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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**PCT COMMITTEE
FOR ADMINISTRATIVE AND LEGAL MATTERS**

**Fourth Session, Second Part
Geneva, March 11 to 15, 1991**

REPORT
OF THE SECOND PART OF THE FOURTH SESSION

adopted by the Committee

INTRODUCTION

1. The second part of the fourth session of the PCT Committee for Administrative and Legal Matters (hereinafter referred to as "the Committee") was held in Geneva from March 11 to 15, 1991.
2. The following members of the Committee were represented at the second part of the session: (i) the following 21 States, members of the International Patent Cooperation Union (PCT Union): Australia, Austria, Canada, Democratic People's Republic of Korea, Denmark, Finland, France, Germany, Hungary, Italy, Japan, Netherlands, Norway, Poland, Romania, Soviet Union, 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. Five States, members of the International Union for the Protection of Industrial Property (Paris Union), participated in the second part of the session as observers: Côte d'Ivoire*, Indonesia, Philippines, Syria and Turkey.

4. The following six 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) and Union of Industrial and Employers' Confederations of Europe (UNICE).

5. The list of participants is contained in Annex I to this report.

OPENING OF THE SECOND PART OF THE SESSION

6. The second part of the session was opened by the Chairman of the Committee, elected at the first part of the session, Mr. U. Schatz (European Patent Office).

ADOPTION OF THE AGENDA

7. The Committee adopted for the second part of its session the agenda appearing in Annex II to this report.

ADOPTION OF THE FRENCH TEXT OF THE REPORT OF THE FIRST PART OF THE FOURTH SESSION

8. The Committee adopted the French version of the report of the first part of its fourth session as set out in document PCT/CAL/IV/6 (see paragraph 96 of that document). The Delegation of France made the observation that there were certain expressions used in the French version of the proposals contained in Annexes III and IV to that document which should be improved before their submission to the PCT Assembly, and agreed to provide suggestions in writing to the International Bureau.

CONSIDERATION OF PROPOSED AMENDMENTS TO THE REGULATIONS AND MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

9. The Committee considered proposed amendments as appearing in documents PCT/CAL/IV/7, 8 and 9 and also several proposals presented during the meeting. It confirmed its approval at the third session of the proposed amendments to Rules** 53.1(b) and (c),

* Côte d'Ivoire deposited its instrument of ratification of the PCT on January 31, 1991, and will become bound by the PCT as of April 30, 1991.

** References in this report to "Articles" are to those of the Patent Cooperation Treaty (PCT), to "Rules" to those of the Regulations under the PCT ("the Regulations") or to Rules as proposed to be amended, and to "Sections" to those of the Administrative Instructions under the PCT ("the Administrative Instructions") or to Sections as proposed to be modified.

53.2(a), 53.6, 56.4, 57.1(b), 57.2(a) and (b), 57.3(b) and (d), 57.4, 57.5, 59.1, 70.3, 70.13, 70.14, 72.1(a), 72.2, 73.2, 75, 76.5(ii) and (iii), 78.1(a) and (b), 80.7(c), 87.2(b), 88.1(ii), 92.2(a), 92.3 and 96, and the Schedule of Fees.

10. The Committee approved unanimously the proposed amendments to the following Rules as appearing in document PCT/CAL/IV/2: Rules 2.2bis, 4.8, 32, 32bis and 48.6(c).

11. The Committee approved unanimously the proposed amendments to the following Rules as appearing in document PCT/CAL/IV/7: Rules 54.4, 56.1(c), (e) and (f), 57.6, 60.1(a), (c), (c-bis) and (d), 60.2(a), 61.2(b), (c) and (d), 64.2, 64.3, 66.2(a)(i), (iv) and (v), 70.12, 70.16, 71.2(c) and (d), 86.3, 86.4, 86.5, 90.1(b) and (c), 90.2(a), (c) and (d), 90.3(a), (b) and (c), 90.3bis(b), 90bis.1(a) and (c) and 90bis.6.

12. The proposed amendments to the following Rules were approved by the Committee as set out in Annex III to this report: Rules 2.2, 53.4, 53.5, 53.8, 56.1(d), 60.2(c) and (d), 61.1(b) and (c), 66.4bis, 68.1, 70.2(d), 90.1bis, 90.3(d), 90.3bis(a) and 90bis.4.

13. Concerning the proposed amendments to the Rules referred to in the following paragraphs of this report, the Secretariat noted various clarifications and drafting changes proposed by members of the Committee and the representatives of the non-governmental organizations. The International Bureau was invited to prepare revised proposals with due regard to the suggestions made. The following paragraphs reflect only selected important points made in interventions relating to those Rules. Other details were noted by the Secretariat.

14. The Committee approved, subject to further review by the International Bureau, the proposed amendments to the following Rules as set out in Annex IV to this report: Rules 60.1(e), 62.1, 62.2, 66.1, 69.1(b) and (c), 90.1(a) and 90.2(b).

15. Rule 13ter.3. The Committee approved the proposed amendment as set out in Annex III to this report.

16. The Delegation of the EPO advised of its first reaction that it would prefer copies of sequence listings to be published with the international search report or the international application and reserved its position pending further study of the issues involved. The Committee noted that the proposal would result in a discrepancy in the provisions for publication of European patent applications depending on whether they were made direct or via the PCT, but that the proposal would have to apply to all seven International Searching Authorities under the PCT. The Delegation of the Netherlands also reserved its position pending further study.

