

WIPO



PCT/A/III/2

ORIGINAL: English

DATE: March 9, 1979

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Third Session (2nd Extraordinary)* Geneva, April 25 to May 1, 1979

AMENDMENTS TO THE REGULATIONS UNDER THE PATENT COOPERATION TREATY (PCT) RELATING TO FEES

Memorandum by the International Bureau

1. When the amounts of the international fee (Rule 15) and the handling fee (Rule 57) were fixed by the Assembly, in its first session (April 1978), "it was agreed that the amounts of the fees fixed in the Regulations in US dollars and Swiss francs are to be considered only as a basis on which the amount of the fees in the various national currencies (other than US dollars and Swiss francs) are fixed by the Director General after consultation with the country of each currency. Such agreement is based on an interpretation of Rule 15.3(b) and similar provisions of the Regulations which vest the right of expressing fees in national currencies in the receiving Offices. The said amounts are the rounded up or rounded down equivalents of the amounts indicated in the Regulations. The Director General was asked to propose to the next session of the Assembly a revision of the relevant provisions of the Regulations so that they spell out this interpretation" (PCT/A/I/14, paragraph 98).
2. It was noted in the proposals presented to the second session (1st Ordinary) of the Assembly, that in order to enable the receiving Offices to avoid any responsibility in connection with the search fee which each of them will generally collect in its own currency but whose original amount is established by each International Searching Authority in a

* *Editor's Note:* This document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

currency of its own choice analogous changes seem to be required in Rule 16.1(b) (PCT/A/II/2, paragraph 2).

3. At the said second session, the Assembly discussed the said proposals but, due to the limited time available and certain proposals for changes made by Delegations, did not adopt amendments, other than to change the amounts of the fees as expressed in Swiss francs and to clarify the application of Rule 15.1(ii) in the case of “double designations” of States, and invited the International Bureau to prepare revised drafts (PCT/A/II/5, paragraphs 19 to 26).

4. The Annex to this document contains the said revised drafts, relating to Rules 15.1, 15.2, 15.3, 16.1(b) and 57, and further proposals relating to Rules 15.1 (ii), 15.4 and 15.5.

5. The said revised drafts attempt to respond, in particular:

to the wishes of certain of the said Delegations that the amount of fees, if not specified by the applicable Rules, should be included in an annex forming an integral part of the Regulations (PCT/A/II/5, paragraphs 12 and 17): by the proposed new Rule 2bis and the proposed new Fees Schedule;

to the wishes expressed by certain of the said Delegations that the amount of fees fixed in currencies not used in the Regulations be subject to review not only upon the occurrence of a 10% (ten percent) variation from the applicable exchange rate but also periodically to take into account smaller variations in the exchange rate applied when the amounts were fixed (PCT/A/II/5, paragraphs 13 and 17): by provisions for a periodic review in the event of a 3% (three percent) change where a rate has been in force for two years, in Rules 15.2(b), 16.1(b) and 57.2(b);

to the wishes expressed by certain of the Delegations that new amounts should take effect only after a longer period than 15 days after publication of the new amounts in the PCT Gazette (PCT/A/II/5, paragraphs 14, 15 and 17): by provisions in Rules 15.2 (b) and 57.2 (b) for the application of new amounts two months after their publication in the PCT Gazette subject to the possibility of shorter periods being fixed by agreement with the interested Offices;

to the wish expressed by the Assembly, having regard to a statement by the representative of the European Patent Organization that the possibility that the International Searching Authority might fix the amount of the search fee in several currencies be taken into account (PCT/A/II/5, paragraph 19): by appropriate provision in Rule 16.2{b) to take this possibility into account.

6. The other proposals of the International Bureau relate:

to Rule 15.1(ii): a simpler, clearer wording of that Rule permitting double designation of the same State for the purposes of a national and a regional patent;

to Rule 15.4: to permit those receiving Offices which are accustomed to allowing applicants an additional period of grace for the payment of fees to allow such a period, not exceeding one month, also in the case of the designation fee, and;

to Rule 15.5: to align the wording of that Rule more closely to the suggested new wording for Rule 15.1(ii).

7. The proposed new Fees Schedule is contained in document PCT/A/III/5.

8. *The Assembly is invited to adopt new Rule 2bis and to amend Rules 15.1, 15.2, 15.3, 15.4, 15.5, 16.1(b) and 57, as set out in the Annex.*

[Annex follows]

THE FEES SCHEDULE

2BIS.1 LEGAL NATURE OF FEES SCHEDULE

The Fees Schedule annexed to these Regulations forms an integral part thereof.

2BIS.2 CURRENCY IN WHICH AMOUNTS ARE EXPRESSED

All amounts in the Fees Schedule shall be expressed in Swiss currency.

