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

SECOND OF THREE PREPARATORY MEMORANDA OF THE INTERNATIONAL
BUREAU

INTRODUCTION

1. The present document is the [second](#) of three documents prepared by the International Bureau within the framework of its study of possible improvements to the Patent Cooperation Treaty (PCT). The third document is scheduled to be published later in July 1982.
2. The introduction contained in the first document (PCT/CAL/I/2) applies also to the present document.

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EXPLANATIONS OF THE PROPOSED AMENDMENTS

VIII. Making it possible to use, in respect of any designated State, a manner of claiming of dependent claims conform to the national law of that State even when that manner of claiming is different from the manner of claiming prescribed by the PCT Regulations

(Concerns Rule 6.4)

1. Rule 6.3 defines, in paragraph (b), the basic requirements for the manner of claiming and provides, in paragraph (c), that the failure to use that manner of claiming has no effect in any designated State where the national law of that State does not require such manner of claiming. This provision, however, is presently not applicable to the special case referred to in Rule 6.4(a), second and third sentences, namely, that a dependent claim which refers to more than one other claim (“multiple dependent claim”) must refer to such claims in the alternative only and cannot serve as a basis for any other multiple dependent claim.

2. The national laws of several States party to the PCT and the European Patent Convention (EPC) allow, with respect to multiple dependent claims, a manner of claiming which is more liberal than the one permitted under Rule 6.4(a). In particular, they allow reference to other claims in cumulation and the use of multiple dependent claims as a basis for any other such claim. Where such is the case, the strict enforcement of the provision of Rule 6.4(a) has, for example, the effect that, if the international application claims the priority of an earlier national (or EPC) application containing a manner of claiming consistent with that—more liberal—required by the national laws (or the EPC) of all designated States (or the EPC), the claims would still have to be redrafted, for the purposes of the international application, in order to conform with the stricter rules of the PCT Regulations, namely with present Rule 6.4(a). Furthermore, where Chapter II applies and where the European Patent Office is, at the same time, International Preliminary Examining Authority and the only elected Office, it must, as International Preliminary Examining Authority, inform the applicant of non-compliance with Rule 6.4(a) if the claims have not been drafted in accordance with that Rule although it would, as elected Office, allow such manner of claiming. Moreover, it is not always understood why failure to comply with the basic requirements provided for in Rule 6.3(b) should have no effect in certain designated States whereas failure to comply with the special requirements under Rule 6.4(a) could not be disregarded by those States.

3. Consequently, it is proposed to amend Rule 6.4(a) by adding a further sentence (along the lines of Rule 6.3(c)), to the effect that, where the national law of the designated State does not require the manner of claiming provided for in the foregoing sentences, failure to use that manner of claiming has no effect in that State, provided the manner of claiming actually used satisfies the national law of the said State.

4. It should be noted that, where the national law of a designated State requires a manner of claiming as provided in present Rule 6.4(a), the international application has to use that manner of claiming or the claims will, in the national phase before the Office of that State, have to be amended in order to comply with the requirements of the present Rule 6.4(a).

TEXT OF THE PROPOSED AMENDMENTS

Rule 6

The Claims

6.1 to 6.3 [no change]

6.4 Dependent Claims

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

(b) and (c) [No change]

6.5 [no change]

IX. Making it possible to correct the defect consisting of filing papers purporting to be an international application in a language that is not admitted and/or with an office which is not competent to receive it

(Concerns Rules 12.3, 19.1 and 20.1)

1. Ad Rule 12.3. Under Article 11(1)(ii), the receiving Office shall accord the international filing date if the international application is—among other things—in the prescribed language. According to present Rule 12.1, the prescribed language is the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of the international application. (If the agreement specifies several languages, the receiving Office may prescribe, among those languages, the language(s) in which any international application filed with it must be.)
2. Experience has shown that applicants sometimes use a language other than that language (or one of those languages) specified in the said agreement or prescribed by the receiving Office (the “admitted” language(s)). Applicants of Contracting States having a national language which is not admitted under the present Rule (a “non-admitted” language) have expressed interest in being allowed to validly file an international application in their national language and obtain an international filing date even if the international application has been filed in that (non-admitted) language. Such possibility, for such applicants, would be of particular importance in cases where the priority of an earlier national application is intended to be claimed but where there is not enough time before the expiration of the priority year to prepare a translation into the (or an) admitted language.
3. It is therefore proposed to amend the present text of Rule 12 by allowing—under certain conditions—the filing of international applications in any non-admitted language. The proposed amendment would consist of a new Rule 12.3 and would provide that an applicant who files papers purporting to be an international application in a non-admitted language would receive from the receiving Office with which such application was filed an invitation to submit a translation of the application in an admitted language; such translation would have to be filed within two months from the invitation or 13 months from the priority date, whichever expires first; the translation would have to be verified by the applicant that it is complete and faithful; where the applicant complies with the invitation, the translation filed by him would be considered to be the international application and would be accorded as its international filing date the date on which the papers in the non-admitted language have been received by the receiving Office.
4. Under Rule 22.1(a), the record copy, which—in the given case—is a copy of the translation filed under Rule 12.3, must be transmitted to the International Bureau in time to reach the International Bureau by the expiration of the 13th month from the priority date. The timely transmittal of the record copy will not be possible where the 13-month time limit under Rule 12.3(b) applies but the record copy should, in such a case, reach the International Bureau before the expiration of 14 months from the priority date, which would, in those exceptional cases, not affect the usual procedure and have no legal consequences under Rule 22.3. A copy of the papers in the non-admitted language as originally filed would accompany the record copy and would be kept in the files of the International Bureau if evidence is needed later of what has been disclosed in those papers on the day which is considered to be the international filing date.

Rule 12

Language of the International Application

12.1 Admitted Languages

[no change in the text of this Rule]

12.2 [see page 25, below]

12.3 Filing in a Non-admitted Language

(a) Where papers purporting to be an international application have been filed in a language other than a language admitted under Rule 12.1 (“papers in the non-admitted language”), the receiving Office shall promptly invite the applicant to submit a translation in a language admitted under Rule 12.1.

(b) The translation shall be submitted not later than at the expiration of 2 months from the date of the invitation or 13 months from the priority date, whichever period expires first.

(c) The translation shall contain a statement that, to the best of the applicant’s knowledge, it is complete and faithful. This statement shall be signed by the applicant.

(d) Any translation submitted under this Rule shall be considered to be the international application, and such international application shall be considered as having been received by the receiving Office on the date on which the papers in the non-admitted language have been received by the receiving Office.

5. [Ad Rule 19.1](#). Under present Rule 19.1(a) international applications must be filed, at the option of the applicant, with the national Office of (or acting for) the Contracting State of which the applicant is a resident or of which he is a national. Where a Contracting State so agreed with another Contracting State or an intergovernmental organization, residents and nationals of the former State may file international applications with the national Office of the latter State or with the intergovernmental organization (Rule 19.1(b)). An international filing date shall be accorded under Article 11 only if the international application has been filed with the [competent](#) receiving Office (see Article 11(1)(i)).
6. It has happened that international applications were erroneously filed with a national Office which was not competent under Rule 19.1 and the desire has been expressed by applicants that the Regulations should provide for some procedure for the transmittal of papers purporting to be an international application, without affecting the date of filing of the said papers, to an Office competent under the present Rule 19.1.
7. It is therefore proposed that Rule 19.1 be amended by adding an additional paragraph (paragraph (d)), which would apply where the applicant attempts to file an international application with an Office which is not the [competent](#) receiving Office under Rule 19.1. Such Office (“the incorrectly chosen Office”) would have to promptly inform the applicant of the fact that it is not competent for receiving the application in question and invite him to request the transmittal of the papers to another Office to be indicated by the applicant (in other words, it is not the incorrectly chosen Office which indicates to the applicant which Office is the competent one, but it is the responsibility of the applicant to indicate to which Office the papers should be transmitted). Where the incorrectly chosen Office charges a transmittal fee under Rule 14 (which is presently the case of all receiving Offices), the applicant would be invited at the same time to pay that fee unless he has already paid it when filing the papers. The incorrectly chosen Office would be entitled to a transmittal fee in order to receive compensation for its work, which consists of checking the papers, mailing the invitation to the applicant and, where the applicant so requests, of transmitting the papers to the competent Office. The latter Office would, of course, have the right to charge its own transmittal fee under Rule 14. In order to make sure that the applicant does not fail to pay the transmittal fee to both Offices (which at the same time serves the purpose of avoiding an abuse of the possibility provided for under the new procedure), he would be told that he must also pay a transmittal fee to the Office to which he requests the papers to be transmitted.
8. The applicant would then have 14 days in which to comply with the invitation. This time limit is rather short, but such shortness is necessary in view of the general time frame and is justified since the time limit would apply only in very rare cases. Where the applicant does not, within the 14-day time limit, indicate an Office, does not request transmittal of the papers to that Office or does not pay the required transmittal fee to the incorrectly chosen Office, the latter Office would notify him that his papers are not and will not be treated as an international application, would keep the papers and the correspondence relating thereto and would send a copy of the said papers to the International Bureau if the latter asks for it for the purposes of the review procedure under Article 25 (see Rule 20.7(1), (iii) and (iv)).
9. If the applicant complies with the invitation within the 14-day time limit, the incorrectly chosen Office would mark on the papers it receives the date on which it actually received them and would transmit them to the Office indicated by the applicant (which, naturally, should be [the](#) competent receiving Office).

