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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE
FOR ADMINISTRATIVE AND LEGAL MATTERS

Third Session, Second Part
Geneva, September 17 to 21, 1990

REPORT
OF THE SECOND PART OF THE THIRD SESSION

adopted by the Committee

INTRODUCTION

1. The third session of the PCT Committee for Administrative and Legal Matters (hereinafter referred to as "the Committee") was reconvened in Geneva from September 17 to 21, 1990, after the Committee had decided at its first part, from July 2 to 6, 1990, to adjourn the session since it could not complete its agenda because of lack of time (see paragraph 1 of the report of the first part of the third session, document PCT/CAL/III/5). Consequently, the present document contains the report of the second part of the session.

2. The following members of the Committee were represented at the second part of the session: (i) the following 18 States, members of the International Patent Cooperation Union (PCT Union): Australia, Austria, Canada, Denmark, Finland, France, Germany (Federal Republic of), Hungary, Italy, Japan, Netherlands, Norway, Romania, Spain, Sweden, Switzerland, United Kingdom and United States of America; (ii) the European Patent Office (EPO), in its capacity as International Searching and International Preliminary Examining Authority.

3. One State, a member of the International Union for the Protection of Industrial Property, (Paris Union), participated in the second part of the session as an observer: Ghana.

4. The following seven non-governmental organizations were represented by observers: Committee of National Institutes of Patent Agents (CNIPA), Federal Chamber of Patent Attorneys (FCPA), Federation of German Industry (BDI), International Association for the Protection of Industrial Property (AIPPI) International Federation of Industrial Property Attorneys (FICPI), Japanese Patent Attorneys Association (JPAA) and Union of Industrial and Employers' Confederations of Europe (UNICE).

5. The list of participants in the second part of the present session is contained in Annex I to this report.

OPENING OF THE SECOND PART OF THE SESSION

6. The session was re-opened by the Chairman of the Committee, elected at the first part of the session, Mr. L. Maassel (United States of America).

AGENDA

7. The agenda for the session, which was adopted by the Committee at the first part of the session, appears as Annex II to this report.

8. In addition to the documents listed in the agenda referred to above, the following documents were presented to the Committee: "Draft Rule 61.4, proposed by the United Kingdom" (PCT/CAL/III/6), "Draft Rule 90*bis*, Comments by the European Patent Office" (PCT/CAL/III/7), "Suggestions concerning Rules 53.7, 53.7*bis*, 54.2, 59, 63 and 67, from the Australian Patent Office" (PCT/CAL/III/8), and "Draft Rules 53.2(a)(v), 53.9, 60.1(e), 69.1(a), (b) and (c), Comments by the Australian Patent Office" (PCT/CAL/III/9).

CONSIDERATION OF PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PCT

9. The Committee considered proposed amendments as appearing in documents PCT/CAL/III/2, 3, 6, 7, 8 and 9 and also several proposals made at the second Part of the session. It approved unanimously the proposed amendments to the following Rules* as appearing in documents PCT/CAL/III/2, 3 and 8: Rules 32, 32*bis*, 48.6(c), 56.4, 57.1(b), 57.2(a) and (b), 57.3(b) and (d), 57.4, 57.5, 60.1(a), 63.1, 70.3, 70.13, 70.14, 71.2(c) and (d), 72.1(a), 73.2, 75, 76.5(11), 80.7(c), 87.2(b), 88.1(ii), 92.2 and 92.3.

10. Concerning the proposed amendments to the Rules referred to below, the Secretariat noted various clarifications and drafting changes proposed by members of the Committee and

* References in this report to "Articles" are to those of the Patent Cooperation Treaty (PCT) and to Rules to those of the Regulations under the PCT or to the proposed Rules contained in the documents referred to in paragraphs 8 and 9.

the representatives of the non-governmental organizations. The International Bureau was requested to prepare revised proposals with due regard to the suggestions made. The following paragraphs reflect only selected important points made in interventions. Other details were noted by the Secretariat.

11. The Delegation of the Netherlands observed that the documents under consideration would benefit, when revised, from the inclusion of a general introductory passage, at the outset, outlining the broad concept underlying several Important proposals which concerned the basis for the international preliminary examination procedure. The Committee-agreed that such an approach should be adopted in preparing revised proposals.

12. Rules 2.2 and 2.2bis. The Committee agreed, in connection with the proposal to amend Rule 90 (see paragraph 67, below), that Rules 2.2 and 2.2*bis* be amended along the lines set out in Annex IV to this report.

13. Rule 4.8. The Committee agreed, in connection with the proposal to amend Rule 90 (see paragraph 67, below), that Rule 4.8 be amended along the lines set out in Annex IV to this report.

14. Rule 53.2(a)(v). The Committee agreed to the proposal as set out in Annex III to this report. The Delegation of the EPO suggested that it would be useful to clarify that the declaration concerned the basis for the start of the international preliminary examination.

15. Rule 53.4. The proposed amendment was agreed by the Committee, subject to a drafting change in the last sentence of the Rule so that the emphasis would be on which applicants should be listed rather than on what the demand should contain.

