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

THIRD OF THREE PREPARATORY MEMORANDA OF THE INTERNATIONAL BUREAU

INTRODUCTION

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

* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

SUBJECT MATTERS OF THE AMENDMENTS PROPOSED IN THIS DOCUMENT

	Objective	Provisions to be amended	Page
XXI.	Informing the designated Offices where the priority claim is cancelled or the filing date of the earlier application is corrected; allowing in the Administrative Instructions to provide for the inclusion in the request of additional optional indications	Rules 4.10 and 4.17	4
XXII.	Omitting any drawing from the publication of the abstract where no drawing is useful for the understanding of the abstract	Rules 8.2 and 48.2	8
XXIII.	Simplifying the wording of Rule 13 <i>bis</i> .7	Rule 13 <i>bis</i> .7	12
XXIV.	Clarifying the date of payment of certain fees and of the effective date in case of new amounts of those fees	Rules 15.4 and 57.3	14
XXV.	Providing for quicker information of the International Bureau where charges are made under Rule 16 <i>bis</i> , and providing for the universal application of that Rule	Rules 16 <i>bis</i> .1 and 16 <i>bis</i> .3	18
XXVI.	Clarifying various questions concerning the submission of the priority document and the furnishing of copies thereof	Rules 17.1 and 17.2	20
XXVII.	Cancelling the obligation of the receiving Office to reimburse to the International Bureau the cost of making a substitute search copy	Rule 23.1	24
XXVIII.	Deleting the requirement to mark all sheets of the international application and all replacement sheets with the stamp of the International Bureau	Rules 24.1 and 46.5	26
XXIX.	Combining in a single paragraph all provisions contained in Rule 26 that relate to the marking of sheets	Rules 26.4 and 26.5	28
XXX.	Doing away with the notification and publication of certain events irrelevant under the circumstances	Rules 29.2, 48.6 and 92 <i>quinquies</i>	30

	Objective	Provisions to be amended	Page
XXXI.	Including certain patent documents published in the Spanish language into the PCT minimum documentation; including the Spanish language among the languages of international publication of international applications	Rules 34.1 and 48.3	36
XXXII.	Specifying the time limit for international search in the PCT Regulations	Rule 42.1	40
XXXIII.	Simplifying the communication under Article 20 of the international application; changing the date which is relevant for an indication in the pamphlet if certain events have not occurred before that date	Rules 47.1, 47.2 and 48.2	42
XXXIV.	Including in the publication of the international application in a language other than English also an English translation of any text matter pertaining to figures of drawings accompanying the abstract	Rule 48.3	48
XXXV.	Making clear the consequences if a demand is made by an applicant not entitled to do so, and providing for a refund of the preliminary examination fee in such a case	Rules 54.3, 54.4 and 58.3	50
XXXVI.	Providing for a notification to the applicant by the International Preliminary Examining Authority, rather than the International Bureau, in case of attempted elections made in the demand	Rule 60.3	54
XXXVII.	Providing for an invitation to the applicant where the International Preliminary Examining Authority needs the priority document but the International Bureau has not received it under Rule 17.1	Rule 66.7	56
XXXVIII.	Making uniform for all receiving Offices the manner of computing time limits	Rule 80.6	58
XXXIX.	Fixing a time limit for the possibility of making certain changes in the request and or the demand	Rules 92 <i>bis</i> .1 92 <i>bis</i> .2	60

EXPLANATIONS OF THE PROPOSED AMENDMENTS

XXI. Informing the designated Offices where the priority claim is cancelled or the filing date of the earlier application is corrected; allowing in the Administrative Instructions to provide for the inclusion in the request of additional optional indications

(Concerns Rules 4.10 and 4.17)

1. Ad Rule 4.10(d). This rule provides that, if the international application contains a priority claim and the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the priority claim is to be cancelled *ex officio* unless the filing date of the earlier application was erroneously indicated and is corrected by the applicant; the International Bureau must notify the applicant and the International Searching Authority of the cancellation or correction but not the designated Offices.
2. However, the designated Offices which have been informed, in the notification sent to them by the International Bureau (of receipt of the record copy under Rule 24.2(a)), of the filing date of the earlier application as indicated in the request, have an interest in being also informed of the said cancellation or correction, since the computation of the date after which national processing may start is based on that date. It is therefore proposed to amend Rule 4.10(d) so that the International Bureau will have to notify all designated Offices of the cancellation or correction if the cancellation or correction concerns an international application whose receipt was already notified to them by the International Bureau under Rule 24.2(a). Such notification would allow the designated Offices to correct their records of pending international applications.
3. Ad Rule 4.17. Rule 4 prescribes and enumerates the mandatory and optional contents of the request. It has been revised several times. The latest amendments were required in connection with the revision of the request form (Form PCT/RO/101).
4. The main objective of the amendment now proposed is to allow certain future modifications in the request form without having to resort to the relatively cumbersome procedure of amending the Regulations. Such modifications would be specified in the Administrative Instructions rather than the Regulations. Naturally, such modifications could only be of a nature which are not contrary to the Treaty or the Regulations; in particular, they cannot increase the requirements with which the request must comply. But they may allow the applicant to make statements in the request useful to him. This is why the proposed new sentence of paragraph (a) would allow—but would not permit to require—the inclusion of matters in the request which are not provided for in Rules 4.1 to 4.16 but which could, in the future, be specified in the Administrative Instructions. Had the proposed amendment been in force at the time of the above-mentioned revision of the request form, Rule 4.1(c), for example, would not have had to be changed since what that revision provided for was a permission—not an obligation—given to the applicant, namely, the permission to ask, in the request, the receiving Office to submit the priority document to the International Bureau.

TEXT OF THE PROPOSED AMENDMENTS

Rule 4The Request (Contents)

4.1 to 4.9 [No change]

4.10 Priority Claim

(a) to (c) [No change]

(d) if the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within 1 month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled *ex officio*. The receiving Office effecting the correction or cancellation shall notify the applicant accordingly and, if copies of the international application have already been sent to the International Bureau and the International Searching Authority, that Bureau and that Authority. If the correction or cancellation is effected by the International Bureau, the latter shall notify the applicant and the International Searching Authority accordingly. Any designated Office which has been notified under Rule 24.2(a) of the receipt of the record copy shall be notified by the International Bureau of any correction or cancellation made under this paragraph.

(e) [No change]

4.11 to 4.16 [No change]

4.17 No Additional Matter

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.16. The Administrative instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that referred to in paragraph (a), the receiving Office shall *ex officio* delete the additional matter.

XXII. Omitting any drawing from the publication of the abstract where no drawing is useful for the understanding of the abstract
(Concerns Rules 8.2 and 48.2)

1. Ad Rule 8.2. Under Rule 3.3(a)(iii), the applicant must indicate the number of the figure of the drawings which he suggests should accompany the abstract when the abstract is published on the front page of the pamphlet and in the Gazette; in exceptional cases, the applicant may suggest more than one figure. Under present Rule 8.2, if the applicant fails to make that indication, or if the International Searching Authority finds that a figure (or figures) other than that figure (or figures) suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, the said Authority must indicate the figure (or figures) which it so considers, and that figure (or figures) will be used by the International Bureau in its publications, that is, both in the pamphlet and in the Gazette (see Rules 48.2(b)(ii) and 86.1(i)).
2. International Searching Authorities have found, in some cases, that none of the figures of the drawings—even if one or some were suggested for accompanying the abstract—would help in understanding the abstract. Consequently, it is proposed to allow the International Searching Authority to suggest that no drawing should accompany the abstract and the International Bureau would proceed accordingly. This change would be expressed in what would be a new paragraph (paragraph (b)) of Rule 8.2.
3. The existing (sole) paragraph of Rule 8.2 would become paragraph (a). It would refer, where necessary, to the exception contained in paragraph (b) and its drafting would be improved.
4. Ad Rule 48.2. The amendment proposed to Rule 48.2(b)(ii) is consequential to the amendment of Rule 8.2.