[Rule 12.3, continued]

(e) The papers in the non-admitted language shall be transmitted to the International Bureau together with the record copy transmitted under Rule 22.1(a).

(f) Where the time limit applicable under paragraph (b) expires later than 12 months after the priority date, the time limit within which the record copy must have reached the International Bureau shall, notwithstanding Rule 22.1(a), be 14 months from the priority date.

Rule 19

The Competent Receiving Office

19.1 Where to File

(a) Subject to paragraphs (b) and (d), the international application shall be filed, at the option of the applicant, with the national Office of or acting for the Contracting State of which the applicant is a resident or with the national Office of or acting for the Contracting State of which the applicant is a national.

(b) and (c) [No change]

10. [Ad Rule 20.1](#). Rule 20.1 prescribes the procedure for the dating and numbering of papers purporting to be an international application. The proposed amendments to Rule 20.1 are consequential to the proposed amendments to Rules 12 and 19, referred to above. In cases where Rule 19.1(d), third sentence, applies, the incorrectly chosen Office would have marked the date of actual receipt by it (see the preceding paragraph) and the proposed new Rule 20.1(c) would provide that the competent receiving Office will only assign the international application number (without marking the date on which it actually received the papers) since the date of actual receipt by the incorrectly chosen Office will be considered by the competent receiving Office as the date on which it received the application (see Rule 19.1(d), fourth sentence). In cases where Rule 12.3 applies (filing in a non-admitted language), the proposed new Rule 20.1(d) would provide that the receiving Office will mark on the papers filed in the non-admitted language the date on which it actually received them, since that date will eventually be the international filing date once the translation has been timely filed and complies with Article 11. Rule 20.1(d) would also cover the case where the applicant filed his papers both with an incorrectly chosen Office and in a non-admitted language ([vis-a-vis](#) the competent receiving Office): in such a case, and provided the applicant complies with the requirements of both Rules 19.1(d) and 12.3, the date to be marked on the papers is the date on which they have actually been received in the non-admitted language by the incorrectly chosen Office, and it is that date which will eventually be the international filing date once the translation has been timely filed and complies with Article 11.

[Rule 19.1, continued]

(d) Where papers purporting to be an international application have been filed with an Office which is not competent under paragraphs (a), (b) or (c) but which, for other international applications, may act as a receiving Office, such Office (“the incorrectly chosen Office”) shall promptly inform the applicant of that fact and invite him to pay to it, unless already received by it, the transmittal fee fixed by it under Rule 14 and to request the transmittal of the said papers to another Office to be indicated by the applicant. The invitation shall remind the applicant that he has to pay a transmittal fee to the competent receiving Office as well. Where the applicant complies with the invitation within 14 days from the date of the invitation, the incorrectly chosen Office shall proceed as provided for in Rule 20.1(c) and shall promptly transmit the said papers to the Office indicated by the applicant. In such case, the latter Office shall consider the said papers as received on the date on which they were received by the incorrectly chosen Office. Where the applicant does not comply with the invitation within 14 days from the date of the invitation, the incorrectly chosen Office shall proceed as provided for in Rule 20.7(i), (iii) and (iv).

19.2 and 19.3 [no change]

Rule 20

Receipt of International Application

20.1 Date and Number

(a) Upon receipt of papers purporting to be an international application, the receiving Office shall, subject to paragraphs (c) and (d), indelibly mark the date of actual receipt in the space provided for that purpose in the request form of each copy received and one of the numbers assigned by the International Bureau to that Office on each sheet of each copy received.

(b) [No change]

(c) Where Rule 19.1(d), third sentence, applies, the date of actual receipt shall be marked, as provided in paragraph (a), by the incorrectly chosen Office, and the assigned number shall be marked, as provided in paragraph (a), by the Office to which the incorrectly chosen Office has transmitted the papers purporting to be an international application.

(d) Where Rule 12.3 applies, the receiving Office shall mark, as the date of actual receipt of the international application, the date on which the papers in the non-admitted language have been actually received by it or, where Rule 19.1(d) also applies, by the incorrectly chosen Office.

20.2 to 20.4 [no change]

20.5 [see document PCT/CAL/I/2, page 5]

20.6 to 20.9 [no change]

X. Allowing the extension of time limits fixed by the receiving Office and obliging that Office to excuse trivial errors whose correction it asked for but whose correction it did not receive

(Concerns Rules 26.2 and 26.5)

1. It is essential for the acceptance and the functioning of the PCT system that the risk of loss of rights for failure to meet certain time limits should be truly minimal.

2. Ad Rule 26.2. The present Rule prescribes that the time limit (for the correction of defects of the international application) referred to in Article 14(1)(b) must be reasonable under the circumstances of the particular case and must be fixed in each case by the receiving Office. The minimum time limit is one month from the date of the invitation to correct. A maximum time limit is not fixed in the Rule; however, it is provided that the time limit should normally not be more than two months. Neither the possibility for the applicant to request an extension of the time limit fixed by the receiving Office nor the possibility for that Office to grant such an extension is provided for in the present text of Rule 26.2. Experience shows that the time limit fixed by the receiving Office is sometimes too short: had a longer time limit been fixed, or had the time limit been extended, the applicant would have been able to submit the correction in time. Therefore, it would be appropriate to allow the applicant, where he is not able to submit the required correction in time, to request an extension of the time limit fixed in the invitation to correct. Such extension would, naturally, be subject to the general rule for fixing such time limit, namely it would have to be reasonable under the circumstances (see present Rule 26.2, first sentence).

3. It may also happen that a correction submitted by the applicant is received only after the expiration of the fixed time limit. In the most frequent case of this kind, the correction is received a few days, or even one day, after the expiration of the time limit. Such a delay could generally be excused without affecting the processing of the international application. It should be excusable even if the applicant did not ask for an extension of the time limit because he thought that his correction would reach the receiving Office in time. Requiring the applicant to request in such a case that the delay be excused would constitute an unnecessary administrative burden for both the applicant and the receiving Office. Naturally, any applicant who realizes, when submitting a correction, that it cannot reach the receiving Office prior to the expiration of the time limit for correction may request, at the same time as he submits his correction, that the delay be excused. If he did not make such a request but is notified by the receiving Office that he missed the time limit and that the international application is declared withdrawn, the applicant could still, then, request that the delay be excused. If the receiving Office deems such excuse to be justified under the circumstances, the delay should be excused and the processing of the international application should continue.

4. It is therefore proposed to amend Rule 26.2 by adding to the existing text (which would become paragraph (a)) a new paragraph (b) allowing the applicant to request an extension of the time limit for submitting the requested correction or, where the time limit has already expired, providing for a possibility to excuse the delay either *ex officio* or on the request of the applicant. Furthermore, it is proposed to delete the present “normal” maximum time limit of two months, which has the character of a guideline rather than of a legal rule and which, in any case, would not make much sense once extension of the time limit and excusing possible delays are introduced in Rule 26.2.

Rule 26

Checking By, and Correcting Before, the Receiving Office of
Certain Elements of the International Application

26.1 [no change]

26.2 Time limit for Correction

(a) The time limit referred to in Article 14(1)(b) shall be reasonable under the circumstances and shall be fixed in each case by the receiving Office. It shall not be less than 1 month from the date of the invitation to correct.

