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PCT/A/III/4

ORIGINAL: English

DATE: March 23, 1979

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

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

FURTHER AMENDMENTS TO AND INTERPRETATION OF THE REGULATIONS
UNDER THE PATENT COOPERATION TREATY (PCT)

Memorandum by the International Bureau

PROPOSED NEW RULES 32TER AND 74TER AND AMENDMENT OF RULES 18.5
AND 54.4: CHANGES IN CERTAIN INDICATIONS IN THE REQUEST

1. Rules 18.5 and 54.4 of the PCT Regulations provide for the recording of changes in the person or name of the applicant by the International Bureau and for the notification by it of the interested International Searching and Preliminary Examining Authorities as well as the designated and elected Offices accordingly. But these Rules do not provide for recording and notification of changes in the residence or nationality of the applicant which may be essential for the purposes of communications provided for in Articles 20 and 36(3) (a) and consequent national procedures before designated and elected Offices, correspondingly, as well as for the purposes of international publication (see paragraph 6 below). The said Rules do not, furthermore, provide (nor would it be appropriate for these Rules to provide) for the recording of certain changes in other indications in the request which may be expected to occur and the notification of such changes to the interested persons and Offices. The Administrative Instructions, as promulgated by the Director General after consultations with the interested

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Offices in accordance with Rule 89 of the PCT Regulations contain in their Annex F forms for the purpose of having the International Bureau record and notify changes in certain data contained in the request (forms PCT/RO/113, 129, 130 and PCT/IB/306, 342, 343). The proposed new Rules 32ter and 74ter and amendments to Rules 18.5 and 54.4 set out in the Annex would include in the PCT Regulations a specific legal basis for the recording of such changes and, thereby, more clearly define the cases in which changes in the indications in the request may be recorded and notified by the International Bureau.

2. The above-mentioned changes, the recording and notification of which would be provided for in the amended and new Rules, are in the residence or nationality of the applicant, in the address of the applicant, the agent, the common representative or the inventor and in the person or name of the agent, the common representative or the inventor. So far as the Rules would provide for the notification of the designated Offices of a change in the person or name of the inventor, the procedure under the new Rules would meet the wishes expressed to the International Bureau by the USSR State Committee for Inventions and Discoveries that, where there has been a change in the person or name of the inventor during the international phase, it should receive a copy of the request in addition to the pamphlet publishing the international application, for the purposes of communication under Article 20. Such notification, rather than a change inserted in the record copy, would provide a clearer indication of the steps leading to the change. It goes without saying that the legal effect of a change in the person or name of the inventor would, having regard in particular to the specific provisions included in the PCT regarding the requirement of national laws in respect of the inventor, be subject to the application of those national laws.

3. The Assembly is invited to adopt the proposed new Rules 32ter and 74ter and the amendment of Rules 18.5 and 54.5 as set out in the Annex.

INTERPRETATION OF RULE 47.2; PROPOSED AMENDMENT OF RULE 47.1(B)

4. At the second session of the Assembly referred to above, the Assembly considered the interpretation of Rule 47.2 according to which the International Bureau uses, to the extent possible, copies of the pamphlets published under Rule 48.1(a) for the purpose of communications under Article 20. The Assembly noted that the International Bureau would study, during the period up to the present session of the Assembly, questions which had been raised in the discussion of the said interpretation, and might present further proposals, it being understood that any designated Office expressing a wish to receive, for the purposes of the communication under Article 20, a copy of the request in addition to the pamphlet or a copy of the pamphlet printed on one side only, or both, would receive a communication in a manner meeting those wishes (PCT/A/II/5, paragraph 40).

5. The only wishes indicated to the International Bureau have been that of the United States Patent and Trademark Office, made at the said session of the Assembly (PCT/A/II/5, paragraph 41) and a wish applying in a specific case, indicated by the USSR State Committee for Inventions and Discoveries (see paragraph 2).

6. On the other hand, the International Bureau has had correspondence with the European Patent Office directed to resolving, in the context of the front page of the pamphlet, indications of the additional bibliographic data which would enable that Office to accept

communication in terms of the said interpretation. The most important of the said additional indications would be an indication in the pamphlet of the residence and nationality of the applicant, for the purpose of enabling a check to be made as to compliance with the national (in the case of the European Patent Office regional) requirements regarding representation in the national (or regional) phase. The said Office also suggested that it would be useful to include telephone numbers and telegraphic and teleprinter addresses of applicants as well as information whether or not an international search has been carried out. The International Bureau is of the view that the inclusion of the said indications as to residence and nationality for the said purpose is desirable and could be provided for by an Administrative Instruction, having regard to the provisions of Rule 48.2(b) (i). So far as the other items are concerned, considerations of available space on the front page of the pamphlet suggest that these indications should be kept to a minimum unless other savings of space on the front page can be made.

7. The said correspondence between the International Bureau and the European Patent Office has led to the acceptance by the latter, on a trial basis, of the position of the International Bureau with respect to drawings included in the international application (in this regard, see PCT/A/II/5, paragraph 35 and paragraph 38, 5th sentence).

8. From the viewpoint of budget savings in the form of reduced reproduction costs and more efficient administrative procedures, the International Bureau is convinced that the said interpretation is in the interest of the PCT Contracting States. It is also convinced that the quality of the reproduction received by the designated Offices is markedly higher than if a separate reproduction were to be made for the purposes of communication. The International Bureau therefore proposes to maintain the said interpretation, subject to any further study, if desired, in cooperation with the three Offices which have raised specific points in relation to the said interpretation.

