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(PCT UNION)

ASSEMBLY

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PROPOSALS FOR AMENDMENTS TO THE PCT REGULATIONS AND
ADMINISTRATIVE INSTRUCTIONS

(BASED ON PROPOSALS MADE BY ORGANIZATIONS REPRESENTING THE USERS
OF THE PCT SYSTEM)

Memorandum prepared by the International Bureau

1. A number of changes which should be made to the PCT Regulations and to the PCT Administrative Instructions (including the forms annexed thereto) have come to notice in the course of practical operations under the PCT, some through the direct experience of the International Bureau (which are not the subject of this document) and others by their having been drawn to the attention of the International Bureau mainly by the applicants and their professional organizations before, during and following the PCT Users Meeting held at the Headquarters of WIPO in October 1979, at which a strong interest was expressed on the part of the users to make concrete proposals on matters of interest to them in the use of the PCT system.

* Editor's Note: This electronic 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

2. The papers received from organizations representing users of the PCT system are set out in full in document PCT/A/V/3. The present document summarizes each proposal made in the said papers which would involve either an amendment of a Rule of the PCT Regulations (Part I of the document) or the modification of a Section or form included in the Administrative Instructions (Part II of the document). Each such summary is followed by a comment by the International Bureau indicating its view as to whether or not an amendment of the Rule in question is desirable. Each such proposal and comment is set out on a left-hand side page. On the opposite page (i.e., right-hand side page), is the text of an amendment of the Rule in question, where the International Bureau takes up a proposed change and itself proposes an amendment to the Assembly, or an indication that no change is proposed by the International Bureau, where the International Bureau, in its comment, indicates that it does not think any change is desirable.

3. The proposed amendments to the Regulations are submitted to the Assembly for decisions. The proposed amendments to the Administrative Instructions are submitted to the receiving Offices and the International Searching and Preliminary Examining Authorities for consultation under Rule 89.2(b) during a meeting to be convened at a time, to be communicated separately, during the (June 1980) session of the Assembly.

4. *The Assembly is invited*

(a) *to amend the PCT Regulations by adopting the amendments appearing on the right hand side pages which follows;*

(b) *to decide the date on which each such amendment shall enter into effect.*

[Parts I and II follows]

PART I

Amendments to the Regulations
under the PCT

Ad Rule 3.3(a) (ii) (and Rule 4.17)

Patent Attorneys Association of Japan

How can the applicant take advantage of a national procedure (such as that under Article 30 of the Patent Law of Japan) which requires the filing by the applicant of a relevant statement, documentary proof, copies, etc., with the application or within a short period thereafter? Should Rule 4.17 be changed to permit the request to include the statement, etc.?

Comment by the International Bureau

In the opinion of the International Bureau, such a requirement is one relating to the form and content of the international application within the meaning of Article 27(1) and thus, at present, could not be made upon the filing of the international application but only once the processing of the international application has started in the designated Office. Nevertheless, the applicant is not prevented from supplying any such document at the time of filing, in which event the application should include a reference to the document in the check list referred to in Rule 3.3(a) (ii).

Rule 3.3(a) (ii)

[No change proposed by the International Bureau]

Ad Rule 4.3

Patent Attorneys Association of Japan

The number of words to which the title should (preferably) be limited (two to seven words when in English or translated into English) is unsuitable to practical needs and it is desired that the number be increased, if possible, up to 15 words.

Comment by the International Bureau

While a different suggested upper limit could be included, such a change would be without any legal significance since the number of words indicated in the Rule is merely advisory. At the same time, it is desirable that titles which are too long should not be encouraged. Therefore, no amendment as suggested is proposed, as it would invite a general lengthening of titles.

RULE 4.3

[No change proposed by the International Bureau]

*Ad Rule 4.8(b)*The Chartered Institute of Patent Agents, London

Consequential upon the proposed amendment of Rule 19.2 mentioned below, this Rule should provide that the applicant first named in the request who is competent to file an international application at the receiving Office where the application was filed shall be considered the common representative.

Comment by the International Bureau

The International Bureau agrees with the amendment proposed to this Rule for the reasons given for the proposed amendment of Rule 19.2.

RULE 4.8(b)

(b) If there is more than one applicant and the request does not refer to an agent representing all the applicants and it does not comply with the requirement of designating one of the applicants as provided in paragraph (a), the applicant first named in the request who is entitled to file an international application according to Rule 19.1(a) shall be considered the common representative.

Ad Rule 4.11

The Chartered Institute of Patent Agents, London

Consequential upon the proposed amendment to Rule 41.1 mentioned below, the Rule should be amended to enable particulars of a standard search carried out by the International Searching Authority competent for the international application to be given in the request (so that the applicant may become entitled to a refund of the whole or part of the search fee payable for the international search to be carried out by that Authority) .

Comment by the International Bureau

Having regard in particular to Rule 4.17, the International Bureau supports the idea that the applicant be expressly permitted to refer to an earlier search carried out by the International Searching Authority (for the purpose of obtaining a refund of the search fee, either in whole or in part, if the international search can be based, either in whole or in part, on the earlier search) even if the earlier search is not an international-type search under Article 15(5). The proposed amendment is one which seems desirable with regard to the proposed amendment of Rule 41.1; so long as the International Searching Authority is prepared to make a refund, a reference to the search in the request should be possible.