(b) The time limit fixed by the receiving Office may, on the request of the applicant, be extended by that Office or, if the correction is received after the expiration of the time limit fixed by the receiving Office, such delay may, on the request of the applicant or even without such a request, be excused by that Office.

26.3 [no change]

26.4 [see document PCT/CAL/I/4]

26.5 Correction of Certain Elements

(a) Without prejudice to Rule 26.2(b), the receiving Office shall decide whether the applicant has submitted the correction within the prescribed time limit. If the correction has been submitted within the prescribed time limit, the receiving Office shall decide whether the international application so corrected is or is not to be considered withdrawn. Even where the correction has not been made or seems to be insufficient, the receiving Office shall not consider the international application withdrawn where, in view of the nature of the defect, considering the international application withdrawn would constitute an excessive consequence.

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

26.6 [no change]

5. [Ad Rule 26.5](#). It follows from present Rule 26.1(a) that the receiving Office must check whether the international application complies with the requirements prescribed by or under Article 14(1)(a). Any corresponding defect may be serious or less serious. A typical example of a less serious defect would be a somewhat less than total compliance with a physical requirement (see Rule 11). Some receiving Offices seem to have the practice, when they invite the applicant to correct defects under Article 14(1)(a), to mention all the defects—whether serious or less serious—detected in the international application and to notify the applicant that the international application will be considered withdrawn should he fail to correct [all](#) the defects within the time limit fixed for that purpose in the invitation. If the applicant then fails to correct one or several minor (less serious) defects among all the defects referred to in the invitation, the receiving Office might find itself in a dilemma. Under strict application of the Rules, the international application should be considered withdrawn but such withdrawal would appear to be a legal consequence which is out of proportion in view of the nature of the defect. The present Rule 26.5 has therefore been interpreted by several Offices and in various cases in a way allowing to disregard failure to correct a minor (less serious) defect and to continue the processing of the international application.

6. The amendment proposed for Rule 26. 5(a) gives effect to this—reasonable—interpretation by making it clear that a declaration considering the international application withdrawn could not be made where the nature of the defect is such that loss of the application would be an excessive legal consequence. The proposed amendment would increase the applicants' confidence in the PCT system. (The cross-reference to Rule 26.2(b) is inserted at the beginning of Rule 26.5(a) to reserve the possibility of an extension of the time limit fixed by the receiving Office for correcting the defects detected in the international application or of an excuse of the delay if the correction is received after the time limit fixed by the receiving Office; see paragraphs 2 to 4, above.)

XI. Making it possible for the applicant to state more in his explanations of amendments of claims filed with the International Bureau
(Concerns Rule 46.4)

1. Under Article 19(1), the applicant may amend the claims before the International Bureau and file, at the same time, a brief statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings. Details concerning the statement are provided for in Rule 46.4. The statement is to be distinguished from the letter which is required under Rule 46.5 either in order to explain the differences between the replacement sheets (on which the amendments are submitted) and the replaced sheets or in order to cancel entire sheets. The statement must, under the present Rule 46.4(b), contain no comments on the international search report or the relevance of the citations contained in that report but it may refer to a citation (appearing in the said report) in order to indicate that a specific amendment of a claim is intended to avoid the cited document. The statement will not be published by the International Bureau if the latter finds that it does not comply with the provisions of Rule 46.4 (see Rule 48.2(h)).
2. Ad Rule 46.4(a). The International Bureau has encountered difficulties in determining in papers received from the applicant what is meant by him to be a statement under Article 19(1) and what is to be taken as a letter explaining the differences between replaced and replacement sheets or cancelling an entire sheet. Yet the correct determination is important since: (i) the statement is, whereas the explanatory letter is not, to be published and (ii) any statement published and communicated to the designated Offices is considered to be part of the international application (see Rules 49.3 and 76.3) and must be translated under Article 22(1) or Article 39(1)(a) whereas the contrary is true for any explanatory letter. If the explanatory letter is taken by the international Bureau to be a statement but was not meant as such by the applicant, there is a risk that the applicant will fail to prepare the prescribed translation for the designated Offices and thus furnishes an incomplete translation. On the other hand, it can also happen that what is taken by the International Bureau as an explanatory letter was meant by the applicant to be a statement under Article 19 and therefore would neither be published nor communicated to the designated Offices.
3. It is proposed to eliminate the risk of such a confusion by adding to Rule 46.4(a) an additional sentence that would require that any statement under Article 19(1) must—by the applicant—be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement. It would follow from this rule that if a text is not so identified by the applicant, the International Bureau would consider it as an explanatory letter which, because it is a mere letter and not an explanatory statement, is neither published nor communicated to the designated Offices. The applicant would then also know that only what was meant to be a statement and has been identified as such by him through the said heading will have to be included in the translation to be furnished under Article 22(1) or Article 39(1)(a).
4. Ad Rule 46.4(b). The checking of compliance of a statement with the provisions of the existing Rule 46.4(b) is, in practice, sometimes a difficult task: the statement must, on the one hand, contain no comments on the relevance of the citations contained in the international search report but it may, on the other hand, refer to such a citation to indicate that a specific amendment of a claim is intended to avoid the document cited and this reference often contains a kind of explanation that the cited document is not relevant in relation to what is still claimed in the amended claim. The borderline between such an explanation and a comment which is not admitted under the present Rule is not always entirely clear. The applicant has problems when drafting a statement complying with Rule 46.4(b) and the International Bureau when checking the compliance of the statement with that Rule.

Rule 46

Amendment of Claims Before the International Bureau

46.1 [see document PCT/CAL/I/2, page 35]

46.2 [no change]

46.3 [see page 25, below]

46.4 Statement

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published and shall not exceed 500 words if in the English language or if translated into that language. The statement shall be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement.

(b) The statement shall contain no disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

46.5 [see document PCT/CAL/I/4]

5. It cannot and should not be the task of the International Bureau to examine each statement received under Article 19(1) as to whether a reference made in such statement to a citation contained in the international search report in order to indicate that a specific amendment of a given claim is intended to avoid the document cited is or is not at the same time to be considered as a comment on the international search report or the relevance of a citation contained in that report.

6. It is therefore proposed to permit the inclusion, in statements explaining amendments, of comments on the international search report and on the relevance of citations contained in that report to the extent that they are not disparaging. The statement, which is published together with the international application, is, naturally, not the appropriate forum for dissatisfied applicants to argue about the quality of the work of an International Searching Authority. If, however, the applicant has an opinion about the prior art cited in the international search report in the context of its relevance for the amendment of the claims, he should be permitted to present his views. Such views may be of interest to the public as well as to the designated Offices. In any case, general comments which are made although no claim is amended cannot be permitted, since Article 19(1) provides for the possibility to make a statement only where amendments have been filed. Therefore any statement referring to citations contained in the international search report must remain prohibited if they are not linked to a specific amendment, and proposed Rule 46.4(b) clearly implies this rule. E.g., a statement saying that none of the documents cited is considered to be relevant and that no amendments seem to be required, would be excluded. The proposed Rule 46.4(b) would, however, give an opportunity for the applicant to comment on the relevance of citations contained in the international search report if a claim is being amended—and only if a claim is amended—and if the citations are relevant to the amended claim. Such comments would add useful information for any reader of the published international applications and for the national Offices.

XII. Reducing from two to one the number of copies of the demand to be filed by the applicant

(Concerns Rules 53.1 and 61.1)

1. Under present Rule 53.1(d), the demand must be submitted in two identical copies: one of the copies is kept in the files of the International Preliminary Examining Authority with which the demand was filed and the other—the original—copy is sent by the said Authority to the International Bureau (see Rule 61.1(a)).
2. Although it is not a particular burden for the applicant to submit the demand in two copies, that requirement may be forgotten, and applicants have expressed interest in changing the rule so that one copy only should be required.
3. It is therefore proposed to delete paragraph (d) of Rule 53.1 and to provide in Rule 61.1(a) for the preparation of a copy of the demand by the International Preliminary Examining Authority. The original would be sent to the International Bureau whereas the copy prepared by the said Authority would be kept in the files of that Authority. The burden which is placed on the International Preliminary Examining Authority through this amendment is a light one. Moreover, it will largely be compensated by the fact that the International Preliminary Examining Authority would be relieved from the burden of issuing an invitation to the applicant to file a second copy if he filed the demand only in one copy (see Rule 60.1(a)). In fact, it is already the practice of some of the International Preliminary Examining Authorities to make such copy instead of sending an invitation to the applicant, since making a copy is cheaper, easier and faster than the invitation procedure provided for in Rule 60.1(a).

