

WIPO



PCT/A/33/2
ORIGINAL: English
DATE: July 23, 2004

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-Third (19th Extraordinary) Session
Geneva, September 27 to October 5, 2004

PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT), based on recommendations of the Working Group on Reform of the PCT (“the Working Group”). The proposed amendments, which are set out in Annex I, relate to the following matters:

(i) simplification of the protest procedure before both the International Searching Authority and the International Preliminary Examining Authority in case of non-unity of invention; for more detailed explanation, see Annex II, paragraphs 1 to 7;

(ii) furnishing of sequence listings for the purposes of search and examination; for more detailed explanation, see Annex II, paragraphs 8 to 16;

(iii) corrigenda and consequential amendments further to the amendments adopted by the Assembly on October 1, 2002, with effect from January 1, 2004; for more detailed explanation, see Annex II, paragraphs 17 to 24.

PROPOSED AMENDMENTS

2. The proposed amendments were considered at the fifth and sixth sessions of the Working Group on Reform of the PCT (“the Working Group”), which agreed that they should be submitted to the Assembly for adoption at its present session, subject to possible further

drafting changes to be made by the Secretariat (see the summaries by the Chairs of the Working Group's fifth and sixth sessions in document PCT/R/WG/5/13, paragraphs 5 to 11, and document PCT/R/WG/6/12, paragraphs 5, 6 and 127 to 131). The Chairs' summaries are reproduced in document PCT/A/33/1, Annexes I and II. The text of the proposed amendments and explanatory notes, including mention of further drafting changes made by the Secretariat, are set out in Annexes I and II to the present document.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

3. It is proposed that the amendments set out in Annex I should enter into force on January 1, 2005; that they should, in general, apply to all international applications whose international filing date is on or after January 1, 2005; and that they should not, in general, apply to international applications whose international filing date is before January 1, 2005. However, it is proposed that certain amended Rules¹ relating to the international preliminary examination procedure should apply in cases where a demand for international preliminary examination is made on or after January 1, 2005, including those cases where the international application was filed before January 1, 2005.

4. Draft decisions that are proposed to be adopted by the Assembly in relation to entry into force and transitional arrangements are set out in Annex III.

5. The Assembly of the PCT Union is invited:

(i) to adopt the proposed amendments of the Regulations under the PCT set out in Annex I; and

(ii) to adopt the proposed decisions set out in Annex III relating to entry into force and transitional arrangements in respect of the proposed amendments.

[Annexes follow]

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws," "national applications," "the national phase," etc., include reference to regional laws, regional applications, the regional phase, etc.

PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT¹

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Rule 3
The Request (Form)

3.1 and 3.2 [No change]

3.3 *Check List*

(a) The request shall contain a list indicating:

(i) [No change]

(ii) where applicable, that the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a sequence listing in electronic ~~computer~~ ~~readable~~ form, a document relating to the payment of fees, or any other document (to be specified in the check list);

(iii) [No change]

(b) [No change]

3.4 [No change]

Rule 4
The Request (Contents)

4.1 to 4.5 [No change]

4.6 *The Inventor*

(a) Where Rule 4.1(a)(iv)~~(v)~~ or (c)(i) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them.

(b) and (c) [No change]

4.7 to 4.18 [No change]

Rule 13ter
Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Procedure Before the International Searching Authority ~~Sequence Listing for International Authorities~~

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, unless such listing in electronic form is already available to it in a form and manner acceptable to it, and to pay to it, where applicable, the late furnishing fee referred to paragraph (c), within a time limit fixed in the invitation.

~~Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:~~

~~(i) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing complying with that standard;~~

~~(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.~~

(b) ~~[Deleted]~~ Where at least part of the international application is filed on paper and the International Searching Authority finds that the description does not comply with Rule 5.2(a), it may invite the applicant to furnish, for the purposes of the international search, a sequence listing in paper form complying with the standard provided for in the Administrative Instructions, unless such listing in paper form is already available to it in a form and manner acceptable to it, whether or not the furnishing of a sequence listing in electronic form is invited under paragraph (a), and to pay, where applicable, the late furnishing fee referred to in paragraph (c), within a time limit fixed in the invitation.

(c) The furnishing of a sequence listing in response to an invitation under paragraph (a) or (b) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 25% 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, provided that a late furnishing fee may be required under either paragraph (a) or (b) but not both.

[Rule 13ter.1, continued]

~~(d)~~ ~~(e)~~ If the applicant does not ~~comply with an invitation under paragraph (a)~~ within the time limit fixed in the invitation under paragraph (a) or (b), furnish the required sequence listing and pay any required late furnishing fee, the International Searching Authority shall only ~~not~~ be required to search the international application to the extent that ~~such non-compliance has the result that~~ a meaningful search can ~~cannot~~ be carried out without the sequence listing.