16. Rule 53.5. The Committee agreed, in connection with the proposal to amend Rule 90 (see paragraph 67 below), that the amendment to Rule 53.5 as proposed in document PCT/CAL/III/3 should not proceed, but that consequential changes to Rule 53.5 would be needed in view of the proposal to amend Rule 90.

17. Rule 53.6. The Committee unanimously agreed to the proposal as set out in Annex III to this report.

18. Rules 53.7 and 53.7bis. It was agreed that the discussion on Rule 53.7, as proposed by the International Bureau, and Rule 53.7*bis*, as proposed by the Delegation of Australia (see document PCT/CAL/III/B), should be taken into account by the International Bureau in preparing, in the light of the new proposal for Rule 4.9 relating to designation of States, a revised proposal for the Committee's next session.

19. The Committee expressed general agreement with the last sentence of Rule 53.7(b) which would provide for the possibility of making a single indication to effect an election of all the States bound by Chapter II designated in the request.

20. Rule 53.8. It was noted by the International Bureau that, consequential to the proposal to amend Rule 4.15 in relation to the request (see paragraph 51 of document PCT/CAL/III/5), a new proposal to amend Rule 53.8 should be presented, so that the proposed new provisions covering signature of the request on behalf of an applicant who refuses to sign, or cannot be found or reached, would also apply to the demand.

21. Rule 53.9. The Delegation of Australia presented a proposal in document PCT/CAL/III/9, which provided for commencement of international preliminary examination, in the usual case, at a fixed time of 20 months after the priority date. The Delegation said that its proposal would make it unnecessary to include a provision such as proposed Rule 53.9 or to include or amend a number of Rules proposed to be changed or included by the International Bureau. Its proposal would obviate the need for the applicant to be required to make decisions regarding amendments in conjunction with the filing of the demand. This was important from the viewpoint of the applicant who wishes to file a demand early to achieve the delaying effect provided by Article 40. It would also mean that more amendments would be filed before the issue of the first written opinion and this would, be to the benefit of applicants and the International Preliminary Examining Authorities. A fixed period, such as 20 months after the priority date, would be readily remembered and worked to by applicants and their professional representatives.

22. There was general agreement with the text as proposed by the International Bureau, subject to an amendment proposed by the Delegation of the EPO to delete the reference to Articles 19(1) and 34(2)(b). It was also suggested that the word “start” or similar be substituted for the words “be carried out”. The Committee agreed to the deletion of the sentence “The declaration is binding for the applicant”. The International Bureau should prepare a revised draft of this proposal for the next session.

23. There was also general agreement that it should be the applicant's responsibility to submit to the International Preliminary Examining Authority copies of amendments, other than amendments under Article 19 which had already been published in the pamphlet, and that no reference should be made in Rule 53.9 to the expiration of the time limit for the filing of such amendments.

24. Rules 54.2 and 54.3. The Committee generally accepted the proposals, subject to minor changes, to refer to “two or more” applicants rather than “several” applicants, and to insert the words “or acting for” between the words “receiving Office of” and “a Contracting State”. It was agreed that Rule 54.3 be deleted.

25. It was recognized that Rule 54.2, as proposed to be amended, represented a liberalization of the present restrictive requirements for filing a demand. Some delegations expressed hesitation as to whether the proposal was consistent with Article 31(2)(a), but it appeared that such a proposal would be within the scope of the provisions of Article 9(3) or could be pursued as an exercise of the PCT Assembly's power to make a decision under Article 31(2)(b) by way of an amendment to the Regulations. The Delegation of the EPO reserved its position. It was agreed that the International Bureau should revise the explanatory notes to set out the position more clearly in this regard.

26. The Delegation of Australia suggested that the existing text of Rule 54.3(i) could be interpreted to permit what, in effect, the International Bureau was seeking to achieve. According to this interpretation the requirement contained in the words “the international application has been filed as provided in Article 31(2)(a)11 was one that would be satisfied by the international application being filed with a competent receiving Office bound by Chapter II of the PCT. Consideration of the State of which the person filing the demand was a national or resident was not, in this interpretation, a requirement of the present text.

