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DRAFT
PROPOSED AMENDMENTS TO CERTAIN TIME LIMITS
IN THE PCT AND TO THE REGULATIONS
UNDER THE PCT

FIRST OF THREE PREPARATORY MEMORANDA OF THE INTERNATIONAL BUREAU

INTRODUCTION

1. The Assembly of the International Patent Cooperation Union (PCT Union), in its seventh session, held in Geneva from June 29 to July 3, 1981, asked the International Bureau to carry out a study of possible improvements to the Patent Cooperation Treaty (PCT), particularly the PCT Regulations (see document PCT/A/VII/15, paragraphs 54 to 64).
2. The Assembly, in its eighth session, held in Geneva from November 16 to 24, 1981, noted with approval a communication by the Director General that the program would not provide for the convocation of a revision conference. Consequently, no proposal is made for any amendment that would require decision by a revision conference. The proposals contain only two amendments to the Treaty but those amendments consist of modifications of time limits (fixed in Articles 22(2) and 39(1) (a)) which, under Article 47(2) (b), may be decided in the Assembly or through voting by correspondence, that is, without a revision conference. All other proposals concern amendments to the Regulations and such amendments require decision by the Assembly (see Article 58(2) (a)).

* *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

3. On the basis of the first conclusions of the study undertaken by the International Bureau—and taking into account proposals received in particular from interested non-governmental organizations—the International Bureau prepared draft proposals for the amendment to the time limit fixed in Article 22(2) of the PCT and for a number of amendments to the PCT Regulations. Those first proposals, contained in document BIG/227, were discussed with representatives of the said organizations in a meeting held in Geneva on April 1 and 2, 1982, to which the Offices of all member States, as well as the European Patent Office and the African Intellectual Property Organization, were invited and at which several of them were represented. The Offices were also invited to make written proposals and several of them did so.

4. On the basis of the discussions of the said meeting and of the written communications received from national Offices, the International Bureau, in continuing its study, revised its first proposals and added further proposals. They are being put—in three separate documents—before the PCT Committee for Administrative and Legal Matters, a Committee of which all States party to the PCT are members and to the sessions of which all interested intergovernmental and international non-governmental organizations are invited.

5. The present document is the first one of the three documents. The other two documents are scheduled to be published in July 1982. Generally speaking, the proposals that, in the view of the International Bureau, are the most important for achieving the objectives of safety and simplicity of the system are contained in the present document.

6. Where a proposal concerning a given subject matter requires that several Rules be amended, the proposed amendments are presented together, as a group (each is numbered with Roman numerals). Since some of the existing Rules deal with several subject matters, proposed amendments to any given Rule may appear, in any of the three documents, in different places; in all such cases, however, appropriate cross-references are included. The proposed amendments appear on the odd-numbered pages, whereas the corresponding explanations appear on the opposite even-numbered pages. In the text itself of the Rules proposed to be amended, underlinings indicate what is new as compared to the present text.

7. Although all the amendments submitted to the Committee for Administrative and Legal Matters are presented in the form of amendments to the Regulations under the PCT (with two exceptions which are amendments to time limits in the Treaty itself), the International Bureau intends to examine the totality of the Regulations, once the said Committee has given its advice on the substance of the proposed amendments, in order to determine which Rules of the Regulations could be transferred into the Administrative Instructions.

8. The Committee for Administrative and Legal Matters is invited to consider, and advise the International Bureau on, the proposed amendments (and corresponding explanations) contained in the present and the other preparatory documents.

SUBJECT MATTERS OF THE AMENDMENTS PROPOSED IN THIS DOCUMENT

	Objective	Provisions to be amended	Page
I.	Making safer the transmittal of the record copy	Rules 20.5, 22.1 to 22.4 and 23.1	4
II.	Making uniform, and in some cases longer, the time limits for entering the national phase in designated States	Article 22(2) and Rules 51.1 and 51.3	12
III.	Making it unnecessary for the applicant to transmit copies of his international application to the designated Offices	Rules 49.1 and 76.1	16
IV.	Making it unnecessary for the applicant to furnish translations of the request; and other improvements favoring the applicant in connection with the translation of claims where amendments to the claims have been filed during the international phase and in connection with any failure to translate statements explaining amendments or to translate certain microbiological indications	Rules 49.3 to 49.6 and 76.3 to 76.7	20
V.	Making it clear that certain requirements for entering the national phase are not allowed under the PCT	Rule 51 <i>bis</i>	26
VI.	Making it clear that certain requirements to be complied with during the national phase must be complied with by the applicant only after entering the national phase and after being invited to comply	Rule 51 <i>ter</i>	30
VII.	Giving more time to the applicant for filing, during the international phase, amendments to the claims in certain cases, and making it possible to file, during the international phase, amendments to the claims not only with the International Bureau but also with the receiving Office or the International Searching Authority	Rules 46.1 and 48.2	34

EXPLANATIONS OF THE PROPOSED AMENDMENTS

I. Making safer the transmittal of the record copy
(Concerns Rules 20.5, 22.1, 22.2, 22.3, 22.4 and 23.1)

1. Ad Rules 20.5 and 22.1, 22.2 and 22.3. Under the present Rules, the obligation to transmit the record copy lies with the receiving Office. The receiving Office must mail the record copy to the International Bureau not later than five days prior to the expiration of the 13th month from the priority date (Rule 22.1(a)). The International Bureau notifies the applicant of the receipt of the record copy from the receiving Office. If the applicant is not in possession of such a notification by the expiration of 13 months and 10 days from the priority date—that is, two weeks after the day on which the receiving Office must, at the latest, mail the record copy to the International Bureau—then, and only then, the applicant himself may transmit the record copy (or a copy equivalent to the record copy) to the International Bureau. This is the procedure under the present Rule 22.1(b) and (c): it will be called hereinafter the “wait and act” procedure. It has, in fact, never been used by any applicant. There is also another procedure—called, in the Regulations, “alternative procedure”—under which, if the rules applicable in the receiving Office so permit, the applicant may, under certain conditions and without waiting for the expiration of any time limit, obtain the record copy from the receiving Office and forward himself the record copy so obtained to the International Bureau. This is the procedure under the present Rule 22.2, a somewhat involved Rule and one of the longest. It is to be noted that there are only two receiving Offices—the Swedish Patent Office and the United States Patent and Trademark Office—that allow the use of this alternative procedure and that, in fact, this procedure has never been used by any applicant.

2. It is also to be noted that till now, as far as the International Bureau is aware, the record copies of all the international applications filed have reached the International Bureau within the prescribed time limit and through transmittal by the receiving Offices.