RULE 4.11

Reference to Earlier International or International-Type Search

If an international or international-type search has been requested on an application under Article 15(5), the request may state that fact, and identify the application (or its translation, as the case may be) by country, date and number, and the request for the said search by date and, if available, number. The request may include a reference to a search, other than an international or international-type search, made by the competent International Searching Authority if the applicant wishes that Authority to base the international search report wholly or in part on the results of the said search and to make a corresponding refund of the search fee, provided the said Authority has, in the agreement under Article 16(3) (b) or in a communication addressed to and published by the International Bureau, expressed its readiness to accept such other searches for purposes of a refund.

*Ad Rule 4.15*Trade Marks, Patents and Designs Federation, London

The request should be capable of signature by the patent agent or attorney in all cases. The position in the United States Patent and Trademark Office should be clarified.

Comment by the International Bureau

In the opinion of the International Bureau, Rule 4.15, read in conjunction with Rule 2.1, means that the request must be signed by the applicant (or applicants if more than one) or his (or their) agent(s) or other representative(s). The International Bureau is not aware of any

Office (including the United States Patent and Trademark Office) which does not accept signature on behalf of the applicant by his duly appointed agent or other representative.

RULE 4.15

[No change proposed by the International Bureau]

Ad Rule 5.1(c)

Patent Attorneys Association of Japan

Minimum requirements should be established so that international applications will uniformly include the minimum necessary headings instead of some being with the headings suggested in the Administrative Instructions (Section 204) and some being without those headings.

Comment by the International Bureau

It is considered an improvement to require the inclusion of the suggested headings in all cases. Moreover, it is felt to be more appropriate to specify the headings to be given in the Rule rather than in the Administrative Instructions so that they will more readily come to the attention of applicants. At the same time, the comment made by The Chartered Institute of Patent Agents, London with regard to a slight change needed to the headings (see below under Section 204) should be taken into account. Attention is drawn to the fact that, according to Rule 88.2, amendment of this Rule requires unanimity during the first five years after the entry into force of the Treaty.

RULE 5.1(c)

(c) Subject to the provisions of paragraph (b), the headings “Technical Field,” “Background Art,” “Disclosure of Invention,” “Brief Description of Drawings,” “Best Mode for Carrying Out the Invention” (or, where appropriate, “Mode for Carrying Out of Invention”) and “Industrial Applicability” shall precede respectively the parts referred to in items (i) to (vi) of paragraph (a).

Ad Rule 6.4(a)

The Chartered Institute of Patent Agents, London

The Rule should be amended so as not to prohibit the inclusion in an international application of multiple dependent claims dependent-on other multiple dependent claims. This form of claiming, which is usual in Europe, tends to result in each such subordinate inventive feature being represented in one and only one of the dependent claims. It may therefore be

considered to facilitate (rather than burden) the searching of the application by the International Searching Authority and generally to be conducive to conciseness and clarity of claiming. The second and third sentences of the Rule should be modified by the insertion of the word “preferably” after the word “shall” in each instance. A further sentence should then be added (along the lines of Rule 6.3(c)), saying that, where the law of the designated State does not require the manner of claiming provided for in the foregoing two sentences, failure to use that manner of claiming shall have no effect in that State provided the manner of claiming actually used satisfies the national law of that State.

Comment of the International Bureau

The International Bureau agrees with the proposed amendment. It should, however, be noted that this Rule may only be changed by unanimous decision of the Assembly during the first five years after the entry into force of the PCT.

RULE 6.4(a)

6.4 Dependent Claims

(a) Any claim which includes all the features of one or more other claims (claim in dependent form, hereinafter referred to as “dependent claim”) shall do so by a reference, if possible at the beginning, to the other claim or claims and shall then state the additional features claimed. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall preferably refer to such claims in the alternative only. Multiple dependent claims shall preferably not serve as a basis for any other multiple dependent claim. Where the national law of the designated State does not require the manner of claiming provided for in the preceding two sentences, failure to use that manner of claiming shall have no effect in that State provided the manner of claiming actually used satisfies the national law of that State.

Ad Rule 8.1(b)

Patent Attorneys Association of Japan

For reasons similar to those given in relation to the proposed change to Rule 4.3, the upper limit on the number of words to which the abstract should (preferably) be limited (150 words if it is in English or when translated into English) should be increased to 250. Comment by the International Bureau The possibility that the length of the abstract may exceed 150 words is open, since the Rule itself speaks of “preferably 50 to 150 words”. Moreover, that possibility is expressly admitted in paragraph 5 of the “Guidelines for the Preparation of Abstracts of International Applications under the Patent Cooperation Treaty” (see the PCT Gazette No. 05/1978, page 279). On the other hand, the International Bureau is concerned that abstracts should not be too long, since they must not only be published but (for that purpose) also translated into another language. Therefore, no amendment as suggested is proposed, as it would invite a general lengthening of abstracts.

RULE 8.1(b)

[No change proposed by the International Bureau].

Ad Rule 8.1(d)

The Chartered Institute of Patent Agents, London

The word “preferably” should be inserted before the words “placed between parentheses” to place the abstract on the same footing as the claims (in which reference signs need not necessarily be in parentheses (Rule 6.2(b))).

Comment by the International Bureau

The International Bureau would have no strong objections to the proposed change provided that it is made clear that the International Bureau may insert the parentheses for the purposes of international publication of the abstract so that there will be consistency in the PCT Gazette, in particular.

RULE 8.1(d)

(d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, preferably placed between parentheses; where parentheses are not used, they may, nevertheless, be inserted in publications by the International Bureau.

