

WIPO



PCT/A/32/8

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

ASSEMBLY

**Thirty-Second (14th Ordinary) Session
Geneva, September 22 to October 1, 2003**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/39/1): 1, 2, 3, 4, 5, 6, 7, 9, 11, 18, 23, 25 and 26.
2. The report on the said items, with the exception of item 6, is contained in the General Report (document A/39/15).
3. The report on item 6 is contained in the present document.
4. Mr. Ian Heath (Australia) was elected Chair of the Assembly; Mr. Bisereko Kyomuhendo (Uganda) and Mr. Rimvydas Naujokas (Lithuania) were elected Vice-Chairs.
5. Mr. Heath presided over the meeting of the Assembly.

ITEM 6 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Schedule of Fees Annexed to the Regulations Under the PCT; Directives for Establishing New Equivalent Amounts of Certain Fees

6. Discussions were based on documents PCT/A/32/1 and 6.

7. The Director General stated that he had closely followed the important discussion on PCT reform, PCT fees and its impact on the budget process for the coming biennium. He assured the Assembly that WIPO was committed to providing cost-effective and user-friendly services of the PCT. The system was currently in the process of transition. The PCT reform would bring about a number of important changes and services as of early next year. In addition, it was necessary to fix the financial framework of this new phase of operation. He suggested, as a matter of principle, to start this process without a change in the fees charged for the typical PCT application. It seemed that to implement this approach at this stage was difficult, as it was not yet known how the PCT users would adapt their filing strategy to the new arrangement. He therefore recommended a two-step approach to respond to this issue in a flexible manner. First, he suggested the approval of a new PCT fee structure closely linked to the proposals set out in document PCT/A/32/1 with one modification, namely, an international filing fee of 1,400 Swiss francs. Second, he intended to consult with Member States and review the actual usage of the new PCT arrangement. On the basis of this work, he would propose a readjustment of the PCT fee, if necessary, next year.

8. The International Bureau referred to the proposal in the Schedule of Fees according to which the reduction currently applied to natural persons from certain countries, including least developed countries (LDCs), would be extended to legal persons, such as companies, from LDCs. A number of delegations had expressed concern to the International Bureau that this might open up the possibility of exploitation on the part of less scrupulous companies from States which were not LDCs. Having looked closely at this matter, noting Rule 18 of the PCT Regulations which dealt with the concepts of residence and nationality, the International Bureau suggested that the Assembly should proceed, as proposed in document PCT/A/32/1, to extend the reduction to corporations and other legal persons in LDCs. The International Bureau did not think that abuse would be likely to arise, but undertook to monitor the matter carefully over the course of the following 12 months. It would then make further proposals to the Assembly if necessary.

9. The Assembly unanimously adopted the amendments of the Schedule of Fees annexed to the Regulations under the PCT appearing in Annex I to this report and decided that those amendments:

(a) shall enter into force on January 1, 2004, and shall apply to any international application whose international filing date is on or after January 1, 2004, provided that the Schedule of Fees as worded before its amendment (by either the present amendments or by those set out in document PCT/A/31/10, Annex V) shall continue to apply to any international application which is received by the receiving Office before January 1, 2004, and is accorded an international filing date that is on or after January 1, 2004;

(b) shall not apply to any international application whose international filing date is before January 1, 2004, provided that the following provisions shall apply to any international application in respect of which a demand for international preliminary examination is filed on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004:

(i) item 2 of the Schedule of Fees as amended; and

(ii) item 4 of the Schedule of Fees as amended, insofar as it relates to the handling fee.

10. The Assembly unanimously adopted the modifications of the directives relating to the establishment of new equivalent amounts of certain fees appearing in Annex II to this report and decided that those modifications shall enter into force on January 1, 2004.

