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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

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

**ASSEMBLY**

**Thirty-Fifth (20<sup>th</sup> Extraordinary) Session**  
**Geneva, September 25 to October 3, 2006**

**FURTHER PROPOSED AMENDMENTS OF THE PCT REGULATIONS;  
PROPOSED AMENDMENTS OF THE SCHEDULE OF FEES  
ANNEXED TO THE PCT REGULATIONS**

*Document prepared by the International Bureau*

## SUMMARY

1. This document, which is an addendum to document PCT/A/35/2, contains further proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT)<sup>1</sup> and of the Schedule of Fees annexed to those Regulations, and proposals for modifications of the Administrative Instructions under the PCT. The proposals relate to the following matters:

(a) revised wording of Rule 20.8(a-*bis*) as proposed in document PCT/A/35/2 (clarifications and consequential amendments);

(b) amendment of item 3 of the Schedule of Fees and modification of Section 707(b) of the Administrative Instructions, concerning reductions in the international filing fee for international applications filed in electronic form.

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<sup>1</sup> 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.

## FURTHER AMENDMENT OF RULE 20.8(a-bis)

2. In document PCT/A/35/2, it is proposed to amend Rule 20.8 by adding new paragraph (a-bis) so as to clarify the procedure to be followed by a receiving Office which has notified the International Bureau of the incompatibility of any of the Rules referred to in paragraph (a) of that Rule with the national law applied by that Office. Upon further consideration, it is proposed to revise the wording of paragraph (a-bis) by adding a second sentence to clarify that, where a missing part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of Rule 20.8(a) and the receiving Office proceeds, in accordance with Rule 20.8(a-bis), under Rule 20.8(c) and corrects the international filing date to a later date, the applicant may proceed under Rule 20.8(e), that is, request the receiving Office that the missing part concerned be disregarded.

3. The proposed revised wording of Rule 20.8(a-bis) is contained in Annex I to this document and supersedes that set out in document PCT/A/35/2, Annex I.

## FEE REDUCTION WHERE INTERNATIONAL APPLICATION IS FILED IN ELECTRONIC FORM

4. The present wording of item 3 of the Schedule of Fees concerning reductions in the international filing fee for international applications filed in electronic form implicitly requires that, in order to qualify for at least some fee reduction, the request be in character coded format while the description, claims, drawings and abstract may be in a non-character coded format, for example, an image based format such as PDF (portable document format).

5. Noting that some receiving Offices wish to accept international applications filed in electronic form where the entire application, including the request, is in a non-character coded format, it is now proposed to amend the Schedule of Fees so as to provide for a fee reduction in such cases. Proposed amendments of item 3 of the Schedule of Fees are set out in Annex II. Noting that greater efficiency in terms of data entry, optical character recognition, storage, handling and searching possibilities is achieved where the request is in character coded format, it is proposed to fix the new fee reduction at 100 Swiss francs in respect of international applications where the request is not in character coded format (see item 3(b)), compared with 200 Swiss francs where the request is in character coded format (item 3(c)) and 300 Swiss francs where all of the request, description, claims and abstract are in character coded format (item 3(d)). The present fee reduction of 100 Swiss francs for filings on paper accompanied by a PCT-SAFE CD or diskette is retained (see item 3(a)).

6. Consequential on the proposed amendments of the Schedule of Fees, it is also proposed to modify Section 707(b) of the Administrative Instructions so as to align it to the new wording of item 3 of the Schedule of Fees. Furthermore, in this context, it is proposed to clarify that item 3(b), (c) and (d) of the Schedule of Fees applies to reduce the international filing fee in respect of an international application filed in electronic form with a receiving Office which, in accordance with Section 703(d) of the Administrative Instructions, has decided to receive such an application although it has not formally notified the International Bureau under Section 710(a) that it is prepared to receive international applications in electronic form.

7. Proposed modifications of Section 707(b) of the Administrative Instructions are set out in Annex III. They are included in this document for the purposes of consultation under Rule 89.2(b).

## ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

8. As to the entry into force of amended Rule 20.8 and transitional arrangements, reference is made to the proposed decisions contained in Annex II of document PCT/A/35/2 concerning entry into force and transitional arrangements in respect of the proposed amendments of the Regulations set out in Annex I of document PCT/A/35/2. It is proposed that those decisions also apply in respect of Rule 20.8(a-*bis*) as proposed to be further amended in this document.

9. As to the entry into force of the amended Schedule of Fees and transitional arrangements, noting that it is expected that certain receiving Offices will soon (possibly as early as mid-October of this year) accept the filing of international application in electronic form where the entire application is in an image based format (PDF), it is proposed that the amendments of the Schedule of Fees set out in Annex II:

(a) shall enter into force on October 12, 2006, and shall apply to any international application whose international filing date is on or after October 12, 2006, provided that the Schedule of Fees as worded before its amendment shall continue to apply to any international application which is received by the receiving Office before October 12, 2006, and is accorded an international filing date that is on or after October 12, 2006;

(b) shall not apply to any international application whose international filing date is before October 12, 2006.

*10. 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 to this document and to decide that those amendments shall enter into force as set out in Annex II to document PCT/A/35/2, with the transitional arrangements set out in that Annex;*

*(ii) to adopt the proposed amendments of the Schedule of Fees annexed to the Regulations under the PCT set out in Annex II to this document and to decide that those amendments shall enter into force on October 12, 2006, with the transitional arrangements set out in paragraph 9, above;*

*(iii) to note that the Director General intends to promulgate modifications of the Administrative Instructions based on Annex III to this document, taking into account consultations pursuant to Rule 89.2(b) during the Assembly's session and subsequently, with effect from October 12, 2006.*

[Annexes follow]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS<sup>1</sup>

**Rule 20**  
**International Filing Date**

20.1 to 20.7 [No change]

20.8 *Incompatibility with National Laws*

(a) [No change as compared to document PCT/A/35/2, Annex I]

(a-bis) Where a missing element or part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be. Where the receiving Office proceeds as provided for in Rule 20.5(c), the applicant may proceed as provided for in Rule 20.5(e).<sup>2</sup>

(b) and (c) [No change as compared to document PCT/A/35/2, Annex I]

[Annex II follows]

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

<sup>2</sup> The first sentence is as proposed in document PCT/A/35/2. The second sentence is new.

## ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS<sup>1</sup>SCHEDULE OF FEES<sup>2</sup>*(as proposed to be amended with effect from October 12, 2006)*

<b>Fees</b>	<b>Amounts</b>
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, ~~as in accordance with and to the extent~~ provided for in the Administrative Instructions, filed:

- |  |                         |
|--|-------------------------|
| (a) on paper together with a copy <del>thereof</del> in electronic form, <u>in character coded format, of the request and the abstract:</u>  | 100 Swiss francs        |
| (b) <u>in electronic form, the request not being in character coded format:</u>  | <u>100 Swiss francs</u> |
| <del>(c)</del> (b) in electronic form, <u>the request being</u> <del>where the text of the description, claims and abstract is not</del> in character coded format:                | 200 Swiss francs        |
| <del>(d)</del> (e) in electronic form, <u>the request,</u> <del>where the text of the description, claims and abstract</del> <u>being</u> <del>is</del> 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 III follows]

<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

<sup>2</sup> The text of items 1, 2 and 4 of the Schedule of Fees is not proposed to be changed but is included for convenient reference.

ANNEX III

PROPOSED MODIFICATIONS OF  
THE PCT ADMINISTRATIVE INSTRUCTIONS

**Section 707**  
**Calculation of International Filing Fee and Fee Reduction**

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

(b) Item 3(b), ~~and~~ (c) and (d) of the Schedule of Fees annexed to the Regulations shall apply to reduce the fees payable in respect of an international application filed in electronic form with a receiving Office which has notified the International Bureau under Section 710(a) that it is prepared to receive international applications in electronic form or which has decided to receive such an application in accordance with Section 703(d).

[End of Annex III and of document]