3. In view of these facts, and after more than three years of practical experience, one could conclude that both the “wait and act” procedure (Rule 22.1(b) and (c)) and the “alternative procedure” (Rule 22.2) are superfluous. Since, however, the theoretical possibility exists that a receiving Office might fail to transmit the record copy in time to the International Bureau, some kind of safeguard procedure should be provided for under which the applicant is fully protected against any such failure on the part of the receiving Office. The International Bureau believes that such a safeguard procedure should be a much simpler one than the “wait and see” and “alternative” procedures now provided for in the Regulations. In particular, this new safeguard procedure should remove the annoying features of the present “wait and act” procedure, namely:

(i) the fact that the applicant must wait until a specific date before he can act, the annoyance being that he has to keep in mind or monitor that date,

(ii) the fact that the applicant must act during a period of three weeks, the annoyance being that the period is a relatively short one,

(iii) the fact that, in order to be able to act—that is, to transmit a copy to the International Bureau—the applicant must first obtain an appropriate copy from the receiving Office.

4. It is therefore proposed to dispose of both the “wait and act” procedure (existing Rule 22.1(b) and (c)) and the “alternative procedure” (Rule 22.2) and to institute a new “safeguard” procedure which would remove all of the said annoyances, namely:

TEXT OF THE PROPOSED AMENDMENTS

Rule 20

Receipt of the International Application

20.1 [See document PCT/CAL/I/3]*

20.2 to 20.4 [No change]

20.5 Positive Determination

(a) [No change]

(b) [No change]

(c) The receiving Office shall promptly notify the applicant of the receipt of the international application, the international application number and the international filing date. The notification shall identify the international application by indicating the name of the applicant and the title of the invention, and shall also indicate, where the priority of an earlier application is claimed in the international application, the date of filing—as indicated in the international application—of the earlier application. If the priority of several earlier applications is claimed, the earliest date of filing shall be indicated. The notification shall be sent to the applicant in two copies, one of them being marked “Copy to be forwarded by the applicant to the International Bureau if the applicant wishes to initiate the procedure under Rule 22.1(b) to (f).”

20.6 to 20.9 [No change]

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Scheduled to be available in July 1982.

- (i) the applicant would not have to wait until a certain date and, consequently, he would be relieved of the necessity to monitor any date,
- (ii) the applicant would not be required to act within a certain, relatively short period,
- (iii) the copy the applicant transmits could be his own and not one that he has to obtain first from the receiving Office.

5. The proposed safeguard procedure would consist of the following steps. The applicant would receive two copies of the notification under Rule 20.5(c), namely, the notification made by the receiving Office to the applicant informing him that the international application has been received by it. One of these copies would bear the inscription “Copy to be forwarded by the applicant to the International Bureau if the applicant wishes to initiate the procedure under Rule 22.1(b) to (f).” The applicant could, if he so wishes, forward that copy to the International Bureau. If he does so, the safeguard procedure would be set in motion: the International Bureau would monitor the timely receipt of the record copy and, should the record copy not have been received within the time limit of 13 months from the priority date prescribed in Rule 22.1(a), remind the receiving Office to promptly transmit the record copy; if the record copy has not been transmitted by the receiving Office following the reminder—and this will probably never happen—the International Bureau would, by the expiration of 14 months from the priority date, invite the applicant to transmit a copy—any copy—of his international application to it within one month from the date of the invitation; the applicant could then either ask the receiving Office for a certified copy of his international application, which would have to be issued at no cost to the applicant, and forward that copy to the International Bureau, or he could simply forward a copy of the international application without any certification. Where national security clearance is still to be obtained, the one-month time limit for the forwarding of a copy by the applicant would be extended by one further month if the applicant proved to the satisfaction of the International Bureau that the necessary clearance for national security was not obtained in time for allowing compliance with the one-month time limit.

6. The rest of the safeguard procedure would consist of the following steps: the International Bureau would, upon receipt from the applicant of an uncertified copy, make a duplicate copy for its files and forward the copy received from the applicant to the receiving Office for certification of its identity with the international application as filed. It may be expected that the receiving Office, where it receives a copy for certification, will (unless lost) transmit the record copy to the International Bureau, which should have been done in the first place, instead of undertaking the task of certification. In practice, the certification of the identity of the copy sent by the applicant to the International Bureau with the international application as filed would have to be made only very rarely, namely, when the receiving Office cannot find the record copy or where the record copy was sent to the International Bureau but got lost in the mail. Where the record copy got lost, the receiving Office could, instead of undertaking the task of certifying the copy sent by the applicant under Rule 22.1(c), prepare a substitute record copy on the basis of the home copy and transmit such copy to the International Bureau. Where, however, the International Bureau receives from the receiving Office neither the record copy nor the substitute record copy or the copy furnished by the applicant and certified by the receiving Office, the copy made by the International Bureau of the copy furnished by the applicant would be considered to be the record copy. If he follows this procedure, the applicant cannot lose, through any fault of the receiving Office, the effect of his international application. It is only in the case where the receiving Office finds that the copy to be certified is not identical with the copy it originally received and notifies the International Bureau accordingly—that is, when it expressly refuses the certification—that the record copy would be considered as not having been received by the International Bureau. It is to be noted that the refusal of the certification could only be based on the said non-identity of copies and on no other reason.

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The notification would contain more information than is presently required under Rule 20.5(c). It would contain not only the international application number and the international filing date but also the title of the invention and the date of the (earliest) priority date claimed (if any), as reflected in proposed Rule 20.5(c).

Rule 22

Transmittal of the Record Copy

22.1 Procedure

(a) [No change]

(b) The applicant may forward a copy of the notification referred to in Rule 20.5(c) to the International Bureau. If, by the expiration of 13 months from the priority date, the International Bureau has received such copy but is not in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly and shall notify the applicant accordingly.

(c) If, by the expiration of 14 months from the priority date, the International Bureau is in possession of a copy of the notification referred to in Rule 20.5(c) but is not in possession of the record copy or of a substitute record copy certified by the receiving Office on the basis of theme copy, it shall invite the applicant to transmit a copy of his international application to it within 1 month from the date of the invitation. If the International Bureau has received such copy within that time limit and if such copy is not certified by the receiving Office as being identical with the international application as filed, it shall send it, after having made a copy thereof for the file, to the receiving Office with the request to the latter to certify it as being identical with the international application as filed.

(d) The one-month time limit referred to in paragraph (c) shall be extended by one further month if the applicant proves to the satisfaction of the International Bureau that the necessary clearance for national security was not obtained in time for allowing compliance with the one-month time limit referred to in paragraph (c).

