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./ The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith working documents PCT/R/2/5 to 7 for the second session of the *Committee on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva from July 1 to 5, 2002.

The working documents are also available on WIPO's web site (see <http://www.wipo.int/pct/en/meetings>).

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Enclosures: documents PCT/R/2/5 to 7

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COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

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Geneva, July 1 to 5, 2002

RIGHT OF PRIORITY AND PRIORITY CLAIMS

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, inter alia, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces these second sessions summary as an Annex.¹

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Website at <http://www.wipo.int/pct/en/meetings>.

Reinstatement of priority claim where time limit missed; Correction and addition of priority claims; Availability of priority documents from digital libraries

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT² relating, as recommended by the Committee, to changes necessary or desirable to bring the requirements under the PCT into line with the letter and spirit of the Patent Law Treaty (PLT) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 72 to 74).

4. There was wide agreement at the first session of the Working Group on the general approach to be taken (see document PCT/R/WG/1/9, paragraph 21). Among the matters agreed was that (see paragraph 21(v)):

“priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following :

– provisions for restoration of the priority right in certain circumstances;

....”

5. The proposals prepared by the International Bureau for consideration at the first session of the Working Group included provisions for reinstatement of priority similar to those in the PLT, as well as to the possibility, in line with the PLT, that priority documents may be available, in the future, from digital libraries (see document PCT/R/WG/1/5, Annex III). The Working Group's discussions are outlined in document PCT/R/WG/1/9, paragraphs 22 and 23:

“22. Discussions were based on document PCT/R/WG/1/5, and in particular on proposed new Rule 26 *bis*.3, contained in Annex III to that document, which would provide for restoration of the priority right for up to two months beyond the usual 12-month priority period. The comments and concerns expressed by various delegations included the following:

(i) there was general agreement with the idea of providing for a means of restoration of priority rights, consistently with corresponding provisions of the PLT, during the international phase of the PCT procedure;

(ii) noting that the administration of those provisions in the national phase would be a matter for ROs [receiving Offices], the importance of a single standard, or at

² 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 (the current texts are available on WIPO's Website at http://www.wipo.int/pct/en/access/legal_text.htm). Reference to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. Reference to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO's Website at http://www.wipo.int/eng/document/pt_dc/index.htm).

least consistent practice, among the various ROs was emphasized by several delegations;

(iii) delegations differed in their views as to the appropriate criterion which should apply in the context of the PCT (under Rule 26 *bis.3(a)(iii)*) in cases where the applicant failed to file the international application within the 12-month priority period, noting that the PLT provided for Contracting Parties to choose between two criteria:

- most delegations favored adopting the more liberal criterion of “unintentional” failure in the context of the PCT;
- certain delegations favored adopting the more restrictive criterion of “due care”;
- certain delegations favored giving ROs a choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT;

(iv) it was recognized by the Working Group that provision for restoration of the priority right in the international phase implied that the RO’s decision would need to have effect for the purposes of the national phase;

(v) most delegations believed that the RO’s decisions should be binding on DOs [designated Offices] (as under proposed Rule 26 *bis.3(f)*), but certain delegations believed that the RO’s decisions should be subject to review by DOs in at least some circumstances, although there was no agreement as to what circumstances should be relevant in this context;

(vi) it was pointed out that, if the PCT were to require that one particular criterion be applied by all ROs, it would be possible for an Office to have to apply one criterion in its capacity as a PCT RO and the other criterion in its capacity as a national Office processing national applications or as a DO processing international applications entering the national phase;

(vii) it was recognized that priority dates had two related but distinct effects:

- “procedural” in the sense that certain important time limits under the PCT were calculated by reference to the priority date;
- “substantive” in the sense that it was at the priority date that it would be determined whether the invention satisfied the requirements of novelty and inventiveness (non-obviousness);

(viii) the recognition in the national phase of an RO’s decision to restore the priority right was more particularly related to the procedural effect; the procedural effect was the dominant consideration in, for example, PCT Article 2(xi) and Rule 26*bis.2(a)*;

(ix) the fact that a considerable number of countries’ national laws did not presently provide for restoration of priority rights, at least according to PLT criteria,

suggested that transitional reservations would need to be allowed for if restoration provisions were to be introduced under the PCT.

“23. It was agreed that the International Bureau should prepare a revised proposal which would:

(i) provide for restoration of the priority right by the RO based on the “unintentional” criterion, but identifying alternatives in the related comments or explanation;

(ii) make it clear that it was the procedural effect of the priority right, rather than the substantive effect, that should be recognized for the purposes of the national phase.”

6. Revised proposals, including provisions relating to the correction and addition of priority claims, were prepared by the International Bureau for consideration by the Working Group at its second session (see document PCT/R/WG/2/3). The Working Group’s discussions are outlined in document PCT/R/WG/2/12, paragraphs 54 to 56:

“54. Although the contents of document PCT/R/WG/2/3 could not, in the time available, be discussed in detail, there was general support for proposed new Rule 26bis.3 relating to restoration of priority claims. Revised proposals should take into account the following considerations:

(i) the substantive validity of a priority claim in terms of the Paris Convention would remain a matter for national law;

(ii) national law could make provisions concerning the prior rights of third parties and the right of third parties to intervene;

(iii) there is need for information concerning the fact that a priority claim had been restored to be communicated to designated Offices, for example, by the inclusion of indications on the front page of the published application (PCT pamphlet);

(iv) considerations should be given to reducing or eliminating the ability of a designated Office to review a decision of the receiving Office to restore or refuse to restore a priority claim (see Rule 26bis.3(h)).

“55. It was agreed that proposed amended Rules 17.1 and 66.7, relating to the possibility, in line with the PLT, that priority documents may be available, in the future, from digital libraries, should proceed together with the proposed amendment of Rule 47.1 and related provisions (see paragraphs 24 and 25, above). Proposed amended Rules 26bis.1 and 26bis.2 and new Rule 80.8, relating to the correction and addition of priority claims, should similarly also proceed.

“56. It was agreed that revised proposals should preferably be submitted to the second session of the Committee, although it was recognized that the time available may not permit the necessary revision of the proposals.”

7. Article 13 and Rule 14 of the PLT are reproduced for ease of reference in Annex I. Revised proposals for amendments to the PCT Regulation to provide for the restoration of priority claims are included in Annex II (see Rules 4 and 48 as proposed to be amended and proposed new Rule 26 *bis.3*), as well as provisions relating to the possibility, in line with PLT requirements, that priority documents may be available, in the future, from digital libraries (see Rules 17.1 and 66.7 as proposed to be amended). Annex II also includes proposals to amend Rules 26 *bis.1* and 26 *bis.2* and to add new Rule 80.8 relating to the possibility for the applicant to correct or add priority claims. Some key issues arising in connection with the proposals are outlined in the following paragraphs.

Procedural and substantive aspects of priority rights

8. Although PLT Article 13(2) refers to the restoration of the *right of priority*, it is proposed in the context of the PCT procedure to provide for the receiving Office to be able to restore the *priority claim* (see proposed Rule 26 *bis.3*).

9. PCT Article 8(2)(a) expressly provides that “the conditions for, and the effect of,” priority claims are matters for Article 4 of the Paris Convention. Thus, the substantive aspects of priority claims, in terms of the validity and substantive effects of the priority rights concerned, are left for designated Offices to determine in the national phase. On the other hand, a priority claim has a procedural significance in the international phase which in some senses carries over into the national phase. For example, a number of time limits under the PCT are computed by reference to the priority date, and the priority date is taken into account in the carrying out of the international search and international preliminary examination.

10. It therefore appears to be necessary to ensure that, while a designated Office would always be free to *determine the validity of a priority right* for the purposes of the national phase in terms of compliance with the Paris Convention, it should be strictly limited in its freedom (during the national phase) to *review a decision by the receiving Office to restore a priority claim* (during the international phase). Proposed Rule 26 *bis.3(g)(i)* would accordingly restrict the circumstances in which a designated Office could decide to review such a decision, namely, to cases where there is a “reasonable doubt” on the part of the designated Office. If national law gives third parties the right to intervene, it would be open to a third party to persuade the designated Office that such a reasonable doubt existed.

11. In the absence of grounds to overturn the decision of the receiving Office, so far as a designated Office is concerned, proposed Rule 26 *bis.3(g)(ii)* would oblige the designated Office to give due effect to the receiving Office’s decision.

Criterion for restoration of priority claim (“unintentionality” or “due care”)

12. See document PCT/R/WG/1/9, paragraphs 22(ii) to (vi) and 23(i), quoted in paragraph 5, above. PLT Article 13(2)(iv) leaves it at the option of each PLT Contracting State to decide whether the Office requires the failure to file the subsequent application to have been “unintentional” or that it “occurred in spite of due care required by the circumstances having been taken”. At the first session of the Working Group, it was agreed that, in the context of the PCT, restoration of priority claims should be based on the more liberal requirement that the failure was “unintentional,” as favored by most delegations. However, certain delegations favored adopting the more restrictive criterion of “due care”. Certain other delegations favored giving receiving Offices a choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT.

13. Certain delegations pointed out that, if the PCT were to require that one particular criterion be applied by all receiving Offices, it would be possible for an Office to have to apply one criterion in its capacity as a PCT receiving Office and the other criterion in its capacity as a national Office processing international applications or as a designated Office processing international applications entering the national phase. On the other hand, the importance of providing a single standard, or at least of ensuring consistent practice, among receiving Offices was emphasized by several delegations.

14. While it is recognized that the Committee may wish to further discuss the matter, proposed Rule 26 *bis*.3(a)(iii) relies on the criterion of unintentionality in accordance with the conclusion of the first session of the Working Group.

Prior rights of third parties and the right of third parties to intervene

15. It does not seem necessary or appropriate to attempt to regulate under the PCT itself the rights of third parties affected by the restoration of a priority right. Rather, any recognition of the rights of such third parties, including any prior user right and any right to request a designated Office to review a decision of the receiving Office to restore a priority claim, should be left to the applicable national law in the designated States. In the event that it were thought desirable to make that position clear in the Regulations, consideration would also need to be given to the rights of third parties whomight be affected in other ways under the PCT procedure, for example, by the correction or addition of a priority claim under Rule 26 *bis*.

Transitional reservation

16. A transitional reservation provision has been included as proposed Rule 26 *bis*.3(h), recognizing that time may be needed for the national law applicable by certain designated Offices to be brought into line with the provisions of proposed Rule 26 *bis*.3(a) to (g).

17. The Committee is invited to consider the proposals contained in Annex II.

[Annex I follows]

ARTICLE 13 AND RULE 14 OF THE PATENT LAW TREATY (PLT)

Article 13

Correction or Addition of Priority Claim; Restoration of Priority Right

(1) [*Correction or Addition of Priority Claim*] Except where otherwise prescribed in the Regulations, a Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations; and
- (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(2) [*Delayed Filing of the Subsequent Application*] Taking into consideration Article 15, a Contracting Party shall provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the priority period; and
- (iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) [*Failure to File a Copy of Earlier Application*] A Contracting Party shall provide that, where a copy of an earlier application required under Article 6(5) is not filed with the Office within the time limit prescribed in the Regulations pursuant to Article 6, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit for filing the copy of the earlier application prescribed in the Regulations pursuant to Article 6(5);

(iii) the Office finds that the request for the copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations; and

(iv) a copy of the earlier application is filed within the time limit prescribed in the Regulations.

(4) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).

(5) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(6) [Opportunity to Make Observations in Case of Intended Refusal] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Rule 14

Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13

(1) [Exception Under Article 13(1)] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.

(2) [Requirements Under Article 13(1)(i)] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) [Time Limit Under Article 13(1)(ii)] The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) [Time Limits Under Article 13(2)] (a) The time limit referred to in Article 13(2), introductory part, shall expire not less than two months from the date on which the priority period expired.

(b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) [Requirements Under Article 13(2)(i)] A Contracting Party may require that a request referred to in Article 13(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [*Requirements Under Article 13(3)*] (a) A Contracting Party may require that a request referred to in Article 13(3)(i):

(i) be signed by the applicant; and

(ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request.

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3)(iv) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [*Time Limit Under Article 13(3)(iii)*] The time limit referred to in Article 13(3)(iii) shall expire two months before the expiration of the time limit prescribed in Rule 4(1).

[Annex II follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ¹

RIGHT OF PRIORITY AND PRIORITY CLAIMS

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¹ 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 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, that date being subject to Rule 26bis.3, a date falling within the period of 12 months preceding the international filing date;

[COMMENT: It is proposed to amend item (i) of paragraph (a) so as to clarify that, where the applicant is submitting a request for restoration of the priority claim, the date on which the earlier application was filed as indicated in the request does not have to be a date falling within the period of 12 months preceding the international filing date.]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 17

The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed (“the priority document”), shall, unless [that priority document has](#) already [been](#) filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraph [s\(b\)](#) [and \(b -bis\)](#), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

[COMMENT: See proposed new paragraph [\(b -bis\)](#), below.]

(b) [No change]

[Rule 17.1, continued]

(b-bis) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library [or other repository], the applicant may, as the case may be, instead of submitting the priority document:

- (i) request the receiving Office to obtain the priority document from such digital library [or other repository] and transmit it to the International Bureau; or
- (ii) request the International Bureau to obtain the priority document from such digital library [or other repository].

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

[COMMENT: See PLTR Rule 4(3). See also proposed new Rule 93bis in document PCT/R/2/6, Annex IV. The Committee may wish to consider adding the words “or other repository” (presently in square brackets) so as to address concerns raised in the second session of the Working Group concerning the use of the term “[intellectual property] digital library” in the context of communication by electronic means (see document PCT/R/WG/2/12, paragraph 25). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the receiving Office or the International Bureau for the purposes of this paragraph.]

[Rule 17.1, continued]

(c) If the requirements of ~~none~~ ~~neither~~ of the ~~three~~ ~~two~~ preceding paragraphs are complied with, any designated ~~Office~~ ~~State~~ may subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as a national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library [or other repository].

[COMMENT See PLTR Rule 4(3). See also proposed new Rule 93bis in document PCT/R/2/6, Annex IV. The Committee may wish to consider adding the words “or other repository” (presently in square brackets) so as to address concerns raised in the second session of the Working Group concerning the use of the term “[intellectual property] digital library” in the context of communication by electronic means (see document PCT/R/WG/2/12, paragraph 25). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the designated Office for the purposes of this paragraph.]

17.2 [No change]

Rule 26 bis

Correction, ~~or~~ Addition or Restoration of Priority Claim

26bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct or add a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, ~~provided that such a notice may be submitted until the expiration of four months from the international filing date~~. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

[COMMENT: It is proposed to amend Rule 26 bis.1(a) and to add a new Rule 80.8(b) (see below) so as to extend the period available to the applicant for the correction or addition of a priority claim prior to international publication of the international application where the applicant mistakenly makes a priority claim which is more than 12 months preceding the international filing date (see document PCT/R/WG/1/4, paragraph 4, and document PCT/R/WG/1/9, paragraphs 32 and 33). Since, under proposed new Rule 80.8(b), a priority claim which does not comply with Rule 4.10(a)(i) (that is, a priority claim related to an earlier application which has a filing date not falling within the period of 12 months preceding the international filing date) would not be taken into account for the purposes of computing the 16-month time limit under Rule 26 bis.1, the applicant would always have 16 months from the corrected priority date to submit a request for correction. The previous “four months from the international filing date” minimum time limit seems to be no longer needed and is thus proposed to be deleted.

Example: An international application with an international filing date of 4 June 2002 claims the priority of an earlier application, (erroneously) indicating that the earlier application was filed on 5 February 2001; the correct priority date should have been 5 February 2002.

Presentsituation : According to present Rule 26bis.1(a), the applicable time limit for submitting a correction would be four months from the international filing date, that is, 4 October 2002.

Situation under the Rules as proposed to be amended : According to Rule 26 bis.1(a) as proposed to be amended and proposed new Rule 80.8(b), the applicable time limit for submitting a correction would be 16 months from the corrected priority date, that is, 5 June 2003.]

