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SUPPLEMENTARY INTERNATIONAL SEARCH:
FURTHER CONSEQUENTIAL AMENDMENTS

Document prepared by the International Bureau

SUMMARY

1. The Annex to this document contains proposals to amend Rules 45*bis*, 90 and 90*bis*¹. The proposed amendments are in the nature of consequential amendments based on the amendments to the Regulations adopted by the Assembly on October 3, 2007, with effect from January 1, 2009, introducing the supplementary international search system (see document PCT/A/36/13, Annex V).

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.

PROPOSED AMENDMENT OF THE PCT REGULATIONS

Proposed amendment of Rule 45bis.2 and 3

2. At present, the provisions concerning the refund of the supplementary search handling fee and the supplementary search fee (see Rules 45bis.2(d) and 45bis.3(d) and (e), respectively, as adopted by the Assembly on October 3, 2007, with effect from January 1, 2009) only provide for a refund of those fees where the request for supplementary search is withdrawn by the applicant or considered not to have been submitted. The present provisions do not, however, provide for a refund of those fees where the international application itself is withdrawn or considered withdrawn.

3. It is thus proposed to fill this apparent gap by amending Rules 45bis.2(d) and 3(d) accordingly. Similar to the provisions governing the refund of the (main) search fee where the international application is withdrawn or considered withdrawn (see Rule 16.2(ii): the main search fee is refunded only where the application is withdrawn or considered withdrawn before the transmittal of the search copy to the International Searching Authority), it is proposed to provide that the supplementary search handling fee and the supplementary search fee will only be refunded if the international application is withdrawn or considered withdrawn, or if the request for supplementary international search is withdrawn or considered not to have been submitted, before the transmittal of the documents referred to in Rule 45bis.4(e)(i) to (iv) to the Authority specified for supplementary search.

Proposed amendment of Rule 90

4. Present Rule 90 does not deal with the issue of the right of an agent to practice in respect of the international application before any International Searching Authority which the applicant has requested to carry out a supplementary international search. It is thus proposed to amend Rule 90 accordingly.

Proposed amendment of Rule 90bis

5. Although a right to withdraw a request for supplementary international search is implied by the wording of Rule 45bis.2(d) as adopted by the Assembly on October 3, 2007, with effect from January 1, 2009, at present, the Regulations do not provide for the requirements nor for the effects of such a withdrawal, as does present Rule 90bis for the other types of withdrawal, such as withdrawal of the international application, of priority claims, of the demand and of elections.

6. It is thus proposed to amend Rule 90bis so as to provide, in particular:

(a) for a time limit within which a withdrawal of a request for supplementary search can be made (at any time prior to the date of transmittal to the applicant and to the International Bureau of the supplementary search report, or the declaration that no such report will be established; see proposed new Rule 90bis.3bis(a));

(b) the date as of which a request for withdrawal shall be effective (the date of receipt of the notice of withdrawal by the Authority specified for supplementary search or by the International Bureau; see proposed new Rule 90bis.3bis(b)); and

(c) the effects of a withdrawal of a request for supplementary international search (the processing of the international application by the Authority specified for supplementary search shall be discontinued; see proposed new Rule 90*bis*.6(b-*bis*)).

7. In addition, it is proposed to amend Rule 90*bis* so as to ensure that, where the notice of withdrawal is addressed to the International Bureau and transmitted by that Bureau to the Authority specified for supplementary search only after that Authority has transmitted the supplementary search report to the applicant and to the International Bureau, communication (on request) of the report to designated Offices will still be effected under Article 20(1) (as applicable by virtue of Rule 45*bis*.8(b)) (see proposed new Rule 90*bis*.3*bis*(b)).

8. *The Working Group is invited to consider the proposals contained in the Annex.*

[Annex follows]

ANNEX

SUPPLEMENTARY INTERNATIONAL SEARCH:
FURTHER CONSEQUENTIAL AMENDMENTS²

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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 45bis

Supplementary International Searches

45bis.1 [No change]

45bis.2 *Supplementary Search Handling Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the [international application is withdrawn or considered withdrawn, or the](#) supplementary search request is withdrawn or considered not to have been submitted.

