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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Fifth Session (3rd Extraordinary)*
Geneva, June 9 to 16, 1980

AMENDMENTS TO THE PCT REGULATIONS (BASED ON THE EXPERIENCE OF
THE INTERNATIONAL BUREAU)

Memorandum prepared by the International Bureau

1. This document contains proposals for amendments to the PCT Regulations and to the PCT Administrative Instructions (including the forms annexed thereto) based on the experience of the International Bureau in operations of the PCT. The document takes into account questions brought to its attention through working contacts with other PCT Offices and Authorities and individual applicants; it supplements document PCT/A/V/4 which contains proposals for amendments presented to the Assembly by the International Bureau on the basis of proposals made by organizations representing the users of the PCT system. Some of the proposed amendments have previously been included in proposals for possible amendments put before the Assembly but deferred for lack of time for later consideration at a subsequent session (see the report of the third session, document PCT/A/III/11 paragraph 32).
2. A summary of the general nature of, and background to, the proposed amendments is given on the left hand side pages which follow; the texts of the proposed changes appear on the right hand side pages opposite thereto.

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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 follow;*

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

[Proposed amendments follow]

Ad Rule 18.5

At its third session, held in Geneva from April 25 to May 1, 1979, the Assembly had before it proposals for the amendment of this Rule and related proposals for the amendment of Rule 54.4 and the adoption of new Rules 32^{ter} and 74^{ter} (document PCT/A/III/4, paragraphs 1 to 3 and Annex A). Due to lack of time, the Assembly deferred consideration of the proposals to a subsequent session (see the report of the said third session, document PCT/A/III/11, paragraph 32).

The following explanation of the said proposals was given in document PCT/A/III/4:

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 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 32^{ter} and 74^{ter} 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.

The International Bureau considers that the Assembly should now take up again the proposed amendments. However, the International Bureau--instead of amending Rules 18.5 and 54.4 and adding two new Rules 32^{ter} and 74^{ter} proposes a single new Rule 92^{bis}, combining all requirements related to the said changes in the request, and the deletion of

Rules 18.5 and 54.4. The said proposal has the advantage of telescoping in one single Rule all provisions relating to the same subject matter.

RULE 18.5

CHANGE IN THE PERSON OR NAME OF THE APPLICANT

[Delete this Rule]

Ad Rule 20.3bis

Article 11(2) provides that if the receiving Office finds that the international application did not, at the time of receipt fulfill the requirements listed in paragraph (1) of that Article, it shall invite the applicant to file the required correction and shall accord as the international filing date the date on which the required correction is received. It appears from Article 11(1) that a required correction may relate to the language in which the purported international application (or part of it) was filed, to an indication contained in or missing from the request or to a missing description or missing claims. Rule 20 sets out the procedure with regard to the handling of the papers of the purported international application received by the receiving Office and the manner in which they shall be marked, both prior to and after the receipt of any required correction. The Rule does not, however, prescribe the manner in which the correction shall be submitted. While it goes without saying that some kinds of correction can only be effected by submitting new (additional) sheets, it is not specified how correction of indications in the request should be submitted (whether in the form of a letter or by the submission of new (replacement) sheets). In the case of later submitted sheets, Section 309 of the Administrative Instructions contains certain prescriptions as to the marking of the sheets and of the request, as to notification of the applicant and as to the transmittal of the record copy. Certain of the provisions of that Section would not be appropriate if the request was to be corrected by the submission of replacement sheets.

It is proposed that a new Rule be adopted which would provide that the Administrative Instructions will prescribe the manner in which corrections required under Article 11(2) (a) shall be presented and entered in the file of the international application. Section 309, either unamended or in an amended form, could be supplemented by a further Instruction as to the submission of a correction of an indication in, or missing from the request and, if necessary, how the correction shall be entered into the file of the international application. The Director General could then consult with the interested Offices with a view to prescribing uniform procedures applicable in all Offices.

NEW RULE 20.3*BIS*

MANNER OF CARRYING OUT CORRECTIONS

The Administrative Instructions prescribe the manner in which corrections required under Article 11(2) (a) shall be presented by the applicant and the manner in which they shall be entered in the file of the international application.