7. It is to be noted that no applicant would be obliged to use the safeguard procedure just outlined. If the applicant chooses not to forward a copy of the notification under Rule 20.5(c) to the International Bureau, the procedure would remain as provided in Rule 22.1(a), and the applicant will be as safe as all applicants having filed international applications so far, none of which has lost an application because the record copy did not reach the International Bureau within the time limit prescribed in Rule 22.3.

8. In order to make the situation concerning the transmittal of the record copy even more reassuring to the applicant, it is also proposed that the time limit by which the non-receipt of the record copy by the International Bureau would cause the loss of the international application be extended by two months. The time limit would thus be 17, instead of 15 months from the priority date. Rule 22.3, as proposed, reflects this recommended change.

9. In addition, it is proposed that, where the safeguard procedure (under the proposed new Rule 22.1(b)) is initiated, the time limit (by the expiration of which the international application is considered withdrawn under Article 12(3)) should start only from the date of the invitation sent to the applicant under the proposed new Rule 22.1(c) and that it be 3 months from the date of such invitation. That time limit would leave ample time for the applicant to forward a copy of the international application to the International Bureau and for obtaining a certification from the receiving Office. The said time limit could, in a given case, expire even later than the 17-month time limit which is applicable when the proposed safeguard procedure is not used. Where the applicant forwarded the copy of the Form PCT/RO/105 under Rule 22.1(b) and that copy is received by the International Bureau, the time limit under Rule 22.3 would start only when the International Bureau issued the invitation to the applicant to send a copy of his international application. The international application would, therefore, never be considered withdrawn under Article 12(3) without a prior warning to the applicant and an invitation to act. Where, in any given case, the International Bureau would fail to issue such an invitation, the time limit under Rule 22.3 would not start to run and, consequently, could not expire.

10. It is to be noted that, where the applicant makes use of the proposed safeguard procedure, his rights would be absolutely safeguarded, since the International Bureau would monitor the receipt of the record copy and, if it did not receive it, would inform the applicant and invite him to act by either obtaining a certified copy of the international application from the receiving Office or making a copy himself and by forwarding either of those copies to the International Bureau.

11. Furthermore, it should be noted that the proposed safeguard procedure would remove the problems which might exist if the international application requires national security clearance, since, by the expiration of 14 months from the priority date, such clearance should have been obtained from the competent authorities and it is only then that the applicant might have to send a copy of his international application to the International Bureau. Where such clearance has not been obtained by the time the applicant receives the invitation referred to in Rule 22.1(c) and where he proves the lack of clearance to the International Bureau, the time limit for forwarding a copy, which is normally one month, would be extended by one further month. Such extension would give the applicant 16 months from the priority date for the obtaining of national security clearance, which is 4 months more than if he were to use the traditional Paris Convention route and will be sufficient in all cases.

12. Ad Rules 22.4 and 23.1. The amendments proposed in Rules 22.4 and 23.1 are consequential upon the deletion of the “wait and see” and “alternative” procedures.

[Rule 22.1, continued]

(e) Any certification under paragraph (c) shall be free of charge and may be refused only on the ground that the copy which the receiving Office has been requested to certify is not identical with the international application as filed.

(f) Where, by the expiration of the time limit fixed in Rule 22.3, the International Bureau has not received the record copy, a substitute record copy or a notification of refusal of the certification referred to in paragraph (c), the copy received by the International Bureau from the applicant under paragraph (c) or the copy thereof made by the International Bureau, as the case may be, shall be considered to be the record copy.

22.2 [Deleted]

22.3 *Time Limit under Article 12(3)*

(a) The time limit referred to in Article 12(3) shall be 17 months from the priority date or, where a copy of the notification referred to in Rule 20.5(c) has been received by the International Bureau under Rule 22.1(b), 3 months from the date of the invitation referred to in Rule 22.1(c).

(b) [No change: remains deleted]

22.4 *Statistics Concerning Non-Compliance with Rule 22.1(a)*

The number of instances in which, according to the Knowledge of the International Bureau, any receiving Office has not complied with the requirements of Rule 22.1(a) shall be indicated, once a year, in the Gazette.

22.5 [No change]

Rule 23

Transmittal of the Search Copy

23.1 Procedure

(a) The search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau.*

(b) [See document PCT/CAL/I/4]**

(c) [No change]

* The amendment consists in deleting, at the end of the present text of this paragraph, the words “or, under Rule 22.2(d), to the applicant.”

** Scheduled to be available in July 1982.

II. Making uniform, and in some cases longer, the time limits for entering the national phase in designated States
(Concerns Article 22(2) and Rules 51.1 and 51.3)

1. Ad Article 22(2). It is often—and rightly—said that one of the advantages of the PCT is the fact that the applicant enjoys at least 20 months after the priority date before any national processing of his international application can start (see Articles 22(1) and 23(1)). (Thus, expenses for translations, local agents and national fees are incurred 8 months later than if priority is claimed under the Paris Convention but the PCT is not used.) This 20 month-time limit, however, is subject to an exception which makes the time limit shorter. The exception is provided for in Article 22(2) and applies in the case where the International Searching Authority declares that no international search report will be established. Such cases are rare but when they exist, the exception must be remembered by the applicant. In any case, keeping in mind two different time limits is a complication in itself. There is real danger that the applicant might overlook the requirement under Article 22(2) to enter the national phase within two months from the date of the notification of such declaration sent to the applicant rather than 20 months from the priority date. Furthermore, the short time limit in Article 22(2) also weakens the advantage, flowing from the use of the PCT route, whereby the applicant is given considerable time to reflect upon the desirability of pursuing his application before the designated Offices. Moreover, there seems to be no particularly convincing reason why a shorter time limit in Article 22(2) is necessary. Finally, having the same time limit under paragraphs (1) and (2) of Article 22 could but make it easier for the applicant to remember time limits under the PCT. It is to be noted that the majority of the national Offices, in their capacity of designated Offices, have already made use of the possibility provided under Article 22(3) to extend the time limit under Article 22(2) and have extended it to 20 months from the priority date, thus making it the same as it is under Article 22(1); these are the Offices of Australia, Austria, Democratic People's Republic of Korea, Germany (Federal Republic of), Hungary, Luxembourg, Monaco, Romania, Soviet Union, Switzerland, as well as OAPI. (The Offices of Australia and Hungary have even extended the time limit to 21 months from the priority date.)
2. For all these reasons, it is proposed that the time limit under Article 22(2) should—as in the case of the time limit in Article 22(1)—be 20 months from the priority date. The possibility for any Contracting State to extend that time limit further under Article 22(3) would remain open. As a consequential amendment—since there would no longer be any difference between the time limits in paragraphs (1) and (2) of Article 22—one could also omit, in paragraph (2), the introductory words (“Notwithstanding the provisions of paragraph (1)”).
3. Although these proposals entail amendments in the PCT itself, such amendments may be effected outside a diplomatic conference, namely, by a unanimous decision of the PCT Assembly or in a vote by correspondence, since Article 47(2) allows “all time limits fixed in Chapters I and II” of the PCT to be modified by such a procedure. Replacing the now existing time limit by another time limit is clearly a modification allowed by Article 47(2). Eliminating the words “Notwithstanding the provisions of paragraph (1)” is a necessary consequence of the said modification of a time limit but it could be argued that it is not, per se, a modification of a time limit and thus outside Article 47(2). Consequently, the deletion of those words is merely a tentative proposal. The maintaining of those words could lead to difficulties of interpretation because there would no longer be any exception (the words “Notwithstanding the provisions of paragraph (1)” imply that there is an exception) to the principle laid down in Article 22(1). As a matter of fact, one could even delete Article 22(2) completely as well as any reference to it in Article 22(3) and still consider such amendments as a mere change in time limits since the whole paragraph (2) of Article 22 deals with nothing but a time limit.

