

WIPO



PCT/A/27/4

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

ASSEMBLY

**Twenty-Seventh (12th Ordinary) Session
Geneva, September 20 to 29, 1999**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/34/1 Prov.3): 1, 2, 3, 4, 5, 6, 8, 14, 23, 26, 28 and 29.
2. The report on the said items, with the exception of item 14, is contained in the General Report (document A/34/16).
3. The report on item 14 is contained in the present document.
4. Mr. Jorge Amigo Castañeda (Mexico) was elected Chair of the Assembly; Mrs. Maureen Dougan (Canada) and Mr. Sarkis Khantardjian (Armenia) were elected Vice-Chairs.

ITEM 14 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Proposed Amendments of the Schedule of Fees Annexed to the Regulations Under the PCT

5. Discussions were based on document PCT/A/27/1.
6. The Delegation of Cuba supported the proposed amendments of the Schedule of Fees, noting, however, that it was concerned with the impact such reductions could have on funds for development activities and expressing its hope that such funds would not decrease as a result.
 7. The Assembly unanimously adopted the amendments of the Schedule of Fees as set out in the Annex to this report and decided that they would enter into force on January 1, 2000.

PCT Automation

8. Discussions were based on document PCT/A/27/2.
9. Introducing the document, the Secretariat announced the distribution of a paper containing a report drawn up by the experts from six Offices who helped the International Bureau in evaluating the five short-listed bids submitted for the purpose of selecting an enterprise or consortium of enterprises that would develop the automated system.
10. The Delegation of the United States of America, applauding WIPO's efforts to bring the PCT system into the electronic age, stated that any electronic filing solution developed in the context of the PCT should, at least, be compatible with electronic filing solutions developed for national filings. The Delegation emphasized that now that WIPO had begun deployment of information technology resources that were approved in the 1998-1999 Program and Budget and would consider further deployments in future budgets, it was critical that these resources be utilized to the maximum advantage of the users of WIPO services. The Delegation further noted that it supported WIPO's business process reengineering efforts and the coordination of WIPO's numerous information technology initiatives through the development of the Strategic Information Technology Plan and expressed its belief that the effective use of information technology would enable WIPO to continue to meet the growing demands placed on it by the private sector, while reducing the need for staff growth, increasing efficiency and lowering costs in the future. The Delegation further stated that it lauded WIPO's dedication to the principles of transparency and accountability and that it looked forward to working with the International Bureau in implementing the important automation initiatives in WIPO.
 11. The Assembly took note of the progress report on the PCT Automation ("IMPACT") Project contained in paragraphs 1 to 8 of document PCT/A/27/2, took note of the information concerning the modifications to be made to the PCT Administrative Instructions to provide for electronic filing contained in paragraph 9 of document PCT/A/27/2, and approved the proposal concerning the provision of workstations contained in paragraph 10 of document PCT/A/27/2.

Claiming Priority Under the PCT: Proposed Amendments of the Regulations

12. Discussions were based on document PCT/A/27/3.

13. The Secretariat introduced the proposed amendments to PCT Rule 4.10 set out in document PCT/A/27/3 as well as proposed new paragraph (d) of Rule 4.10, presented during the discussion in connection with the matter raised by the Delegation of Japan (see next paragraph). It also drew attention to paragraph 6 of document PCT/A/27/3, which indicated that a PCT Contracting State that was not a WTO Member would not be obliged to recognize the effects of a claim to priority based on an earlier filing in a WTO Member which was not party to the Paris Convention. Information as to any effect given by such PCT Contracting States to such claims would be collected and published by the International Bureau. Moreover, any such Contracting State, and any Contracting State to which new paragraph (d) of Rule 4.10 applied, having any special requirements in relation to claims to priority based on earlier filings in countries not party to the Paris Convention would be invited to inform the International Bureau of those requirements so that the latter could publish them.

14. The Delegation of Japan indicated that, even though it agreed with the proposal in principle, the proposal was not compatible with the Japanese national law and a transitional provision was needed, as far as Japan was concerned, until that law was amended; the proposed new paragraph (d) of Rule 4.10 was acceptable to the Delegation.

15. The Delegation of Cuba expressed its agreement on the substance of the proposal, noting, however, that it would have been preferable to deal with this matter by a revision of Article 8 of the Treaty itself. However, in view of the difficulties involved in a revision procedure, it could accept the proposed amendments of Rule 4.10.

16. The Delegation of the Netherlands stated that it shared the position of the Delegation of Cuba. It added that not only Article 8, but the Treaty as a whole might need revision so as to bring it up to modern standards.

17. The Assembly unanimously adopted the amendments of Rule 4.10 as set out in the Annex to this report and decided that they would enter into force on January 1, 2000.

[Annex follows]

ANNEX

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
TEXT OF THE AMENDED RULE AND SCHEDULE OF FEES
(as in force from January 1, 2000)

4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

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

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;

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

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

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

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

(ii) where the earlier application is a regional application and at least one of the countries party to the regional patent treaty is neither party to the Paris Convention for the Protection of Industrial Property nor a Member of the World Trade Organization, the priority claim shall indicate at least one country party to that Convention or one Member of that Organization for which that earlier application was filed.

(c) For the purposes of paragraphs (a) and (b), Article 2(vi) shall not apply.

(d) If, on September 29, 1999, paragraphs (a) and (b) as amended with effect from January 1, 2000, are not compatible with the national law applied by a designated Office, those paragraphs as in force until December 31, 1999, shall continue to apply after that date in respect of that designated Office for as long as the said paragraphs as amended continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by October 31, 1999. The information received shall be promptly published by the International Bureau in the Gazette.

SCHEDULE OF FEES
(as in force from January 1, 2000)

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	140 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 8 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	140 Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The total amount of the fees payable under items 1 and 2(a) is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.
5. All fees payable (where applicable, as reduced under item 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[End of Annex and of document]