Rule 53

The Demand

53.1 Form

(a) to (c) [no change]

(d) [~~Deleted~~]

53.2 to 53.8 [no change]

Rule 61

Notification of the Demand and Elections

61.1 Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority

(a) The International Preliminary Examining Authority shall indicate on the demand the date of receipt or, where applicable, the date referred to in Rule 60.1(b). The International Preliminary Examining Authority shall promptly send the demand to the International Bureau. It shall prepare and keep a copy in its files.

(b) and (c) [No change]

61.2 and 61.3 [no change]

XIII. Doing away with the need for submitting amendments in two languages (the language of the international application as filed and the language of publication of the international application) and allowing to submit them in only one language (the language of publication), in cases in which the language of filing and the language of publication are different
(Concerns Rules 12.2, 46.3, 66.5, 70.16 and 70.17)

1. Ad Rules 12.2, 46.3 and 66.5. Under the present system, amendments to the international application must be made in the language of the international application; however, where the language in which the international application is published is different from the language in which it was filed, amendments must also be made in the language of publication. The languages of publication are English, French, German, Japanese and Russian. The languages in which international applications may be filed but which are not languages of publication are at present six: Danish, Dutch, Finnish, Icelandic, Norwegian and Swedish. International applications filed in one of these six languages are published in English translation (see Rule 48.3(b)).
2. The fact that the applicant has to furnish, in the cases referred to above, amendments in two languages (one of the said six languages and English), has been regarded by some applicants as an unnecessary burden since the amendments in the language of the international application would, later on, practically never be used. Naturally, amendments in the language of the international application are useful where that language is the language of a designated Office. This is, however, rather rare, as international applications filed in one of the six languages frequently claim the priority of an earlier application filed in that language. The Office with which such earlier application was filed will usually not be a designated Office and the designated Offices will usually require the use of their own language^{*}. Therefore, a general requirement to file amendments in two languages, when the language of the international application and the language of its publication are different, seems, indeed to be superfluous.
3. It is therefore proposed to amend Rules 46.3 and 66.5 in order to provide that, where the language of publication is different from the language of filing, amendments made under Article 19 or Article 34(2)(b) must be made only in the language in which the international application is published.
4. The amendment proposed for Rule 12.2 is consequential upon the amendments just proposed.
5. Ad Rules 70.16 and 70.17. The terminology used in the present English text of these Rules is not uniform: in some instances, the words “attachment” or “attached” are used (once in the title of Rule 70.16 and twice in the text of that Rule), whereas in other instances the words “annex,” “annexes” or “annexed” are used (twice in the text of Rule 70.16, once in the title of Rule 70.17 and once in the text of the latter Rule), although in all instances they speak of the same thing. The French text of the same Rules uses one and the same expression—namely “annexe” and its derivatives—in all these instances. From the many questions received by the International Bureau related to the interpretation of these two Rules, it appears to be appropriate to clarify the English text by using—like in the French text—only one expression. It is therefore proposed to use in the English text only the word “annex.”

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If the language of a designated Office should be the language of the international application, the applicant would need amendments in such language, but this would occur only in very rare cases and at the time of entering the national phase.

Rule 12

Language of the International Application

12.1 [see page 7, above]

12.2 Language of Changes in the International Application

Any changes in the international application, such as amendments and corrections, shall, subject to Rules 46.3 and 66.5, be in the same language as the said application.

12.3 [see page 7, above]

Rule 46

Amendment of Claims Before the International Bureau

46.1 [see document PCT/CAL/I/2, page 35]

46.2 [no change]

46.3 Language of Amendments

If the international application has been filed in a language other than the language in which it is published, any amendment made under Article 19 shall be in the language in which the international application is published.

46.4 [see page 19, above]

46.5 [see document PCT/CAL/I/4]

6. At the same time, it is proposed, for the reasons given under paragraphs 1 to 4, above, that the annexes be only in the language in which the international application to which they relate is published (and no longer also in the language in which the international application was filed, if different from the language of publication). To achieve this amendment, it is proposed to include a reference to the annexes into the text of the existing Rule 70.17(a) and to delete Rule 70.17(b).

Rule 66

Procedure Before the International Preliminary
Examining Authority

66.1 to 66.3 [no change]

66.4 [see page 35, below]

66.5 Amendment

Any change, other than the rectification of errors or mistakes under Rule 91, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment. If the international application has been filed in a language other than the language in which it is published, any amendment shall be in the language in which the international application is published.

66.6 [no change]

66.7 [see document PCT/CAL/I/4]

66.8 [no change]

Rule 70The International Preliminary Examination Report

70.1 to 70.15 [no change]

70.16 Annexes of the Report

If the claims, the description, or the drawings, were amended or any part of the international application was corrected before the International Preliminary Examining Authority, each replacement sheet marked as provided in Rule 66. 8(b) shall be annexed to the report. Replacement sheets superseded by later replacement sheets shall not be annexed. If the amendment is communicated in a letter, a copy of such letter shall also be annexed to the report.

70.17 Languages of the Report and the Annexes

(a) The report and any annex shall be in the language in which the international application to which they relate is published.

(b) [Deleted]

XIV. Making it possible for the applicant to submit the translation of any annex to the international preliminary examination report later than under the present Rules and specifying the consequences of any failure to submit such translation

(Concerns Rule 74.1)

1. The present text of Rule 74 consists of one very long sentence covering various alternatives with different time limits applying to the furnishing of translations of any replacement sheet referred to in Rule 70.16, or of translations of any amendment referred to in the last sentence of that Rule, namely, an amendment communicated in a letter which is to be annexed to the international preliminary examination report. The translation must, where Article 39 applies, be furnished together with the translation of the international application within the time limit applicable under Article 39(1) or, if the said replacement sheet or letter has been filed with the International Preliminary Examining Authority less than one month before or even after the furnishing of the translation of the international application, the translation must be furnished within one month after the filing of the replacement sheet or letter with the International Preliminary Examining Authority. Where Article 22 applies for the furnishing of the translation of the international application to an elected Office—and this is the case only in respect of the Japanese Patent Office since Japan is the only Contracting State which has made a declaration under Article 64(2)(a)(i)—a translation of the replacement sheet or letter must be furnished together with the translation of the international application or, if the replacement sheet or letter has been filed with the International Preliminary Examining Authority less than one month before or even after the furnishing of the translation of the international application, the translation must be furnished within one month after the filing of the replacement sheet or letter with the International Preliminary Examining Authority. The Japanese national law, however, requires the furnishing of a translation of the replacement sheet or letter only prior to the expiration of the 25-month time limit fixed at present in Article 39(1)(a) (see Volume II of the PCT Applicant's Guide, paragraph JP.17(iv)).

2. It is proposed to completely revise the text of this Rule to make it more readily understandable. The proposed new text of Rule 74.1 is divided into three paragraphs, the main features of which would be as follows: paragraph (a) deals with the normal case, namely where the furnishing of a translation of the international application is governed by Article 39(1). Paragraph (b) deals with the exception, namely where the furnishing of the translation of the international application is governed by Article 22 (rather than by Article 39(1)) because the elected State has made a declaration under

Article 64(2)(a)(i). Paragraph (c) provides that the elected Office must invite the applicant to furnish a translation of the annexes of the international preliminary examination report where he failed to do so within the applicable time limit; this would be a new guarantee to the applicant.

3. Ad Rule 74.1(a). The proposed new text of Rule 74.1(a) requires the “translation of any annex, referred to in Rule 70.16, of the international preliminary examination report” and no longer a translation of “any replacement sheet referred to in Rule 70.16, or any amendment referred to in the last sentence of that Rule.” The proposed amendment does not involve any change in substance; it only harmonizes the wording of Rule 74.1 with the proposed amendment to the English text of Rule 70.16 (see Chapter XIII, above) which, as it reads in the proposed amended form, speaks only of “annexes” and defines the content of the annexes. It becomes, therefore, unnecessary to repeat in Rule 74.1 what the annexes to the international preliminary examination report may consist of.