RULE 15

THE INTERNATIONAL FEE

15.1 BASIC FEE AND DESIGNATION FEE

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau ("international fee") collected by the receiving Office and consisting of,

- (i) a "basic fee," and
- (ii) as many "designation fees" as there are States designated in the international application for the purposes of national patents and as there are groups of states designated for the purposes of regional patents.

15.2 AMOUNTS

(a) The amounts of the basic fee and of the designation fee are as set out in the Fees Schedule.

(b) The amounts of the basic fee and of the designation fee shall be established, for each receiving Office which, under Rule 15.3, prescribes the payment of those fees in a currency or currencies other than Swiss currency, by the Director General in consultation with that Office and in the currency or currencies prescribed by that Office; the amounts so established shall be published in the Gazette. The amounts in each such currency shall be the equivalents, in round figures, of the amounts in Swiss currency set out in the Fees Schedule. Where, at any time, the exchange rate between Swiss currency and any such other currency differs by more than 10% (ten percent) from the exchange rate applied when the amounts in the said other currency were last established, the Director General shall, after consultation with the receiving Office having prescribed that latter currency, establish new amounts for the said fees. He shall proceed in the same manner if, at the end of two years from the date on which the amount in the said other currency was established, the exchange rate between the Swiss currency and the said other currency differs by more than 3% (three percent) from the exchange rate that was applied at the said date. New amounts shall also, to the extent

necessary, be established by the Director General, after consultation with the interested receiving Offices, whenever the amount of the basic or designation fee is changed in the Fees Schedule. All such new amounts shall become applicable two months after the date of publication of the, new amounts in the Gazette, provided that any interested Office and the Director General may agree on a date falling during the said two month period in which case the new amounts shall become applicable for that Office on that date.

15.3 MODE OF PAYMENT

The international fee shall be payable in the currency or currencies prescribed by the receiving Office, it being understood that, when transferred by the receiving Office to the International Bureau, it shall be freely convertible into Swiss currency.

15.4 TIME OF PAYMENT

(a) Subject to paragraph (c), the basic fee shall be due on the date of receipt of the international application.

(b) Subject to paragraph (c), the designation fee may be paid on the date of receipt of the international application or on any later date prior to the expiration of one year from the priority date.

(c) The national law may permit applicants to pay either the basic fee or the designation fee or both of the fees later, or the receiving Office may, where the national law so permits, notify, at its discretion, the applicant of any lack of receipt or insufficiency of any amount received in respect of the basic fee or the designation fee and permit applicants to pay either the basic fee or the designation fee or both of the fees later, provided that:

(i) permission shall not be given to pay the basic fee later than one month after the date of receipt of the international application;

(ii) permission shall not be given to pay the designation fee later than one month after the expiration of one year from the priority date;

(iii) permission may not be subject to any extra charge.

Such later payment of the said fees shall be without loss, in the case of the basic fee, of the international filing date or, in the case of the designation fee, of the designations to which the payment relates.

15.5 PARTIAL PAYMENT

(a) If the applicant specifies the states designated for the purposes of a national patent or groups of States designated for the purposes of regional patents to which he wishes any amount paid to be applied as designation fee, the amount shall be applied according to the number of States or groups of States which are covered by the amount in the order specified by the applicant. A group of States designated for the purposes of a regional patent shall be considered to have been so specified whenever at least one of the States in the group designated for such purposes is so specified.

(b) If the applicant does not specify any such wish, and if the amount or amounts received by the receiving Office are higher than the basic fee and one designation fee but lower than what is due according to the number of States designated for the purposes of a national patent and groups of States designated for the purposes of a regional patent, any amount in excess of the basic fee and one designation fee shall be treated as designation fees for the States, or groups of States, following the State, or group of States, first named in the request and in the order in which the States, or groups of States, are designated in the request up to and including that designated State, or group of States, for which the total amount of the designation fee is covered by the amount or amounts received. A group of States designated for the purposes of a regional patent shall be considered to have been reached whenever the first State in the group, designated for such purposes, is reached.

(c) [deleted]

[15.6: No change]

RULE 16

THE SEARCH FEE

16.1 RIGHT TO ASK FOR A FEE

(a) [No change]

