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FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

FURTHER CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

*Document prepared by the International Bureau*

1. The Annex to this document contains proposals to further amend Rules 16 *bis*.2, 32.1, 44*bis*, 60.1 and 90.2 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, Annex V), and to further amend Rule 90.5. These proposed amendments are in the nature of corrigenda or consequential amendments based on the amendments already adopted. Explanations are set out in the Annex in Comments relating to the provisions concerned.

2. *The Working Group is invited to consider the proposals contained in the Annex to this document.*

[Annex follows]

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## ANNEX

## PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

## FURTHER CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

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**Rule 16 bis**

**Extension of Time Limits for Payment of Fees**

16bis.1 [No change]

16bis.2 *Late Payment Fee*

(a) [No change] The payment of fees in response to an invitation under Rule 16bis.1(a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

[COMMENT: No change is proposed to present paragraph (a); the text is reproduced above for convenient reference.]

(b) The amount of the late payment fee shall not, however, exceed the amount of 50% ~~25%~~ of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

[COMMENT: Without prejudice to the determination of the amount of the international filing fee (see document PCT/R/WG/4/8, paragraph 5), upon further reflection, the maximum amount of the late payment fee under Rule 16 bis.2(b) as adopted by the Assembly on October 1, 2002, with effect from January 1, 2004, (25% of the international filing fee)

*[Rule 16bis.2.(b), continued]*

appear to be too low and would result in a maximum amount of the late payment fee which would be much lower than the maximum amount of the late payment fee under present Rule 16bis.2(b) (under present Rule 16bis.2(b), the amount of the late payment fee must not exceed the amount of the basic fee which, at present, is fixed at 650 Swiss francs). In respect of certain receiving Offices, a maximum amount of the late payment fixed at 25% of the international filing fee would even have the result that the minimum amount of the late payment fee fixed in accordance with Rule 16bis.2(a)(ii) would be higher than the maximum amount of that fee fixed in accordance with Rule 16bis.2(b). It is thus proposed to fix the maximum amount of the late payment fee under Rule 16bis.2(b) at 50% of the international filing fee.]

**Rule 32**

**Extension of Effect of International Application to  
Certain Successor States**

32.1 ~~Request for~~ *Extension of International Application to Successor State*

[COMMENT: Proposed amendment of the title of Rule 32.1 is consequential on the amendment of Rule 32.1 as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004. In line with the new approach with regard to designations, a request for extension by the applicant is no longer needed; the effects of an international application are automatically extended to a successor State which has deposited a declaration of continuation under Rule 32.1(a).]

(a) to (c) [No change]

(d) [*Remains deleted*]

32.2 [No change]

**Rule 44 bis**

**International Preliminary Report on Patentability by  
the International Searching Authority**

*44 bis.1 Issuance of Report* [: Transmittal to the Applicant](#)

(a) [No change] Unless an international preliminary examination report has been or is to be established, the International Bureau shall issue a report on behalf of the International Searching Authority (in this Rule referred to as “the report”) as to the matters referred to in Rule 43 bis.1(a). The report shall have the same contents as the written opinion established under Rule 43 bis.1.

(b) [No change] The report shall bear the title “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” together with an indication that it is issued under this Rule by the International Bureau on behalf of the International Searching Authority.

[COMMENT: No change is proposed to paragraphs (a) and (b) as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004; the text is reproduced above for convenient reference.]

[\(c\) The International Bureau shall promptly transmit one copy of the report issued under paragraph \(a\) to the applicant.](#)

[COMMENT: It is proposed to add a new paragraph (c) so as to require the International Bureau to send one copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) to the applicant as soon as it has been issued.]

*44 bis.2 to 44 bis.4* [No change]

**Rule60**

**CertainDefectsintheDemand**

60.1 *DefectsintheDemand*

(a) and(a *-bis*) [Nochange]

(a-*ter*) [Nochange] ForthepurposesofRule 53.8,iftherearetwoormoreapplicants,  
itshallbesufficientthatthedemandbesigned byoneofthem.

[COMMENT:Nochangeisproposedtoparagraph(a *-ter*)asadoptedbythePCTAssembly  
onOctober1,2002,witheffectfromJanuary1,2004;thetextisreproducedabovefor  
convenientreference.]

(b) and(c) [Nochange]

(d) ~~[Deleted] Where,aftertheexpirationofthetimelimitunderparagraph(a),a  
signaturerequiredunderRule53.8oraprescribedindicationislackinginrespectofan  
applicantforacertainelectedsState,theelectionofthatStateshallbeconsideredasifithad  
notbeenmade.~~

[COMMENT:Proposeddeletionofparagraph(d)isconsequentialontheadditionofnew  
Rule 60.1(a-*ter*)(seeabove)asadoptedbythePCTAssemblyonOctober1,2002,witheffect  
fromJanuary1,2004.]