Article 22

Copy, Translation, and Fee, to Designated Offices

It is proposed that the time limit “two months from the date of the notification sent to the applicant of the said declaration” in Article 22(2) be replaced by “20 months from the priority date.”

[As a consequence, it is proposed that the words “Notwithstanding the provisions of paragraph (1)” be omitted from the same provision (that is, Article 22(2)).]

Rule 51

Review by Designated Offices

51.1 Time Limit Referred to in Articles 25(1)(c) and 25(2)(a)

The time limit referred to in Article 25(1)(c) for presenting a 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 time limit applicable under Article 22.

51.2 [No change]

51.3 [Deleted]

51.4 [No change].

4. [Ad Rule 51.1](#). Once a uniform time limit is achieved, as proposed, for entering the national phase, it would be logical—and would mean an additional simplification—if the time limit prescribed in Rule 51.1 for presenting a request initiating any review (of an adverse decision by the receiving Office) on the part of a designated Office were also uniform. That is why it is proposed that such time limit should be the same as the proposed new (and only) time limit in Article 22. This proposal would, in some cases, result in a time limit longer than under the present Rules. Such prolongation would be an additional advantage for the applicant by providing for more flexibility, it being understood that it would not prevent him from initiating the review as soon as possible, which is generally advisable.
5. [Ad Rule 51.3](#). Since, according to the proposal, Rule 51.1 would also deal with the time limit dealt with in the present Rule 51.3, namely, the time limit for paying the national fee and furnishing a translation, it is proposed to delete the latter.

III. Making it unnecessary for the applicant to transmit copies
of his international application to the designated Offices
(Concerns Rules 49.1 and 76.1)

1. [Ad Rules 49.1\(a-bis\) and 76.1\(a-bis\)](#). Article 24(1)(iii) (and also Article 39(2)) provides that the effect of the international application provided for in Article 11(3) (i.e., the same effect as that of a national (or regional) application) shall cease in any designated (elected) State with the same consequence as the withdrawal of a national (or regional) application, if [the applicant](#) fails, *inter alia*, to furnish to the designated Office a copy of the international application within the 20 (or 25) months time limit, unless a copy of the international application has already reached the designated (elected) Office through transmittal (under Article 20 and Rule 47.1(a)) [by the International Bureau](#).
2. In practice, however, the designated (elected) Offices rely [entirely](#) on the communication of the international application [by the International Bureau](#). Where they are not in possession of a copy of the international application at the expiration of the 20 (25) months time limit, they ask the International Bureau to supply a copy of the international application, or they refer to the copy contained in the complete set of all published international applications received by them under Rule 87.2, and they do not, in fact, consider the international application as an application that has lost its Article 11(3) effect only because [no](#) copy transmitted [by the applicant](#) reached them in time. In other words, and in practice, lack of compliance by the applicant with his obligation to furnish a copy of the international application under Article 22 (or Article 39) is, in fact, not sanctioned.
3. However, the legal possibility of sanctioning such omission exists, and this is a danger that makes the position of the applicant insecure. It is, therefore, proposed that a new rule—Rule 49.1(a-bis) (Rule 76.1(a-bis))—provide that where the designated (elected) Office foregoes the application of the said sanction, it announce it publicly which would have as a consequence that any applicant could rely on the practice. Such waiver finds its legal basis in the words “as provided in the Regulations” contained in Article 20(1)(a).
4. [Ad Rules 49.1\(a-ter\) and 76.1\(a-ter\)](#). There may be Contracting States where, even if the said practice is acceptable, a formal declaration under the proposed new Rule 49.1(a-bis) (Rule 76.1(a-bis)) would not be possible without first making a corresponding amendment of their national laws. It is for such States that Rule 49.1(a-ter) (Rule 76.1(a-ter)) is being proposed. That new Rule would have the same practical effect—security for the applicant—as the proposed Rule 49.1(a-bis) (Rule 76.1(a-bis)) and would rely on Article 24(2) (Article 39(3)) as its legal basis.

Rule 49

Copy, Languages of Translations and Amounts of Fees
under Article 22(1) and (2)

49.1 Notification

(a) [No change]

(a-bis) Any Contracting State not requiring the furnishing, under Article 22, by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau provided for, under Article 20, in Rule 47 has not taken place by the expiration of the time limit applicable under Article 22) shall notify the International Bureau accordingly.

(a-ter) Any Contracting State which, pursuant to Article 24(2), maintains, if it is a designated State, the effect provided for in Article 11(3) even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under Article 22 shall notify the International Bureau accordingly.

(b) Any notification received by the International Bureau under paragraphs (a), (a-bis) or (a-ter) shall be promptly published by the International Bureau in the Gazette.

(c) [No change]

49.2 [No change]

49.3 to 49.6 [See pages 21 and 23, below]

Rule 76

Copy, Languages of Translation and Amounts of Fees
under Article 39(1); Translation of Priority Document

76.1 Notification

(a) [No change]

(a-bis) Any Contracting State not requiring the furnishing, under Article 39(1), by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau provided for, under Article 20, in Rule 47 has not taken place by the expiration of the time limit applicable under Article 39(1)) shall notify the International Bureau accordingly.

(a-ter) Any Contracting State which, pursuant to Article 39(3), maintains, if it is an elected State, the effect provided for in Article 11(3) even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under Article 39(1) shall notify the International Bureau accordingly.

(b) Any notification received by the International Bureau under paragraphs (a), (a-bis) or (a-ter) shall be promptly published by the International Bureau in the Gazette.