Ad Rule 10.1(b)

The Chartered Institute of Patent Agents, London

The word “centigrade” should be replaced by the word “Celsius” since the policy expressed in the Rule is that the rules of international practice should be observed and “Celsius” is the internationally prescribed term.

Comment by the International Bureau

The International Bureau is in agreement with the proposed amendment for the reasons given.

RULE 10.1(b)

(b) Temperatures shall be expressed in degrees Celsius, or also expressed in degrees Celsius, if first expressed in a different manner.

Ad Rule 10.1(c)

The Chartered Institute of Patent Agents, London

This paragraph should be omitted since density is, in effect, a matter of weights and measures which are already dealt with in Rule 10.1(a). Also, the paragraph is unduly restrictive because it does not include a provision for density to be specified not only in metric terms but also in non-metric terms, if desired, as is the case under Rule 10.1(a).

Comment by the International Bureau

The International Bureau agrees with the arguments on the basis of which the amendment is proposed. While the International Bureau notes that the same provision is contained in Rule 35(12), third sentence, of the Implementing Regulations under the European Patent Convention, Rule 35(12), in general, prescribes the use solely of the metric system), the removal of the paragraph would not affect the harmonization of the requirements of the PCT and the European Patent Convention; the applicant under the PCT would still have to indicate densities by the use of metric units under Rule 10.1(a) and thus would satisfy the requirements of the European Patent Office but would have the option of also using the terms of a different system again under Rule 10.1(a).

RULE 10.1 (c)

[Delete this paragraph]

Ad Rule 11.2(a)

Trade Marks, Patents and Designs Federation, London

The standard of quality set by WIPO for documents for an international application (i.e., the description and claims) appears unduly high. As a result, at least one national Patent Office rejects documents with reference to Rule 11.2(a) of the PCT when accepting documents of the same quality for national applications or when acting as receiving Office for the European Patent Office. It does so because it has learnt from experience that the International Bureau takes a stricter line with reference to Rule 11.2(a) of the PCT than the national Office or the European Patent Office takes on the same point. Although the necessity for a standard sufficiently high to enable satisfactory reproduction is accepted, it seems desirable that the PCT standard be no higher than that required by the European Patent Office.

Comment by the International Bureau

The International Bureau is not aware that its standards would be unreasonably high since it is the receiving Office that is deciding whether to ask for replacement sheets or not. It is up to the receiving Offices to decide whether to apply the same or different standards to national (regional) and international publications. In any case, easy legibility is indispensable since the pamphlets are produced by direct photographic reproduction from the international application.

RULE 11.2(a)

[No amendment proposed by the International Bureau]

Ad Rule 11.2(d) and (e)

The Chartered Institute of Patent Agent, London

It should be made possible for tables to be typed sideways on the page if the information cannot satisfactorily be presented in any other way since the situation is similar to that with respect to drawings which may be placed sideways under Rule 11.13(j). A new paragraph to this effect, overriding paragraph (d) of this Rule, should be added.

Comment by the International Bureau

The International Bureau is in agreement with what is proposed for the reasons given.

RULE 11.2

(d) Subject to Rule 11.13(j) and paragraph (e), each sheet shall be used in an upright position (i.e., the short sides at the top and bottom).

(e) Tables may be arranged in a position which is other than upright, where the information cannot satisfactorily be presented in an upright position.

*Ad Rule 11.12*Patent Attorneys Association of Japan

It is desirable that standards be established and made public of the conditions under which alterations, over writings and interlineations are admitted in view of the requirement ‘that each sheet shall be “free from alterations, over writings and interlineations”’.

Comment by the International Bureau

The obligation to replace sheets for non-compliance with this Rule in the international phase of the PCT procedure will result only from the exercise by the receiving Office (of the particular application) of its powers under Article 14(1) (b). The receiving Office has a certain degree of flexibility in deciding to overlook the existence of alterations, over writings and interlineations in the sheets of the international application by reason of the second sentence of Rule 11.12 (which makes the authenticity of the content and the possibility of reproducing the sheet the criteria for overlooking the existence of alterations, over writings and interlineations) and Rule 26.3 (which subjugates the enforcement of all of the physical requirements of Rule 11 in the hands of the receiving Office to what is “necessary for the purposes of reasonably uniform international publication”). The International Bureau has not, to date, had the occasion to consider that any international application in Japanese has contained sheets which should be replaced by reason of Rule 11.12. In any event, in order to make the meaning of Rule 11.12 more apparent, the International Bureau believes that the words “in exceptional cases” should be deleted from the second sentence of the Rule. This change would also bring the Rule into harmony with the equivalent Rule (Rule 35(14) of the Implementing Regulations under the European Patent Convention).

RULE 11.12

Alterations, Etc.

Each sheet shall be reasonably free from erasures and shall be free from alterations, over writings, and interlineations. Non-compliance with this Rule may be authorized if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

Ad Rule 13.2

The Chartered Institute of Patent Agents, London

The expressions “one independent claim,” “one process,” “one use” and “one apparatus or means” wherever occurring under possibilities (i) and (ii) should be replaced respectively by “an independent claim”, “a process”, “a use” and “an apparatus or means”; furthermore, the inclusion, in addition to an independent claim for a product, of an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for an apparatus or means specifically designed for carrying out the process should be allowed having regard, in particular, to the corresponding Rule of the Implementing Regulations under the European Patent Convention (Rule 30).