(e) to(g) [Nochange]

60.2 *[Remainsdeleted]*

## Rule 90

### Agents and Common Representatives

90.1 [No change]

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 [and in respect of whom the indication ~~all indications~~ required under Rule 4.5(a)(ii) has ~~have~~ been provided ] may be appointed by the other applicants as their common representative.

[COMMENT: Although the words “and in respect of whom all indications required under Rule 4.5(a) have been provided” were only added to paragraph (a) by way of an amendment adopted by the Assembly on October 1, 2002, with effect from January 1, 2004, it is proposed to further amend paragraph (a) so as to no longer require that only an applicant in respect of whom *all* indications required under Rule 4.5(a) (name, address, nationality *and* residence) have been provided can be appointed as the common representative. Upon further consideration, it would appear sufficient that the name, the nationality *or* residence, and the address of the applicant be furnished to be appointed as a common representative. Note that the indication of the name and of the nationality *or* residence of the applicant is already required for the determination whether the applicant is entitled to file the international application according to Article 9, so that there would appear to be no need to specifically refer to the furnishing of the indications required under Rule 4.5(a)(i) and (iii). The requirement as such (“and in respect of whom the indication required under Rule 4.5(a)(ii) has been provided”) is presented in square brackets for consideration by the Working Group whether the furnishing of the address should be made a condition for the appointment of an applicant as the common representative or whether it should not, as at present, be left to the practice of the receiving Office to decide how to deal with the case of a missing address of the applicant to be appointed as a common representative.]



[Rule 90.2, continued]

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office ~~and in respect of whom all indications required under Rule 4.5(a) have been provided~~ shall be considered to be the common representative of all the applicants.

[COMMENT: Although the words “and in respect of whom all indications required under Rule 4.5(a) have been provided” were only added to paragraph (b) by way of an amendment adopted by the Assembly on October 1, 2002, with effect from January 1, 2004, it is proposed to further amend paragraph (b) so as to no longer require that only an applicant in respect of whom *all* indications required under Rule 4.5(a) (name, address, nationality *and* residence) have been provided can be considered to be the common representative. Upon further consideration, it would appear sufficient that, as at present, the name and the nationality *or* residence of the applicant be furnished to be considered to be common representative. Note that the indication of the name and of the nationality *or* residence of the applicant is already required for the determination whether the applicant is entitled according to Rule 19.1 to file the international application with the receiving Office, so that there would appear to be no need to specifically refer to the furnishing of the indications required under Rule 4.5(a)(i) and (iii). With regard to the address of the applicant to be considered as the common representative, rather than making the furnishing of the address a condition for considering the applicant to be the common representative, it is proposed to continue, as at present, to leave it to the practice of the receiving Office to decide how to deal with the case of a missing address. Otherwise, that is, if the furnishing of the address would be a condition for considering an applicant to be the common representative, it would appear possible that, in certain cases, none of the applicants could be considered to be the common representative (example: the applicant who is first named in the request is an applicant from a non-PCT Contracting State; the applicants named second and third in the request are applicants from a PCT Contracting State but not all indications required under Rule 4.5(a) have been provided for either of them).]

90.3 and 90.4 [No change]

90.5 *General Power of Attorney*

(a) [No change] Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:

(i) the general power of attorney has been deposited in accordance with paragraph (b), and

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

(b) [No change] The general power of attorney shall be deposited with the receiving Office, provided that, where it 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.

[COMMENT: No change is proposed to present paragraphs (a) and (b); the text is reproduced above for convenient reference.]

(c) Subject to paragraph (d), any receiving Office, any International Searching Authority and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

*[Rule 90.5, continued]*

(d) Where the agent submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4, the requirement under paragraph (a)(ii) for the attachment of a copy of the general power of attorney to the request, the demand or these separate notices, as the case may be, shall not be waived under paragraph (c).

[COMMENT: During its second session, the Committee on Reform of the PCT agreed that there was no need to amend Rule 90.5 to permit a receiving Office or an International Authority to waive the requirement under Rule 90.5(a)(ii) for a copy of a general power of attorney to be attached to the request, demand or separate notice (see document PCT/R/2, paragraph 71). Upon further reflection, however, it would appear inconsistent to permit an Office to waive the requirement that a separate power of attorney is furnished while still insisting on the furnishing of a copy of such deposited general power of attorney. It is thus proposed to add new paragraphs (c) and (d) so as to permit (but not oblige) any receiving Office and any International Searching and Preliminary Examining Authority to waive the requirement that a copy of a deposited general power of attorney be submitted to it.]

90.6 [No change]

[End of Annex and of document]