[Rule 26bis.1, continued]

(b) [No change]

(c) ~~[Deleted] Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.~~

[COMMENT: The content of current Rule 26 bis.1(c) is proposed to be moved to proposed new Rule 80.8(a) (see below) so as to deal with all matters relating to time limits computed from the priority date in one place.]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

[COMMENT: Consequential on the proposed deletion of the reference to “invitation” in paragraph (b).]

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds that:

(i) a priority claim does not comply with the requirement of Rule 4.10(a)(i) and a request for restoration of that priority claim under Rule 26bis.3 has not been filed; or

(ii) a priority claim does not comply with the other requirements of Rule 4.10; or

(iii) ~~that~~ any indication in a priority claim is not the same as the corresponding indication appearing in the priority document ;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim.

[COMMENT: There appears to be no need for an invitation to correct a priority claim where a request for restoration of that priority claim has been filed by the applicant, showing that the applicant, while being aware of the fact that the filing date of the earlier application as indicated in the request does not fall within the 12 months preceding the international filing date, has no intention to correct that priority date but rather wishes to have the priority claim restored under Rule 26 bis.3, below.]

[Rule 26bis.2, continued]

(b) If, ~~in response to an invitation under paragraph (a),~~ the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim so as to comply with the requirements of Rule 4.10, or does not, where applicable, before the expiration of the time limit under Rule 26bis.3(a)(ii), submit a request for restoration of the priority claim, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, provided that a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

[COMMENT: Paragraph (b) is proposed to be amended so as to clarify that a priority claim cannot be considered not to have been made under this paragraph where the applicant has filed a request for restoration. Rather, the decision by the receiving Office on whether or not to consider the priority claim not to have been made is governed by proposed new Rule 26bis.3, below (that is, the decision to restore the priority claim or to refuse the request for restoration). In this context, it is also proposed to delete the words, “in response to an invitation under paragraph (a),” which appear to be superfluous; whether or not the notice of correction or the request for restoration is received as a result of an invitation would seem irrelevant.]

(c) [No change]

26bis.3 Restoration of Priority Claim

(a) The receiving Office shall, at the request of the applicant and subject to paragraphs (c) and (d), restore a priority claim where the international application has an international filing date which is later than the date on which the priority period referred to in paragraph (b) has expired, if:

[COMMENT: See PLT Article 13(2)]

(i) the international application has been accorded an international filing date which is within a time limit of two months from the date on which the priority period expired; and

[COMMENT: See PLT Article 13(2) and PLTR Rule 14(4)(a).]

(ii) the request for restoration of the priority claim is submitted to the receiving Office within a time limit of two months from the date on which the priority period expired; and

[COMMENT: See PLT Article 13(2)(ii) and PLTR Rule 14(4)(b).]

(iii) the receiving Office finds that the failure to file the international application within the priority period was unintentional.

[COMMENT: As to the criterion for restoration (“unintentionality” as against “due care”), see paragraphs 12 to 14 of the Introduction to this document.]

[Rule 26bis.3, continued]

(b) The priority period referred to in paragraph (a) shall be 12 months calculated from the priority date that would apply if the priority claim were restored.

(c) The request referred to in paragraph (a) shall:

(i) state the reasons for the failure to comply with the priority period; and

[COMMENT: See PLT Article 13(2)(iii).]

(ii) be accompanied, where the international application did not claim the priority of the earlier application, by a notice adding the priority claims so as to comply with the requirements of Rule 4.10.

[COMMENT: See PLTRule 14(5)(ii).]

[Rule 26bis.3, continued]

(d) The receiving Office:

(i) may require that a fee be paid in respect of a request under paragraph (a) for restoration of a priority claim;

[COMMENT: See PLT Article 13(4).]

(ii) may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (c)(i) be filed within a time limit which shall be reasonable under the circumstances;

[COMMENT: See PLT Article 13(5).]

(iii) shall not refuse, totally or in part, a request under paragraph (a) for restoration of a priority claim without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[COMMENT: See PLT Article 13(6).]

(e) Where the receiving Office refuses a request for restoration of a priority claim under paragraph (a), that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly.

[Rule 26bis.3, continued]

(f) Where the receiving Office has refused a request under paragraph (a) for restoration of a priority claim, or where such a request is pending at the time of the completion of the technical preparations for international publication, the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning that request for restoration. A copy of the request under this paragraph shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: New paragraph (f) is proposed to be added as a safeguard for the applicant where his request for the restoration of a priority claim has been refused or has not been decided upon by the time the international application is to be published so as to enable him to pursue the matter further, after national phase entry, before the designated Offices concerned; see also Rule 26 bis.2(c), which has been used as a model for the wording of new paragraph (f). New Sections in the Administrative Instructions, similar to Sections 314 and 402 in respect of the correction and addition of priority claims, would also be required.]

[Rule 26bis.3, continued]

(g) Where the receiving Office has restored a priority claim under paragraph (a):

(i) no designated Offices shall review the decision of the receiving Office unless it has reasonable doubts that a requirement under that paragraph was not complied with, in which case it shall notify the applicant accordingly, indicating the reasons for those doubts and giving the applicant an opportunity to make observations within a reasonable time limit;

(ii) no designated Offices shall disregard the priority claim only because the international application has an international filing date which is later than the date on which the priority period referred to in Rule 26 bis.3(b) expired, unless it finds that a requirement under paragraph (a) was not complied with.

[COMMENT: As to the procedural aspects of priority claims as against the substantive aspects of priority rights, see paragraphs 8 to 11 of the Introduction to this document. New paragraph (g) is intended to strike an equitable balance between the interests of the applicant in not having the restoration of a priority claim routinely reviewed by designated Offices and the right of the designated Office to revoke an incorrectly restored priority claim (see document PCT/R/WG/2/12, paragraph 54(iv), quoted in the Introduction). As to the right of third parties to intervene in the matter of a request for the restoration of the priority claim, see paragraphs 10 and 15 of the Introduction.]

[Rule 26 bis.3, continued]

(h) If, on [date of adoption of these modifications by the PCT Assembly], any provision of this Rule is not compatible with the national law applied by the designated Office, that provisions shall not apply in respect of that Office as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: As to prior rights of third parties and the right of third parties to intervene, see paragraphs 10 and 15 of the Introduction to this document.]

Rule48

InternationalPublication

48.1 [Nochange]

48.2 *Contents*

(a) Thepamphletshallcontain:

(i) to(ix) [Nochange]

(x) anydeclarationreferredtoinRule4.17(v),andanycorrectionthereofunder Rule 26*ter*.1,whichwasreceivedbytheInternationalBureaubeforetheexpirationofthetime limitunderRule26 *ter*.1;

(xi) indicationsconcerninganypriorityclaimhasbeenrestoredunder

Rule 26*bis*.3(a).

[COMMENT:Thisitemhasbeenincludedfollowingagreementatthesecondsessionofthe WorkingGroupasto“theneedforinformationconcerningthefactthatapriorityclaimhad beenrestoredtobecomunicatedtodesignatedOffices,forexample,bytheinclusionof indicationsonthefrontpageofthepublishedapplication(PC Pamphlet)”(seedocument PCT/R/WG/2/12,paragraph54(iv)).]

(b)to(i) [Nochange]

48.3to48.6 [Nochange]

[COMMENT:SeedocumentPCT/R/2/3forproposedamendmentsofRule48.3.]

Rule 66

Procedure Before the

International Preliminary Examining Authority

66.1 to 66.6 [No change]

66.7 Copy and Translation of Earlier Application Whose Priority is Claimed ~~Document~~

(a) If the International Preliminary Examining Authority needs a copy of the earlier application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1 , and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library [or other repository] in accordance with the Administrative Instructions, the international preliminary examination report may be established as if the priority had not been claimed.

[COMMENT: See PLTR Rule 4(3). The Committee may wish to consider adding the words “or other repository” (presently in square brackets) so as to address concerns raised in the second session of the Working Group concerning the use of the term “[intellectual property] digital library” in the context of communication by electronic means (see document PCT/R/WG/2/12, paragraph 25). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the International Preliminary Examining Authority for the purposes of this paragraph. The Working Group agreed at its second session (see document PCT/R/WG/2/12, paragraph 55) that this change should proceed together with the proposed amendment of Rule 47.1 and related provisions (see proposed new Rule 93bis in see Annex IV of document PCT/R/2/6).]

(b) [No change]

66.8 and 66.9 [No change]

Rule80

ComputationofTimeLimits

80.1to80.7 [Nochange]

80.8 *TimelimitsComputedFromthePriorityDate*

(a) Whereachangeintheprioritydateiscausedby:

(i) thecorrectionoradditionofapriorityclaim;or

(ii) there storationofapriorityclaim;

anytimelimitwhichiscomputedfromthepreviouslyapplicableprioritydateandwhichhas
notalreadyexpiredshallbecomputedfromtheprioritydateassochanged.

[COMMENT:SeecommentonRule26 *bis*.1(c),above.Itis proposedtomovethecontentof
currentRule26 *bis*.1(c)toproposednewRule 80.8(a)soastodealwithallmattersrelatingto
timelimitscomputedfromtheprioritydate,includingarestoredpriorityclaim,inoneplace.]

[Rule 80.8, continued]

(b) For the purposes of computing time limits, if a priority claim does not comply with Rule 4.10(a)(i) because the date on which the earlier application was filed was not a date falling within the 12 months preceding the international filing date, that priority claim shall not, subject to paragraph (a)(ii), be taken into account for the purposes of determining the priority date.

[COMMENT: See the Comment on Rule 26 *bis*.1(a), above. It appears necessary to make this provision “subject to paragraph (a)(ii)” so as to ensure that a priority claim which does not comply with Rule 4.10(a)(i) that, if the date on which the earlier application was filed is a date falling within the 12 months preceding the international filing date, it is taken into account where that priority claim is restored under proposed new Rule 26 *bis*.3(a).]

[End of Annex II and of document]

WIPO



PCT/R/2/6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

Second Session
Geneva, July 1 to 5, 2002

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT;
RELATED PROPOSALS: ELECTIONS; INTERNATIONAL FILING FEE;
“COMMUNICATION ON REQUEST” SYSTEM

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.¹

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

The concept and operation of the designation system

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT² relating, as recommended by the Committee, to the concept and operation of the designation system (see the report of the first session of the Committee, document PCT/R/26, paragraph 69).

4. The Working Group agreed on the general approach to be taken with regard to the new concept and operation of the designation system and generally agreed on the proposals for amendment of the Regulations contained in document PCT/R/WG/2/2, Annexes I to IV, subject to the matters raised in document PCT/R/WG/2/12, paragraphs 5 to 25:

“5. Discussions were based on document PCT/R/WG/2/2.

“Automatic indication of all designations possible under the PCT

“6. The International Bureau indicated that paragraph 5(e) of document PCT/R/WG/2/2 was not intended to suggest that Article 27(5) was exhaustive on the question of prior art effect, but rather that it must be read giving proper effect to Articles 11(3) and 64(4).

“7. The proposals contained in document PCT/R/WG/2/2, Annex I, were generally agreed, subject to the matters raised in the following paragraphs.

“8. In connection with proposed amended Rule 4:

(i) provision should be made for the mention in the request of details of a parent application where a patent of addition, etc., is sought, similarly to Rule 4.1(b)(iii) dealing with parents of a continuation or continuation-in-part of an earlier application, on the understanding that the absence of such an indication could be corrected by the applicant in the national phase; Rule 4.13 should also be reviewed in this connection;

(ii) the wording of Rule 4.9(a)(i) should make it expressly clear that it is only possible to designate States which are Contracting States at the filing date of the application;

(iii) the wording of Rule 4.9(a)(ii) and (iii) should be revised to provide that the filing of the request ‘constitute’ the desired effect rather than ‘have the effect of the wish of the applicant’;

² 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 (the current texts are available on WIPO’s Web site at http://www.wipo.int/pct/en/access/legal_text.htm). 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 (see document PT/DC/47 on WIPO’s Web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

(iv) the terminology used in Rule 4.9(b) ('prior to the time of performing the acts ...' and that used in Rule 49*bis*.1 ('within the time limit applicable ...') should desirably be aligned;

(v) the wording of Rule 4.9(c) should be revised to make it clear what was the nature of the circumstances in which it would operate (that is, in cases of 'self-designation' as explained in document paragraph 12(iv) of PCT/R/WG/1/9), having regard to the provisions of the national laws affected (that is, to those of Germany, Japan and the Republic of Korea), noting that 'incompatibility' did not correctly describe those circumstances;

(vi) the request form should contain a box which would enable applicants to make exclusions of designations under Rule 4.9(c) during the transitional period during which that Rule would operate;

(vii) Rule 4.9(d) should be deleted as being unnecessary having regard to the limited and transitional nature of Rule 4.9(c).

"9. It was agreed that the present requirements in respect of indications and signature under Rules 4.5 and 4.15 should be retained. However, in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide such signature and the indications required under Rule 4.5(a) to (c) in respect of all of two or more applicants, two safeguards for applicants should be added.

"10. The first safeguard would provide that, for the purposes of Article 14(1)(a)(i), it would be sufficient that the request be signed by at least one applicant. The second safeguard would provide that, for the purposes of Article 14(1)(a)(ii), it would be sufficient that indications required under Rule 4.5(a) to (c) be provided in respect of at least one applicant who is entitled according to Rule 19 to file the international application with the receiving Office concerned.

"11. It was also agreed that, consequential to those changes, provision should be made in Rule 51*bis*.1 to permit designated Offices to require, in the national phase, the signature and required indications in respect of all applicants where those had not been provided in the international phase. In addition, to enable the receiving Office to contact a common representative appointed, or considered, under Rule 90.2, such representative should have provided the indications required under Rule 4.5(a) to (c).

"12. It was further agreed that safeguards for applicants corresponding to those provided in relation to the request should be also added in relation to the signature, and to the indications in respect of the applicant, required in the demand.

"13. While most delegations favored the simplicity of an automatic and all-inclusive designation, the Delegation of Germany drew attention to the wording of certain Articles of the Treaty which contemplate the possibility that the applicant may (for example) designate only one Contracting State (see Article 4) or choose only one form of protection (see Article 43). It was agreed that further consideration should be given to the question whether such possibilities needed to be specifically enabled by procedures available under the Regulations. In the event that they did need to be enabled, while recognizing that they might not be of great practical significance, one possibility might be the withdrawal of designations on the same day as the application

was filed and to provide that such a withdrawal be considered as the exclusion of the designations concerned.

“14. It was noted that, when an automatic and all-inclusive designation system had been adopted, future contractual arrangements between applicants and others would need to take that fact into account.

“15. It was noted that further consequential amendments would be needed to Rule 32.2(b) and (c).

“16. In connection with proposed Rule 49*bis*:

(i) in Rule 49*bis*.1(a) and (b), the reference to ‘Article 22(1) and 39(1)(a)’ should be simply to ‘Article 22,’ noting that Rule 76.5 made the provisions applicable to Chapter II;

(ii) in Rule 49*bis*.2, the words ‘a further time which shall be reasonable under the circumstances’ should be replaced by ‘at least two months from [the time of entering the national phase]’ (the wording of the latter to be aligned with that in Rules 4.9(b) and 49*bis*.1; see paragraph 8(iv), above).

“17. It was agreed that Rule 76.6 no longer had any effect and should be deleted, since all transitional reservations made under that provision had since been withdrawn.

“Automatic indication of all elections possible under the PCT

“18. The proposals contained in document PCT/R/WG/2/2, Annex II, were generally agreed, subject to the matters raised in the following paragraphs.

“19. Considering that there is no longer a need for a specific regulation for the concept of ‘later election,’ it was agreed that Rule 56 should be deleted. Consequential amendment of other Rules (such as Rule 61.2) would then also be needed.

“‘Flat’ international filing fee’

“20. The proposals contained in document PCT/R/WG/2/2, Annex III, were generally agreed, subject to the matters raised in the following paragraphs.

“21. It was agreed that further consideration should be given to the basis for calculation of the late payment fee contemplated in Rule 16*bis*.2(b), depending on the amount which might be fixed for the new flat international filing fee (see Schedule of fees, item 1).

