

# WIPO



PCT/R/WG/4/4  
ORIGINAL:English  
DATE:March17,2003

# E

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT  
COOPERATION TREATY (PCT)

Fourth Session  
Geneva, May 19 to 23, 2003

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS;  
SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION;  
PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT ;  
INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY;  
CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

*Document prepared by the International Bureau*

## BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group were certain proposals aimed at further streamlining and simplifying the PCT procedure.

2. The Working Group agreed that specific proposals for amendment of the Regulations would be prepared by the Secretariat, taking into account the discussion and conclusions reflected in the summary of the third session of the Working Group by the Chair and other points of detail noted by the International Bureau, for further consideration by the Working Group, where possible at its next session. Proposals for consideration in the short term would primarily be dealt with by way of amending the Regulations, but longer term proposals

involving revision of the Treaty should also be identified and draft provisions prepared (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 112).

3. The Annexes to this document contain a number of proposed amendments of the PCT Regulations aimed at further streamlining and simplifying the PCT procedure:<sup>1</sup>

(i) Annex I contains proposals concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13ter.1 (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57; and paragraphs 5 to 7, below);

(ii) Annex II contains a proposal to simplify the protest procedure before both the International Searching Authority ("ISA") and the International Preliminary Examining Authority ("IPEA") in case of non-unity of invention (see document PCT/R/WG/3/1, Annex I, items 4 and 10; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97; and paragraphs 8 to 10, below);

(iii) Annex III contains a proposal to permit, upon request of the applicant, the publication of a translation furnished by the applicant, or of the international application as filed if filed in a non-publication language, together with the international application (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 82; and paragraphs 11 and 12, below);

(iv) Annex IV contains a proposal to allow for the use of, and to introduce, a standardized international form for entry into the national phase (see document PCT/R/WG/3/5, paragraphs 67 and 68; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 67 and 68; and paragraphs 13 and 14, below);

(v) Annex V contains proposals to further amend Rules 4.11(a)(iv), 43 bis.1(b) and 94.2 as adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004 (see document PCT/A/31/10); it also contains a proposal to amend Rule 17.2, consequential on the amendment of Rule 17.1 as adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004. See also paragraph 15, below.

4. The proposals are further outlined in the following paragraphs.

#### LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

5. At its third session, the Working Group reviewed a proposal to amend Rule 13ter and to provide that International Searching Authorities and International Preliminary Examining Authorities would no longer be obliged to issue invitations to furnish sequence listings in computer-readable form complying with the prescribed standard or to carry out an international search and international preliminary examination in case where a sequence listing complying with that standard had not been filed (see document PCT/R/WG/3/1, Annex I, item 5).

<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended are included for ease of reference.

6. The Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standards should be furnished together with the international application so as not to delay the start of the international search, it was agreed that the International Bureau should prepare a proposal which would permit Authorities to require the payment of a late furnishing fee where an invitation had to be issued under Rule 13ter.1(a)(ii) or (e) (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57).

7. Annex I contains a proposal to amend Rule 13ter.1 accordingly.

#### SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

8. With regard to the protest procedure before both the International Searching Authority ("ISA") and the International Preliminary Examining Authority ("IPEA") in case of non-unity of invention, the Working Group during its third session agreed that the International Bureau should prepare a proposal for simplifying the protest procedure under Rules 40 and 68 (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97, in particular, paragraph 97).

9. It was also agreed (see document PCT/R/WG/3/5, paragraph 97) that:

"...in order to discover more information about the experience of Authorities regarding this issue, the International Bureau should send out a questionnaire asking them to indicate how many invitations they issued per year under Rules 40 and 68, how many additional fees were paid under protest, and how many of the invitations were in respect of applications containing claims to more than, say, 10 inventions."

10. Annex II contains a proposal to amend Rules 40 and 68 accordingly. An overview of the replies received in response to the questionnaire sent out by the International Bureau to all International Searching and Preliminary Examining Authorities (Circular C.PCT/896) is contained in document PCT/R/WG/4/4 Add.1.

#### PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT

11. During its third session, the Working Group discussed proposals for a possible deletion of Article 64(4), based on document PCT/R/WG/3/1, Annex II, item 28. The Working Group agreed that further consideration of this matter, while it would be within the competence of the Working Group, should be deferred until progress had been made in discussions of prior art issues by the Standing Committee for the Law of Patents (SCP). As a related matter, the Working Group agreed, however, that the International Bureau should look into the possibility of amending Rule 48 so as to provide for the electronic publication by the International Bureau of translations, furnished by the applicant, of the international application (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 78 to 82).