~~(e)~~ ~~(f)~~ Any sequence listing not contained in the international application as filed, whether furnished in response to an invitation under paragraph (a) or (b) or otherwise, shall not, ~~subject to Article 34,~~ form part of the international application, but this paragraph shall not prevent the applicant from amending the description in relation to a sequence listing pursuant to Article 34(2)(b).

~~(f)~~ ~~(d)~~ Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to submit ~~file~~ the required correction. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

13ter.2 ~~13ter.1(e)~~ *Procedure Before the International Preliminary Examining Authority*

Rule 13ter.1 ~~Paragraphs (a) and (e)~~ shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

13ter.3 ~~13ter.2~~ *Sequence Listing for Designated Office*

~~Once the processing of the international application has started before a designated Office, Rule 13ter.1(a) shall apply *mutatis mutandis* to the procedure before that Office.~~ No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

Rule 16bis
Extension of Time Limits for Payment of Fees

16bis.1 Invitation by the Receiving Office

(a) Where, by the time they are due under Rules 14.1(c), 15.4 and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing fee and the search fee, the receiving Office shall, subject to paragraph (d), invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

(b) *[Remains deleted]*

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall, subject to paragraph (e) ~~(d)~~:

(i) and (ii) [No change]

(d) and (e) [No change]

16bis.2 [No change]

Rule 23
Transmittal of the Search Copy, Translation and Sequence Listing

23.1 *Procedure*

(a) and (b) [No change]

(c) Any sequence listing in electronic ~~computer-readable~~ form which is furnished for the purposes of Rule 13~~ter~~ but submitted to the receiving Office instead of the International Searching Authority shall be promptly transmitted by that Office to that ~~the International Searching~~ Authority.

Rule 40
Lack of Unity of Invention
(International Search)

40.1 *Invitation to Pay Additional Fees; Time Limit*

The invitation to pay additional fees provided for in Article 17(3)(a) shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~and shall~~

(ii) invite the applicant to pay the additional fees within one month from the date of the invitation, and indicate the amount of those fees to be paid; and

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(e) within one month from the date of the invitation, and indicate the amount to be paid.

40.2 *Additional Fees*

(a) The amount of the additional ~~fees~~ ~~fee~~ due for searching under Article 17(3)(a) shall be determined by the competent International Searching Authority.

(b) The additional ~~fees~~ ~~fee~~ due for searching under Article 17(3)(a) shall be payable direct to the International Searching Authority.

(c) Any applicant may pay the additional ~~fees~~ ~~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 ~~fees~~ ~~fee~~ is excessive. Such protest shall be examined by a review body constituted in the framework ~~three member board or special instance~~ of the International Searching Authority ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional ~~fees~~ ~~fee~~. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

(d) The membership of the review body referred to in paragraph (c) may include, but shall not be limited to, the ~~three member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any~~ person who made the decision which is the subject of the protest.

[Rule 40.2, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee. ~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required ~~If the protest fee is not so paid,~~ the protest shall be considered not to have been made withdrawn and the International Searching Authority shall so declare. The protest fee shall be refunded to the applicant where the review body ~~three-member board, special instance or higher authority~~ referred to in paragraph (c) finds that the protest was entirely justified.

40.3 [Deleted] *Time Limit*

~~The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant’s address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.~~

Rule 43bis
Written Opinion of the International Searching Authority

43bis.1 Written Opinion

(a) Subject to Rule 69.1(b-*bis*), the International Searching Authority shall, at the same time as it establishes the international search report [or the declaration referred to in Article 17\(2\)\(a\)](#), establish a written opinion as to:

(i) and (ii) [No change]

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) and (c) [No change]

Rule 44
Transmittal of the International Search Report, Written Opinion, Etc.

44.1 *Copies of Report or Declaration and Written Opinion*

The International Searching Authority shall, on the same day, transmit one copy of the international search report [or of the declaration referred to in Article 17\(2\)\(a\)](#), and [one copy of](#) the written opinion established under Rule 43bis.1, ~~or of the declaration referred to in Article 17(2)(a)~~, to the International Bureau and one copy to the applicant.

44.2 and 44.3 [No change]

Rule 53
The Demand

53.1 to 53.8 [No change]

53.9 *Statement Concerning Amendments*

(a) [No change]

(b) If no amendments under Article 19 have been made and the time limit for filing such amendments has not expired, the statement may indicate that, should the International Preliminary Examining Authority wish to start the international preliminary examination at the same time as the international search in accordance with Rule 69.1(b), the applicant wishes the start of the international preliminary examination to be postponed in accordance with Rule 69.1(d).