Rule 74

Translations of Annexes of
the International Preliminary Examination Report

74.1 Time Limit

(a) Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), furnish a translation of any annex, referred to in Rule 70.16, of the international preliminary examination report. However, where such report was transmitted to the applicant less than 1 month before, or any time after, the expiration of the said time limit, the applicant shall furnish the translation of any annex within 1 month from the transmittal of the said report.

(b) The time limits fixed in paragraph (a) shall apply even where the furnishing of a translation of the international application to an elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

(c) Where no translation of the annexes referred to in Rule 70.16 was furnished to the elected Office within the applicable time limit fixed in paragraphs (a) and (b), that Office, if it deems such translation to be necessary, may invite the applicant to furnish the required 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. If no translation has been furnished within that time limit, the elected Office shall take into account only the translation of the international application furnished under Article 39(1), unless later amendments are made under Article 41.

4. At the same time, it is proposed to change the time limit for the furnishing of a translation of the said annexes. The present Rule 74.1 requires, in principle, the furnishing of the translation of the said annexes together with the furnishing, under Article 39, of the translation of the international application. This principle remains unchanged. The proposed change concerns the present one-month time limit for the later furnishing of the translation of the annexes. The present one-month time limit starts on the date of filing the amendments with the International Preliminary Examining Authority and it expires in some cases even before the international preliminary examination report has been established or received by the applicant and the elected Office, although the furnishing of a translation of the annexes to the said report makes sense only if the report itself has been established and has been received by the elected Office. Moreover, the applicant having to furnish the translation of the annexes should be aware of what, in fact, has been annexed by the International Preliminary Examining Authority before such furnishing. It is therefore proposed to amend the existing one-month time limit under Rule 74.1 by changing the starting date from the date of filing of the amendments to the date of transmittal of the report.

5. [Ad Rule 74.1\(b\)](#). As already stated, this Rule concerns the cases where a declaration has been made by a Contracting State under Article 64(2)(a)(i), that is, at present, Japan. It is proposed to apply the same time limits for the furnishing of translations [of the annexes](#) of the international preliminary examination report as under Rule 74.1(a)*. The reasons are the same as those given in connection with the proposed new Rule 74.1(a): the applicant should know what has been annexed by the International Preliminary Examining Authority to its report before he is required to furnish a translation thereof.

6. [Ad Rule 74.1\(c\)](#). The furnishing of a translation of the [annexes](#) to the international preliminary examination report is not governed by Article 39(1). That Article applies only to the furnishing of a translation of the international application as filed and as amended under Article 19(1). The translation of the annexes to the international preliminary examination report must be furnished pursuant to Article 36(3)(b). The sanction provided for the non-furnishing of a translation of the international application in Article 39(2) does not apply to the failure to furnish a translation of the annexes to the international preliminary examination report.

7. To give effect to the provision of Article 36(3)(b), for which the present text does not provide for any sanction, it is proposed that the applicant should be invited to furnish the translation if he failed to do so within the applicable time limit fixed in Rule 74.1(a) and (b). If the applicant fails to comply with the invitation, the elected Office will disregard the changes made to the international application before the International Preliminary Examining Authority and, unless the applicant presents further amendments under Article 41, take into account only the translation of the international application furnished under Article 39(1).

8. The language into which a translation must be furnished has not been expressly prescribed, since, in the view of the International Bureau, it goes without saying that the language must be the same as the language notified under Rule 76.1(a)(i), although this Rule refers only to Article 39(1) and not to Article 36(3)(b).

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As far as Japan is concerned, the proposed amendment would only cause a minimal change, since Japan already admits that the Japanese translation of the annexes to the international preliminary examination report be furnished by the expiration of 25 months from the priority date, which, in most cases, will coincide with the proposed time limit. Naturally, the obligation of the applicant to furnish a Japanese translation of the [international application](#) by the expiration of 20 months from the priority date would not be affected by the proposed amendment.

XV. Making it possible for the applicant to present additional arguments to the International Preliminary Examining Authority even where he submits no amendments; making longer the time limit for establishing the international preliminary examination report in cases where the applicant is given more than one opportunity to submit amendments, corrections or arguments to the said Authority

(Concerns Rules 66.4 and 69.1)

1. Ad Rule 66.4. Under Rule 66.3, the applicant may reply to a written opinion of the International Preliminary Examining Authority issued under Rule 66.2 by submitting amendments or corrections or—if he disagrees with the opinion of that Authority—by submitting arguments, as the case may be, or do both. The International Preliminary Examining Authority has, under Rule 66.4(a), the possibility to issue one or more additional written opinions and the applicant has the same right to respond as outlined above. When, however, the applicant requests the International Preliminary Examining Authority, without having received an additional written opinion, to give him one or more additional opportunities under Rule 66.4(b), such opportunities are limited to the submission of amendments or corrections and do not include the possibility of submitting arguments.
2. Practice has shown that some applicants would like to have, during the international preliminary examination, also the right to request one or more additional opportunities for the submission of arguments in support of the international application.
3. It is therefore proposed to amend Rule 64.4(b) by allowing also a request for one or more additional opportunities to submit arguments. This amendment would contribute to the better acceptance of Chapter II by applicants since it would broaden the possibility for a dialogue between the applicant and the International Preliminary Examining Authority.
4. Ad Rule 69.1. Present Rule 69.1(a) provides for the establishment of international preliminary examination reports within maximum time limits and that the agreements with the various International Preliminary Examining Authorities must provide the same time limits for all International Preliminary Examining Authorities. Since the first agreement concluded with an International Preliminary Authority has fixed the time limits at the maxima allowed, it is those maxima which had to be and were provided in all the agreements. Naturally, the same time limits would have to be applied also to any agreement with additional International Preliminary Examining Authorities. Under these circumstances, reference in the Rule to agreements seems to be superfluous, and it is proposed to convert the maxima provided in the present Rule into fixed time limits and to add to the two present time limits (Rule 69.1(a)(i) and (n)) a third one.
5. This third time limit would apply where the applicant asks (under Rule 66.4(b) as amended; see paragraph 3, above) for additional opportunities to file amendments, corrections or arguments, and would be 10 months after the start of the international preliminary examination. The time limit would thus be 4 or 2 months longer than under present Rules 69.1(a)(i) and (n), respectively. Such longer time limit is obviously to the advantage of the applicant since it gives him more time for his efforts to convince the International Preliminary Examining Authority of the well-foundedness of his application or his efforts to amend his claims to make them (more) acceptable.

Rule 66

Procedure Before the International Preliminary

Examining Authority

66.1 to 66.3 [no change]

66.4 Additional Opportunity for Submitting Amendments, Corrections or Arguments

(a) [no change]

(b) On the request of the applicant, the International Preliminary Examining Authority may give him one or more additional opportunities to submit amendments corrections or arguments.

66.5 [See page 27, above]

66.6 [no change]

66.7 [see document PCT/CAL/I/4]

66.8 [no change]

Rule 69

Time Limit for International Preliminary Examination

69.1 Time Limit for International Preliminary Examination

(a) The time limit for establishing the international preliminary examination report shall be that one of the following which, in the given case, expires last:

(i) 6 months after the start of the international preliminary examination;

(ii) where the International Preliminary Examining Authority issues an invitation to restrict the claims or pay additional fees (Article 34(3)), 8 months after the start of the international preliminary examination;

(iii) where the applicant has made a request under Rule 66.4(b), 10 months after the start of the international preliminary examination.