Rule 8The Abstract

8.1 [No change]

8.2 Figure

(a) If the applicant fails to make the indication referred to in Rule 3.3(a)(iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall, subject to paragraph (b), indicate the figure or figures which it so considers. In such case, publications of the abstract by the International Bureau shall be accompanied by the figure or figures so indicated by the international Searching Authority. Otherwise, the said publications shall, subject to paragraph (b), be accompanied by the figure or figures suggested by the applicant.

(b) If the international Searching Authority finds that no drawing is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, publications of the abstract by the international Bureau shall not be accompanied by any drawing even where the applicant has made a suggestion under Rule 3.3(a)(iii).

8.3 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) [No change]

(b) Subject to paragraph (c), the front page shall include:

(i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions,

(ii) a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies,

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first.

(c) to (e) [No change]

(f) [See document PCT/CAL/I/2, page 37]

(g) and (ii) [See page 45, below]

(i) [No change]

48.3 [See pages 39 and 49, below]

48.4 and 48.5 [No change]

48.6 [See page 33, below]

XXIII. Simplifying the wording of Rule 13bis.7
(Concerns Rule 13bis.7)

1. The present text of Rule 13bis.7(b) provides, among other things, for notifications to be effected before the entry into force of Rule 13bis. Such entry into force occurred on January 1, 1981, and thus is in the past. It is proposed to delete any reference to both the said event and to future changes in the national law.

2. The proposed remaining text of Rule 13bis.7(b) would institute a permanent requirement that the national Offices must notify the International Bureau of the depositary institutions with which deposits may be made. Such a requirement clearly implies that, should a change occur with respect to such institutions, such change would have to be notified to the International Bureau.

Rule 13bis

Microbiological inventions

13bis.1 to 13bis.6 [No change]

13bis.7 National Requirements: Notification and Publication

(a) [No change]

(b) Each national Office shall notify the International Bureau* of the depositary institutions with which the national law permits deposits of microorganisms to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.

(c) [No change]

* The amendment consists of deleting, after the word "Bureau," the following words: "a first time before entry into force of this Rule and then each time a change occurs."

XXIV. Clarifying the date of payment of certain fees and of the effective date in case of new amounts of those fees

(Concerns Rules 15.4 and 57.3)

1. Ad Rule 15.4(a) and (b). From many questions raised by applicants, it appears that the present text of Rule 15.4 is not always readily understood, in particular as far as the time of payment of the designation fee is concerned. This comes from the fact that Rule 15.4 deals, in its present wording, with the time of payment of the basic fee and with the time of payment of the designation fee and that, although the regimes applicable to those two fees are different, they are not clearly separated from each other (see paragraph (c) of the present Rule 15.4). For the sake of clarity, it is proposed to redraft the present contents of Rule 15.4 so that paragraph (a) would deal with the time of payment of the basic fee (including the permission for later payment of the basic fee, which is presently covered by paragraph (c)) and paragraph (b) would deal with the time of payment of the designation fee (including the permission for later payment of the designation fee, which is presently covered by paragraph (c)). (Paragraph (c), whose present contents would be included in paragraphs (a) and (b), would contain a new provision whose contents are explained in paragraphs 4 to 6, below.)
2. The proposed new wording of paragraph (a) of Rule 15.4 would deal with the time of payment of the basic fee and would contain only one change of substance, which concerns the extended period for the later payment of the basic fee. Under the present text, the receiving Office may grant an extension of up to one month, which means that the extension may be one week, two weeks, or any other period up to one month. It is now proposed to provide for a uniform period for later payment of one month, which corresponds to the present practice of all receiving Offices permitting later payment. This change would contribute to standardizing the time limits under the PCT.
3. The proposed new wording of paragraph (b) of Rule 15.4 would deal with the time of payment of the designation fee. It consists of two sentences. The first sentence covers the case where the international application contains no priority claim and makes it clear that the period for payment of the designation fee is always and in all receiving Offices one year from the date of receipt of the international application. The second sentence covers the case where the priority of an earlier application is claimed in the international application and makes it clear that the designation fee must be paid before the expiration of one year from the priority date or, where the receiving Office permits later payment, within one month from the date of receipt of the international application, whichever period expires later. (This means in practice, that an applicant would benefit from the additional month for paying the designation fee only if he filed the international application during the 12th month from the priority date, because, if he filed the international application before the expiration of the 11th month from the priority date, the priority year would expire later than the additional month granted for later payment.) The only change in substance which is proposed is that the period for later payment would always be one month, for the reasons outlined in paragraph 2, above.
4. Ad Rule 15.4(c). The present Rule 15 does not say clearly whether, if the amount of the international fee is changed (be it a change of the amount as set out in the Schedule of Fees or be it a change of an equivalent amount in a prescribed currency), the new amount is payable also by applicants who have filed their international applications prior to the date on which the new amount becomes effective but are permitted—and use such permission—to make a later payment of the basic fee, the designation fee or both of these fees.
5. It is proposed to amend Rule 15 by making it clear in paragraph (c)—whose contents would be completely different from its present contents—that the amount which must be paid is the amount applicable on the date of payment and not the amount applicable on the date of receipt of the international application. If the latter were the case, the former amount of the designation fee would be payable up to one year after the entry into force of the new amount of the designation fee. Such parallel application of two different amounts for the same fee would be confusing and should be avoided, and the new amount should be applied in all cases as of the date on which it has become effective.

Rule 15

The International Fee

15.1 to 15.3 [No change]

15.4 Time of Payment

(a) The basic fee shall be due on the date of receipt of the international application. However, the receiving Office may permit applicants to pay the basic fee within one month from that date, provided that such later payment shall not be subject to any surcharge and shall be without loss of the international filing date.

(b) Where the international application does not contain any priority claim under Article 8, any designation fee shall be paid within one year from the date of receipt of the international application. Where the international application contains any priority claim under Article 8, any designation fee shall be paid prior to the expiration of one year from the priority date; however, the receiving Office may permit applicants to pay any designation fee within one month from the date of receipt of the international application, provided that such later payment shall not be subject to any surcharge and shall be without loss of the designations to which the payment relates.

(c) If the amount of the basic fee or of the designation fee as set out in the Schedule of Fees or any corresponding amount in any prescribed currency is changed and the new amount becomes applicable after the date of receipt of the international application, the new amount shall apply to any payment of the basic fee or of any designation fee made on or after the date on which the new amount becomes applicable.

15.5 [No change: remains deleted]

15.6 [No change]

6. The proposed amendment would not involve particular risks for applicants who pay—inadvertently—less than the new amount since any difference between the amount paid and the new applicable amount would be charged to the International Bureau under Rule 16*bis*. Since it is also proposed to make Rule 16*bis* applicable for all receiving Offices, no applicant would risk losing his application if he pays the amount applicable on the date of receipt of the international application not knowing that the amount has changed in the meantime.
7. It is to be noted that—through the reference in Rule 16.1(f) to Rule 15.4—the provisions of the proposed Rules 15.4(a) and (c) would also apply to the time of payment of the search fee.
8. [Ad Rule 57.3](#). The amendment to this Rule, which consists of adding to it a new paragraph (e), is proposed to apply to the payment of the handling fee or of the supplement to the handling fee the same principles laid down in the proposed new text of Rule 15.4(c) for the international fee. It involves likewise no risk for the applicant if he pays less than the new amount since, where the required amount has not been paid on the due date (namely, when the demand or the later election was submitted), the applicant is invited to pay the missing amount and, if he complies with the invitation, the fee is considered to have been paid on the due date (see Rules 57.4(a) and (b) and 57.5(a) and (b)).