“22. It was agreed that item 1 of the Schedule of Fees should refer to ‘each sheet of the international application.’

“‘Communication on request’ system

“23. The proposals contained in document PCT/R/WG/2/2, Annex IV, were generally agreed, subject to the matters raised in the following paragraphs.

“24. It was agreed that Rule 47 as proposed to be amended and proposed new Rule 93bis should be revised to reflect the fact that those Rules would have to operate in relation to every Article 20 communication of a copy of the international application to a designated Office, no matter how that communication was effected, be it on the basis of a standing order for systematic communication of all or a certain class of documents or on the basis of a particular order for the communication of specified documents, be it on paper, in electronic form, by physical means (mailing) or by electronic means. Different considerations applied and could lead to different approaches, noting, in particular, the possibility of effecting communications by electronic means via a central data source (‘intellectual property digital library’ (IPDL)) from which Offices would be able to ‘pull’ documents rather than have them ‘pushed’ to Offices by the International Bureau.

“25. It was agreed that further consideration should be given to the nature of the act of ‘communication,’ the operation of Article 22(1), the safeguard afforded to applicants by the last sentence of present Rule 47.1(c), against the background of the proposed communication on request system, the possibilities available for Offices to make either particular orders for the communication of particular documents or standing orders for the communication of all or a certain class of documents, and the use of the term ‘IPDL’ in the context of communication by electronic means.”

5. This document sets out revised proposals for amendment of the Regulations concerning the concept and operation of the designation system, taking into account the comments and concerns expressed by various delegations during the discussions on this matter by the Working Group, and the areas where agreement has been reached. Similar to the order of the discussions on this matter by the Working Group, revised proposals for new or amended Rules contained in this document are divided into four parts and contained in the four Annexes to this document:

Annex I: Automatic indication of all designations possible under the PCT;

Annex II: Automatic indication of all elections possible under the PCT;

Annex III: “Flat” international filing fee;

Annex IV: “Communication-on request” system.

The main general features of those proposals are outlined in the following paragraphs.

Automatic indication of all designations possible (see Annex I)

6. *All-inclusive coverage.* By filing an international application, the applicant would obtain an automatic and all-inclusive coverage of all designations available under the Treaty, including all kinds of protection as well as both national and regional patent protection, without needing, at the time of filing the application, to designate individual Contracting States, to choose certain kinds of protection or to indicate expressly whether national or regional protection is sought. Such matters would be left to be dealt with in the national phase.

7. *Limited exclusions under transitional reservation provision.* The request form would include a box enabling applicants to exclude from the automatic and all-inclusive coverage

any Contracting State which had made use of a transitional reservation provision applicable to certain States whose national law provides for the automatic withdrawal of an earlier national application if a later international application claimed priority of that earlier national application and designated the country concerned (“self-designation”).

8. *Kind(s) of protection sought.* The ability to specify certain kinds of protection sought in particular designated States would be deferred until entry into the national phase in the States concerned; if no such specification is made at that stage, the international application would be treated as an application for the grant of a patent (only). Applicants could still mention in the request, for the purposes of international search, details concerning a parent application in case of a continuation or continuation-in-part or concerning a parent application or parent grant in other cases.

9. *Withdrawal of designations.* Under the proposals, the applicant could, as at present, withdraw individual designations. While in practice there would seem to be a negligible number of cases in which applicants might wish not to designate certain States at the time of filing (apart from the possibility referred to in paragraph 7, above), Articles 4(1)(ii) and 11(1)(iii)(b) envisage, and arguably require the provision of the option for, not making all possible designations. It would be therefore be possible, although extremely unlikely in practice, for an applicant to exercise such an option by withdrawing a designation on the same day on which the international application is filed, in which case the designation of the State concerned would be considered not to have been made (see proposed Rule 90bis.6(d)).

10. *Signatures; indications concerning applicants.* The present requirements in respect of signatures and indications in respect of applicants under Rules 4.5 and 4.15 would be maintained. However, in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide such signatures and indications in respect of all applicants (where there are two or more), it would be sufficient that the request be signed by at least one applicant and that indications be provided in respect of at least one applicant who is entitled under Rule 19 to file the international application with the receiving Office concerned. However, designated Offices would be permitted to require, in the national phase, the signature and required indications in respect of any applicants who had not provided them in the international phase.

11. *Powers of attorney.* Where a sole applicant is represented by an agent, or where all co-applicants are represented by a common agent or a common representative, the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the International Bureau would be entitled to waive the requirement that a separate power of attorney be submitted. It would be for the Office, the Authority or the International Bureau, as the case may be, to decide in what circumstances the requirement would be waived. The Office, the Authority or the International Bureau would be permitted to require a separate power of attorney in particular instances even if it had waived the requirement in general. The signature of all applicants would, however, be mandatory in the case of a withdrawal under Rule 90bis or a change in the person of the applicant under Rule 92bis.

Automatic indication of all elections possible (see Annex II)

12. *All-inclusive coverage.* The same concept as for designations would be applied to elections under Chapter II; all eligible States would be considered to have been elected. The Rules containing express provisions regulating the procedure for making “later elections”

would be deleted as unnecessary, although the theoretical possibility of making later elections, as envisaged by Article 31(4)(a) and (6)(b), would not be excluded.

13. *Signatures; indications concerning applicants.* Safeguards corresponding to those provided in relation to the request (see paragraph 10, above) would be added in relation to the signature, and to the indications in respect of the applicant, required in relation to the demand.

14. *Withdrawal of elections.* Under the new approach, as at present, the applicant would be able to withdraw any or all elections. As for designations (see paragraph 9, above), and noting that Article 31(4)(a) envisages the possibility that not all eligible States may be elected, an election could theoretically be withdrawn on the same day as the demand is filed, in which case that election would be considered not to have been made (see proposed Rule 90*bis*.6(e)).

“Flat” international filing fee (see Annex III)

15. *Elimination of basic fee and designation fees.* The concept of designation fees payable in addition to the basic fee would be eliminated; instead, a flat “international filing fee” would be introduced, irrespective of the number of designations made. As a consequence of the change in the fee structure, a new international filing fee would have to be fixed. The amount of such fee would need to be determined taking into consideration the requested level of the budget resources of WIPO at the time and any related budgetary implications.

“Communication on request” system (Annex IV)

16. *Communication of documents.* The present system of “systematic communication” to a designated Office of all documents relating to international applications designating that Office would be replaced by a “communication on request” system, under which documents would be communicated to a designated Office only upon request by the Office and at the time specified by it. While it would still be possible for a designated Office to request the communication of a class or classes of documents, it would be expected that most Offices would request communications only in relation to international applications which have actually entered the national phase before them.

17. *The Committee is invited to consider the proposals contained in Annexes I to IV.*

[Annex I follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT

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¹ 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.

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Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) The request shall contain:

(i) to (iii) [No change]

~~(iv) the designation of States,~~

[COMMENT: In line with the proposed new approach of eliminating the need for individual designations of Contracting States (see, in particular, the proposed new wording of Rule 4.9(a), below) it is proposed to delete item (iv) from the list of mandatory content of the request.]

~~(iv)~~^(v) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

(b) The request shall, where applicable, contain:

(i) and (ii) [No change]

~~(iii) choices of certain kinds of protection,~~

~~(iv) an indication that the applicant wishes to obtain a regional patent,~~

[Rule 4.1(b), continued]

[COMMENT: In line with the proposed elimination of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see Rule 4.9(a)(ii) as proposed to be amended) and of the need to specify whether national and/or regional patents are sought (see Rule 4.9(a)(iii) as proposed to be amended, below), it is proposed to delete present items (iii) and (iv) from the list of mandatory contents (where applicable) of the request and to renumber present items (v) and (vi) accordingly.]

(iii) ~~(v)~~ a reference to a parent application or parent patent,

[COMMENT: As has been suggested by the Working Group (see document PCT/R/WG/2/12, paragraph 8(i), reproduced in paragraph 4 of the Introduction, above), it is proposed to retain the current requirement to include, in the request, a reference to a parent application (where the international application is a continuation or continuation in part of an earlier application) or a reference to a parent application or parent patent, parent inventor's certificate or parent utility certificate (where the applicant wishes the international application to be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition). Inclusion of such references would be for the purposes of international search, for the benefit of the International Searching Authority, and in no way would affect the operation of the designation system itself under Rule 4.9. See also Rule 4.11 as proposed to be amended, below.]

(iv) ~~(vi)~~ an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) No change

4.2 to 4.8 [No change]

4.9 *Designation of States; Kinds of Protection; National and Regional Patents*

(a) The filing of a request shall constitute:

(i) the designation of all Contracting States that are bound by the Treaty on the international filing date;

(ii) an indication that the international application is, in respect of each designated State to which Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State;

(iii) an indication that the international application is, in respect of each designated State to which Article 45(1) applies, for the grant of a regional patent and also, unless Article 45(2) applies, a national patent.

[COMMENT: This is the central provision giving effect to the proposed automatic and all-inclusive designation system outlined in the Introduction, above. Paragraph (a)(i) has been further amended so as to clarify that it is only possible to designate Contracting States that are bound by the Treaty on the international filing date (see document PCT/R/WG/2/12, paragraph 8(ii), reproduced in paragraph 4 of the Introduction, above). Paragraph (a)(ii) and (iii) have been further amended so as to simplify the wording (see document PCT/R/WG/2/12, paragraph 8(iii), reproduced in paragraph 4 of the Introduction, above).]

[Rule 4.9(a), continued]

~~Contracting States shall be designated in the request:~~

~~(i) in the case of designations for the purpose of obtaining national patents, by an indication of each State concerned;~~

~~(ii) in the case of designations for the purpose of obtaining a regional patent, by an indication that a regional patent is desired either for all Contracting States which are party to the regional patent treaty concerned or only for such Contracting States as are specified.~~

[Rule 4.9, continued]

(b) Notwithstanding paragraph (a)(i), if, on [date of adoption of these modifications by the PCT Assembly], the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request may, for as long as that national law continues to so provide, contain an indication that the designation of that State is not made, provided that the designated Office informs the International Bureau by [three months from the date of adoption of these modifications by the PCT Assembly] that this paragraph shall apply in respect of designations of that State. The information received shall be promptly published by the International Bureau in the Gazette.

~~The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:~~

~~(i) at least one Contracting State is designated under paragraph (a), and~~

~~(ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.~~

[Rule 4.9, continued]

(e) ~~[Deleted] The confirmation of any designation made under paragraph (b) shall be effected by~~

~~(i) filing with the receiving Office a written notice containing an indication as referred to in paragraph (a)(i) or (ii), and~~

~~(ii) paying to the receiving Office the designation fee and the confirmation fee referred to in Rule 15.5~~

~~within the time limit under paragraph (b)(ii).~~

[COMMENT: In line with the proposed new concept of designations, there is no need to maintain the present precautionary designation and confirmation system as provided in existing paragraphs (b) and (c). Paragraph (b) is proposed to be amended so as to provide, in the form of a transitional reservation provision, for the possibility of excluding the designation of a Contracting State if the national law of that State provides for automatic withdrawal of an earlier application in the case of “self-designation” (see paragraph 7 of the Introduction, above). It is envisaged to include in the request form a box which would enable applicants to make exclusions of designations under paragraph (b) during the transitional period during which that Rule would operate. (See document PCT/R/WG/2/12, paragraphs 8(v) and (vi), reproduced in paragraph 4 of the Introduction, above).]

4.10 [No change]

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

(a) If:

- (i) an international or international-type search has been requested on an application under Article 15(5); ~~or if~~
- (ii) the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application;
- (iii) the applicant intends to make an indication under Rule 49bis.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
- (iv) the applicant intends to make an indication under Rule 49bis.1(c) 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;

[Rule 4.11(a), continued]

the request shall so indicate and shall, as the case may be, ~~contain a reference to that fact.~~
~~Such reference shall either~~ identify the application ~~(or its translation, as the case may be)~~ in
respect of which the earlier search was made ~~by indicating country, date and number,~~ or
otherwise identify the ~~said~~ search, ~~by indicating, where applicable, date and number of the~~
~~request for such search~~ or indicate the relevant parent application or parent patent or other
parent grant.

(b) The inclusion in the request of an indication under paragraph (a)(iii) or (iv) shall
have no effect on the operation of Rule 4.9.

[COMMENT: It is proposed to amend Rule 4.11 so as to require the applicant to include in the request, in accordance with Rule 4.1(b)(iii) and (iv) as proposed to be amended (see above), an indication of the parent application or parent patent concerned where the applicant intends, when entering the national phase (see Rule 49bis), to indicate the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition, or as a continuation or continuation in part of an earlier application. Inclusion of such indications would be for the for the purposes of international search, for the benefit of the International Searching Authority, and would not affect the operation of Rule 4.9. Certain details in the present provision are proposed to be omitted and left to the Administrative Instructions or simply to the wording of the request form. See also Rule 4.1(b)(iii) and (iv) as proposed to be amended, above.]

4.12 [Deleted] ~~*Choice of Certain Kinds of Protection*~~

~~(a) If the applicant wishes his international application to be treated, in any designated State, as an application not for a patent but for the grant of any of the other kinds of protection specified in Article 43, he shall so indicate in the request. For the purposes of this paragraph, Article 2(ii) shall not apply.~~

[Rule 4.12, continued]

~~(b) In the case provided for in Article 44, the applicant shall indicate the two kinds of protection sought, or, if one of two kinds of protection is primarily sought, he shall indicate which kind is sought primarily and which kind is sought subsidiarily.~~

4.13 ~~[Deleted]~~ *Identification of Parent Application or Parent Grant*

~~If the applicant wishes his international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, he shall identify the parent application or the parent patent, parent inventor's certificate, or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph, Article 2(ii) shall not apply.~~

4.14 ~~[Deleted]~~ *Continuation or Continuation-in-Part*

~~If the applicant wishes his international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, he shall so indicate in the request and shall identify the parent application involved.~~

[COMMENT: The proposed deletion of Rules 4.12 to 4.14 is consequential on the proposed introduction of an automatic and all-inclusive coverage of all designations available under the Treaty, including all kinds of protection as well as both national and regional patent protection, without needing to designate individual Contracting States, to choose certain kinds of protection or to indicate expressly whether national or regional protection is sought).]

4.14*bis* to 4.18 [No change]

Rule 26

**Checking by, and Correcting Before, the Receiving Office of Certain Elements of the
International Application**

26.1 and 26.2 [No change]

26.2bis *Checking of Requirements Under Article 14(1)(a)(i) and (ii)*

(a) For the purposes of Article 14(1)(a)(i), if there is more than one applicant, it shall be sufficient that the request be signed by at least one of them [who is entitled according to Rule 19.1 to file the international application with the receiving Office].

(b) For the purposes of Article 14(1)(a)(ii), if there is more than one applicant, it shall be sufficient that the indications required under Rule 4.5(a) to (c) be provided in respect of at least one of them who is entitled according to Rule 19.1 to file the international application with the receiving Office [and has signed the request].

[COMMENT: As was agreed at the second session of the Working Group (see document PCT/R/WG/2/12, paragraphs 9 to 11, reproduced in paragraph 4 of the Introduction, above), in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide the signatures or the required indications of *all* of the applicants (where there are two or more), it is proposed to add the new safeguards set out in proposed new Rule 26.2bis(a) and (b). The words in square brackets have been included for discussion purposes: Do the signature and the indications provided need to be of the same applicant; do(es) the applicant(s) concerned need to have the right to file with the receiving Office? Consequential to those proposed changes, it is also proposed to permit designated Offices to require, in the national phase, the signature and required indications in respect of all applicants where those had not been provided in the international phase (see Rule 51bis.1(a) as proposed to be amended, below; see also Rule 90.2 as proposed to be amended, below).]

26.3 to 26.6 [No change]

Rule 32

Extension of Effects of International Application to Certain Successor States

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

(a) The effects of any international application whose international filing date falls in the period defined in paragraph (b) ~~are may, subject to the performance by the applicant of the acts specified in paragraph (c), be~~ extended to a State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting State designated in the international application which subsequently ceased to exist (“the predecessor State”), provided that the successor State has become a Contracting State through the deposit, with the Director General, of a declaration of continuation the effect of which is that the Treaty is applied by the successor State.