17. Rule 16.1(a). The Committee considered again the proposal concerning amendment of this Rule submitted by the Delegation of Sweden (document PCT/CAL/IV/3). In response to a request for further study (document PCT/CAL/IV/6, paragraph 34), the International Bureau indicated that proposed Rule 16.1(a) would be difficult to implement because, (1) the receiving Office would have to calculate additional fees, (2) amendments to various rules relating to fees and fee collection would be required, and (3) there would be difficulties in fixing a suitable sanction when the fee for certain claims was not paid.

18. The Delegation of Sweden indicated that the procedure for charging a fee for claims in excess of a certain number (e.g., 25 or 30) would be optional for each International Searching Authority and that such a claims fee would be part of the fee due under Rule 16.1(a). If the claims fee was not paid after invitation, the solution could be either withdrawal of the application or no search of any claims for which the fee had not been paid.

19. The International Bureau indicated that it considered that any such claims fee would be a fee prescribed under Article 3(4)(iv) and therefore non-payment would result in withdrawal of the application under Article 14(3)(a), a rather harsh sanction for such a defect. The Delegation of Australia noted that, if a limit were to be fixed for the number of claims for which no claims fee would be required, the claims could still be drafted in such a way as to avoid the claims fee while not reducing the work involved in performing the search. The introduction of a claims fee would thus not act as a deterrent against those applicants whose international applications would, in any event, require a substantial search effort.

20. A number of delegations expressed sympathy for the concept of a claims fee but agreed that withdrawal of the international application was too harsh a sanction. A solution might be to consider withdrawn those claims for which no claims fee had been paid. The International Bureau was asked by the Committee to consider the matter further. The Delegation of Sweden reserved the right to submit a revised proposal for consideration by the Assembly.

21. Rules 40.2(e) and 68.3(e). The proposed amendments to those Rules, as set out in document PCT/CAL/IV/8, were submitted by the Delegation of the EPO. The Committee approved revised versions of the proposed amendments as set out in Annex III to this report.

22. There was some difference of opinion as to the need to provide for a refund of the proposed protest fee. A majority of the Committee agreed that the Rule should provide for a refund where justified in the circumstances, as set out in the last sentence of each of the proposals as approved. The Delegation of the United States of America supported a refund of the proposed protest fee where the protest was found to be justified and reserved its position in relation to the provision that a refund be made only if it would be "equitable in the circumstances of the case".

23. The Committee recognized that the prior review provided for in the proposals would meet the practical objectives of examination of protests under Rules 40.2 and 68.3. It was suggested by some delegations, however, that the instance conducting the prior review should not include the examiner concerned. The Delegation of the EPO undertook to consider such a possibility, and reserved the right to submit to the Assembly a proposal along those lines as an alternative to the refund provisions.

24. The Committee did not support a suggestion that the protest fee could be established by way of setting different additional fees under Rules 40.2 and 68.3 depending on whether or not a protest was filed.

25. Rule 53.1(a). The Committee confirmed its approval of the proposed amendment at its third session, subject to the insertion in the first line of the word "be" after the words "on a printed form or".

26. Rule 53.7. The proposed amendment was approved subject to the amendment of the first line of paragraph (b) to read "Election of Contracting States shall be made in the

demand:" and to the deletion of the word "or" at the end of paragraph (b)(i). It was noted that this Rule would enable the International Bureau, when revising the demand Form, to insert a pre-printed Box covering the situation under paragraph (b)(iii). The question whether the box should be "pre-checked" was left for further consideration by the International Bureau. The International Bureau further noted that all offices concerned would be consulted when the demand Form was revised. The representatives of non-governmental organizations expressed strong support for the proposal to "pre-check" the box permitting the collective election under paragraph (b)(iii). The Delegations of the Netherlands and the United States of America noted concerns and reserved their positions regarding the pre-checking of the box.

27. Rule 53.9. The Committee agreed that a new Rule 53.9 should be included along the lines of the proposal set out in Annex IV to this report. It was noted that the proposal appeared to resolve the issues of concern in document PCT/CAL/IV/9, which contained a proposal by the Institute of Inventions and Rationalizations of Bulgaria.

28. The representatives of several non-governmental organizations expressed the view that the proposed Rules relating to the taking into account of amendments for the purposes of the international preliminary examination should not be too complex, notably in the declaration referred to in proposed Rule 53.9.

29. In the interests of keeping the system more simple, certain, useful and attractive to applicants, the Delegation of Australia proposed to review the approach with a view to finding a simpler solution. Several delegations expressed sympathy for the proposal, provided that workable details could be formulated. The Delegation of Australia said it would consider submitting workable details to the International Bureau. The International Bureau was invited to study any proposal received from the Delegation of Australia.

30. The Delegation of Japan suggested that the applicant should be able to declare that he did not wish to make amendments under Article 19. The Committee understood that such a possibility was not excluded from the amendment proposal. The Delegation was invited to make that suggestion when discussing the demand form at a later stage.

