

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Ninth (21st Ordinary) Session
Geneva, October 2 to 11, 2017

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, and an Understanding by the Assembly, 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 tenth session, held in Geneva from May 8 to 12, 2017, with a view to their submission to the Assembly for consideration at its current session. These amendments relate to the following matters:

- (a) correction of references in Rules 4.1(b)(ii) and 41.2(b) to properly reflect changes in numbering, consequential to the amendments to Rules 12*bis* and 23*bis* adopted by the Assembly at its forty-seventh (held in October 2015) and forty-eighth sessions (held in October 2016), respectively.

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) amendment to the Schedule of Fees to make clear that the 90 per cent fee reductions in item 5 are intended only for persons filing an international application in their own right and not those filing an international application on behalf of a person or entity which is not eligible for the reduction, such as a director or employee of a company filing an international application on behalf of a company in order to obtain the reduction in item 5(a).

3. With regard to the latter issue, the Working Group recommended that, in addition to the amendment to the Schedule of Fees, the PCT Assembly adopt the following Understanding:

“It is the understanding of the PCT Assembly that the fee reduction in item 5 of the Schedule of Fees is intended to apply only in the case where the applicants indicated in the request are the sole and true owners of the application and under no obligation to assign, grant, convey or license the rights in the invention to another party which is not eligible for the fee reduction.”

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

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

5. It is proposed that the proposed amendments should enter into force on July 1, 2018, and should apply to any international application the international filing date of which is on or after that date. Noting that the amendment to the Schedule of Fees is intended as a clarification of the original intent of the fee reduction rather than a substantive change, it is proposed that the Understanding be adopted with effect from the closing of the Assembly on October 11, 2017.

6. It is therefore proposed that the Assembly adopt the following decision 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 Rules 4.1(b)(ii) and 41.2(b) and of the Schedule of Fees shall enter into force on July 1, 2018, and shall apply to any international application the international filing date of which is on or after that date.”

7. *The Assembly of the PCT Union is invited:*

(i) to adopt the proposed amendments to the Regulations under the PCT set out in Annex I to document PCT/A/49/4, and the proposed decision set out in paragraph 6 of document PCT/A/49/4 relating to entry into force and transitional arrangements; and

(ii) to adopt the Understanding set out in paragraph 3 of document PCT/A/49/4 with effect from October 11, 2017.

[Annexes follow]

PROPOSED 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 underlining or striking through) appears in Annex II.

Rule 4
The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) [No change]

(b) The request shall, where applicable, contain:

(i) a priority claim, or

(ii) indications relating to an earlier search as provided in Rules 4.12(i) and 12bis.1 ~~(e)~~(b) and ~~(f)~~(d),

(iii) a reference to a parent application or parent patent,

(iv) an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) [No change]

4.2 to 4.19 [No change]

Rule 41

Taking into Account Results of Earlier Search and Classification

41.1 *[No change]*

41.2 *Taking into Account Results of Earlier Search and Classification in Other Cases*

(a) *[No change]*

(b) Where the receiving Office has transmitted to the International Searching Authority a copy of the results of any earlier search or of any earlier classification under Rule 23bis.2(a) or ~~(b)~~(c), or where such a copy is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, the International Searching Authority may take those results into account in carrying out the international search.

SCHEDULE OF FEES

Fees

1. to 3. [No change]

Amounts

Reductions

4. [No change]

5. The international filing fee under item 1 (where applicable, as reduced under item 4), the supplementary search handling fee under item 2 and the handling fee under item 3 are reduced by 90% if the international application is filed by:

- (a) [No change] an applicant who is a natural person and who is a national of and resides in a State that is listed as being a State whose per capita gross domestic product is below US\$ 25,000 (according to the most recent 10-year average per capita gross domestic product figures at constant 2005 US\$ values published by the United Nations), and whose nationals and residents who are natural persons have filed less than 10 international applications per year (per million population) or less than 50 international applications per year (in absolute numbers) according to the most recent five-year average yearly filing figures published by the International Bureau; or
- (b) [No change] an applicant, whether a natural person or not, who is a national of and resides in a State that is listed as being classified by the United Nations as a least developed country;

provided that, [at the time of filing of the international application, there are no beneficial owners of the international application who would not satisfy the criteria in sub-item \(a\) or \(b\) and provided that](#), if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b). The lists of States referred to in sub-items (a) and (b)³ shall be updated by the Director General at least every five years according to directives given by the Assembly. The criteria set out in sub-items (a) and (b) shall be reviewed by the Assembly at least every five years.

[Annex II follows]

³ *Editor's Note:* The first lists of States were published in the Gazette of February 12, 2015, page 32 (see www.wipo.int/pct/en/official_notices/index.html).

PROPOSED 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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4.1 <i>Mandatory and Optional Contents; Signature</i>	2
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Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) [No change]

(b) The request shall, where applicable, contain:

(i) a priority claim, or

(ii) indications relating to an earlier search as provided in Rules 4.12(i) and 12bis.1(b)

and (d),

(iii) a reference to a parent application or parent patent,

(iv) an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) [No change]

4.2 to 4.19 [No change]

Rule 41

Taking into Account Results of Earlier Search and Classification

41.1 *[No change]*

41.2 *Taking into Account Results of Earlier Search and Classification in Other Cases*

(a) *[No change]*

(b) Where the receiving Office has transmitted to the International Searching Authority a copy of the results of any earlier search or of any earlier classification under Rule 23bis.2(a) or (c), or where such a copy is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, the International Searching Authority may take those results into account in carrying out the international search.

SCHEDULE OF FEES

Fees

Amounts

1. to 3. [No change]

Reductions

4. [No change]

5. The international filing fee under item 1 (where applicable, as reduced under item 4), the supplementary search handling fee under item 2 and the handling fee under item 3 are reduced by 90% if the international application is filed by:

- (a) [No change] an applicant who is a natural person and who is a national of and resides in a State that is listed as being a State whose per capita gross domestic product is below US\$ 25,000 (according to the most recent 10-year average per capita gross domestic product figures at constant 2005 US\$ values published by the United Nations), and whose nationals and residents who are natural persons have filed less than 10 international applications per year (per million population) or less than 50 international applications per year (in absolute numbers) according to the most recent five-year average yearly filing figures published by the International Bureau; or
- (b) [No change] an applicant, whether a natural person or not, who is a national of and resides in a State that is listed as being classified by the United Nations as a least developed country;

provided that, at the time of filing of the international application, there are no beneficial owners of the international application who would not satisfy the criteria in sub-item (a) or (b) and provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b). The lists of States referred to in sub-items (a) and (b)⁴ shall be updated by the Director General at least every five years according to directives given by the Assembly. The criteria set out in sub-items (a) and (b) shall be reviewed by the Assembly at least every five years.

[End of Annex II and of document]

⁴ *Editor's Note:* The first lists of States were published in the Gazette of February 12, 2015, page 32 (see www.wipo.int/pct/en/official_notices/index.html).