[COMMENT: In line with the proposed new approach with regard to designations, it is proposed to amend Rule 32 so as to automatically extend the effects of an international application to a successor State which has deposited a declaration of continuation under Rule 32.1(a).]

(b) [No change]

(c) Information on ~~In respect of~~ any international application whose filing date falls within the applicable period under paragraph (b) and whose effect is extended to the successor State shall be published by; the International Bureau ~~shall in the Gazette. send the applicant a notification informing him that he may make a request for extension by performing, within three months from the date of that notification, the following acts:~~

[Rule 32.1(c), continued]

~~(i) filing with the International Bureau the request for extension;~~

~~(ii) paying to the International Bureau an extension fee in Swiss francs, the amount of which shall be the same as the amount of the designation fee referred to in Rule 15.2(a).~~

[COMMENT: It is proposed to stop sending individual notifications to each applicant and instead to publish the relevant information about the extension and the international applications concerned in the Gazette.]

(d) ~~[Deleted] This Rule shall not apply to the Russian Federation.~~

[COMMENT: The proposed deletion of paragraph (d) is consequential on the proposed amendment of paragraph (a).]

32.2 *Effects of Extension to Successor State*

(a) Where the effects of the international application are extended to the successor State ~~a request for extension is made~~ in accordance with Rule 32.1,

(i) [No change]

(ii) the applicable time limit under Article 22 or 39(1) in relation to that State shall be extended until the expiration of at least six ~~three~~ months from the date of the publication of the information under Rule 32.1(c) ~~request for extension~~.

[Rule 32.2(a), continued]

[COMMENT: It appears justified to extend the time limit for national phase entry to six months from the date of the publication of the information concerning the extension and the international applications concerned since the applicant is no longer notified by the International Bureau by way of an individual notification but has to rely on the information published in the Gazette.]

~~(b) [Deleted] Where, in the case of a successor State which is bound by Chapter II of the Treaty, the request for extension was made after, but the demand was made before, the expiration of the 19th month from the priority date, and a later election is made of the successor State within three months from the date of the request for extension, the applicable time limit under paragraph (a)(ii) shall be at least 30 months from the priority date.~~

~~(b)(e)~~ The successor State may fix a time limits which expires later than that ~~those~~ provided in paragraphs (a)(ii) ~~and (b)~~. The International Bureau shall publish information on such time limits in the Gazette.

[COMMENT: The proposed deletion of present paragraph (b) is consequential on the proposed amendment of Rule 32.1(a) and the proposed elimination of the system of later elections (see Annex II). The proposed amendment of present paragraph (c) is consequential on the proposed deletion of present paragraph (b).]

Rule 48

International Publication

48.1 to 48.5 [No change]

[COMMENT: In line with the proposed new concept of eliminating the need for individual designations, the Administrative Instructions will have to be modified so as to avoid having to indicate, on each front page of the pamphlet (and in each entry in the Gazette, see Rule 86.1(a)(i) and Annex D of the Administrative Instructions), a list of all names (two-letter country codes) of all States designated in the international application concerned, noting that, in all cases, that list would always contain all States bound by the Treaty on the international filing date of the application concerned. Instead, an entry along the following lines could appear on the front page of the pamphlet: “Designated States: all States bound by the Treaty on the international filing date of this application.” In the electronic version of the PCT Gazette, the list of those States could be seen by clicking on a hyperlink; furthermore, the International Bureau would publish in each PCT Gazette a list of the Contracting States indicating the date on which each of them became bound by the Treaty. Of course, should any Contracting State make use of the transitional reservation provision under Rule 4.9(b), any exclusion of such State from the “all-inclusive” designation must also be indicated.]

48.6 *Announcing of Certain Facts*

(a) If any notification under Rule 29.1~~(a)~~(ii) reaches the International Bureau at a time later than that at which it was able to prevent the international publication of the international application, the International Bureau shall promptly publish a notice in the Gazette reproducing the essence of such notification.

[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed amendment of Rule 29.1 (see Annex III, below).]

(b) *[Remains deleted]*

(c) [No change]

Rule 49bis

Indications as to Protection Sought for Purposes of National Processing

49bis.1 Choice of Certain Kinds of Protection

(a) If the applicant wishes the international application to be treated, in a designated State in respect of which Article 43 applies, as an application not for the grant of a patent but for the grant of another kind of protection referred to in that Article, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office.

(b) If the applicant wishes the international application to be treated, in a designated State in respect of which Article 44 applies, as an application for the grant of more than one kind of protection referred to in Article 43, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall indicate, if applicable, which kind of protection is sought primarily and which kind is sought subsidiarily.

(c) In the cases referred to in paragraphs (a) and (b), if the applicant wishes the international application to be treated, in a designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition, the applicant, when performing the acts referred to in Article 22, shall indicate the relevant parent application, parent patent or other parent grant.

[Rule 49bis.1, continued]

(d) If the applicant wishes the international application to be treated, in a designated State, as an application for a continuation or a continuation-in-part of an earlier application, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall indicate the relevant parent application.

[COMMENT: See Comment on Rule 4.9(a), above. The applicant would obtain, when filing an international application, an automatic and all-inclusive coverage with regard to all kinds of protection, without the need to specify, already upon filing, which kind(s) of protection he intends to seek in any of the designated States (an indication may, however be required at the time of filing for the purposes of the international search; see Rule 4.11, above). Instead, under proposed new Rule 49bis, the applicant would be required to do so only when entering the national phase before the designated Office concerned. If the applicant does not make any choice of kind of protection, the international application will be treated as an application for the grant of a patent (only) (see Article 4(3)).]

49bis.2 Time of Furnishing Indications

(a) No designated Office shall require the applicant, before performing the acts referred to in Article 22, to furnish any indication referred to in Rule 49bis.1 or, where applicable, any indication as to whether the applicant seeks the grant of a national patent or a regional patent.

(b) Where the applicant fails to furnish an indication referred to in paragraph (a) when performing the acts referred to in Article 22, the applicant shall have an opportunity to furnish such indication within a time limit which shall be at least two months after the applicant has performed those acts. In any case, the applicant may, if so permitted by the national law of the designated State concerned, furnish such indication or, if applicable, convert from one kind of protection to another, at any later time.

[COMMENT: New Rule 49bis.2 would ensure that an applicant who does not, upon entry into the national phase, comply with the requirement to choose the kind(s) of protection sought or to identify the parent application or grant, would have another opportunity to do so. Note that there would be no obligation on the designated Office to invite the applicant to make such choice or to identify the parent application or grant. Where the applicant, after the expiration of the applicable time limit, still has not made any choice, or has not identified the parent application or grant, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)). Provisions under the applicable national law which provide for a conversion of an application for the grant of a patent into an application for the grant of another kind of protection, if any, should apply. A two-month time limit is set for furnishing a missing indication after national phase entry (see document PCT/R/WG/2/12, paragraphs 8(iv) and 16(ii), reproduced in paragraph 4 of the Introduction, above).]

Rule 51bis

Certain National Requirements Allowed Under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iv) [No change]

(v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time;

(vi) the confirmation of the international application by the signature of any applicant for the designated State who has not signed the request;

[COMMENT: The designated Office would be free to require the missing signatures on a copy of the request as originally filed or in some other way. The wording derives from that found in Article 27(2)(ii).]

[Rule 51bis.1(a), continued]

(vii) any indication required under Rule 4.5(a) to (c), in respect of any applicant who is indicated as applicant for the designated State, which was not included in the request.

[COMMENT: Notwithstanding the fact that, during the international phase, the indications required under Rule 4.5 (a) to (c) and the signature of only one applicant would be sufficient, it is proposed that the national law applicable by the designated Office may require the furnishing, after national phase entry, of any such indications and of the signature of any applicant who has not furnished such indications or has not signed the request (or a power of attorney, if the request was signed by an agent or a common representative) (see document PCT/R/WG/2/12, paragraph 11, reproduced in paragraph 4 of the Introduction, above).]

(b) to (f) [No change]

51bis.2 and 51bis.3 [No change]

Rule 76

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

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

Rules 22.1(g), 49, [49bis](#) and 51bis shall apply, provided that:

[COMMENT: It is proposed to amend Rule 76.5 so as to ensure that proposed new Rule 49bis is also applied with regard to elected Offices. Rule 76.5 is proposed to be further amended in the context of Annex IV (see below).]

(i) to (iv) [No change]

76.6 ~~[Deleted]~~ *Transitional Provision*

~~If, on July 12, 1991, Rule 76.5(iv) is not compatible with the national law applied by the elected Office in respect of claims amended under Article 19, Rule 76.5(iv) shall not apply in that respect to that elected Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.~~

[COMMENT: Rule 76.6 has no longer any effect since all transitional reservations made under this provision have since been withdrawn, and is thus proposed to be deleted (see paragraph 17, reproduced in paragraph 4 of the Introduction, above).]

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[, who has signed the request and] in respect of whom all indications required under Rule 4.5(a) to (c) have been provided may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent 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[, who has signed the request and] in respect of whom all indications required under Rule 4.5(a) to (c) have been provided shall be considered to be the common representative of all the applicants.

[COMMENT: Rule 90.2 is proposed to be amended to require an appointed or “deemed” common representative to provide the indications required under Rule 4.5(a) to (c) so as to enable receiving Offices to contact such common representative (see document PCT/R/WG/2/12, paragraph 11, reproduced in paragraph 4 of the Introduction, above). As to the text in square brackets, see the Comment on Rule 26.2*bis*, above.]

90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a)and (b) [No change]

(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 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) Where the agent or the common representative submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 or any request for the recording of a change in the person of the applicant referred to in Rule 92bis.1(a)(i), the requirement under paragraph (b) for a separate power of attorney shall not be waived under paragraph (d).

[COMMENT: Rule 90.4 is proposed to be amended to provide that any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement provided in Rule 90.4(b) that a separate power of attorney be submitted to it (see document PCT/R/WG/2/12, paragraphs 57 and 58, reproduced in paragraph 4 of the Introduction, above). It would be for the Office, the Authority or the International Bureau, as the case may be, to decide in what circumstances the requirement would be waived (for example, in cases where the agent concerned was the subject of an indication under Rule 4.7(b), or where the agent is registered to practice before the Office and subject to professional code of conduct). The Office, the Authority or the International Bureau would be permitted to require a separate power of attorney in particular instances even if it had waived the requirement in general. The signature of the applicant or of all applicants would be mandatory in the case of a withdrawal under Rule 90bis (see Rule 90bis.5 as proposed to be amended, below) or a change in the person of the applicant under Rule 92bis (see proposed new Rule 92bis.1(a-bis), below).]

Rule 90bis

Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

(a) 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 ~~Where one of the applicants~~ is considered to be the common representative under Rule 90.2(b) shall not be entitled to sign such a notice on behalf of the other applicants. ~~such notice shall, subject to paragraph (b), require the signature of all the applicants.~~

[COMMENT: See Comment on Rule 90.4, above. The second sentence of paragraph (a) is proposed to be amended for clarification purposes only.]

(b) [See Annex II]

[COMMENT: Paragraph (b) (see the proposed amendment thereof in Annex II) excuses signature in certain cases by applicants indicated as applicant/inventor for the United States of America. The Committee may wish to consider whether the operation of that paragraph should be extended to any applicant.]

90bis.6 Effect of Withdrawal

(a) to (c) [No change]

(d) Where a designation is withdrawn under Rule 90bis.2 on the same day as the international filing date, that designation shall be considered not to have been made.

(e) [See Annex II]

[COMMENT: See document PCT/R/WG/2/12, paragraph 13, reproduced in paragraph 4 of the Introduction, and paragraph 9 of the Introduction, above. See also proposed Rule 90bis.6(e) in respect of elections, in Annex II, below.]

90bis.7 [No change]

Rule 92bis

**Recording of Changes in Certain Indications
in the Request or the Demand**

92bis.1 *Recording of Changes by the International Bureau*

(a) [No change]

(a-bis) Rule 90bis.5 shall apply *mutatis mutandis* to any request for the recording of a change in the person of the applicant.

[COMMENT: See Comment on Rule 90.4, above.]

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.∴

~~(i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;~~

~~(ii) of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.~~

[Rule 92bis.1(b), continued]

[COMMENT: In the context of the proposed introduction of a new concept and operation of the designation system, it is also proposed to amend Rule 92bis. The existing time limits for the recording of a change under Rule 92bis is either 20 or 30 months from the priority date, depending on whether it is the time limit under Article 22(1) or 39(1)(a) which is applicable. That distinction has become meaningless since, following the recent modification of the time limit under Article 22(1), the time limits under Articles 22(1) and 39(1)(a) are both 30 months. Section 422 of the Administrative Instructions, providing for the details as to notifications concerning changes recorded under Rule 92bis, would also have to be modified accordingly.]

[Annex II follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

AUTOMATIC INDICATION OF ALL ELECTIONS POSSIBLE UNDER THE PCT

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¹ 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 53

The Demand

53.1 to 53.3 [No change]

53.4 *The Applicant*

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*. ~~Only applicants for the elected States are required to be indicated in the demand.~~

[COMMENT: The proposed amendment of Rule 53.4 is consequential on the proposed introduction of the new concept of automatic election of all designated Contracting States under Rule 53.7 (see below).]

53.5 and 53.6 [No change]

53.7 *Election of States*

(a) The filing of a demand shall constitute the election of all ~~indicate at least one~~ Contracting States, ~~from among those States~~ which are designated and are bound by Chapter II of the Treaty (~~“eligible States”~~), ~~as an elected State~~.

~~(b) Election of Contracting States in the demand shall be made:~~

~~(i) by an indication that all eligible States are elected, or,~~

~~(ii) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States that are elected, and, in the case of States which have been designated for the purpose of obtaining a regional patent, by an indication of the regional patent concerned together with either an indication that all eligible States party to the regional patent treaty concerned are elected or an indication of those among the said States that are elected.~~

[COMMENT: Rule 53.7 is proposed to be amended so as to align the concept of election of Contracting States with the proposed new concept of designation. The proposed new wording is necessary to ensure compliance with Article 31(4) which requires that the demand “shall indicate ... the Contracting ... States ... in which the applicant intends to use the results of the international preliminary examination.” As to the possibility of withdrawing elections on the same day as the demand is received, see paragraph 14 of the Introduction, above, and proposed Rule 90*bis*.6(e), below.]

53.8 and 53.9 [No change]

Rule 56

[Deleted] Later Elections

~~56.1—Elections Submitted Later than the Demand~~

~~(a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice submitted to the International Bureau. The notice shall identify the international application and the demand, and shall include an indication as referred to in Rule 53.7(b)(ii).~~

~~(b) Subject to paragraph (c), the notice referred to in paragraph (a) shall be signed by the applicant for the elected States concerned or, if there is more than one applicant for those States, by all of them.~~

~~(c) Where two or more applicants file a notice effecting a later election of a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the notice or could not be found or reached after diligent effort, the notice need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and~~

~~(i) a statement is furnished explaining, to the satisfaction of the International Bureau, the lack of signature of the applicant concerned, or~~

[Rule 56.1(c), continued]

~~(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or did not sign the demand but the requirements of Rule 53.8(b) were complied with.~~

~~(d) An applicant for a State elected by a later election need not have been indicated as an applicant in the demand.~~

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

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

~~56.2—Identification of the International Application~~

~~The international application shall be identified as provided in Rule 53.6.~~

~~56.3—Identification of the Demand~~

~~The demand shall be identified by the date on which it was submitted and by the name of the International Preliminary Examining Authority to which it was submitted.~~

~~56.4—Form of Later Elections~~

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

~~56.5—Language of Later Elections~~

~~The later election shall be in the language of the demand.~~

[COMMENT: Rule 56 is proposed to be deleted since there is no longer a need to regulate the procedure for making later elections (see document PCT/WG/R/2/12, paragraph 19, reproduced in paragraph 4 of the Introduction, and paragraph 12 of the Introduction, above).]