31. Rules 54.2 and 54.3. The proposed deletion of Rule 54.3, and the proposed amendment to Rule 54.2, as set out in Annex III to this report, were approved.

32. The Delegation of Japan expressed a reservation as to the text originally proposed in document PCT/CAL/IV/7 because it would, in the Delegation's view, enable one applicant who was not a resident or national of a Contracting State bound by Chapter II to file a demand, and thus was inconsistent with Article 31(2)(a). The text as approved by the Committee contained a change designed to ensure that such a possibility could not occur, and the Delegation agreed to give the matter further consideration.

33. The International Bureau observed that the Assembly was entitled under Article 31(2)(b) to extend the right to make a demand to persons other than those specified in Article 31(2)(a) even if they were residents or nationals of a State not party to the Treaty or not bound by Chapter II. The proposal approved by the Committee did not, however, go as far as Article 31(2)(b) permitted.

34. Rule 56.1(a) and (b). The Delegation of the United Kingdom noted that, in view of the proposed amendment to Rule 53.4, a consequential amendment was needed to Rule 56.1 in

order to clarify that any applicant who was not an applicant for any of the later elected States would not need to sign the later election. In addition, since it might happen that an applicant for a later elected State was not an applicant for any of the States elected in the demand and was therefore not indicated in and did not sign the demand, Rule 56.1 should include a statement that any applicant who was indicated in the later election but was not actually indicated in the demand should be deemed to have been so indicated in the demand and that the signature of an applicant in a later election who did not sign the demand should be deemed to be a signature in the demand.

35. The Committee approved the amendments as proposed by the International Bureau as well as the substance of the further suggestions by the Delegation of the United Kingdom. The International Bureau was invited to prepare a revised proposal.

36. Rule 61.3. In connection with the approval of the proposed amendment, and as a result of a suggestion by the Delegation of the United States of America, the Committee agreed that the International Bureau should consider the possibility of developing a proposal for applicants to be notified whether a demand had been filed within the time limit under Article 19. It appeared unlikely, however, that a written procedure would be rapid enough to warn an applicant, where that time limit had not been met, to enter the national phase within the time limit under Article 22. Some International Preliminary Examining Authorities already followed the practice of quickly contacting the applicant informally in such cases, and consideration should be given to incorporating that practice in the PCT Guidelines for International Preliminary Examination.

37. The International Bureau was also invited to consider the inclusion in the demand Form of a check-box, to be filled out by the International Preliminary Examining Authority, indicating whether the demand had been filed within the time limit under Article 19. It would be useful to notify such information to elected Offices.

38. Rule 61.4. The proposed amendment was approved by the Committee.

39. The Delegation of the United Kingdom suggested that the proposed notification in the PCT Gazette of the fact that a demand had been filed should be expanded to provide also for a notification of which States had been elected. This could also be done in the form of a listing of those designated States which had not been elected. The Delegation believed that, alternatively, a system should be established for obtaining that information from contact points in elected Offices. Although the Delegation's suggestions were welcomed by some other delegations and the representatives of some non-governmental organizations, the Committee recognized that there would be practical problems for the International Bureau in publishing such information in the Gazette. The International Bureau agreed to consider further whether the suggestion could be accommodated and whether a revised proposal could be submitted to the Assembly.

40. The Delegation of Japan reserved its position on the proposed amendment to Rule 61.4 and on the suggestion of the Delegation of the United Kingdom, based on the view that Article 38 required the fact of the making of a demand to remain confidential. It believed that Article 38 should be interpreted broadly in favor of applicants. The International Bureau pointed out that information that an Office had been elected was routinely sent to elected Offices under the provisions of Article 31(7), which thus constituted an express exception to the strict confidentiality requirements of Article 38. The elected Offices were not bound to

treat the information thus sent to them as confidential, and were free to make suitable arrangements for its publication. The making of a Rule providing for publication in the PCT Gazette would be a proper and convenient way of allowing access to that information, the collection of which was otherwise cumbersome and costly.

41. Rule 66.2(a)(vi). The proposed amendment was approved by the Committee subject to the insertion of the words "in respect of that claim" after the words "international preliminary examination".

42. Rule 66.8. The representative of BDI presented a proposal relating to the form of amendments and the Committee approved the proposal as set out in Annex III to this report.

43. Rule 73bis. In the light of the discussion on this proposal and proposed Rule 76.5(iv), the Committee agreed that proposed Rule 73bis should be omitted.

44. Rule 76.5(iv). The proposed amendment, on the basis of wording suggested by the Delegation of Japan, was approved as set out in Annex III to this report.

45. The Delegation of the Netherlands reserved its position since in its opinion the claims as amended under Article 19 were part of the international application as published and as communicated to the designated Offices, and were therefore part of the international application, the translation of which could be required by elected Offices under Article 39(1)(a) without taking into account any further developments during international preliminary examination. Such translation of the amendments under Article 19 would put an elected Office needing it on the same footing as an elected Office that was able to process the international application without such a translation. It was only the elected Office concerned that could decide about more lenient conditions as regards the translation of amendments under Article 19. In connection herewith the Delegation indicated that its Office would be prepared to adapt its practice as an elected Office so that no conflict would arise with the practice foreseen under the new Rule 76.5(iv).

