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**PCT COMMITTEE FOR ADMINISTRATIVE AND LEGAL**  
**MATTERS**

**Fourth Session, Second Part<sup>+</sup>**  
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DRAFT  
PROPOSED AMENDMENTS TO PART C TO PART F  
OF THE REGULATIONS UNDER THE PCT

*Memorandum prepared by the International Bureau*

## INTRODUCTION

1. Reference is made to the Introduction to document PCT/CAL/IV/2. The present document is a continuation of that document and contains further proposal for amendments, relating to Parts C to F of the Regulations\*. The proposals for amendments relating to Parts A and B contained in document PCT/CAL/IV/2 have been considered by the Committee at the first part of its fourth session with the exception of the proposals relating to Rules 2.2, 2.2bis, 4.8, 32, 32bis and 48.6. It was agreed to postpone consideration of those Rules and to discuss

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<sup>\*</sup> References in this document 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.

them together with the proposals concerning Rules 90 and 90bis contained in this document (see paragraphs 13, 17, 62 and 76 of the report, document PCT/CAL/IV/6).

2. The proposed amendments appear on the odd-numbered pages, whereas the corresponding explanations appear on the opposite even-numbered pages. In the text itself of the Rules proposed to be amended, underlinings indicate what is new as compared to the present text. Deletions of text matter in a given Rule are identified by asterisks.

Overview of several proposals concerning amendments of international applications in relation to Chapter II of the PCT

3. The major part of this document relates to amendments to the Regulations relating to Chapter II of the PCT. Experience during recent years with increasing use of Chapter II has revealed the need for certain clarifications, particularly in respect of the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase. The amendments proposed in this document relating to Rules 53.2(a)(v), 53.9, 62, 66.1, 69.1(b), 73bis, 76.5 and 76.6 are intended to clarify the operation of these provisions and overcome the problems which have arisen, particularly in connection with:

(i) the timing and basis of international preliminary examination (notably, whether and under what circumstances amendments under Article 19 are to be taken into account, particularly when international preliminary examination commences before the expiration of the time limit for filing amendments under Article 19), and

(ii) entry into the national phase (notably, whether and under what circumstances national Offices should be able to require translations of amendments made under Article 19 or 34).

4. Since several Rules are involved, and in order to avoid repetition, a general explanation of the present situation and an outline of the proposed solutions is given below. The explanations of the proposed amendment to an individual Rule will, where appropriate, make reference to this overview.

*Present situation*

5. Substantive amendments of an international application (as distinct from correction of defects, rectification of errors and changes in certain indications) are provided for in the international phase under Articles 19 and 34 and in the national phase under Articles 28 and 41.

6. The Treaty does not contain any express provision as to the status of amendments made during the international phase under Article 19 or 34. From the ordinary meaning of the word “amend”, however, it would be expected that, when an amendment has been made, the international application thereafter would be the application as amended. Under Article 19(1), amendments may be made “by filing” amendments with the International Bureau, so that the date at which the international application is amended would be the date on which the amendment was filed with that Bureau.

7. Time limits for amendments. Article 19 and Rule 46.1 afford the applicant an opportunity to file amendments to the claims with the International Bureau within two months from the date of transmittal of the international search report by the International Searching Authority or 16 months from the priority date (whichever expires later), or even later, until the completion of the technical preparations for international publication. Article 34(2)(b) and Rule 66 enable the applicant to file amendments of the claims, description and drawings with the International Preliminary Examining Authority before and during the international preliminary examination procedure.

8. In the national phase, Article 28 and Rule 52.1 guarantee the applicant the opportunity to amend the claims, description and drawings before each designated Office within one month after the fulfillment of the requirements under Article 22 (or even later in some circumstances). Article 41 and Rule 78 guarantee the applicant the opportunity to amend the claims, description and drawings before each elected Office within a time limit which depends on when the election concerned is made. Where the election is made prior to the expiration of 19 months from the priority date, the applicant may make amendments at least until the expiration of the time limit applicable under Article 39, with the possibility in some circumstances of later amendments (see Rule 78.1). Where the election is made after the expiration of 19 months from the priority date (so that entry into the national phase is not delayed), the time limit for making amendments is the same as that which applies under Article 28 (see Rule 78.2).

9. *Language and translations of amendments.* The contents of a translation for the purposes of Article 22 (i.e., where the designated Office has not been elected under Chapter II before the expiration of 19 months from the priority date) are governed by Rule 49.5, which Rule enables the designated Office to require a translation of both the claims as filed and the claims as amended (under Article 19). By contrast, where the designated Office has been elected before the expiration of 19 months from the priority date, the applicant is required under Article 39(1) to furnish a translation of the international application “as prescribed”. Rule 74.1 provides that the applicant shall, where such a translation is required by the elected Office, transmit a translation of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report. Rule 70.16, in turn, requires the annexing to that report of each replacement sheet submitted under Rule 66.8, with the proviso that replacement sheets superseded by later replacement sheets and letters under Rule 66.8 shall not be annexed.

10. Replacement sheets must be submitted, under Rule 46.5, where claims are amended under Article 19 and, under Rule 66.8, where amendments are made under Article 34(2)(b) before or during the international preliminary examination procedure. Rule 70.16 does not, however, refer to replacement sheets submitted under Rule 46.5, although the amendments concerned (i.e., those made under Article 19) will generally be taken into account by the International Preliminary Examining Authority (see Ad Rule 70.16, below).

11. *The basis of international preliminary examination.* Under Article 31, on the demand of the applicant, “his international application” shall be the subject of an international preliminary examination. Where amendments have been made under Article 19, it is thus the international application as amended which is the subject of international preliminary examination. Consistently with this, the present Rules require copies of such amendments to be provided to the International Preliminary Examining Authority and require that the international preliminary examination is to commence only when it is known whether any

such amendments have been made. Noting that the applicant has further possibilities for making amendments under Article 34 and Rule 66, however, the international preliminary examination report need not always take into account all amendments made under Article 19. For example, where claims which have been amended under Article 19 are further amended during international preliminary examination, the report will be based only on the claims as so further amended and not on the claims as amended under Article 19 (see Rule 70.2(a)). It is important, of course, that the basis on which the report was prepared is clear from the report.

12. Further, the following two problems have arisen under the present procedure. First, under Rule 62.2, the International Bureau must transmit promptly copies of claims which have been amended under Article 19 to the International Preliminary Examining Authority. If such amendments are made after the demand has been filed, the Rule requires the applicant to send copies of the amendments to the International Preliminary Examining Authority at the same time as he files amendments with the International Bureau. This is often overlooked by applicants. (Where the applicant declares to the International Bureau that he does not wish to make amendments, the Rule requires the International Bureau to inform the International Preliminary Examining Authority accordingly).

13. Second, the present system under Rule 69.1(b), by which international preliminary examination starts only once it is clear whether amendments under Article 19 have been made, has proved to be impracticable. If the applicant receives, for example, the international search report within nine months from the priority date, he usually files a demand soon thereafter. International preliminary examination, however, may, under the present Rules, only start if the time limit prescribed in Rule 46.1 for filing amendments of the claims under Article 19 has expired or if the applicant has declared that he does not have the intention to file amended claims under Article 19. The time limit prescribed in Rule 46.1 expires two months after the date of the transmittal of the international search report or 16 months after the priority date, whichever time limit expires later, and, if an amendment is received after the expiration of that time limit but prior to the completion of the technical preparations for international publication, it is considered to have been received by the International Bureau on the last day of the applicable time limit. Since the applicant thus has the right to file amendments under Article 19 until the completion of the technical preparations for international publication, the International Preliminary Examining Authority must base its activities on the expectation that applicants can file amendments under Article 19 until that moment, and it can therefore not start with the international preliminary examination. Thus, valuable time is lost which could have been used for international preliminary examination.

14. The basis of entry into the national phase. While the Treaty makes no express provision as to the status of any amendments which have been made to the international application before entry into the national phase, it is presumably the international application as amended under the Treaty during the international phase which enters the national phase. In cases where amendments go beyond the disclosure in the international application as filed (see Articles 19(2) and (3) and 34(2)(b)), it is clearly open to national law either to regard them, in the national phase, as not having been made or to require the applicant, in the national phase, to make further amendments to correct the position.

15. Clarification of the status of amendments made to the international application is of particular importance for the purpose of the translation of the international application which must be furnished by the applicant. The present practice in some national Offices is to require, at the time of entry into the national phase, a translation only of amended claims and not of any original claims which have been cancelled or amended. Other national Offices require a

translation not only of the claims as amended under Article 19 but also of the claims as filed. Some other national Offices afford the applicant the option, where such amendments have been made, as to whether the translation of the claims to be furnished for the national phase incorporates the amendments or not, and they simply disregard any amendment for which no translation is furnished.

16. Where the international application has been amended under Articles 19 and 34 in respect of the claims, it needs to be clarified whether claims which have been cancelled or further changed should still have any status. As already stated, the status in the national phase of amendments made during the international phase under Article 19 or 34 is a particularly pertinent issue for the purposes of the translation which must be furnished. However, it may also be relevant when a question of provisional protection arises, in which case the availability of a translation may be very important. For example, some national laws require that a translation of the claims as published be available in an official language in order to obtain provisional protection. It needs to be remembered, however, that the scope and validity of provisional protection under national law will eventually depend on the scope of the claims at the date of grant of the patent. The scope of the claims at the date of publication will be irrelevant to the extent to which the claims are no longer pursued by the applicant.

*Problems needing to be addressed*

17. It is apparent, from the discussion in the preceding paragraphs, that there are several problems in the present procedure which need to be addressed. These, and a number of other factors which must be borne in mind, may be summarized as follows:

(a) The international preliminary examination, procedure ought to be able to commence without the need to await the expiration of the time limit for making amendments under Article 19.

(b) It should be clear, what is the basis for international preliminary examination, whenever it starts, and in particular a workable mechanism must be found for international preliminary examination of international applications which have been amended under Article 19.

(c) It should be clear, upon entry into the national phase, what is the status of any amendment made to the international application during the international phase under Article 19 and/or Article 34(2)(b).

(d) Applicants should not be obliged to furnish translations unnecessarily, upon entry into the national phase, of amendments which have been superseded during the international phase.

*Proposed solutions*

18. It is proposed to amend a number of Rules, as outlined in more detail subsequently in this document, along the following lines:

(a) International preliminary' examination should be able to be commenced as soon as possible after the establishment of the international search report, without the need to wait for the expiration of the time limit for making amendments under Article 19 (see the proposal for amendment of Rule 69.1(b)).

(b) Applicants will be required to make a declaration in the demand as to whether or not any amendments under Article 19 have been filed and whether the applicant wishes the international preliminary examination to be based on the application as originally filed or as amended under Article 19 and/or Article 34 (see the proposals for amendment of Rules 53.2(a)(v) and 53.9).

(i) Failure to make such a declaration will be considered a defect and compliance with the requirements of Rule 53 will be invited (see the proposal for amendment of Rule 60.1(a)). Failure to comply with the invitation will result in the demand being considered as not having been submitted under Rule 60.1(c).

(ii) Where a demand is filed and the declaration indicates that amendments under Article 19 have been made, but a copy of the amendments is not submitted with the demand to the International Preliminary Examining Authority, the International Preliminary Examining Authority should indicate this fact not only to the applicant but also to the International Bureau which would then be responsible for forwarding a copy of the amendments under Article 19 to the International Preliminary Examining Authority. The International Preliminary Examining Authority will, in such a case, need to delay the international preliminary examination until receipt of the amendments under Article 19. This delay is not unreasonable because it is due to the applicant's failure to include the copy required under proposed Rule 53.9 and because examination of claims which are superseded by claims amended under Article 19 would be a waste of time. (See the proposed new Rule 60.1(c) and the proposals for amendment of Rules 62.1 and 66.1(b)).

(iii) If the declaration refers to amendments under Article 34, but they do not accompany the demand, the applicant should be so advised and invited to forward a copy of them within a set time period. If the applicant does not timely respond to the invitation, international preliminary examination would proceed before the International Preliminary Examining Authority without those amendments. (See the proposal for amendment of Rule 66.1(b)).

(c) Amendments under Article 19 should continue to be able to be made after the filing of a demand, and no change is proposed in this respect. However, such amendments should be taken into account for the purposes of the international preliminary examination only if a copy of them is available at the International Preliminary Examining Authority. Such copy should be submitted by the applicant himself. (See the proposal for amendment of Rule 62.2.)

(d) Where amendments have been taken into account for the purposes of the establishment of the international preliminary examination report, a copy of all such amendments (including any amendments under Article 19) should be annexed to it (see the proposal for amendment of Rule 70.16).

(e) Amendments not taken into account by the International Preliminary Examining Authority would, upon transmittal of the international preliminary examination report, be considered to have been withdrawn. An appropriate warning to this effect would be included in the demand Form. Where amendments have been so considered withdrawn, no question could arise as to whether they would have to be translated or not. (See the proposals for amendment of Rules 66.1(c) and 76.5(iv) as well as proposed new Rule 73bis).

(f) A designated Office which is not elected before the expiration of the 19-month time limit under Article 39(1) should continue to be furnished by the applicant with a translation of the claims as amended under Article 19 and also, where required by the designated Office, with a translation of the claims as filed (see Rule 49.5(a) and also new Rule 49.5(c-bis) as proposed in document PCT/CAL/IV/2).

(g) Where a designated Office was elected before the expiration of the 19-month time limit under Article 39(1), the applicant should be obliged to furnish that Office, upon entry into the national phase, with a translation only of the application as amended by any amendment which was taken into account in the international preliminary examination and is thus annexed to the international preliminary examination report (see the proposal for amendment of Rule 76.5(iv)). Where required by the elected Office, the applicant would, however, continue to be obliged to furnish a translation of the claims as filed (see Rules 49.5(a) and 76.5(ii)).

(h) Where a designated Office was elected before the expiration of the 19-month time limit under Article 39(1), the applicant should not be obliged to furnish a translation of any amendments under Article 19 which have been superseded and therefore are not annexed to the international preliminary examination report. Such amendments would be considered to have been withdrawn for the purposes of such a State (see proposed new Rule 73bis and the proposed amendment to Rule 76.5(iv)).

(i) The proposed procedure under the preceding sub-paragraph should not, however, prevent national laws from requiring, during a transitional period, a translation of the claims as amended under Article 19 if they are not annexed to the international preliminary examination report (see proposed new Rule 76.6).

*19. The Committee is invited to consider and advise the International Bureau on the proposed amendments contained in the present document.*

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## EXPLANATION OF THE PROPOSED AMENDMENTS

*Ad Rule 53.1(a) and (c)*

1. *Present situation.* Rule 53.1(a), at present, requires the demand to be made on a printed form. It does not permit the use of computer generated forms.
2. *Proposed solution.* The proposed amendment to Rule 53.1(a) is, like the amendments proposed to Rules 3.1 and 3.4, intended to prepare the ground for a future filing of demands with the help of word processing equipment. The new second sentence of Rule 53.1(a) replaces Rule 53.1(c), which is proposed to be deleted.
3. This proposed amendment was agreed by the Committee at its third session.
4. A text for a new Section of the Administrative Instructions which would cover both the demand and the request has been proposed in paragraph 4 of the explanatory notes concerning the proposed amendment to Rule 3.4 (see document PCT/CAL/IV/2, page 10).

*Ad Rule 53.1(b)*

1. *Present situation.* Present Rule 53.1(b) does not spell out what is the general practice, namely, that applicants may obtain free of charge copies of the printed demand Form, not only from the receiving Office, but also from the International Preliminary Examining Authority.
2. *Proposed solution.* The proposed amendment to Rule 53.1(b) adds a reference to demand Forms being available from the International Preliminary Examining Authority.
3. This proposed amendment was agreed by the Committee at its third session.

*Ad Rule 53.2(a)(v)*

1. *Present situation.* Present Rule 53.2(a) does not provide for an indication of the basis of the international preliminary examination, namely, an indication as to which amendments are to be considered for international preliminary examination. Such information is important when the international preliminary examination is to begin as soon as possible after filing of the demand and receipt of the international search report. The present demand Form, in Box IV, provides already for a declaration concerning amendments of the claims but without a basis in Rule 53.
2. *Proposed solution.* It is proposed to add to the mandatory contents of the demand Form a declaration of the applicant concerning the basis of the international preliminary examination. For further details, see the explanations concerning the corresponding amendment of Rule 53.9, below.
3. This proposed amendment was agreed by the Committee at its third session.

TEXT OF THE PROPOSED AMENDMENTS

Rule 53

The Demand

53.1 *Form*

(a) The demand shall be made on a printed form or presented as a computer print-out. The particulars of the printed form and of a demand presented as a computer print-out shall be prescribed by the Administrative Instructions.

(b) Copies of printed demand forms shall be furnished free of charge by the receiving Office or by the International Preliminary Examining Authority.

(c) [Deleted]

53.2 *Contents*

(a) The demand shall contain:

(i) to (iii) [No change]

(iv) election of States,

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

(b) [No change]

*Ad Rule 53.4*

1. *Present situation.* Rule 53.4, at present, provides that indications concerning the applicant be made, without specifying whether all of the applicants who filed the international application, or only those who are applicants for the elected States listed in the demand, are to be indicated.
2. *Proposed solution.* In order to provide uniform practice and clear provisions in the Regulations, Rule 53.4 is proposed to be amended to state that only the applicants for the States elected shall be indicated in the demand. Applicants, who are applicants only for designated States which are not elected, are not to be indicated in the demand and need not sign the demand.