11. The Delegation of the Republic of Korea thanked the International Bureau for the development of the electronic filing system designed to cope with the increasing number of PCT applications in an efficient manner. The Delegation considered that the character coded (XML) format for patent applications would provide the greatest benefits, bringing efficiency in data entry, storage, handling and searching possibilities. Furthermore, it noted that PCT-EASY, the forerunner of this system, offered fewer benefits and less efficiency, requiring the handling and storage of paper, the diskette and the electronic contents of the diskette. Consequently, the Delegation supported the incentive scheme, encouraging applicants to file applications in electronic form, and especially in XML format, by providing differential fee reductions. However, the Delegation noted that the XML-based system was new to most users and that the first application in this format filed with the receiving Office of the International Bureau had been filed only one month ago. The PCT-EASY software remained, among Contracting States, including the Republic of Korea, the most popular electronic means for filing international applications. Consequently, the Delegation was concerned about the change from 200 to 100 Swiss francs in the fee reduction in respect of international applications filed using the PCT-EASY software being applicable from January 1, 2004, just three months from now. The PCT receiving Office of the Republic of Korea would not be ready to accept applications in XML format by that time, and the Delegation would have preferred a transitional period of at least six months in applying the changes in the reduction scheme for PCT applications filed using the PCT-EASY software.

12. The International Bureau noted the particular circumstances described by the Delegation of the Republic of Korea, while emphasizing that introducing an appropriate scale of incentives for electronic filing in the new fee structure had been a complex exercise.

13. The Delegation of Mexico highlighted WIPO's importance for developing countries in the context of a globalized economy. The work done by the Organization could help to speed up economic and social development, as well as development in science, industry, culture and technology. The Delegation recalled that the patent system was established in order to encourage technological and scientific research. The Delegation felt that an appropriate level of PCT fees for the biennium 2004-2005, as proposed by the International Bureau, would, on the one hand, benefit users of the system, who needed quality services, and would make use of the system more attractive; on the other hand, it would financially strengthen the Organization with a positive impact on international cooperation for development. A reduction in PCT fees, together with the decrease in the number of applications filed in 2003

and the possibility of only minor increases in filings in the near future, would create additional pressure on the development cooperation budget. As a result, the Delegation supported the PCT fees proposal consistently with its earlier statements in the Program and Budget Committee and in the Working Group on Reform of the PCT.

14. The Delegation of Italy, on behalf of the European Community and its Member States, as well as the States which were in the process of acceding to the European Community, stated that the Community and those States had carefully examined the proposals concerning the structure and the level of PCT fees and agreed in principle with a policy aimed at reducing them. They were, however, aware that such a policy would have an impact on WIPO's budget and asked the International Bureau to carefully monitor the future development of the revenues of the PCT system, with a view to defining an adequate strategy that would lead to a possible reduction of PCT fees in the medium term.

Reform of the PCT

15. Discussions were based on document PCT/A/32/2.

16. The Delegation of Costa Rica, on behalf of GRULAC, expressed its concern about the envisaged dates for the fifth session of the Working Group on Reform of the PCT, tentatively scheduled to take place in Geneva from November 17 to 21, 2003, noting a scheduling conflict with another meeting in a different forum that was due to take place during that week in Geneva, and noting the difficulties, in particular for smaller delegations, to be adequately represented when several meetings were scheduled to take place at the same time. In this context, the Delegation further noted the importance of financial assistance being made available to enable experts from developing countries to attend the highly technical sessions of the Working Group.

17. The Director General, referring to the concerns expressed by the Delegation of Costa Rica, stated that the International Bureau would consult with the delegations concerned with a view to finding an appropriate solution.

18. The Delegation of China expressed its thanks for WIPO's work on reform of the PCT, noting that the PCT had served China well over the years. The Delegation said that it expected the PCT to play an increasingly important role in China in the years to come, noting that, in the first eight months of 2003, the number of international applications filed with its Office as a PCT receiving Office had increased by about 14%, while the number of international applications entering the national phase in China had increased by about 7%. The Delegation welcomed the remarkable results that reform of the PCT had achieved in a relatively short period of time. It also supported the plan to reduce the international filing fee, which would attract more applicants. Finally, the Delegation emphasized that, at this point, Contracting States needed time to adapt their national legislations and information technology systems, and to train staff, with the assistance of WIPO.

