate prevailing on, or a date after, July 1, 2010;

“(b) shall not apply to the establishment of equivalent amounts which, in accordance with the Regulations and the Directives as in force prior to July 1, 2010, are established according to an exchange rate prevailing on a date prior to July 1, 2010; in respect of the establishment of such equivalent amounts, the Regulations and the Directives as in force prior to July 1, 2010 shall continue to apply until the new equivalent amounts so established become applicable.

“4. With regard to the approved inclusion of amended Articles 11(2) and (4) in the applicable agreements under PCT Article 16(3) between the International Bureau and Offices in relation to their functioning as International Searching and Preliminary Examining Authorities set out in Annex V [*of document PCT/A/39/...*], with effect from a date to be agreed upon by each Authority and the Director General, the Assembly recommends that such amendments should be made to the applicable agreements and should, where possible, become effective on July 1, 2010.”

[End]