*Ad Rule 53.6*

1. *Present situation.* The items which under present Rule 53.6 must be indicated in the demand in order to identify the international application include the name of the receiving Office with which the international application was filed. In general, the indication of the name of the receiving Office appears to be superfluous because the Office with which the application was filed can be identified by the two-letter code which forms part of the international application number. However, there could be cases in which the demand is filed early, too early for the applicant to know the international application number.
2. *Proposed solution.* It is proposed to amend Rule 53.6 and to require the indication of the name of the receiving Office only in those cases in which the international application number is not available.

53.3 [No change]

*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 shall be indicated in the demand.

53.5 [No change]

*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.

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\* 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 amendment consists in deleting, after the word “invention”, the words “and, where”.

*Ad Rule 53.7*

1. *Present situation.* Rule 53.7 requires, at present, that the name of the State must be indicated for the election of a Contracting State in the demand. It does not provide for referring to regional patents or referring to all eligible designated States, which would simplify the filling in of the demand Form.

2. *Proposed solution.* It is proposed, firstly, to keep in a paragraph (a) the existing provision that at least one of the designated States, bound by Chapter II of the Treaty, be elected, and secondly, to no longer require that the elected States be “named” but rather “indicated”. Consequently, it is proposed to provide in a new paragraph (b) for the possibilities of election by way of individual indications of States, or of collective indications of States party to a regional patent treaty (e.g., “All designated States party to the European Patent Convention which are bound by Chapter II of the PCT”), or of an indication that all designated States which are bound by Chapter II of the Treaty are elected. The wording of proposed new paragraph (b) has been aligned to that of proposed Rule 4.9(a) concerning designations (see document PCT/CAL/IV/2).

*53.7 Election of States*

(a) The applicant shall in the demand 'indicate, from among the designated States, at least one Contracting State bound by Chapter II of the Treaty as elected State.

(b) Contracting States shall be elected in the demand:

(i) in the case of States which have been designated for the purpose of obtaining national patents, by an individual indication of each State that is elected; or

(ii) in the case of States which have been designated for the purpose of obtaining a regional patent, by an indication of the regional patent which is desired, together with, where required by the relevant regional patent treaty, either an individual indication of each State that is elected or a collective indication made in such a manner that it is clear which States are elected; or

(iii) in either case, by an indication that all Contracting States which have been designated in the international application and are bound by Chapter II of the Treaty are elected.



*Ad Rule 53.8*

1. *Present situation.* Present Rule 53.8 does not provide for any exceptions to the requirement that the demand must be signed by all applicants. The discussion with regard to the signature of the request (see Rule 4.15 in document PCTjCALjIVj2) applies here equally for the demand.
2. *Proposed solution.* It is proposed to amend Rule 53.8 along the lines of Rule 4.15 and in particular to make Rule 4.15(b) apply *mutatis mutandis* in the cases covered by proposed new paragraph (b) of Rule 53.8. Where the signature of an applicant for the purposes of the election of a State for which that applicant must be the inventor (at present, the United States of America) is lacking, and if the other applicant or applicants (for the same or for different elected States) have signed the demand, it shall be sufficient if a statement is provided by the other applicant or applicants explaining to the satisfaction of the International Preliminary Examining Authority that the non-signing applicant refused to sign, or could not be found or reached after diligent effort.
3. It is also proposed to add a new paragraph (c) providing that if Rule 4.15(b) applied with regard to the signature of an applicant at the time of filing the request, the statement provided at that time will be sufficient, so that there will be no need for an additional statement at the time of filing the demand. Rather, the applicant could refer to the original statement furnished to the receiving Office and submit a copy to the International Preliminary Examining Authority.

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 of them.

(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).

*Ad Rule 53.9*

1. *Present situation.* Reference is made to the overview of several proposals regarding the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase, as set out at pages 2 to 7, above.
2. *Proposed solution.* In proposed new Rule 53.2(a)(v) (see above), it is proposed that the demand include a declaration concerning the basis of the international preliminary examination. It is proposed to specify in a new Rule 53.9 that the applicant must declare in the demand whether he has filed amendments under Article 19 and whether he wishes the international preliminary examination to proceed on the basis of any amendments made under Article 19 and/or Article 34. Where such amendments are to be taken into account, the applicant should be required to attach a copy of those amendments to the demand (see Ad Rule 62, below).
3. The declaration by the applicant in the demand will consist, in practice, in the marking, on the printed demand Form, of check-boxes relating to a preprinted text expressing the wish that the international preliminary examination be directed to the international application as filed or as amended. Any amendment which is to be taken into account shall be submitted, by the applicant himself, with the demand. It will thus always be readily available for the international preliminary examination. While such submission may constitute an additional burden for the applicant, it will allow an earlier start of the international preliminary examination and will be a great advantage for him compared to the present situation. At present the International Preliminary Examining Authority must wait until it receives from the International Bureau a copy of the amendments under Article 19, or a notification that no amendments have been filed within the applicable time limits or that the applicant declared that he does not wish to file such amendments (see present Rule 69.1(b)(ii)). Under the proposed new system, if the applicant fails to submit an Article 19 amendment with the demand although he indicates in the declaration that such amendment should be taken into account in the international preliminary examination, the International Preliminary Examining Authority shall inform the International Bureau accordingly, which will forward a copy of the amendment to it; until it has received that copy, the International Preliminary Examining Authority shall not start examination (see. Ad Rule 60.1(e) and Ad Rule 62, below).
4. Where amendments under Article 19 and/or Article 34 are submitted after the filing of the demand, proposed new Rule 66.1(c) would permit the International Preliminary Examining Authority to take them into account, if such amendments can be considered by the examiner before he has begun to draw up the first written opinion.

*53.9 Declaration Concerning the Basis of the International Preliminary Examination*

The declaration referred to in Rule 53.2(a)(v) shall specify whether or not amendments have been filed under Article 19 and whether the applicant wishes the international preliminary examination to be based on the description, claims and drawings as originally filed or as amended under Article 19(1) and/or Article 34(1). A copy of any amendment referred to in the declaration shall be submitted with the demand.

*Ad Rules 54.2 and 54.3*

1. *Present situation.* Under present Rule 54, in accordance with Article 31(2)(a), applicants are entitled to file a demand for international preliminary examination only if they are residents or nationals of a Contracting State bound by Chapter II and if the international application has been filed with the receiving Office of, or acting for, such State. If there are different applicants for different elected States, this requirement must be fulfilled by at least one of the applicants indicated for the purposes of each elected State. This means that, for the purposes of each elected State, at least one applicant must be a national or resident of a Contracting State bound by Chapter II and it means in addition that the international application must have been filed with the receiving Office of, or acting for, the State of which that applicant is a national or resident.
2. This leads to the result that, even if all applicants are nationals or residents of Contracting States bound by Chapter II, not all of them are always entitled to make a demand or elections. The following example is intended to illustrate the problem: if a demand is filed by an applicant who is a national of France for an international application filed with the receiving Office of that country, and if that international application indicates as applicant for the United States of America a national and resident of Australia, the election of the United States of America is not valid, although the applicant for the United States of America is a national and resident of a Contracting State bound by Chapter II (Australia), because the international application has not been filed with the receiving Office of that State, which would be the Office of Australia and not the Office of France. This result is not only unjust but it is also absurd because an international application cannot be filed with two Offices. For the election of the United States of America to be valid, the international application would have had to be filed with the Office of Australia, but, had it been filed with the Office of Australia, the elections made in the name of the national of France would not have been valid. In other words, the present text of Rule 54.3 causes problems for the use of Chapter II whenever different applicants for different elected States do not have the same nationality or residence.
3. *Proposed solution.* It is therefore proposed to liberalize the present requirement by amending Rule 54 and providing in Rule 54.2 that it is sufficient for the right to file a demand if at least one of all the applicants fulfills the requirements set out in paragraphs (i) or (ii) of that Rule. This means that the right to file a demand exists if at least one of all the applicants is a national or resident of a Contracting State bound by Chapter II and if the international application has been filed with the receiving Office of, or acting for, such State. In order to have a proper election for each State, it is proposed to no longer require that the international application must have been filed with the receiving Office of the State of which the applicant is actually a national or resident. Since, as is also clarified in an amended title of Rule 54.2, that Rule covers all cases where two or more applicants file an international application, whether they are the same for all elected States or different for different elected States, Rule 54.3 is no longer needed and is proposed to be deleted.
4. The proposed amendments to Rules 54.2 and 54.3 are within the scope of Article 9(3) which provides that the application of the concepts of nationality and residence in cases where there are several applicants or different applicants for different States (i.e., designated or elected States), are defined in the Regulations.

Rule 54

The Applicant Entitled to Make a Demand

54.1 [No change)

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 them 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]

54.3 [Deleted]

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\* 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”.

[Ad Rule 54.2 and 54.3, continued]

5. In addition, Article 31(2)(b) provides that the Assembly may decide to extend the right to file a demand to persons who have the right to file international applications but are nationals or residents of a State which is not bound by Chapter II or even not party to the PCT. Thus, there is no doubt that the Assembly has the right to make the proposed amendment and its power could be exercised by way of amending Rule 54.2 as proposed and deleting Rule 54.3.

*Ad Rule 54.4*

1. *Present situation.* The present situation is described above with respect to Rules 54.2 and 54.3.
2. *Proposed solution.* The proposed amendment to Rule 54.4(a) is consequential to the amendments in Rule 54.2. The reference to Article 31(2) is replaced by a reference to Rule 54.2 because, in case of different applicants for different elected States, the conditions of Article 31(2) must only be complied with by one of the applicants.
3. The proposed deletion of Rule 54.4(b), which applies only in relation to Rule 54.3, is consequential to the proposed deletion of Rule 54.3. If Rule 54.3 is deleted, Rule 54.4(b) would no longer apply.



54.4 *Applicant Not Entitled to Make a Demand\**

(a) If the applicant does not have the right or, in the case of two or more applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.

(b) [Deleted]

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\* The amendment to the title consists in deleting, at the end, the words “or and Election”.

*Ad Rule 56.1*

1. *Present situation.* Present Rule 56.1 does not provide for any exceptions to the requirement that the notice of later election(s) must be signed by the applicant. The discussion with regard to the signature of the request in connection with Rule 4.15 (see document PCT/CAL/IV/2) and the signature of the demand (see Ad Rule 53.8 in this document) apply equally for a notice under Rule 56.1 effecting later election(s).
2. Furthermore, present Rule 56.1 does not refer to the requirement of Article 31(6)(b) that a later election should be directed to the International Bureau and does not mention that all such later elections must be submitted prior to the expiration of 19 months from the priority date in order to have the effect of delaying the national procedure under Article 39(1)(a). These requirements are often overlooked by applicants since they are dealing with the International Preliminary Examining Authority, and later elections are often filed with that Authority instead of with the International Bureau. Although that Authority will usually forward the later election to the International Bureau, such later election may reach the International Bureau only after the expiration of 19 months and therefore not have the effect desired by the applicant, namely, to postpone the entry into the national phase for the State in question from 20 to 30 months after the priority date.
3. *Proposed solution.* It is proposed to amend Rule 56.1 and to divide it into several paragraphs. Paragraph (a) as proposed to be amended provides specifically that later elections should be submitted to the International Bureau, and a minor rewording is proposed which specifically refers to a “later election”.
4. It is also proposed to delete from the present text of the Rule, which is proposed to be designated as paragraph (a), the requirement that the notice effecting a later election be signed, and to include provisions on signature of such notices in new paragraphs (b), (c) and (d). Paragraph (b) would require that the notice be signed by the applicant or, if there is more than one applicant, by all of them. Paragraphs (c) and (d) parallel similar provisions of Rule 53.8 as proposed to be amended with regard to the cases where the applicant is unwilling to sign or cannot be reached or found (see Ad Rule 53.8, above and Ad Rule 4.15 in document PCT/CAL/IV/2).
5. Proposed new paragraph (e) is entirely new and requires the International Bureau to notify the applicant that any later election submitted after the expiration of 19 months from the priority date does not have the effect provided under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in the elected Office concerned within the time limit applicable under Article 22. The proposed amendment will assist applicants in their comprehension of the requirements which apply under Articles 31(6)(b) and 39(1)(a).

Rule 56

Later Elections

56.1 *Elections Submitted Later Than the Demand*

(a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice\* submitted to the International Bureau by the applicant, and shall identify the international application and the demand.

(b) Subject to paragraphs (c) and (d), the notice referred to in paragraph (a) shall be signed by the applicant or, if there is more than one applicant, by all of them.

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

(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).

(e) If a later election is submitted after the expiration of 19 months from the priority date, the International Bureau shall notify the applicant that the election does not have the effect provided for under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in respect of the elected Office concerned within the time limit applicable under Article 22.

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\* The amendment consists in deleting, after the word “notice”, the words “signed and”.

[Ad Rule 56.1, continued]

6. Proposed new paragraph (f) provides that any later election which is submitted by the applicant to the International Preliminary Examining Authority shall be transmitted by that Authority promptly to the International Bureau. The later election would then be considered as if it had been submitted to the International Bureau on the date on which it has been received by the International Preliminary Examining Authority. By recognizing the date of submission with the International Preliminary Examining Authority as the date of submission with the International Bureau, it is guaranteed that an applicant who submits a later election by mistake to the International Preliminary Examining Authority before the expiration of 19 months from the priority date will still gain the benefit of Article 39(1)(a), i.e., it would result in the postponing of the entry into the national phase from 20 to 30 months. This proposed new provision would make the PCT system simpler and safer for applicants.

*Ad Rule 56.4*

1. *Present situation.* Present Rule 56.4 provides that use of a printed form for making later elections is preferred and that copies of such forms must be furnished free of charge to applicants. The existing later election form is rarely used. Most applicants make later elections by way of a letter, using the preferred wording suggested in Rule 56.4.

2. *Proposed solution.* It is proposed to amend Rule 56.4 by deleting any reference to a printed form. The reference to the preferred wording would remain. The present form could, however, continue to be used and it is not intended to remove it from the PCT Applicant's Guide.

3. This proposed amendment was agreed by the Committee at its third session.

[Rule 56.1, continued]

(f) If a later election is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the paper containing the later election and transmit it promptly to the International Bureau. The later election shall be considered to have been submitted to the International Bureau on the date marked.

56.2 to 56.3 [No change]

#### 56.4 *Form of Later Elections*

The later election shall\* preferably be worded as follows: “In relation to the international application filed with ... on ... under No ... by ... (applicant) (and the demand for international preliminary examination submitted on ... to ... ), the undersigned elects the following additional State(s) under Article 31 of the Patent Cooperation Treaty: ••• “.

56.5 [No change]

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\* The amendment consists in deleting, after the words “election shall”, the words “preferably be made on a printed form furnished free of charge to applicants. If it is not made on such a form, it shall”.

*Ad Rules 57.1 to 57.5*

1. *Present situation.* The present Rule 57 requires the payment of further handling fees (or, in case of a later election, of a supplement to the handling fee) for each language into which the international preliminary examination report must be translated by the International Bureau. Many mistakes have been made by applicants when paying the handling fee because they did not correctly assess the number of languages into which a translation is required.
2. *Proposed solution.* It is proposed to amend Rule 57.2(a) consequential to the amendment proposed to Rule 72.1, below. Proposed Rule 72.1 provides for a translation of the international preliminary examination report by the International Bureau only if that report is not in English, and it would only be translated into English. In view of the clearly limited number of translations and in view of the fact that any translation would be only into English, it is proposed to further simplify the PCT system, to do away with the multiplications of the handling fee if a translation is required, and to provide for one single amount of the handling fee. This single amount will be payable by all applicants independent of the language in which the international preliminary examination report is established. Such improvement would be achieved by deleting the second sentence of Rule 57.2(a).
3. The proposed amendments have the advantage that applicants will no longer have to check whether any of the elected Offices requires a translation, and that they will need to pay only one handling fee. The proposed amendments will also facilitate the procedure for the International Preliminary Examining Authorities when checking the payment of the fees.
4. It is also proposed to delete Rule 57.1(b), Rule 57.2(b), Rule 57.3(b) and (d) and Rule 57.5. This will avoid complications resulting from the need for a translation of the international preliminary examination report due to a later election filed with the International Bureau. The proposed single amount of the handling fee renders the so-called “supplement to the handling fee” superfluous. This solves also the confusion and problems which resulted from the fact that the supplement to the handling fee was payable to the International Bureau, whereas the handling fee itself was payable to the International Preliminary Examining Authority.
5. As a consequence of all the amendments proposed above, it is also proposed to simplify the titles of Rules 57.2 and 57.4.
6. These proposed amendments were agreed by the Committee at its third session.

