

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Eighth (28th Extraordinary) Session Geneva, October 3 to 11, 2016

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT)¹, as agreed by the PCT Working Group (“the Working Group”) with a view to their submission to the Assembly for consideration at its current session.

PROPOSED AMENDMENTS

2. Annex I sets out proposed amendments to the Regulations under the Patent Cooperation Treaty, as agreed by the Working Group at its ninth session, held in Geneva from May 17 to 20, 2016, with a view to their submission to the Assembly for consideration at its current session. These amendments relate to the following matters:

- (a) extension of the time limit for requesting supplementary international search from 19 to 22 months from the priority date (proposed amendment of Rule 45*bis*.1(a)); for further information, see document PCT/WG/9/6 and paragraphs 117 to 123 of document PCT/WG/9/27.

¹ References in this document to “Articles” and “Rules” are to those of the 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 references to regional laws, regional applications, the regional phase, etc.

(b) clarification of the relationship between, on the one hand, Rule 23*bis*.2(a) and, on the other hand, Article 30(2) as applicable by virtue of Article 30(3) in relation to the transmittal by the receiving Office of earlier search and/or classification results to the International Searching Authority (proposed amendments of Rule 23*bis*.2); for further information, see document PCT/WG/9/5 and paragraphs 135 to 138 of document PCT/WG/9/27.

(c) deletion of “incompatibility provisions” following the withdrawal of the remaining notifications of incompatibility under those provisions (proposed amendments of Rules 4.10 and 51*bis*.1); for further information, see document PCT/WG/9/12 and paragraphs 139 and 140 of document PCT/WG/9/27.

3. Annex II contains a “clean” text of the relevant Rules as they would stand after amendment.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

4. With regard to the entry into force of the proposed amendment of Rule 45*bis*.1(a), it is proposed that the amendment of Rule 45*bis*.1(a) should enter into force on July 1, 2017, and should apply to any international application, irrespective of its international filing date, in relation to which the time limit for filing a request for supplementary international search under Rule 45*bis*.1(a) as in force until June 30, 2017, has not yet expired on July 1, 2017.

5. The amendments to add Rule 23*bis* to the Regulations were adopted by the Assembly at its forty-seventh session, held from October 5 to 14, 2015. The Assembly decided that new Rule 23*bis* should enter into force on July 1, 2017, and should apply to any international application whose international filing date is on or after July 1, 2017 (see paragraph 20 of the report of that session, document PCT/A/47/9). It is proposed that the same entry into force provision should apply to these additional proposed amendments of Rule 23*bis*.2. This will ensure that the version of Rule 23*bis* to enter into force on July 1, 2017, will be the amended version as proposed in Annex I to this document.

6. As regards the deletion of the incompatibility provisions contained in Rules 4.10 and 51*bis*.1, it is proposed that these amendments should enter into force on July 1, 2017, along with the other amendments proposed in Annex I to this document.

7. It is therefore proposed that the Assembly adopt the following decisions concerning entry into force and transitional arrangements of the proposed amendments of the Regulations set out in Annex I to this document:

“The amendment of Rule 45*bis*.1(a) shall enter into force on July 1, 2017, and shall apply to any international application, irrespective of its international filing date, in respect of which the time limit for filing a request for supplementary international search under Rule 45*bis*.1(a) as in force until June 30, 2017, has not yet expired on July 1, 2017.”

“The amendments of Rule 23*bis*.2 shall enter into force on July 1, 2017, and shall apply to any international application whose international filing date is on or after July 1, 2017.”

“The amendments of Rules 4.10 and 51*bis*.1 shall enter into force on July 1, 2017.”

8. *The Assembly of the PCT Union is invited to adopt the proposed amendments to the Regulations under the PCT set out in Annex I to document PCT/A/48/3, and the proposed decisions set out in paragraph 7 of document PCT/A/48/3 relating to entry into force and transitional arrangements.*

[Annexes follow]

DRAFT AMENDMENTS TO THE PCT REGULATIONS²

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. A “clean” copy of the proposed amended provisions (without underline or strikethrough) appears in Annex II.

Rule 4

The Request (Contents)

4.1 to 4.9 *[No change]*

4.10 *Priority Claim*

(a) to (c) *[No change]*

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

4.11 to 4.19 *[No change]*

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 *[No change]*

23bis.2 *Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2*

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to [Article 30\(2\)\(a\) as applicable by virtue of Article 30\(3\) and](#) paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may, [subject to Article 30\(2\)\(a\) as applicable by virtue of Article 30\(3\),](#) also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

(b) to (e) *[No change]*

Rule 45bis

Supplementary International Searches

45bis.1 Supplementary Search Request

(a) The applicant may, at any time prior to the expiration of ~~49~~ 22 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45bis.9. Such requests may be made in respect of more than one such Authority.

(b) to (e) *[No change]*

45bis.2 to 9 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) to (d) *[No change]*

(e) *[No change]* The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required:

(i) where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable; or

(ii) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii) or 20.5(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, for the purposes of determining under Rule 82ter.1(b) whether that element or part is completely contained in the priority document concerned, in which case the national law applicable by the designated Office may also require the applicant to furnish, in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the translation of the priority document.

~~(f) If, on March 17, 2000, the proviso in paragraph (e) is not compatible with the national law applied by the designated Office, that proviso shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.~~

[Rule 51bis, continued]

51bis.2 and 51bis.3 *[No change]*

[Annex II follows]

DRAFT AMENDMENTS TO THE PCT REGULATIONS

(CLEAN TEXT)

Proposed amendments of the PCT Regulations are set out in Annex I, in which additions and deletions are shown, respectively, by underlining and striking through of the text concerned. This Annex contains, for convenient reference, a “clean” text of the relevant provisions as they would stand after amendment.

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Rule 4

The Request (Contents)

4.1 to 4.9 *[No change]*

4.10 *Priority Claim*

(a) to (c) *[No change]*

(d) *[Deleted]*

4.11 to 4.19 *[No change]*

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 *[No change]*

23bis.2 *Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2*

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to Article 30(2)(a) as applicable by virtue of Article 30(3) and paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may, subject to Article 30(2)(a) as applicable by virtue of Article 30(3), also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

(b) to (e) *[No change]*

Rule 45bis

Supplementary International Searches

45bis.1 Supplementary Search Request

(a) The applicant may, at any time prior to the expiration of 22 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45bis.9. Such requests may be made in respect of more than one such Authority.

(b) to (e) *[No change]*

45bis.2 to 9 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) to (e) *[No change]*

(f) *[Deleted]*

51bis.2 and 51bis.3 [No change]

[End of Annex II and of document]