46. Rule 76.6. In the light of the Committee's approval of proposed Rule 76.5(iv) and the position taken by the Delegation of the Netherlands, it was agreed that proposed Rule 76.6 should be omitted since a transitional provision was not required.

47. Rule 82.1(d) and (e). The Committee approved inclusion of a proposed amendment along the lines of that set out in Annex IV ' to this report. The Delegation of Japan expressed concern that the proposal might be inconsistent with Article 48. The Delegation of Sweden stated that it would have to consider the proposal further.

48. Rule 90.1(d). The proposed amendment was approved subject to deletion of the word "so" from Rule 90.1(d)(ii).

49. In response to a question from the Delegation of the EPO, it was clarified that there was nothing in the proposal to prevent sub-agents from appointing further sub-agents, if they were so authorized.

50. The Delegation of Italy expressed a reservation based on its view that the proposal might be inconsistent with the provisions of its national law relating to the appointment of

sub-agents. The Delegation of Sweden also expressed a reservation since the consequence of the proposal for the applicant would be contrary to the proceedings under its national law.

51. Rule 90.3. In connection with this proposal, the proposed modifications of Sections 328 and 425, as set out on page 108 of document PCT/CAL/IV/7, and proposed new Sections 512 and 608, as set out on page 110 of that document, were approved. It was noted that the PCT Receiving Office Guidelines could refer specifically to passing on a power of attorney which had been wrongly submitted to the receiving Office.

52. Rule 90.4. The proposed amendment was approved by the Committee, subject to adding the word "concerned" at the end of Rule 90.4(a). The deletion of Section 106 was also approved.

53. In response to the queries of some delegations, the International Bureau emphasized that the "automatic" revocation provisions of Rule 90.4(b) and (c) did not represent new proposals, but rather they would replace provisions which presently appeared in Section 106. The Delegation of Japan expressed a reservation as to Rule 90.4(b) and (c) in the light of its national law, but agreed to further consider its position taking into account the International Bureau's comments.

54. In relation to proposed Rule 90.4(d), there was some discussion as to whether the applicant should be notified of a renunciation of an appointment of an agent, as to whether a renunciation should be effective only after the applicant's approval had been obtained, and as to the time when a renunciation would be effective. The Delegation of the United States of America reserved its position on the proposed amendment and indicated that its Office did not allow an agent to renounce until it was satisfied that the applicant had been notified. It also noted that this was a matter for national law. In response, it was pointed out that renunciation depended on many matters; however, once an authority had been notified of a renunciation, it should no longer deal with that agent.

55. The International Bureau pointed out that the proposed Rule did not affect the relationship between the applicant and his agent, but rather dealt with the recognition of agents by Offices and authorities under the PCT. In the latter connection, a renunciation would be effective at the time when it was received by the authority concerned (see proposed Rule 90.4(e) which would apply proposed Rule 90.3(b) and (c) *mutatis mutandis*).

56. Rule 90.5. The Committee approved the substance of the proposed amendment, but it was agreed that the provisions should be incorporated into Section 108.

57. Rule 90bis.1(b). The Committee approved the proposed amendment subject to replacement of the words "effected by" by the word's "effective on receipt of" in the first line of the Rule.

58. Rule 90bis.2. In approving this Rule, the Committee discussed proposed new Section 415bis (as set out on page 124 of document PCT/CAL/IV/7) and agreed that it would be better placed in the Regulations, preferably after paragraph (a) of Rule 90bis.2, as set out in Annex III to this report.

59. Rule 90bis.3. This proposed amendment found support in particular among the representatives of the non-governmental organizations. The Committee approved the

proposal subject to replacement of the words "effected by" by the words "effective on receipt of" in the first line of paragraph (c). The Delegations of France, Italy, Japan and the United Kingdom expressed reservations on Rule 90bis.3 as a whole.

60. The Delegation of France, supported by the Delegation of Italy, noted that it would prefer that the substance of this Rule not go beyond the scope of present Rule 32bis and that withdrawal of a priority claim should not be permitted after international publication.

61. The Delegation of Japan, in reserving its position, expressed the view that priority claims should not be able to be withdrawn. It felt that the withdrawal of priority claims would cause uncertainty in both international and national phase processing, particularly where an international preliminary examination report had been established.

62. The International Bureau noted that Rule 32bis already permitted withdrawal of priority claims at any time before international publication of the international application. It also explained that such withdrawal would not diminish the value of international preliminary examination reports. Furthermore, the prior art effect in respect of other national applications would not be effected since that effect would apply, if the national law so provided, only once the application entered into the national phase.

63. The Delegation of the United Kingdom noted that there was a risk of abuse of the system by applicants since all time limits would have to be recomputed when a priority claim was withdrawn and the applicant could use the withdrawal procedure to delay further processing.

64. It was finally noted that the fact that a priority claim had been withdrawn would be published in the PCT Gazette, as already provided by Rule 48.6(c).

65. Rule 90bis.5. The proposed amendment was approved by the Committee. The Delegations of the United States of America and the EPO expressed concern that an applicant should not be permitted to avoid a negative international preliminary examination report by withdrawing the demand or elections and still obtain the benefit of delaying entry into the national phase. Moreover, the elected Offices where the national phase had already started should not be deprived of the benefit of any examination work which had been effected by the International Preliminary Examining Authority.