19. The Delegation of Romania, speaking on behalf of the Central European and Baltic States, expressed its support for the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2003 and September 2004 sessions of the Assembly.

20. The Assembly:

(i) took note of the summaries by the Chair of the third and fourth sessions of the Working Group on Reform of the PCT contained in documents PCT/R/WG/3/5 and PCT/R/WG/4/14 and reproduced in Annexes I and II to document PCT/A/32/2;

(ii) unanimously approved the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2003 and September 2004 sessions of the Assembly, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee, and financial assistance to enable attendance of certain delegations, as set out in paragraph 26 of document PCT/A/32/2.

Proposed Amendments of the Regulations Under the PCT

21. Discussions were based on document PCT/A/32/4 and 4 Add.1.

22. The Assembly unanimously adopted the amendments of the Regulations under the PCT contained in Annex III and decided that those amendments:

(a) shall enter into force on January 1, 2004, and shall apply to any international application whose international filing date is on or after January 1, 2004;

(b) shall not apply to any international application whose international filing date is before January 1, 2004, provided that:

(i) amended Rules 53.2, 60.1 and 61.1 shall apply to any international application in respect of which a demand for international preliminary examination is filed on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004;

(ii) amended Rule 70.16 shall apply to any international application in respect of which the international preliminary examination report is established on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004.

23. In connection with amended Rule 16*bis*.2(a), the Assembly noted that the 75% reduction provided for by the Schedule of Fees in the case of certain applicants from qualifying countries (including most developing countries) would, in effect, carry over to any late payment fee payable under Rule 16*bis*.2 by virtue of Rule 16*bis*.2(a)(i) (see document PCT/A/32/4, Annex II, paragraph 4).

24. The Assembly noted that Rule 73.2 as adopted on October 1, 2002, with effect from January 1, 2004, had to be read in light of Article 38(1) and present Rule 94.2 and would not prevent an elected Office from gaining access to the file of the international preliminary examination once the international preliminary examination report had been established (see document PCT/A/32/4, Annex II, paragraph 12).

Appointment of the National Board of Patents and Registration of Finland as an International Searching and Preliminary Examining Authority Under the PCT; Approval of the Corresponding Draft Agreement

25. Discussions were based on document PCT/A/32/5.

26. The Delegation of Finland stated that the PCT Committee for Technical Cooperation had recognized, last year, that Finland had the right to seek appointment of the National Board of Patents and Registration of Finland (the "Board") as an International Searching and Preliminary Examining Authority. The Board had the necessary competence and capacity in this respect, in particular, as far as technical aspects were concerned, as detailed in document PCT/A/32/5. The Delegation explained that the Board wanted to guarantee good service to all its clients, including inventors, small- and medium-sized enterprises and large-scale industry. The Delegation further stated that, over the past five years, the number of international applications originating from Finland had doubled and had been as high as 1,762 in 2002. The Delegation pointed out that Finnish industry had been satisfied with the high standard of search and examination work carried out by the Board, as well as by the modern methods and tools used. Electronic filing of applications had started in the spring of 2001, and the Board aimed at introducing fully electronic processing of applications and electronic file inspection before the end of 2004. The Delegation also emphasized that examiners had access to the whole PCT minimum documentation in electronic form and to an extensive collection of documents in paper form. The Delegation stated that the Board as an International Searching and Preliminary Examining Authority would process applications in Finnish, Swedish and English, originating, at the first stage, from Finland. It was anticipated that the Board would be ready to start operations during the year 2004. On behalf of the Finnish government and on behalf of the Board, the Delegation expressed the wish that its application would receive a positive response.

27. The Delegation of Kyrgyzstan expressed its support for the proposal and stressed that it was sure that Finland met all the required standards, since it was a highly qualified organization with a very good technical basis and a great deal of experience.

28. The Delegation of Australia noted that the Board met all the technical requirements to be appointed as an International Searching and Preliminary Examining Authority and that there was no reason to refuse the appointment. The Delegation expressed its support for the proposal.

29. The Delegation of South Africa stated that it also supported the proposal and was looking forward to future collaboration with the new International Authority.