27. Rule 54.4. The proposed amendment was agreed, subject to two drafting changes, i.e., the deletion of the words “or an election” from the title of the Rule and the replacement of the word “several” by the words “two or more” in paragraph (a).
28. Rule 56.1. The Committee generally accepted the proposal. Although it was recognized that proposed Rule 56.1(b) represented a duplication of provisions of the Treaty itself, it was also felt desirable that the Regulations make the importance of the 19-month time limit clear for the benefit of applicants. Further, it was believed to be important that the International Bureau should promptly inform the applicant if a later election was submitted after the expiration of 19 months from the priority date. It was agreed that proposed Rule 56.1(b) should be amended accordingly and that a suitable warning to applicants could be included in the demand Form. The Committee was not persuaded by a suggestion that proposed Rule 56.1(c) contravened Article 31(6)(b).
29. Rule 57.6. The proposed amendment was accepted by the Committee subject to revision by the International Bureau in order to specify that the refund of the handling fee would be made by the International Preliminary Examining Authority. In addition, it was agreed to provide in this Rule for refund of the handling fee, under special circumstances, similarly to amended Rule 15.6 relating to the international fee (see paragraph 34 of document PCT/CAL/III/5).
30. Rule 59.1. The Committee accepted the proposal subject to the insertion of the words “of or” between the words “receiving Office” and “acting for”.
31. Rule 60.1(e). The Committee generally accepted the proposal as set out in Annex III to this report.
32. Rule 60.2(a). In connection with the proposed amendment to Rule 60.1(a), it was noted that a similar amendment should be introduced in Rule 60.2(a) relating to the time limit for correction of defects in later elections. The proposal which appears in Annex III to this report was agreed by the Committee.
33. Rule 61.1(b) and (c). The Committee generally accepted the proposed amendment to Rule 61.1(c). Noting the proposed deletion of Rule 54.4(b), it also agreed that Rule 61.1(b) should be amended by deleting the words “or where an election has been considered under Rule 54.4(b) as if it had not been made”.
34. The International Bureau was asked to consider whether the reference in Rule 61.1(c) to the “actual date of receipt by the International Bureau” should be amended in view of the proposed amendment to Rule 56.1(c).
35. Several delegations expressed hesitation in relation to a suggestion that the International Preliminary Examining Authority be responsible for notifying the applicant, in addition to the filing of the demand, of the names of the elected States. While such a notification would enable the applicant to check the correctness of the elections at a slightly earlier stage, it would also increase the workload of the International Preliminary Examining Authorities and the risk of errors.
36. Rule 61.2. The Committee generally accepted the proposal. A suggestion that notifications referred to in Rule 61.2(c) should be sent to elected Offices earlier, where the

Offices so desired, was not pursued in view of the express provisions of Article 38(1). The Delegation of Denmark reserved its position on this point. The International Bureau was asked to consider the need for a provision (e.g., as a new paragraph (d) to Rule 61.2) which would correspond to proposed new Rule 47.4 (see paragraph 64 of document PCT/CAL/III/5).

37. Rule 61.3. The Committee accepted the proposal subject to a minor change by substituting the word “of” for the words “that it has effected”.

38. Rule 61.4. The Delegation of the United Kingdom presented a proposal for a new Rule 61.4, as it appears in document PCT/CAL/III/6.

39. The Delegations of France and the EPO expressed views that their Interested circles would be in favor of provisions that would allow the publication in the PCT Gazette of a notice concerning the application of Chapter II of the PCT to an international application. The Delegations of the United States of America and Japan expressed concern as to the compatibility of the proposal with Article 38. The Delegation of Australia reserved its position.

40. Following an intervention by the Delegation of the EPO, it was noted that the; new Rule should make it clear that it would apply only if the international application had been published.

41. There was further discussion on what should be published in the PCT Gazette: the fact that a demand had been filed and/or the list of the elected States. In conclusion, there was general agreement from the delegations as well as the representatives of non-governmental organizations that the publication of the fact that a demand had been filed would be sufficient.

42. Rule 62. The proposal to delete the Rule was generally accepted as a consequential change following consideration of the other Rules relating to the basis of the international preliminary examination.

43. Rule 66.1(a), (b) and (c). The Committee discussed the proposed amendment at length and agreed that the International Bureau should prepare a revised version of the proposal taking the discussion into account, notably concerning the relationship between amendments made under Article 19 and the procedure under Chapter II as well as the relationship between Rule 66 and Rule 53.9.

44. There was general agreement with the principle that international preliminary examination should be able to commence before the expiration of the time limit for making amendments under Article 19.

45. A majority of the Committee believed that the international preliminary examination procedure should not necessarily take into account amendments under Article 19 made prior to the start of the international preliminary examination; rather, the applicant should have the choice (and the responsibility) of deciding what claims would form the basis of the international preliminary examination report.

46. Rule 66.1(d). The Committee accepted the proposal as set out in Annex III to this report. It was noted that the International Preliminary Examining Authority should have a

discretion whether or not to examine claims in respect of which no international search report had been established. It was suggested that the Guidelines for International Preliminary Examination could contain details as to how the International Preliminary Examining Authority should proceed in cases where it disagreed with the International Searching Authority on questions of subject matter under Rules 39.1 and 67.1 or unity of invention.