Rule 57

The Handling Fee

57.1 *Requirement to Pay*

- (a) [No change]
- (b) [Deleted]

57.2 *Amount\**

- (a) The amount of the handling fee is as set out in the Schedule of Fees.\*\*
- (b) [Deleted]
- (c) to (e) [No change]

57.3 *Time and Mode of Payment*

- (a) [No change]
- (b) [Deleted]
- (c) [No change]
- (d) [Deleted]

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\* The title has been amended to read “Amount” instead of “Amounts of the Handling Fee and the Supplement to the Handling Fee”.

\*\* The amendment consists in deleting the second sentence.

*Ad Rule 57.6*

1. *Present situation.* Under the present Rule 57.6, the handling fee is never refunded. It does not, however, appear to be fair to withhold the handling fee from an applicant who withdraws the demand promptly after filing it (e.g., because he has realized that the demand was received by the International Preliminary Examining Authority only after the expiration of 19 months from the priority date and therefore does not have the effect of postponing the entry into the national phase). Likewise, it does not appear to be fair to withhold the handling fee from an applicant who is not entitled to make a demand because he is not a national or resident of a Contracting State bound by Chapter II of the PCT. In both cases there will be no “handling” of the demand by the International Bureau and it appears therefore to be justified to refund any handling fee paid by such an applicant. Furthermore, the Rule refers to the “supplement to the handling fee” which is proposed to be deleted (see Ad Rules 57.1 to 57.5, above).

2. *Proposed solution.* It is proposed to amend Rule 57.6 to provide for a refund of the handling fee where the demand is withdrawn prior to submission to the International Bureau or is considered under Rule 54.4(a) not to have been made. It is also proposed to expressly enable the International Bureau to refund the handling fee if there are other special circumstances which justify a refund.

3. At the same time, it is proposed to make an amendment consequential to the deletion of Rules 57.1(b), 57.2(b), 57.3(b) and (d) and 57.5, proposed above, and to delete, in Rule 57.6, the reference to the supplement to the handling fee. There will no longer be a supplement to the handling fee if the said Rules are amended as proposed above .



[Rule 57, continued]

57.4 *Failure to Pay*\*

(a) to (c) [No change]

57.5 [Deleted]

57.6 *Refund*

(a) The International Preliminary Examining Authority shall refund the handling fee to the applicant:

(i) if the demand is withdrawn before it has been sent by that Authority to the International Bureau, or

(ii) if the demand is considered, under Rule 54.4(a), not to have been submitted.

(b) If there are special circumstances which justify a refund, the International Bureau may refund the handling fee to the applicant.

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\* The amendment consists in deleting, at the end of the title, the words “(Handling Fee)”.

*Ad Rule 59.1*

1. *Present situation.* The present text of Rule 59.1 provides that each Contracting State bound by the provisions of Chapter II shall inform the International Bureau of the International Preliminary Examining Authority or Authorities which are competent for international preliminary examination of international applications filed with its national Office, or with the national Office of another State or an intergovernmental organization acting for the former Office. In practice, however, and in reliance on Article 32(2), it is the receiving Office of or acting for a State bound by Chapter II which both specifies the International Preliminary Examining Authority or Authorities and informs the International Bureau.
2. *Proposed solution.* It is proposed to amend Rule 59.1 to align it with Article 32(2), which provides that it is the receiving Office which, in accordance with the applicable agreement between the International Preliminary Examining Authority or Authorities and the International Bureau, specifies the International Preliminary Examining Authority or Authorities competent for the international preliminary examination.
3. The proposed deletion of some words is consequential to the change from “Contracting State” to “receiving Office”. The added full stop and thus resulting new complete sentence is to increase legibility of the text.
4. This proposed amendment was agreed by the Committee at its third session.

## Rule 59

## The Competent International Preliminary Examining Authority

59.1 *Demands under Article 31(2)(a)*

For demands made under Article 31(2)(a), each receiving Office of or acting for a Contracting State bound by the provisions of Chapter II shall, in accordance with the terms of the applicable agreement referred to in Article 32(2) and (3), inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with it\*. The International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of Rule 35.2 shall apply mutatis mutandis.

## 59.2 [No change]

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\* The amendment consists in the deletion of: “its national Office, or, in the case provided for in Rule 19.1(b), with the national Office of another State or an intergovernmental organization acting for the former Office, and”. A full stop is added and the “t” in “the” has been capitalized.

*Ad Rule 60.1(a)*

1. *Present situation.* Rule 60.1(a) in its present form requires the International Preliminary Examining Authority to invite the applicant to correct any defect in the demand within one month from the date of the invitation. No provision is made for longer periods for response or for any extension of the one-month time limit.

2. *Proposed solution.* It is proposed that Rule 60.1(a) be amended to be subject to new paragraph (e), discussed below under Ad Rule 60.1(e), and to provide for a time limit reasonable under the circumstances, but never less than one month from the date of the invitation. The proposed Rule would also provide for extending the time limit if a decision has not yet been taken by the International Preliminary Examining Authority about the proper correction of the defect. The wording proposed is similar to that of the present Rule 26.2. Although the proposed amendment may make additional time available to applicants, it should be recognized by applicants that a prompt response is to their advantage because international preliminary examination will normally not start before the correction of any defect in the demand has been received. Thus, a late response to the invitation reduces the time available for the International Preliminary Examining Authority to issue written opinions and the international preliminary examination report before the deadline of 28 months after the priority date. However, it is nevertheless felt that additional flexibility in the presently rather rigid time frame for correction would be beneficial.

3. This proposed amendment was agreed in substance by the Committee at its third session, but it is now proposed with slight changes of a merely drafting nature.

*Ad Rule 60.1(c) to (d)*

1. *Present situation.* Rule 60.1(c) presently only provides one consequence for failure to comply with an invitation under Rule 60.1(ea), namely, the demand is to be considered as if it had not been submitted. No provision is made for a case where a signature or prescribed indications are lacking in respect only of a certain applicant for a certain elected State.

2. *Proposed solution.* It is proposed to amend Rule 60.1(c) to make it subject to proposed new Rule 60.1(c-bis), which will provide that, where a signature or prescribed indication is lacking in respect of an applicant for a certain elected State, the election concerned shall be considered to have been withdrawn (rather than disregarding the whole of the demand). A consequential amendment is proposed to Rule 60.1(d).

3. The provisions of Rule 60.1 do not, of course, apply to the situation where a signature is not needed by virtue of Rule 53.8.

Rule 60

Certain Defects in the Demand or Elections

60.1 *Defects in the Demand*

(a) Subject to paragraph (e), if the demand does not comply with the requirements specified in Rules 53 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) [No change]

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

(c-bis) 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 election concerned shall be considered not to have been made.

(d) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs Ca) to (c-bis).

*Ad Rule 60.1(e)*

1. *Present practice.* Under current Rule 69.1(b), a number of alternative events are listed, one of which must occur before international preliminary examination may start, even though the demand and necessary fees have already been submitted. The time delay which currently results from the requirements of Rule 69.1(b) uses valuable time which could be used for preliminary examination. It is, however, necessary under the present system because the basis for international preliminary examination is clear only after the expiration of the applicable period.
2. *Proposed solution.* In order to provide for international preliminary examination to begin as soon as possible after filing the demand, it is proposed above to add new Rules 53.2(a)(v) and 53.9 to require a declaration concerning the basis of the international preliminary examination. Proposed new Rule 60.1(e) relates to the situation where a declaration under Rule 53.2(a)(v) is filed but the amendment referred to therein is not submitted with the demand.
3. The application of the provision of Rule 60.1(a) to the omission of copies of amendments does not appear to be justified. The application of the sanction that the demand is considered as if it had not been submitted appears to be too severe and would probably also be in violation of Article 19, which permits the applicant to file amendments with the International Bureau with effect for the whole PCT procedure. Copies of amendments under Article 19 will be transmitted by the International Bureau in those instances where the applicant fails to attach them to the demand (see Rule 62, below). Where amendments under Article 34 are not available to the International Preliminary Examining Authority, that Authority shall invite the applicant to submit the missing amendments within a time limit fixed in the invitation; where the applicant fails to submit the missing amendment, the international preliminary examination will start on the basis of the international application without such amendment (see Rule 66.1(b), below); moreover, the applicant has the possibility, after receipt of the first written opinion, to present any amendment desired, including any earlier amendments which had not been taken into account by the International Preliminary Examining Authority for the first written opinion because the applicant failed to submit the copies of the amendments referred to in a declaration made in the demand.
4. However, it is proposed that the International Preliminary Examining Authority should bring to the attention of the applicant that the amendments (either under Article 19 or under Article 34) referred to in the declaration in the demand were not submitted.

[Rule 60.1, continued]

(e) Where the declaration referred to in “Rule 53.2(a)(v) specifies that the applicant wishes the international preliminary examination to be based on the international application as amended but a copy of an amendment referred to in the declaration is not submitted together with the demand, the International Preliminary Examining Authority shall bring that defect to the attention of the applicant. In the case of an amendment under Article 19, that Authority shall request the International Bureau to transmit a copy of such amendment to it. In the case of an amendment under Article 34, that Authority shall invite the applicant to submit the missing amendment within a time limit fixed in the invitation.

*Ad Rule 60.2*

1. *Present situation.* Rule 60.2(a) requires the International Bureau to invite the applicant to correct any defect in a later election within one month from the date of the invitation. There is no provision for longer periods or for any extension of the one-month time limit.
2. *Proposed solution.* During the discussion at the third session of the Committee on the proposed amendment to Rule 60.1(a), it was agreed that a consequential amendment should be made to Rule 60.2(a). It is therefore proposed to amend Rule 60.2(a) in order to liberalize the time limit for correction of defects in later elections, at the discretion of the International Bureau and as long as the time limit expires before the International Bureau must make a decision with regard to the later elections.
3. This proposed amendment was agreed in substance by the Committee at its third session, but it is now proposed with slight changes of a merely drafting nature.
4. In addition, it should be noted that Rule 60.2(c) provides a sanction where the applicant does not comply with an invitation under Rule 60.2(b), namely, that the later election shall be considered as if it had not been submitted. It is to be understood that the words “later election” in Rule 60.2, and particularly in 60.2(c), refer to a later election of a State and not to a notice submitted under Rule 56.1, which notice may include a number of later elections.
5. The provisions of Rule 60.2 do not, of course, apply to the situation where a signature is not required by virtue of Rule 56.1(b) to (d).



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. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Bureau at any time before a decision is taken.

(b) and (c) [No change]

*Ad Rule 61.1(b) and (c)*

1. *Present situation.* The present Rule 61.1(c) requires that the International Preliminary Examining Authority be notified of any later election received by the International Bureau. There appears, however, to be no interest on the side of the International Preliminary Examining Authority in receiving information about possible later elections. Furthermore, Rule 61.1(c) does not refer to the possibility that the date of receipt of a later election may be the date referred to in Rule 56.1(f) (see the proposal in relation to the latter Rule). In addition, the present Rules 61.1(b) and (c) contain references to Rules 54.4(b) and 57.5(c), respectively, which Rules are proposed to be deleted (see Ad Rules 54.4 and 57.1 to 57.5).
2. *Proposed solution.* It is proposed to amend Rule 61.1(b) to remove the reference to Rule 54.4(b) which is proposed to be deleted.
3. It is proposed to amend Rule 61.1(c) by deleting the reference to the International Preliminary Examining Authority and thus to no longer provide for notification of that Authority by the International Bureau of later elections. It is also proposed to amend Rule 61.1(c) to make it clear that the date of receipt of a later election may be the actual date of receipt by the International Bureau or, where applicable, the date referred to in either Rule 56.1(f) or 60.2(b). Furthermore, it is proposed, consequential to the deletion of Rule 57.5(c), to delete in Rule 61.1(c) the reference to Rule 57.5(c).

Rule 61

Notification of the Demand and Elections

61.1 *Notification to the International Bureau and the Applicant*<sup>\*</sup>

(a) [No change]

(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<sup>\*\*</sup>, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) The International Bureau shall promptly notify<sup>\*\*\*</sup> 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<sup>\*\*\*\*</sup> 60.2(c) as if it had not been submitted, the International Bureau shall notify the applicant accordingly.

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\* 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 “submitted”, the words “or where an election has been considered under Rule 54.4(b) as if it had not been made”.

\*\*\* 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”.

*Ad Rule 61.2(b)*

1. *Present situation.* Rule 61.2(b), at present, requires that the notification to each elected Office under Article 31(7) about its election include, in addition to the number of the international application, the name of the receiving Office. Since the application number already identifies the receiving Office by the two-letter code, the separate indication of the receiving Office is redundant. In addition, Rule 61.2(b) does not refer, in the case of later elections, to the possibilities that the date of receipt may be that referred to in Rule 56.1(f) (see the proposal in relation to that Rule) or Rule 60.2(b).

2. *Proposed solution.* It is proposed to delete from Rule 61.2(b) the requirement of an indication in the notification to the elected Offices of the name of the receiving Office with which the international application has been filed. Reference is made to the proposed amendment to Rule 53.6 where the special indication of the name of the receiving Office in the demand is no longer required. It is also proposed to amend Rule 61.2(b) to make it clear that the date of receipt of a later election is the date of actual receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b).

*Ad Rule 61.2(c)*

1. *Present situation.* Under the present Rule 61.2(c), the elected Offices shall be notified of their election promptly after the expiration of the 18<sup>th</sup> month from the priority date, or, if the international preliminary examination report is communicated earlier, then, at the same time as the communication of that report.

2. *Proposed solution.* If the proposed amendments to Rules 24.2 and 47.1(a) (see document PCT/CAL/IV/2) are adopted, the national Offices will be notified that they have been designated only together with the communication under Article 20. In order to avoid that an Office is notified of its election prior to the communication under Article 20, it is proposed to amend Rule 62.1(c) and to provide for the notification to the elected Offices of all elections made prior to the communication under Article 20 to be effected together with that communication.

*Ad Rule 61.2(d)*

1. *Present situation.* A new Rule 47.4 is proposed in document PCT/CAL/IV/2 to cover the situation where the applicant makes use of the possibility to expressly request under Article 23(2) the designated Office to start the processing or examination of the international application early, i.e., before the designated Office has received a copy of the international application together with the communication under Article 20. A similar provision is needed in case the applicant makes an express request for an early start of the national phase before an elected Office.

2. *Proposed solution.* It is proposed to add a new paragraph (d) to Rule 61.2, providing that, in the case of an express request by the applicant for an early start of the national phase, the applicant or the elected Office concerned may request the International Bureau for an advance communication under Article 20 of a copy of the international application to the elected Office. The communication would include the notification of the designation and of the election concerned.

## 61.2 *Notifications to the Elected Offices*

(a) [No change]

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant,<sup>\*</sup> the filing date of the application whose priority is claimed (where priority is claimed), the date of receipt by the International Preliminary Examining Authority of the demand, and in the case of later elections the date of receipt<sup>\*\*</sup> of the later election. The latter 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).

(c) The notification shall be sent to the elected Office together with the communication provided for in Article 20. Elections effected after such communication shall be notified promptly after they have been effected.

(d) Where the applicant makes an express request to the elected Office under Article 40(2) before the communication provided for in Article 20 has taken place, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect that communication to the elected Office concerned.

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\* The amendment consists in deleting, after the word “applicant,” the words “the name of the receiving Office”.

\*\* The amendment consists in deleting, after the word “receipt”, the words “by the International Bureau”.

*Ad Rule 61.3*

1. *Present situation.* Present Rule 61.3 provides for the International Bureau to inform applicants that the elected Offices have been notified of their election under Article 31(7) but does not require the naming of each elected Office which has been so notified. Furthermore, the second sentence of present Rule 61.3 requires the International Bureau to inform the applicant, in respect of each elected State, of any applicable time limit under Article 39(1)(b).
2. *Proposed solution.* It is proposed to amend Rule 61.3 by deleting the current second sentence relating to informing applicants of time limits and replacing it with a new sentence which provides that applicants will be informed of the elected Offices which have been notified as to their election. This amendment would allow applicants to check the correctness of the elections. It would also remove the requirement that the International Bureau inform the applicant in each case of the applicable time limit under Article 39(1)(b) in each elected Office. The latter amendment corresponds to the amendment proposed in document PCT/CAL/IV/2 concerning Rule 24.2(a) which contains an equivalent provision relating to Chapter I and the time limit under Article 22. The reasons given in respect of Rule 24.2(a) apply also here. The information needed as to applicable time limits under Article 39(1)(b) is available to applicants in the WIPO publication "PCT Applicant's Guide, Volume II".
3. A minor amendment to the first sentence would replace the words "that it has effected" by the word "of".
4. This proposed amendment was agreed by the Committee at its third session.

61.3 *Information for the Applicant*

The International Bureau shall inform the applicant in writing of the notification referred to in Rule 61.2. Such information shall also contain a list of the elected Offices notified under Article 31(7).