30. The Delegation of Estonia expressed its strong support for the appointment of the Board.

31. The Delegation of Egypt also supported the proposal.

32. The Assembly:

(i) approved the text of the Agreement between the National Board of Patents and Registration of Finland and the International Bureau as set out in Annex IV to this report; and

(ii) appointed the National Board of Patents and Registration of Finland as International Searching and Preliminary Examining Authority with effect from the entry into force of said Agreement.

33. The Delegation of Finland expressed its gratitude to the Assembly for granting the Board the status of International Searching and Preliminary Examining Authority and especially to the delegations that had supported the proposal, as well as to the Director General and to the International Bureau for its technical support. The Delegation further stated that Finland was looking forward to working with all PCT Contracting States and promised to provide the best possible quality of work.

IMPACT Project Status Report

34. Discussions were based on document PCT/A/32/3.

35. In introducing the report, the International Bureau provided the Assembly with a brief update on the status of the project.

36. The Assembly took note of the status report on the IMPACT Project contained in document PCT/A/32/3.

PCT-SAFE Project Status Report

37. Discussions were based on document PCT/A/32/7.

38. In introducing the report, the International Bureau provided the Assembly with a brief update on the status of the project.

39. The Assembly took note of the status report on the PCT-SAFE Project contained in document PCT/A/32/7.

40. The Delegation of Egypt, referring to its recent accession to the PCT which entered into force on September 6, 2003, expressed the hope that its collaboration with all PCT Contracting States would benefit all and help to promote economic development. The Egyptian Patent Office had been able to enhance its working capacity in the last few years, thanks to the continuous support of WIPO, allowing the Office to look forward to excellent results and performance. The Delegation noted, in particular, the introduction of an electronic processing system and the creation of a PCT receiving unit equipped with advanced technologies for dealing both with international and national phases processing of PCT applications. The Delegation added that the Office, having become a model for other Offices in the Arab region, was currently streamlining its services for search and examination. The Delegation indicated that, as a next step, the Office would consider the question of becoming an International Searching and Preliminary Examining Authority. Furthermore, noting that there were now eight Arab Member States in the PCT Union, the Delegation stressed the importance of envisaging the future introduction of the Arabic language as an official

language under the PCT, in particular for the purposes of international publication, so as to facilitate the use of PCT by applicants from the Arab region and provide wider access to information in that region. The Delegation expressed its appreciation to the Arab Bureau for the continued assistance provided in respect of accession to the PCT, and, in addition to the Office of the PCT and the Developing Countries (PCT) Division.

41. The Delegation of France, reiterating its strong support for a PCT system which is adaptable to various users' needs, indicated that it was pleased with the adoption of the proposed amendments of the Regulations under the PCT. Furthermore, it supported the progress on the automation projects (IMPACT and PCT-SAFE), noting that they had benefitted from a major financial effort. The Delegation was of the view that the effect of the amendments and of the new fee structure would need to be evaluated before any further changes were made to the system. Having noted a gradual slowdown, since last year, in the overall number of applications filed, the Delegation expressed the wish that the PCT Authorities would take advantage of the situation to reduce their backlogs, this being one of the continuing existing difficulties experienced by the system. The slowdown would need to be assessed to see whether it was a one-time situation or whether it represented the beginning of a trend, in which case its impact on WIPO's budget and on the budgets of the various Offices would need to be assessed. The Delegation was pleased to note, as others had already done, the growing number of emerging countries joining the PCT and of the applications originating therefrom, noting that the bilateral and multilateral assistance extended to those countries was beginning to bear fruit. Finally, the Delegation pledged to continue its involvement in work relating to the PCT and to patent law harmonization.