47. Rule 66.2(a). The Committee accepted the proposal subject to amendment of subparagraph (vi) as set out in Annex III to this report.'
48. Rule 67.1. The Committee agreed that the proposal for a new subparagraph (vii) for this Rule should not proceed, observing that the provision of sequence listings in computer readable form was important only for the International Searching Authority for the purposes of international search and was sufficiently covered by the proposed amendment to Rule 39.1. The International Preliminary Examining Authority would be provided with any sequence listing which had been provided to or prepared by the International Searching Authority and should not specially require such a listing in computer readable form if the International Searching Authority had conducted the International search without one. Where no such listing had been provided and the international search report had not been established, the International Preliminary Examining Authority would, pursuant to proposed Rule 66.1M, not be obliged to examine the claims concerned.
49. The Delegation of Australia also presented a proposal to amend the Rule (see document PCT/CAL/III/8) but it was not supported by the Committee.
50. Rules 68.1 and 68.2. The Committee decided that, instead of the proposed changes to these Rules, the words "in respect of the entire international application" in present Rule 68.1 should be replaced by the words "in respect of those inventions on which the international search report has been established". The other proposed amendment to Rule 68.1 was then not required. It was generally agreed that the only claims to be considered in the international preliminary examination procedure would be those which the applicant wished to have considered. No amendments would then be required to present Rule 68.2.
51. Rule 69.1. There was general support for the proposed amendment to Rule 69.1, subject to the correction, in paragraph (b), of the reference made to Article 17(2)(a)(i).
52. The Delegation of Australia presented an alternative proposal (see paragraph 21 above) but following the discussions relating to the other proposed amendments designed to ensure an early start of the international preliminary examination, decided not to pursue it further at the session.
53. The Delegation of Japan, even though supporting the general motives behind the proposal, expressed the view that amendments filed under Article 19 within the prescribed time limit should always be taken into account in the international preliminary examination procedure.
54. Rule 70.2(d). The proposed amendment was accepted as set out in Annex III to this report.
55. Rule 70.12. The proposed amendment was generally supported in principle. It was suggested that the International Bureau redraft this Rule and Rule 66.2(a)(i) by using a word

more appropriate than “defect”, and in order to clarify the relationship between Rule 66.2(a)(i) and Article 34(4).

56. Rule 72.2. When discussing Rule 72.1, it was noted that a consequential amendment to Rule 72.2 would be useful and it was agreed that the latter Rule should be amended by replacing the word “each” by the word “any”.

57. Rule 76.5(1v). Delegations expressed different views on the proposal to amend the Rule, but there was general agreement that a solution should be found which would achieve certainty for applicants as well as relieve them of the obligation to furnish translations of superseded amendments which were no longer relevant for elected Offices. The Delegation of the Netherlands was of the opinion that one should distinguish between a translation required under Article 36 (Rule 74) and a translation required under Article 39 (Rule 76). The Committee agreed that the International Bureau should propose a new draft clarifying which amendments should be translated.

58. The Delegation of Australia pointed out that its national law provided specifically that, in case of amendment in the international phase, the national application was the international application as amended under Article 19 or Article 34(2)(b), or both. It was not proposed to change this provision which was consistent with the provisions of the Treaty.

59. In its new proposal, the International Bureau should take into account the need to provide applicants with guidance on the requirements of elected Offices under the applicable national laws. The International Bureau should Send to all elected Offices a circular letter with a questionnaire concerning the various translation requirements of those Offices.

60. An answer needed to be found to the question of what was or should be the effect of amendments under Article 19 If they were not taken into account in the preparation of the international preliminary examination report. There was no agreed view of what version of the international application should be regarded, in such circumstances, as the version which entered the national phase In elected Offices as distinct from the version which entered the national phase in designated Offices. The revised proposal should attempt to clarify these issues.

61. It was generally agreed that the effect and extent of provisional protection after international publication was a matter for the national law and should be distinguished from the question of the content of the translation of the international application to be furnished under Article 39(1)(a).

62. Several delegations indicated that their national laws required translations of all amendments submitted during the international phase, including amendments under Article 19 and even if they were superseded. In this regard, the Delegation of Japan interpreted that the provision of Article 39(1)(a) should also be applied to amendments under Article 19. The International Bureau noted that for Contracting States with such laws transitional provisions might be necessary.

63. The Committee finally noted that, with regard to the provisions of Rule 70.16 relating to the annexes to the international preliminary examination report, a consequential amendment should be considered which would clarify whether amendments under Article 19 needed to be annexed to or referred to in that report.

64. Rule 78.1(a). The proposed amendment, which intended to guarantee the applicant the right to file amendments upon entry into the national phase even when the international preliminary examination report was late, was generally accepted. Several delegations indicated that their national laws already allowed applicants to file such amendments within even more generous time limits.

65. Rule 78.1(b). Consequential to the proposed amendment of Rule 78.1(a), the Committee agreed that Rule 78.1(b) should also be amended by replacing the words “Article 39” by the words “paragraph (a)”.

66. Rule 82.1. The Committee could not agree to the proposal presented by the International Bureau but generally accepted for further consideration a proposal by the Delegation of Australia for a new Rule 82.1(d) along the lines of the text set out in Annex IV to this report. It was explained that recognition of delivery services other than the mail was, under the proposal, optional for national Offices. The qualifications as to proof at the end of paragraph (d) of Rule 82.1, would not apply to paragraphs (a) to (c). The Delegation of Spain expressed the reservation that use of private delivery services in the sense of the proposal would contravene national law relating to filing of documents with the State authorities.