Comment by the International Bureau

The International Bureau agrees with what is proposed. The proposed amendment would tend to achieve more uniformity in the field of unity of invention in the interest of the users of the system.

RULE 13.2

Claims of Different Categories

Rule 13.1 shall be construed as permitting, in particular, one of the following three possibilities:

(i) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the said product, and the inclusion in the same international application of an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same international application of an independent claim for an apparatus or means specially designed for carrying out the process.

Ad Rules 14.1, 15.4 and 16.1

International Federation of Patent Agents (FICPI)

A remedy should, be provided against the loss of rights by an, applicant owing to inadvertent late or insufficient payment. Such remedy might consist of allowing either a period of grace for completing the payment or a reinstatement of the application, possibly subject to a reasonable penalty payment.

The Chartered Institute of Patent Agents, London

It should be provided that if the fee payable under each of these Rules is not paid in full as required, the receiving Office shall invite the applicant to pay the fees or the missing parts thereof within one month from the date of the invitation; if the fee is paid within the prescribed time limit, it should be considered as if paid on the due date. This would make the PCT procedure materially less hazardous and therefore more attractive to prospective applicants and their professional advisers.

Trade Marks, Patents and Designs Federation, London

A Rule similar to Rule 85(a) of the Implementing Regulations under the European Patent Convention (which allows a grace period of two months after the due date for the payment of certain fees and, providing a surcharge is paid, treats the fees as having been paid in time if paid during the grace period) should be included in the PCT Regulations.

Comment by the International Bureau

The International Bureau agrees, in substance, with what is proposed but thinks that it would be better to make the provision in a separate new Rule (see proposed new Rule 16bis). This new Rule should, as proposed, be generally applicable without the possibility of disclaimer provided in the part in square brackets. The part in square brackets has been suggested for consideration only in the case that one or more Contracting States should not be in a position to accept the immediate general application of that Rule.

RULES 14.1, 15.4 AND 16.1

[No change proposed by the International Bureau; instead the following text is proposed of a separate new Rule which could, perhaps, be numbered Rule 16bis]

New Rule 16bisLater Payment of Fees*16bis.1 Grace Period for Late Payment*

(a) Where the transmittal fee, the international or the search fee or part, of these fees is not paid by the due date referred to in Rules 14.1(b), 15.4 and 16.1(f), respectively, the receiving Office shall invite the applicant to pay any such missing fee or part thereof together with a surcharge within one month from the invitation.

(b) If the applicant complies with the invitation within the said one-month time limit, any missing fee or part thereof shall be considered as if it had been paid on the date referred to in Rules 14.1(b), 15.4 and 16.1(f).

16bis.2 Amount of Surcharge

The amount of any surcharge shall be fifty per cent of the missing fee, provided that it shall be in no case less than fifty and not exceed five hundred Swiss francs or its equivalent in the currency in which the payment of the fee is made.

16bis.3 Notifications

Any receiving Office may exclude the application of this Rule by a written communication to this effect to the International Bureau. Such communication shall be published in the Gazette.

Ad Rule 17.1

European Federation of Agents of Industry in Industrial Property (FEMIP)

For the “applicant, it would be simpler to submit the priority document to the receiving Office also when it is not filed together with the international application. Such a change would place all applicants on the same footing since the receiving Office is, as a rule, the Patent Office of the country of the applicant.

Comment by the International Bureau

Experience has shown that many applicants prefer to send the priority document to the International Bureau via the receiving Office even when the priority document is submitted subsequent to the filing of the international application, particularly where the priority document is an earlier national application filed with that Office and must, therefore, be ordered from it. Also it appears that a number of Offices regard receipt by the receiving Office as receipt on behalf of the International Bureau. The International Bureau supports the formalization of these practices in an amendment of the Rule.

RULE 17.1

Obligation to Submit Copy of Earlier National Application

(a) Where the priority of an earlier national application is claimed under Article 8 in the international application, a copy of the said national application, certified by the authority with which it was filed (“the priority document”), shall, unless already filed with the receiving Office, together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or, in the case referred to in Article 23.(2), not later than at the time the processing or examination is requested. Where submitted to the receiving Office, the priority document shall be transmitted by that Office to the International Bureau together with the record copy or promptly after having been received by that Office. In the latter case, the receiving Office shall certify to the International Bureau the date on which it received the priority document.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request shall be made not later than the expiration of the applicable time limit referred to under paragraph (a). The receiving Office shall transmit the priority document promptly after the receipt of such request to the International Bureau and certify the date on which it received the said request.

(c) If the applicant fails to comply with the requirements under paragraphs (a) and (b), any designated State may designate the priority claim.

(d) The International Bureau shall record the date on which the priority document has been received by it or by the receiving Office. Where applicable, the date of receipt by the receiving Office of a request referred to under paragraph (b) shall be recorded as the date of receipt of the priority document.

Ad Rule 19.1(a)

European Federation of Agents of Industry in Industrial Property (FEMIP)

This Rule should be liberalized since some applications have not been able to be treated as international applications because they have been filed with a receiving Office which is not competent for the particular application. It should be considered whether the competent receiving Office should be not only the national Office of or acting for the Contracting State of which the applicant is a resident or national but also the national Office of or acting for a Contracting State of which the (common) agent is a resident or national.