42. The Delegation of Japan stated that it was extremely important to introduce more accountability and transparency in respect of the accounts of the PCT Union. As implied by PCT Article 53(2)(vi), such accounts could be considered, theoretically, as independent, even though they were closely and/or directly related to the accounts of other Unions as well as to the overall accounts of WIPO. In other words, the PCT Union activities could be considered as independent activities, or an independent business, and could be separated from other WIPO activities, especially from the accounting viewpoint. At the same time, the Delegation fully recognized the present budgetary situation of WIPO, noting how much certain WIPO activities depended on the income generated by the PCT. The Delegation was, at this point, asking neither for the immediate introduction of an independent accounting system in respect of the PCT Union nor for a separation of the PCT income from the WIPO general income. However, when trying to secure the future stability of WIPO's budgetary situation, the Delegation believed that it was indispensable to undertake a feasibility study on introducing an independent accounting system for the PCT Union, such as was widely in use in the private sector. When considering the present situation relating to the Madrid Union and the Hague Union, and to some extent that relating to the decrease of international applications, it seemed that thought should be given to the future of the PCT Union. According to document A/39/5, entitled "Medium-term Plan for WIPO Program Activities – Vision and Strategic Direction of WIPO," the modernization of accounting practices would be ensured as a matter of policy, which the Delegation strongly supported, in particular because the PCT Union was the most important Union for WIPO. The Delegation wished to suggest that the International Bureau take into account systems widely used in the private sector when addressing the modernization of WIPO's accounting practices.

43. The Delegation of the United States of America fully supported the statement made by the Delegation of Japan.

44. The International Bureau welcomed the proposal made by the Delegation of Japan, indicating that it would study the question and report back in due course.

[Annex I follows]

ANNEX I

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on January 1, 2004)

SCHEDULE OF FEES

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,400 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling fee: (Rule 57.2)	200 Swiss francs

Reductions

3. The international filing fee is reduced by the following amount if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:

- | | |
|---|------------------|
| (a) on paper together with a copy thereof in electronic form: | 100 Swiss francs |
| (b) in electronic form where the text of the description, claims and abstract is not in character coded format: | 200 Swiss francs |
| (c) in electronic form where the text of the description, claims and abstract is in character coded format: | 300 Swiss francs |

4. The international filing fee (where applicable, as reduced under item 3) and the handling fee are reduced by 75% if the international application is filed by:

- | |
|--|
| (a) an 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); or |
| (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations; |

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[Annex II follows]

ANNEX II

MODIFIED DIRECTIVES OF THE PCT ASSEMBLY RELATING TO THE
ESTABLISHMENT OF NEW EQUIVALENT AMOUNTS OF CERTAIN FEES
(to enter into force on January 1, 2004)

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

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

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

- (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(c)

may ask the Director General to 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 request is made. The Director General shall proceed accordingly, as provided in Rules 15.2(d) and 57.2(e).

(3) 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(c)

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) 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) 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%.

[Annex III follows]

ANNEX III

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on January 1, 2004)

Rule 4
The Request (Contents)

4.1 to 4.10 [No change]

4.11 *Reference to Earlier Search, Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

(i) to (iii) [No change]

(iv) the applicant intends to make an indication under Rule 49*bis*.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or indicate the relevant parent application or parent patent or other parent grant.

(b) [No change]

4.12 to 4.14 [*Remain deleted*]

4.14*bis* to 4.18 [No change]

Rule 16*bis*
Extension of Time Limits for Payment of Fees

16*bis*.1 [No change]

16*bis*.2 *Late Payment Fee*

(a) [No change]

(b) The amount of the late payment fee shall not, however, exceed the amount of 50% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

Rule 17
The Priority Document

17.1 [No change]

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a), (b) or (b-*bis*), the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(b) and (c) [No change]

Rule 32
**Extension of Effects of International Application to
Certain Successor States**

32.1 *Extension of International Application to Successor State*

(a) to (c) [No change]

(d) [*Remains deleted*]

32.2 [No change]

Rule 43bis
Written Opinion of the International Searching Authority

43bis.1 *Written Opinion*

(a) [No change]

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

(c) [No change]

Rule 44bis
International Preliminary Report on Patentability by
the International Searching Authority

44bis.1 Issuance of Report; Transmittal to the Applicant

(a) and (b) [No change]

(c) The International Bureau shall promptly transmit one copy of the report issued under paragraph (a) to the applicant.