*Ad Rule 61.4*

1. *Present situation.* The Regulations do not provide for the publication of information relating to the fact that an international application is proceeding under Chapter II, i.e., that the start of the national phase will be postponed until 30 months after the priority date. The time during which no information is made available to third parties is then rather long. Consequently, the Delegation of the United Kingdom presented a proposal for a new Rule 61.4 (see document PCT/CAL/III/6) which was discussed at the third session of the Committee.
2. *Proposed solution.* It is proposed to add a new Rule 61.4 which would provide for the publication in the PCT Gazette of the fact that a demand was filed before the expiry of 19 months from the priority date.
3. Only the fact that a demand was filed would be published. It seems superfluous to publish also the list of the States which have been elected since applicants normally elect all the States designated originally and which are bound by Chapter II and since the list of designated States is published both in the pamphlet and in the PCT Gazette, thus easily available to third parties. In addition, with the number of PCT Contracting States increasing and the average number of designations, and consequently elections, being already at present around 20, the space required in the PCT Gazette would be rather large, if the names of, or even only the two-letter codes for, the elected States were to be published for each case.
4. Furthermore, the proposed new Rule would provide for the publication of the fact that a demand was filed only after the international application has 'been published under Article 21. If a demand is filed early, and the international application withdrawn before the 18-month publication, then the fact that a demand was filed will not be published. If a demand is filed for an international application which designates only the United States of America and consequently is not published pursuant to Article 64(3), the fact that a demand was filed will not be published either.
5. The proposed new Rule would not be inconsistent with Article 38, which relates to the confidential nature of the international preliminary examination, since the publication in the PCT Gazette will not give any information on the international preliminary examination report, nor whether or not such a report was issued, nor whether or not the demand or any elections were withdrawn. The publication will certainly not give third parties access to the file of the international preliminary examination.



61.4 *Publication in the Gazette*

Where a demand has been filed prior to the expiration of the 19th month from the priority date, the International Bureau shall publish a notification of that fact in the Gazette promptly after the filing of the demand, but not before the international publication of the international application.

*Ad Rule 62*

1. *Present situation.* Reference is made to the overview of several proposals regarding the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase, as set out at pages 2 to 7, above.
2. *Proposed solution.* It is proposed to revise Rule 62 and to provide in Rule 62.1 for the transmittal of copies of amendments under Article 19 by the International Bureau to the International Preliminary Examining Authority only in certain cases, namely, only where the applicant made reference in the demand to amendments under Article 19, but failed to attach a copy (see proposed Rule 60.1(e)). This would replace the provisions of the first sentence of present Rule 62.2(a).
3. In Rule 62.2 it is proposed to provide what is contained at present in the second sentence of paragraph (a) of that Rule. An applicant who files an amendment under Article 19 after he has filed a demand shall submit a copy to the International Preliminary Examining Authority. For the case that the applicant fails to submit such a copy, it is not proposed that the International Bureau would transmit that copy to the International Preliminary Examining Authority. This appears to be unnecessary. Once a demand is filed, amendments need to be made under Article 34. This, however, does not exclude the possibility of filing the same amendments under Article 19, but, if such amendments are filed, there is no longer a need for the International Bureau to submit copies to the International Preliminary Examining Authority.
4. In practice, it is extremely rare that applicants file amendments under Article 19 after they have filed a demand. If they do, then the amendments are usually the result of a written opinion issued by the International Preliminary Examining Authority. If the first written opinion has already issued when the applicant files amendments, it means that he files those amendments under Article 34 with the International Preliminary Examining Authority, in response to the opinion. However, the same amendments may also be filed under Article 19 with the International Bureau in order for them to be published by that Bureau.
5. Where a demand has been filed but the applicant wishes to amend the claims before the first written opinion has issued, such amendments need to be made under Article 34 and applicants must send the amendments to the International Preliminary Examining Authority. Where the applicant submits amendments under Article 19 only to the International Bureau, the International Preliminary Examining Authority would issue its opinion without taking into account such Article 19 amendments. This omission would be obvious to the applicant who can, when he receives the opinion, amend the international application in response to that opinion by submitting then a copy of the Article 19 amendments or any other amendment under Article 34, as appropriate in the light of the written opinion.

Rule 62

Copy of Amendments under Article 19 for the  
International Preliminary Examining Authority\*

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) to transmit a copy of an amendment under Article 19, it shall promptly transmit such a copy to that Authority.

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.

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\* The title has been changed from “Copy for the International Preliminary Examining Authority” to read “Copy of Amendments Under Article 19 for the International Preliminary Examining Authority”.

\*\* The title has been changed from “Amendments” to read “Amendments Made after the Demand is Filed”.

*Ad Rule 64.2*

1. *Present situation.* At the third session of the Committee, a proposed amendment to Rule 33.1(b) was considered. It appears that a similar amendment should be made to Rule 64.2. Rule 64.2 which relates to citing by the International Preliminary Examining Authority of written disclosures relating to an oral disclosure, use or exhibition which occurred before the “relevant” date” as defined in Rule 64.1(b). Such written disclosure shall be separately mentioned in the international preliminary examination report if it has been made available to the public on a date “after the relevant date”. Present Rule 64.2 does not cover the situation where the date on which the written disclosure is made available to the public on the relevant date.

2. *Proposed solution.* The proposed amendment would change the word “after” in Rule 64.2 to “on a date which is the same as, or later than,” in order to cover also the situation where the dates are the same. It is to be noted that voting on this item is subject to Rule 88.1 and notice requirements are set forth in Rule 88.4.

Rule 64

Prior Art for International Preliminary Examination

64.1 [No change]

64.2 *Non-Written Disclosures*

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means (“non-written disclosure”) before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the non-written disclosure shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.

*Ad Rule 64.3*

1. Present situation. At the third session of the Committee, a proposed amendment to Rule 33.1(c) was considered. It appears that a similar amendment should be made to Rule 64.3. Present Rule 64.3 relates to citing by the International Preliminary Examining Authority of published applications or patents which have a publication date “after”, but a filing or priority date which is “prior” to the “relevant date” defined in Rule 64.1(b). The Rule does not cover the situation where the publication date and the filing date of the international application are the same.

2. Proposed solution. The proposed amendment would change “as such, after” to “on a date which is the same as, or later than,” in order to cover the situation where the dates are the same. It is noted that voting on this item is subject to Rule 88.1 and notice requirements are set forth in Rule 88.4.

### 64.3 *Certain Published Documents*

In cases where any application or any patent which would constitute prior art for the purposes of Article 33(2) and (3) had it been published prior to the relevant date referred to in Rule 64.1 was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in Rule 70.10.

*Ad Rule 66*

1. *Present situation.* Reference is made to the overview of several proposals regarding the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase, as set out at pages 2 to 7, above. The basis of the international preliminary examination is presently, unless the applicant makes amendments under Article 34(2)(b) before the examination starts, the claims as filed or as amended under Article 19. Therefore, international preliminary examination can start only after amendments under Article 19 have been filed or once it is clear that no such amendments will be filed, under the present Rule 62.2. Waiting until the end of the period for filing amendments under Article 19 wastes valuable time which can better be used for international preliminary examination. Further, the present Rule does not indicate how claims to inventions on which no international search report has been established are to be treated before the International Preliminary Examining Authority.
2. *Proposed solution.* It is proposed to revise Rule 66.1 completely to set out the status of amendments for the purpose of the international preliminary examination.
3. The proposed amended first paragraph, Rule 66.1(a), is directed to the applicant's right to make amendments to his international application according to Article 34(2)(b) and provides that amendments may be filed with the International Preliminary Examining Authority at the time of filing the demand or, subject to Rule 66.1(c), subsequently.
4. The amended second paragraph, Rule 66.1(b), provides that the international preliminary examination shall initially be directed to the claims, description and drawings as filed or, where the applicant has specified amendments in the demand (see Rules 53.2(a)(v) and 53.9), to the claims, description and drawings as amended. It also provides that the International Preliminary Examining Authority may not start with the international preliminary examination until a copy of the amendment under Article 19 is available to it. It is recalled that, pursuant to proposed Rule 62.1, copies of amendments under Article 19 would be transmitted by the International Bureau to the International Preliminary Examining Authority where the applicant failed to submit them with the demand. On the other hand, if, despite the invitation referred to in Rule 60.1(e), the applicant has not submitted an amendment referred to in the demand as an amendment under Article 34, the International Preliminary Examining Authority shall start the international preliminary examination without taking such amendment into account.
5. Proposed Rule 66.1(c) clarifies the situation for the International Preliminary Examining Authority where amendments filed by the applicant are received at a time when the international preliminary examination has already started. The International Preliminary Examining Authority need not consider such amendments if the examiner, when he receives the amendment, has started to draw up a written opinion or the international preliminary examination report.
6. The proposed amendment does not limit in any way the possibility of amending the international application under Rules 66.3 and 66.4 subsequent to the first written opinion.



Rule 66

Procedure before the International Preliminary Examining Authority

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 paragraph (d), subsequently.

(b) The international preliminary examination shall initially be directed to the claims, the description, and the drawings, as filed or, where an amendment is referred to in the demand under Rule 53.9, as so amended. 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 commence the international preliminary examination until it has received such a copy from the applicant or, under Rule 62.1, from the International Bureau. Where the applicant failed to submit a copy of any amendment under Article 34 referred to in the demand within the time limit fixed in the invitation under Rule 60.1(e), the international preliminary examination shall commence on the basis of the international application without taking such amendment into account.

(c) If an amendment is received by the International Preliminary Examining Authority after the said Authority has begun to draw up a written opinion or, where applicable, the international preliminary examination report, the amendment need not be taken into account in relation to that opinion or report.

[Ad Rule 66, continued]

8. New Rule 66.1(d) and 66.2(a)(vi) are proposed to be added in order to provide that claims directed to inventions on which no international search report has been established need not be subject to international preliminary examination. These provisions clarify that there would be, during the limited time available for international preliminary examination, no further search required by the International Searching Authority and no search required by the International Preliminary Examining Authority. The procedure may result in any claims directed to inventions not searched being not taken into account for consideration by the International Preliminary Examining Authority. This situation may occur because there are new claims directed to non-searched inventions, or where the claims were not searched since the applicant did not pay additional search fees following a holding of lack of unity of invention by the International Searching Authority, or where claims were not searched because the International Searching Authority did not have available to it listings of nucleotide and/or amino acid sequences in suitable form (see proposed new Rule 39.1(vii) in document PCT/CAL/IV/2).

9. 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. 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.

10. The proposed amendments to add Rules 66.1(d) and 66.2(a)(vi) were agreed by the Committee at its third session.

*Ad Rule 66.2(a)(i)*

1. *Present situation.* Rule 66.2(a)(i) refers to the “defects” described in Article 34(4) whereas the latter does not contain the word “defect” in relation to the cases in which the International Preliminary Examining Authority will not carry out the international preliminary examination.

2. *Proposed solution.* It is proposed to amend Rule 66.2(a)(i)’ so that it refers to the “situations” described in Article 34(4) instead of the “defects”.

[Rule 66.1, continued]

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

66.2 *First Written Opinion of the International Preliminary Examining Authority*

(a) If the International Preliminary Examining Authority:

(i) considers that any of the situations referred to in Article 34(4) exists,

(ii) and (iii) [No change]

(iv) considers that any amendment goes beyond the disclosure in the international application as filed,\*

(v) wishes to accompany the international preliminary examination report by observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, or

(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, the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

(b) to (d) [No change]

66.3 to 66.9 [No change]

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\* The amendment consists in deleting the word “or”.

*Ad Rule 68.1*

1. *Present situation.* Rule 68 does not presently mention which claims are considered by the International Preliminary Examining Authority where there has been a finding of lack of unity of invention by the International Searching Authority and the international search report has been established in respect of some but not all of the claims. Rule 66.2(a) is proposed to be amended to provide in a new item (vi) that only claims relating to inventions for which an international search report has been established will be subject to international preliminary examination for the purposes of Article 33.
2. *Proposed solution.* It is proposed to amend Rule 68.1 consequential to proposed new item (vi) of Rule 66.2(a) and to provide that the requirement of unity of invention will only be considered as to claims directed to inventions on which an international search report has been established. An international search report may not have been established on some inventions because no additional fees were paid following a holding of lack of unity of invention by the International Searching Authority or because such inventions were not claimed at the time of the international search.
3. An invitation under Rule 68.2 to restrict or pay would then be issued only if the claimed invention had been searched. The sending of such an invitation would not be necessary where the applicant failed to pay additional fees for international search with the consequence that no international search report has been established in respect of the invention concerned.

Rule 68

Lack of Unity of Invention

(International Preliminary Examination)

68.1 *No Invitation to Restrict or Pay*

When 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 establish the international preliminary examination report, subject to Article 34(4)(b), in respect of those inventions on which the international search report has been established but shall indicate, in the said report, that, in its opinion, the requirement of unity of invention is not fulfilled and shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention.

68.2 to 68.5 [No change]

*Ad Rule 69.1(b)*

1. *Present situation.* Reference is made to the overview of several proposals regarding the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase, as set out at pages 2 to 7, above. At present, Rule 69.1(b) lists four different events and stipulates that international preliminary examination shall start only once any of these events occurs. This results in the start of international preliminary examination being unnecessarily delayed.
2. *Proposed solution.* It is proposed to amend Rule 69.1(b) to simplify the system in such a way that it guarantees an optimum use of the time available for international preliminary examination. International preliminary examination should be able to commence, as a general rule, upon receipt either of the international search report or of the declaration under Article 17(2) that no international search report will be established. If that report has already been established at the time of filing the demand or, if it is received only after the filing of a demand, international preliminary examination should start as soon as possible. International preliminary examination will, in both cases, commence on the basis of the declaration made by the applicant in the demand, subject to proposed Rule 66.1(b), or, if no declaration is made, of the application as filed (see the proposal concerning Rule 66.1, above). This guarantees a maximum of time for international preliminary examination and, subject to proposed Rule 66.1(b), avoids the present waiting time until the receipt of amendments under Article 19 or of various notices.

*Ad Rule 69.1(c)*

1. *Present situation.* Reference is made to the overview of several proposals regarding the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase, as set out at pages 2 to 7, above. Where the International Searching Authority and the International Preliminary Examining Authority are the same Office and wish to start international preliminary examination simultaneously with the international search, the second sentence of Rule 69.1(c) provides for a time limit for the establishment of the international preliminary examination report of six months after the expiration of the time limit under Rule 46 for amending claims under Article 19.
2. *Proposed solution.* It is proposed to delete the second sentence of Rule 69.1(c), since the 28-month time limit under Rule 69.1(a)(i) for the establishment of the international preliminary examination report fits perfectly in cases where the international preliminary examination starts together with the international search. There is no need for a special time limit for the so-called “telescoped” procedure under the present first sentence of Rule 69.1(c).

Rule 69

Time Limit for International Preliminary Examination

69.1 *Time Limit for International Preliminary Examination*

(a) [No change]

(b) International preliminary examination shall, subject to paragraph (c) and to Rule 66.1(b), 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 start at the same time as the international search.\*

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\* The amendment consists in deleting the last sentence.

*Ad Rule 70.2*

1. *Present situation.* Rule 70.2, relating to the basis of the international preliminary examination report, does not cover the situation where certain claims cannot be considered for international preliminary examination because they are drawn on inventions on which no international search report has been established and which under proposed Rule 66.2(a)(vi) (see above) are not required to be examined.
2. *Proposed solution.* A new Rule 70.2(d) is proposed which would clarify that the international preliminary examination report shall indicate if certain claims were not considered for international preliminary examination either because the claims are new and are drawn to inventions not claimed at the time the international search report was established or because the claims are drawn to inventions not searched because lack of unity of invention was found by the International Searching Authority and no additional search fees were paid for such inventions.
3. This proposed amendment was agreed by the Committee at its third session. However, the addition of the words “international preliminary examination” before the word “report” is proposed by the International Bureau.

*Ad Rule 70.3*

1. *Present situation.* Present Rule 70.3 requires both the international application number and the name of the receiving Office to be indicated in the -international preliminary examination report. The indication of the name of the receiving Office is superfluous because the receiving Office can be identified by the two-letter code forming part of the international application number.
2. *Proposed solution.* Reference is made to the explanations relating to the proposed amendments to Rules 53.6 and 61.2(b). The proposed amendment to Rule 70.3, deleting the requirement to indicate the name of the receiving Office, is complementary to the -deletion of the requirement under Rule 53.6 to identify in the demand the receiving Office with which the international application was filed.
3. At the same time, it is proposed to make an editorial change and to delete the comma after the word “application”.
4. This proposed amendment was agreed by the Committee at its third session.



Rule 70

The International Preliminary Examination Report

70.1 [No change]

70.2 *Basis of the Report*

(a) to (c) [No change]

(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 international preliminary examination report shall so indicate and state the reasons therefore.

70.3 *Identifications*

The report shall identify the International Preliminary Examining Authority which established it by indicating the name of such Authority, and the international application<sup>\*</sup> by indicating the international application number, the name of the applicant,<sup>\*\*</sup> and the international filing date.

70.4 to 70.11 [No change]

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\* The amendment consists in deleting the comma after the word “application”.

\*\* The amendment consists in deleting, after the word “applicant,” the words “the name of the receiving Office”.

*Ad Rule 70.12*

1. *Present situation.* Rule 70.12, relating to the mention of certain defects in the international preliminary examination report, does not provide for the inclusion of any opinions or reasons as to why the International Preliminary Examining Authority considers that, under Article 34(4), the international application relates to subject matter on which it has decided not to carry out the international preliminary examination or that the international application is so unclear or the claims are so inadequately supported by the description that no meaningful opinion can be made. The relevant provisions, however, exist. They are contained in Article 35(3).