[COMMENT: See paragraphs 2 and 3 in the main body of this document.]

45bis.3 *Supplementary Search Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the [international application is withdrawn or considered withdrawn, or the](#) supplementary search request is withdrawn or considered not to have been submitted.

[COMMENT: See paragraphs 2 and 3 in the main body of this document.]

[Rule 45bis.3, continued]

(e) [No change] The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under Article 16(3)(b), refund the supplementary search fee if, before it has started the supplementary international search in accordance with Rule 45bis.5(a), the supplementary search request is considered not to have been submitted.

[COMMENT: No change would appear to be needed to paragraph (e).]

45bis.4 to 45bis.9 [No change]

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 is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, [any Authority specified for supplementary search](#) and the International Preliminary Examining Authority.

(b) [No change] 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.

[\(b-bis\) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.](#)

(c) [No change]

[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, [any Authority specified for supplementary search](#) and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) specifically before the International Searching Authority, [any Authority specified for supplementary search](#) or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, [the Authority specified for supplementary search](#) or International Preliminary Examining Authority, as the case may be.

90.2 and 90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) [No change] The appointment of an agent shall be effected by the applicant signing the request, the demand or a separate power of attorney. Where there are two or more applicants, the 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.

(b) Subject to Rule 90.5, 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), [\(b-bis\)](#), (c) or (d)(ii), it shall be submitted to the International Searching Authority, [the Authority specified for supplementary search](#) or the International Preliminary Examining Authority, as the case may be.

(c) [No change] 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.

(d) Subject to paragraph (e), any receiving Office, any International Searching Authority, [any Authority competent to carry out supplementary searches](#), any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply.

(e) [No change] Where the agent or the common representative submits any notice of withdrawal referred to in Rules *90bis.1* to *90bis.4*, the requirement under paragraph (b) for a separate power of attorney shall not be waived under paragraph (d).

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

(c) Any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches 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) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 to the receiving Office, the International Searching Authority, [the Authority specified for supplementary search](#) or the International Preliminary Examining Authority, [as the case may be](#), a copy of the general power of attorney shall be submitted to that Office or Authority.

90.6 [No change]

Rule 90bis

Withdrawals

90bis.1 to 90bis.3 [No change]

90bis.3bis *Withdrawal of Request for Supplementary International Search*

(a) The applicant may withdraw a request for supplementary international search at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45bis.8(a), of the supplementary search report or the declaration that no such report will be established.

(b) Withdrawal shall be effective on receipt, within the time limit under paragraph (a), of a notice addressed by the applicant, at his option:

(i) to the Authority specified for supplementary search; or

(ii) to the International Bureau, provided that, where the notice is transmitted by that Bureau to the Authority specified for supplementary search after that Authority has effected the transmittal under Rule 45bis.8(a), the communication under Article 20(1), as applicable by virtue of Rule 45bis.8(b), of the supplementary search report or of the declaration that no such report will be established shall nevertheless be effected.

[COMMENT: See paragraph 7 in the main body of this document.]

90bis.4 [No change]

90bis.5 *Signature*

(a) [No change] Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, subject to paragraph (b), be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, subject to paragraph (b), not be entitled to sign such a notice on behalf of the other applicants.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

(i) [No change] a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d), ~~or~~ 90bis.3(c) or 90bis.3bis(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) [No change] in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with.

90bis.6 Effect of Withdrawal

(a) [No change] Withdrawal under Rule 90*bis* of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).

(b) Where the international application is withdrawn under Rule 90*bis*.1, the international processing of the international application shall be discontinued.

(b-bis) Where a request for supplementary international search is withdrawn under Rule 90*bis*.3*bis*, the processing of the international application by the Authority specified for supplementary search shall be discontinued.

(c) [No change] Where the demand or all elections are withdrawn under Rule 90*bis*.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

90bis.7 [No change]

[End of Annex and of document]