Ad Rule 22.3(b)

Paragraph (b) of Rule 22.3 states that Article 48(1) and Rule 82 shall not apply to the transmittal of the record copy. There does not seem to be any compelling reason for creating an exceptional situation for the time limit under Article 12(3) by excluding the application of Article 48(1) or Rule 82 (delay or loss in mail). Having regard to the consequences under Article 12(3) (the international application shall be considered withdrawn), it is proposed that Rule 22.3(b) be deleted with the effect that a delay in meeting the time limit under Rule 22.3(a) because of irregularities in the mail service may be excused under the circumstances prescribed under Rule 82.

Rule 22.3(b)

[Delete this paragraph]

Ad Rule 22.5

The definition for the purposes of Rule 22 of the term “record copy” as including also any document filed with the international application referred to in Rule 3.3(a) (ii) seems to be superfluous and not quite logical since, as it already follows from Rule 22.5, non-transmittal of the elements mentioned in Rule 3.3(a) (ii) does not necessarily prevent the record copy to have its effect as a record copy. Consequently, it would seem to be desirable to delete the first sentence of Rule 22.5 and to replace it by a provision that any document filed with the international application referred to in Rule 3.3(a) (ii) shall be transmitted to the International Bureau together with the record copy.

RULE 22.5

Any document filed with the international application referred to in Rule 3.3(a) (ii) shall accompany the record copy. If any document referred to in Rule 3.3(a) (ii) which is indicated in the check list as accompanying the international application is not, in fact, filed at the latest by the time the record copy leaves the receiving Office, that Office shall so note on the check list and the said indication shall be considered as if it had not been made.

Ad Rule 46.2(a)

Experience has shown that sometimes applicants file amendments instead of with the International Bureau with the receiving Office or with the International Searching Authority. In such cases, the International Bureau may receive the amendments, as transmitted to it by the said Office or Authority, only after the expiration of the time limit under Rule 46.1 although the amendment had been filed in due time with the receiving Office or the International Searching Authority. The practice of filing amendments with the said Office or Authority should be expressly permitted and the receipt of the amendments by them should be considered as a receipt on behalf of the International Bureau.

New Rule 46.2(a)

(a) Any amendment made under Article 19 may be given to the receiving Office or the International Searching Authority for transmittal to and filing with the International Bureau. Such transmittal shall be effected promptly after the receipt of the amendment together with a certification, by the receiving Office or the International Searching Authority, of the date on which the amendment has been received. The amendment shall be considered as having been filed with the International Bureau on the day on which it was so received.

Ad Rule 46.2 (b)

Most applicants seem to wish to receive a notification of the date of receipt of any amendment filed by them. Although such notification would constitute an additional burden for the International Bureau, a change of the present Rule providing for such a notification is deemed to be necessary, the more so as the indication of the date of filing of amendments is required by at least one of the designated Offices.

New Rule 46.2(b)

(b) The date of filing of any amendment shall be recorded by the International Bureau, which shall also notify the applicant of the date and indicate the date in any publication or copy issued by it.

Add Rule 54.4

See above, under “Ad Rule 18.5.”

RULE 54.4

CHANGE IN THE PERSON OR NAME OF THE APPLICANT

[Delete this Rule]

Ad Rule 55.1

There does not seem to be any compelling reason for limiting the language of the demand to the language of the international application or the language of the translation under Rule 55.2. The demand is of concern primarily to the International Preliminary Examining Authority and the International Bureau (see Rule 60.1). The language in which the demand is to be submitted could be liberalized so that the applicant has the possibility of using even a language different from that in which the international application was filed. For example, where the international application is filed in English with the Swedish Patent Office and will be examined in that language by the Swedish Patent Office as International Preliminary Examining Authority, there is no reason why the demand should not be filed in Swedish (rather than English) if that language is more convenient to the applicant.

RULE 55.1

THE DEMAND

The demand shall be in the language of the international application or, when a translation is required under Rule 55.2, in the language of that translation, provided that the International Preliminary Examining Authority may permit the demand to be in any language specified in the agreement concluded between the International Bureau and that Authority.