2. *Proposed solution.* A new paragraph (iii) is proposed to be added to Rule 70.12 which would provide that, if the International Preliminary Examining Authority considers that any of the situations referred to in Article 34(4) exists, it shall include this opinion and the reasons therefore in the international preliminary examination report as provided in Article 35(3). Consequently, it is proposed to amend the title of the Rule in order to reflect its content better by adding a reference to other matters which are not considered to be defects. Thus, together with the amendment to Rule 70.13, proposed below, Rule 70 would list comprehensively all the items which must be included in the report.

*Ad Rule 70.13*

1. *Present situation.* The present Rule 70.13, relating to remarks concerning unity of invention, provides only for the situation where an invitation to pay additional fees was issued. Where no such invitation was issued despite a clear lack of unity, it is Rule 68.1 which contains the provision relating to remarks concerning unity of invention.

2. *Proposed solution.* It is proposed to amend Rule 70.13 by adding a cross-reference to Rule 68.1 and thus complete the listing of items which must be included in the report.

3. This proposed amendment was agreed by the Committee at its third session.

### 70.12 *Mention of Certain Defects and Other Matters\**

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

- (i) [No change]
- (ii) the international application calls for any of the observations referred to in Rule 66.2(a)(v), it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;
- (iii) any of the situations referred to in Article 34(4) exists, it shall include this opinion and the reasons therefore in the report.

### 70.13 *Remarks Concerning Unity of Invention*

If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a)), or on the main invention only (Article 34(3)(c)), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chooses not to invite the applicant to restrict the claims or to pay additional fees.

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\* The title has been amended to read “Mention of Certain Defects and Other Matters” instead of “Mention of Certain Defects”.

*Ad Rule 70.14*

1. *Present situation.* Present Rule 70.14 requires that a signature appear on the international preliminary examination report. The requirement for signature is an additional step that requires returning the typed report, prior to mailing, back to the authorized officer. In particular, when the report is produced with the help of a central computer, the obtaining of original signatures requires special handling.
2. *Proposed solution.* In order to simplify processing of the international preliminary examination report, it is proposed to amend Rule 70.14, including its title, and to provide only for an indication of the name of the authorized officer rather than a signature. It is to be understood that the name may be indicated by writing, typing, printing or use of a seal. If an International Preliminary Examining Authority desired signature for internal control purposes, it would be free to do so, but no signature would be required on the report itself.
3. A similar amendment had been proposed concerning the international search report (see Rule 43.8 in document PCT/CAL/IV/2) and agreed by the Committee at its third session.
4. This proposed amendment was agreed by the Committee at its third session.

*Ad Rule 70.16*

1. *Present situation.* Rule 70.16 currently provides only that replacement sheets containing amendments made before the International Preliminary Examining Authority under Rule 66.8(a) be attached to the international preliminary examination report. Sheets containing amendments of the claims under Article 19 made before the International Bureau are not mentioned.
2. *Proposed solution.* It is proposed to amend Rule 70.16 and to provide that all replacement sheets containing amendments which have not been superseded be attached to the international preliminary examination report. Thus, it is also made clear for the purposes of Rule 74 what must be translated for the elected Office.

70.14 *Authorized Officer*\*

The report shall indicate the name of an authorized officer of the International Preliminary Examining Authority.

70.15 [No change]

70.16 *Annexes of the Report*

Each replacement sheet under Rule 66.8(a) and each replacement sheet containing amendments under Article 19 shall, unless superseded by later replacement sheets, be annexed to the international preliminary examination report. Letters under Rule 66.8(a) shall not be annexed.

70.17 [No change]

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\* The title has been amended to read “Authorized Officer” instead of “Signature”.

*Ad Rule 71.2*

1. *Present situation.* Rule 71.2(c) currently provides that an International Preliminary Examining Authority may send copies of documents cited in the international preliminary examination report to the International Bureau which would then supply copies to the elected Office or to the applicant. No use of this procedure has been made since operations began under Chapter II.
2. *Proposed solution.* In view of the fact that no use is being made of the procedure under paragraph (c) of Rule 71.2, it is proposed that this paragraph be deleted along with references thereto in paragraph (d). A similar change had been proposed in respect of Rule 44.3, which contains an equivalent provision for the International Searching Authority (see document PCT/CAL/IV/2) and was agreed by the Committee at its third session.
3. This proposed amendment was agreed by the Committee at its third session. However, the International Bureau proposes to insert the word “paragraphs” before “(a) and (b)”.

Rule 71

Transmittal of the International Preliminary Examination Report

71.1 [No change]

71.2 *Copies of Cited Documents*

(a) and (b) [No change]

(c) [Deleted]

(d) Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

*Ad Rule 72.1*

1. *Present situation.* Under the present text of Rule 72, any elected State has the right to require from the International Bureau a translation into English, French, German, Japanese, Russian or Spanish of any international preliminary examination report established in a language other than the official language or one of the official languages of the national Office. Each required translation is a burden for the applicant, who has to pay a further handling fee for each language, for the International Preliminary Examining Authority, which has to check whether the handling fees corresponding to the various translations have been paid by the applicant, and for the International Bureau, which has to prepare all those translations.

2. The International Bureau has, therefore, proposed in the past to all national Offices that translations should be required only if an international preliminary examination report is not in English and then the translation should be into English and into no other language. This has been accepted by all elected Offices and the present worldwide practice is to require a translation of the international preliminary examination report only into English.

3. *Proposed solution.* It is proposed to amend Rule 72.1(a) in order to reflect the present practice, which will also make it binding for all future Contracting States bound by Chapter II. The amendment of this Rule is a condition for the proposed amendments relating to the handling fee in Rule 57 and the Schedule of Fees. It will make the system simpler because it would permit the charging of one single handling fee irrespective of whether or not the translation into English will have to be made by the International Bureau. It will simplify the work of the International Preliminary Examining Authority in checking the correct payment of the prescribed handling fee. Furthermore, it will take from the International Bureau the burden of translating the sometimes very complicated international preliminary examination reports into various languages. Those translations would be difficult for the International Bureau to cope with in the future in view of the increasing number of international applications filed and increasing use of Chapter II.

4. This proposed amendment was agreed by the Committee at its third session.

*Ad Rule 72.2*

1. *Present situation.* During the discussion at the third session of the Committee of the proposed amendment to Rule 72.1, it was agreed that a consequential amendment should be made to Rule 72.2 which relates to the transmittal by the International Bureau of a translation of the international preliminary examination report to the applicant and to the elected Offices. The reference to “each” translation means that there can be more than one translation of the same report. This is no longer the case (see Ad Rule 72.1).

2. *Proposed solution.* It is therefore proposed to replace the word “each” by the word “any” so that the Rule will adequately reflect the present practice under which the International Bureau only transmits a copy of the English translation of the international preliminary examination report to the applicant and the elected Office, if a translation is required, i.e., no other translations are required by any elected Office.

3. This proposed amendment was agreed by the Committee at its third session.



Rule 72

Translation of the International Preliminary Examination Report

72.1 *Languages*

(a) Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office, be translated into English\*.

(b) [No change]

72.2 *Copies of Translations for the Applicant*

The International Bureau shall transmit a copy of any translation of the international preliminary examination report to the applicant at the same time as it communicates such translation to the interested elected Office or Offices.

72.3 [No change]

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\* The amendment consists in deleting, after the word “English”, the words “French, German, Japanese, Russian, or Spanish”.

*Ad Rule 73.2*

1. *Present situation.* The communication under Article 36(3)(a) of the international preliminary examination report by the International Bureau to the elected Offices shall, under present Rule 73.2, be effected as promptly as possible. If a demand is filed early, it may happen that the report issues prior to the communication under Article 20 of a copy of the international application and prior to a national Office being notified of its election, which notification under proposed amended Rule 61.2(c) is to be sent together with the communication under Article 20.
2. *Proposed solution.* It is proposed to amend Rule 73.2 and to provide that the communication of the international preliminary examination report to the elected Office will not be effected prior to the notification of an election which is proposed to take place together with the communication under Article 20 (see Ad Rule 61.2(c), above).
3. This proposed amendment was agreed by the Committee at its third session.

Rule 73

Communication of the International Preliminary Examination Report

73.1 [No change]

73.2 *Time Limit for Communication*

The communication provided for in Article 36(3)(a) shall be effected as promptly as possible but not earlier than the communication under Article 20.

*Ad Rule 73bis [New]*

1. *Present situation.* Reference is made to the overview of several proposals regarding the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase, as set out at pages 2 to 7, above. The Regulations presently assume that any amendments, for example, those under Article 19, constitute part of the international application and proceed as such into the national phase. This causes problems where, during the international preliminary examination procedure, the applicant decides not to proceed further with the amendments made under Article 19 or decides to make other amendments under Article 34(2)(b) which supersede those made previously under Article 19. Although a copy of any amendments made during the international preliminary examination procedure which have not been superseded is annexed to the international preliminary examination report (Rule 70.16), the status of superseded amendments is not clear.
2. *Proposed solution.* It is proposed to add new Rule 73bis to provide expressly that any amendments, including amendments under Article 19, which are not annexed to the international preliminary examination report are to be considered withdrawn for the purposes of the national law of any State which was elected before the expiration of the 19<sup>th</sup> month from the priority date. This will not, of course, affect the right of the applicant to make amendments in the national phase under Article 41.
3. If the national phase before an elected Office is entered prior to the establishment of the international preliminary examination report, any amendments made before the International Preliminary Examining Authority will not have been communicated to that Office under Article 36. If the applicant desired that any such amendment which was not communicated be considered by the elected Office, such amendment should be made under Article 41 and Rule 78.

Rule 73bis [New]

Amendments Not Annexed to the International  
Preliminary Examination Report

73bis.1 *Amendments Considered Withdrawn*

For the purposes of the procedure before the national Office of or acting for any Contracting State which was elected before the expiration of the 19th month from the priority date, any amendments made to the international application which are not annexed to the international preliminary examination report shall be considered to have been withdrawn.

*Ad Rule 75*

1. *Present situation.* Rule 75 relates to the withdrawal of the demand, or of elections. A new Rule 90bis is proposed below which would incorporate the content of Rule 75.
2. *Proposed solution.* If new Rule 90bis is adopted, it is proposed to delete Rule 75 since the subject matter thereof is covered in new Rule 90bis.
3. This proposed amendment was agreed by the Committee at its third session.

Rule 75

[Deleted]

*Ad Rule 76.5(ii)*

1. *Present situation.* Rule 76.5 stipulates that certain Rules relating to Chapter I of the PCT apply also under Chapter II, provided that any reference in the said Rules to certain expressions or Articles is to be construed as a reference to the corresponding expressions or Articles under Chapter II. Rule 49.1(a-ter), which is one of the Rules which applies, contains a cross-reference to Article 24(2). The corresponding cross-reference under Chapter II would be a reference to Article 39(3); however, it is not contained in Rule 76.5. The lack of that reference appears to be an unintentional omission.
2. *Proposed solution.* It is proposed, in order to make Rule 49.1(a-ter) also applicable if Chapter II applied, to amend Rule 76.5 by specifying in item (ii) that a reference to Article 24(2) is to be construed as a reference to Article 39(3).
3. This proposed amendment was agreed by the Committee at its third session.

*Ad Rule 76.5(iv)*

1. *Present situation.* Reference is made to the overview of several proposals regarding the status of amendments of international applications in relation to the international preliminary examination procedure and upon entry into the national phase, as set out at pages 2 to 7, above. It is not clear, at present, whether the applicant must furnish to the elected Office, under Article 39(1)(a), a translation of any amendment under Article 19. Such amendment would under present Rule 70.16, if it has been made before the start of the international preliminary examination and has been used as a basis of the examination, not be annexed to the international preliminary examination report and therefore would not have to be translated for the purposes of Article 39(1) under Rule 74.1. A translation of claims which have been amended under Article 19 is provided only for the purposes of Article 22 in Rule 49.5(a) but Article 22 does not apply where Article 39(1) applies. Therefore, it is doubtful to which extent any amendment under Article 19 must be translated by the applicant where Article 39(1) applies.
2. *Proposed solution.* A new item (iv) is proposed to be added to Rule 76.5 which would clarify that, for the purposes of Article 39(1), translations of amendments under Article 19 which were not taken into account by the International Preliminary Examining Authority when establishing the international preliminary examination report, need not be furnished to the elected Offices. It should be noted that Rule 76.5(iv) only relates to requirements which must be satisfied to effect entry into the national phase. It does not prevent a translation from being required under national law at a later time as a condition, for example, of enforcing provisional protection.
3. Under the new system which is proposed to be implemented under Chapter II, the applicant must indicate in the demand whether amendments under Article 19 have been filed and, in the affirmative, he must provide a copy to the International Preliminary Examining Authority (see the proposed new Rule 53.9, above). Under Rule 70.16, replacement sheets containing amendments made before the International Preliminary Examining Authority must be annexed to the report and any annex to the report may be required to be translated under Rule 74.1. It follows from these provisions that, under the said new system, amendments under Article 19 on which the international preliminary



Rule 76

Copy, Translation and Fee under Article 39(1);  
Translation of Priority Document

76.1 to 76.3 [Remain deleted]

76.4 [No change]

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

Rules.22.1(g), 49 and 51bis shall apply, provided that:

- (i) [No change]
- (ii) any reference in the said Rules to Article 22 or Article 24(2) shall be construed as a reference to Article 39(1) or Article 39(3), respectively;
- (iii) the words “international applications filed” in Rule 49.1(c) shall be replaced by the words “a demand submitted”;
- (iv) for the purposes of Article 39(1), a translation of any claim as amended may only be required if that claim as amended is annexed to the international preliminary examination report.

[Ad Rule 76.5(iv), continued]

examination is based will be annexed to the report and may be required to be translated under Rule 74.1. If amendments under Article 19 have not been subjected to international preliminary examination, they will not be annexed to the international preliminary examination report. Under proposed new Rule 73bis (see above), it is clarified that any amendments to the claims (e.g., under Article 19) which are not annexed to the international preliminary examination report are to be considered withdrawn.

*Ad Rule 76.6 [New]*

1. *Present situation.* Several national laws require the furnishing of amendments under Article 19 irrespective of whether or not the international application was subjected to international preliminary examination and whether such amendments are still relevant after such examination. Such a requirement entails the need for applicants to translate amended claims which have been superseded, and it would not be compatible with proposed Rule 76.5(iv).
2. *Proposed solution.* It is proposed to include a transitional provision in a new Rule 76.6 for the Contracting States whose national laws would not be in compliance with Rule 76.5(iv) at the time of its adoption. Information on such laws would be published by the International Bureau in the Gazette.

*76.6 Transitional Provision*

If, on [date of adoption by the PCT Assembly], Rule 76.5(iv) is not compatible with the national law applied by the elected Office in respect of claims amended under Article 19, Rule 76.5(iv) shall not apply in that respect to that elected Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

*Ad Rule 78.1(a)*

1. *Present situation.* Under the present text of Rule 78.1(a), which fixes the time limit for submitting amendments to the international application before the elected Offices, any amendment must have been made upon entering the national phase before the elected Offices, at the latest before the expiration of the time limit applicable under Article 39. Rule 52.1(a) contains an equivalent provision fixing a time limit for amendments upon entering the national phase before the designated Offices. The time limit under Rule 52.1(a), however, is one month from the fulfillment of the requirements for entering the national phase or, if the international application has not yet been communicated by the expiration of the time limit applicable under Article 22, amendments must be made not later than four months after the expiration of that time limit.

2. *Proposed solution.* It is proposed to amend Rule 78.1(a) and to provide in that Rule a time limit which corresponds to the time limit under Rule 52.1(a). There seems to be no particular reason why the time limits for amending the international application are different in the two Rules. Furthermore, it would be simpler for applicants to remember that they have always at least one month from the fulfillment of the requirements for entering the national phase under Article 39(1)(a). Should, exceptionally, the international preliminary examination report not have been established under Rule 69.1(a)(i) before the expiration of 28 months from the priority date, it is proposed to allow for the filing of amendments within four months after the expiration of the time limit applicable under Article 39. This corresponds to the time limit provided by Rule 52.1(a) for filing amendments. Thus, both Rules 52.1(a) and 78.1(a) would provide for equivalent time limits for amendments to the application before the designated and elected Offices, respectively.

3. This proposed amendment was agreed by the Committee at its third session.

*Ad Rule 78.1(b)*

1. *Present situation.* During the discussion at the third session of the Committee on the proposed amendment to Rule 78.1(a), it was agreed that a consequential amendment was required to be made to Rule 78.1(b) because it refers to the time limit applicable under Article 39(1). This time limit would no longer be applicable where the time limit under Rule 78.1(a) applies. The reference to Article 39(1) should be replaced by a reference to the time limit applicable under Rule 78.1(a).

2. *Proposed solution.* It is therefore proposed to amend Rule 78.1(b) by replacing the reference to the time limit under Article 39(1) by a reference to the time limit under paragraph (a) of the Rule.