Rule 57

The Handling Fee

57.1 and 57.2 [No change]

57.3 Time and Mode of Payment

(a) to (d) [No change]

(e) If the amount of the handling fee or of the supplement to the handling fee as set out in the Schedule of Fees or any corresponding amount in any prescribed currency is changed and the new amount becomes applicable after the date of submission of the demand or of the later election, the new amount shall apply to any payment of the handling fee or of the supplement to the handling fee made on or after the date on which the new amount becomes applicable.

57.4 to 57.6 [No change]

XXV. Providing for quicker information of the International Bureau where charges are made under Rule 16bis, and providing for the universal application of that Rule
(Concerns Rule 16bis.1 and 16bis.3)

1. Ad Rule 16bis.1(d). The present Rule provides, where charges to cover amounts of fees not paid by the applicant have been made to the International Bureau, that the receiving Office must inform the International Bureau each month.
2. Experience has shown that it can happen that the information about any charges made to the International Bureau is being received at a time when the International Searching Authority has already started searching the international application. Such situation could to a large extent be avoided if the International Bureau would receive information about any charges made to it under Rule 16bis.1 as early as possible.
3. It is therefore proposed to amend Rule 16bis.1(d) by providing for the information to the International Bureau to be made promptly after the latter has been charged. The proposed amendment would allow an earlier invitation to pay under Rule 16bis.2 and consequently earlier clarity about effective payment of any fee which had so far not been (completely) paid by the applicant. The proposed amendment would not allow notification of the International Bureau only once a month but would require notification as many times, and promptly, as the receiving Office charges an amount to the International Bureau. Since the cases are rare, no real increase in the workload of the receiving Offices would occur and, in fact, the proposed amendment already corresponds to the practice of all receiving Offices applying the procedure under Rule 16bis.
4. Ad Rule 16 bis.3. It is recalled that Rule 16bis was adopted by the PCT Assembly in June 1980, and entered into force on October 1, 1980. When discussing the proposal for Rule 16bis, some delegations felt that they could not accept such a Rule if it were to enter into force only a few months later.
5. By September 1, 1980, notifications under Rule 16bis.3 had been received from the receiving Offices of Australia, Austria, Hungary and Japan. The receiving Office of Austria withdrew subsequently its notification so that at present Rules 16bis.1 and 16bis.2 are not applicable in the receiving Offices of the remaining three States only.
6. The present proposal to delete Rule 16bis.3 is made in the hope that by the time such deletion would come into effect, the three countries in question would also be in a position to accept Rules 16bis.1 and 16bis.2—clearly in the interest of their nationals—and thus withdraw their notifications under Rule 16bis.3. Such withdrawals would allow the proposed deletion of the said Rule.

Rule 16bis

Advancing Fees by the International Bureau

16bis.1 Guarantee by the International Bureau

(a) to (c) [No change]

(d) The receiving Office shall inform the International Bureau promptly of any charge made under paragraphs (a) and (b).

16bis.2 [No change]

16bis.3 [Deleted]

XXVI. [Clarifying various questions concerning the submission of the priority document and the furnishing of copies thereof](#)

(Concerns Rules 17.1 and 17.2)

1. [Ad Rule 17.1\(c\)](#). Under Rule 17.1(a), where the priority of an earlier national application is claimed under Article 8 in the international application, the applicant must submit, generally within 16 months after the priority date, a certified copy of such earlier application (“the priority document”) to the receiving Office or the international Bureau. If the priority document has been submitted to the receiving Office, that Office must transmit it to the International Bureau. Under Rule 17.1(b), the applicant may, instead of submitting the priority document, request the receiving Office to transmit it to the international Bureau, if the earlier application, the priority of which is claimed, had been filed with that Office.
2. Rule 17.1(c) provides that where the requirements of neither of paragraphs (a) and (b) of Rule 17.1 are complied with, any designated State may disregard the priority claim. Those requirements are the following: (i) the applicant must—within the prescribed time limit—submit the priority document or must request the receiving Office to transmit it to the International Bureau and (ii) where the receiving Office is involved, that Office must submit the priority document to the International Bureau. Present Rule 17.1(c) seems to mean that the priority claim may be disregarded by any designated State if [either](#) of the requirements mentioned under (i) or (ii) is not complied with. This may lead to the undesirable result that, where the applicant complied with the Rule but the receiving Office failed to transmit the priority document to the International Bureau, the applicant may lose his priority claim.
3. It is therefore proposed to amend Rule 17.1(c) by making it clear that the priority claim may only be disregarded if [the applicant](#) did not comply with the requirements of either Rule 17.1(a) or Rule 17.1(b). Failure of the receiving Office to transmit the priority document to the International Bureau would not result in such a serious sanction since the applicant should not be blamed for mistakes made by the receiving Office. Should it really happen—it has not happened so far and it is unlikely to happen in the future—that the receiving Office fails to transmit the priority document to the international Bureau, that Bureau will, should it be informed about such failure, remind the receiving Office to transmit the priority document promptly and then furnish copies to the designated Offices under Rule 17.2(a). Such a procedure would be provided for in the Administrative Instructions, and no amendment to the Regulations is deemed to be necessary in this respect.
4. [Ad Rule 17.1\(d\)](#). This Rule prescribes, in the first and third sentences, the recording of the date on which the International Bureau has received the priority document and the notification of the applicant and of the designated Offices of such date. The second sentence of this Rule (“Where applicable, the date of receipt by the receiving Office of a request referred to under paragraph (b) shall be recorded as the date of receipt of the priority document.”) contains details on the question of which date has to be indicated. Since the important fact to be recorded (and notified) is [whether](#) the applicable time limit referred to in Rule 17.1(a) has been complied with—and not, if the time limit has been complied with, [the date](#) on which the relevant event occurred (i.e., submission of the priority document to the International Bureau or to the receiving Office under Rule 17.1(a), or submission of a request to the receiving Office for transmitting the priority document to the International Bureau, under Rule 17.1(b))—it is proposed to record (and notify) the date on which the International Bureau received the priority document in all cases where the said time limit was complied with and to record (and notify) the date on which the receiving Office received the priority document or the request to transmit the priority document to the International Bureau [only](#) in those cases where the said time limit was not complied with. It is proposed to provide for these administrative details in the Administrative Instructions rather than the Regulations and, consequently, delete Rule 17.1(d).

Rule 17

The Priority Document

17.1 Obligation to Submit Copy of Earlier National Application

(a) and (b) [No change]

(c) If the requirement of neither of the two preceding paragraphs are complied with by the applicant, any designated State may disregard the priority claim.

(d) [Deleted]

17.2 Availability of Copies

(a) [No change]

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application. After such publication, the International Bureau shall, upon request and subject to reimbursement of the cost of the service, furnish to any person copies of the priority document.

(c) Paragraphs (a) and (b) shall apply also to any earlier international application whose priority is claimed in the subsequent international application. The certification of the earlier international application shall be given by the International Bureau.

5. The contemplated provisions of the Administrative Instructions could read as follows:

[“Section 411](#)

(a) Subject to paragraph (b), the International Bureau shall record the date on which the priority document has been received by it and shall notify the applicant and the designated Offices accordingly.

(b) Where the priority document has been received by the International Bureau from the receiving Office after the expiration of 16 months from the priority date, the date of receipt by the receiving Office of the priority document or of a request under Rule 17.1(b), as the case may be, shall be recorded as the date of receipt of the priority document.

(c) Where the date of receipt of the priority document is later than the date of expiration of the time limit referred to in Rule 17.1(a), the International Bureau shall notify the applicant and the designated Offices accordingly.”

6. [Ad Rule 17.2\(b\)](#). The present text of Rule 17.2(b) provides that copies of the priority document may not be made available to the public by the International Bureau prior to the international publication of the international application, but it is not said that they must be made available after such publication. Such obligation exists only where Rule 94.1 applies, namely, where the applicant requests himself the furnishing or has authorized a third party to make such request.