66. Those Delegations proposed an amendment to paragraph (c), providing for the results of the international preliminary examination, be it the international preliminary examination report or only a written opinion, to be made available to the elected Offices where the national phase had already started. If the international preliminary examination report had not been established at the time when the withdrawal was effected, then the last written opinion should be taken to be the report.

67. The International Bureau, supported by several delegations, noted that, where the demand or elections were withdrawn, the international phase ended for the States concerned, and that forcing the applicant to obtain a result of the International preliminary examination which he expressly no longer wanted would amount to depriving him of his right to effect such withdrawal. The International Bureau reiterated that, even under the present system, it was not aware of any abuses by applicants trying to avoid a negative international preliminary examination report. Furthermore, as a practical consideration, the International Preliminary

Examining Authority did not have any way of knowing whether national processing has started in an elected Office. In addition, the International Bureau noted that using the last written opinion as a report, in the way suggested, would be inconsistent with Article 38, and that, in any case, if the report were to contain only the information appearing in the last written opinion, the report would in most cases not comply with Article 35 and Rule 70. Moreover, the applicant would be deprived of the right to take action to improve the international application before preparation of the final report--a right which was a cornerstone of the international preliminary examination procedure.

68. The International Bureau further noted that, if a system such as the one proposed by the Delegations of the United States of America and the EPO were to be implemented, a whole new system of procedures would have to be introduced.

69. The International Bureau compared the withdrawal of the international application before the establishment of the International search report with the withdrawal of the demand before the establishment of the international preliminary examination report. It noted that, in the first instance, the international search report would not be established, even though it would seem that that report would be of great value to the applicant and to any national office in which the applicant had entered the national phase.

70. The Delegation of the United Kingdom indicated that it would be improper to take an intermediate document (i.e., a written opinion) and give it a status that the Treaty did not give it, particularly after the procedure concerned had been terminated by the applicant's action.

71. After detailed discussion, the Delegations of the United States of America and the EPO withdrew their proposal but reserved the right to introduce a proposal for consideration by the Assembly. The Delegation of France expressed its regrets about the withdrawal of the proposal. The Delegation of the EPO invited the International Bureau to take appropriate measures to assess in the future any possible abuse in order to remedy the situation that might entail. The International Bureau indicated that it was, ready to take the necessary measures.

72. In discussing Rule 90bis, the Committee approved the proposed modification to Section 326 of the Administrative Instructions, as set out on page 130 of document PCT/CAL/IV/7, subject to the Insertion of a reference to Rule 90bis.1 in the title of that Section. The Committee also approved the proposed modifications to Sections 415 and 419, as set out on page 130 of document PCT/CAL/IV/7. With regard to Section 609, the Committee approved the proposed modification, as set out on page 130 of document PCT/CAL/IV/7, subject to the deletion of the reference to Rule 90bis.4 in the title and in the text of that Section.

73. Rule 91.1. The proposed amendment was approved by the Committee.

74. The Delegation of the United States of America reserved its position and indicated that perhaps the wording was too broad in that the applicant might introduce something other than what was originally intended. The current wording of the Rule was preferred. This position was supported by the Delegation of Denmark which also reserved its position.

75. It was noted that the receiving Office was responsible for authorizing rectifications in the request, and that rectifications in the description, claims and drawings required the authorization of the International Searching Authority or the International Preliminary Examining Authority, which was a clear protection against the introduction of new matter.

76. The Delegation of the Netherlands, although somewhat sharing the concerns of the Delegations of Denmark and the United States of America, felt that sufficient safeguards existed since any rectification required specific authorization. If problems were found in practice under the proposed amendment, corrective action could be taken in the future.

77. Rule 92.4. After some discussion, the Committee approved the Inclusion of a proposed amendment along the lines of that set out in Annex IV to this report.

78. It was noted, in connection with proposed paragraphs (d) and (e), that it would be optional for an office to establish any confirmation requirements at all under paragraph (d). Any Office would be free to choose not to require automatic confirmation and to require the sending of an original upon invitation. Moreover, such an Office would not need to wait for the expiration of the period set out in paragraph (d) before issuing an invitation under paragraph (e).

79. Delegations varied in their approaches to the requirement of confirmation copies. Some delegations indicated that they preferred an invitation system operating on a case by case basis, e.g. by inviting the sending of original sheets bearing signatures or complying with the physical requirements under Rule 11. Other delegations would prefer to require the filing of confirmation copies in all cases, at least for some classes of documents.

80. It was noted that problems could arise where a tele-transmission spanned two calendar days. It was suggested that the PCT Receiving Office Guidelines or the Administrative Instructions could provide for national offices to apply their usual national practice in such cases.

81. The Delegation of Japan informed the Committee that, in the Japanese national procedure, recently introduced provisions enabled the filing of applications in electronic form with no need for confirmation copies of any document. In relation to the use of the means of telecommunication envisaged in Rule 92.4, the Delegation proposed that filing under that Rule through facsimile machines should be expressly permitted, but that confirmation copies should be required for any document subsequent to the international application. The Delegation also proposed that facsimile transmissions of international applications should be treated as originals and any defects dealt with under the normal provisions of Rule 11. The Delegation found particular problems with sheets bearing signatures. The Delegation expressed a reservation as to the proposal approved by the Committee.