3. This proposed amendment was agreed by the Committee at its third session.

Rule 78

Amendment of the Claims, the Description, and the  
Drawings, before Elected Offices

*78.1 Time Limit Where Election Is Effected prior to Expiration of  
19 Months from Priority Date*

(a) Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the applicant shall, if he so wishes, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfillment of the requirements under Article 39(1)(a), provided that, if the transmittal of the international preliminary examination report under Article 36(1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any other time if so permitted by the national law of the said State.

(b) In any elected State in which the national law provides that examination starts only on special request, the national law may provide that the time limit within or the time at which the applicant may exercise the right under Article 41 shall, where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under paragraph (a).

78.2 and 78.3 [No change]

*Ad Rule 80.7(c)*

1. *Present situation.* Rule 80.7(c) provides that the International Bureau shall be open for business until 6 p.m. In practice, the International Bureau is open for receipt of documents filed by hand or through the post until 6 p.m. on all working days which are not holidays. The International Bureau publishes in the PCT Gazette the holidays on which it is closed for receipt of documents filed by hand or through the post. For receipt of documents by teleprinter or facsimile machine, the International Bureau's machines operate 24 hours a day, seven days a week, i.e., a document received by the International Bureau before midnight is considered to have been received that day despite the fact that the International Bureau is closed for business after 6 p.m., provided that that day is a day on which the International Bureau is open for business. If a document is received by teleprinter or facsimile machine on a non-working day (e.g., Saturday or Sunday), the date of receipt is the next working day.

2. *Proposed solution.* It is proposed to delete Rule 80.7(c). It is sufficient that the Regulations provide that a period expiring on a given day shall expire at the moment the national Office or intergovernmental organization with which the document must be filed or to which the fee must be paid closes for business on that day. There is no necessity to provide in the Regulations for the hours on which the International Bureau is open for business. The opening hours could be fixed in the Administrative Instructions and, even more important, could be published, together with the list of non-working days, once a year in the PCT Gazette. Rule 80.7(b) allows departure from that principle, in the sense that documents may be filed up to midnight. In particular, for documents sent by facsimile machine there is no reason why they should not be accepted if they are received by the International Bureau after closing for business. A document received on a working day before midnight will be considered to have been filed that day. Documents received on non-working days would continue to be dated as received on the next working day.

3. This proposed amendment was agreed by the Committee at its third session.

Rule 80

Computation of Time Limits

80.1 to 80.6 [No change]

80.7 *End of Working Day*

(a) and (b) [No change]

(e) [Deleted]

*Ad Rule 82.1*

1. *Present situation.* The procedural safeguard contained in Rule 82 has proven to be of importance to prevent losses of rights. Applicants can provide evidence of mailing of documents if the sending was effected five days prior to the expiration of a time limit and the document or letter was received after expiry of the time limit.
2. In many instances conscientious applicants make use of the very reliable express mail services offered by the postal authorities or by private enterprises. However, Rule 82 permits evidence only if the mailing was by mail registered by the postal authorities. When a private over-night delivery service is used and a letter or document is registered by them, the document or letter is not registered by a postal authority. Sending of documents through private delivery services is more and more frequently done. Therefore, the right to present evidence on the timely mailing has shown itself in practice to be too limited.
3. *Proposed solution.* In order to liberalize the right to provide evidence in cases of delayed or lost documents or letters, it is proposed to add a new Rule 82.1(d) which would enable the national Offices to treat documents delivered by a private delivery service as if they had been delivered by mail. The optional nature of this provision would allow any Office to accept evidence as to delays or loss of documents relating to international applications. Those Offices which do not wish to do so would have the option not to.
4. The qualifications as to evidence set out in the last sentence of proposed new paragraph (d) would apply only to the cases where a delivery service is used (i.e., paragraph (d) and not to the cases where the mail is used (i.e. paragraphs (a) to (c)). This sentence envisages that the national law may enable evidence of the matters referred to in Rule 82.1(a) to (c) to be presented in an established procedure (e.g., by way -of the production of a statutory declaration). If there is no such procedure, such evidence would be acceptable only from a person having the right to practice before the national Office or intergovernmental organization concerned, thus reducing the possibility of abuse.



Rule 82

Irregularities in the Mail-Service

82.1 *Delay or Loss in Mail*

(a) to (c) [No change]

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

82.2 [No change]

*Ad Rule 86.3*

1. *Present situation.* Rule 86.3 provides, in its paragraph (a), that the PCT Gazette be published once a week, subject to paragraph (b) which in turn provides for a “transitional period” after the entry into force of the Treaty terminating upon a date fixed by the Assembly, during which the frequency of publication of the Gazette is to be determined by the Director General.. The transitional period is still in effect, and the PCT Gazette is published every second week.
2. *Proposed solution.* It is proposed to amend Rule 86.3 and to entrust, on a permanent basis, the determination of the frequency of publication of the PCT Gazette to the Director General. In other words, it is proposed that the present “transitory system” become the rule applicable without any time limit. It is to be noted that any change in the frequency of the publication of the PCT Gazette would have budgetary and other administrative consequences, and the PCT Assembly would, when considering the budget and the accounts of the PCT Union, be informed accordingly. Consequently, the Assembly could change any decision of the Director General with which it disagrees.

*Ad Rule 86.4*

1. *Present situation.* Rule 86.4 provides, in its paragraph (a), that the subscription and other sale prices of the PCT Gazette be fixed in the Administrative Instructions, subject to paragraph (b) which in turn provides for a “transitional period” after the entry into force of the Treaty terminating upon a date fixed by the Assembly, during which the PCT Gazette may be distributed on such terms as the Director General considers appropriate having regard to the number of international applications and the amount of other material published therein. The transitional period is still in effect and details are provided in the Administrative Instructions in Section 407(d).
2. *Proposed solution.* As in the case of periodicity of publication of the PCT Gazette (see Ad Rule 86.3), it is proposed to entrust, on a permanent basis, the determination of the subscription and other sale prices of the PCT Gazette to the Director General, without having to modify the Administrative Instructions each time a change is desirable. If the proposed amendment is adopted, Section 407(d) could be deleted.

*Ad Rule 86.5*

1. *Present situation.* Present Rule 86.5 specifies the title of the Gazette in English for the English edition and in French for the French edition. The Delegation of the Netherlands, at the first part of the third session of the Committee (see paragraph 83 of document PCT/CAL/III/5) questioned the need for such a specific provision in the Regulations and suggested that the title could be determined by the Director General.
2. *Proposed solution.* It is proposed to amend Rule 86.5 to give the Director General the authority to determine the title of the Gazette. The design of the existing cover pages of both editions already highlights the expressions “PCT Gazette” and “Gazette du PCT” in English and French, respectively.

Rule 86

The Gazette

86.1 and 86.2 [No change]

86.3 *Frequency*

The frequency of publication of the Gazette shall be determined by the Director General.

86.4 *Sale*

The subscription and other sale prices of the Gazette shall be determined by the Director General.

86.5 *Title*

The title of the Gazette shall be determined by the Director General.

86.6 [No change]

*Ad Rule 87.2(b)*

1. *Present situation.* Rule 87.2(b) provides that any national Office desiring to receive copies of certain PCT publications must make a request by November 30 for the publications desired during the following calendar year and specify which language of publication is desired.
2. *Proposed solution.* Rule 87.2(b) is proposed to be amended to provide only that the national Offices must make a request for copies of publications, without any requirement for an annual renewal of such request. Rule 87.2(b), as proposed to be amended, would also provide for copies of publications to be obtained in more than one language.
3. This proposed amendment was agreed by the Committee at its third session.

Rule 87

Copies of Publications

87.1 [No change]

87.2 *National Offices*

(a) [No change]

(b) The publications referred to in paragraph (a) shall be sent on special request\*. If any publication is available in more than one language, the request shall specify the language or languages in which it is desired.

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\* The amendment consists in deleting, after the words “special request”, the following: “, which shall be made, in respect of each year, by November 30 of the preceding year”.

*Ad Rule 88.1(ii)*

1. *Present situation.* Rule 88.1(ii) still refers to the alternative procedure for transmittal of the record copy to the International Bureau under Rule 22.2 which was deleted in 1984.
2. *Proposed solution.* It is proposed that Rule 88.1(ii) be deleted, because Rule 22.2, to which it refers, has already been deleted. It is noted that voting on this item is subject to Rule 88.1 and notice requirements are set forth in Rule 88.4.
3. This proposed amendment was agreed by the Committee at its third session.

Rule 88

Amendment of the Regulations

88.1 *Requirement of Unanimity*

Amendment of the following provisions of these Regulations shall require that no State having the right to vote in the Assembly vote against the proposed amendment:

- (i) [No change]
- (ii) [Deleted]
- (iii) to (vii) [No change]

88.2 to 88.4 [No change]

*Ad Rules 90.1, 90.1bis and 90.2*

1. *Present situation.* Rule 90.1 presently provides definitions of “agent” and “common representative”. The definition of “agent” overlaps or conflicts with that given in Rule 2.2. Moreover, it only includes persons who are entitled to practice under Article 49. This has particular practical importance in relation to the appointment of agents for the purposes of the procedure before an International Preliminary Examining Authority. Applicants from Japan and the United States of America, when filing a demand for international preliminary examination with the European Patent Office (EPO), often appoint a European patent attorney for the international preliminary examination procedure before the EPO as International Preliminary Examining Authority. These European patent attorneys are entitled to practice before the EPO but not before the national Offices of Japan and the United States of America, with which the international applications were filed.
2. *Proposed solution.* In view of the proposals for amendment of Rule 2.2 and the inclusion of a new Rule 2.2bis (see document PCT/CAL/IV/2), it is proposed to delete the definitions in present Rule 90.1. They are no longer needed if the proposed amendments to Rule 2 are accepted.
3. Rule 90.1 as proposed to be amended deals specifically with appointments as agents, and the proposed new title reflects that change. Under proposed new Rule 90.1(a), it is made clear who may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority; namely, any person entitled to practice before the national Office with which the international application was filed (see Article 49). It should be noted, in the context of Article 49 and proposed Rule 90.1(a) that the term “national Office” includes any intergovernmental authority entrusted with the task of granting regional patents (see the definition of the term in Article 2(xii)).
4. It is apparent that Article 49, while it guarantees certain persons a right to practice, is not exhaustive of all persons who may practice before an International Searching Authority or International Preliminary Examining Authority and is not intended to exclude persons who are otherwise entitled to practice before the Office which acts as such an Authority. Proposed new Rule 90.1(b) and (c) clarifies this point by providing an express possibility for persons to be appointed as agents to represent the applicant specifically before the International Searching Authority or International Preliminary Examining Authority, respectively, if they have the right to practice before the national Office or intergovernmental organization which constitutes the Authority.
5. It should be noted that the proposals in relation to agents under Rules 2.2 and 90 have no bearing on the operation of Rule 51bis.1(b)(i) and (ii) in relation to requirements of the national law applicable by the designated Office concerning the appointment of local agents.



Rule 90

Agents and Common Representatives\*

90.1 *Appointment as Agent\*\**

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

(b) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Preliminary Examining Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

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\* The title has been amended to read “Agents and Common Representatives” instead of “Representation”.

\*\* The title has been amended to read “Appointment as Agent” instead of “Definitions”.

[Ad Rules 90.1, 90.1bis and 90.2, continued]

6. Proposed new Rule 90.1(d) would enable an agent to appoint one or more sub-agents to represent the applicant as the applicant's agent. Under the proposed new provision, appointments of sub-agents may be made by an agent unless otherwise indicated in the document appointing him, making for a smooth and expedient processing of international applications. A person may be appointed as a sub-agent to represent the applicant before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority if he has the right to practice referred to in Rule 90.1(a). A person may be appointed as a sub-agent to represent the applicant specifically before the International Searching Authority or the International Preliminary Examining Authority if he has the right to practice referred to in Rule 90.1(b) or (c), as the case may be. A sub-agent would thus be the applicant's agent in the same way as a agent appointed by the applicant himself, and the term "agent" in the Regulations thus includes a sub-agent appointed under Rule 90.1(d).

7. Proposed new Rule 90.1bis relates to common representatives, replacing the present provisions of Rule 4.8(a) and (b), which are proposed to be amended accordingly (see document PCT/CAL/IV/2). Rule 90.1bis(a) would enable the appointment by two or more applicants, where they have not appointed a common agent, of one of them who is entitled to file an international application according to Article 9, as their common representative. Rule 90.1bis(b) deals with the case where no common agent or common representative is appointed. In such a case, the applicant first named in the request who is entitled under Rule 19.1 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 90.1, continued]

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority, provided that the person appointed as sub-agent has the right to practice referred to in paragraph (a)i

(ii) specifically before the International Searching Authority or the International Preliminary Examining Authority, provided that the person so appointed as sub-agent has the right to practice referred to in paragraph (b) or (c), as the case may be.

90.1bis *Common Representative*

(a) Where there are two or more applicants and all the applicants have not appointed 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.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent or common representative, 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.

[Ad Rules 90.1, 90.1bis and 90.2, continued]

8. The title of Rule 90.2 is proposed to be amended to reflect more fully the content of the Rule. Minor changes are proposed to the wording of Rule 90.2(a) and (c) consequential on the amendments proposed to Rule 90.1.

9. Present Rule 90.2(d) provides for the appointment of agents and common representatives to have the effects set out in Rule 90.1(a), (b) and (c) in relation to the processing of the international application by the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority. This is inconsistent with proposed Rule 90.1 which envisages that an agent could be appointed for the purposes specifically of the procedure before the International Searching Authority or the International Preliminary Examining Authority. Rule 90.2(d) is thus no longer required and is proposed to be deleted.

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

(a) Any act by or in relation to an agent shall have the effect of an act by or in relation to the applicant or applicants concerned.

(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.\*\*

(c) If there are two or more agents representing the same applicant or applicants, any act by or in relation to any of those agents shall have the effect of an act by or in relation to the said applicant or applicants.

(d) [Deleted]

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

\*\* This paragraph is not proposed to be amended. The text is included here for convenient reference.

*Ad Rule 90.3*

1. *Present situation.* At present, Rule 90.3(a) does not enable an agent or common representative to be appointed in the demand. The Rule refers only to the request and to a separate power of attorney.
2. Under Rule 90.3(b), a power of attorney must be submitted either to the receiving Office or to the International Bureau. The filing of a power of attorney with the International Searching Authority or International Preliminary Examining Authority is not provided for. If the applicant appoints an agent for his representation before the International Preliminary Examining Authority, he must at present furnish the power of attorney to the receiving Office or to the International Bureau. If he furnishes it to the receiving Office, that Office is usually not aware of the fact that a demand has been filed and therefore cannot, although it should under the present Rule 90.3(b), inform the International Preliminary Examining Authority. This can result in delaying the receipt of the power of attorney by the appropriate authority.
3. *Proposed solution.* The title of Rule 90.3 is proposed to be amended to better reflect the amended subject matter of the Rule. It is proposed to amend the text of Rule 90.3(a) to replace or of any common representative within the meaning of Rule 4.8(a), by “or common representative”, noting the definition of “common representative” proposed for inclusion in Rule 2.2bis. It is also proposed to amend Rule 90.3(a) to refer specifically to the possibility of appointing an agent or a common representative in the demand itself.
4. It is proposed to amend Rule 90.3(b) to require that, where an agent (i.e., including a sub-agent) is appointed in a separate power of attorney to represent the applicant specifically before the International Searching Authority or International Preliminary Examining Authority (Rule 90.1(b), (c) and (d)(ii)), that power be submitted direct to the Authority concerned. Rule 90.3(b) as proposed to be amended is expressed to be subject to Rule 90.3bis, which makes specific provision in relation to general powers of attorney (see below).
5. It is also proposed to delete the second sentence of the present Rule 90.3(b), according to which the recipient of the power of attorney should immediately notify the interested International Searching Authority and the interested International Preliminary Examining Authority. Such details would be more appropriately left to the Administrative Instructions. It should also be noted that if, in practice, the applicant forwarded a power of attorney to the receiving Office or to an Authority other than that to which the appointment is directed, the power of attorney should then be promptly forwarded to the appropriate Authority as provided in the Administrative Instructions, Sections 328, 425, 512 and 608, as proposed to be modified or added (see paragraphs 7 and 8, below).

90.3 *Manner of Appointment of Agent or Common Representative*\*

(a) Appointment of any agent or common representative shall be effected in the request, the demand or a separate power of attorney.\*\*

(b) Subject to Rule 90.3bis, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be submitted to the International Searching Authority or the International Preliminary Examining Authority, as the case may be.\*\*\*

(c) If the separate power of attorney is not signed, or if the required separate power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered non-existent unless the defect is corrected.\*\*\*\*

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

\*\* The amendment consists in deleting, after the word “attorney”, the words “(i.e., a document appointing an agent or common representative)”.

\*\*\* The amendment consists in deleting the second sentence.

\*\*\*\* This paragraph is not proposed to be amended. The text is included here for convenient reference.

[Ad Rule 90.3, continued]

6. It is proposed to delete the present text of Rule 90.3(d) relating to general powers of attorney, and to deal with that issue in a new Rule 90.3bis (see below). A completely new text of Rule 90.3(d) is proposed to make it clear that appointment of a common agent or a common representative may be effected by two or more applicants by each signing, at his choice, the request, the demand or a separate power of attorney. That is the applicants' signatures need not all appear in the same document.