7. The International Bureau has received, after the international publication of the international applications concerned, several requests for copies of priority documents from third parties which were not authorized by the applicant. As no obligation exists to furnish such copies, the International Bureau has, so far, referred the third party to the Office with which the earlier application was filed or to the designated Offices. The main reason for this practice is that the International Bureau does not know whether the earlier application (or the patent granted on the basis of that application) has already been published and, thus, whether it is still to be kept confidential by the Office with which it was filed. It is recognized that third parties may have an interest in the priority document, but the question is whether it should be the International Bureau which should make copies of the priority document available to third parties.

8. It is proposed that the International Bureau have the obligation to make copies of the priority document available to any third party, on such party's request and expense, after the international publication of the international application, even if the requesting party does not produce an authorization by the applicant. It is proposed to amend Rule 17.2(b) accordingly.

9. [Ad Rule 17.2\(c\)](#). The obligation of the applicant to submit, under Rule 17.1(a), the priority document applies where the earlier application (the priority of which is claimed in the international application) is a “national” application. In accordance with [Article 2](#)(vi), any reference to a “national application” is to be construed as a reference to an application for a national or regional patent, but not to an international application filed under the PCT. Therefore, where the applicant claims the priority of an earlier international application, the applicant is not required to file a copy of the priority document.

10. On the other hand, Rule 17.2(a) prescribes that the International Bureau must, at the specific request of the designated Office, furnish a copy of the priority document to that Office. This includes, according to Rule 17.2(c), a copy of any earlier international application whose priority is claimed in the subsequent international application.

11. In order to fulfil its obligation under Rule 17.2(a) and (c), the International Bureau furnishes a certified copy of the pamphlet publishing the earlier international application. All designated Offices have been informed about such practice through Circular letter C. 139/PCT 211 of January 27, 1981. None of the designated Offices objected to it. In order to confirm that practice, it is proposed to add a second sentence to Rule 17.2(c) to the effect that the copy of the earlier international application would be certified by the International Bureau (rather than by the Office with which the earlier international application was filed).

XXVII. Cancelling the obligation of the receiving Office to reimburse to the International Bureau the cost of making a substitute search copy
(Concerns Rule 23.1)

1. The second sentence of present Rule 23.1(b) provides that “Unless the International Searching Authority has erred in alleging that it was not in possession of the search copy by the expiration of the 13th month from the priority date, the costs of making a copy for that Authority shall be reimbursed by the receiving Office to the International Bureau.”

2. The International Bureau remembers only two cases where it had to prepare a copy of the international application and to send it to the International Searching Authority under the first sentence of this Rule. In both cases, it could not be clearly established whether the International Searching Authority erred or not. The administrative costs involved in establishing such facts and the invoicing of costs is higher for the International Bureau than the cost of making a copy. Therefore, it is proposed to delete the second sentence of Rule 23.1(b).

Rule 23

Transmittal of the Search Copy

23.1 Procedure

(a) [See document PCT/CAL/I/2, page 11]

(b) If the International Bureau has not received, within 10 days from the receipt of the record copy, information from the International Searching Authority that that Authority is in possession of the search copy, the International Bureau shall promptly transmit a copy of the international application to the international Searching Authority.*

(c) [No change]

* The amendment consists of deleting the second sentence of this paragraph. That sentence is quoted in the explanations (opposite page).

XXVIII. Deleting the requirement to mark all sheets of the international application and all replacement sheets with the stamp of the International Bureau
(Concerns Rules 24.1 and 46.5)

1. Ad Rule 24.1. Under the present Rule, the International Bureau must mark on the request sheet the date of receipt of the record copy and on all sheets of the international application the stamp of the International Bureau.
2. It is proposed to amend this Rule by deleting the requirement that all sheets of the international application must be marked with the stamp of the International Bureau, since such marking seems to be unnecessary: all sheets of the international application have already been marked under Rule 20.1(a)—or will be marked under Rule 26.4(b)—by the receiving Office with the international application number and can thus be identified as pertaining to a specific international application. Furthermore, it is sometimes not possible to mark sheets with the said stamp without interfering with the text, namely where the applicant failed to leave a 2 cm margin on the bottom of the sheet as prescribed in Rule 11.6(a).
3. Should the proposed amendment be adopted. Section 407(a) of the Administrative Instructions would be amended accordingly.
4. Ad Rule 46.5(b). For the reasons given in connection with the amendment proposed for Rule 24.1(see paragraphs 1 to 3, above), in particular since the international application number is marked on each replacement sheet by the International Bureau, it is proposed to delete from Rule 46.5(b) the requirement to mark on each replacement sheet the stamp identifying the International Bureau.

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 Recording of Date of Receipt of the Record Copy

The International Bureau shall, upon receipt of the record copy, mark on the request sheet the date of receipt and* the stamp of the International Bureau.

24.2 [No change]

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 and 46.4 [See document PCT/CAL/I/3, pages 25 and 19]

46.5 Form of Amendments

(a) [No change]

(b) The International Bureau shall mark on each replacement sheet the international application number and the date on which it was received.** It shall keep in its files any replaced sheet, the letter accompanying the replacement sheet or sheets, and any letter referred to in the last sentence of paragraph (a).

(c) [No change]

*

The amendment consists of deleting the words “on all sheets of the international application.”

**

The amendment consists in deleting the words “, and the stamp identifying the International Bureau.”

XXIX. Combining in a single paragraph all provisions contained in Rule 26 that relate to the marking of sheets
(Concerns Rules 26.4 and 26.5)

1. Rule 26.4 entitled “Procedure” (for correcting certain elements of the international application) requires in its paragraph (b) the marking of each replacement sheet with the date on which it was received. It requires furthermore that the receiving Office keep a copy of any letter containing corrections in its files. The requirement to mark also such a letter with the date on which it was received, however, is contained in Rule 26.5(b) as the only matter of that paragraph.
2. It is proposed to clarify and simplify the text by deleting paragraph (b) of Rule 26.5 and including in Rule 26.4(b)—where it belongs—the requirement to mark letters containing corrections or accompanying any replacement sheet with the date of receipt, thus achieving the grouping of all provisions contained in Rule 26 which relate to the marking of sheets in a single paragraph, namely paragraph (b) of Rule 26.4.

Rule 26

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

26.1 [No change]

26.2 [See document PCT/CAL/I/3, page 15]

26.3 [No change]

26.4 Procedure

(a) [No change]

(b) The receiving Office shall mark on each replacement sheet the international application number, the date on which it was received, and the stamp identifying the Office. It shall mark on the letter containing the correction or accompanying any replacement sheet the date on which that letter was received. It shall keep in its files a copy of the letter containing the correction or, when the correction is contained in a replacement sheet, the replaced sheet, the letter accompanying the replacement sheet, and a copy of the replacement sheet.