Comment by the International Bureau

The International Bureau supports the proposed solution although it would open the possibility of “shopping” for the receiving Office where the fees are the lowest. It is to be noted, however, that the situation would be similar to the one existing under the Paris Convention, since under that Convention any national of a member State of the Paris Union may file his first national application in any State member of the Paris Union. It is naturally, understood that the applicant would have to be a national or resident of one of the States party to the PCT.

RULE 19.1(a)

(a) Subject to the provisions of paragraph (b), the international application shall be filed, at the option of the applicant, with the national Office of or acting for the Contracting State of which the applicant is a resident or with the national Office of or acting for the Contracting State of which the applicant is a national or with the national Office of or acting for the Contracting State before which the agent of the applicant has the right to practice.

Ad Rule 19.2

- (1) European Federation of Agents of Industry in Industrial Property (FEMIP)
- (2) The Chartered Institute of Patent Agents, London
- (3) Trade Marks, Patents and Designs Federation, London

In the event of several applicants, the requirements of Rule 19.1(a) should be regarded as satisfied so long as one of the applicants, irrespective of the order in which his name appears in the request, meets the requirements of that Rule; the competence of the receiving Office should not be dependent on whether there is a common representative or on the order in which the names of applicants appear in the request (as at present under this Rule).

Comment by the International Bureau

The International Bureau strongly supports the proposals made by the above-mentioned organizations for the reasons given by them. For reasons of uniformity, it is suggested to apply, in this case, the same solution as in Rule 19.1(a).

RULE 19.2

Several Applicants

If there are several applicants, the requirements of Rule 19.1 shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national or, if the agent, if any, has the right to practice before that Office as receiving Office.

Ad Rule 22.3(a)

The Chartered Institute of Patent Agents, London

The time limit for the record copy to reach the International Bureau should be 15 months (and not 14 months) after the priority date since the time allowed to the applicant to take the steps necessary to save his rights under the procedure provided in Rules 22.1 and 22.2 in the event of the receiving Office failing to meet its obligations under these Rules (approximately 18 to 21 days) is unrealistically short.

Comment by the International Bureau

The International Bureau supports the above-mentioned proposal for the reasons given.

RULE 22.3

Replace “13 months” (wherever that expression appears) by “14 months” and “14 months” (wherever that expression appears) by “15 months.”

Ad Rule 30.1

The Chartered Institute of Patent Agents, London

A determination by the receiving Office that the requirements for according an international filing date were not complied with at the date of filing (notwithstanding its earlier decision to accord an international filing date) and that, accordingly, the international application is considered withdrawn, should be made promptly; the determination should be made before the international search is carried out and certainly before there is any possibility of the application being prepared for international publication.

Comment by the International Bureau

The International Bureau is in agreement with the amendment proposed for the reasons given.

RULE 30.1

Replace “6 months” by “4 months.”

Ad Rule 41.1

The Chartered Institute of Patent Agents, London

A reference to a “standard” search carried out by the International Searching Authority competent for the international application should be treated as if it were an international-type search since the results of an earlier standard search, although not international-type search within Article 15(5), may be used by the International Searching Authority in establishing the international search report and some refund of the search fee may therefore be appropriate.

Comment by the International Bureau

Whether or not an International Searching Authority is prepared to treat an earlier “standard” search which is not an international-type search on the same basis as an international-type search for the purposes of entitling the applicant to a refund if the international search can be based on the earlier search is a matter for decision by the International Searching Authority itself since the International Searching Authority will itself define the kinds of searches which it will carry out and the subsequent uses which can be made of the search results (and consequently whether or not a refund will be allowed). With this proviso, the International Bureau is in agreement with the proposed change.

RULE 41

THE INTERNATIONAL-TYPE AND OTHER SEARCHES

41.1 Obligation to Use Results; Refund of Fee

If reference has been made in the request, in the form provided for in Rule 4.11, to an international-type search carried out under the conditions set out in Article 15(5) or to a search other than an international or international-type search, the International Searching Authority shall, to the extent possible, use the results of the said search in establishing the international search report on the international application. The International Searching Authority shall refund the search fee, to the extent and under the conditions provided for in the agreement under Article 16(3) (b) or in a communication addressed to and published by the International Bureau in the Gazette, if the international search report could wholly or partly be based on the results of the international-type search.

*Ad Rule 46.2*Patent Attorneys Association of Japan

The applicant should be informed by the International Bureau of the date on which amendments to the claims are received; at present, the only way to find out this date is by checking the pamphlet issued by the International Bureau.

Comment by the International Bureau

The International Bureau is in agreement with the proposal and considers that the Rule should be amended to provide for notification of the applicant. The proposal for amendment of Rule 46.2 is contained in document PCT/A/V/5.

RULE 46.2

[See document PCT/A/V/S]

Ad Rule 46.4

The Chartered Institute of Patent Agents, London

The applicant should be permitted to file comment not exceeding, say, 500 words when in English or translated into English, on the relevance of citations made in the international search report whether or not he amends his claims. Such a comment would be in the interests of the public as well as the applicant.

Comment by the International Bureau

The International Bureau has sympathy for the views expressed. Following the PCT Users Meeting in October 1979, similar views were expressed in a letter to the Director General from Mr. Brian Cronin of Diamond Shamrock Technologies S.A. of Geneva, who referred to the interest of applicants in having the opportunity of filing a statement discussing the relevance (or irrelevance) of the documents cited in the search report, but without amending the claims. Moreover, he suggested that “it is also invaluable for third parties to know how the applicant interprets the prior art, since this can considerably simplify study of the case”. In the same letter, it was also stated:

“In reply to my questions [at the PCT Users Meeting] as to what the PCT officials would do with a statement which is not in compliance with Rule 46.4(b), there were conflicting replies. It seems that the statement would go into the file but it may not be communicated to designated Offices.