7. It is proposed to modify Sections 328 and 425 to account for the possibility that a power of attorney may be for the purposes only of the procedure before the International Searching Authority or the International Preliminary Examining Authority, as follows:

#### Section 328

##### Notifications Concerning Representation

Where a power of attorney, a document containing the revocation of an appointment, or a notification of renunciation of an appointment, is submitted to the receiving Office, that Office shall immediately notify the International Bureau and the interested International Searching Authority by sending them a copy of the power of attorney, document or notification, and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92bis.1(a)(ii).

#### Section 425

##### Notifications Concerning Representation

Where a power of attorney, a document containing the revocation of an appointment, or a notification of renunciation of an appointment, is submitted to the International Bureau, that Bureau shall immediately notify the receiving Office, the interested International Searching Authority and the interested International Preliminary Examining Authority by sending them a copy of the power of attorney, document or notification, and shall record a change in the indications concerning the agent or common representative under Rule 92bis.1(a)(ii). Where the International Bureau receives a notification under Section 328, it shall immediately notify the interested International Preliminary Examining Authority.



[Rule 90.3, continued]

(d) 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.

[Ad Rule 90.3, continued]

8. It is also proposed to add new Sections 512 and 608 to account for the possibility that documents concerning appointments of agents or common representatives may be submitted to the International Searching Authority or the International Preliminary Examining Authority, as follows:

Section 512 [New]

Notifications Concerning Representation

Where a power of attorney, a document containing the revocation of an appointment, or a notification of renunciation of an appointment, is submitted to the International Searching Authority, that Authority shall immediately notify the International Bureau by sending it a copy of the power of attorney, document or notification, and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92bis.1(a)(ii).

Section 608 [New]

Notifications Concerning Representation

Where a power of attorney, a document containing the revocation of an appointment, or a notification of renunciation of an appointment, is submitted to the International Preliminary Examining Authority, that Authority shall immediately notify the International Bureau by sending it a copy of the power of attorney, document or notification, and request the International Bureau to record a change in the indications concerning the agent or common representative under Rule 92bis.1(a)(ii).

*Ad Rule 90.3bis*

1. *Present situation.* Present Rule 90.3(d) deals with appointment of agents by way of a general power of attorney. It does not explain what is meant by a “general power of attorney”. The wording would require amendment, in any event, consequential to the changes proposed above to Rules 90.1 to 90.3.
2. *Proposed solution.* It is proposed to delete the present text of Rule 90.3(d) and to add a new Rule 90.3bis dealing with general powers of attorney.
3. Proposed Rule 90.3bis(a) makes it clear that an agent may be appointed in a “general power of attorney” to represent the applicant in relation to any international application which may be filed by that applicant. To be effective, the request or demand would need to refer to the general power of attorney, which would need to have been deposited in accordance with Rule 90.3bis(b). Also, a copy of the general power of attorney, which need not be signed, would need to be attached to the request or the demand, as the case may be.
4. Proposed Rule 90.3bis(b) provides for a general power of attorney to be deposited with the receiving Office. However, where the agent is appointed to represent the applicant specifically before the International Searching Authority or the International Preliminary Examining Authority (see Rule 90.1(b), (c) and (d)(ii), above), it would need to be deposited with the Authority concerned.

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 or the demand 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 or the demand, as the case may be; that copy need not be signed.

(b) A general power of attorney shall be deposited with the receiving Office, provided that, where a general power of attorney appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be deposited with the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

*Ad Rule 90.4*

1. *Present situation.* A number of provisions relating to the appointment of agents and common representatives, and to the revocation and renunciation of such appointments, presently appear in Section 106 of the Administrative Instructions. They require modification in the light of the amendments proposed to Rules 90.1 to 90.3, and, in any event, it would be more appropriate for them to be included in the Regulations themselves in view of their direct interest to applicants.
2. *Proposed solution.* It is proposed to amend Rule 90.4(a) to refer specifically to the appointment of an agent or common representative, and to make a minor drafting change for the sake of greater clarity. In view of the fact that sub-agents, under proposed Rule 90.1(d), would be appointed by an agent and not by the applicant himself, it is also proposed to add a sentence to Rule 90.4(a) to ensure that the applicant himself may revoke the appointment of a sub-agent.
3. The proposed new text of Rule 90.4(b) and proposed new Rule 90.4(c) would ensure that the appointment of an agent under Rule 90.1(a) or of a common representative would, unless otherwise indicated, operate to revoke automatically any earlier such appointment. That automatic revocation would not apply where the later appointment of an agent (including a sub-agent) was to represent the applicant specifically before the International Searching Authority or the International Preliminary Examining Authority (such appointments being made under Rule 90.1(b), (c) or (d)(ii)). Nor would the appointment of a sub-agent under Rule 90.1(d)(i) operate automatically to revoke earlier appointments.
4. Proposed new Rule 90.4(d) provides for an agent or common representative to renounce his appointment by a notification signed by him.
5. The text of present Rule 90.4(b) provides that Rule 90.3 applies mutatis mutandis to a document containing a revocation. The text of Rule 90.4(b) is proposed to be clarified and relocated as Rule 90.4(e), referring to both revocations and renunciations.
6. In view of the provisions proposed to Rules 90.1 to 90.4, present Section 106 of the Administrative Instructions is no longer required and is proposed to be deleted:

Section 106[Deleted]

90.4 *Revocation and Renunciation*\*

(a) Any appointment of an agent or common representative may be revoked by the persons who have made the appointment or by their successors in title. Any appointment of a sub-agent under Rule 90.1(d) may also be revoked by the applicant.

(b) The appointment of an agent under Rule 90.1ea) shall, unless otherwise indicated, have the effect of revoking any earlier appointment of an agent under that Rule.

(c) The appointment of a common representative shall, unless otherwise indicated, have the effect of revoking any earlier appointment of a common representative.

(d) An agent or a common representative may renounce his appointment by a notification signed by him.

(e) Rule 90.3(b) and (c) shall apply, *mutatis mutandis*, to a document containing a revocation or renunciation under this Rule.

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\* The title has been amended to read “Revocation and Renunciation” instead of “Revocation”.

*Ad Rule 90.5*

1. *Present situation.* Provisions dealing with the sending of correspondence intended for applicants who are represented by agents is presently dealt with in Section 108(a) of the Administrative Instructions. These provisions require updating in view of the amendments proposed above to Rules 90.1 to 90.4.
2. *Proposed solution.* It is proposed to delete the present text of Section 108(a) and to include the revised provisions, taking account of the amendments proposed to Rules 90.1 to 90.4, as a new Rule 90.5.
3. Proposed new Rule 90.5(a) provides a definition of “first mentioned agent” for the purposes of Rule 90.5. Where there are two or more agents, the “first mentioned agent” is the agent first mentioned in the document containing the appointments or, if there are two or more such documents, in that which was filed first.
4. Proposed new Rule 90.5(b) provides for correspondence to be addressed to a sole applicant’s agent or, where there is more than one agent, to the first mentioned agent. The provision is subject to Rule 90.5(d).
5. Proposed new Rule 90.5(c) deals with the addressing of correspondence intended for two or more applicants. Such correspondence would be sent to their common representative (or his agent or first-mentioned agent) or to their common agent (or first-mentioned such agent). This provision is also subject to Rule 90.5(d).

90.5 *Correspondence*

(a) For the purpose of this Rule, where there are two or more agents whose appointments are in force, “first mentioned agent” means the agent first mentioned in the document containing the appointments or, where the appointments are contained in two or more documents, in that which was filed first.

(b) Where a sole applicant has appointed an agent or agents under Rule 90.1(a), correspondence intended for the applicant from the receiving Office, the International Bureau, the International Searching Authority or the International Preliminary Examining Authority shall, subject to paragraph (d), be addressed to that agent or, where applicable, to the first mentioned agent.

(c) Where there are two or more applicants, correspondence intended for the applicants from the receiving Office, the International Bureau, the International Searching Authority or the International Preliminary Examining Authority shall, subject to paragraph (d), be addressed:

(i) if no common agent is appointed under Rule 90.1, to the common representative or, where applicable, to his agent or first mentioned agent; or

(ii) if the applicants have appointed a common agent or common agents under Rule 90.1(a), to that agent or, where applicable, to the first mentioned agent.



[Ad Rule 90.5, continued]

6. Proposed Rule 90.5(d) provides an exception to the provisions of Rule 90.5(b) and (c), to the effect that, where an agent or agents are appointed to represent the applicant specifically before the International Searching Authority or the International Preliminary Examining Authority, correspondence from such Authority would be sent to that agent or the first mentioned agent (i.e., rather than to the agent appointed under Rule 90.1(a)).

7. In view of the proposed inclusion of new Rule 90.5, the present text of Section 108(a) is no longer required, and it is proposed that Section 108 be modified as follows:

Section 108

Correspondence Intended for the Applicant

- (a) [Deleted]
- (b) [No change]

[Rule 90.5, continued]

(d) Where an agent or agents are appointed under Rule 90.1(b), (c) or (d)(ii), correspondence intended for the applicant from the International Searching Authority or the International Preliminary Examining Authority, as the case may be, shall be addressed to that agent or, where applicable, to the first mentioned agent.

*Ad Rule 90bis [New]*

1. *Present situation.* At present, the different possibilities to withdraw the international application, designations, the demand, elections, as well as priority claims, are provided for in Rules 32, 32bis and 75 as well as in Article 37. Users of the system have difficulties in finding the applicable provisions in the Treaty and the Regulations.

2. The present Regulations allow a withdrawal under Rule 32 of the international application or of designations until the expiration of 20 months from the priority date. Where the 30-month time limit under Article 39(1)(a) applies, the Regulations do not provide for a withdrawal of the international application after 20 months from the priority date. Furthermore, the effect of a withdrawal in a designated or elected State in which national processing or examination has already started is not clear. Should the international search or international preliminary examination continue only for the State where the national phase has already started?

3. The effect of a withdrawal in a designated or elected State depends on the interpretation of the words hereafter underlined in present Rule 32.1(a):

“The applicant may withdraw the international application prior to the expiration of 20 months from the priority date except as to any designated State in which national processing or examination had already started” and of the words hereafter underlined in present Rule 75.1(a): “Withdrawal of the demand or all the elections may be effected prior to the expiration of 30 months from the priority date except as to any elected State in which national processing or examination has already started.”

4. These words mean, in the view of the International Bureau, that the start of national processing or examination puts an end to the international phase with respect to that State. Once the national processing or examination has started in a given State, a withdrawal under Rule 32.1 or Rule 75.1 does not affect the application in that State and any withdrawal must be sent by the applicant to the national Office of, or acting for, such State. The general rule applies that the international phase is over when the national processing or examination has already started. After the beginning of national processing or examination, it is the national law and no longer the PCT which applies in respect of a withdrawal, and it is for this reason that Rules 32.1 and 75.1 contain the said exception. There is no evidence that the said exception could mean that the international phase continues in respect of the State in which the national processing or examination has already started and that, for example, the international search or the international preliminary examination, if not yet completed, would have to continue for the purposes of just that State.

[The text of new Rule 90bis appears on pages 123, 125, 127, 129 and 131].

[Ad Rule 90bis, continued]

5. This interpretation is supported by the present practice. For example, Section 419 of the Administrative Instructions provides for a notification of the International Preliminary Examining Authority, by the International Bureau, of the withdrawal of the demand. Upon receipt of such a notification, the international preliminary examination is stopped. Should the international preliminary examination continue in respect of the elected Office where the national phase has already started, the PCT would provide for the notification of the International Preliminary Examining Authority, by the International Bureau, of the fact that the withdrawal of the demand or of an election is without effect with respect to a certain State because national processing or examination has already started in that State. But this is not foreseen by the PCT. Moreover, such notification cannot be made because the elected Office does not notify the International Bureau of an early beginning of national processing or examination and, consequently, the International Bureau is not aware of that fact and cannot notify the International Preliminary Examining Authority thereof.

6. As far as the withdrawal of a priority claim is concerned, it may, under the present Regulations, be effected until international publication. The Regulations do not provide for a withdrawal after that event, although it would be of great interest to applicants because it would further postpone the beginning of the national phase.

7. Another question which needs to be addressed relates to the withdrawal of a designation of a State which is the subject of a so-called "double designation", i.e., which has been designated for both a national patent and a regional patent. The present Rules are not clear as to the consequence of withdrawal of the designation of the State in terms which do not refer specifically to that designation for a national patent or regional patent, respectively.

8. *Proposed solution.* To streamline the system and to clarify the questions outlined above in connection with withdrawals, it is proposed to combine, in one new Rule, Rule 90bis, all provisions relating to withdrawals and to cover all possible situations in which applicants can make a withdrawal. At the same time, it is proposed to clarify certain points of ambiguity. Further, it is proposed that the new Rule include related matters such as where the withdrawal should be sent to and the question of the prevention of international publication of the international application.

9. New Rule 90bis.1 provides the general legal basis for the withdrawal of the international application as such. The proposed Rule corresponds basically to present Rule 32 which is proposed to be deleted (see document PCT/CAL/IV/2). However, it clarifies that a withdrawal of the international application is possible also if it is made after the expiration of 20 months from the priority date in all cases where Chapter II applies. The withdrawal must, in such cases, be made prior to the expiration of 30 months from the priority date and has the consequence that all international processing, including international preliminary examination, is terminated (see new Rule 90bis.5(b)). Proposed new Rule 90bis.1 also provides for the notice of withdrawal to be filed with the International Bureau or the receiving Office and, in addition for the cases where Article 39(1) applies, with the International Preliminary Examining Authority. The applicant would have the choice. However, for the purposes of preventing publication, the decisive date would be the date of receipt by the International Bureau of the notice if it is forwarded by the receiving Office or the International Preliminary Examining Authority, and not the date of receipt by either one of the latter.

Rule 90bis [New]

Withdrawals

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 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.

(c) No international publication of the international application 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.

[Ad Rule 90bis, continued]

10. As far as the effect of a withdrawal in respect of a designated Office is concerned where the national processing or examination has already started, see below the proposed new Rule 90bis.5.

11. New Rule 90bis.2 provides for the withdrawal of designations. The text corresponds to present Rule 32 which is proposed to be deleted (see document PCT/CAL/IV/2). However, it provides in addition for the withdrawal of a designation, where Chapter II applies in respect of the State concerned, until the expiration of 30 months from the priority date. This Rule complies with the practice of applicants which withdraw a designation rather than the corresponding election because they do not understand the present system correctly. It appears clearer to expressly allow and provide for the possibility to withdraw a designation throughout the international phase even where a designated State has been elected. However, where the latter is the case, the withdrawal of a designation would have the effect of withdrawal of the corresponding election.

12. It is also proposed to allow the applicant to notify the withdrawal of a designation not only to the International Bureau or the receiving Office, but to give him in addition, where Article 39(1) applies the option to notify the withdrawal to the International Preliminary Examining Authority. Further, it is proposed that the new Rule include related matters such as where the withdrawal should be sent to and the question of the prevention of international publication of the international application.

13. In connection with the withdrawal of the designation of a State which was the subject of a “double designation” for both a national patent and a regional patent, it is proposed to provide in the Administrative Instructions that, in such a case, the withdrawal of the designation of the State is to be taken to include withdrawal of both designations unless the applicant clearly indicates that the withdrawal is only of the designation for the purpose of a regional patent or of that for the purpose of a national patent, as the case may be.

14. The proposed new Section could read as follows:

Section 415bis [New]

Withdrawal under Rule 90bis.2 of a Designation for the  
Purpose of Obtaining both National and Regional Patents

Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation of such a State shall be taken to include withdrawal of both designations, except where the withdrawal is clearly directed to only one of those designations.

[Rule 90bis, continued]

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) 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 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.

(d) 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.



[Ad Rule 90bis, continued]

15. New Rule 90bis.3 relates to notices of withdrawal of priority claims. Such withdrawals are at present governed by Rule 32bis which is proposed to be deleted if this Rule is adopted (see document PCT/CAL/IV/2). The possibility of withdrawing the priority claim, which is presently open only until international publication, has been used so far primarily to delay international publication of- the international application where the applicant was uncertain as to whether he wanted to retain his invention as a secret or to have it published later without the benefit of the priority date.

16. It appears to be to the applicant's advantage to go a step further and to allow the applicant also to postpone the entry into the national phase by withdrawing the priority claim at a later date. This may be desired because an applicant does not have sufficient funds to cover the cost to begin the procedures before the designated or elected Offices within the time periods under Articles 22(1) or 39(1)(a), calculated from the filing date of the earlier application. Such a delayed entry into the national phase is justified because the applicant could have initially filed the international application without benefit of the priority claim. Therefore, no undue advantage is given to the applicant. Similarly, applicants could withdraw a priority claim to delay the date for filing a demand, while still obtaining the delay to enter the national phase before the elected States under Article 39(1)(a).

17. Consequently, it is proposed to provide in a new Rule 90bis.3(a) and (b) that, in effect, a priority claim may be withdrawn until the expiration of 20 months from the priority date, which corresponds to the time limit under Article 22(1), or, if a demand has been filed prior to the expiration of the 19th month from the priority date, until the expiration of 30 months from the priority date, which corresponds to the time limit under Article 39(1)(a).