(c) and (d) [No change]

26.5 Correction of Certain Elements

(a) [See document PCT/CAL/I/3, page 15]

(b) [Deleted]

26.6 [No change]

XXX. [Doing away with the notification and publication of certain events irrelevant under the circumstances](#)

(Concerns Rules 29.2, 48.6 and 92*quiquies*)

1. [Ad Rules 29.2, 48.6\(b\) and 92*quiquies*.1](#). The present text of Rule 29.2 provides for a notification of the International Bureau by the designated Office in two cases. The first case is where the effect of the international application provided for in Article 11(3) ceased in the designated State concerned by virtue of Article 24(1)(iii), namely, because the applicant failed to perform the acts referred to in Article 22(for entering the national phase) within the applicable time limit.
2. The second case is where the effect of the international application is maintained in the designated State concerned by virtue of Article 24(2), namely, where such effect is maintained (without being required to be maintained by virtue of Article 25(2)) in spite of the existence of one of the four circumstances—enumerated in items (i), (ii) and (iii) of Article 24(1)—causing the ceasing of the said effect. These four circumstances are the following:
 - (i) the applicant withdrew his international application or the designation of the designated State concerned (Article 24(1)(i));
 - (ii) the international application was considered withdrawn (Article 24(1)(ii)) by virtue of:
 - Article 12(3)(no receipt of the record copy by the International Bureau within the prescribed time limit),
 - Article 14(1)(b)(failure to correct certain defects before the receiving Office),
 - Article 14(3)(a)(failure to pay the prescribed fees under Rule 27.1(a), namely, the transmittal fee, the basic fee part of the international fee and the search fee), or
 - Article 14(4)(later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1));
 - (iii) the receiving Office declared that the designation of the designated State concerned was considered withdrawn under Article 14(3)(b), that is, because of failure to pay the prescribed designation fee under Rule 27.1(b)(Article 24(1)(ii));
 - (iv) the applicant failed to perform the acts referred to in Article 22(for entering the national phase) within the applicable time limit (Article 24(1)(iii)).
3. Under the present Rule 48.6(b), the essence of any notification under Rule 29.2—as well as of any notification under Rule 51.4, namely, where the designated Office notifies the International Bureau that the effect of the international application is maintained in the designated State concerned after the review procedure provided for in Article 25—is to be published in the Gazette and, if the notification reaches the International Bureau before preparations for the publication of the pamphlet have been completed, also in the pamphlet.
4. Furthermore, Rule 86.1(iv) provides for the publication in the Gazette of information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned.

Rule 29

International Applications or Designations Considered

Withdrawn under Article 14(1), (3) or (4)

29.1 [No change]

29.2 Notification of Maintaining of Effect by the Designated Office

Where Article 24(1)(ii) applies but the effect of the international application is maintained in any designated State by virtue of Article 24(2), the competent designated Office shall promptly notify the International Bureau accordingly.

29.3 and 29.4 [No change]

Rule 48

International publication

48.1 [No change]

48.2 [See pages 11, above, and 4 5, below, and document PCT/CAL/I/2, page 37]

48.3 [See pages 39 and 49, below]

48.4 and 48.5 [No change]

5. The combination of those Rules is not satisfactory for several reasons. First, no elected Office has the obligation to notify the international Bureau where the effect of the international application ceased in the elected State concerned by virtue of Article 39(2), namely, because the applicant failed to perform the acts referred to in Article 39(1) (for entering the national phase) within the applicable time limit—a case which would correspond to the first case mentioned in paragraph 1, above. Secondly, it is difficult to imagine in which case a designated Office would maintain, under Article 24(2), the effect of the international application where the applicant has withdrawn his international application or the designation of the designated State concerned under Article 24(1)(ii) (see subparagraph (i) of paragraph 2, above). Thirdly, no elected Office has the obligation to notify the International Bureau that the effect of the international application is maintained in the elected State concerned by virtue of Article 39(3) although the applicant failed to perform the acts referred to in Article 39(1) (for entering the national phase) within the applicable time limit—a case which would correspond to the circumstances described in subparagraph (iv) of paragraph 2, above. It is probably for these reasons that not all the designated Offices comply with their obligations under Rule 29.2. On the other hand, the International Bureau has never proceeded with any publication under Rule 48.6(b) or Rule 86.1(iv), mainly because the required notifications under Rules 29.2 and 51.4 have not been received from all designated or elected Offices. Furthermore, such publications would not be complete as far as elected Offices are concerned.

6. Indeed, one can wonder whether there is a real interest in the publication of all the cases referred to in Rules 29.2 and 51.4. With respect to the cases where the applicant failed to enter the national phase in any designated (or elected) State within the prescribed time limit or where the effect of the international application is maintained in a designated (or elected) State although the applicant failed to enter the national phase within the prescribed time limit, such publication would not give the public full and reliable information on the fate of the international applications since it would not cover withdrawals or refusals of protection occurring [during](#) the national phase. On the other hand, it may be interesting, from a statistical point of view, to know the percentage of international applications entering the national phase before a certain designated (or elected) Office and those not entering it. Furthermore, the publication of all cases where the effect of the international application is maintained in the designated State although the international application (or the designation of the State concerned) has been considered withdrawn does not seem to make much sense since the international application itself (or the fact that a designation had been made in the request but was considered withdrawn) has not been published.

7. Consequently, it is proposed to delete Rule 48.6(b), thus deleting all the publications which, under that Rule and at the present time, should be (but, in fact, are not) made. It is furthermore proposed to limit the obligation of the designated Office to notify the international Bureau of individual cases under Rule 29.2 to the cases where the effect of the international application is maintained by the designated Office under Article 24(2) although the international application or the designation of the State concerned was considered withdrawn (Article 24(1)(ii)): it may be useful for the International Bureau to receive such information in order to be able to gradually gain an impression on the circumstances under which applicants may benefit in certain countries from the application of Article 24(2). All other notifications prescribed by the present text of Rule 29.2 could be omitted since they do not serve any other purpose than to provide information for publication by the International Bureau, and such publication is proposed to be deleted.

8. Moreover, it is proposed to introduce a new Rule *92quinquies* into the PCT Regulations. That new Rule would require the designated Offices to furnish once a year statistical information on the number of international applications entering or not entering the national phase. New Rule *92quinquies* would also introduce a similar obligation for elected Offices, which presently are not required to make any notifications in this context to the International Bureau. The proposed new Rule *92quinquies* would allow the International Bureau to receive the information it needs in order to proceed with its publication under Rule 86.1(iv) which, since its present text already permits publication of statistical information, is not proposed to be amended.

48.6 Announcing of Certain Facts

(a) [No change]

(b) [Deleted]

(c) If the international application or the designation of any designated State is withdrawn under Rule 32.1 after the termination of the technical preparations for international publication of the international application, this fact shall be published in the Gazette.

Rule 92quinquies (New)

Ceasing of Effect under Articles 24(1)(iii) and 39(2)

92quinquies.1 Notification

Each national Office shall, once a year, notify the International Bureau of the number of international applications designating or electing it, in respect of which, during the preceding calendar year,

(i) the requirements provided for in Article 22 or in Article 39(1) have been complied with within the applicable time limit;

(ii) the requirements provided for in Article 22 or in Article 39(1) have not been complied with within the applicable time limit.

9. It is to be noted that the foregoing proposals correspond, to a certain extent, to the interpretation of Rule 29.2 given by the Assembly of the PCT Union at its seventh session, held in Geneva from June 29 to July 3, 1981 (see document PCT/A/VII/15, paragraph 38). However, it is the view of the International Bureau, after having consulted the national Offices, that the PCT Regulations would have to be amended in order to give effect to the Assembly's interpretation. On the other hand, it is proposed not to amend Rule 51.4—which was interpreted by the Assembly in the same way as Rule 29.2 and which covers the notification, by the competent designated Office, of the happy (for the applicant) result of the review procedure under Article 25—so that the system under Rule 51.4 and the system proposed in the new wording of Rule 29.2 would be the same.

10. [Ad Rule 48.6\(c\)](#). The present text of Rule 48.6(c) requires the International Bureau to publish, in the Gazette, the fact that the international application has been withdrawn after its international publication, but it does not expressly limit this requirement to withdrawals occurring during the international phase. It is proposed to clarify this issue by making in Rule 48.6(c) a reference to Rule 32.1, which deals with the withdrawal of the international application or of designations and which limits, for the purposes of the international procedure, such withdrawals to those occurring, as a general rule, prior to the expiration of 20 months from the priority date. Thus, it would be clear that the International Bureau would publish the withdrawal of an international application only if it is a withdrawal under Rule 32.1. Any declaration of withdrawal received by the International Bureau after the expiration of the time limit referred to in Rule 32.1 is without legal effect and is consequently not published in the Gazette. Furthermore, it is proposed to make it clear that the withdrawal must be published in the Gazette even where it occurs during the period between the termination of the technical preparations for international publication and the actual international publication of the international application.