12. Annex III contains proposals to amend Rule 48 so as to require the International Bureau, on request of the applicant, to publish, together with the international application, any translation of the international application furnished by the applicant or, where the international application was filed in a language which is not a language of publication, the international application in the language in which it was filed.

## INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

13. At the third session of the Working Group, several delegations and representatives of users supported the proposed introduction of a standardized international form for entry into the national phase (see document PCT/R/WG/3/1, Annex I, item 11 (introduce international forms for national phase entry)), including standard texts of declarations similar to those provided for in the case of the request form under Rule 4.17, on the understanding that the use of such a form by applicants would be optional and not a requirement for a valid national phase entry. The Working Group agreed that the International Bureau should prepare such a proposal (see document PCT/R/WG/3/5, paragraphs 67 and 68).

14. Annex IV contains a proposal to amend Rule 49.4 accordingly. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such a form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51bis.

## CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

15. Annex V contains proposals to further amend Rules 4.11(a)(iv), 43bis.1(b) and 94.2 as adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004 (see document PCT/A/31/10), and to amend Rule 17.2. These proposed amendments are in the nature of corrigenda or consequential amendments based on the amendments already adopted. Explanations are set out in Annex VI in Comments relating to the provisions concerned.

*16. The Working Group is invited to consider the proposals contained in the Annexes to this document.*

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

TABLE OF CONTENTS

|  |   |
|--|---|
| Rule 13 <sup>ter</sup> Nucleotide and/or Amino Acid Sequence Listings .....      | 2 |
| 13 <sup>ter</sup> .1 <i>Sequence Listing for International Authorities</i> ..... | 2 |
| 13 <sup>ter</sup> .2 [No change] .....   | 3 |

**Rule 13ter**

**Nucleotide and/or Amino Acid Sequence Listings**

*13ter.1 Sequence Listing for International Authorities*

(a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:

(i) [No change]

(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it and to pay, where applicable, the late furnishing fee referred to in paragraph (a-bis), within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.

[COMMENT: Text modeled after Rule 12.3(c)(ii). Further amendments of Rule 13ter are proposed in document PCT/R/WG/4/6 (Deposit of Sequence Listings).]

(a-bis) The furnishing of a sequence listing in response to an invitation under paragraph (a)(ii) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee. The amount of the late furnishing fee shall be determined by the International Searching Authority and shall be specified in the invitation under paragraph (a)(ii).

[COMMENT: Text modeled after Rules 12.3(e) and 40.2(a).]

[Rule 13ter.1, continued]

(b) [Remains deleted]

(c) If the applicant ~~has~~ does not within the time limit fixed in the invitation, furnished  
the required sequence listing and paid any required late furnishing fee ~~comply with an~~  
~~invitation under paragraph (a) within the time limit fixed in the invitation~~, the International  
Searching Authority shall not be required to search the international application ~~to the extent~~  
~~that such non-compliance has the result that a meaningful search cannot be carried out~~.

[COMMENT: The proposed amendment to paragraph (c) is consequential on the proposed introduction (at the option of the International Searching Authority) of the late furnishing fee under paragraph (a) *-bis*): where the applicant does not pay any required late furnishing fee, the International Searching Authority would not be required to carry out international search, even if the applicant has furnished the required sequence listing.]

(d) [No change]

(e) [No change] Paragraphs (a) and (c) shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

[COMMENT: No change is proposed to paragraph (e) which is included in this document only for ease of reference. The effect of the proposed change to paragraph (a) would be that the International Preliminary Examining Authority would be permitted, under paragraph (e), to require the payment of a late furnishing fee where it had issued an invitation to furnish a sequence listing complying with the prescribed standard.]

13ter.2 [No change]

[Annex I follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

TABLE OF CONTENTS

|  |   |
|--|---|
| Rule 40 Lack of Unity of Invention (International Search).....                   | 2 |
| 40.1 <i>Invitation to Pay</i> <u><i>Additional Fees; Time Limit</i></u> .....    | 2 |
| 40.2 <i>Additional Fees</i> .....  | 3 |
| 40.3 <u>[Deleted]</u> <del><i>Time Limit</i></del> .....                         | 4 |
| Rule 68 Lack of Unity of Invention (International Preliminary Examination) ..... | 5 |
| 68.1 [No change] .....   | 5 |
| 68.2 <i>Invitation to Restrictor Pay</i> .....                                   | 5 |
| 68.3 <i>Additional Fees</i> .....  | 6 |
| 68.4 and 68.5 [No change] .....  | 8 |



**Rule 40**

**Lack of Unity of Invention (International Search)**

40.1 *Invitation to Pay Additional Fees; Time Limit*

[COMMENT: Clarification only.]