(c) [No change]

Rule 68
Lack of Unity of Invention
(International Preliminary Examination)

68.1 [No change]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, the invitation ~~it~~ shall:

(i) specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement; ~~, and shall~~

(ii) specify ~~the amount of the additional fees and~~ the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~-It shall, at the same time,~~

(iii) invite the applicant to comply with the invitation within one month from the date of the invitation; ~~fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation~~

(iv) indicate the amount of the required additional fees to be paid in case the applicant so chooses; and

(v) invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within one month from the date of the invitation, and indicate the amount to be paid.

68.3 *Additional Fees*

(a) The amount of the additional fees ~~fee~~ due for international preliminary examination under Article 34(3)(a) shall be determined by the competent International Preliminary Examining Authority.

(b) The additional fees ~~fee~~ due for international preliminary examination under Article 34(3)(a) shall be payable direct to the International Preliminary Examining Authority.

[Rule 68.3, continued]

(c) Any applicant may pay the additional ~~fees~~ ~~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 ~~fees~~ ~~fee~~ is excessive. Such protest shall be examined by a review body constituted in the framework ~~three-member board or special instance~~ of the International Preliminary Examining Authority, ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional ~~fees~~ ~~fee~~. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.

(d) The membership of the review body referred to in paragraph (c) may include, but shall not be limited to, the ~~three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any~~ person who made the decision which is the subject of the protest.

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a protest fee. ~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 68.2(v), paid any required ~~If the~~ protest fee ~~is not so paid~~, the protest shall be considered not to have been made ~~withdrawn and the International Preliminary Examining Authority shall so declare~~. The protest fee shall be refunded to the applicant where the review body ~~three-member board, special instance or higher authority~~ referred to in paragraph (c) finds that the protest was entirely justified.

68.4 and 68.5 [No change]

Rule 69
Start of and Time Limit for International Preliminary Examination

69.1 *Start of International Preliminary Examination*

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:

- (i) and (ii) [No change]
- (iii) either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established. and the written opinion established under Rule 43*bis*.1 ~~or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established;~~

provided that the International Preliminary Examining Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54*bis*.1(a) unless the applicant expressly requests an earlier start.

(b) and (c) [No change]

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:

- (i) and (ii) [No change]
 - (iii) the expiration of the applicable time limit under Rule 46.1 ~~Rule 54*bis*.1(a).~~
- (e) [No change]

69.2 [No change]

Rule 76

**~~Copy, Translation and Fee Under Article 39(1);~~ Translation of Priority Document;
Application of Certain Rules to Procedures Before Elected Offices**

76.1, 76.2 and 76.3 [*Remain deleted*]

76.4 [No change]

76.5 Application of Certain Rules to Procedures Before Elected Offices ~~22.1(g), 47.1, 49, 49bis and 51bis~~

Rules 13ter.3, 22.1(g), 47.1, 49, 49bis and 51bis shall apply, provided that:

(i) to (v) [No change]

[Annex II follows]

ANNEX II

EXPLANATORY NOTES

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

1. Proposed amendments of Rules 40.1, 40.2, 40.3, 68.2 and 68.3 are set out in Annex I. Details of the prior consideration by the Working Group of the proposed amendments to the Regulations related to the simplified protest procedure in case of non-unity of invention are set out in documents PCT/R/WG/3/5 (paragraphs 95 to 97), PCT/R/WG/4/14 (paragraph 104(ii)) and PCT/R/WG/5/13 (paragraphs 5 to 11).

Lack of Unity (International Search)

2. It is proposed to amend Rule 40.1 and to delete Rule 40.3 so as to deal with all matters to be included in the invitation to the applicant (reasons, time limit for payment of additional fees and amount of those fees; where applicable, time limit for payment of protest fee and amount of that fee) in just one Rule.

3. It is proposed to amend Rule 40.2(c), (d) and (e) so as to simplify the procedure and to leave the form of the review body and its composition to the International Searching Authority; in this context, it does not appear necessary to oblige an International Searching Authority which wishes to require the payment of a protest fee for the examination of the protest to apply a two stage review process.