Rule 60

Certain Defects in the Demand or Elections

60.1 *Defects in the Demand*

(a) Subject to paragraph (a-bis), if ~~H~~ the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(a-bis) For the purposes of paragraph (a), if there are two or more applicants, it shall be sufficient that:

(i) the demand be signed by at least one applicant [who has the right according to Rule 54.2 to make a demand].

(ii) the indications referred to in Rule 4.5(a) to (c) as required under Rule 53.4 be provided in respect of at least one applicant who [has signed the demand and] has the right according to Rule 54.2 to make a demand.

[COMMENT: Proposed new paragraph (a-bis) would provide for safeguards for the applicants corresponding to those provided in relation to the request in proposed new Rule 26.2bis (see Annex I, above) in relation to the signature, and to the indications in respect of the applicant, required in the demand (see document PCT/R/WG/2/12, paragraph 12, reproduced in paragraph 4 of the Introduction, and paragraphs 10 and 13 of the Introduction, above). As to the text in square brackets, similar considerations apply to those mentioned in the Comment on Rule 26.2bis in Annex I, above.]

(b) to (g) [No change]

60.2 ~~[Deleted]~~ *Defects in Later Elections*

~~(a) If the notice effecting a later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Bureau at any time before a decision is taken.~~

~~(b) If the applicant complies with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had been received on the actual filing date, provided that the notice as submitted contained at least one election and permitted the international application to be identified; otherwise, the notice shall be considered as if it had been received on the date on which the International Bureau receives the correction.~~

~~(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted and the International Bureau shall so declare.~~

~~(d) Where, in respect of an applicant for a certain elected State, the signature required under Rule 56.1(b) and (c) or the name or address is lacking after the expiration of the time limit under paragraph (a), the later election of that State shall be considered as if it had not been made.~~

[COMMENT: The proposed deletion of Rule 60.2 is consequential on the proposed deletion of Rule 56 (see above).]

Rule 61

Notification of the Demand and Elections

61.1 *Notification to the International Bureau and the Applicant*

(a) and (b) [No change]

(c) ~~[Deleted] The International Bureau shall promptly notify the applicant of the receipt, and the date of receipt, of any notice effecting a later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b). Where the notice has been considered under Rule 60.2(c) as if it had not been submitted or where a later election has been considered under Rule 60.2(d) as if it had not been made, the International Bureau shall notify the applicant accordingly.~~

[COMMENT: The proposed deletion of paragraph (c) is consequential on the proposed deletion of Rule 56 (see above).]

61.2 *Notification to the Elected Offices*

(a) [No change]

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed) [and](#); the date of receipt by the International Preliminary Examining Authority of the demand, ~~and in the case of a later election the date of receipt of the notice effecting the later election. The latter date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b).~~

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed deletion of Rule 56 (see above).]

(c) [No change]

(d) [See Annex IV]

61.3 [No change]

61.4 [See document PCT/R/2/7]

[COMMENT: No change is proposed to be made to Rule 61.4 in the context of this document. See, however, changes proposed to be made to Rule 61.4 in the context of the introduction of the enhanced international search and preliminary examination system (document PCT/R/2/7). Section 431 of the Administrative Instructions, providing for the details as to which information on the demand and the elected States is to be published in the Gazette, would have to be modified so as to bring it in line with the proposed new concept of eliminating the need for individual elections and the fact that, under the proposed new approach, exclusion of elections would not any longer be possible.]

Rule 90bis

Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

(a) [See Annex I]

(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) and (ii)

(iii) 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, ~~or did not sign the later election concerned but the requirements of Rule 56.1(c) were complied with.~~

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed deletion of Rule 56 (see above). The Committee may wish to consider whether the operation of that paragraph, which excuses signature in certain cases by applicants indicated as applicant/inventor for the United States of America, should be extended to any applicant.]

90bis.6 *Effect of Withdrawal*

(a) to (c) [No change]

[\(d\)](#) [See Annex I]

[\(e\) Where an election is withdrawn under Rule 90bis.4 on the same day as that on which the demand is received, that election shall be considered not to have been made.](#)

[COMMENT: See document PCT/R/WG/2/12, paragraph 13, reproduced in paragraph 4 of the Introduction, and paragraph 14 of the Introduction, above. See also proposed Rule 90bis.6(d) in respect of designations, in Annex I, above.]

90bis.7 [No change]

[Annex III follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

“FLAT” INTERNATIONAL FILING FEE

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¹ 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 15

The International Filing Fee

15.1 *The International Filing ~~Basic Fee and Designation~~ Fee*

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau (“international filing fee”) to be collected by the receiving Office. That fee includes the fee referred to in Article 4(2). ~~and consisting of,~~

~~(i) a “basic fee,” and~~

~~(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a), except that, where Article 44 applies in respect of a designation, only one designation fee shall be due for that designation, and that the Schedule of Fees may indicate a maximum number of designation fees payable.~~

[COMMENT: In line with the new concept of eliminating the need for individual designations, it is proposed to also eliminate the need for the payment of individual designation fees and to replace both the current basic fee and the current designation fee(s) with just one flat “international filing fee,” irrespective of the number of designations made. See also Rule 27 as proposed to be amended.]

15.2 *Amounts*

(a) The amount ~~amounts~~ of the international filing ~~basic fee and of the designation~~ fee is ~~are~~ as set out in the Schedule of Fees.

[Rule 15.2, continued]

(b) The international filing ~~basic fee and the designation~~ fee shall be payable in the currency or one of the currencies prescribed by the receiving Office (“prescribed currency”), it being understood that, when transferred by the receiving Office to the International Bureau, ~~it they~~ shall be freely convertible into Swiss currency. The amount ~~amounts~~ of the international filing ~~basic fee and of the designation~~ fee shall be established, for each receiving Office which prescribes the payment of ~~that those~~ fees in any currency other than Swiss currency, by the Director General after consultation with the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as the prescribed currency. The ~~amounts~~ so established shall be the ~~equivalents~~, in round figures, of the ~~amounts~~ in Swiss currency set out in the Schedule of Fees. ~~It They~~ shall be notified by the International Bureau to each receiving Office prescribing payment in that prescribed currency and shall be published in the Gazette.

(c) Where the amount ~~amounts~~ of the international filing fee ~~fees~~ set out in the Schedule of Fees ~~is are~~ changed, the corresponding ~~amounts~~ in the prescribed currencies shall be applied from the same date as the ~~amounts~~ set out in the amended Schedule of Fees.

(d) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new ~~amounts~~ in the prescribed currency according to directives given by the Assembly. The newly established ~~amounts~~ shall become applicable two months after the date of its ~~their~~ publication in the Gazette, provided that the receiving Office referred to in the second sentence of paragraph (b) and the Director General may agree on a date falling during the said two-month period, in which case the said ~~amounts~~ shall become applicable from that date.

15.3 *[Remains deleted]*

15.4 *Time Limit for Payment; Amount Payable*

(a) The international filing basic fee shall be paid within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

~~(b) The designation fee shall be paid within a time limit of:~~

~~(i) — one year from the priority date, or~~

~~(ii) — one month from the date of receipt of the international application if that one-month period expires later than one year from the priority date.~~

~~(c) Where the designation fee is paid before the expiration of one month from the date of receipt of the international application, the amount payable shall be the amount applicable on that date of receipt. Where the time limit under paragraph (b)(i) applies and the designation fee is paid before the expiration of that time limit but later than one month from the date of receipt of the international application, the amount payable shall be the amount applicable on the date of payment.~~

15.5 [~~Deleted~~] ~~*Fees Under Rule 4.9(e)*~~

~~(a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(e) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office) equal to 50% of the sum of the designation fees payable under this paragraph. Such fees shall be payable in respect of each designation so confirmed, even if the maximum number of designation fees referred to in item 2(a) of the Schedule of Fees is already payable or if a designation fee is already payable in respect of the designation under Rule 4.9(a) of the same State for a different purpose.~~

~~(b) Where moneys paid by the applicant within the time limit under Rule 4.9(b)(ii) are not sufficient to cover the fees due under paragraph (a), the receiving Office shall allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.~~

15.6 *Refund*

The receiving Office shall refund the international [filing](#) fee to the applicant:

- (i) to (iii) [No change]

[COMMENT: The proposed amendments of Rules 15. 2 to 15.6 are consequential on the proposed elimination of the designation fee, the basic fee, and the system of confirmation of precautionary designations.]

Rule 16bis

Extension of Time Limits for Payment of Fees

16bis.1 Invitation by the Receiving Office

(a) Where, by the time they are due under Rules 14.1(c), 15.4(a) and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the [international filing basic](#) fee and the search fee, the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

(b) ~~[Deleted] Where, by the time they are due under Rule 15.4(b), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation. The amount payable in respect of any designation fee shall be the amount applicable on the last day of the one-year period from the priority date if the time limit under Rule 15.4(b)(i) applies or the amount applicable on the date of receipt of the international application if the time limit under Rule 15.4(b)(ii) applies.~~

[Rule 16bis.1, continued]

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) ~~or (b)~~ and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall, subject to paragraph (d):

(i) ~~[Deleted] allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions,~~

(ii) make the applicable declaration under Article 14(3), and

(iii) proceed as provided in Rule 29.

(d) Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) ~~or (b)~~ shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.4(a) ~~or (b)~~ or 16.1(f), as the case may be.

(e) Any payment received by the receiving Office before that Office makes the applicable declaration under Article 14(3) shall be considered to have been received before the expiration of the time limit referred to in paragraph (a) ~~or (b)~~.

16bis.2 *Late Payment Fee*

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) ~~or (b)~~ 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.

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

[COMMENT: The proposed amendments of Rule 16bis are consequential on the proposed elimination of the designation fee and the basic fee. The exact amount of the late payment fee (that is, the exact percentage of the international fee) will need to be determined in the context of fixing the amount of the international fee in item 1 of the Schedule of Fees, below (see document PCT/R/WG/2/12, paragraph 21, reproduced in paragraph 4 of the Introduction, above).]

Rule 27

Lack of Payment of Fees

27.1 *Fees*

(a) For the purposes of Article 14(3)(a), “fees prescribed under Article 3(4)(iv)” means: the transmittal fee (Rule 14), the ~~basic fee part of the~~ international [filing](#) fee (Rule 15.1~~(i)~~), the search fee (Rule 16), and, where required, the late payment fee (Rule 16*bis*.2).

(b) For the purposes of Article 14(3)(a) and (b), “the fee prescribed under Article 4(2)” means the ~~designation fee part of the~~ international [filing](#) fee (Rule 15.1~~(ii)~~) and, where required, the late payment fee (Rule 16*bis*.2).

[COMMENT: Consequential on the proposal to eliminate the need for the payment of individual designation fees (see Rule 15.1 as proposed to be amended, above).]

Rule 29

International Applications ~~or Designations~~ Considered Withdrawn

29.1 *Finding by Receiving Office*

~~(a)~~ If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iv) [No change]

~~(b) [Deleted] If the receiving Office declares under Article 14(3)(b) (failure to pay the prescribed designation fee under Rule 27.1(b)) that the designation of any given State is considered withdrawn, the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration. The International Bureau shall in turn notify each designated Office which has already been notified of its designation.~~

[COMMENT: Consequential on the proposal to eliminate the need for the payment of individual designation fees (see Rule 15.1 as proposed to be amended, above).]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 51

Review by Designated Offices

51.1 Time Limit for Presenting the Request to Send Copies

The time limit referred to in Article 25(1)(c) shall be two months computed from the date of the notification sent to the applicant under Rules 20.7(i), 24.2(c); [or](#) 29.1(a)(ii); ~~or 29.1(b).~~

[COMMENT: The proposed amendment of Rule 51.1 is consequential on the proposed amendment of Rule 29.1, above.]

51.2 and 51.3 [No change]

SCHEDULE OF FEES

Fees	Amounts
1. <u>International Filing</u> Basic Fee: (Rule 15.2(a))	[...] 650 <u>Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets</u>
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	140 Swiss francs per designation provided that any designation made under Rule 4.9(a) in excess of 6 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)*	140 Swiss francs per designation
<u>3</u> 3 . Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

3 ~~4~~. The international filing fee ~~total amount of the fees payable under items 1 and 2(a)~~ is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.

4 ~~5~~. All fees payable (where applicable, as reduced under item 3 ~~4~~) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[COMMENT: The amount of the international filing fee remains to be determined in the context of WIPO's budget. The exact amount of the late payment fee under Rule 16bis.2(b) (that is, the exact percentage of the international fee) will also need to be determined once the amount of the international fee has been fixed (see document PCT/R/WG/2/12, paragraphs 21 and 22, reproduced in paragraph 4 of the Introduction, above).]

[Annex IV follows]

* ~~Editor's Note: See Rule 15.5(a) for the confirmation fee, which is also payable.~~

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

“COMMUNICATION ON REQUEST” SYSTEM

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¹ 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 24

Receipt of the Record Copy by the International Bureau

24.1 *[Remains deleted]*

24.2 *Notification of Receipt of the Record Copy*

(a) The International Bureau shall promptly notify:

(i) to (iii) [No change]

of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the ~~States~~ designated Offices under ~~Rule 4.9(a)~~ and, in the case of a designated Office which is responsible for granting regional patents, of the Contracting States designated for such regional patent ~~where applicable, of those States whose designations have been confirmed under Rule 4.9(c).~~

[COMMENT: Rule 24.2(a) is proposed to be amended so as to bring it in line with the current practice of the International Bureau when informing the applicant about the designations made (Form PCT/IB/301).]

[Rule 24.2, continued]

(b) ~~[Deleted] Each designated Office which has informed the International Bureau that it wishes to receive the notification under paragraph (a) prior to the communication under Rule 47.1 shall be so notified by the International Bureau:~~

~~(i) if the designation concerned was made under Rule 4.9(a), promptly after the receipt of the record copy;~~

~~(ii) if the designation concerned was made under Rule 4.9(b), promptly after the International Bureau has been informed by the receiving Office of the confirmation of that designation.~~

[COMMENT: In line with the new concept of eliminating the need for individual designations and the replacement of the systematic communication of documents to designated Offices by a “communication on request” system (see proposed new Rule 93*bis*, below), it is proposed to delete paragraph (b).]

(c) [No change]

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) The communication provided for in Article 20 shall be effected by the International Bureau to each designated Office in accordance with Rule 93bis.1 but, subject to Rule 47.4, not prior to the international publication of the international application.

[COMMENT: Paragraph (a) is proposed to be amended so as to clarify the operation of that Rule in view of the proposed introduction of new Rule 93bis. See also Rule 76.5 as proposed to be amended, below.]

(a-bis) The International Bureau shall notify each designated Office, at the time when ~~of~~ the communication provided for in Article 20 is effected, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. ~~Such notification shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.~~

[COMMENT: The proposed deletion of the second sentence is consequential on the proposed introduction of new Rule 93bis. Clarification only in the first sentence.]

(a-ter) [No change]

[Rule 47.1, continued]

(b) ~~Such communication shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date.~~ Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication [provided for in Article 20](#) shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

[COMMENT: The proposed deletion of the first sentence is consequential on the proposed introduction of new Rule 93bis. Clarification only in the second sentence.]

(c) The International Bureau shall send a notice to the applicant indicating [any the](#) designated Offices to which the communication [provided for in Article 20](#) has been effected [in accordance with Rule 93bis.1](#) and the date of such communication. Such notice shall be sent on the ~~same~~ day [on which](#) as the communication [has been effected](#). ~~Each designated Office shall be informed, separately from the communication, about the sending and the date of mailing of the notice.~~ The notice shall be accepted by [all the](#) designated Offices as conclusive evidence that the communication has [been effected](#) ~~duly taken place~~ on the date specified in the notice.

[COMMENT: See Comment on paragraph (e) as proposed to be amended, below.]