The invitation to pay additional fees provided for in Article 17(3)(a) shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention;  ~~and shall~~

(ii) invite the applicant to pay the additional fees within [one month] [two months] from the date of the invitation, and indicate the amount of those fees to be paid ; and

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(e) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid.

[COMMENT: It is proposed to amend Rule 40.1 so as to deal with all matters to be included in the invitation to the applicant (reasons, time limit for payment of additional fees and amount of those fees; where applicable, time limit for payment of protest fee and amount of that fee) for in just one Rule. See also Rule 40.3, below, which is proposed to be deleted. For the time limit for compliance with the invitation under items (ii) and (iii), two months would be consistent with the PLT but one month may be more appropriate to the tight time frame under which the PCT procedure operates.]

## 40.2 Additional Fees

(a) and (b) [No change]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Searching Authority ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

[COMMENT: To simplify the procedure, it is proposed to leave the form of the review body and its composition to the ISA. The expression “board of appeal or other review body constituted in the framework of...” is modeled after the terminology in paragraph 1.11 of the Explanatory Notes on the Patent Law Treaty. Furthermore, it does not appear necessary to provide for a protest in respect of unity of invention to be considered, in the first instance, by a higher authority than a board of appeal or other review body constituted in the framework of the ISA. This would, of course, not prevent a higher authority from hearing an appeal against a decision of that board of appeal or other review body.]

(d) ~~[Deleted] The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom made the decision which is the subject of the protest.~~

[COMMENT: It is proposed that the form of the review body and its composition should be left to the ISA.]

[Rule 40.2, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee. ~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest ("protest fee"). The protest fees shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required ~~If the protest fee is not so paid,~~ the protest shall be considered withdrawn and the International Searching Authority shall so declare. The protest fees shall be refunded to the applicant where the ~~three member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) find that the protest was entirely justified.

[COMMENT: The amendment to the first sentence is proposed for the purpose of simplification – it does not appear necessary to oblige an ISA which wishes to require the payment of a protest fee for the examination of the protest to apply at a two-stage review process. The proposed amendment to the last sentence is consequential on the proposed amendment of paragraph (c).]

#### 40.3 ~~[Deleted]~~ *Time Limit*

~~The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant's address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.~~

[COMMENT: See Comment on Rule 40.1 as proposed to be amended, above.]

## Rule 68

### Lack of Unity of Invention

#### (International Preliminary Examination)

68.1 [No change]

[PRODOMO: Rule 68 could be further simplified by deleting Rule 68.1 and amending Rule 68.2 to provide an invitation in all cases (subject to Rule 66.1(e)), in line with the Chapter I procedure under Rule 40.1. However, this is not proposed since it would take away the present applicant-friendly “no invitation” procedure under Rule 68.1.]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, [the invitation](#) shall:

(i) specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement; ~~and shall~~

(ii) specify ~~the amount of the additional fees and~~ the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~It shall, at the same time,~~

*[Rule 68.2, continued]*

(iii) invite the applicant to comply with the invitation within [one month] [two months] from the date of the invitation; ~~fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation~~

(iv) indicate the amount of the required additional fee to be paid in case the applicant so chooses; and

(v) invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid .

[COMMENT: The amendments proposed to Rule 68.2 correspond to those proposed to Rule 40.1.]

### 68.3 *Additional Fees*

(a) and (b) [No change]

[Rule 68.3, continued]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Preliminary Examining Authority, ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.

[COMMENT: The amendments proposed to paragraph (c) correspond to those proposed to Rule 40.2(c).]

(d) ~~[Deleted] The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom the decision which is the subject of the protest.~~

[COMMENT: The proposed deletion of paragraph (d) corresponds to the proposed deletion of Rule 40.2(d).]

[Rule 68.3, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a protest fee. ~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 68.2(iii), paid any required ~~If the~~ protest fee is not paid, the protest shall be considered ~~withdrawn~~ and the International Preliminary Examining Authority shall so declare. The protest fee shall be refunded to the applicant where the ~~three-member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) finds that the protest was entirely justified.

[COMMENT: The amendments proposed to paragraph (e) correspond to those proposed to Rule 40.2(e).]

