

WIPO



PCT/R/WG/5/1

ORIGINAL:English

DATE:August21,2003

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

Fifth Session

Geneva, November 17 to 21, 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

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above [in document PCT/A/32/2], on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."
2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will thence cease to be provisional in nature.

BACKGROUND

3. 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.

4. 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).¹

5. For the fourth session of the Working Group, the International Bureau had prepared a number of proposed amendments of the PCT Regulations aimed at further streamlining and simplifying the PCT procedure. However, having regard to the time available during the fourth session, discussions on the contents of document PCT/R/WG/4/4 were limited to proposals concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13^{ter}.1 (see Annex I of document PCT/R/WG/4/4) and proposals in the nature of corrigenda and consequential amendments (see Annex V of document PCT/R/WG/4/4). With regard to Annex I of document PCT/R/WG/4/4, the Working Group agreed that the International Bureau should prepare revised proposals taking into account the comments and clarifications set out in the summary of the fourth session of the Working Group by the Chair (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 97 to 102). With regard to Annex V of document PCT/R/WG/4/4, the Working Group concluded its discussion and approved certain amendments of the Regulations with a view to their submission to the Assembly (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 5 to 15). Discussions on the remaining matters (Annexes II to IV of document PCT/R/WG/4/4) were deferred until the next session of the Working Group (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraph 104).

6. The Annexes to this document contain a number of proposed amendments of the PCT Regulations aimed at further streamlining and simplifying the PCT procedure:

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws," "national applications," "the national phase," etc., include reference to regional laws, regional applications, the regional phase, etc. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

(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, taking into account the comments and clarifications set out in the summary of the fourth session of the Working Group by the Chair (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 97 to 102; and paragraphs 8 to 11, below);

(ii) Annex II reproduces the contents of Annex II of document PCT/R/WG/4/4 and contains proposals 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 12 to 14, below);

(iii) Annex III reproduces the contents of Annex III of document PCT/R/WG/4/4 and contains proposals 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 15 and 16, below);

(iv) Annex IV reproduces the contents of Annex IV of document PCT/R/WG/4/4 and 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 17 and 18, below).

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

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

8. 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 cases where a sequence listing complying with that standard had not been filed (see document PCT/R/WG/3/1, Annex I, item 5).

9. The Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standard 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).

10. At its fourth session, the Working Group discussed proposals prepared by the International Bureau concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13ter.1. The Working Group's discussions are outlined in document PCT/R/WG/4/14, paragraphs 97 to 102:

“97. Discussions were based on document PCT/R/WG/4/4, Annex I.

“98. The Working Group agreed that the Secretariat should prepare revised proposals taking into account the comments and clarifications set out in the following paragraphs.

“*Rule 13 ter.1*

“99. The Working Group agreed that Rule 13 *ter.1(a)* as proposed to be amended should be further amended so as to also require the payment of a late furnishing fee in the case where an invitation was issued under Rule 13 *ter.1(a)(i)*.

“100. The Working Group agreed that Rule 13 *ter.1(c)* as proposed to be amended should be further amended to read:

“(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 without the required sequence listing.”

“101. Certain delegations suggested the fixing of a maximum amount for the late furnishing fee, but other delegations noted that the Regulations in general left the fixing of fees to the discretion of each Authority.

“102. One delegation expressed concern as to the operation of Rule 13 *ter.1* in the case where an international application is forwarded from one (non-competent) Authority to another (competent) Authority.”

11. As agreed by the Working Group at its fourth session, Annex I to this document contains revised proposals for amendment of the PCT Regulations concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13 *ter.1*, taking into account the comments and clarifications set out in the summary of the fourth session of the Working Group by the Chair (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 97 to 102).

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

12. 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).

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

“...inordertodiscovermoreinformationabouttheexperienceofAuthoritiesregarding thisissue,theInternationalBureaushouldsendoutaquestionnaireaskingthemto indicatehowmanyinvitationstheyissuedperyearunderRules 40and68,howmany additionalfeeswerepaidunderprotest,andhowmanyoftheinvitationswereinrespect ofapplicationscontainingclaimsmorethan,say,10inventions.”