(d) [No change]

[Rule 47.1, continued]

(e) Where any designated Office has not, before the expiration of the applicable time limit under Article 22, requested the International Bureau, in accordance with Rule 93bis.1, to effect the communication provided for in Article 20, the Contracting State for which that Office acts as designated Office shall be considered to have notified the International Bureau, under Rule 49.1(a-bis), that it does not require the furnishing, under Article 22, by the applicant of a copy of the international application. ~~Where any designated Office has waived the requirement provided under Article 20, the copies of the documents which otherwise would have been sent to that Office shall, at the request of that Office or the applicant, be sent to the applicant at the time of the notice referred to in paragraph (e).~~

[COMMENT: Paragraphs (c) and (e) are proposed to be amended so as to clarify the operation of those paragraphs, notably the safeguard afforded to applicants by the last sentence of present paragraph (c), under the new “communication on request” system, noting that, under proposed new Rule 93bis and Rule 89bis.3 as proposed to be amended, designated Offices can choose among the following options with regard to Article 20 communication: (i) request Article 20 communication to be effected, at the time of publication, on the basis of a “standing order” for systematic communication of pamphlets relating to all international applications in which the Office is designated; (ii) request Article 20 communication to be effected, (usually) after national phase entry, on the basis of a “particular order” for the communication of pamphlets relating to *specified* international applications in which the Office concerned is designated and which have entered the national phase before the Office; (iii) request Article 20 communication under both (i) or (ii) to be effected on paper, in electronic form or by making them available via a central data source (“intellectual property digital library” (IPDL)) from which designated Offices would be able to “pull” the pamphlets rather than have them “pushed” by the International Bureau.]

47.2 *Copies*

(a) The copies required for communication shall be prepared by the International Bureau. [Further details concerning the copies required for communication may be provided for in the Administrative Instructions.](#)

(b) ~~[Deleted] They shall be on sheets of A4 size.~~

(c) ~~[Deleted] Except to the extent that any designated Office notifies the International Bureau otherwise, copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.~~

[COMMENT: In the context of the proposed move from a “systematic communication system” to a “communication on request system” (see proposed new Rule 93*bis*, below), it is proposed to delete both paragraph (b) and (c) and to provide in the Administrative Instructions for the details concerning the way in which copies of international applications are communicated to designated Offices (on paper or in electronic form, by mail or by electronic means).]

47.3 [No change]

47.4 *Express Request Under Article 23(2)* Prior to International Publication

Where the applicant makes an express request to a designated Office under Article 23(2) prior to the international publication of the international application ~~before the communication provided for in Article 20 has taken place~~, the International Bureau shall, upon request of the applicant or the designated Office, promptly effect ~~the~~ that communication provided for in Article 20 to that Office.

[COMMENT: The proposed amendment of Rule 47.4 is consequential on the proposed amendment of Rule 47.1(a). See also Rule 61.2 as proposed to be amended, below.]

Rule 61

Notification of the Demand and Elections

61.1 [No change]

61.2 *Notification to the Elected Offices*

(a) [No change]

(b) [See Annex I]

(c) [No change]

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

[COMMENT: The proposed amendment of Rule 61.2(d) is consequential on the proposed amendment of Rule 47.1(a). See also Rule 47.4 as proposed to be amended, above.]

61.3 and 61.4 [No change]

Rule 73

**Communication of the
International Preliminary Examination Report**

73.1 [No change]

73.2 *Time Limit for Communication*

The communication provided for in Article 36(3)(a) shall be effected to each elected Office in accordance with Rule 93bis.1 ~~as promptly as possible~~ but not earlier than the communication under Article 20.

[COMMENT: The proposed amendment of Rule 73.2 is consequential on the proposed move from a system under which all documents, including copies of international preliminary examination reports, are systematically communicated to all elected Offices, to a system under which such communication would only take place upon request of the designated/elected Office concerned. See proposed new Rule 93bis, below.]

Rule 76

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 *Application of Rules 22.1(g), [47.1\(a\) and \(e\)](#), 49 and 51bis*

Rules 22.1(g), [47.1\(a\) and \(e\)](#), 49 and 51bis shall apply, provided that:

(i) to (iii) [No change]

(iv) for the purposes of Article 39(1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report;

[\(v\) the reference in Rule 47.4 to Rule 47.1\(a\) shall be construed as a reference to Rule 61.2\(d\).](#)

[COMMENT: The proposed amendment of Rule 76.5 is consequential on the proposed amendment to Rule 47.1. Note that Rule 76.5 is proposed to be further amended in the context of Annex I (see above).]

76.6 [No change]

Rule 89bis

**Filing, Processing and Communication ~~Transmission~~ of International Applications and
Other Documents in Electronic Form or by Electronic Means**

89bis.1 and 89bis.2 [No change]

89bis.3 Communication ~~Transmittal~~ *Between Offices*

Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, documents, notifications, communication, ~~s-or~~ correspondence or other document ~~to be transmitted~~ by one national Office or intergovernmental organization to another, such communication ~~transmittal~~ may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

[COMMENT: The title of Rule 89bis and the title and text of Rule 89bis.3 are proposed to be amended so as to align the terminology with that used in proposed new Rule 93bis, below.]

Rule 93bis

Manner of Communication of Documents

93bis.1 Communication on Request; Communication via Repository

(a) Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, notification, communication, correspondence or other document (“document”) by the International Bureau to any designated or elected Office, such communication shall be effected only upon request by the Office concerned and at the time specified by that Office. Such request may be made in relation to individually specified documents or a specified class or classes of documents.

(b) A communication under paragraph (a) shall, where so agreed by the International Bureau and the designated or elected Office concerned, be considered to be effected at the time when the International Bureau takes action to make the document available to that Office in electronic form in a digital library [or other repository] from which that Office is entitled to retrieve that document.

[COMMENT: In line with the proposed new concept of designations, it is proposed to move from the current communication system under which documents relating to international applications are systematically communicated to all designated/elected Offices to a system under which such communication would only be effected upon request of the designated/elected Office concerned. Since all Contracting States would always be (considered to be) designated in all international applications, and elected in all demands, each designated/elected Office would be flooded with a vast amount of documents related to international applications which may never enter the national phase before the Office concerned. Any Office which wishes to do so would be entitled to continue to request to receive all, or specified classes of, documents on a systematic basis. As to the words “or other repository” (presently in square brackets), see document PCT/R/WG/2/12, paragraph 25.]

[End of Annex IV and of document]

WIPO



PCT/R/2/7

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

Second Session
Geneva, July 1 to 5, 2002

ENHANCED INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION SYSTEM

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).
2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.¹

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

Improved coordination of international search and international preliminary examination and time limit for entering the national phase: expanded international search system

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT² relating, as recommended by the Committee, to an improved coordination of international search and international preliminary examination and time limit for entering the national phase (expanded international search system) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 69).
4. There was wide agreement at the first session of the Working Group on the general approach to be taken (see document PCT/R/WG/1/9, paragraphs 7 to 10). As stated in paragraph 8:

“The general concept of the proposed EISR [expanded international search system] attracted great interest and considerable support, subject to certain comments and concerns mentioned below. As a basic consideration, it was necessary to meet the needs of certain DOs [designated Offices] and EOs [elected Offices], particularly small and medium-sized Offices, including those in developing countries, for examiners’ opinions, especially in view of the recent adoption by the Assembly of a 30-month time limit for entering the national phase under Article 22.”

The Working Group further agreed at its first session (see document PCT/R/WG/1/9, paragraph 10):

“that the International Bureau should prepare a revised proposal, along the lines of the system outlined in the following subparagraphs [subparagraphs 10(a) to (p) of document PCT/R/WG/1/9], for consideration by the Working Group at its next session.”

5. At its second session, the Working Group considered revised proposals for an expanded international search system. The discussion by the Working Group is outlined in the summary of the session (see document PCT/R/WG/2/12, paragraphs 31 to 49):

“31. Discussions were based on documents PCT/R/WG/2/1, 1 Add.1, 9, 9 Corr., 10 and 11, particularly focusing on document PCT/R/WG/2/9, submitted by the United States of America, which proposed a simplified approach.

“32. It was agreed that the proposed amendments of the Regulations set out in the documents should be further revised, taking into account the matters mentioned in the following paragraphs:

² 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 (the current texts are available on WIPO’s Web site at http://www.wipo.int/pct/en/access/legal_text.htm). 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 (see document PT/DC/47 on WIPO’s Web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

“33. While a more extensive combination of the international search and international preliminary examination procedures would be considered in the context of long-term reform of the PCT, the separate procedures under Chapters I and II of the Treaty would be retained in the context of amending the Regulations to introduce the proposed expanded international search (EIS) system. The international preliminary examination procedure under Chapter II should continue to be initiated by the filing of a demand. The existing possibility for International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) to combine the procedures under Rule 69.1(b) would be retained.

“34. Since all ISAs would be responsible for preparing international search opinions (ISOs) which were analogous in their content to international preliminary examination reports (IPERs), the Regulations should ensure that the qualifications for appointment of an ISA include all of those which apply for appointment of an IPEA.

“35. If the applicant did not file a demand for international preliminary examination, the ISO would be re-issued as a report as part of the Chapter I procedure. The title of the report remained to be decided. Possibilities mentioned (but not agreed) during the session included: “international preliminary examination report” used in such a way as to distinguish the reports under Chapters I and II, “international initial examination report,” “international search examination report,” “international report on patentability” and “international advisory report.” Further suggestions would be welcomed by the Secretariat.

“36. Under the Chapter I procedure, the ISO would remain confidential until the report mentioned in the previous paragraph was communicated to designated Offices by the International Bureau, with the international application, 30 months from the priority date, unless the applicant expressly requested early entry into the national phase under Article 23(2) before a designated Office, in which case the report would be transmitted to that Office. The communication of international applications at the expiration of the applicable time limit under Article 22 to designated Offices of States which had made transitional reservations in connection with the modified time limit under that Article would not include the report, but the report would be sent to such Offices at the same time it was sent to Offices which had not made reservations. Once the report had been communicated, it would also be made publicly available by the International Bureau.

“37. No special provisions would be included in the Regulations for the applicant to comment on the ISO. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent to designated Offices by the International Bureau and made publicly available, as would be the report resulting from the ISO. Designated Offices would be free to require a translation of such comments. Under the Chapter II procedure, any response to the ISO would need to be submitted to the IPEA under Article 34 as part of the international preliminary examination procedure.

“38. It was not necessary to require that the same Office act as both ISA and IPEA, noting that any IPEA could, under the existing system, restrict its competence to applications in respect of which the international search had been carried out by the same Office acting as ISA.

“39. In accordance with the view of the majority of those delegations which expressed views on the matter, the ISO would, for the purposes of the international preliminary examination procedure, be considered to be the first written opinion in that procedure, on the understanding that this did not imply that the IPEA would be bound by the conclusions contained in the ISO. However, any IPEA would be entitled to inform the International Bureau that ISOs which had not been prepared by the same Office in the capacity of ISA would not be considered to be first written opinion in relation to the procedure before that IPEA; such an IPEA would then have to issue a first written opinion after receiving the demand, although that opinion could, of course, incorporate part or all of the content of the ISO.

“40. The time limit for submitting a demand for international preliminary examination would be three months after the issuance of the ISO or 22 months from the priority date, whichever was later, and the time limit for paying the necessary fees would need to be adjusted accordingly. During the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, the demand would have to be filed within 19 months from the priority date if the applicant wished to have 30 months in which to enter the national phase in those countries.

“41. Any arguments and/or amendments in response to the ISO would also have to be submitted within three months after the issuance of the ISO or 22 months from the priority date, whichever was later, if they were to be taken into account by the IPEA, failing which the IPEA would be free to proceed straight to the issuance of the international preliminary examination report, without issuing any further notification to the applicant. That time limit would apply even where the demand had been filed earlier.

“42. Several non-governmental organizations representing users of the PCT system proposed that the applicant should be guaranteed a second written opinion after filing a demand (that is, in addition to the ISO which was considered to be the first written opinion). That proposal did not find support among delegations, but it was noted that the International Preliminary Examination Guidelines, which the IPEAs were obliged to apply and observe, provide for the issuance of a further opinion where the applicant made a serious attempt to respond to a (first) written opinion.

“43. The ISO (or an accompanying form) should outline to the applicant the available options and consequences in terms of filing a demand, particularly if the same Office were not to act as both ISA and IPEA (see paragraph 39, above), time limits, responding to the matters raised in the ISO under Chapter I (by way of submitting informal comments) or Chapter II (by way of filing a demand and Article 34 arguments or amendments), etc.

“44. No change would be proposed, at least for the time being, to the time limit for the preparation of the international search report (international search report). The Delegation of the United States of America urged consideration of a relaxed time limit for the preparation of the international search report.

“45. The EIS system needed to operate simply and safely during the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, as well as in the future.

“46. Provision would be made for the International Bureau to make reports resulting under Chapter I from the ISO publicly available, together with any informal comments received, and to make IPERs publicly available on behalf of elected Offices which so request.

“47. The scope of the relevant prior art to be considered in the preparation of both the international search report and the ISO, and the basis on which prior art was cited, including the date to which the search should be carried out, would correspond to the international preliminary examination procedure.

“48. If for any reason the applicant filed a demand but the international application or the demand was subsequently withdrawn with the result that an international preliminary examination report was not issued, the report resulting from the ISO would be available to the elected Offices. That is, either an international preliminary examination report or the report resulting from the ISO would always be available to Offices in the national phase.

“49. A number of drafting points were noted by the Secretariat and would be taken into account in the preparation of revised proposals.”

6. Revised proposals for amendment of the Regulations designed to implement an enhanced international search and preliminary examination system are set out in the Annex. They take into account the comments and concerns expressed by various delegations during the discussions on this matter in the first and second sessions of the Working Group, and the areas where agreement has been reached.

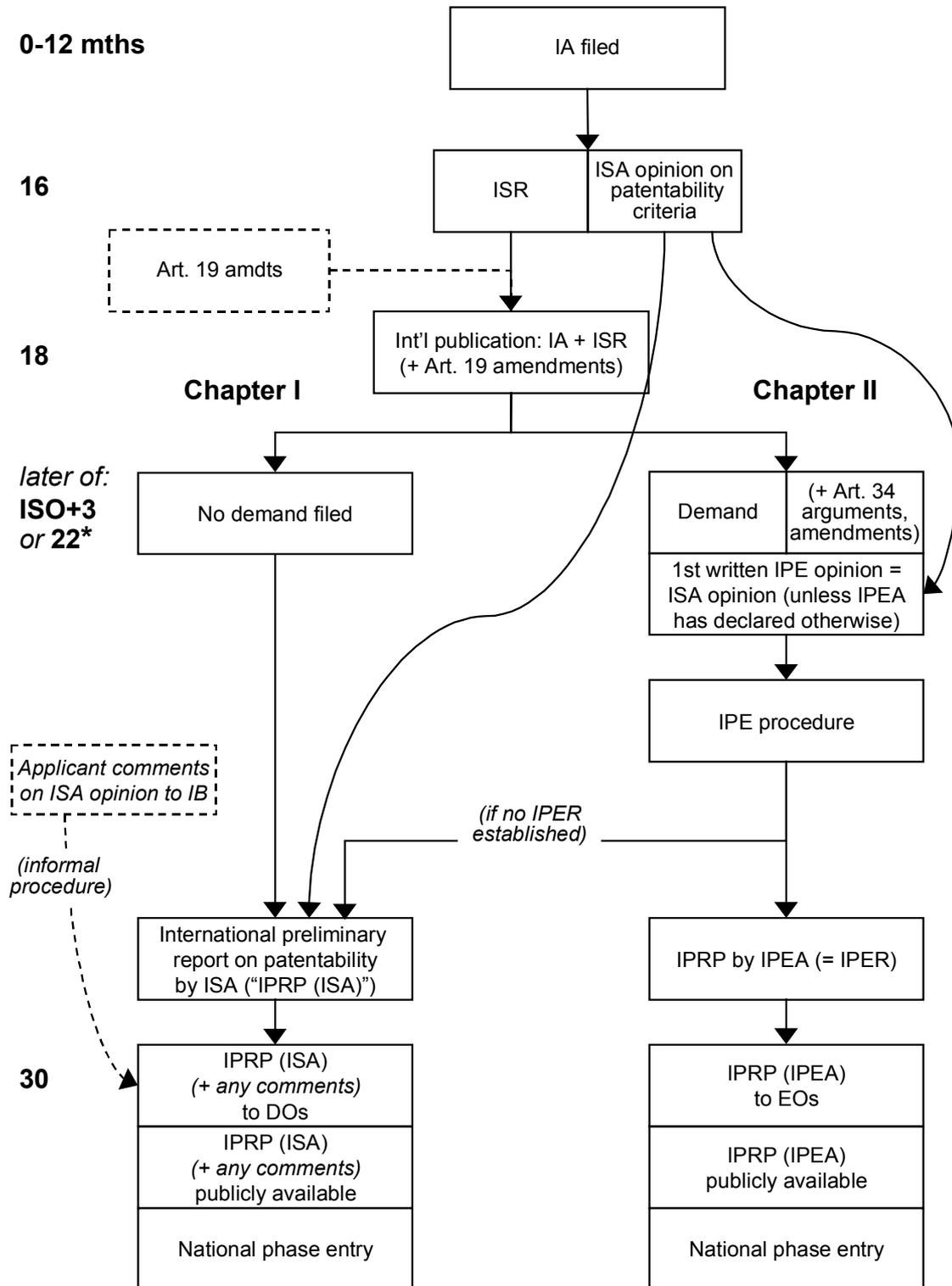
ENHANCED INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION SYSTEM

Overview

7. The flow chart on the following page illustrates the main features of the proposed enhanced international search and preliminary examination system.