Lack of Unity (International Preliminary Examination)

4. The amendments proposed to Rule 68.2 correspond to those proposed to Rule 40.1.

5. The amendments proposed to Rule 68.3 correspond to those proposed to Rule 40.2.

6. Although not considered by the Working Group, it is also proposed to further amend Rule 68.3(e) as proposed to be amended by the Working Group at its fifth session (see documents PCT/R/WG/5/1 (Annex II) and PCT/R/WG/5/13 (paragraphs 5 to 11)) so as to replace the erroneous reference to Rule 68.2(iii) with a reference to Rule 68.2(v).

Terminology

7. Although not considered by the Working Group, it is proposed to amend Rule 40.2(a), (b) and (c), and Rule 68.3(a), (b) and (c) so as to align the wording “additional fee” with that used in Article 17(3)(a) and elsewhere in the Regulations and to use, throughout the Regulations, the wording “additional fees” instead.

FURNISHING OF SEQUENCE LISTINGS FOR SEARCH AND EXAMINATION

8. Proposed amendments of Rules 3.3, 13^{ter}, 23.1 and 76.5 are set out in Annex I. Details of the prior consideration by the Working Group of the proposed amendments to the Regulations related to the furnishing of sequence listings for search and examination are set out in documents PCT/R/WG/3/5 (paragraphs 53 to 57), PCT/R/WG/4/14 (paragraphs 97 to 102), PCT/R/WG/5/13 (paragraphs 63 to 73) and PCT/R/WG/6/12 (paragraphs 127 to 131).

Terminology

9. It is proposed to amend the Regulations (Rules 3.3, 13*ter* and Rule 23.1) so as to align the wording “computer readable form” with that used in Part 7 of the Administrative Instructions and to use, throughout the Regulations, the wording “electronic form” instead.

Invitation to Furnish, for the Purposes of International Search, a Sequence Listing in Electronic Form

10. It is proposed to amend Rule 13*ter*.1(a) so as to clarify the cases in which the International Searching Authority would be entitled to invite the applicant to furnish, for the purposes of international search, a sequence listing in *electronic* form complying with the standard provided for in the Administrative Instructions.

Invitation to Furnish, for the Purposes of International Search, a Sequence Listing in Paper Form

11. It is proposed to amend Rule 13*ter*.1(b) so as to clarify the cases in which the International Searching Authority would be entitled to invite the applicant to furnish, for the purposes of international search, a sequence listing in *paper* form, whether or not the furnishing of a sequence listing in electronic form is invited under Rule 13*ter*.1(a).

Late Furnishing Fee

12. It is proposed to amend Rule 13*ter*.1(c) so as to enable the International Searching Authority to require a late furnishing fee where it needed to invite the applicant to furnish, for the purposes of international search, a copy of the sequence listing complying with the relevant standard, whether the listing was in electronic form or, in rare cases, in paper form. It is further proposed to fix the maximum amount of that late furnishing fee at 25% 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, provided that a late furnishing fee may be required under either Rule 13*ter*.1(a) or Rule 13*ter*.1(b) but not both.

International Search where the Required Sequence Listing is not Furnished and/or where the Required Late Furnishing Fee is not Paid

13. It is proposed to amend Rule 13*ter*.1(d) so as to clarify that, where the applicant does not pay any required late furnishing fee, the International Searching Authority would not be required to carry out international search, even if the applicant has furnished the required sequence listing. In approving this proposed amendment, the Working Group concluded that, if a sequence listing and any required late furnishing fee were received after the time limit fixed in the invitation but before the International Searching Authority had declared that a meaningful search could not be carried out, the [wording of Rule 13*ter*.1(d) as proposed to be amended] provided sufficient flexibility to allow the search to be carried out anyway (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 69).

Procedure Before the International Preliminary Examining Authorities

14. The proposed amendments to present Rule 13ter.1(e) (proposed new Rule 13ter.2) are consequential on the proposed amendments to Rule 13ter.1.

Sequence Listings for Designated Offices

15. The proposal to delete the first sentence of present Rule 13ter.2 (proposed new Rule 13ter.3) is consequential on the proposed amendments to Rule 13ter.1(a). Furthermore, it is proposed to leave the procedure with regard to sequence listings before designated Offices to the applicable national law of the designated Office concerned, except that no such Office would be permitted to require the applicant to furnish a sequence listing (be it in paper form or in electronic form) other than a listing complying with the standard provided for in the Administrative Instructions.

Application of Certain Rules to Procedures Before Elected Offices

16. It is proposed to amend the title of Rule 76 so as to clarify and simplify the wording and to amend Rule 76.5 so as to ensure that proposed new Rule 13ter.3 is also applied in respect of elected Offices.

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

17. Proposed amendments of Rules 4.6, 16bis.1, 43bis.1, 44.1 and 69.1 are set out in Annex I. Details of the prior consideration by the Working Group of the proposed amendments to the Regulations are set out in documents PCT/R/WG/5/13 (paragraphs 12 to 14) and PCT/R/WG/6/12 (paragraphs 5 and 6).