82. The representatives of the non-governmental organizations felt that the sanction which would be provided under paragraph (f)(i) was too harsh in a case where only an insignificant part of an international application was not confirmed by sending the original. This should not lead to a loss of the international application. The International Bureau explained that paragraph (f)(i) was consistent with the provisions of Article 14(1)(b) and Rule 26 and that no other sanction could apply in such a case. However, It was agreed that the International Bureau would study whether Rules 26.3bis and/or 26.5 should be applied by the receiving Office when deciding whether an international application should be considered withdrawn.

83. The proposal to amend paragraph (g) was approved with the understanding that an office or intergovernmental organization could specify the kind of documents which it was prepared to receive by any of the means referred to in paragraph (a) when making its

notification to the International Bureau under paragraph (g) for publication in the PCT Gazette.

84. The international Bureau confirmed that it was intended to convene an extraordinary session of the Assembly from July 8 to 12, 1991, in Geneva, for decisions about the proposals for amendments to the Regulations prepared by the International Bureau on the basis of advice by the Committee.

85. This report was unanimously adopted by the Committee on March 15, 1991.

[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/GERMANY

Sabine JOTZO (Miss), Regierungsrätin z.A., German Patent Office, Munich

AUSTRALIE/AUSTRALIA

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Chambre fédérale des conseils en brevets (PCPA)/Federal Chamber of Patent Attorneys (PCPA): Eugen POPP (Patent Attorney, Munich)

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

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Vice-président/Vice-Chairman: Shigeo TAKAKURA (Japon/Japan)

Secrétaire/Secretary: Busso BARTELS (OMPI/WIPO)

V. BUREAU INTERNATIONAL DE L'ORGANISATION MONDIALE DE LA
PROPRIÉTÉ INTELLECTUELLE (OMPI)/INTERNATIONAL BUREAU
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Division juridique du PCT/PCT Legal Division: Busso BARTELS (Directeur/ Director);
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[L'annexe II suit/Annex II follows]

ANNEX II

AGENDA FOR THE SECOND PART OF THE FOURTH SESSION

adopted by the Committee

1. Opening of the second part of the fourth session
2. Adoption of the agenda for the second part of the fourth session (this document)
3. Adoption of the French version of the report of the first part of the fourth session (document PCT/CAL/IV/6)
4. Consideration of proposed amendments to the Regulations under the PCT (documents PCT/CAL/IV/7, 8 and 9)
5. Other matters
6. Adoption of the report 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 approved by the Committee. Some of the proposals replace, and others are in addition to, proposals set out In documents PCT/CAL/IV/7 and 8. 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.

Proposed Amendments to the Regulations

Rule 2.2 “Agent”

Whenever the word “agent” is used, it shall be construed as meaning an agent appointed under Rule 90.1, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used.*

Rule 13ter.3 Requirement of Designated Office

Once the processing of the international application has started before a designated Office, that Office may require the applicant to furnish to it a copy of a sequence listing furnished or transcribed under Rule 13ter.1(a).

Rule 40.2 Additional Fees

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may require that the applicant pay a fee for the examination of the protest. ("protest fee"), provided that there has been a prior review of the invitation to pay an additional fee, taking the protest into account, by the instance having Issued the invitation. The protest fee shall be paid within one month after notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the board, special Instance or higher authority referred to In paragraph (c) finds that the protest was entirely justified and that the refund would be equitable In the circumstances of the case.

Rule 53.4 The Applicant

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*. Only applicants for the elected States are required to be Indicated in the demand.

* The amendment consists in deleting the word ", also the common representative referred to In Rule 4.8".

Rule 53.5 Agent or Common Representative*

If an agent or common representative is designated, the demand shall so indicate. Rules 4.4** and 4.16 shall apply, and Rule 4.7 shall apply *mutatis mutandis*.

Rule 53.8 Signature

(a) Subject to paragraphs (b) and (c), the demand shall be signed by the applicant or, if there is more than one applicant, by all applicants for the elected States.

(b) Rule 4.15(b) shall apply *mutatis mutandis*.

(c) The demand need not be signed by an applicant if that applicant did not need to sign the request by virtue of Rule 4.15(b).

Rule 54.2 Two or More Applicants: Same for All Elected States or Different for Different Elected States***

If there are two or more applicants, the right to make a demand under Article 31(2) shall exist if at least one of the applicants making the demand is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II, or

(ii) [No change]

Rule 56.1 Elections Submitted Later Than the Demand

(d) The notice referred to in paragraph (a) need not be signed by an applicant if that applicant did not need to sign the request by virtue of Rule 4.15(b) or the demand by virtue of Rule 53.8(b).

Rule 60.2 Defects in Later Elections

(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the prescribed time limit, the later election shall be considered as if it had not been submitted.

* The title has been amended to read "Agent or Common Representative" instead of "The Agent".
** The amendment consists in deleting ", 43" after "Rules 4.40."
*** The title has been amended to read "Two or More Applicants: Same for All Elected States or Different for Different Elected States" instead of "Several Applicants: Same for All Elected States".