(c) [No change]

76.2 [No change]

76.3 to 76.7 [See pages 23 and 25, below]

IV. Making it unnecessary for the applicant to furnish translations of the request; and other improvements favoring the applicant in connection with the translation of claims where amendments to the claims have been filed during the international phase and in connection with any failure to translate statements explaining amendments or to translate certain microbiological indications

(Concerns Rules 49.3 to 49.6 and 76.3 to 76.7)

1. Ad Rule 49.3. The amendment proposed for Rule 49.3—namely, the inclusion of the words “subject to Rules 49.5 and 49.6”—is a consequence of the proposed inclusion of new Rules 49.5 and 49.6 (see paragraphs 4 to 11, below).
2. Ad Rule 49.4. Article 22(1) provides that a translation of the international application, “as prescribed” in the Regulations, may be required. It is proposed that a new Rule—Rule 49.4—specify the parts that have to be translated. Those would be all the parts of the international application except the request. Requiring translation of the request creates difficulties for the applicant where no version of the request form exists in the language of the translation. Even where such a version exists, it may not be easily at the disposal of the applicant. On the other hand, lack of translation of the request creates no difficulties for the designated Office since the request is required to consist of filling in a printed form (see Rule 3.1), since the printed form has a uniform content and layout in all languages (see Section 201 of the Administrative Instructions) and since the key words (names and addresses) if written in characters other than those of the Latin alphabet must also be indicated in characters of the Latin alphabet either as a mere transliteration or through translation into English (see Rule 4.16): the first two requirements allow the easy identification of the kind of indications concerned in the request, whereas the third requirement makes familiarity with alphabets other than the Latin alphabet unnecessary. The fact that the title of the invention appearing in the request would not be translated there would cause no difficulties since it is always translated as part of the description (see Rule 5.1(a)). By the way, several of the national Offices—those of Denmark, Finland, Hungary, Norway, Romania, the Soviet Union and Sweden—already do not require a translation of the request.
3. Practice has shown that the translation of words (“text matter”) appearing in a drawing requires also clarification. It is now proposed that Rule 49.4 clarify the manner in which the translation of such text matter may be furnished. It is recalled that Rule 11.11 requires that any words used in a drawing must be so placed that, if translated, they may be pasted over without interfering with any lines of the drawing. Consequently, it is proposed that Rule 49.4 provide that the translation of any text matter of a drawing may be furnished on a copy of the original drawing by pasting the translation on that copy. Furthermore, it is proposed that requiring the translation of the expression “Fig.” be excluded since the expression is commonly used and understood whatever the language of the application.
4. Ad Rule 49.5. The inclusion in the Regulations of a new Rule 49.5 is proposed to clarify what is to be translated if the applicant has filed with the International Bureau (under Article 19) amendments to the claims (paragraph (a)) and a statement explaining them (paragraph (b)). At present, the practice is not uniform. Some designated Offices (e.g., the Patent Offices of Australia, Denmark, Finland, Luxembourg, Sweden and the Soviet Union) require only a translation of the claims as amended whereas other designated Offices require a translation of both the claims appearing in the international application as filed (“original” claims) and the claims as amended. In order to simplify the procedure to be observed for entering the national phase and in order to allow the applicant to save the expense of two translations where only one is required (because the designated Office is satisfied with the translation of the claims as amended since the national (or regional) procedure only relates to the international application as amended (and not to the international application as filed)), the following is proposed: Although the applicant may furnish both translations, it will be enough—for entering the national phase—to furnish only the translation of the claims as amended. However, in the course of the national phase, the furnishing of the translation of the original claims may also be required but such requirement must be the subject of an express invitation.

Rule 49Copy, Languages of Translations and Amounts of FeesUnder Article 22(1) and (2)

49.1 and 49.2 [See page 17, above]

49.3 *Statements under Article 19; Indications under Rule 13bis.4*

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall, subject to Rules 49.5 and 49.6, be considered part of the international application.

49.4 *Contents of the Translation*

The translation of the international application shall contain the description, claims, text matter of drawings (if any) and the abstract. Any translation of the text matter of a drawing may be furnished on a copy of the original drawing by pasting the translation on such copy of the drawing; the expression “Fig.” does not require translation into any language.

49.5 *Translation of Amendments and Statements Made Under Article 19*

(a) If the applicant amended any claims under Article 19, the translation required under Article 22 may contain, at the option of the applicant, either the claims as appearing in the international application as filed (“original claims”) and the claims as amended, or only the claims as amended. If the translation furnished by the applicant contains only the claims as amended, the designated Office may invite the applicant to furnish a translation of the original claims, if it deems such translation to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation; the time limit shall not be less than 2 months from the date of the invitation. If the translation submitted by the applicant contains only the translation of the original claims, the designated Office shall take into account only those claims, unless later amendments are made under Article 28.

5. Allowing the designated Office to ask for the translation of the original claims is provided since such Office may find it useful to have also the translation of the claims to which the international search report relates in order to identify the extent to which the applicant has taken into account any reference cited in the said report. Furthermore, allowing the applicant to present—even if not invited to do so—also a translation of the claims as filed is provided since he might find it useful to show the difference from the amended claims.
6. The proposed procedure would be perfectly viable even in those cases where an amended claim is not supported by the description and would appear to go beyond the disclosure in the international application as filed but, in fact, does not do so because what seems to go beyond the said disclosure was contained in the original claim. Such cases should be very rare since, if the applicant has drafted his international application properly, the complete disclosure is given in the description. In those exceptional cases where that is not the case, the applicant has, under the proposed procedure, always the option to furnish a translation of the original claim, which permits him to prove that the amended claim does not go beyond the disclosure in the international application as filed. Where the applicant does not furnish such a translation, any designated Office could indicate to the applicant that it intends to disallow the amended claim. The applicant could then, by presenting a translation of the original claim, prove that the amendment does not go beyond the disclosure in the international application as filed. In any case, where the designated Office is of the opinion that it needs a translation of the original claim in addition to the translation of the amended claim, it may invite the applicant to furnish such translation, and it is only if the applicant does not furnish the translation in reply to the invitation that he may lose his rights.
7. Where the applicant has filed amendments but failed to furnish the required translation of the claims as amended while having furnished a translation of the original claims, he should not risk losing his rights. The amendments may then simply be disregarded or amendments of the same kind could be filed under Article 28 once national processing has started. These ideas find expression in the last sentence of proposed Rule 49.5(a).
8. As far as the statement explaining the amendments is concerned, the applicant should not be in jeopardy of being held not to have filed the required translation if he omits to file a translation of the statement. The fact that this minor defect in the translation may lead to the international application ceasing to have the effect provided for in Article 11(3) in the designated State with the same consequences as the withdrawal of a national application (see Article 24(1)(iii)) is out of proportion with the significance of the statement for the designated Office. In practice, it seems that the Offices probably exercise leniency with regard to the statement but the applicant should not be in the position of having to rely on leniency.
9. It is therefore proposed in paragraph (b) of the new Rule 49.5 that the designated Office will disregard any statement if not translated. Consequently, Article 24(1)(iii) would not apply in such a case.
10. [Ad Rule 49.6.](#) The inclusion in the Regulations of a new Rule 49.6 is proposed in order to take care of the special case of microbiological inventions under Rule 13*bis*. That Rule provides, *inter alia*, that, where a reference to a deposited microorganism appears in an international application, the applicant must furnish certain indications, in particular, the date of deposit and the accession number of the deposit. Under the present Regulations, failure to furnish a translation of those indications within the time limit applicable under Article 22 would lead to the applicant losing his rights in the designated State concerned, which seems to be an excessive sanction, particularly in view of the fact that some of those indications (e.g., those mentioned above) do not require translation.