67. Rule 90. The Committee accepted in principle a proposal by the International Bureau that Rule 90 together with Rules 2.2, 2.2*bis*, and 4.8 be amended along the lines set out in Annex IV to this report. It was agreed that the proposal would overcome certain problems-in relation to the Rules concerning representation of applicants (i) by dealing with the question of appointment of agents and common representatives in Rule 90, (ii) by defining “agent” and “common representative” in Rule 2 by reference to the relevant provisions of Rule 90, and, (iii) by limiting Rule 4.8 to prescribing the contents of the request. Consequential changes would then be needed to Rule 53.5 and to Rules 90*bis*.1(b), 90*bis*.2(c), 90*bis*.3(c) and 90*bis*.4(b) (see paragraphs 70 to 81 below).

68. In redrafting these provisions, the International Bureau should take into account, in connection with proposed Rule 90.1*bis*(a), a suggestion by the Delegations of Japan and the EPO that persons eligible for appointment as agents include any person who would be entitled under Article 49 to practice before the competent international authority in respect of the international application if that authority were the national Office with which the application had been filed. The aim should be to enable any person with the right to practice before an international authority to be appointed as an agent for the purposes of the PCT procedure before that authority. In redrafting proposed Rule 90.1*bis*(a), consideration should also be given to dealing separately with the receiving Office and the various international authorities.

69. Several delegations expressed concern that proposed Rule 90.1*bis*(c) might contradict certain national jurisprudence which applied a presumption that an agent, in the absence of an express authorization to the contrary, was not permitted to appoint additional agents. Possibilities were discussed for providing an express power to appoint additional agents by way of a suitable indication in the request and demand Forms, and requiring an express authorization in the power of attorney, if additional agents are to be validly appointed.

70. Rule 90*bis* (general). Proposed new Rule 90*bis* combines and revises various provisions relating to withdrawals presently covered by Rules 32, 32*bis* and 75.1. The Committee agreed to the combining of all such provisions in one Rule. A number of drafting

changes suggested by various delegations were accepted by the Committee. In response to concerns voiced by several delegations and by representatives of non-governmental organizations, the International Bureau confirmed that the PCT Applicant's Guide as well as documents serving as the basis for PCT seminars would provide appropriate information for applicants about the various procedures for withdrawals. There was no need to overburden the Regulations with even more details.

71. Rule 90bis.1. There was general agreement for the proposed amendment relating to the withdrawal of the international application. It was decided to extend the possibility of filing a notice of withdrawal of the application so that, where Article 39(1) applied, the notice could, at the applicant's option, be filed with the International Preliminary Examining Authority. It was stressed that, in order to prevent international publication, the critical date would be that on which the notice reached the International Bureau. The text which was approved by the Committee appears in Annex III to this report, subject to some clarification in paragraph (b).

72. Rule 90bis.2. There was general support for the proposal for withdrawal of designations as set out in Annex III to this report, subject to some clarification in paragraph (c).

73. The issue of double designations (i.e., designation of a State for the purpose of obtaining both a national patent and a regional patent) was brought up by the Delegation of Australia and discussed at length. It was finally agreed that sufficient details could be incorporated in the Administrative Instructions, and that there was no need for amending the Regulations.

74. Rule 90bis.3. The proposed new Rule relating to the withdrawal of priority claims was generally supported after discussion of several points similar to those raised in relation to Rules 90bis.1 and 90bis.2. The proposal, as accepted by the Committee, appears in Annex III to this report, subject to some clarification in paragraph (c).

75. However, the Delegations of France, Japan and the EPO reserved their positions with regard to paragraph (a) of the Rule. The new possibility for a withdrawal of a priority claim after international publication could, in their view, have consequences under the national law in respect of conflicting prior national applications. It was noted that the proposed amendment to Rule 48.6 would provide for the publication of the withdrawal of a priority claim in the PCT Gazette.

76. Rule 90bis.4. The proposed new Rule relating to withdrawal of the demand or of elections was accepted, but the applicant should also have the option of filing a notice of withdrawal with the International Preliminary Examining Authority. Consequently, it was agreed to add the words "or the International Preliminary Examining Authority" after the words "International Bureau".

77. Rule 90bis.5. The proposed new Rule relating to the effect of withdrawal was generally accepted after a lengthy discussion on the merits of this proposal and of a proposal by the Delegation of the EPO (see document PCT/CAL/III/7).

78. The International Bureau commented that, if the proposal of the Delegation of the EPO were to be implemented, several new provisions would be needed in the Regulations and Administrative Instructions providing (i) for elected Offices to inform the International Bureau about any entry into the national phase, (ii) for the International Bureau to inform the

International Preliminary Examining Authority, and (iii) for the latter to resume the International preliminary examination. It was further noted that up to now the problem was merely theoretical. If, in the future, frequent abuses were to occur, the matter could be reviewed then and appropriate measures taken.

79. The Representative of BDI suggested that, if a first written opinion could be issued as the international preliminary examination report, there would be no conflict with Article 38 and the elected Offices would be allowed to obtain a copy of such report, thus limiting the possibility of abuse. This was supported by several delegations and it was agreed that it would be further studied.