8. During the discussions in the Working Group on how to improve coordination of international search (Chapter I of the Treaty) and international preliminary examination (Chapter II of the Treaty), it has been recognized that a possible merger of the procedures under Chapters I and II would only be considered in the context of long-term reform of the PCT (see document PCT/R/WG/2/12, paragraph 33). While the separate procedures under Chapters I and II would be retained, the proposed enhanced international search and preliminary examination system may be seen as an important first step towards a more extensive rationalization of the international search and international preliminary examination procedures, with a view ultimately to achieving greater convergence of the international and national procedures. The present proposals therefore strive, so far as possible, to bring the procedures under Chapters I and II into line.

Enhanced International Search and Preliminary Examination System



* must in practice file demand by 19 months for Article 22 transitional reservation countries

9. The main feature of the proposed new system is that one of the main elements of the present Chapter II procedure, namely, the establishment of an examiner's opinion, would in effect be advanced and incorporated into the Chapter I procedure. Under the new system, the International Searching Authority (ISA) would be responsible for establishing a preliminary and non-binding written opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. That written opinion of the ISA would be used for the purposes both of Chapter I and, if the applicant files a demand for international preliminary examination, of Chapter II, thus combining the international search and international preliminary examination procedures to a much greater extent than is the case at present.

10. Under Chapter I of the Treaty (that is, if no demand for international preliminary examination is made), the written opinion of the ISA would form the basis for the establishment by the International Bureau, on behalf of the ISA, of an "international preliminary report on patentability" (IPRP) to be communicated to all designated Offices and to be made available for public inspection after the expiration of 30 months from the priority date.

11. In the designated Offices, following the entry into the national phase of an international application under Chapter I of the Treaty, the proposed IPRP by the ISA would meet the need for an "examiner's opinion," of particular importance for small and medium-sized Offices, including those in developing countries, following the recent adoption by the Assembly of a 30-month time limit for entering the national phase under Article 22. Following the adoption of that changed time limit, there is the expectation that many applicants will not opt to request the international preliminary examination procedure under Chapter II of the PCT, with the result that many international applications will enter the national phase with an international search report but without any examiner's opinion.

12. The proposed IPRP by the ISA would fill that gap. The report would be equivalent to an international preliminary examination report which is established on the basis of a written opinion to which the applicant never responded, noting that, in such a case, it is the practice of International Preliminary Examining Authorities (IPEAs) to simply "convert" the written opinion into an international preliminary examination report. For the purposes of national phase processing, the IPRP by the ISA should carry the same weight as such an international preliminary examination report.

13. Under Chapter II, that is, if a demand for international preliminary examination is made, the written opinion of the ISA would, unless the IPEA specifically opts otherwise, take the place of the first written opinion established, under the present system, by the IPEA during the international preliminary examination procedure. International preliminary examination would be carried out on the basis of the international search report and the written opinion of the ISA, and would be concluded with the international preliminary examination report which, in order to stress the similarities between the report established under Chapter I and that established under Chapter II, is also proposed to bear the title "international preliminary report on patentability."

14. The main distinction between the IPRP by the ISA under Chapter I and the IPRP by the IPEA under Chapter II would be that the former would be established on the basis of the international application as filed whereas the latter would be established following a dialogue between the applicant and the examiner, often on the basis of the international application as

amended, under Article 34, in response to the international search report and the written opinion of the ISA.

15. Further details of the proposed procedure are outlined in the following paragraphs.

Procedure under Chapter I

16. *Establishment of written opinion by ISA.* With regard to every international application, the ISA would establish, at the same time that it establishes the international search report, a written opinion as to whether the international application complies with certain requirements, which would correspond directly to the matters referred to in Article 34(2)(c), that is: (i) whether the invention satisfies the criteria of novelty, inventive step and industrial applicability; and (ii) whether the international application complies with the requirements of the Treaty and the Regulations (so far as checked by the ISA). The written opinion of the ISA would also contain any other observations corresponding to those referred to in Article 35(2), last sentence. In other words, the scope of the ISA's written opinion would be similar to the written opinion established by the IPEA during international preliminary examination.

17. The relevant date for determining prior art for the purposes of establishing the written opinion would be the international filing date or, where priority of an earlier application is claimed, the priority date, as is the case for the establishment of the international preliminary examination report. Although the Working Group suggested that "[t]he scope of the relevant prior art to be considered in the preparation of both the international search report and the ISO [international search opinion], and the basis on which prior art was cited, including the date to which the search should be carried out, would correspond to the international preliminary examination procedure" (see document PCT/R/WG/2/12, paragraph 47), it is proposed upon further reflection, for the safeguard of the applicant, that the *international search* should continue to take into account prior art up to the international filing date, even if the international application claims the priority of an earlier application, and to apply the same prior art criteria as for international preliminary examination only to the establishment of the *written opinion* established by the ISA. That approach would put the written opinion of the ISA on equal footing with the written opinion of the IPEA, and should not pose any problems for examiners who are already used to taking different "relevant dates" into account for determining prior art for international search and international preliminary examination purposes.

18. The time limit for the ISA to establish the written opinion would be the same as that currently applicable for the international search report (see Rule 42.1), that is, three months from the date of receipt by the ISA of the search copy or nine months from the priority date, whichever time limit expires later. The written opinion of the ISA would be established in the language in which the international search report is established, and would be communicated, together with the international search report, to the applicant and to the International Bureau.

19. *Options for the applicant.* After having received the international search report and the written opinion of the ISA, the applicant would have a choice of the following options to pursue:

- (i) submit to the International Bureau (informal) comments on the written opinion of the ISA (see paragraphs 20 and 21, below); and/or

- (ii) submit to the International Bureau amendments of the claims under Article 19(1) (see paragraph 22, below); and/or
- (iii) request international preliminary examination (see paragraphs 30 to 39, below);

and, in addition, the applicant would always have the following options:

- (iv) withdraw the international application under Rule 90*bis*.1; or
- (v) not take any action.

20. *Informal comments on the written opinion of the ISA.* No special provisions would be included in the Regulations for the applicant to comment on the written opinion of the ISA. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent by the International Bureau to all designated Offices and made publicly available, as would be the report resulting from the written opinion of the ISA (see paragraph 26, below). Designated Offices would be free to require a translation of such comments. Any formal response to the written opinion of the ISA would need to be submitted to the IPEA under Article 34 as part of the procedure under Chapter II, that is, by requesting international preliminary examination.

21. The main purpose of allowing for informal comments to be submitted would be to give the applicant an opportunity to rebut the written opinion of the ISA in the event that international preliminary examination is not requested, noting that the written opinion of the ISA will be “converted” to an IPRP, communicated to the designated Offices and made available for public inspection (see paragraphs 26 and 29, below).

22. *Amendments of the claims under Article 19.* As at present, after the receipt of the international search report and of the written opinion of the ISA (or the declaration under Article 17.2(a)), the applicant would have the opportunity under Article 19 to amend the claims (only), within the time limit under present Rule 46.1, in particular with a view to international publication (in which the Article 19 amendments are included) and any provisional protection the applicant may enjoy under national law. There would be no reason why such amendments (to the claims only, of course) under Article 19 could not respond to matters raised in the written opinion of the ISA.

23. *International publication.* Unless the applicant withdraws the international application, the international application would, as at present, be published promptly after the expiration of 18 months from the priority date, together with the international search report and any Article 19 amendments of the claims, but without the written opinion of the ISA or any comments thereon furnished informally by the applicant. Both the written opinion of the ISA and any such comments thereon would remain confidential until a later date (see paragraphs 28 and 29, below).

24. *International preliminary report on patentability.* If no demand for international preliminary examination is made (and thus no international preliminary examination report is to be established), the International Bureau would establish, on behalf of the ISA, an IPRP with the same content as the written opinion of the ISA. That procedure would correspond to the present procedure during international preliminary examination under which the IPEA issues a written opinion which, if the applicant does not respond, is “converted” by the IPEA

into an international preliminary examination report. An IPRP by the ISA should thus carry the same weight for national phase purposes as an international preliminary examination report established at present in that way (see paragraph 12, above).

25. The proposed title “international preliminary report on patentability” would not be in conflict with Article 35(2). The report would not “contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable *according to any national law*” (emphasis added); rather, the report would be limited to a statement, in relation to each claim, whether the claimed appears to satisfy the criteria of novelty, inventive step and industrial applicability as defined for the purposes of the international phase under the PCT (see Article 33 and Rules 64 and 65).

26. *Communication to designated Offices.* The International Bureau would communicate the IPRP by the ISA and any (informal) comments on the written opinion of the ISA furnished by the applicant to all designated Offices, but not before the expiration of 30 months from the priority date (see paragraphs 28 and 29, below). Where the applicant makes an express request for early national phase entry before a designated Office before the expiration of 30 months from the priority date, the International Bureau would, if the IPRP has not yet been established, communicate a copy of the written opinion by the ISA to that Office (the content of which would, of course be identical to the subsequently produced IPRP).

27. *Translation of IPRP.* As for an international preliminary examination report at present, the IPRP by the ISA, when communicated to the any designated Office, if not in English, would, if requested by that Office, be accompanied by a translation into English prepared by or under the responsibility of the International Bureau. The applicant would have an opportunity to submit observations on the translation. As is the case for international preliminary examination reports, an IPRP in English or translated into English would have to be accepted by all designated Offices for the purposes of national phase processing, and no designated Office would be entitled to require the applicant to furnish a translation of the IPRP into any other language.

28. *Confidentiality of written opinion, IPRP, translation and comments.* As indicated above, the written opinion of the ISA, the IPRP by the ISA, any translation thereof and any comments on the written opinion of the ISA submitted by the applicant would remain confidential as against third parties and designated Offices until 30 months from the priority date, corresponding to the time at which the file of the international preliminary examination presently becomes available for public inspection (via the elected Offices).

29. After the expiration of 30 months from the priority date, the IPRP by the ISA, any translation into English thereof and any comments on the written opinion of the ISA submitted by the applicant would be communicated to all designated Offices. At the same time, the written opinion of the ISA, the IPRP, any translation into English thereof and any comments on the written opinion of the ISA submitted by the applicant would be made available for public inspection by the International Bureau. Public inspection would be possible even where a demand for international preliminary examination has been made, noting that third parties would, in any case, get access to those documents, once the international preliminary examination report has been established, via elected Offices.

Procedure under Chapter II

30. *Demand for international preliminary examination.* The international preliminary examination procedure under Chapter II would continue to be initiated by the filing of a demand. The existing possibility for ISAs and IPEAs to combine the procedures under Rule 69.1(b) would be retained.

31. The time limit for making a demand for international preliminary examination would be three months after the issuance of the international search report and the written opinion of the ISA or of the declaration under Article 17.2(a), or 22 months from the priority date, whichever is later. Any demand made after the expiration of the applicable time limit would be considered as if it had not been submitted and the IPEA would so declare. During the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 are still in force, the demand would have to be filed within 19 months from the priority date if the applicant wished to have 30 months in which to enter the national phase in those countries.

32. *International preliminary examination procedure.* As at present, if the applicant files a demand for international preliminary examination, the further processing of the international application would be governed by Chapter II.

33. Upon receipt of a demand or a copy thereof from the IPEA, the International Bureau would transmit to the IPEA copies of the written opinion of the ISA (unless the same Office is acting as both ISA and IPEA). Any comments on the written opinion of the ISA submitted (informally) by the applicant to the International Bureau (see paragraph 20 and 21, above) would not be communicated to the IPEA; rather, any response to the written opinion of the ISA would need to be submitted by the applicant to the IPEA under Article 34 as part of the international preliminary examination procedure.

34. Upon the request of the IPEA, where the written opinion of the ISA is not in English or in a language accepted by the IPEA, a translation into English of the written opinion of the ISA would be prepared by the International Bureau and transmitted to the IPEA within two months following the request for translation. All IPEAs would be required to accept such written opinions established in or translated by the International Bureau into English.

35. *Written opinion of ISA considered to be written opinion for the purposes of international preliminary examination.* In general, the written opinion of the ISA would be considered to be a written opinion for the purposes of international preliminary examination (see paragraph 37, below, with regard to the exception from this general rule). Any arguments and/or amendments in response to the written opinion of the ISA would have to be submitted within the same time limit as the time limit for making the demand, that is, three months after the issuance of the written opinion of the ISA or 22 months from the priority date, whichever was later, if they are to be taken into account by the IPEA, failing which the IPEA would be free to proceed straight to the issuance of the international preliminary examination report without issuing any further notification to the applicant. That time limit would apply even where the demand had been filed earlier. Indications informing the applicant that, if a demand for international preliminary examination is made, the written opinion of the ISA will be considered to be a written opinion of the IPEA (except in the case outlined in paragraph 37, below) and an invitation to submit, within the applicable time limit, a written reply together, where appropriate, with amendments, would be included in the written opinion of the ISA submitted to the applicant.

36. The IPEA would not be obliged to issue a further written opinion, in addition to the written opinion of the ISA, before establishing the international preliminary examination report. However, if the applicant makes a serious attempt to meet the (search) examiner's objections by submitting, within the applicable time limit, arguments and/or amendments in response to the written opinion of the ISA, the International Preliminary Examination Guidelines, which the IPEAs are obliged to apply and observe in corresponding cases at present, require that "if there are still objections that require to be met, the examiner must consider, subject to sufficient time being available having regard to the time limit for the establishment of the international preliminary examination report ... whether they could best be resolved by a further written opinion, a telephone discussion or an interview."

37. *IPEA may decide not to accept written opinions of other ISAs for the purposes of international preliminary examination.* While, in general, the written opinion of the ISA would be considered to be a written opinion for the purposes of international preliminary examination, any IPEA would be entitled to inform the International Bureau that a written opinion of the ISA which had not been prepared by the same Office in its capacity as an ISA would not be considered to be first written opinion in relation to the procedure before that IPEA. Such an IPEA would be obliged to notify the applicant accordingly, and the normal international preliminary examination procedure (as at present) would apply, although the IPEA would in any event be obliged to take the content of the written opinion of the ISA into account. As at present, the applicant would be entitled to receive one written opinion from the IPEA (in addition to the written opinion of the ISA), with the opportunity to submit arguments and/or amendments under Article 34.

38. *International preliminary report on patentability.* In the context of introducing the enhanced international search and preliminary examination system, it is proposed to entitle the international preliminary examination report as an "international preliminary report on patentability" so as to stress the similarities between the report established under Chapter I and that established under Chapter II. As explained in paragraph 25, above, this proposed title would not be in conflict with Article 35(2).