[Rule 49.5, continued]

(b) Where the translation submitted by the applicant does not contain the translation of the statement which has* been filed by the applicant under Article 19(1), the designated Office shall disregard such statement.

49.6 *Translation of Indications Under Rule 13bis.4*

Where no translation of the indications furnished under Rule 13bis.4 is submitted to the designated Office, the latter shall, if it deems such translation to be necessary, invite the applicant to furnish a translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. The time limit shall not be less than 2months from the date of the invitation.

Rule 76

Copy, Languages of Translations and Amounts of Fees
Under Article 39(1); Translation of Priority Document

76.1 and 76.2 [See page 19, above]

76.3 *Statements Under Article 19; Indications Under Rule 13bis.4*

For the purposes of Article 39 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall, subject to Rules 76.6 and 76.7, be considered part of the international application.

76.4 [No change]

11. It is therefore proposed that failure of the applicant to furnish a translation of the indications furnished under Rule 13*bis*.4 should not automatically lead to a loss of rights but that, where the designated Office considers it necessary to have a translation of any such indication, the applicant be given an opportunity to furnish that translation. It is only where he does not comply with the invitation to furnish a translation that he may lose his rights.

12. [Ad Rules 76.3 to 76.7](#). The amendments proposed for Rule 76.3 to 76.7 are simply an extension to the procedure under Chapter II of what is proposed, in Rules 49.3 to 49.6, in respect of the procedure under Chapter I.

76.5 Contents of the Translation

The translation of the international application shall contain the description, claims, text matter of drawings (if any) and the abstract. Any translation of the text matter of a drawing may be furnished on a copy of the original drawing by pasting the translation on the drawing; the expression “Fig.” does not require translation into any language.

76.6 Translation of Amendments and Statements Made Under Article 19

(a) If the applicant amended any claims under Article 19, the translation required under Article 39(1) may contain, at the option of the applicant, either the claims as appearing in the international application as filed (“original claims”) and the claims as amended, or only the claims as amended. If the translation furnished by the applicant contains only the claims as amended, the elected Office may invite the applicant to furnish a translation of the original claims, if it deems such translation to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation; the time limit shall not be less than 2 months from the date of the invitation. If the translation submitted by the applicant contains only the translation of the original claims, the elected Office shall take into account only those claims, unless later amendments are made under Article 34(2)(b) and the prescribed translation thereof is furnished by the applicant or unless later amendments are made under Article 41.

(b) Where the translation submitted by the applicant does not contain the translation of the statement which has been filed by the applicant under Article 19(1), the elected Office shall disregard such statement.

76.7 Translation of Indications Under Rule 13bis.4

Where no translation of the indications furnished under Rule 13bis.4 is submitted to the elected Office, the latter shall, if it deems such translation to be necessary, invite the applicant to furnish a translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. The time limit shall not be less than 2 months from the date of the invitation.

V. Making it clear that certain requirements for entering the national phase are not allowed under the PCT
(Concerns new Rule 51*bis*)

1. The provisions of Articles 22(1) and 39(1)(a) list exhaustively the acts that must be performed as a condition of entering the national phase, as was pointed out by the International Bureau in its document PCT/A/V/6 which it presented to the PCT Assembly at its fifth session held from June 9 to 16, 1980 (see Part II of the said document, headed “Questions Concerning the National Phase”). That the said list is exhaustive follows also from Article 24(1)(iii) and Article 39(2) which cite only the acts referred to in Articles 22(1) and 39(1)(a) as acts whose non-performance may result in the effect of the international application ceasing in the designated or elected States (“may” because Articles 24(2) and 39(3) enable the designated or elected Office to maintain the effect notwithstanding such non-performance).
2. The applicant who files an international application is entitled to expect—especially having regard to the provisions of Articles 24(1)(iii) and 39(2)—that nothing more is required of him prior to the time limit applicable under Article 22 or Article 39(1) than to pay the national fee and provide any necessary translation of his application, and that he will not lose his rights if he complies with these two conditions.
3. Besides, Article 27(1) expressly excludes any requirement relating to the form or contents of the international application different from or additional to those which are laid down in the Treaty and the Regulations, be it during the so-called international phase or once national processing of the international application has started (national phase).
4. The International Bureau has learned—from its discussions with the national Offices in connection with its publication of Volume II of the PCT Applicant’s Guide (which deals with the procedure before them as designated and elected Offices) and from letters it receives from users of the PCT—that some designated or elected Offices ask, for allowing the entering of the national phase, for compliance with conditions additional to those permitted by the PCT and the Regulations.
5. Such possible excess requirements for entering the national phase (to the extent that they are known) include the following:
 - (i) Use of a special national form for entering the national phase.
 - (ii) Presentation of drawings other than a copy of the drawings included in the international application as communicated under Article 20, in particular the presentation of drawings executed anew. (Article 22(1) or Article 39(1)(a) requires only the furnishing of a translation of the international application but not the furnishing of drawings. It should be noted in this context that the required translation may include a translation of any text matter of the drawings, but this may be done by using a copy of the original drawings as proposed above in new Rules 49.4 and 76.5, and the applicant should not be obliged in such a case to present drawings executed anew.)
 - (iii) Presentation of several copies of documents (instead of one, as prescribed under Article 22(1) or Article 39(1)(a)).
 - (iv) Certification of the translation of the international application.
6. All four of the above requirements—the use of a special form, the presentation of additional drawings, the presentation of several copies of a document (instead of one)* as well as the certification of any translation (that is, a translation made by a sworn translator)—are certainly formal requirements, and thus are at variance with Article 27(1), which admits no requirements relating to the form of the international application different from or additional to those which are laid down in the Treaty and the Regulations.