11. Furthermore, the present text of Rule 48.6(c) does not provide for the publication, in the Gazette, of the fact that, after the international publication of the international application, the [designation](#) of any designated State (and not the whole international application) is withdrawn. Such fact, however, is published, in practice, by the International Bureau. It is proposed to amend Rule 48.6(c) in order to bring its wording in harmony with the practice.

XXXI. Including certain patent documents published in the Spanish language into the PCT minimum documentation; including the Spanish language among the languages of international publication of international applications

(Concerns Rules 34.1 and 48.3)

1. The PCT Assembly, during its seventh session held in Geneva from June 29 to July 3, 1981, noted an intervention by the Delegation of Spain concerning the bearing of the use of the Spanish language upon its possible accession to the PCT. The Chairman of the Assembly, noting the urgency and importance of that matter in view of its bearing on the participation of Spain and the Latin American countries of Spanish language, said that the question of the use of Spanish language in the PCT system should be pursued with priority (see document PCT/A/VII/15, paragraph 67).
2. It is now proposed to amend Rules 34.1 (Minimum Documentation) and 48.3 (Languages [of the international publication of international applications]) by adding the Spanish language to the languages referred to in those Rules.
3. Ad Rule 34.1. It is proposed that patent documents in the Spanish language should be part of the PCT minimum documentation under the combined conditions laid down now in Rule 34.1(c)(vi) for patent documents in English, French and German of countries other than those referred to in Rule 34.1(c)(i) and (ii) and in Rule 34.1(e) for patent documents in the Japanese and Russian languages, namely. first, if no priority is claimed in them and if the national Office of the interested country sorts out those documents and places them at the disposal of each International Searching Authority, the said documents would be included; second, if any International Searching Authority whose official language is not Spanish wishes to do so, it would be entitled not to include those among the said patent documents for which no abstracts in the English language are generally available.
4. Ad Rule 48.3. It is proposed that, as to the question in which languages an international application must be published by the International Bureau, the Spanish language should have the same status as have, under the present Rules, the English, French, German, Japanese and Russian languages: if the international application was filed in Spanish, it would have to be published in Spanish and in Spanish only. These proposals are reflected in the suggested amendments to paragraphs (a) and (b) of Rule 48.3. (It is to be noted that paragraph (c) of Rule 48.3 would not be amended in this respect and that Rule 86.2(b) would remain unchanged which would mean that if the international application is published in Spanish, the abstract would be published—in the pamphlet containing the international application—in both Spanish and English, that the abstract would be published—in the Gazette entry concerning such application—in English and French, and that the English and French translations would be prepared by the International Bureau.)
5. It is proposed that if, at the time of adopting the amendments to Rules 34.1 and 48.3, no Spanish speaking country is yet party to the PCT, the PCT Assembly decide that the said amendments would enter into force at the same time that the PCT will enter into force in respect of the country which, among Spanish speaking countries, is the first to ratify or accede to the PCT.

Rule 34

Minimum Documentation

34.1 Definition

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) to (v) [No change]

(vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages is not Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan and the Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than 6 months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

Rule 48

International publication

48.1 [No change]

48.2 [See pages 11, above, and 45, below, and document PCT/CAL/I/2, page 3 7]

48.3 Languages

(a) If the international application is filed in English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed.

(b) If the international application is filed in a language other than English, French, German, Japanese, Russian or Spanish, that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit the communication under Article 20 by the prescribed date, or, if the international publication is due at an earlier date than the said communication, to permit international publication by the prescribed date.

Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. if there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

(c) [See page 49, below]

48.4 and 48.5 [No change]

48.6 [See page 33, above]

XXXII. [Specifying the time limit for international search
in the PCT Regulations](#)
(Concerns Rule 42.1)

1. For the reasons outlined in the explanations to the proposed amendment to Rule 69.1(a) in document PCT/CAL/I/3, page 34, paragraphs 4 and 5, it is proposed to fix the time limit for the establishment of the international search report directly in the Regulations. The 3-month or 9-month time limit, which is prescribed as a maximum in present Rule 42.1, is contained in all agreements concluded with the International Searching Authorities and should be maintained. The reference to the agreements could be deleted from Rule 42.1.
2. The second sentence of Rule 42.1 contains transitory provisions for the first three years from the entry into force of the PCT. This transitory period is over and the related text obsolete. It is therefore proposed to delete the second sentence.

Rule 42

Time Limit for International Search

42.1 Time Limit for International Search

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be 3 months from the receipt of the search copy by the International Searching Authority, or 9 months from the priority date, whichever time limit expires later in the given case.*

*

The amendment also consists of deleting the second sentence of Rule 42.1, which reads as follows: “For a transitional period of 3 years from the entry into force of the Treaty, time limits for the agreement with any International Searching Authority may be individually negotiated, provided that such time limits shall not extend by more than 2 months the time limits referred to in the preceding sentence and in any case shall not go beyond the expiration of the 18th month after the priority date.”

XXXIII. [Simplifying the communication under Article 20 of the international application; changing the date which is relevant for an indication in the pamphlet if certain events have not occurred before that date](#)

(Concerns Rules 47.1, 47.2 and 48.2)

1. Present Rule 47.1(b) provides that if, at the time the communication under Article 20 of the international application is effected, the time limit under Rule 46.1 (for making amendments to the claims under Article 19) has not expired and the international Bureau has neither received amendments to the claims nor a declaration that the applicant does not wish to make such amendments, the applicant and the designated Office must be notified accordingly. Similarly, under present Rule 48.2(ii), if, at the time when publication is due, the time limit under Rule 46.1 has not expired, the pamphlet must refer to that fact and indicate that, should amendments to the claims be received later by the International Bureau, they would be published subsequently.
2. Communication under Article 20 is normally effected immediately after international publication. It may occur that, when the time limit under Rule 46.1 expires after the preparation of the pamphlet is achieved but before the communication is effected, amendments or the applicant's declaration are received during that period. In such a situation, the pamphlet, which is used for communication to all designated Offices, contains an indication that the time limit under Rule 46.1 has not expired—which implies that neither amendments nor a declaration have been received from the applicant—but in fact such amendments or such declaration have been received at the time of the communication. Moreover, such an indication on the pamphlet is not true in those cases where the amendments have been received after the termination of the technical preparations for the international publication but before actual publication.
3. It is proposed to bring this somewhat anomalous situation to an end by amending Rules 47.1(b) and 48.2(ii).
4. [Ad Rule 48.2\(g\) and \(h\)](#). Any pamphlet can only reflect the situation that exists at the end of the time of the preparation for the printing ("technical preparations") of the international application, which, naturally, is earlier than the time when publication is due. This applies not only to the indication concerning the time limit under Rule 46.1 for amending the claims under Article 19 (Rule 48.2(ii)) but also to the indication concerning the receipt of the international search report (Rule 48.2(g)). Consequently, it is proposed to replace, both in paragraph (g) and in paragraph (h) of Rule 48.2, the words "at the time when publication is due"—appearing in each of those paragraphs—by the words "at the time of the termination of the technical preparations for international publication."
5. [Ad Rule 47.1\(b\)](#). Since the pamphlet is used for the purposes of communication under Article 20, it seems superfluous to notify again facts which are already indicated in the pamphlet. It is therefore proposed to delete the first half of the second sentence of present Rule 47.1(b) concerning the situation where the time limit under Rule 46.1 has not expired at the time when the communication is effected. The second half of the second sentence of present Rule 47.1(b) should be amended by providing for the subsequent communication (and a corresponding notification of the applicant) of any amendment which was received within the time limit under Rule 46.1 but which was not included in the first communication since it was received after the termination of the technical preparations for the international publication and therefore not included in the pamphlet. (In such a case the amendments will be published under Rule 48.2(ii).)
6. Should the amendment of the time limit under Article 22(2) as proposed in document PCT/CAL/I/2, page 13, be adopted, the last sentence of Rule 47.1(b) would become obsolete, since the communication of an international application within one month from the date on which the International Bureau has been notified by the International Searching Authority of a declaration under Article 17(2)(a)—to the effect that no international search report will be established—is no longer required. The time before which national processing of such application may not start would be 20 months from the priority date and the pamphlet containing a reference to such a declaration (see Rule 48.2(a)(v)) could be used for communication under Article 20.