(b) and (c) [No change]

XVI. Making longer the time limit for entering the national phase in elected States
(Concerns Article 39(1))

1. The present text of Article 39(1)(a) provides in effect that the national phase must be entered at the latest at the expiration of 25 months from the priority date. The main reason for this extension is to allow enough time for the establishment of the international preliminary examination report before the applicant has to comply with the acts required for the entry into the national phase.
2. If the demand is filed, as is usually the case, during the 19th month from the priority date, the time limit for the establishment of the international preliminary examination report, which is normally 6 months after the start of the international preliminary examination (see Rule 69.1(a)(i)), expires during the 25th month from the priority date. On the other hand, the applicant must enter the national phase before the elected Office prior to the end of that 25th month. In certain cases, the time limit for the establishment of the international preliminary examination report expires two or four months later (see Rule 69.1(a)(ii) and the proposed new Rule 69.1(a)(iii)) that is, [after](#) the expiration of the existing time limit under Article 39(1)(a).
3. Even in cases where the demand is filed earlier than the 19th month from the priority date, the existing time frame has, in some cases, proven to be rather tight. Where the priority of an earlier application is claimed in an international application—and this is normally the case—the international search report will be mailed during the 16th month from the priority date. The international preliminary examination usually starts upon receipt by the International Preliminary Examining Authority of amendments under Article 19 or of a notice from the International Bureau that no such amendments have been filed (see Rule 69.1(b)). This occurs usually during the 18th month from the priority date. The time limit for the establishment of the international preliminary examination report expires in such a case during the 24th, 26th or 28th month from the priority date—which is too close, or even posterior, to the expiration of the present, 25-month, time limit under Article 39(1)(a).
4. The main purpose of Chapter II of the Treaty is to provide the applicant with an international preliminary examination report [before](#) he must incur expenses for translations, local agents and national fees, that is, before entering the national phase. The existing time limit of 25 months from the priority date is too short to allow the applicant to benefit from the said report in all cases before entering the national phase.
5. It is therefore proposed to extend the time limit under Article 39(1)(a) from 25 months to 30 months from the priority date, which would permit the establishment of the international preliminary examination report in practically all cases some time before the applicant has to enter the national phase.
6. Compared to the time usually needed by national Offices for patent examination, the period of 6 to 10 months provided for the establishment of the international preliminary examination report appears still to be rather short. If, in addition, the time is taken into consideration which will be saved by the elected Offices for any national examination where the international preliminary examination report has been established and has been considered by the applicant prior to the start of national processing, it becomes evident that the proposed extension of the time limit for starting such processing would not constitute an undue delay.
7. It is firmly believed that the proposed change would contribute to a much wider use of Chapter II for the benefit of the applicants and the elected Offices, since international preliminary examination reports would almost always be available before the national processing may start and thus reduce the number of applications reaching the national phase which are unlikely to become patents.
8. The time limit in Article 39(1)(a) can be modified by a unanimous decision of the PCT Assembly or in a vote by correspondence under Article 47(2) as indicated in more detail in Chapter II, paragraph 3, of document PCT/CAL/I/2 (page 12).

Article 39

Copy Translation, and Fee, to Elected Offices

It is proposed that the time limit “25 months from the priority date” in Article 39(1)(a), *in fine*, be replaced by “30 months from the priority date.”

XVII. Making it clear in which cases Contracting States must excuse delays in meeting time limits
(Concerns new Rule 82bis)

1. Ad Rule 82bis.1. Article 48 deals with excusing the missing of time limits. paragraph (1) of that Article speaks about “any time limits fixed in this Treaty [that is, the PCT] or the Regulations [that is, the PCT Regulations],” whereas paragraph (2) speaks—in both of its two ((a) and (b)) subparagraphs—of “any time limit.” Practical experience has shown that there is some uncertainty about the meaning of the expression “any time limit” used in paragraph (2) and that, in particular, some interpret the latter expression as if it were also qualified by the words “fixed in this Treaty and the Regulations.” But since that qualification does not appear in paragraph (2), the meaning of “any time limit” is obviously broader in paragraph (2) than in paragraph (1) and, if correctly interpreted, “any time limit” appearing in paragraph (2) cannot but mean all the time limits relevant in a procedure covering an international application and not only time limits fixed in the PCT or the Regulations.
2. Proposed new Rule 82bis.1 is intended to make all this clear by speaking of any time limit “relevant for international applications” and by making it clear that such time limits may have been fixed not only in the PCT or the PCT Regulations but also in the national law and by any national Office (in its capacity of receiving, designated or elected Office—since otherwise the time limit is not relevant for international applications) or any of the international authorities dealing with international applications, that is, International Searching Authorities, International Preliminary Examining Authorities and the International Bureau (time limits fixed by these authorities are necessarily relevant for international applications). In the case of the national Offices and international Authorities, the proposed text does not say where the time limits must be fixed to come under the proposed new Rule; consequently, they may be fixed anywhere, in particular a law, regulations or an ad hoc decision. Naturally, the reasons for which delays must be excused under paragraph (a) are not the same as the reasons for which delays may be excused under paragraph (b): in the first case” the reasons are reasons admitted in the national law of the Contracting State whose organs (its national Office qua designated or elected Office and its courts) are asked to excuse the delay, whereas, in the second case, the reasons are reasons other than reasons admitted in the national law. What these latter reasons are is not specified; consequently, it may be any reason, including errors by others than the applicant (see proposed new Rule 82bis.3, below).
3. Ad Rule 82bis.2. Proposed new Rule 82bis. 2 is intended to enumerate the more common remedies that result in excusing delays in meeting time limits, namely reinstatement of rights, restoration, *restitutio in integrum* and “further processing [of the international application] in spite of non-compliance with a time limit”. It is, furthermore, intended to make it clear that the said listing of certain remedies does not mean that that listing is exhaustive: this is why the proposed draft speaks of “any other provisions.”
4. Ad Rule 82bis.3. Proposed new Rule 82bis.3 is intended to keep free the applicant from the consequences of any delay of meeting a certain time limit where the delay was caused by a mistake or an erroneous information coming from certain official sources. In the case of a national application, where the only official source is the Patent Office, it is only natural that, if the delay is caused by a mistake or erroneous information of the Patent Office, that Patent Office will excuse the delay since it caused itself that delay. What is intended here is to extend this principle—natural and equitable—to international applications and to make it mandatory for each national Office, qua designated or elected Office, to apply it. The legal basis for such an extension is in Article 48(2)(b) which allows excusing delays for reasons other than those admitted by national laws. Here, the reasons are characteristically outside the national law since, as far as known, no national law deals with mistakes or errors of PCT authorities; but should a national law deal with them, Article 48(2)(a)(rather than Article 48(2)(b)) will apply, and the result for the applicant will presumably be the same. Article 48(2)(b) gives a faculty to excuse; the proposed new Rule, if adopted, would mean that all Contracting States would make use of this faculty in a given case, namely that of a mistake or erroneous information of a PCT Authority.

Rule 82bis (New)

Excuse of Delays in Meeting Certain Time Limits

82bis.1 Meaning of “Time Limit” in Article 48(2)

The reference to “any time limit” in Article 48(2) shall be construed as comprising a reference to any time limit relevant for international applications, whether fixed in the Treaty or these Regulations or fixed in the national law of a Contracting State, as well as to any time limit fixed by any national Office in its capacity of receiving, designated or elected Office, by any International Searching Authority, any International Preliminary Examining Authority or the International Bureau.

82bis.2 Examples of Provisions under the National Law to which Article 48(2)(a) Applies

The provisions of the national law referred to in Article 48(2)(a) concerning the excusing of any delay in meeting any time limit are, in particular, those provisions of the national law which relate to reinstatement of rights, restoration, *restitutio in integrum* or further processing in spite of non-compliance with a time limit, and any other provision related to extension of time limits or to excuses for delays in meeting time limits.

5. One of the questions to be resolved is which should be the PCT authorities whose mistakes or erroneous information should be covered. The proposed text limits them to the International Searching Authority, the International Preliminary Examining Authority and the International Bureau and does not include the receiving Office. However, one could also include the receiving Office since it has international authority functions. The limitation in the proposal is based on the consideration that whereas any International Searching Authority and International Preliminary Examining Authority and, even more so, the international Bureau are under the constant scrutiny of the PCT community as represented by the member States, a receiving Office is not or much less under such scrutiny so that its possible mistakes or errors are less susceptible of public exposure.

6. In any case, and as obvious, the intent is that the applicant should not suffer where he is—so to say—misled by an “official” mistake or misinformation, even where, by studying himself the relevant provisions, he could have discovered that the official body was in error. Such an advantage given to the applicant would, as already stated, be a mere extension to the PCT of what is already a generally accepted principle on the national level.

7. The obligation to excuse would only apply where the applicant “proves” that the delay was “due to” an official error of the said kind. Any excuse allowed would, naturally, be effective only in the Office that granted it; this follows from the words “as far as that State is concerned” of Article 48(2)(b).