Ad Rule 57.4(b)

This Rule provides, in effect, that, if the handling fee is not paid in full when the demand is submitted, the demand will be considered as having been received only when the missing amount is paid. The delaying of the date on which the demand is considered as having been received may result in the demand being filed too late for obtaining the advantage consisting of the prolongation to 25 months of the time limit before expiration of which national processing may not start. The PCT system would be made safer for the applicant if the provisions of Rule 57.4(b) were aligned with those of Rule 58.2(b). It is, consequently, proposed to make any payment made within the one-month time limit as being retroactive to the date on which it should have been made.

Rule 57.4(b)

(b) If the applicant complies with the invitation within the one-month time limit, the handling fee shall be considered as if it had been paid on the due date.

Ad Rule 57.5(b)

For reasons similar to those mentioned in relation to Rule 57.4(b), this Rule should be aligned to the provisions of Rule 58.2(b).

Rule 57.5(b)

(b) If the applicant complies with the invitation within the one-month time limit, the supplement to the handling fee shall be considered as if it had been paid on the due date.

Ad Rule 60.1(b)

Consequential to the proposed amendment of Rule 57.4(b), this Rule needs to be amended accordingly. At the same time, it is proposed to make the following further amendment: where the demand does not comply with requirements other than those referred to in Rule 53.2(a), the present consequence under Rule 60.1(b), that the date of receipt of the correction be accorded to the demand, seems to be inappropriate in view of the minor nature of such defects. The same arguments given for the proposed amendment of Rule 57.4(b) apply also to this amendment.

Rule 60.1(b)

(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 corrections where the defects in the demand concern the requirements referred to under Rule 53.2(a) (i) and (iv); otherwise, the demand shall be considered as if it had been received on the actual filing date.

Ad Rule 60.2(b)

Consequential to the proposed amendment of Rule 57.5(b), this Rule needs to be amended accordingly. In addition, what has been proposed for the demand (see Rule 60.1(b), as amended), applies also to a later election and the same amendment as proposed in the said Rule is proposed for Rule 60.2(b).

Rule 60.2(b)

(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 corrections where the defects in the later election concern the requirements referred to under Rule 53.2(a) (i) and (iv); otherwise, the later election shall be considered as if it had been received on the actual filing date.

Ad Rule 90.3

Although the present text does not exclude the use of a general power of attorney, the International Bureau considers a clarification in this respect to be appropriate. The general power of attorney should be deposited with the competent receiving Office and a copy of it should be provided by the applicant for the sake of completeness of the record copy and the files of the International Bureau and to facilitate the checking by the receiving Office.

New Rule 90.3(d)

(d) Where a general power of attorney has been deposited with the receiving Office, reference may be made in the request to such general power of attorney, provided that an unsigned copy thereof shall be attached to the request.

Ad Rule 91.2

Rule 91.1 prescribes the procedure for requesting, authorizing and notifying the rectification of obvious errors of transcription in the international application itself or in a paper submitted to the International Searching Authority, the International Preliminary Examining Authority or the International Bureau. The Administrative Instructions do not prescribe the manner in which the proposed rectification must be presented by the applicant and the manner in which it is to be entered in the file of the international application. In order to assure flexibility, particularly considering that the manner in which the rectification is submitted may vary according to whether the error is in the request, in another part of the international application or in a paper submitted to the International Searching Authority, the International Preliminary Examining Authority, or the International Bureau, it is proposed that the question of the manner of presentation of the rectification and the manner in which it is entered in the file of the international application be as prescribed in the Administrative Instructions. The Director General could then consult with the interested Offices with a view to establishing uniform procedures for the presentation and entering in the file of the international application of obvious errors of transcription.

NEW RULE 91.2

MANNER OF CARRYING OUT RECTIFICATIONS

The Administrative Instructions prescribe the manner in which rectifications of obvious errors of transcription shall be presented by the applicant and the manner in which they shall be entered in the file of the international application.

Ad Rule 92.4

The PCT does not deal with (and, as a consequence, probably excludes) communications by telegraphic and teleprinter messages and the like. It would be desirable that some provision be included to enable such means of communication to be used.

NEW RULE 92.4

USE OF TELEGRAPH, TELEPRINTER, ETC.

Notwithstanding the provisions of Rule 11.14 and of paragraph (a) of this Rule, any document, paper or letter subsequent to the international application, may be sent by telegraph or teleprinter or other like means of communicating visible messages. However, the contents of the telegraphic, teleprinter or other like visible message, in a form complying with the requirements of the same provisions, must be furnished within 14 days after the receipt of the telegraphic, teleprinter or other like visible message; otherwise, the telegraphic, teleprinter or other like visible message shall be considered not to have been made.