80. Rule 90bis.6. he proposed new Rule relating to withdrawal after expiration of time limit was withdrawn by the International Bureau after several delegations questioned the need for such a provision.

81. Rule 90bis.7. The Committee accepted the proposed new Rule subject to renumbering in consequence of the deletion of proposed Rule 90bis.6.

82. Rule 91.1(b) and (c). The Committee generally accepted the proposal to amend Rule 91.1(b) and (c) subject to minor alterations, namely: in paragraph (b), “the error” should be replaced by “an error”, and “by the international filing date” should be replaced by “before or on the international filing date”; and the provisions of paragraph (c) should be made subject to the last sentence in paragraph (b). The Delegation of the EPO suggested that only documents which were submitted on the international filing date should be relevant for rectification. The Delegation of the United Kingdom suggested that rectification should be able to be derived from another paper filed by the applicant before or on the international filing date.

83. The Delegations of the United States of America and Japan expressed concern that the Rule as proposed to be amended went too far by allowing rectification in the light of a range of previously filed documents and without more specific restrictions on the kinds of error which would be rectifiable.

84. The International Bureau was requested, when revising the proposal, to consider the views expressed by the delegations and the possibility of amalgamating the second and third sentences of paragraph (b).

85. Rule 92.4. The Committee generally accepted the proposed amendments to Rule 92.4 as set out in Annex IV to this report subject to further drafting changes in the light of the discussion, particularly the information given by the Delegation of Japan about the very extensive experience of the Japanese Patent Office in receiving documents by facsimile machine. The Delegation of Sweden stated that it preferred the present system in Rule 92.4(a).

86. Rule 96 and Schedule of Fees. The Committee agreed to the deletion of items 4 and 5 and noted that the proposed amendment of item 2 was subject to review in the light of the final provisions of Rule 4.9.

OTHER MATTERS

87. The Delegation of the EPO informed the Committee that it would not at this stage present a proposal for a fee for filing a protest under Rule 40.2(c) (see paragraph 85 of document PCT/CAL/III/5), but would be likely to present a proposal at the next session of the Committee.

88. The International Bureau advised that the next session of the Committee was planned to be held from December 10 to 14, 1990, in Geneva, for consideration of revised proposals for amendment of Rules relating to Chapter I.

89. This report was unanimously adopted by the Committee on September 21, 1990.

[Annexes I to IV follow]

LISTE DES PARTICIPANTS/
LIST OF PARTICIPANTS

I. MEMBRES DU COMITE/MEMBERS OF THE COMMITTEE

(dans l'ordre alphabétique français des noms des États)
(in the French alphabetical order of the names of the States)

ALLEMAGNE (RÉPUBLIQUE FÉDÉRALE D')/GERMANY (FEDERAL REPUBLIC OF)

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AUSTRALIE/AUSTRALIA

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Richard LAZARUS, Lead Legal Examiner, International Division, Patent and Trademark Office, Department of Commerce, Washington, D.C.

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Maarit Helena LÖYTÖMÄKI (Mrs.) Head of Section, National Board of Patents and Registration, Helsinki

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Jacques VERONE, Responsable de la section administrative du PCT et des demandes européennes, Institut national de la propriété industrielle, Paris

Alice de PASTORS (Mme), Ingénieur en chef, Institut national de la propriété industrielle, Paris

HONGRIE/HUNGARY

Margit SÜMEGHY (Mrs.), Head, Legal Section, National Office of Inventions, Budapest

ITALIE/ITALY

Bruno GRADI, Chef de Division, Ministère de l'industrie, du commerce et de l'artisanat, Rome

JAPON/JAPAN

Shigeo TAKAKURA, First Secretary, Permanent Mission, Geneva

NORVÈGE/NORWAY

Ingolf LILLEVIK, Head of Division, Patent Department, Norwegian Patent Office, Oslo

PAYS-BAS/NETHERLANDS

Siep de VRIES, Member of the Patents Council, Netherlands Patent Office, Rijswijk

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Association internationale pour la protection de la propriété industrielle (AIPPI)/International Association for the Protection of Industrial Property (AIPPI): Gaylord E. KIRKER (Vice-président du groupe suisse de (AIPPI)

Chambre fédérale des conseils en brevets (FCPA)/Federal Chamber of Patent Attorneys (FCPA)/Patentanwaltskammer (PAK), Federal Republic of Germany: Eugen POPP (Patent Attorney)

Comité des instituts nationaux d'agents de brevets (CNIPA)/Committee of National Institutes of Patent Agents (CNIPA): Eugen POPP (Patent Attorney)

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Union des confédérations de l'industrie et des employeurs d'Europe (UNICE)/Union of Industrial and Employers' Confederations of Europe (UNICE): Alain DECAMPS (Mandataire européen, représentant, c/o Solvay & Cie, Bruxelles); Reinhard KOCKLAUNER (Representative, c/o Hoechst AG, Frankfurt am Main)