Indications in the Request Concerning the Inventor

18. It is proposed to amend Rule 4.6(a), as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004, so as to replace the erroneous reference to Rule 4.1(a)(v) with a reference to Rule 4.1(a)(iv).

Extension of Time Limits for Payment of Fees

19. It is proposed to amend Rule 16bis.1(a) so as to clarify that the sending of an invitation by the receiving Office under paragraph (a) is subject to paragraph (d), and that thus any payment received by the receiving Office before that Office sends the invitation under paragraph (a) would be considered to have been received in time, and the receiving Office should not send any invitation under paragraph (a). Furthermore, it is proposed to amend Rule 16bis.1(c) so as to clarify that the making of a declaration under Article 14(3) that the application is considered withdrawn is subject to paragraph (e), and thus that any payment received by the receiving Office before that Office makes that declaration would be considered to have been received in time, and the receiving Office should not make any Article 14(3) declaration under paragraph (c).

Written Opinion of the International Searching Authority

20. It is proposed to amend Rules 43bis.1(a), 44.1 and 69.1(a)(iii) so as to clarify that a written opinion under Rule 43bis.1 is to be established by the International Searching

Authority even in the case that no international search report is established in accordance with Article 17(2)(a). Since there has been no international search, the scope of the report will necessarily be very limited. Usually, the only substantive content will be an explanation under Rules 43*bis*.1(b) and 66.2(a)(i) or (vi) as to why no opinion is given on the questions of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable. This procedure is already envisaged in the PCT International Search and Preliminary Examination Guidelines (see paragraph 9.40 of document PCT/GL/ISPE/1). It is also equivalent to the procedure which has long existed under Chapter II where, if any of the situations referred to in Article 34(4) exists or if no international search report has been established, a similarly limited written opinion or international preliminary examination report is established (see Box No. III of Forms PCT/IPEA/408 and 409 and paragraph 17.29 of document PCT/GL/ISPE/1).

Statement Concerning Amendments

21. Under Rules 53.9(b), 54*bis*.1(a) and 69.1(d) as in force as from January 1, 2004, the time limit for making amendments under Article 19 always (with one exception, mentioned further below) expires before the expiration of the time limit under Rule 69.1(a) for the start of the international preliminary examination. The time limit for making such amendments is *two* months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later (see Rule 46.1), whereas the time limit for the start of the international preliminary examination is *three* months from the date of transmittal to the applicant of the international search report and the written opinion by the International Searching Authority or of the declaration referred to in Article 17(2)(a), or 22 months from the priority date, whichever time limit expires later (see Rule 69.1). Therefore, in the ordinary course of events, there is no need (and, indeed, no possibility) for the applicant to request postponement of the start of the international preliminary examination under Rule 53.9(b).

22. The only exceptional case is that where the applicant submits the demand and pays the preliminary examination fee prior to the start of the international search (for example, at the same time as the filing of the international application itself) and where the International Preliminary Examining Authority (being the same Authority which acts as the International Searching Authority) wishes to start the international preliminary examination at the same time as the international search, as contemplated by Rule 69.1(b).

23. It could thus be argued that, in such an exceptional case as outlined in paragraph 22, above, the applicant, by requesting international preliminary examination at such an early stage, could be taken to have forsaken the possibility of also requesting a postponement of the international preliminary examination under Rule 53.9(b), and that thus Rules 53.9(b) and 69.1(d) should be deleted. This, however, would deprive the applicant of his right to have the international preliminary examination carried out on the basis of the claims as amended under Article 19.

24. It is thus proposed to amend Rules 53.9(b) and 69.1(d) so as to limit the request for postponement to the exceptional case that the International Preliminary Examining Authority wishes to start international preliminary examination at the same time as the international search.

[Annex III follows]

ANNEX III

PROPOSED DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

It is proposed that the Assembly adopt the following decisions in relation to entry into force and transitional arrangements of the proposed amendments set out in Annex I:

“The amendments set out in Annex I:

“(a) shall enter into force on January 1, 2005, and shall apply to any international application whose international filing date is on or after January 1, 2005;

“(b) shall not apply to any international application whose international filing date is before January 1, 2005, provided that amended Rules 13*ter*.2, 53.9, 68.2, 68.3 and 69.1 shall apply in relation to any international application in respect of which a demand for international preliminary examination is made on or after January 1, 2005, whether the international application is filed before, on or after January 1, 2005.”

[End of Annex III and of document]