* An exception, however, is proposed to be allowed where the applicant seeks two kinds of protection under Article 44. The exception is to be admitted because, in such a case, the international application can be considered as a double application. The exception, however, would be covered by the proposed new Rule 51*ter.1*(iv) (see the explanations relating thereto in Chapter VI, paragraph 2(iv), below).

Rule 51bis (New)

National Requirements Excluded Under Article 27(1)

51bis.1 Requirements Excluded

The requirements referred to in Article 27(1) as being different from or additional to those provided for in the Treaty and the Regulations shall, in particular, include the following:

- (i) any requirement that the applicant use a national form in connection with performing any of the acts referred to in Articles 22 and 39(1),
- (ii) any requirement that the applicant present drawings other than a copy of the drawings included in the international application as communicated under Article 20, in particular any requirement that the drawings be executed anew,
- (iii) any requirement that the international application, its translation or any document relating thereto be presented in more than one copy, without prejudice to Rule 51ter.I(iv),
- (iv) any requirement that the translation furnished under Article 22 or Article 39(1) be certified, without prejudice to Rule 51ter”l(ii).

7. It is therefore proposed that such requirements should be expressly negated in what would be a new Rule, namely Rule 51*bis*.

8. It is to be noted that it follows from the words “in particular” and “include” used in the introductory part of the proposed Rule 51*bis*.1 that there may be practices other than those listed in items (i) to (iv) that are contrary to the Treaty and the Regulations. Should the International Bureau, in the future, learn about any such additional practice, it will propose its express mentioning in the Rule in question.

VI. Making it clear that certain requirements to be complied with during the national phase must be complied with by the applicant only after entering the national phase and after being invited to comply
(Concerns new Rule 51*ter*)

1. The exhaustive listing of the acts that must be performed as a condition for entering the national phase (see Chapter V, paragraph 1, above) precludes requiring compliance, for entry into the national phase, with any other requirements even if otherwise they do not appear to be at variance with the Treaty. Compliance with such other requirements can only be required once the national processing has started—that is, during the national phase and not before, or at the moment of entering the national phase—(see Article 27(2) and (7)).

2. The following are requirements which some of the designated (elected) Offices try—although they should not do so—to impose at, rather than only after, entering the national phase:

- (i) representation by a local agent and/or indication of an address for service,^{*}
- (ii) furnishing of:
 - a document relating to the identity of the inventor;
 - deeds of transfer or assignment of the right to file the application;
 - a document relating to an oath or declaration by the inventor alleging his inventorship;
 - a document relating to the declaration by the applicant designating the inventor or alleging the right to file the application;
 - proof of the right of the applicant to claim priority where the earlier application was filed by another applicant;
 - a statement or evidence concerning non-prejudicial disclosures or exceptions to lack of novelty^{**};
 - a verification, by the applicant or the translator, of the translation forwarded under Article 22 or Article 39(1)^{***};

* Naturally, representation may be required once national processing has started; moreover, it is desirable that the applicant be represented before the designated (elected) Office even where he is not required to be represented.

** What is meant to be covered here are, for example, the provisions of the European Patent Convention and of the national laws of several European countries under which, for the purposes of evaluating the novelty of the invention, a disclosure of the invention is not taken into consideration if it occurred within six months before the filing date of the application and was due to, or in consequence of, an evident abuse in relation to the applicant or his legal predecessor, or the fact that the applicant or his legal predecessor has displayed the invention at certain exhibitions. Also meant to be covered are provisions such as those of the national law of Japan, under which a disclosure of the invention by the person having the right to obtain a patent does not affect the patentability of the invention if such person files a patent application within six months from the said disclosure. Under those two kinds of provisions, the applicant wishing to avail himself of them must, at least in most cases, furnish a statement to that effect at the time of filing the patent application and, later on, evidence of the veracity of the statement. Both the statement and the evidence would be covered by the proposed new Rule 51*ter*. In other words, the applicant would not lose the possibility to take advantage of the provisions in question if he did not furnish the statement and the evidence before or at the time of entering into the national phase

*** Verification of a translation means a statement by the applicant or by the translator that, to the best of his knowledge, the translation is complete and faithful. The verification of a translation as distinguished from the certification of a translation may be considered as proof under Article 27(2)(ii) of the faithfulness and completeness of the translation, whereas a certification would constitute an additional formal requirement not permitted under Article 27(1) and therefore included under Rule 51*bis*.

Rule 51ter (New)

National Requirements Allowed

Under Article 27(2), (6) and (7)

51ter.1 Requirements Allowed

Where the national law applicable by the designated Office requires that

(i) the applicant be represented by an agent having the right to represent applicants before that Office and/or that the applicant have an address in the designated State for the purpose of receiving notifications (see Article 27(7)),

(ii) documents referred to in Article 27(2)(ii) or evidence referred to in Article 27(6) be furnished by the applicant, including in particular documents relating to or containing:

- the identity of the inventor,
- any transfer or assignment of the right to file the application,
- an oath or declaration by the inventor alleging his inventorship,
- a declaration by the applicant designating the inventor or alleging the right to file the application,
- any proof of the right of the applicant to claim priority where he is different from the applicant having filed the earlier application the priority of which is claimed,
- any statement or evidence concerning non-pre judicial disclosures or exceptions to lack of novelty, such as abusive disclosures, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time,
- any verification, by the applicant or the translator, of the translation furnished under Article 22 or Article 39(1),

(iii) where the applicant is represented by an agent, furnishing of a document appointing the agent;

(iv) more than one copy of the international application or its translation, where the applicant is seeking two kinds of protection.*

3. It should be noted that compliance with these conditions may be required out only after entering the national phase.

4. The purpose of the proposed new Rule 51*ter* is to give full effect to the advantage of a uniform procedure under the PCT. No applicant should be at risk of losing his rights for reasons of non-compliance with any of the above-mentioned requirements without having been given an opportunity by the designated (elected) Office to remedy the omission of the required act. In practice, as can be seen in Volume II of the PCT Applicant's Guide (which deals with the procedure before the designated and elected Offices), all national Offices—except those of Australia, Austria, Japan, the United Kingdom and the United States of America—already apply what is proposed under the new Rule 51*ter*, namely, that where any of the said requirements exist, non-compliance with them may lead to loss of rights only after the applicant has been given an opportunity to remedy the omission of the required act. This opportunity is given to the applicant through the invitation provided for in the new Rule.