44bis.2 to 44bis.4 [No change]

Rule 53
The Demand

53.1 [No change]

53.2 Contents

(a) The demand shall contain:

(i) to (iii) [No change]

(iv) where applicable, a statement concerning amendments.

(b) [No change]

53.3 to 53.9 [No change]

Rule 60
Certain Defects in the Demand

60.1 Defects in the Demand

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

(a-bis) and (a-ter) [No change]

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing

date, provided that the demand as submitted permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

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

(d) [Deleted]

(e) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs (a) to (c).

(f) and (g) [No change]

60.2 *[Remains deleted]*

Rule 61

Notification of the Demand and Elections

61.1 *Notification to the International Bureau and the Applicant*

(a) [No change]

(b) The International Preliminary Examining Authority shall promptly notify the applicant of the date of receipt of the demand. Where the demand has been considered under Rules 54.4, 55.2(d), 58*bis*.1(b) or 60.1(c) as if it had not been submitted, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) *[Remains deleted]*

61.2 to 61.4 [No change]

Rule 70

International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and each replacement sheet containing rectifications

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

(b) Notwithstanding paragraph (a), each superseded or reversed replacement sheet referred to in that paragraph shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c). In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

70.17 [No change]

Rule 80 **Computation of Time Limits**

80.1 to 80.4 [No change]

80.5 *Expiration on a Non-Working Day or Official Holiday*

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day:

- (i) on which such Office or organization is not open to the public for the purposes of the transaction of official business;
- (ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;
- (iii) which, where such Office or organization is situated in more than one locality, is an official holiday in at least one of the localities in which such Office or organization is situated, and in circumstances where the national law applicable by that Office or organization provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; or
- (iv) which, where such Office is the government authority of a Contracting State entrusted with the granting of patents, is an official holiday in part of that Contracting State, and in circumstances where the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day;

the period shall expire on the next subsequent day on which none of the said four circumstances exists.

80.6 and 80.7 [No change]

Rule 90
Agents and Common Representatives

90.1 [No change]

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

90.3 and 90.4 [No change]

90.5 *General Power of Attorney*

(a) and (b) [No change]

(c) Any receiving Office, any International Searching Authority and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 to the receiving Office, the International Searching Authority or the International Preliminary Examining Authority, a copy of the general power of attorney shall be submitted to that Office or Authority.

90.6 [No change]

[Annex IV follows]

ANNEX IV

AGREEMENT BETWEEN
THE NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to
the functioning of the National Board of Patents and Registration of Finland
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The National Board of Patents and Registration of Finland and the International Bureau
of the World Intellectual Property Organization,

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the National Board of Patents and Registration of Finland;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.
- (2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, that, where applicable, the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its function as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that the Authority satisfies the requirements under Rules 36.1(i) and 63.1(i).

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), 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.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the National Board of Patents and Registration of Finland gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the National Board of Patents and Registration of Finland written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [Geneva], this _____, in two originals in the English language.

For the National Board of Patents and
Registration of Finland
by:

For the International Bureau
by:

(signature)
Martti Enäjärvi
Director General
National Board of Patents and Registration
of Finland

(signature)
Kamil Idris
Director General
World Intellectual Property Organization

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States:
 - (a) Finland;
 - (b) any other Contracting State in accordance with the obligations of the Authority within the framework of the European Patent Organisation;
- (ii) the following languages:

Finnish, Swedish, English.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the national patent grant procedure under the provisions of the Finnish Patent Law.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Euro)</i>
Search fee (Rule 16.1(a))	[...]
Additional fee (Rule 40.2(a))	[...]
Preliminary examination fee (Rule 58.1(b))	[...]
Additional fee (Rule 68.3(a))	[...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	[...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from:

- (i) an earlier national search already made by the Authority on an application whose priority is claimed for the international application, [...] % of the search fee paid shall be refunded.
- (ii) an earlier international or international-type search already made by the Authority on an application whose priority is claimed for the international application, [...] % or [...] % of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Finnish, Swedish and English, depending on the language in which the international application is filed or translated.

[End of Annex IV and of document]