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Vice-Président/Vice-Chairman: Siep de VRIES (Pays-Bas/Netherlands-

Secrtaire/Secretary: Busso BARTELS (OMPI/WIPO)

V. BUREAU INTERNATIONAL DE LIORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Division juridique du PCT/PCT Legal Division: Busso BARTELS, Chef/Head; Vitaly TROUSSOV; Philip M. THOMAS; Isabelle BOUTILLON (Mlle)

[L'annexe II suit/Annex II follows]

ANNEX II

AGENDA

adopted by the Committee

1. Opening of the session
2. Election of a Chairman and two Vice-Chairmen
3. Adoption of the agenda (this document)
4. Consideration of proposed amendments to the Regulations under the PCT (see documents PCT/CAL/III/2, 3 and 4)
5. Other matters
6. Adoption of the report of the session Closing of the session
7. Closing of the session

[Annex III follows]

ANNEX III

This Annex sets out the text of proposals for amendment of certain Rules as referred to in the report and accepted by the Committee. Some of the proposals replace, and others are in addition to, proposals set out in document PCT/CAL/III/3. Where the proposed amendment relates to only a part of a Rule, this Annex reproduces, under the title of the Rule, only that relevant part.

Rule 53.2 Contents

(a)(v) a declaration concerning the basis of the international preliminary examination.

Rule 53.6 Identification of the International Application

The international application shall be identified by* the name and address of the applicant, the title of the invention, the international filing date (if known to the applicant) and the international application number or, where such number is not known to the applicant, the name of the receiving Office with which the international application was filed.

Rule 60.1 Defects in the Demand

(e) Where the demand does not contain a declaration concerning the basis of the international preliminary examination as provided for in Rule 53.2(a)(v), or where such declaration has been made but a copy of any amendment referred to in the declaration is not submitted together with the demand that defect shall not give rise to an invitation under paragraph (a). Nevertheless, the International Preliminary Examining Authority may bring that defect to the attention of the applicant if it issues an invitation under Rule 60.1(a) to correct other defects.

Rule 60.2 Defects in Later Elections

(a) If the later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. It shall not be less than one month from the date of the invitation to correct. The time limit may be extended by the International Bureau at any time before a decision is taken.

Rule 66.1 Basis for the Start of the International Preliminary Examination**

(d) Claims relating to inventions in respect of which no international search report has been established need not be subject to international preliminary examination.

Rule 66.2 First Written Opinion of the International Preliminary Examining Authority

(a)(vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination.

Rule 70.2 Basis of the Report

* The amendment consists in deleting, after the word “by,” the words “the name of the receiving Office with which the international application was filed.”

** The title has been amended to read “Basis for the Start of the International Preliminary Examination” instead of “Basis of the International Preliminary Examination”.

(d) If claims relate to inventions in respect of which no International search report has been established and have therefore not been subject to international preliminary examination, the report shall so indicate and state the reasons therefor.

Rule 90bis Withdrawals

Rule 90bis.1 Withdrawal of the international Application

(a) The applicant may withdraw the international application at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date.

(b) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau, to the receiving Office, or, where Article 39(1) applies, to the International Preliminary Examining Authority. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

(c) There shall be no International publication of the International application if the notice effecting withdrawal reaches the International Bureau before the technical preparations for publication have been completed.

Rule 90bis.2 Withdrawal of Designations

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies in respect of that State, prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of that election under Rule 90bis.4.

(b) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90bis.1.

(c) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau, to the receiving Office, or, where Article 39(1) applies, to the International Preliminary Examining Authority. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

(d) There shall be no international publication of the designation if the notice effecting withdrawal-reaches the International Bureau before the technical preparations for publication have been completed.

Rule 90bis.3 Withdrawal of Priority Claims

(a) The applicant may withdraw a priority claim made in the international application under Article 8(1) at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date.

(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one or more or all of the priority claims.

(c) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau, to the receiving Office, or, where Article 39(1) applies, to the International Preliminary Examining Authority. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

(d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change,

(e) In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international Publication on the basis of the said time limit as commuted from the original priority date if the notice effecting withdrawal reaches the International Bureau during the period of 15 days preceding the expiration of that time limit

[Annex IV follows]

ANNEX IV

This Annex sets out the text of proposals for amendment of certain Rules, as referred to in the report, which were generally accepted by the Committee subject to further revision by the International Bureau. Some of the proposals replace, and others are in addition to, proposals set out in documents PCT/CAL/III/2 and 3. Where the proposed amendment relates to only a part of a Rule, this Annex reproduces, under the title of the Rule, only that relevant part.

Rule 2.2 “Agent”

Whenever the word “agent” is used, it shall be construed as meaning an agent appointed under Rule 90.1bis.

Rule 2.2bis “Common Representative”

Whenever the expression “common representative” is used, it shall be construed as meaning an applicant appointed as, or considered to be, the common representative under Rule 90.1bis.

Rule 4.8 Common Representative *

If a common representative is designated, the request shall so indicate.