(b) The search fee shall be collected by the receiving Office. The said fee shall be payable in" the currency or currencies prescribed by that Office, it being understood that if any currency so prescribed is not that or one of those (if more than one) in which the International Searching Authority has fixed the said fee; it shall, when transferred by the receiving Office to the International Searching Authority, be freely convertible into the currency of the State in which the International Searching Authority has its headquarters. The amount of the said fee in a currency or currencies prescribed by the receiving Office other than that or one of those (if more than one) in which the International Searching Authority has fixed the amount of the search fee shall be established by the Director General in consultation with that Office; the amounts so established shall be published in the Gazette. The amount in each such currency shall be the equivalent, in round figures, of the amount established by the International Searching Authority in a currency of its choice. Where, at any time, the exchange rate between the latter currency and any such other currency differs by more than 10% (ten percent) from the exchange rate applied when the amount in the said other currency was established, the Director General shall, after consultation with the receiving Office having prescribed that latter currency, establish a new amount for the search fee. He shall proceed in the same manner if, at the end of two years from the date on which the amount in the said other currency was established, the exchange rate between the Swiss currency and the said other currency differs by more than 3% (three percent) from the exchange rate that was applied at the said date. New amounts shall also, to the extent necessary, be established by the Director General, after consultation with the interested receiving Offices whenever the amount of the search fee is changed by the International Searching Authority. All such new amounts shall become applicable two months after the date of publication of the new amounts in the Gazette, provided that any interested Office and the Director General may agree on a date falling during the said two month period in which case the new amount shall become applicable for that Office on that date. Where, in respect of the payment of the search fee in a

currency in which the International Searching Authority has not fixed the amount of that fee, the amount actually received by the said Authority in the currency of the State in which it has its headquarters is less than that established by it, the difference will be paid to the

International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

[16.2, 16.3: No change]

RULE 57

THE HANDLING FEE

57.1 REQUIREMENT TO PAY

(a) Each demand for international preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau (“handling fee”) to be collected by the International Preliminary Examining Authority to which the demand is submitted.

(b) Where, because of a later election or elections, the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau into one or more additional languages, a “supplement to the handling fee” equal to the amount of the handling fee shall be payable for each such additional language and shall be collected by the International Bureau for its own benefit.

57.2 AMOUNT OF THE HANDLING FEE

(a) The amount of the handling fee is as set out in the Fees Schedule. The amount payable in any particular case shall be the amount as so set out, increased by as many times the same amount as the number of languages into which the International Preliminary Examination report must, in application of Article 36(2), be translated by the International Bureau.

(b) The amount of the handling fee shall be established for each International Preliminary Examining Authority which, under Rule 57.3(c), prescribes the payment of the handling fee in a currency or currencies other than Swiss currency, by the Director General in consultation with that Authority and in the currency or currencies prescribed by that Authority; the said amount shall be published in the Gazette. The said amount shall be the equivalent, in round figures, in the said currency or currencies of the amount specified in the Fees Schedule. Where, at any time, the exchange rate between Swiss currency and any such other currency differs by more than 10% (ten percent) from the exchange rate applied when the amount in the said other currency was last established, the Director General shall, after consultation with each International Preliminary Examining Authority having prescribed that latter currency, establish a new amount. He shall proceed in the same manner if, at the end of two years from the date on which the amount in the said other currency was established, the exchange rate between the Swiss currency and the said other currency differs by more than 3% (three percent) from the exchange rate that was applied at the said date. New amounts shall also, to the extent necessary, be established by the Director General, after consultation with the interested International Preliminary Examining Authorities, whenever the amount of the handling fee and the supplement to the handling fee is changed in the Fees Schedule. All

such new amounts shall become applicable two months after the date of publication of the new amounts in the Gazette, provided that any interested Office and the Director General may agree on a date falling during the said two month period in which case the new amount shall become applicable for that Office on that date.

57.3 TIME AND MODE OF PAYMENT

- (a) The handling fee shall be due at the time the demand is submitted.
- (b) Any supplement to the handling fee under Rule 57.1(b) shall be due at the time the later election is submitted.
- (c) The handling fee shall be payable in the currency or currencies prescribed by the International Preliminary Examining Authority to which the demand is submitted, it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency.
- (d) Any supplement to the handling fee shall be payable in Swiss currency.

57.4 FAILURE TO PAY (HANDLING FEE)

- (a) Where the handling fee is not paid as required, the International Preliminary Examining Authority shall invite the applicant to pay the fee within one month from the date of the invitation.
- (b) If the applicant complies with the invitation within the prescribed time limit, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the fee, unless, under Rule 60.1(b), a later date is applicable.
- (c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

57.5 FAILURE TO PAY (SUPPLEMENT TO THE HANDLING FEE)

- (a) Where the supplement to the handling fee is not paid as required, the International Bureau shall invite the applicant to pay the supplement within one month from the invitation.
- (b) If the applicant complies with the invitation within the prescribed time limit, the later election shall be considered as if it had been received on the date on which the International Bureau receives the supplement, unless, under Rule 60.2(b), a later date is applicable.
- (c) If the applicant does not comply with the invitation within the prescribed time limit, the later election shall be considered as if it had not been submitted.

57.6 REFUND

In no case shall the handling fee, or the supplement to the handling fee, be refunded.

[End of Annex and of document]