14. ForthefourthsessionoftheWorkingGroup,theInternationalBureauhadprepareda proposaltoamendRules 40and68accordingly(seeAnnexIIofdocumentPCT/R/WG/4/4). However,havingregardtothetimeavailablefordiscussionduringthefourthsession, discussionsonthisproposalweredefereduntilthenextsessionoftheWorkingGroup. AnnexIItothisdocumentreproducesthecontentsofAnnexIIofdocumentPCT/R/WG/4/4 fordiscussionatthissession.Anoverviewoftherepliesreceivedinresponsetothe questionnairesentoutbytheInternationalBureautoallInternationalSearchingand PreliminaryExaminingAuthorities(CircularC.PCT896)iscontainedindocument PCT/R/WG/4/4Add.1.

PUBLICATIONOFTRANSLATIONFURNISHEDBYTHEAPPLICANT

15. Duringitsthirdsession,theWorkingGroupdiscussedproposalsforapossibledeletion ofArticle64(4),basedondocumentPCT/R/WG/3/1,AnnexII,item28.TheWorkingGroup agreedthatfurtherconsiderationofthismatter,whileit wouldbewithinthecompetenceof theWorkingGroup,shouldbedeferreduntilprogresshadbeenmadeindiscussionsofprior artissuesbytheStandingCommitteefortheLawofPatents(SCP).Asarelatedmatter,the WorkingGroupagreed,however,thatt heInternationalBureaushouldlookintothe possibilityofamendingRule48soastoprovidefortheelectronicpublicationbythe InternationalBureauoftranslations,furnishedbytheapplicant,oftheinternational application(seethesummaryoftheChair'sreportofthethirdsessionoftheWorkingGroup, document PCT/R/WG/3/5,paragraphs78to82).

16. ForthefourthsessionoftheWorkingGroup,theInternationalBureauhadprepareda proposaltoamendRule48soastorequiretheInternationalBureau,onrequestofthe applicant,topublish,togetherwiththeinternationalapplication,anytranslationofthe internationalapplicationfurnishedbytheapplicantor,wheretheinternationalapplicationwas filedinalanguagewhichisnotalanguageofpublication,theinternationalapplicationinthe languageinwhichitwasfiled(seeAnnexIIIofdocumentPCT/R/WG/4/4).However, havingregardtothetimeavailablefordiscussionduringthefourthsession,discussionson thisproposal weredefereduntilthenextsessionoftheWorkingGroup. AnnexIIItothis documentreproducesthecontentsofAnnexIIIofdocumentPCT/R/WG/4/4fordiscussionat thissession.

INTERNATIONALFORMFORNATIONALPHASEENTRY

17. AtthethirdsessionoftheWorkingGroup,severaldelegationsandrepresentativesof userssupportedtheproposedintroductionofastandardizedinternationalformforentryinto thenationalphase(see documentPCT/R/WG/3/1,AnnexI,item11(introduceinternational formsfor nationalphaseentry)),includingstandardtextsofdeclarationssimilar tothose providedforinthecaseoftherequestformunderRule4.17,ontheunderstandingthattheuse ofsuchaformbyapplicantswouldbeoptionalandnota requirementforavalidnational phaseentry.TheWorkingGroupagreedthattheInternationalBureau shouldprepare sucha proposal(see document PCT/R/WG/3/5,paragraphs 67and68).

18. For the fourth session of the Working Group, the International Bureau had prepared a proposal to amend Rule 49.4 accordingly (see Annex IV of document PCT/R/WG/4/4). However, having regard to the time available for discussion during the fourth session, discussions on this proposal were deferred until the next session of the Working Group. Annex IV to this document reproduces the contents of Annex IV of document PCT/R/WG/4/4 for discussion at this session. 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 51*bis*.

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

[Annexes follow]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

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13ter.1 <i>Sequence Listing for International Authorities</i>	2
13ter.2 [No change]	4

² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

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 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/5/3 (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).

[Rule 13ter.1(a), cont. inued]

[COMMENT: Text modeled after Rules 12.3(e) and 40.2(a). During the fourth session of the Working Group, certain delegations suggested the fixing of a maximum amount for the late furnishing fee but other delegations noted that the Regulations generally left the fixing of fees for the benefit of Authorities to the discretion of each Authority (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 101). In view of the latter, the proposal has not been further revised and remains as presented in Annex I of document PCT/R/WG/4/4.]

(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 of paragraph (c) was approved by the Working Group at its fourth session (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 100).]

(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 [Nochange]

[Annex II follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ³

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

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³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

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, *con tinued*]

(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 (e), 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 purposes 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 two stages of the 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 limits 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]

ANNEX III

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ⁴

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

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⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

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:⁵

INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

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⁵ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 49

Copy, Translation and Fee 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 Offices 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]

[End of Annexes and of document]