“I believe that it would place an unnecessary burden on WIPO officials if they are to examine whether comments in a statement under Article 19(1) are or are not in compliance with Rule 46.4(b); in many instances this would be paramount to the WIPO official making a thorough examination of the technical subject matter. This seems to me to be quite contrary to the purpose of WIPO as a clearing house rather than an examining authority.

“I would recommend abolition of Rule 46.4(b) (since it is practically unenforceable) and in the meantime publication of a practice direction (e.g., in the Users Guide) that WIPO will, in general, communicate statements under Article 19(1)”.

An opportunity for the applicant to comment on the relevance of citations made in the international search report and thus add useful information for the reader of the pamphlet and the designated and/or elected Office would certainly help to analyze the case. However, such statement will not become permissible by the simple omission of Rule 46.4(b). The said Rule only repeats in other terms what is provided for under Article 19(1), second sentence. This Article permits statements only where amendments have been filed and only for the purpose of explaining such amendments and indicating the impact they might have on the description and the drawings. For statements where no amendments have been filed and for statements commenting on the international search report, its impact and the relevance of its citations, there is, at present, no legal basis to be found in the Treaty or the Regulations. If it should be considered desirable to open a possibility for the filing of such statements by an appropriate amendment of the Regulations, the maximum of 500 words for such a statement, as provided in Rule 46.4(a), would have to be maintained, having regard to the need to publish such statement.

In the light of the preceding remarks, the International Bureau is of the opinion that there are important arguments in favor of and against the substance of the proposal, which require careful consideration. The International Bureau therefore does not suggest any amendment at this stage but invites the Assembly to consider the proposal on its merits.

RULE 46.4

[No change proposed by the International Bureau]

Ad Rule 46.5(a)

Patent Attorneys Association of Japan

The PCT Regulations require that the form of amendments under Article 19 of the Treaty shall be by way of the submission of a replacement sheet for every sheet which differs from the sheet originally filed and the letter accompanying the replacement sheet shall state the differences from the replaced sheet (PCT Rule 46.5(a)). It has been noted that many of the amendments under Article 19 which have been received by Japanese agents from overseas applicants are not in compliance with the above requirements. The agents receiving other forms of amendments are unable to confirm from such papers themselves whether they are in fact Article 19 amendments. A sample of the letter accompanying the replacement sheets should be prepared and published in the PCT Gazette.

Comment by the International Bureau

The International Bureau agrees that amendments must be submitted in accordance with Rule 46.5(a). The need for an accompanying letter follows from Rule 92.1. Such a letter, where it does not contain a statement referred to in Article 19(1) and Rule 46.4 but only an explanation, will stay in the file of the International Bureau and does not need to be published or sent to any designated Office and may not be required by any such Office from the applicant. Consequently, the applicant (or an agent representing the applicant) does not have to furnish a copy of such a letter to the designated Office together with a copy (or the translation) of the amendments filed under Article 19(1). The international Bureau, therefore, neither sees a need nor a possibility to amend Rule 46.5(a) or to prepare a sample letter. Even where such sample letter existed, it would not replace the need to obtain an individual explanation of the amendments in each given case. Since the use of such sample letter could not be prescribed by the Regulations, its existence would not help any patent agent in identifying any amendment where the applicant fails to use it.

RULE 46.5(a)

[No amendment proposed by the International Bureau]

Ad Rule 47.1

European Federation of Agents of Industry in Industrial Property (FEMIP)

The applicant should be entitled to rely on the notice of the International Bureau according to Rule 47.1(c) (indicating the designated Offices to which communication of the international application has been effected and the date of such communication). It should be made clear that the applicant does not have to make certain that the communication referred to in the notice has been received by the designated Office by adding an additional sentence to this Rule.

Comment by the International Bureau

In the opinion of the International Bureau, the communication under Article 20 takes place when it is made by the International Bureau. The provisions of Rule 47.1(c), first sentence, confirm this view. Furthermore, the International Bureau believes that the applicant is not responsible for (since he has no possibility of checking and the PCT cannot be read as making the applicant responsible for actions which are entrusted to an international authority over which he has no control):

- (a) The adequacy of the communication (if it is defective in any way, the designated Office must look to the International Bureau to remedy the defect);
- (b) Whether the communication has in fact taken place.

RULE 47.1(c)

Add after the second sentence “Each designated Office shall be informed about the sending of the notice. The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place.”

Ad Rule 48.2(a)

Patent Attorneys Association of Japan

The “request” should be included in the publication of the pamphlet. There are instances where the copy of the request which an agent in a designated State receives from the applicant and the copy of the request which the International Bureau communicated to the designated Office under Article 20 of the Treaty have discrepancies due to, for example, corrections made subsequent to the filing. When the designated Office draws the agent’s attention to a deviation in any particulars from the information contained in the copy of the Office, the agent will be able to check this if the pamphlet includes the “request.”

Comment by the International Bureau

The front page of the pamphlet contains data taken from the request. If the request has been corrected, the corrected data will appear on the front page. Since all relevant data from

the request is now shown on the front page, publication of the request would not add anything but would, of course, result in additional pages in the pamphlet which should be avoided in the interests of economizing on storage space and costs.