18. Paragraph (c) of proposed new Rule 90bis.3 provides that the applicant may send his notice of withdrawal to the International Bureau or the receiving Office, and gives him the option, where Article 39(1) applies to notify the withdrawal to the International Preliminary Examining Authority. Further, it is proposed that the new Rule include related matters such as where the withdrawal should be sent to and the question of the prevention of international publication of the international application.

19. Paragraph (d) of proposed new Rule 90bis.3 corresponds to Rule 32bis.1(c) under which only time periods which have not yet expired will be recomputed from the effective priority date resulting from the withdrawal of the priority claim.

20. Paragraph (e) of proposed new Rule 90bis.3 provides that international publication may still occur if the notice effecting withdrawal of a priority claim is received by the International Bureau after completion of the technical preparations for publication.

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 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.

(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 computed from the original priority date if the notice effecting withdrawal by the applicant or a corresponding information by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for publication.

[Ad Rule 90bis, continued]

21. New Rule 90bis.4 relates to withdrawal of the demand or of elections. It provides that the demand or any or all elections may be withdrawn until the expiration of 30 months from the priority date. This corresponds to present Rule 75 which is proposed to be deleted (see Ad Rule 75, above) if this Rule is adopted. It is proposed to allow the applicant to send his notice of withdrawal to the International Bureau or to the International Preliminary Examining Authority, at his option. In this regard, Section 419 is proposed to be modified and a new Section 609 proposed to be added (see 27 below).

22. As far as the effect of a withdrawal in respect of an elected Office is concerned where the national processing or examination has already started, see below proposed new Rule 90bis.5.

23. New Rule 90bis.5 clarifies the effects of withdrawals and makes it clear that withdrawals under Rule 90bis do not affect the international application in any designated or elected Office where the national processing or examination has already started. In respect of such an Office it is the national law which applies, and where the applicant wants a withdrawal to have effect in the said Office he must address the withdrawal to that Office. Concern has been expressed that the result of the interpretation of the present system which is reflected in this proposed Rule could lead to an abuse. Applicants should not be allowed to take advantage of a delayed commencement of the national phase on the one hand and to avoid the establishment of an international preliminary examination report on the other hand. However, the International Bureau is not aware of any such abuse and the PCT does not contain provisions necessary to implement measures to avoid such practice as is explained in paragraph 5, above. Should the future show that applicants start to regularly request an early start of national processing or examination in order to avoid negative international preliminary examination reports, appropriate amendments of the Regulations could be considered. At present, such provisions do not appear to be necessary and should not be introduced as long as the concern expressed is based solely on theoretical considerations.

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

(a) The applicant may withdraw the demand or any or all the elections at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effected by a signed notice addressed by the applicant to the International Bureau or 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.

90bis.5 *Effect of Withdrawal*

(a) The withdrawal of the international application, of a designation, of a priority claim, of the demand or of an election, effected under Rule 90bis.1, 90bis.2, 90bis.3 or 90bis.4, as the case may be, shall have no effect in any designated or elected Office where the processing or examination of the international application has already started.

(b) Where the international application is withdrawn under Rule 90bis.1, all international processing shall be terminated.

(c) Where the demand or all elections are withdrawn under Rule 90bis.4, all processing by the International Preliminary Examining Authority shall be terminated.

[Ad Rule 90bis, continued]

24. New Rule 90bis.6 is the same as present Rule 75.4, which is proposed to be deleted if the proposed new Rule 90bis is adopted.

25. Section 326 and the titles of Sections 415 and 419 are proposed to be modified, and a new Section 609 to be added, in order to take into account the provisions of proposed new Rule 90bis as well as the need for an additional provision concerning the filing of a notice of withdrawal by the applicant to the International Preliminary Examining Authority. The proposed modified Sections and the proposed new Section are as follows:

Section 326

Withdrawal under Rule 90bis.2 or 90bis.3

(a) The receiving Office shall promptly transmit any notice effecting withdrawal under Rule 90bis.1, 90bis.2 or 90bis.3 which has been filed with it to the International Bureau. If the record copy has not yet been sent to the International Bureau, the receiving Office shall transmit the said notice to that Bureau together with the record copy.

(b) to (c) [No change]

Section 415

Notification of Withdrawal under Rule 90bis.1, 90bis.2 or 90bis.3

(a) and (b) [No change]

Section 419

Notification of Withdrawal under Rule 90bis.4

[The text of the Section is not changed].

Section 609 [New]

Withdrawal under Rule 90bis.1, 90bis.2, 90bis.3 or 90bis.4

The International Preliminary Examining Authority shall promptly transmit any notice effecting withdrawal under Rule 90bis.1, 90bis.2, 90bis.3 or 90bis.4 which has been filed with it to the International Bureau.

90bis.6 *Faculty under Article 37(4)(b)*

(a) Any Contracting State wishing to take advantage of the faculty provided for in Article 37(4)(b) shall notify the International Bureau in writing.

(b) The notification under paragraph (a) shall be promptly published by the International Bureau in the Gazette, and shall have effect in respect of international applications filed more than one month after the publication date of the relevant issue of the Gazette.

*Ad Rule 91.1(b) and (c)*

1. *Present situation.* Rule 91 relates to rectification of obvious errors in the international application and other documents. Rule 91.1(b) defines an obvious error as something other than what was obviously intended. Allowable rectifications are only those which are obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification. It has been argued that these provisions are too restrictive. Furthermore, an editorial change appears to be desirable to clarify paragraph (c) of Rule 91.1.

2. *Proposed solution.* It is proposed to amend Rule 91.1(b) and to clarify that rectification is also permitted if the error is obvious from a comparison of the originally filed international application with any other papers which may have been filed by the applicant with the receiving Office before or on the international filing date. For example, the Fee Calculation Sheet contains a listing of all designated States for which the payment of the designation fees is intended. If this listing does not correspond to the designations made in the request, and the designation fees have been fully paid as indicated in the Fee Calculation Sheet, it is obvious that an error exists. The applicant should, upon request, be allowed to rectify such error. Another example is where, due to erroneous printing or copying, the text of the international application is incomplete because a few lines at the bottom or at the top of a page are not included. When such an incomplete text appears in an international application and the text present in the international application is identical to the text of the priority document, rectification should be allowed upon applicant's request. Any such rectification must be authorized by the International Searching Authority or the International Preliminary Examining Authority under Rule 91.1(e)(ii) or (iii). The receiving Office would not be responsible for comparing the international application and the priority document or for authorizing rectification of the description, claims and drawings.

3. Rule 91.1(c) is proposed to be amended by deleting the words "elements or" since confusion has arisen as to the definition of "element". There appears to be no need to provide, in addition to the omission of entire sheets, for the omission of entire elements. If such element is the description, the claims or the drawings, it will be contained on one or more omitted sheets and is thus covered by the Rule as proposed to be amended. It should be noted, however, that the omission of an entire sheet can be remedied if the later filed sheet is received by the receiving Office within the applicable time limit under Rule 20.2 but, in such a case, the international filing date would have to be changed. Rectification of the omission of entire sheets would be allowed under the conditions specified in item (ii) of proposed Rule 91.1(b). If, for example, the priority document is identical with the international application except for the missing sheet, then it is obvious that the text on the omitted sheet of the international application is to be identical with the corresponding text of the priority document rectification should be admitted without loss of international filing date. It is further noted that Article 14(2) and Rule 20.2(a) do not apply to correction of obvious errors.

Rule 91

Obvious Errors in Documents

91.1 *Rectification*

(a) [No change]

(b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious:

(i) in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification, or

(ii) from a comparison of the international application with an earlier application, the priority of which is claimed in the international application, or with any other paper relating to the international application if that paper has been filed by the applicant with the receiving Office before or on the international filing date.

(c) Except where subparagraph (b)(ii) applies, omissions of entire\* sheets of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

(d) to (g-quarter) [No change]

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\* The amendment consists in deleting, after the word “entire”, the words “elements or”.



*Ad Rule 92.2*

1. *Present situation.* Rule 92.2(a) requires, in general, that any letter or document submitted to an International Searching Authority or International Preliminary Examining Authority be in the language of the international application to which it relates. There is no provision which would permit the use of the language of any translation made under Rule 12.1(c), i.e., a translation of the international application prepared under the responsibility of the receiving Office for the purposes of international search.
2. *Proposed solution.* It is proposed to add a new sentence to Rule 92.2(a) which provides that, where the international application has been translated under Rule 12.1(c), the language of the translation must be used in any letter or document submitted by the applicant to the International Searching Authority or International Preliminary Examining Authority. The International Searching Authority requires a translation under Rule 12.1(c) because the international application was filed in a language which is not one of its official languages. That Authority should be permitted to impose its official language(s) in such a case.
3. This proposed amendment was agreed by the Committee at its third session.

*Ad Rule 92.3*

1. *Present situation.* Rule 92.3 provides that any document or letter mailed by a national Office or an intergovernmental organization setting a time limit running from the mailing date shall be sent by registered air mail. Such mailing is quite expensive and cumbersome for both the sender and the recipient, and does not seem to serve any really useful purpose.
2. *Proposed solution.* Rule 92.3 is proposed to be amended by deleting the word “registered” so that the use of registered mail is no longer required by the Rule.
3. This proposed amendment was agreed by the Committee at its third session.

Rule 92

Correspondence

92.1 [No change]

92.2 *Languages*

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. Where the international application has been translated under Rule 12.1(c), the language of such translation shall be used.

(b) to (e) [No change]

92.3 *Mailings by National Offices and Intergovernmental Organizations*

Any document or letter emanating from or transmitted by a national Office or an intergovernmental organization and constituting an event from the date of which any time limit under the Treaty or these Regulations commences to run shall be sent by\* air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within two days from mailing or where air mail service is not available.

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\* The amendment consists in deleting, before the words "air mail" (first instance), the word "registered".

*Ad Rule 92.4*

1. *Present situation.* Present Rule 92.4 concerns the sending of documents subsequent to the international application by various telecommunication means. The filing of an international application by such means is, at present, not covered. The present Rule provides that a document sent by telecommunication means is considered to have been submitted only if it is furnished within 14 days in a form complying with Rules 11.14 and 92.1(a). If the applicant fails to repeat the sending in the proper form within 14 days, the communication of that document is considered not to have been made. There appears to be no need to limit this Rule to documents subsequent to the international application and to require a confirmation within 14 days in all cases. Also, the present Rule does not clearly indicate whether facsimile machines may be used for such transmittal.
2. *Proposed solution.* It is proposed to revise the present Rule completely and divide it into several paragraphs as explained below.
3. First, paragraph (a) is proposed to be amended in order to expressly allow the possibility of filing an international application by any of the means of telecommunication referred to in this paragraph. An express reference is added to facsimile machines. The reference in paragraph (a) to Rule 92.1(a) is proposed to be deleted, having regard to proposed new paragraph (d) of Rule 92.4.
4. In relation to the filing of an international application by facsimile machine, it is to be noted that the PCT Assembly, during its twelfth session in September 1984,  

“agreed that an international application which is received by telecopier by the receiving Office, is to be accorded an international filing date if all the requirements listed in items (i) to (iii) of Article 11(1) are complied with and that any formal defect, such as the lack of signature or of fitness for reproduction, may be corrected upon invitation issued by the receiving Office under Article 14(1). It was understood, however, that no receiving Office would be obliged to make telecopier facilities available to applicants.” (See document PCT/A/XII/4, paragraph 18).
5. It is proposed to delete the second sentence of present Rule 92.4(a), requiring automatic confirmation within 14 days by communication of the contents of all papers sent by telecommunication means.
6. The substance of present Rule 92.4(b) has been incorporated into proposed new paragraph (g) of this Rule (see below).
7. Proposed new paragraph (b) deals with a signature appearing on a document transmitted by facsimile machine. It is proposed that such a signature be recognized for the purposes of the Treaty and the Regulations as a proper signature. Recognition of such signatures would reduce the number of original documents to be submitted by applicants and received by the national Offices and intergovernmental organizations. The original documents would be retained by the applicant or his agent and would be available for inspection.

8. Proposed new paragraph (c) sets out the consequence if part or all of a document which is transmitted by any of the means of telecommunication referred to in paragraph (a) is not received or is illegible. It is proposed that the document be treated in such a case as not having been received to the

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

(a) Notwithstanding the provisions of Rule 11.14, but subject to paragraphs (c) to (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 Ca) but part or all of the document is not received or is illegible, the document shall be treated as not having been received to the extent that the attempted transmission failed or that the received document is illegible. 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.

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\* 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.

[Ad Rule 92.4, continued]

extent that the attempted transmission failed or that the received document is illegible. It is also proposed to provide that the national Office or intergovernmental organization to which the transmittal was made shall promptly notify the applicant in such a situation. If the document concerned is the international application, the applicant would have the possibility, upon notification under Rule 92.4(c), for example, to provide the missing sheets of all the claims, and the international filing date would then be the date of receipt of the later-furnished sheets containing the claims.

9. Proposed new paragraph (d) enables each national Office or intergovernmental organization to establish a general requirement for submission of the original of a transmitted document within 14 days of the transmittal of a document by any of the means referred to in paragraph (a). If the original is submitted, it should be accompanied by a letter identifying the earlier transmission. Such a requirement, to be enforceable, would need to have been notified to the International Bureau and published in the PCT Gazette. The discretion whether or not to require automatically a confirmation of a facsimile transmission by sending the original is introduced in this Rule because the technical quality of facsimile transmissions is, in many instances, such that the facsimile received fully meets the requirements of the Treaty and Regulations. Offices which have such high quality equipment and a telecommunication network allowing such impeccable transmission should not be obliged to require, automatically, the original of documents received earlier by facsimile transmission and to compare in detail the original with the document received by facsimile transmission.

10. Proposed new paragraph (e) enables the national Office or intergovernmental organization to invite the applicant to furnish the original document if it has not been furnished on time, under paragraph (d), to an Office or organization which requires submission of such an original. An invitation may also be issued if, in any event, an Office or organization requires the original of a particular document in a particular case (e.g., where there are doubts as to the authenticity of a signature). In both cases, the Office or organization would have to invite the applicant to furnish the original document within a reasonable time limit fixed in the invitation.

11. Proposed new paragraph (f) provides for a sanction where the applicant fails to comply with an invitation under Rule 92.4(e). A distinction is made between the kinds of documents concerned. If the document concerned is the international application itself and the original of papers making up the international application is not received within the time limit fixed in the invitation, the receiving Office would declare that the international application is considered withdrawn. That sanction is appropriate noting that the international application having been accorded an international filing date could be used later as the basis for a claim for priority and consequently could have to be made available in the form of a priority document. If, on the other hand, the document transmitted is not the international application, but some other document, that document would simply be considered as not having been submitted if the applicant failed to comply with the invitation.

12. Proposed new paragraph (g) incorporates the substance of present paragraph (b). It provides that no national Office or intergovernmental organization shall be obliged to receive documents by any of the means of telecommunication referred to in paragraph (a) unless it has notified the International Bureau that it is prepared to receive documents by such means and information thereon has been published in the PCT Gazette by the International Bureau.

[Rule 92.4, continued]

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

*Ad Rule 96*

1. *Present situation.* Present item 4 of the Schedule of Fees provides for a “Supplement to the Handling Fee” which is no longer required under Rule 57 as proposed to be amended. Likewise, item 5, on surcharges is no longer required because it is included in Rule 16bis as proposed to be amended.
2. *Proposed solution.* It is proposed to delete item 4, “Supplement to the Handling Fee”, from the Schedule of Fees as a consequential amendment to the amendments proposed to Rule 57, since there will no longer be a supplement to the handling fee.
3. It is furthermore proposed to delete item 5, “Surcharge for late payment”, because surcharges would be paid to the receiving Office under Rule 16bis as proposed to be amended and the amounts of the surcharges are provided for in Rule 16bis.1(f) as proposed to be amended.
4. In addition, it is proposed to amend item 2 by adding a reference to Rule 4.9(a) which would make it clear that a designation subject to confirmation made under Rule 4.9(b) as proposed to be amended is not covered by the maximum amount of the designation fee. The designation fee with the surcharge under Rule 15.5 as-proposed to be amended is payable in all cases in which a designation made under proposed new Rule 4.9(b) is confirmed by the applicant.
5. Furthermore, it is proposed to label the two parts under item 1, “Basic Fee”, by adding the letters (a) and (b), respectively. This amendment would facilitate references to either of the two parts.
6. Finally, it is proposed to delete the heading “Surcharges” because of the proposed deletion of item 5.



Rule 96

The Schedule of Fees

96.1 [No change]

SCHEDULE OF FEES

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	706 Swiss francs
(b) if the international application contains more than 30 sheets	706 Swiss francs plus 14 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	171 Swiss francs per designation for which the fee is due, with a maximum of 1,710 Swiss francs, any such designation, made pursuant to Rule 4.9(a) in excess of 10 being free of charge
3. Handling Fee: (Rule 57.2(a))	216 Swiss francs
4. [Deleted]	
*[Heading deleted]	
5. [Deleted]	

[End of document]

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\* The amendment consists in deleting the heading "Surcharges".