Rule 82.1 Delay or Loss **

(d) In case a delivery service, rather than the mail, is used for the sending of a document or letter, a national Office or intergovernmental organization may apply the preceding paragraphs as if:

- (i) the delivery service was an airmail service;
- (ii) sending by the delivery service was mailing;
- (iii) failure of delivery by the delivery service was loss in the mail;
- (iv) a receipt issued by the delivery service was a mail registration by the postal authorities.

Except where the proof is by means of a process established under the national law, proof shall only be accepted from a person having the right to practice before the national Office or intergovernmental organization to which the proof is offered.

* The title has been amended to read “Common Representative” instead of “Representation of Several Applicants Not Having a Common Agent”.

** The title has been amended to read “Delay or Loss” instead of “Delay or Loss in Mail”.

Rule 90 Representation

Rule 90.1 Definitions

For the purposes of Rule 90, “international authority” means the International Bureau, an International Searching Authority or an International Preliminary Examining Authority.

Rule 90.1bis Appointment of Agents and Common Representatives

(a) The applicant or, if there are two or more applicants, each applicant, may appoint as his agent, for the purposes of the procedure before the receiving Office or an international authority, a person who is entitled, under Article 49 or otherwise, to practice before that Office or authority.

(b) An applicant may appoint more than one agent. Different agents may be appointed for the purposes of different procedures.

(c) An agent may, for the purposes of the procedure before a particular international authority, appoint as an additional agent a person who could be validly appointed under paragraph (a), unless such an appointment by, the agent is expressly excluded in the power of attorney by which he was appointed.

(d) If, where there is more than one applicant, all the applicants do not appoint a common agent, one of the applicants who is entitled to file an international application according to Article 9 may be appointed by the other applicants as their common representative. [Different common representatives may be appointed for the purposes of the procedures before different international authorities.]

(e) If, where there is more than one applicant, all the applicants have not appointed a common agent or common representative, the applicant first named in the request who is entitled under Rule 19.1(a) to file an international application with the receiving Office with which the international application was filed shall be considered to be the common representative of all the applicants.

Rule 90.3 Manner of Appointment of Agent or Common Representative*

(a) Appointment of any agent or common representative shall be effected by the applicant, at his choice, either by signing the request or, where applicable, the demand in which the agent or common representative is designated or by a separate power of attorney (i.e., a document appointing an agent or common representative).

(b) The power of attorney shall be submitted to either the receiving Office or the International Bureau unless the appointment was made only for the purposes of the procedure before a particular international authority, in which case the power of attorney shall be submitted to that authority.

* The title has been amended to read “Manner of Appointment of Agent or Common Representative” instead of “Appointment”.

(c) and (d) [No change]

Rule 90.4 [No change]

Rule 92.4 Use of Telegraph, Teleprinter, Facsimile Machine, Etc.*

(a) Notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraphs (b) to (g), the international application or any subsequent documents relating thereto may be transmitted by telegraph, teleprinter, facsimile machine or other like means of communication producing a printed or written document.** The transmitted document shall identify the international application to which it relates. Where the transmitted document is a document making up the international application, or a replacement sheet, or a sheet containing amendments, it shall be accompanied by a statement that the original sheets of the transmitted document will be submitted forthwith.

(b) [No change]

(c) Where the transmitted document is a document making up the international application, if it is not accompanied by the statement referred to in paragraph (a), or if the said original sheets are not received by the receiving Office within 14 days of the date of the transmittal by the means referred to in paragraph (a), an invitation to correct as provided for in Article 14(1)(b) shall be issued. If the applicant does not comply with the invitation within the time limit under Rule 26.2, the international application shall be considered withdrawn.

(d) Where the transmitted document is a replacement sheet or a sheet containing amendments relating to the international application, if it is not accompanied by the statement referred to in paragraph (a), or if the original sheets are not received by the national Office or intergovernmental organization concerned within 14 days of the date of transmittal by the means referred to in paragraph (a), an invitation to correct within a time limit which shall be reasonable under the circumstances shall be Issued. If the applicant does not comply with the invitation within that time limit, the document shall be considered as not having been submitted.

(e) If the transmitted document is not a document making up the international application or a replacement sheet or a sheet containing amendments, the original document shall be submitted only upon invitation, within a time limit which shall be reasonable under the circumstances. If the applicant does not comply with the invitation within the time limit fixed in the invitation, the document shall be considered as not having been submitted.

(f) The original document, where required, shall be submitted in a form complying with the requirements of Rule 11. It shall be accompanied by a letter identifying the earlier transmitted document, the means of communication used and the date of transmittal.

* The title has been amended to read "Use of Telegraph, Teleprinter, Facsimile Machine. Etc." instead of "Use of Telegraph, Teleprinter, Etc."

** The amendment consists in deleting the second sentence of Rule 92.4(a)

(g) A document which is transmitted by facsimile machine and bears a signature shall be regarded as duly signed under these Regulations except where the submission of the original document is required under paragraphs (c) to (f).

[End of Annex IV and of document]