Ad Rule 92bis

See above, under “Ad Rule 18.5”

NEW RULE 92BIS

CHANGES IN CERTAIN INDICATIONS IN THE REQUEST

92bis.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:

- (i) person, name, residence, nationality or address of the applicant,
- (ii) person, name or address of the agent, the common representative or the inventor.

92bis.2 Notifications

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

- (i) to the receiving Office where the change has been recorded on the request of the applicant,
- (ii) 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,
- (iii) as long as the communication provided for in Article 20 has not yet been effected, to the designated Offices,
- (iv) as long as the preliminary examination report or the opinion referred to in Article 34(4) has not yet issued, to the International Preliminary Examining Authority,
- (v) as long as the communication provided for in Article 36(3) (a) has not yet been effected, to the elected Offices.

(b) The receiving Office shall give notifications concerning changes recorded by it to the applicant and the International Bureau.

Ad Section 306 of the Administrative Instructions

Pursuant to the change of the Rules referred to in this Section, the related Administrative Instruction must be adapted accordingly.

SECTION 306

CHANGES IN CERTAIN INDICATIONS IN THE REQUEST

Any request for recording of any changes referred to under Rule 92bis shall be signed by the applicant or, if the receiving Office requested such change, by the receiving Office. The request shall clearly identify the indications the change of which is requested.

Ad Annex F of the Administrative Instructions, Form PCT/ISA/210 (International Search Report)

The space provided on the second sheet of this form turned out to be, in some cases, insufficient to allow the citation of all documents considered to be relevant. It is therefore necessary to supplement this form in an appropriate way. In lieu of the limited space given on the supplemental sheet (2) for the purpose of supplementary indications of citations and having regard to the fact that the Boxes V (Observations where certain claims were found unsearchable) and VI (Observations where unity of invention is lacking) will normally not have to be used in such cases, it is proposed that an extra sheet as a continuation sheet for Box III of the second sheet be adopted.

III. DOCUMENTS CONSIDERED TO BE RELEVANT (CONTINUED FROM THE SECOND SHEET)				
Category *	Citation of Document, ¹⁶ with indication, where appropriate, of the relevant passages ¹⁷	Relevant to Claim No. ¹⁸		
<p>* Special categories of cited documents: ¹⁶</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 50%; border: none; vertical-align: top;"> <p>"A" document defining the general state of the art</p> <p>"E" earlier document but published on or after the international filing date</p> <p>"L" document cited for special reason other than those referred to in the other categories</p> <p>"O" document referring to an oral disclosure, use, exhibition or other means</p> </td> <td style="width: 50%; border: none; vertical-align: top;"> <p>"P" document published prior to the international filing date but on or after the priority date claimed</p> <p>"T" later document published on or after the international filing date or priority date and not in conflict with the application, but cited to understand the principle or theory underlying the invention</p> <p>"X" document of particular relevance</p> </td> </tr> </table>			<p>"A" document defining the general state of the art</p> <p>"E" earlier document but published on or after the international filing date</p> <p>"L" document cited for special reason other than those referred to in the other categories</p> <p>"O" document referring to an oral disclosure, use, exhibition or other means</p>	<p>"P" document published prior to the international filing date but on or after the priority date claimed</p> <p>"T" later document published on or after the international filing date or priority date and not in conflict with the application, but cited to understand the principle or theory underlying the invention</p> <p>"X" document of particular relevance</p>
<p>"A" document defining the general state of the art</p> <p>"E" earlier document but published on or after the international filing date</p> <p>"L" document cited for special reason other than those referred to in the other categories</p> <p>"O" document referring to an oral disclosure, use, exhibition or other means</p>	<p>"P" document published prior to the international filing date but on or after the priority date claimed</p> <p>"T" later document published on or after the international filing date or priority date and not in conflict with the application, but cited to understand the principle or theory underlying the invention</p> <p>"X" document of particular relevance</p>			
IV. CERTIFICATION				
Date of the Actual Completion of the International Search ²		Date of Mailing of this International Search Report ²		
International Searching Authority ¹		Signature of Authorized Officer ²⁰		