5. The Rule, as proposed, lists those requirements of which the International Bureau has knowledge at the present time. Should, in the future, additional requirements of the kind come to the attention of the International Bureau, that Bureau will propose mentioning them expressly in Rule 51*ter*. The fact that any such requirement is not expressly mentioned in the Regulations does not make it legitimate since what makes it illegitimate are the provisions of the Treaty referred to in paragraph 1, above. In order to express this thought in the text of the Regulations itself, one could insert, in the proposed Rule, after the words “any of these requirements,” the following words: “as well as any other requirement of the national law permitted to be applied by the designated Office under the Treaty.”

*

Where an applicant is seeking in his international application pursuant to Article 44 at the same time two kinds of protection, the furnishing to the designated (elected) Office of one copy of the international application or its translation is required for each of the two kinds of protection.

[Rule 51ter.1, continued]

(iii) the agent, if any, representing the applicant be duly appointed by the applicant,

(iv) the international application, its translation or any document relating thereto be presented in more than one copy if the applicant is seeking two kinds of protection under Article 44,

and any of these requirements is not already fulfilled during the same period within which the requirements under Article 22 or Article 39(1) must be complied with, the designated Office shall invite, in writing, the applicant to comply with the requirement within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. The time limit shall not be less than two months from the date of the invitation.

VII. Giving more time to the applicant for filing, during the international phase, amendments to the claims in certain cases, and making it possible to file, during the international phase, amendments to the claims not only with the International Bureau but also with the receiving Office or the International Searching Authority
(Concerns Rules 46.1 and 48.2)

1. Ad Rule 46.1. It is proposed to amend Rule 46.1 in two respects: firstly, as regards the time limit for filing amendments to the claims under Article 19 and, secondly, as regards the authority with which such amendments must be filed.
2. On the first point, the present text of Rule 46.1 provides for a time limit which is two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or, when such transmittal takes place before (the expiration of 14 months from the priority date (for the definition of “priority date” see Article 2(xi)), three months from the date of such transmittal. The three-month time limit is applicable in all those cases where the international application has been filed early in the priority year or does not claim the priority of an earlier application. If, for example, the international search report is transmitted to the applicant 10 months after the priority date (which is the international filing date if no priority of an earlier application is claimed), the time limit presently applicable ((for filing amendments under Article 19) is 13 months from that date. One does not see, however, why the applicant should not be given more time for filing amendments, since what is important in such a case is that the amendments reach the International Bureau early enough to permit their publication together with the international publication of the international application. If they reach the International Bureau before the expiration of 16 months after the date in question, it is sufficient.
3. Consequently, it is proposed to replace the present time limit (three months from the transmittal of the international search report) by a time limit of 16 months from the priority date. The two-month time limit from the transmittal of the international search report would continue to apply whenever it expires later than 16 months from the priority date (that is, whenever the international search report is transmitted after the expiration of 14 months from the priority date; this is necessarily the case where the C international application claims the priority of an earlier application and has been filed at the end of the priority year).
4. As far as the second point is concerned (the authority with which any amendments to the claims must be filed under Article 19), the present text of Rule 46 is silent, but it follows from Article 19 that such amendments must be filed with the International Bureau. However, experience shows that sometimes applicants file amendments with the receiving Office or with the International Searching Authority instead. Such amendments are then usually transmitted by the receiving Office or the International Searching Authority to the International Bureau, so that, eventually, they are filed with the International Bureau, albeit indirectly. In such cases, it can happen that the International Bureau does not receive the amendments, as transmitted by the Office or Authority, until after the expiration of the time limit under Rule 46.1, although the amendments had been filed within that time limit with the L receiving Office or the International Searching Authority.
5. It is proposed to add a sentence to Rule 46.1 to the effect that filing amendments through the receiving Office or International Searching Authority would be expressly permitted and that the date of receipt of amendments by either of them would be considered as the date of receipt by the International Bureau, provided that the International Bureau actually received them from that Office or Authority not later than 14 days after the expiration of the time limit for amending the claims under Article 19, since it is desirable that any amendment be received by the International Bureau prior to the termination of technical preparations for international publication. If the amendments reach the International Bureau after the said 14 days, the applicant does not lose any rights since he can always make amendments under Article 28 during the national phase and, if Chapter II is applicable, before the International Preliminary Examining Authority.

Rule 46Amendment of Claims Before the International Bureau46.1 Time Limit

The time limit referred to in Article 19 shall be 2 months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever is later. Any amendment made under Article 19 and filed within the time limit referred to in the preceding sentence with the receiving Office or the International Searching Authority shall be considered to have been filed within that time limit with the International Bureau, provided it is transmitted by that Office or Authority to the International Bureau with an indication of the date on which it was received by the said Office or Authority and provided it is received by the International Bureau not later than 14 days after the expiration of the said time limit. In such a case, the date of filing of the amendment shall be the date on which the amendment was received by the said Office or Authority.

46.2 [No change]

46.3 [See document PCT/CAL/I/3]

46.4 and 46.5 [No change]

6. Naturally, one could argue that the possibility of filing amendments under Article 19 with an authority other than the International Bureau goes against the wording of Article 19. However, amendments submitted by the applicant to the receiving Office or the International Searching Authority and transmitted to the International Bureau under the proposed system can, in the spirit of Article 19, be considered to have been filed with the International Bureau, the receiving Office or the International Searching Authority having, in such a case, merely an intermediary function.

7. [Ad Rule 48.2](#). Rule 48.2(f), last sentence, provides that the date of receipt of the amended claims by the International Bureau is indicated in the pamphlet. In the case where the amendments are actually received by the receiving Office or the International Searching Authority and then transmitted to the International Bureau, the date to be indicated in the pamphlet should be the date on which the amendments have been received by the receiving Office or the International Searching Authority. In order to achieve that result, it is proposed to make a reference, in the last sentence of Rule 48.2(f), to “the date recorded under Rule 46.2.” Since the International Bureau is to record under Rule 46.2 the “date of filing of any amendment,” it is understood that the International Bureau would record, in the case under consideration, the date on which the amendments have been received by the receiving Office or the International Searching Authority rather than the date on which the amendments have reached the International Bureau.

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) [No change]

(b) [see document PCT/CAL/I/4]

(c) to (e) [No change]

(f) If the claims have been amended under Article 19, the publication shall contain either the full text of the claims both as filed and as amended or the full text of the claims as filed and specify the amendments. Any statement referred to in Article 19(1) shall be included as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4. The date recorded under Rule 46.2 shall be indicated in the publication.

(g) and (h) [See document PCT/CAL/I/4]

(i) [No change]

48.3 [See document PCT/CAL/I/4]

48.4 and 48.5 [No change]

48.6 [See document PCT/CAL/I/4]

[End of document]