82bis.3 Excuse of Delays Where They Can be Traced to an Error of an International Authority

If the applicant proves to the satisfaction of any designated or elected Office that any delay in meeting a time limit is due to a mistake made or erroneous information given by* the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, the delay shall be excused by the said designated or elected Office.

*

It should be considered whether the words “the receiving Office,” should not be inserted here.

XVIII. Making more liberal the rules concerning the rectification of correctible errors and mistakes in documents

(Concerns Rules 91.1 and 91.2)

1. Ad Rule 91.1(a) to (d). The present provisions allow the rectification of what are referred to as “obvious errors of transcription” in the international application and other papers submitted by the applicant and expressly exclude the possibility of correcting the omission of entire elements or sheets. It is proposed to make the provisions more liberal: any error or mistake—and not only “obvious” errors “of transcription”—including omissions of entire elements or sheets, should be rectifiable. As far as the rectification offered is concerned, it would continue to be required that it be obvious in the sense that “nothing else could have been intended” than what is offered as rectification but the realization of such obviousness would no longer be required to be an “immediate” realization by “anyone” which means that the realization may even be the result of a careful and long checking and consideration by an expert.
2. Ad Rule 91.1(e). This paragraph specifies which authority or office is competent to decide to accept or refuse a request for the rectification of an error. The provisions would, with one exception, remain the same as in the present provisions. The exception would relate to the case in which the error consists in omitting an intended designation: in that case, it would be the national Office of (or acting for) the State whose designation was so omitted which would be competent to decide whether to accept the rectification. Details concerning this case are provided in what would be new paragraph (i); that paragraph is commented upon in paragraphs 9 to 12, below.
3. Ad Rules 91.1(f) and (h). At present, paragraph (f) reads as follows: “The date of the authorization [to rectify] shall be recorded in the files of the international application,” whereas paragraph (h) reads as follows: “Any authority, other than the International Bureau, which authorizes any rectification shall promptly inform the International Bureau of such rectification.” It is proposed to merge the two Rules into what would be the new paragraph (f) with a text adapted to the proposed changes in other paragraphs: the authorities or offices that would be required to make the notification would be enumerated for the sake of clarity, the communication of the date of the rectification would be required only when it is legally relevant (that is, in the case of the amended paragraph (g)(ii)), and the requirement of “recording” in the files of the international application would be omitted as not sufficiently clear (whose files are meant?) and unnecessary (since, thanks to the communication made to the International Bureau, or to the fact that the decision is made by the International Bureau, the files of the international Bureau would, in any case, show the rectification).
4. Ad Rule 91.1(g). Both the present paragraph (g) and paragraph (g) as proposed to be amended deal with the time limit or event until which a rectification can be made. The proposed changes would essentially be clarifications and would make the situation of the applicant more secure since the events and dates would be more precise. Thus, where the rectification is authorized by the receiving Office or the International Searching Authority, it would have to reach the International Bureau by the expiration of 17 months from the priority date, which should be ample and would secure that the international publication would take into account the rectification; where the rectification is authorized by the International Bureau, it would have to be effected by the expiration of the same time limit (which would have the same advantages). There is no change proposed in respect to rectifications authorized by the International Preliminary Examining Authority. It is to be noted that for the rectification of the omission of a designation, no time limit is provided for for the granting of the authorization since it is a matter which affects only the (intended) designated State; on the other hand, as will be seen, paragraph (i) does provide a time limit for making a request for such a rectification. Finally, it is to be noted that the provisions of paragraph (g) would be subject to three qualifications which are dealt with in proposed paragraphs (*g-bis*), (*g-ter*) and (*g-quater*).

Rule 91

Errors and Mistakes in Documents

91.1 Rectification

(a) Subject to paragraphs (b) to (i), errors and mistakes in the international application or other papers submitted by the applicant may be rectified.

(b) An error or mistake may be due to the fact that something other than what was intended was written, or that something that was intended to be included was not included (“omission”), in the international application or other paper submitted by the applicant. The rectification of any error or mistake must, in order to be admitted, be obvious in the sense that nothing else could have been intended, by the applicant, at the time he filed the international application or other paper containing the error or mistake, than what he offers as rectification.

(c) [Deleted]

(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be a rectifiable error or mistake may invite the applicant to present a request for rectification as provided in paragraphs (e) to (i).

(e) No rectification shall be made except with the express authorization:

(i) of the receiving Office if the error or mistake is in the request, except in the case provided for in paragraph (i),

(ii) of the national Office concerned, in the case provided for in paragraph (i),

5. [Ad Rule 91.1\(g-bis\)](#). The first qualification is contained in paragraph (g-*bis*). It would allow to accept rectifications even beyond the (17-month time limit in the cases covered by paragraph (g)(i) and (iii): where the rectification authorized by the receiving Office or the International Searching Authority reaches the International Bureau after the expiration of that time limit but at a moment when it can still be taken into account in the international publication, the rectification will be effective. In practice, this could mean one or two weeks beyond the 17-months time limit; in other words, the possibility to rectify could go up to two or three weeks before the actual publication (to be effected promptly after the expiration of the 18-month time limit) of the international application. Similar flexibility would apply in the case of rectifications authorized by the International Bureau.
6. [Ad Rule 91.1\(g-ter\)](#). The second qualification to paragraph (g) is contained in proposed paragraph (g-*ter*). It applies where the applicant asked for early publication. The time limits in paragraph (g) are based on the (assumption that international publication occurs promptly after the end of the 18th month from the priority date. Where international publication occurs earlier—because the applicant asked for an early publication—the time limits must expire earlier, otherwise the rectifications could not be taken into account in the international publication. It is proposed that the time limit should be the date on which the request for early publication reaches the International Bureau. Thus, the International Bureau will be able to take into account the rectification in the early publication of the international application.
7. [Ad Rule 91.1\(g-quater\)](#). The third qualification to paragraph (g) is contained in paragraph (g-*quater*). It applies where the international application is not published (because none of the designated States requires publication). In that case, obviously, the 18-month publication date is of no influence on setting a time limit. But the time limit for communication under, Article 20 is of such influence, since the communication should take into account any rectification. This is why the proposed limit is communication under Article 20. In fact, this means that the time limit will be between 18 and 19 months from the priority date which, in turn, means an additional ½ to 2 months for rectifications. Such longer time limit is naturally an added advantage for the applicant.
8. [Ad Rule 91.1\(h\)](#). See the observations under paragraph 3, above.
9. [Ad Rule 91.1\(i\)](#). This new paragraph would deal with the case where the applicant asks for a rectification alleging that he intended to designate a State but, through an error or mistake, failed to do so in the request part of the international application. The request for rectification would have to be filed with the receiving Office and would have to be accompanied by the designation fee (unless more designation fees were originally paid than (required in view of the number of designations effected in the request part of the international application). The time limit for requesting such a rectification would be 15 months from the priority date. Such a time limit would be enough since it would give the applicant a minimum of three months after the filing of the international application to discover the omission. It would, at the same time, give several weeks to the applicant after he receives the notification of the International Bureau under Rule 24.2(a); that notification contains the list of the designated offices and, by reading that C list, the applicant can discover the omission made by him.
10. The receiving Office would communicate the request for rectification to the International Bureau. Thus, the International Bureau could take it into account in the international publication of the international application. But since the decision on the request for rectification is—as will be seen later—reserved for the (intended) designated Office and since at the time of the international publication of the international application that decision is not yet taken, the international publication would have to, and would, indicate that the designation is [subject to](#) the said decision. Thus, the uncertainty would be flagged.

[Rule 91.1(e), continued]

(iii) of the International Searching Authority if the error or mistake is in any part of the international application other than the request or if the error or mistake is in any paper submitted to that Authority,

(iv) of the International Preliminary Examining Authority if the error or mistake is in any part of the international application other than the request or if the error or mistake is in any paper submitted to that Authority, and

(v) of the International Bureau if the error or mistake is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

(f) Any receiving Office, International Searching Authority, International Preliminary Examining Authority, or national Office referred to in paragraph (i) that authorizes any rectification shall promptly notify such rectification to the International Bureau; notifications by an International Preliminary Examining Authority shall also indicate the date on which the authorization was given.

(g) The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g-bis), (g-ter) and (g-quater), be effective:

(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;

(ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;

(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.