(d) Where, after the expiration of the time limit referred to in paragraph (a), a signature or prescribed indication is lacking in respect of an applicant for a certain elected State, the later election concerned shall be considered not to have been made.

Rule 61.1 Notification to the International Bureau and the Applicant*

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 60.1(c-bis) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) The International Bureau shall promptly notify** the applicant of the receipt, and the date of receipt, of any later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b). Where the later election has been considered under Rule*** 60.2(c) as if it had not been submitted or where a later election has been considered under Rule 60.2(d) as if it had not been made, the International Bureau shall notify the applicant accordingly.

Rule 66.4bis Certain Amendments and Arguments Not to be Taken into Account

Amendments or arguments need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received after that Authority has begun to draw up that written opinion or that report.

Rule 66.8 Form of Amendments

(a) The applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet originally filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. Where the amendment consists in the deletion of passages or in minor alterations or additions, such amendment may be made on a copy of the relevant sheet of the international application provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.

* The title has been amended to read "Notification to the International Bureau and the Applicant" Instead of "Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority".

** The amendment consists in deleting, after the word "notify", the words "the International Preliminary Examining Authority and".

*** The amendment consists in deleting the words "Rules 57.5(c) or".

Rule 68.1 No Invitation to Restrict or Pay

Where the International Preliminary Examining Authority finds that the requirement of unity of Invention is not complied with and chooses not to invite the applicant to restrict the claims or to pay additional fees, it shall proceed with the International preliminary examination^{*}, subject to Article 34(4)(b) and Rule 66.1(e). In respect of the entire international application, but shall indicate, in any written opinion and in the international preliminary examination report, that it considers that the requirement of unity of invention is not fulfilled and it shall specify the reasons therefor.

Rule 68.3 Additional Fees

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may require that the applicant pay a fee for the examination of the protest ("protest fee"), provided that there has been a prior review of the invitation to pay an additional fee, taking the protest into account, by the instance having issued the invitation. The protest fee shall be paid within one month after notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified and that the refund would be equitable in the circumstances of the case.

Rule 70.2 Basis of the Report

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

Rule 76.5 Application of Rules 22.1(g), 49 and 51bis

(iv) for the purposes of Article 39(1), a translation of any amendment under Article 19 shall not be required unless that amendment is annexed to the international preliminary examination report.

Rule 90.1bis Common Representative

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a "common agent") under Rule 90.1(a), 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.

* The amendment consists in deleting, after the word "examination", the word "report".

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

Rule 90.3 Manner of Appointment of Agent or Common Representative*

(d) Where an appointment of an agent is made in the request or the demand, the request or demand shall be signed by the applicant. Where there are two or more applicants, appointment of a common agent or common representative shall be effected by each applicant signing, at his choice, the request, the demand or a separate power of attorney.

Rule 90.3bis General Power of Attorney

(a) Appointment of an agent In relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:

(i) the general power of attorney had been deposited In accordance with paragraph (b); and

(ii) a copy of it Is attached to the request, the demand or the separate notice, as the case may be; that copy need not be signed.

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 the corresponding election under Rule 90bis.4.

(b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.

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

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

(d) Withdrawal shall be effective on receipt of a signed notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority. Where one of the applicants is considered to be the common representative under Rule 90.1bis(b), the notice shall require the signature of all the applicants concerned.

(e) No international publication of the designation shall be effected if the notice-of withdrawal by the-applicant or a corresponding information by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for publication have been completed.

Rule 90*bis*.4 Withdrawal of-the Demand, or of Elections

(b) Withdrawal shall be effective upon receipt of a signed notice addressed by the applicant to the International Bureau. Where one of the applicants is considered to be the common representative under Rule 90.1bis(b), the notice shall require the signature of all the applicants.

(c) If the notice containing the withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit It promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

[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 approved by the Committee subject to further review by the International Bureau. Some of the proposals replace, and others are in addition to, proposals set out in documents PCT/CAL/IV/7 and 9. 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.

Proposed Amendments to the RegulationsRule 53.9 Declaration Concerning the Basis of the International Preliminary Examination

(a) The declaration referred to in Rule 53.2(a)(v) shall specify, subject to paragraph (c), whether the applicant wishes the international preliminary examination to be initially directed to the description, claims and drawings as originally filed or as amended under Article 19 and/or Article 34.

(b) A copy of any amendment under Article 19, or any amendment under Article 34, referred to in the declaration shall be submitted with the demand.

(c) Where, at the time of filing the demand, the applicant has not yet received the international search report or the time limit for filing amendments under Article 19 has not yet expired, the declaration may contain, instead of the indication referred to in paragraph (a), an indication that the applicant wishes the international preliminary examination to be delayed until he has either filed such amendments or informed the International Preliminary Examining Authority that international preliminary examination should start without such amendments.

(d) If no declaration under this Rule is made, it shall be assumed that the applicant wishes the international preliminary examination to be initially directed to the description, claims and drawings as originally filed.