9. The only amendment to the PCT Regulations proposed by the International Bureau at this stage is to Rule 47.1(b). Experience has shown that the time limit for communication under Rule 47.1(b) most usually ends in the period from shortly before to shortly after the time limit for publication, depending on the time taken by the receiving Office in its processing of the application (before sending the search copy to the International Searching Authority, which event usually determines the time limit for the establishment of the international search report), by the International Searching Authority to establish and send the international search report to the applicant (from which event the time limit for amending the claims and thus for communication is calculated) and by the applicant to file amendments or a declaration that no amendments will be filed (after which event, communication becomes due). Administrative procedure would be simplified if, in the cases where communication falls due before international publication, the communication were delayed until publication.

10. From the viewpoint of the designated Offices, there seems no reason for the communication to be effected according to a time schedule so strictly related to the amendment of claims; communication according to a time limit based on international publication (so long as international publication is carried out promptly after the expiration of 18 months from the priority date) that is, during the 19th month after the priority date, would be sufficiently prior to the time at which national processing is due to start and could, indeed, better suit the needs of the designated Offices which will not want to be in possession of the international application too long before that time. Certain offices have waived communication under Article 20 since they feel that communication according to the present time limit results in their receipt of the international application at a time too much in advance

of the time at which they will start national processing. While the faculty of waiving communication is entrenched in the Treaty itself, there is an undoubted disadvantage to the applicant (who then becomes responsible for sending a copy of the international application to the designated Office) and to the International Bureau (which has to meet different requirements as to communication for different Offices and, on occasions, send a copy of the international application the copy which it would itself have sent to the designated Office, i.e., usually a copy of the pamphlet to the applicant himself) which detract from the attractiveness of the PCT system on the one hand and add to the administrative costs on the other. The setting of a time limit for communication closer to the commencement of the national phase will possibly provide a basis on which the said national Offices could accept communication in the normal way under Article 20.

11. From the viewpoint of the applicant, there would seem to be no disadvantage in allowing communication to be delayed until international publication since the notification as to communication would be received during the 19th month after the priority date. Moreover, the right of the applicant to request communication after the expiration of the time limit now provided for in Rule 47.1(b), in cases where he sees an advantage in such a procedure, could be expressly reserved.

12. It is consequently proposed by the International Bureau that Rule 47.1(b) be amended by the insertion of a sentence which, without changing the present time limit, would allow the International Bureau to delay the communication until international publication but not beyond the end of the 19th month from the priority date and not in cases where the applicant requests communication in accordance with the time limit presently provided for in Rule 47.1(b).

13. The Assembly is invited to adopt the interpretation of Rule 47.1 referred to above and the amendment of Rule 47.1(b) as set out in the Annex.

[Annex follows]

PCT/A/III/4
ANNEX

RULE 18

THE APPLICANT

18.5 CHANGE IN THE PERSON, NAME, RESIDENCE OR NATIONALITY OF THE APPLICANT

Any change in the person, name, residence or nationality of the applicant shall, on the request of the applicant or the receiving Office, be recorded by the International Bureau, which shall notify the interested International Searching Authority and the designated Offices accordingly.

RULE 32TER

CHANGES IN CERTAIN INDICATIONS
IN THE REQUEST

32TER.1 RECORDING OF CHANGES BY THE INTERNATIONAL BUREAU

The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request:

- (a) the person or name of the agent, the common representative or the inventor,
- (b) the address of the applicant, the agent, the common representative or the inventor.

32TER.2 NOTIFICATIONS

The International Bureau shall give notifications concerning changes recorded by it:

- (a) to the applicant;
- (b) as long as the international search report or the declaration referred to in Article 17(2) has not yet issued, to the International Searching Authority;
- (c) as long as the communication provided for in Article 20 has not yet been effected, to the designated Offices.

RULE 47

COMMUNICATION TO DESIGNATED OFFICES

47.1 PROCEDURES

- (a) [No change]
- (b) Such communication shall be effected promptly after the International Bureau has received amendments from the applicant, or a declaration that the applicant does not wish to

make amendments before the International Bureau, or, otherwise, when the time limit provided for in Rule 46.1 has expired. Communication may, however, be delayed until the international publication has taken place, but in any case not beyond the end of the 19th month after the priority date; it may not be so delayed if the applicant has requested communication to be effected in accordance with the preceding sentence. Where, under Article 17(2) (a), the International Searching Authority has made a declaration that no international search report will be established, the communication provided for in Article 20 shall be effected, unless the international application is withdrawn, within 1 month from the date on which the International Bureau has been notified of the said declaration by the International Searching Authority; such communication shall be accompanied by an indication of the date of the notification sent to the applicant under Article 17(2) (a).

(c) [No change]

(d) [No change]

(e) [No change]

RULE 54

THE APPLICANT ENTITLED TO MAKE A DEMAND

54.4 CHANGE IN THE PERSON, NAME, RESIDENCE OR NATIONALITY OF THE APPLICANT

Any change in the person, name, residence or nationality of the applicant shall, on the request of the applicant or the receiving Office, be recorded by the International Bureau, which shall notify the interested International Preliminary Examining Authority and the elected Offices accordingly.

RULE 74TER

NOTIFICATION OF CHANGES IN CERTAIN INDICATIONS IN THE REQUEST RECORDED UNDER RULE 32TER

74TER.1 NOTIFICATIONS

The International Bureau shall give notifications concerning changes recorded by it under Rule 32ter:

(a) as long as the preliminary examination report or the opinion referred to in Article 34(4) (a) has not yet issued, to the International Preliminary Examining Authority,

(b) as long as the communication provided for in Article 36(3) (a) has not yet been effected, to the elected Offices.

[End of Annex
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