68.4 and 68.5 [No change]

[Annex III follows]

ANNEXIII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

PUBLICATION OF TRANSLATIONS IN ADDITION TO  
INTERNATIONAL PUBLICATION OF THE INTERNATIONAL APPLICATION

TABLE OF CONTENTS

|   |   |
|---|---|
| Rule 47 Communication to Designated Offices .....         | 2 |
| 47.1 and 47.1 [No change] .....                           | 2 |
| 47.3 <i>Languages: <a href="#">Translations</a></i> ..... | 2 |
| 47.4 [No change] .....                                    | 2 |
| Rule 48 International Publication .....                   | 3 |
| 48.1 and 48.2 [No change] .....                           | 3 |
| 48.3 <i>Languages of Publication</i> .....                | 3 |
| 48.4 to 48.6 [No change] .....                            | 4 |



**Rule 47**

**Communication to Designated Offices**

47.1 and 47.1 [No change]

47.3 *Languages; Translations*

(a) The international application communicated under Article 20 shall be in the language in which it is published.

(b) Where the language in which the international application is published is different from the language in which it was filed, the International Bureau shall furnish to any designated Office, upon the request of that Office, a copy of that application in the language in which it was filed or of any translation furnished under Rule 48.3(d)(ii).

47.4 [No change]

## **Rule 48**

### **International Publication**

48.1 and 48.2 [No change]

#### *48.3 Languages of Publication*

(a) [No change] If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(b) [No change] If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

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

*[Rule 48.3, continued]*

(d) Upon request by the applicant received by the International Bureau prior to the expiration of 16 months from the priority date, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, the International Bureau shall publish, together with the international application as published under paragraph (a) or (b):

(i) in the case referred to in paragraph (b), the international application in the language in which it was filed;

(ii) any translation of the international application furnished by the applicant within the time limit under paragraph (e).

[COMMENT: The proposed publication of the international application in the language in which it was filed (if filed in a non-publication language) and of any translation of the international application furnished by the applicant would take place in addition to, but would not form part of, the international publication of the international application under Article 21. Publication and communication to designated Offices of the international application in a language different from the language in which international publication takes place would be beneficial for the protection of rights of the applicant under the national law of certain designated States, for example, designated States which make provisional protection after the international publication of an international application conditional on the furnishing of a translation, or States where the prior art effect of an international application is, in accordance with Article 64(4), dependent on the publication of a translation into a language accepted by the Office of the designated State concerned.]

48.4 to 48.6 [No change]

[Annex IV follows]

ANNEXIV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:  
INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

TABLE OF CONTENTS

|  |   |
|--|---|
| Rule 49 Copy, Translation and Fee Under Article 22 ..... | 2 |
| 49.1 to 49.3 [No change] .....                           | 2 |
| 49.4 Use of National <u>or International</u> Form .....  | 2 |

**Rule 49**

**Copy, Translation and Filing Under Article 22**

49.1 to 49.3 [No change]

49.4 *Use of National or International Form*

(a) No applicant shall be required to use a ~~national~~ form when performing the acts referred to in Article 22.

(b) The designated Office shall accept the use by the applicant, when performing the acts referred to in Article 22, of the form prescribed by the Administrative Instructions for the purposes of this paragraph, provided that the Office may require that the form shall be filed in a language of publication which it accepts for the purposes of this paragraph.

[COMMENT: The provision and use of any form for national phase entry (be it a national form made available by the designated Office concerned or the new international form) would remain optional, as at present. In addition, it is proposed to require any designated Office to accept the prescribed international form where the applicant chooses to use that form. By virtue of Rule 76.5, the same would apply to any elected Office. As is the case for all forms under the PCT which are to be used by the applicant, the form would be made available by the International Bureau in all seven languages of publication. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51bis.]

49.5 to 49.6 [No change]

[Annex V follows]

## ANNEXV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:  
 CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

## TABLE OF CONTENTS

|  |   |
|--|---|
| Rule 4 The Request (Contents) .....  | 2 |
| 4.1 to 4.10 [No change] .....  | 2 |
| 4.11 <i>Reference to Earlier Search, Continuation or Continuation -in-Part, or Parent Application or Grant</i> ..... | 2 |
| 4.12 to 4.14 [ <i>Remain deleted</i> ] .....   | 2 |
| 4.14bis to 4.18 [No change] .....  | 2 |
| Rule 17 The Priority Document .....  | 3 |
| 17.1 [No change] .....   | 3 |
| 17.2 <i>Availability of Copies</i> .....   | 3 |
| Rule 43 bis Written Opinion of the International Searching Authority .....   | 4 |
| 43bis.1 <i>Written Opinion</i> .....   | 4 |
| Rule 94 Access to Files .....  | 5 |
| 94.1 [No change] .....   | 5 |
| 94.2 <i>Access to the File Held by the International Preliminary Examining Authority</i> .....                       | 5 |
| 94.3 [No change] .....   | 5 |