Rule 60.1 Defects in the Demand

(e) Where the declaration referred to in Rules 53.2(a)(v) and 53.9 specifies that the applicant wishes the international preliminary examination to be based on the international application as amended but a copy of an amendment, or an amendment, referred to in the declaration is not submitted together with the demand, the International Preliminary Examining Authority shall,

(i) In the case of an amendment under Article 19, request the International Bureau to transmit a copy of the amendment to it, or

(ii) In the case of an amendment under Article 34, invite the applicant to submit the amendment within a time limit fixed in the Invitation,

and shall proceed as provided for in Rule 66.1(c)

Rule 62.1 Amendments Made before the Demand is Filed

Where the International Bureau is requested by the International Preliminary Examining Authority under Rule 60.1(e)(i) to transmit a copy of an amendment under Article 19, it shall promptly transmit such a copy to that Authority.

Rule 62.2 Amendments Made after the Demand is Filed*

If, at the time of filing any amendment under Article 19, a demand for international preliminary examination has already been submitted, the applicant shall, at the same time as he files the amendment with the International Bureau, also file a copy of such amendment with the International Preliminary Examining Authority, and the International Bureau shall promptly transmit a copy of such amendment to that Authority.

Rule 66.1 Basis of the International Preliminary Examination

(a) The applicant may make amendments according to Article 34(2)(b) at the time of filing the demand or, subject to Rule 66.4bis, subsequently.

(b) The international preliminary examination shall initially be directed to the claims, the description, and the drawings, as originally filed or, where an amendment is referred to in the demand under Rule 53.9(a) or made before the start of the International preliminary examination, as so amended.

(c) Where the applicant failed to submit a copy of any amendment under Article 19 referred to in the demand, the International Preliminary Examining Authority shall not start the international preliminary examination until it has received such a copy. Where the applicant failed to submit any amendment under Article 34 referred to in the demand within the time limit fixed in the invitation under Rule 60.1(e)(ii), the international preliminary examination shall start without taking such amendment into account.

(d) Where the applicant has expressed under Rule 53.9(c) the wish that the international preliminary examination be delayed, the International Preliminary Examining Authority shall start such examination promptly after it has received a copy of any amendment under Article 19 or an indication that the international preliminary examination should start or, in any case, promptly after the expiration of 20 months from the priority date.

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

Rule 69.1 Time Limit for International Preliminary Examination

* The title has been changed from "Amendments" to read "Amendments Made after the Demand is, Filed".

(b) International preliminary examination shall, subject to paragraph (c) and to Rule 66.1(b) to (d), start once the International Preliminary Examining Authority is in possession of the international search report or of a notice of the declaration by the International Searching Authority under Article 17(2)(a) that an International search report will not be established.

(c) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes and subject to Rule 66.1(d), start at the same time as the international search.*

Rule 82.1 Delay or Loss in Mail

(d) Where a delivery service (not being the mail) is used to send a document or letter, the provisions of paragraphs (a) to (c) may be applied by any national Office or Intergovernmental organization as if:

(i) the delivery service was a mail 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.

(e) Each national Office or intergovernmental organization prepared to apply the provisions of paragraph (d) shall notify the International Bureau accordingly. The International Bureau shall publish the information so received in the Gazette.

Rule 90.1 Appointment as Agent**

(a) A person having the right to practice before the national Office with which the international application is filed may be appointed by the applicant as his agent to represent him before that office acting as a receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority.

Rule 90.2 Effects of Acts by or in Relation to Agents and Common Representatives***

* The amendment consists in deleting the last sentence.

** The title has been amended to read "Appointment as Agent" instead of "Definitions".

*** The title has been amended to read "Effects of Acts by or in Relation to Agents and Common Representatives" instead of "Effects".

(b) Subject to Rules 90bis.1(b), 90bis.2(d), 90bis.3(c) and 90bis.4(b), any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

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 paragraph (g), a document making up the international application, or any subsequent document relating thereto, may be transmitted by telegraph, teleprinter, facsimile machine or other like means of communication producing a printed or written document.**

(b) A signature appearing on a document transmitted by facsimile machine shall be recognized for the purposes of the Treaty and these Regulations as a proper signature.

(c) Where the applicant has attempted to transmit a document by any of the means referred to in paragraph (a) but part or all of the document is illegible or part of the document is not received, the document shall be treated as not having been received to the extent that the received document is illegible or that the attempted transmission failed. The national Office or intergovernmental organization shall promptly notify the applicant accordingly.

(d) In the case of transmission by any of the means referred to in paragraph (a), a national office or intergovernmental organization may require the submission, within 14 days of the date of the transmission, of the original of the document transmitted and an accompanying letter, identifying the earlier transmission, provided that such requirement has been notified to the International Bureau and the International Bureau has published information thereon in the Gazette.

(e) If the applicant fails to submit the original document required under paragraph (d) or if, in any event, the national Office or intergovernmental organization considers it necessary to receive the original document, that Office or organization may invite the applicant to furnish the original document within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(f) If the applicant fails to comply with an invitation under paragraph (e):

(i) where the document concerned is the international application, the latter shall be considered withdrawn and the receiving Office shall so declare;

(ii) where the document concerned is not the international application, the document shall be considered as not having been submitted.

(g) No national Office or intergovernmental organization shall be obliged to receive documents submitted by a means referred to in paragraph (a) unless it has notified the

* 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 this paragraph.

International Bureau that it is prepared to receive documents by that means and the International Bureau has published information thereon in the Gazette.

[End of Annex and of document]