RULE 48.2(a)

[No change proposed by the International Bureau]

Ad Rule 51

The Chartered Institute of Patent Agents, London

The time limit for seeking review before the designated Offices should be made uniform with that for entry into the national phase under Article 22.

Comment by the International Bureau

The International Bureau agrees with the proposal which results in a useful simplification in the PCT time limits as it allows to telescope Rules 51.1 and 51.3. It must, however, be pointed out that the proposed change in the Rule could occasionally have the effect of shortening the time available to the applicant under the present Rule to consider whether to seek a review under Article 25 (which may involve for the applicant a consideration of the national laws applicable in designated Offices as well as the circumstances giving rise to the loss of rights by the applicant). Under the proposal, such a shortening would occur, for example, where the determination which the applicant wishes to have reviewed occurs only shortly before the time limit under Article 22; in such a case, the present time limit of two months from the determination would expire after the time limit under Article 22. Such cases should, however, be very rare, as the receiving Offices must make the determination under Article 14(4) within 6 months from the international filing date (Rule 30.1) and as it is proposed by this document to reduce that time limit to 4 months.

RULE 51

Review by Designated Offices

51.1 Time limits referred to in Articles 25(1) (c) and 25(2) (a)

The time limit referred to in Article 25(1) (c) for presenting the request to send copies and in Article 25(2) (a) for paying the national fee and furnishing a translation shall expire at the same time as the applicable time limit under Article 22 (1) and (3).

51.2 [No change]

51.3 [Delete this Rule]

51.4 [No change]

Ad Rule 69.1

- (1) The Chartered Institute of Patent Agents, London
- (2) Trade Marks, Patents and Designs Federation, London

The time limits prescribed (for inclusion in the agreements with the International Preliminary Examining Authorities pursuant to Article 32(3)) for the establishment of the international preliminary examination report in paragraphs (a) and (c) should be capable of extension by a period of up to six months upon request by the applicant considering that the time limits referred to in those paragraphs may prove to be too short to establish when evidence is required in proof of inventive step. (Trademarks, Patents and Designs Federation, London, especially, when time for experimental work is desired by the applicant to provide evidence).

Comment by the International Bureau

The International Bureau is in agreement with the proposed amendment which was also suggested during the PCT Users Meeting, held in Geneva in October 1979.

RULE 69.1

Time Limit for International Preliminary Examination

- (a)
 - (i) [existing text]
 - (ii) [existing text]
 - (iii) in cases where the applicant requests an extension of the time limit referred to in item (i) or (ii), such time limit, provided that it shall not expire later than one year after the start of the, international preliminary examination.

*Ad Rule 80.6*The Chartered Institute of Patent Agents, London

When a period starts on the day of the date of a document or letter emanating from a national Office or intergovernmental organization, the party to whom the document or letter was addressed should be able to prove that he did not receive it until after 5 days after the date that it bears, in which case the period should be computed from the date 5 days before the date of actual receipt. A similar presumption that a document or letter will arrive within 5 days after the date of mailing is found in Rule 82.1(a). The proposed amendment would be highly desirable in the interests of the applicant, in view of delays currently experienced in the post, and would also serve to introduce a measure of conformity with European practice (see Rule 83(2), together with Rule 78(3) of the Implementing Regulations under the European Patent Convention). Moreover, in the absence of an amendment of this character, it would

apparently be necessary to amend Rules 46.1 and 66.2(d) which prescribe time limits running respectively from the date of transmittal of the international search report and the date of notification of the written opinion of the International Preliminary Examining Authority, because Article 19(1) and 34(2) (c) under which those Rules are made require the applicant to have received the document in question before having to respond to it.

Comment by the International Bureau

Although the International Bureau does not accept the views expressed with regard to the interpretation of Articles 19(1) and 34(2) (c) of the PCT and the consequent necessity to amend Rules 46.1 and 66.2(d) if an amendment of the kind proposed is not adopted, the International Bureau is of the view that the applicant should be entitled to have notifications delivered to him not later than 7 days from the date of mailing and in the event of such delivery not taking place, to have time limits extended by a period corresponding to the delay in delivery beyond 7 days. A period of 7 days has been suggested as corresponding to the longest normal period of delivery even where the applicant is resident in a country distant from the sender of the notification.

RULE 80.6

Date of Documents

Add to the present text the following additional sentence:

Irrespective of the date on which such a document or letter was mailed, if the applicant offers to the national Office or intergovernmental organization evidence which satisfies the national Office or intergovernmental organization that the document or letter was received more than 7 days after the date it bears, the national Office or intergovernmental organization shall treat the period starting from the date of the document or letter as expiring later by an additional number of days which is equal to the number of days which the document or letter was received later than 7 days after the date it bears.

Ad Rule 90.3(a)

The Chartered Institute of Patent Agents, London

Only the applicants who have not signed an authorization (power of attorney) should be required to sign the request form (see below the proposal with regard to Section 106 of the Administrative Instructions).

Comment by the International Bureau

Rule 90.3 (a) requires that the appointment of any agent or common representative within the meaning of the Rule 4.8(a) shall be effected by a separate signed power of attorney (i.e., a document appointing an agent or common representative) if the said agent or common representative is not designated in the request signed by all the applicants. Rule 90.3(c)

provides that a power of attorney shall be considered non-existent so long as the power of attorney is not signed as provided in paragraph (a). The combined effect of these two provisions appears to be that an agent or common representative cannot be appointed partly by signature of the request and partly by signature of a separate document. The International Bureau believes that the objective sought in the proposal made in relation to Section 106, with which the International Bureau agrees, can only be achieved by an amendment of Rule 90.3(a), permitting the appointment in the request to be signed only by applicants who have not appointed the agent or common representative in a separate power of attorney, as well as the modification of Section 106.