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) [No change]

(b) Such communication shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication shall be communicated promptly to the designated Offices by the International Bureau, which shall notify the applicant accordingly.

(c) to (e) [No change]

47.2 Copies

(a) and (b) [No change]

(c) Copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.

47.3 [No change]

7. [Ad Rule 47.2\(c\)](#). All designated Offices accept that the International Bureau may use copies of the pamphlet under Rule 48 for the purposes of the communication of the international application and the advantages of this practice are evident. The use of the pamphlet has also brought about considerable economies for the International Bureau and it is proposed to delete the option, which exists in present Rule 47.2(c), that the pamphlet may not be used for the purposes of the communication under Article 20. This would secure that any future designated Office would follow the general practice of all present designated Offices.

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) [No change]

(b) [See page 11, above]

(c) to (e) [No change]

(f) [See document PCT/CAL/I/2, page 37]

(g) If, at the time of the termination of the technical preparations for international publication, the international search report is not yet available (for example, because of publication on the request of the applicant as provided in Articles 21(2)(b) and 64(3)(c)(i)), the pamphlet shall contain, in place of the international search report, an indication to the effect that that report was not available and that either the pamphlet (then also including the international search report) will be republished or the international search report (when it becomes available) will be separately published.

(h) if, at the time of the termination of technical preparations for international publication, the time limit for amending the claims under Article 19 has not expired, the pamphlet shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after such amendments, either the pamphlet (containing the claims as amended) will be republished or a statement reflecting all the amendments will be published. In the latter case, at least the front page and the claims shall be republished and, if a statement under Article 19(1) has been filed, that statement shall be published as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4.

(i) [No change]

48.3 [See pages 39, above, and 49, below]

48.4 and 48.5 [No change]

48.6 [See page 33, above]

XXXIV. Including in the publication of the international application in a language other than English also an English translation of any text matter pertaining to figures of drawings accompanying the abstract
(Concerns Rule 48.3)

1. Under the present Rule 48.3(c), if the international application is published in a language other than English, its publication must include a translation into English of the abstract. Text matter contained in the figure (or figures) accompanying the abstract and published with it is, at present, not required to be published also in English.
2. Interest has been expressed in including in the pamphlet, where a figure published with the abstract contains any text matter, also a translation of such text matter. In most cases, the abstract requires to be accompanied by a figure in order that the technical features of the invention can more readily be understood. If such figure consists of a table or contains explanatory text matter, this purpose may not be served if such text matter is not also in the English language.
3. Consequently, it is proposed to amend Rule 48.3(c) and to provide for the publication in English of any text matter pertaining to the figure (or figures) published with the abstract. The translation of such text matter would be the responsibility of the International Bureau and would not constitute an additional burden since that Bureau has to prepare such translation for publication in the PCT Gazette in the English language anyway. In some cases, it would be possible to present on the front page of the pamphlet a figure with text matter in both the original language and the English language. But in the (more frequent) cases where tables and diagrams are involved, such bilingual solution would not be feasible since the manner in which such tables or diagrams have been drawn up by the applicant does not provide for enough space to include also the translation into English of the text matter. In such cases, the figure would have to be published twice, namely, once with the text matter in English (together with the English text of the abstract) and once with the text matter in the original language (together with the abstract in that original language).

Rule 48

International Publication

48.1 [No change]

48.2 [See pages 11 and 45, above, and document PCT/CAL/I/2, page 37]

48.3 Languages

(a) and (b) [See page 39, above]

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

48.4 and 48.5 [No change]

48.6 [See page 33, above]

XXXV. Making clear the consequences if a demand is made by an applicant not entitled to do so, and providing for a refund of the preliminary examination fee in such a case
(Concerns Rules 54.3, 54.4 and 58.3)

1. Ad Rules 54.3 and 54.4. Present Rule 54.3(b) provides that, in the (exceptional) case of different applicants indicated for the purposes of different elected States, the election of a State is considered not to have been made if none of the applicants indicated for the purposes of that State is qualified to make a demand under Article 31(2)(a).
2. Rule 54 does not contain a provision for the (more common) case where the applicant or, in case of several applicants indicated for the purposes of all elected States, none of them is qualified under Article 31(2)(a) to make a demand.
3. Although there are no doubts about the legal consequence in cases where none of the applicants is qualified to make a demand, it is proposed to clarify the situation by adding a new Rule 54.4 to Rule 54. Paragraph (a) would provide that the demand shall be considered not to have been made if the applicant or, in case of several applicants, none of them is entitled to make a demand. Paragraph (b) would be practically identical to the present text of Rule 54.3(b), which is proposed to be transferred to Rule 54.4 in order for that Rule to cover all cases of applicants not qualified to make a demand.
4. Ad Rule 58.3. Where the demand is considered not to have been submitted because of non-payment of the handling fee or the preliminary examination fee in spite of an invitation to pay (Rules 57.4(c) and 58.2(c)) or because the applicant did not comply with an invitation to correct a defect in the demand (Rule 60.1(c)), a refund of any amount paid as preliminary examination fee is provided for in present Rule 58.3. It seems to be justified to apply the same Rule to the case where the demand would be considered not to have been made under the proposed new Rule 54.4(a). It is therefore proposed to amend Rule 58.3 by including in it a reference to the new Rule 54.4(a).

Rule 54

The Applicant Entitled to Make a Demand

54.1 and 54.2 [No change]

54.3 Several Applicants: Different for Different Elected States

(a) [No change]

(b) [Deleted]

54.4 Applicant Not Entitled to Make a Demand

(a) If the applicant does not have the right or, in the case of several applicants, if none of them has the right to make a demand under Article 31(2)(a), the demand shall be considered not to have been submitted.

(b) If the requirement under Rule 54.3(a) is not fulfilled in respect of any elected State, the election of that State shall be considered not to have been made.

Rule 58

The Preliminary Examination Fee

58.1 and 58.2 [No change]

58.3 Refund

The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted under Rule 54.4(a), Rule 57.4(c), Rule 58.2(c) or Rule 60.1(c), and the International Bureau shall promptly publish such information.

XXXVI. Providing for a notification to the applicant by the International Preliminary Examining Authority, rather than the International Bureau, in case of attempted elections made in the demand
(Concerns Rule 60.3)

1. Present Rule 60.3 provides that, where the applicant has attempted to elect a State which is not a designated State or which is not bound by Chapter II, the International Bureau must notify the applicant that the attempted election is considered not to have been made. This provision applies irrespective of whether the attempted election was made in the demand (any other defect in which must be notified to the applicant by the International Preliminary Examining Authority; see present Rule 60.1(a) and (d)) or in the later election (any other defect in which must be notified to the applicant by the International Bureau; see present Rule 60.2(a)).
2. It is proposed to amend Rule 60.3 and to provide that, where the attempted election is in the demand, the International Preliminary Examining Authority—rather than the International Bureau—must notify the applicant that such attempted election is considered not to have been made. This proposal is made because if it is the said Authority that has to make the notification, the applicant will receive it sooner than if it has to be made by the International Bureau (since the demand has to be first notified to the International Bureau; see Rule 61.1(a)).