11. The (intended) designated Office would receive the request for rectification together with the international application communicated to it under Article 20. Once the national processing of the international application starts before the (intended) designated Office, and only then, will the decision be taken, by that Office, whether the rectification is accepted. Naturally, the (intended) designated Office may reject the request for rectification if it finds that the error or mistake is not proved.

12. Authorizing the rectification would not be a “later” designation—a possibility discussed but rejected in the negotiations that lead to the PCT—since a “later” designation (as understood, for example, in the Trademark Registration Treaty) is a designation [after](#) filing which is later on purpose: it is so intended by the applicant. The designation here contemplated, on the other hand, is a designation which was intended [before](#) the filing of the international application but omitted, at that time, due to an error or mistake.

13. [Ad Rule 91.2](#). As far as the manner of carrying out rectifications authorized under Rule 91.1 is concerned, it is proposed to replace the present reference to the Administrative Instructions by a reference to Rule 26.4(a) to (c), which deals with the procedure for carrying out corrections required by the receiving Office under Article 14(1). The latter Rule would apply *mutatis mutandis* to rectifications under Rule 91.1.

[Rule 91.1, continued]

(g-bis) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but at a time when the international publication of the international application can still incorporate the rectification, the rectification shall be effective and shall be incorporated in the said publication.

(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be made by, the International Bureau, in order to be effective, latest at the time when the request for early publication reaches the International Bureau.

(g-quater) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be made by, the International Bureau, in order to be effective, latest at the time of the communication of the international application under Article 20.

(h) [Deleted]

[Rule 91.1, continued]

(i) Where the applicant alleges that it is due to an error or mistake that the designation of a State has been omitted in the request, his request for rectification shall be filed, and accompanied by the corresponding designation fee, with the receiving Office before the expiration of 15 months from the priority date. The receiving Office shall promptly communicate the request for rectification to the International Bureau. The International Bureau shall include the omitted designation in the record copy and in the international publication of the international application with an indication that the designation is subject to authorization by the national Office of or acting for the State whose designation is requested, and shall transmit the request for rectification to that Office together with the international application communicated under Article 20.

91.2 Manner of Carrying Out Rectifications

Rule 26.4(a) to (c) shall apply *mutatis mutandis* to the manner in which rectifications of errors and mistakes shall be made and the manner in which they shall be entered in the file of the international application.

XIX. Clarifying the conditions of a request for early examination and other processing of the international application

(Concerns new Rule 92*ter*)

1. The Treaty provides, in effect, in Article 23(1)(and Article 40 (I)), that no designated (or elected) Office may examine or otherwise process the international application prior to the expiration of the time limit applicable under Article 22 (or Article 39(1)), unless the applicant, under Article 23(2) (or Article 40(2)), makes an express request for an earlier start of the examination and other processing of the international application.
2. The present text of the Treaty and the Regulations does not prescribe any special procedure for such an express request, and it would certainly be useful, both for the applicant and the national Offices concerned, if the Regulations clarified what is to be done if the applicant wants to request an earlier start of the national procedure.
3. The proposed new Rule 92*ter*.1 would prescribe that any request under Article 23(2)(or Article 40(2)) must be made in writing, must be addressed to the Office concerned, and must state the wish of the applicant that the designated (or elected) Office start the examination and other processing without waiting for the expiration of the time limit applicable under Article 22 (or Article 39(1)). The earliest date on which the national procedure may start could be indicated by the applicant in the said request but would not have to be so indicated. If there is no such indication in the request, the national procedure could start at any time after the request has been made.
4. Any such request, in order to have the desired effect, would have to be preceded by the fulfilment of the following conditions: the payment of the designation fee, the payment of the national fee (if any), the furnishing of the translation (if one is required) and the furnishing of a copy of the international application (unless such furnishing is not required).

Rule 92ter (New)

Early Examination and Other Processing of the International Application

92ter.1 Request under Article 23(2) or Article 40(2)

A request under Article 23(2) or Article 40(2) shall be made in writing, shall be addressed to the designated or elected Office concerned, and shall state that the applicant wishes the examination and other processing of the international application by that Office to start without waiting for the expiration of the time limit applicable under Article 22 or Article 39(1), as the case may be. The said request may indicate a date before which the examination and other processing of the international application should not start, provided that such date is prior to the expiration of the time limit applicable under Article 22 or Article 39(1), as the case may be. The said request is not considered to have been made until the designation fee has been paid and the acts referred to in Article 22(1) or Article 39(1)(a) have been performed.

XX. [Specifying the procedure for reinstating the Article 11\(3\) effect of an international application](#)
(Concerns new Rule 92^{quater})

1. Article 24(2)(and Article 39(3)) allow any designated (or elected) Office to maintain the effect of an international application (that is, the effect of a regular national application in the State of the designated (or elected) Office as of the international filing date). This faculty may be exercised for whatever reason the said effect has been lost, be it through withdrawal of the international application or the designation or through a declaration that the international application or the designation is considered withdrawn, be it through a finding by the International Bureau that no record copy has been received by it in time, or be it because of failure to perform the acts referred to in Article 22 (or Article 39(1)) within the applicable time limit.
2. In practice, probably the most important circumstance where maintaining the said effect would be needed by the applicant are the cases in which a time limit was not kept and the delay may be excused. The proposed new Rule 82^{bis} (see Chapter XVII, above) specifies in some detail the cases in which delays in meeting time limits may be excused.
3. The present text of the Treaty and of the Regulations does not provide for any specific procedure for requesting the maintaining of the effect of the international application under Article 24(2)(or Article 39(3)). The only provision of a similar nature is Article 25 (Review by Designated Offices), but that Article does not cover the cases which would fall under Article 24(2). However, the acts to be performed for such a review by the designated Office can be compared with those which would be required if the applicant requests, under Article 24(2)(or Article 39(3)), the maintaining of the effect of the international application. The national fee (if any) must have been paid to the designated (or elected) Office and a copy of the international application and any prescribed translation must have been furnished to it as a condition for the examination by the designated (or elected) Office of the question whether the effect of the international application provided for in Article 11(3) can be maintained for the reasons advanced by the applicant.
4. A new Rule 92^{quater.1} is proposed in order to provide a procedure under Article 24(2)(or Article 39(3)) for the applicant and the designated (or elected) Offices. It has not always been fully understood by applicants and national Offices what is meant by Article 24(2)(or Article 39(3)) and when and under what conditions those Articles can be applied. The proposed procedure is intended to clarify the situation. Where an international application has lost its effect provided for in Article 11(3), the applicant may address a request to the designated (or elected) Office before which he wants such effect to be maintained. The request must be in writing and explain the reasons why the applicant thinks that the designated (or elected) Office should maintain the said effect. The request must be accompanied by the necessary proof of the facts on the basis of which the applicant is claiming the maintaining of the effect provided for in Article 11(3). At the same time, the applicant must have paid the national fee to the Office concerned and must have furnished any prescribed translation. The copy of the international application must be furnished by the applicant only where the designated (or elected) Office requires such copy from him and where communication of the international application under Article 20 has not taken place.
5. The time limit for a request under Article 24(2)(or Article 39(1)) proposed in the text of the new Rule 92^{quater.1} is usually the time limit before the expiration of which national processing of the international application may not start. Where the applicant wants an early clarification of the effect of his international application, he has also the right to make, at the same time, an express request for early processing under Article 23(2) (or Article 40(2)) as provided for in the new Rule 92^{ter.1} (see the preceding Chapter XIX).

Rule 92^{quater} (New)

Maintaining of Effect of International Application
under Article 24(2) or Article 39(3)

92^{quater}.1 Request for Maintaining Effect

(a) Where the effect of the international application provided for in Article 11(3) has ceased in a designated or elected State pursuant to Article 24(1) or Article 39(2), the applicant may, with reference to Article 24(2) or Article 39(3), request the maintaining of such effect.

(b) The request shall be made in writing and shall be addressed to the designated or elected Office concerned. Such Office shall, provided that, at the time it received the request, the national fee (if any) has been paid and a copy of the international application and the appropriate translation (as prescribed) have been furnished, decide whether the effect provided for in Article 11(3) shall be maintained.

(c) The request shall be made within the time limit applicable under Article 22 or Article 39(1) or, where the effect provided for in Article 11(3) has ceased pursuant to Article 24(1)(iii) or Article 39(2), within 2 months from the expiration of such time limit.

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