RULE 90.3

APPOINTMENT

Appointment of any agent or of any common representative within the meaning of Rule 4.8(a) shall be effected by each applicant, at his choice, by the signing of the request in which the agent is designated under Rule 4.7 or of a separate power of attorney (i.e., a document appointing an agent or common representative).

Ad Rule 92.1

The Chartered Institute of Patent Agents, London

If the applicant submits a letter from' which his signature is missing, a copy of the letter should be sent to him with an invitation to return it within the prescribed time limit after affixing his signature thereto and only if this invitation is not complied with should the original letter be considered not to have been submitted.

Comment by the International Bureau

The International Bureau believes that the present Rule, whereby a paper cannot be taken into account unless it is accompanied by a letter signed by the applicant (or his agent) could be improved, particularly in the case where the letter does not appear to contain a signature. Furthermore, once it is conceded that an invitation should be issued in such a case and the possibility should be provided for the applicant to remedy any omission without consequence, a number of questions arise. There seems to be little reason to limit the possibility of omissions being remedied to the case where the deficiency is the omission of a signature. Also, it would seem necessary to deal with the case where a time limit expires between the time of receipt of the defective paper and the remedying of the defect. Equally, the present Rule could be further improved since its operation is the same whether or not the defect has been noted and taken into account. Accordingly, the International Bureau would propose an amendment which would include, but also be more extensive than, that proposed.

RULE 92.1

NEED FOR LETTER AND FOR SIGNATURE

(a) [Existing text]

(b) If the requirements provided for in paragraph (a) are not complied with, the applicant shall be informed as to the non-compliance and invited to remedy the omission within a time limit fixed in the invitation. The time limit so fixed shall be reasonable in the circumstances; even where the time limit so fixed expires later than the time limit applying to the furnishing of the paper (or even if the latter time limit has already expired), it shall not be less than 10 days from the mailing of the invitation; where the time limit so fixed expires later than the time limit applying to the furnishing of the paper, it shall not be more than one month from the mailing of the invitation. If the omission is remedied within the time limit fixed in the invitation, the omission shall be disregarded otherwise the applicant shall be informed that the paper has been disregarded.

(c) Where non-compliance with the requirements provided for in paragraph (a) has been overlooked and the paper taken into account in the international procedure, the non-compliance shall be disregarded.

[Part II follows]

PART II

Amendments to the Administrative Instructions under the PCT

Ad Section 106

The Chartered Institute of Patent Agents, London

This Section should be amended to cater for a situation where one of several applicants 'has already lodged a general authorization (power of attorney) with the receiving Office (see also new Rule 90.3(d)) so that only the other applicants (e.g., inventors where the United States of America is designated) need sign the request form or any separate power of attorney.

Comment by the International Bureau

The International Bureau is in agreement with the proposed amendment for the reasons given.

SECTION 106

(a) [Existing text becomes paragraph (a)]

(b) Where the international application is filed with reference to a general power of attorney not signed by all the applicants, it shall be sufficient for the purpose of appointment of a common agent under Rule 90.3, if the request or a separate power of attorney is signed by the applicant, who did not sign the general power of attorney.

Ad Section 204(v)

The Chartered Institute of Patent Agents, London

Heading (v) should be amended to include "Mode for Carrying Out the Invention" by way of alternative. Rule 5.1(a) (v) indicates that the law of some designated States does not require the description of the best mode but is satisfied with the description of any mode (whether it is the best contemplated or not). For example, there is no requirement in the European Patent Convention (c.f., Rule 27(1) (f) for a description of the best mode. Unless a State is designated which, requires a description of the best mode, heading (v) as currently set out in Section 204 is inappropriate.

Comment by the International Bureau

The International Bureau is in agreement with what is proposed for the reasons given. However, Section 204 of the Administrative Instructions should be deleted and included in the Regulations, thus coming more readily to the attention of the applicant. See proposed new Rule 5.1(c).

SECTION 204

[To be deleted]

Ad Section 205

The Chartered Institute of Patent Agents, London

Greater flexibility should be allowed in the numbering of amended claims. For example, it should be possible to replace a single claim by two claims with consequent renumbering of subsequent claims in the set.

Comment by the International Bureau

The International Bureau agrees that some amendments may require greater flexibility as far as new claims are concerned and where such new claims do not for substantive reasons, belong at the end of all claims. However, in such a case, a renumbering of claims is required with a clear reference to the original number of the renumbered claims in order to allow clear identification of any amendment.

SECTION 205(a)

Numbering of Claims upon Amendment

(a) [Existing text]

(i) [Existing text]

(ii) as a new claim, in which case it shall bear the next number after the highest previously numbered claim; that number shall be followed by the word “(new)” or its equivalent in the language of the international application; where the consecutive order of claims requires for a new claim a number before the highest previously numbered claim, the claims following the number which is given to the new claim and the following claims shall be renumbered; the new number shall be followed by the words (or an equivalent of these words in the language of the international application) “(Original claim No.)” and an indication of the original number of the renumbered claim.

[End of document]