Rule 60

Certain Defects in the Demand or Elections

60.1 and 60.2 [No change]

60.3 Attempted Elections

If the applicant has attempted to elect a State which is not a designated State or which is not bound by Chapter II, the attempted election shall be considered not to have been made, and the applicant shall be notified accordingly by the International Preliminary Examining Authority if the attempted election is in the demand or by the International Bureau if the attempted election is in a later election.

XXXVII. Providing for an invitation to the applicant where the International Preliminary Examining Authority needs the priority document but the International Bureau has not received it under Rule 17.1

(Concerns Rule 66.7)

1. Ad Rule 6 6.7(a). Under the present text of Rule 66.7(a), where the International Preliminary Examining Authority requests the International Bureau to furnish to it a copy of the priority document, and where the International Bureau has not yet received the priority document under Rule 17.1(a), the applicant must furnish a copy of the application whose priority is claimed in the international application.
2. It is proposed to amend Rule 66.7(a) by making reference to Rule 17.1 (rather to Rule 17.1(a)), which will make Rule 66.7(a) applicable also to Rule 17.1(b), namely, to the case where the receiving Office is requested to transmit the priority document to the International Bureau under Rule 17.1(b).
3. At the same time, it is proposed to provide that where the International Bureau cannot itself furnish the copy to the International Preliminary Examining Authority (since the International Bureau has not yet received the priority document), it must invite the applicant to furnish a copy direct to the international Preliminary Examining Authority. It is also proposed that, in such a case, the applicant should not be invited to furnish a copy to the International Bureau because what the international Bureau must have is the priority document transmitted under Rule 17.1—namely, a copy of the application whose priority is claimed in the international application, certified by the authority with which the said application was filed—whereas a copy of what the applicant sends to the International Preliminary Examining Authority, if it is not a certified copy, is of no particular use to the International Bureau. Finally, it is proposed to provide that the International Bureau must inform the International Preliminary Examining Authority of the fact that, since it is not yet in the possession of the priority document, it has invited the applicant to furnish a copy direct to the International Preliminary Examining Authority.
4. Ad Rule 66.7(c). This Rule, as it is today, fixes a time limit for the furnishing by the applicant of a copy of the application whose priority is claimed in the international application to the International Preliminary Examining Authority and makes to run that time limit from the date of the request for a copy made by the International Preliminary Examining Authority to the International Bureau. The applicant cannot know the date of such a request since the request was not made to him and since there is no provision that that date must be communicated to him. It is proposed that this Rule be amended so that the time limit should run from the invitation which would be provided under the proposed amendment to Rule 66.7(a) (see paragraph 3, above), an invitation which is sent to the applicant. This result is achieved by omitting the words “request or” in Rule 66.7(c).

Rule 66

Procedure Before the International Preliminary
Examining Authority

66.1 to 66.3 [No change]

66.4 and 66.5 [See document PCT/CAL/I/3, pages 3 5 and 27]

66.6 [No change]

66.7 Priority Document

(a) If the International Preliminary Examining Authority needs a copy of the application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy, provided that, where the request is made before the International Bureau has received the priority document under Rule 17.1, the International Bureau shall invite the applicant to furnish such copy direct to the International Preliminary Examining Authority. The International Bureau shall inform that Authority accordingly.

(b) [No change]

(c) The copy to be furnished by the applicant under paragraph (a) and the translation referred to in paragraph (b) shall be furnished not later than by the expiration of 2 months from the date of the * invitation. If they are not furnished within that time limit, the international preliminary examination report shall be established as if the priority had not been claimed.

66.8 [No change]

* The amendment consists of deleting the words “request or”.

XXXVIII. Making uniform for all receiving Offices the manner of computing time limits

(Concerns Rule 80.6)

1. The PCT Assembly amended, during its fifth session, held in Geneva from June 9 to 16, 1980, the text of Rule 80.6 by adding a second sentence to the text and by adding a second paragraph (paragraph (b)) allowing the exclusion, by any receiving Office that so wishes, of the application of the said second sentence. The national Offices (in their capacity as receiving Offices) of Australia, Denmark, Finland, Japan, Norway and Sweden have notified the International Bureau under this Rule that they exclude the application of the said second sentence.
2. The possibility of excluding the application of the second sentence of Rule 80.6(a) was introduced to allow an early entry into force of the amended Rule for those receiving Offices whose national laws or regulations did not have to be modified in order to comply with the said second sentence or could be modified before the said entry into force. It was, however, the understanding of the Assembly that the exclusion of the application of that second sentence would be a temporary measure and that, after a reasonable period left for amending the national laws or regulations, all Contracting States would apply the second sentence.
3. More than two years have expired since the adoption of the said second sentence and there will be additional time until the amendments now proposed will be adopted and will enter into force. Thus, there was and will be ample time to prepare amendments to the national laws and regulations in the seven countries in question. It is therefore proposed to delete Rule 80.6(b) which allows the exclusion of the second sentence of Rule 80.6(a) and thus make that sentence applicable to all receiving Offices.

Rule 80

Computation of Time Limits

80.1 to 80.5 [No change]

80.6 Date of Documents

(a) [No change]

(b) [Deleted]

80.7 [No change]

XXXIX. Fixing a time limit for the possibility of making certain changes in the request or the demand
(Concerns Rules 92*bis*.1 and 9 2*bis*.2)

1. Ad Rule 92*bis*.1. Under Rule 92*bis*. If certain indications made in the request part of the international application or in the demand may be changed on the request of the applicant or the receiving Office, and the International Bureau must record the change.
2. However, the said Rule does not provide for a time limit after the expiration of which the recording of changes may no longer be requested. It makes no sense to allow recordings of such changes by the International Bureau once the time limit for delaying national procedure has expired since, from the expiration of that time limit, the international application is entirely under the control of the national Offices.
3. Consequently, it is proposed that a new paragraph (paragraph (b)) in Rule 92*bis*.1 provide that the International Bureau would not record the said changes if the request for changes is received by it after the expiration of a certain time limit. If Article 39(1) is applicable with respect to at least one Contracting State (that is, if there is at least one elected State), that time limit would be the time limit referred to in Article 39(1)(a), that is, 25 months (or, if the proposal contained in Chapter XVI (see document PCT/CAL/I/3, page 39) is accepted, 30 months) from the priority date. If Article 39(1) is not applicable with respect to any Contracting State, the time limit in question would be the time limit referred to in Article 22(1), that is, 20 months from the priority date. If the requested change is not recorded due to the expiration of the applicable time limit, the International Bureau would notify the applicant and, if the change was requested by the receiving Office, that Office accordingly (see proposed Rule 92*bis*.1 (c)). The notification sent in such a case to the applicant could explain that the request to record the change should be sent by the applicant to each designated or elected Office.
4. Ad Rule 92*bis*.2. It is proposed to add a sentence to present Rule 92*bis*.2(b), to the effect that in the case of change in the person of the applicant, a copy of the related notification must be sent to both the earlier applicant and the new applicant. If, however, the earlier applicant and the new applicant are both represented by the same agent, which is frequently the case, then, in practice, only one single copy will be sent to the said agent.

Rule 92bis

Changes in Certain Indications in the Request or the Demand

92bis.1 Recording of Changes by the International Bureau

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

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

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration:

(i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;

(ii) of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.

(c) Where paragraph (b) applies, the International Bureau shall notify the applicant accordingly and, if the change was requested by the receiving Office, that Office.

92bis.2 Notifications

(a) [No change]

(b) A copy of each notification sent under paragraph (a) shall be sent to the applicant by the International Bureau. If the change consists of a change in the person of the applicant, the said copy shall be sent to the earlier applicant and the new applicant.

[End of document]