**Rule 4**

**The Request (Contents)**

4.1 to 4.10 [No change]

4.11 *Referenceto Earlier Search, Continuation or Continuation -in-Part, or Parent  
Application or Grant*

(a) If:

(i) to (iii) [No change]

(iv) the applicant intends to make an indication under Rule 49 *bis.1(d)* ~~(e)~~ of the  
wish that the international application be treated, in any designated State, as an  
application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, as the case may be, identify the application in respect of  
which the earlier search was made or otherwise identify the search, or indicate the relevant  
parent application or parent patent or other parent grant.

[COMMENT: With regard to Rule 4.11 as adopted by the Assembly on October 1, 2002,  
with effect from January 1, 2004 (see document PCT/A/31/10), it is proposed to further  
amend Rule 4.11(a)(iv) so as to replace the erroneous reference to Rule 49 *bis.1(c)* with a  
reference to Rule 49 *bis.1(d)*.]

(b) [No change]

4.12 to 4.14 [*Remain deleted*]

4.14 *bis* to 4.18 [No change]

## Rule 17

### The Priority Document

17.1 [No change]

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a) ~~or~~ (b) or (b -bis), the International Bureau shall, at the specific request of the designated Office, subject to paragraph (a-bis), promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(a-bis) No designated Office shall request a copy of the priority document from the International Bureau under paragraph (a) if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

[COMMENT: It is proposed to amend Rule 17.2 so as to take into account the fact that, in the future, priority documents may be available to designated Offices from digital libraries; in the future, no designated Office shall request the International Bureau to furnish a copy of the priority document if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library. See Rule 17.1 as amended by the Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10).]

(b) and (c) [No change]



**Rule 43 bis**

**Written Opinion of the International Searching Authority**

43bis.1 *Written Opinion*

(a) [No change]

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), ~~66.2(a), (b) and (e)~~, 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

[COMMENT: With regard to Rule 43 bis as adopted by the Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10), it is proposed to further amend Rule 43 bis.1(b) so as to delete the reference to Rule 66.2(a), (b) and (e). Rule 66.2(a) and (b) concern the content of the written opinion of the International Preliminary Examining Authority (IPEA) and should not be referred to as applying *mutatis mutandis* to the written opinion by the International Searching Authority (ISA). The references in Rule 43 bis.1(b) to the various paragraphs of Rule 70 are correct and sufficient: all issues covered in Rule 66.2(a) and (b) are also covered in Rule 70 (Rule 70.12(iii) correspond to Rule 66.2(a)(i); Rule 70.6 correspond to Rule 66.2(a)(ii); Rule 70.12(i) correspond to Rule 66.2(a)(iii); Rule 66.2(iv) is not applicable to the written opinion by the ISA; Rule 70.12(ii) correspond to Rule 66.2(a)(v); Rule 70.2(d) correspond to Rule 66.2(a)(vi); Rule 70.12(iv) correspond to Rule 66.2(a)(vii); Article 35(2) and Rules 70.6(a), 70.8 and 70.12 correspond to Rule 66.2(b); Rule 66.2(e) is not applicable to the written opinion by the ISA) (see also the Comment on proposed new Rule 43bis.1 in document PCT/R/2/7).]

(c) [No change]

## Rule 94

### Access to Files

94.1 [No change]

94.2 *Access to the File Held by the International Preliminary Examining Authority*

At the request of the applicant or any person authorized by the applicant, or of an  
elected Office, once the international preliminary examination report has been ~~established~~  
communicated to that Office in accordance with Rule 73.2(a) or (b)(i), ~~of any elected Office,~~  
the International Preliminary Examining Authority shall furnish, subject to reimbursement of  
the cost of the service, copies of any document contained in its file.

[COMMENT: The proposed amendment of Rule 94.2 is consequential on the amendment of Rule 73.2 as adopted by the Assembly on October 1, 2002 with effect from January 1, 2004 (see document PCT/A/31/10), so as to ensure that copies of any document contained in the file of the International Preliminary Examining Authority are not furnished to any elected Office before the international preliminary examination report has been communicated to that Office, that is, usually, not before the expiration of 30 months from the priority date (see Rule 73.2 as in force from January 1, 2004).]

94.3 [No change]]

[End of Annex V and of document]