39. *Communication of IPRP to elected Offices.* The IPRP by the IPEA would be established within the applicable time limit under Rule 69 (that is, usually within 28 months from the priority date) and communicated by the IPEA to the applicant and to the International Bureau. As is the case for the communication to all designated Offices of the IPRP by the ISA, the International Bureau would communicate the IPRP by the IPEA to all elected Offices, but not before the expiration of 30 months from the priority date. Where the applicant makes an express request for early national phase entry before an elected Office before the expiration of 30 months from the priority date, the International Bureau would if the international preliminary examination report has not yet been established, communicate a copy of the written opinion by the ISA to that Office.

Guidelines for international search and preliminary examination

40. If the proposed enhanced system is adopted, the PCT International Search Guidelines and PCT International Preliminary Examination Guidelines would have to be modified accordingly, with a view to implementing the amendments of the Regulations proposed in the Annex to this document and to merging both Guidelines into a single set of Guidelines addressed to the International Searching and Preliminary Examining Authorities, which would be responsible, in future, for conducting the international search and international preliminary examination in a more coordinated way than at present.

National phase processing

41. *Communication of IPRP to designated and elected Offices.* In general, national phase processing before any designated or elected Office would not change as compared to today's situation. Any designated or elected Office would receive from the International Bureau, promptly after the expiration of 30 months from the priority date, a copy of an IPRP, established by either the ISA or the IPEA, as applicable, together with, if necessary, a translation into English, and a copy of any comments submitted informally to the International Bureau by the applicant on the written opinion of the ISA. The content of the file of the international preliminary examination, which would include the written opinion of the ISA, would be available to any elected Office from the IPEA (see present Rule 94.2).

42. *Public inspection (Chapter I).* A copy of the written opinion of the ISA and of any comments thereon submitted informally by the applicant to the International Bureau, of the IPRP by the ISA and any translation thereof into English, and of any observations on the translation submitted by the applicant, would be made available, after the expiration of 30 months from the priority date, to any person as part of the file held by the International Bureau (see present Rule 94.1).

43. *Public inspection (Chapter II).* As at present, access by third parties to the international preliminary examination report (and other parts of the file of the IPEA) would be available via any elected Office whose national law provides for such access (see present Rule 94.3). In the context of introducing the enhanced international search and preliminary examination system, it is now proposed to amend Rule 94.3 to provide for the International Bureau to make the international preliminary examination report available on behalf of any elected Office which so requests.

Demand filed at the same time as the filing of the international application

44. In the context of introducing the enhanced international search and preliminary examination system, it is proposed to enable the applicant to submit the demand at the same time as the filing of the international application or at any time thereafter prior to the expiration of the time limit for filing the demand (see paragraph 30, above). In order to enable the applicant to do so, it is proposed to postpone the due date for the payment of the handling fee and the preliminary examination fee (at present, one month from the date of filing of the demand) and to provide that those fees only fall due within one month from the date of filing of the demand or 22 months from the priority date, whichever expires later (see, however, paragraph 45, below), with the same invitation procedure and further extension of the time limit for payment as applies at present if the fees are not paid (in full). Of course, international preliminary examination procedures would only start if the applicant pays in full, within the applicable time limit, the amount due for the handling fee and the preliminary examination fee, including, where applicable, a late payment fee.

45. As an exception to the general rule that the handling fee and the preliminary examination fee fall due within one month from the date of filing of the demand or 22 months from the priority date, whichever expires later (see paragraph 44, above), it is proposed to set an earlier due date for the payment of those fees where the IPEA is part of the same national Office or intergovernmental organization as the ISA and wishes to start the international preliminary examination at the same time as the international search. In such a case, the IPEA would be required to invite the applicant to pay those fees within one month from the

date of the invitation. Otherwise, no special provision has been included at this stage which would introduce new possibilities for a combination of international search and international preliminary examination, beyond what is envisaged in present Rule 69.1(b); present Rule 69.1(b) appears sufficient to enable an IPEA to start the international preliminary examination at the same time as the international search.

46. The Committee is invited to consider the proposals contained in the Annex.

[Annex follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹ENHANCED INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION SYSTEM

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¹ 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.

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Rule 36

Minimum Requirements for International Searching Authorities

36.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 16(3)(c) shall be the following:

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

[COMMENT: Rule 36.1 is proposed to be amended so to ensure that the qualifications for appointment of an ISA (in charge of establishing the written opinion established under Chapter I) include all of those which apply for appointment of an IPEA (see Rule 63.1) (see document PCT/R/WG/2/12, paragraph 34). Rule 63.1 is also proposed to be amended accordingly (see below).]

Rule 43bis

Written Opinion of the International Searching Authority

43bis.1 Written Opinion

(a) Subject to Rule 69.1(b-bis), the International Searching Authority shall, at the same time as it establishes the international search report, establish a written opinion as to:

(i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;

(ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

[COMMENT: See paragraph 16 in the Introduction to this document. The scope of the written opinion of the ISA would be similar to the present written opinion established as part of the international preliminary examination procedure. Proposed new Rule 43bis.1 has been made subject to proposed new Rule 69.1(b-bis) (see below): where the national Office or intergovernmental organization that acts as ISA is also acting as IPEA and wishes, in accordance with Rule 69.1(b), to carry out international preliminary examination at the same time as international search, and considers that all the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization Author need not, in its capacity as ISA, establish a written opinion under Rule 43bis.1 but may proceed to issue the international search report and the (positive) international preliminary examination report.]

[Rule 43bis.1, continued]

(b) For the purposes of establishing the written opinion, Article 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.2(a), (b) and (c), 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: As regards the relevant date for determining prior art, note that, for the purposes of establishing the written opinion of the ISA, reference is made to Rule 64 rather than to Rule 33 (see paragraph 17 of the Introduction to this document). As regards the list of Articles and Rules to be applied *mutatis mutandis*, while the scope and contents of the written opinion of the ISA would be similar to the present first written opinion in the international preliminary examination procedure, it appears more appropriate to refer to the corresponding provisions concerning the international preliminary examination report rather than to the provisions concerning the written opinion under Chapter II, since the written opinion of the ISA, as a document to be sent to the applicant separate from the international search report, appears to be, from a formal point of view, closer to an international preliminary examination report-style “report” than to a written notification containing certain negative statements as listed in Rule 66.2. This also would appear to reflect the current practice under which the IPEAs send out, as the written opinion, a first draft of the international preliminary examination report which contains more information than is required under Rule 66.2 (for example, not only a negative statement as referred to in Rule 66.2(a)(ii) but a full statement similar to the full international preliminary examination report as referred to in Rule 70.6).]

(c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under Rule 66.1bis(a) but subject to Rule 66.1bis(b), be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a), in which case the applicant is invited to submit to that Authority, with the demand or in any event before the expiration of the time limit under Rule 54bis.1(a), a written reply together, where appropriate, with amendments.

[COMMENT: See paragraphs 35 and 36 of the Introduction to this document. A notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion of the ISA will be considered to be a written opinion of the IPEA (except where the IPEA has made a declaration under Rule 66.1bis(b), see below) and an invitation to submit, within the applicable time limit, a written reply together, where appropriate, with amendments, would be included in the written opinion of the ISA submitted to the applicant.]

Rule 44

Transmittal of the International Search Report, Written Opinion, Etc.

44.1 *Copies of Report or Declaration and Written Opinion*

The International Searching Authority shall, on the same day, transmit one copy of the international search report and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a), to the International Bureau and one copy to the applicant.

[COMMENT: See paragraph 18 of the Introduction to this document.]

44.2 and 44.3 [No change]

Rule 44bis

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

44bis.1 Establishment of Report

(a) Unless an international preliminary examination report has been or is to be established, the International Bureau shall establish 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 43bis.1(a)(i) to (iii). The report shall have the same contents as the written opinion established under Rule 43bis.1.

(b) The report shall bear the title “international preliminary report on patentability” together with an indication that it is established under this Rule by the International Searching Authority.

[COMMENT: See paragraphs 24 and 25 of the Introduction to this document.]

44bis.2 Communication to Designated Offices

(a) Where a report has been established under Rule 44bis.1, the International Bureau shall communicate it to each designated Office in accordance with Rule 93bis.1 but not before the expiration of 30 months from the priority date.

[COMMENT: See paragraph 26 of the Introduction to this document.]

(b) Where the applicant makes an express request to a designated Office under Article 23(2), the International Bureau shall communicate a copy of the written opinion established by the International Searching Authority under Rule 43bis.1 to that Office promptly upon the request of that Office or of the applicant.

[COMMENT: While, in “normal” cases, the IPRP by the ISA is communicated to any designated Office not before the expiration of 30 months from the priority date, where the applicant makes a request for early national phase entry before a designated Office before the that report is established, it is proposed to communicate to that Office a copy of the written opinion of the ISA (the content of which would be identical to any IPRP by the ISA).]

44bis.3 Translation for Designated Offices

(a) Any designated State may, where the report has been established in a language other than the official language, or one of the official languages, of its national Office, require a translation of the report into English. Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

(b) If a translation is required under paragraph (a), it shall be prepared by or under the responsibility of the International Bureau.

(c) The International Bureau shall transmit a copy of the translation to any interested designated Office and to the applicant at the same time as it communicates the report to that Office.

[COMMENT: See paragraph 27 in the Introduction to this document.]

44bis.4 Observations on the Translation

The applicant may make written observations as to the correctness of the translation referred to in Rule 44bis.3 and shall send a copy of the observations to each of the interested designated Offices and to the International Bureau.

[COMMENT: See paragraph 27 in the Introduction to this document.]

Rule 44ter

Confidential Nature of Written Opinion, Report, Translation and Observations

44ter.1 Confidential Nature

(a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:

(i) subject to Rules 44bis.2(b), 62.1(i) and 73.2(b), to the written opinion established under Rule 43bis.1;

(ii) if a report is established under Rule 44bis.1, to that report, to any translation of it prepared under Rule 44bis.3(b) or to any written observations on that translation sent by the applicant under Rule 44bis.3(d).

[COMMENT: See paragraphs 28 and 29 in the Introduction to this document. Item (i) of paragraph (a) is subject to Rules 44bis.2(b) and 73.2(b) (communication of the written opinion of the ISA to any designated or elected Office, before the expiration of 30 months from the priority date, in case of early national phase entry under Chapter I and Chapter II, respectively) and subject to Rule 62.1(i) (communication of the written opinion of the ISA to the IPEA, before the expiration of 30 months from the priority date, where a demand for international preliminary examination has been made).]

(b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.

[COMMENT: The wording of paragraph (b) is modeled after Article 30(4).]

Rule 54bis

Time Limit for Making a Demand

54bis.1 Time Limit for Making a Demand

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a); or

(ii) 22 months from the priority date.

(b) Any demand made after the expiration of the time limit applicable under paragraph (a) shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

[COMMENT: See paragraph 31 in the Introduction to this document.]

Rule 57

The Handling Fee

57.1 and 57.2 [No change]

57.3 *Time Limit for Payment; Amount Payable*

(a) Subject to paragraphs (b) and (c), the ~~The~~ handling fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later., ~~provided that,~~

[COMMENT: See paragraph 44 of the Introduction to this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

(b) Subject to paragraph (c), where ~~Where~~ the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the handling fee shall be paid within one month from the date of receipt by that Authority or 22 months from the priority date, whichever expires later.

[COMMENT: See paragraph 44 of the Introduction to this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

[Rule 57.3, continued]

(c) Where, in accordance with Rule 69.1(b), the International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search, that Authority shall invite the applicant to pay the handling fee within one month from the date of the invitation.

[COMMENT: See paragraph 45 of the Introduction to this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

(d) The amount of the handling fee payable shall be the amount applicable on the date of payment ~~that date of submittal or date of receipt, as the case may be. For the purposes of the preceding two sentences, Rule 59.3(e) shall not apply.~~

[COMMENT: The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

57.4 and 57.5 *[Remain deleted]*

57.6 *Refund*

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

- (i) [No change]
- (ii) if the demand is considered, under Rule 54.4 or 54bis.1(b), not to have been submitted.

Rule 58bis

Extension of Time Limits for Payment of Fees

58bis.1 Invitation by the International Preliminary Examining Authority

(a) Where, ~~by the time they are due under Rules 57.3 and 58.1(b),~~ the International Preliminary Examining Authority finds: ~~that no fees were paid to it, or~~

(i) that the amount paid to it is insufficient to cover the handling fee and the preliminary examination fee; ~~or~~

(ii) ~~by the time they are due under Rules 57.3 and 58.1(b), that no fees were paid to it;~~

the Authority shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 58bis.2, within a time limit of one month from the date of the invitation.

[COMMENT: The proposed change appears necessary for two reasons: (i) to clarify that the finding whether the amount paid is insufficient to cover the handling fee and the preliminary examination fee needs to be done already upon receipt of any amount intended to cover those fees and not only at the time fees are due (which may be as late as 20 months from the priority date); and (ii) to clarify that no invitation to pay fees should be send out to the applicant where the applicant has filed the demand early (say, at the same time as the international application) but where the fees are not yet due (in such a case, they would not be due before the expiration of 20 months from the priority date).]

(b) to (d) [No change]

58bis.2 [No change]

Rule 59

The Competent International Preliminary Examining Authority

59.1 and 59.2 [No change]

59.3 *Transmittal of Demand to the Competent International Preliminary Examining Authority*

(a) and (b) [No change]

(c) Where the demand is transmitted to the International Bureau under paragraph (a) or submitted to it under paragraph (b), the International Bureau shall promptly:

(i) [No change]

(ii) if two or more International Preliminary Examining Authorities are competent, invite the applicant to indicate, within [the time limit applicable under Rule 54bis.1\(a\) or](#) 15 days from the date of the invitation ~~or 19 months from the priority date~~, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

[COMMENT: Proposed amendment of item (ii) of paragraph (c) is consequential on the introduction of new time limit for the filing of a demand under proposed new Rule 54bis.1(a) (see above).]

(d) to (f) [No change]

Rule 61

Notification of the Demand and Elections

61.1 to 61.3 [No change]

[COMMENT: No change is proposed to Rule 61.1 in the context of this document. Note, however, that it is proposed to delete Rule 61.1(c) in the context of document PCT/R/2/6.]

61.4 *Publication in the Gazette*

~~Where a demand has been filed before the expiration of 19 months from the priority date, the~~ The International Bureau shall, promptly after the filing of the demand but not before the international publication of the international application, publish in the Gazette information on the demand and the elected States concerned, as provided in the Administrative Instructions.

[COMMENT: Proposed amendment of Rule 61.4 is consequential on the proposed introduction of new Rule 54bis and the fact that any demand made after the expiration of the applicable time limit under that Rule is considered not to have been made. Even following the recent change of the time limit under Article 22(1) from 20 to 30 months, the Rule still serves a purpose in that it requires the International Bureau to publish information on the fact that a demand for international preliminary examination has been filed, thereby informing the public that an international preliminary examination report will become available in respect of the international application concerned. Section 431 of the Administrative Instructions, providing for the details as to which information on the demand and the elected States is to be published in the Gazette, would also have to be modified.]

Rule 62

**Copy of Written Opinion by International Searching Authority and of Amendments
Under Article 19 for the International Preliminary Examining Authority**

62.1 *Copy of Written Opinion by International Searching Authority and of Amendments
Made Before the Demand Is Filed*

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

(i) a copy of the written opinion established under Rule 43bis.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and

(ii) a copy of any amendments under Article 19, and any statement referred to in that Article, ~~to that Authority,~~ unless that Authority has indicated that it has already received such a copy.

[COMMENT: See paragraph 33 of the Introduction to this document.]

62.2 [No change]

Rule 62bis

**Translation for International Preliminary Examining Authority
of Written Opinion of International Searching Authority**

62bis.1 Translation and Observations

(a) Upon request of the International Preliminary Examining Authority, the written opinion established under Rule 43bis.1 shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau.

(b) The International Bureau shall transmit a copy of the translation to the International Preliminary Examining Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

(c) The applicant may make written observations as to the correctness of the translation and shall send a copy of the observations to the International Preliminary Examining Authority and to the International Bureau. The International Preliminary Examining Authority may take such observations into account.

[COMMENT: See paragraph 34 of the Introduction to this document.]

Rule 63

**Minimum Requirements for
International Preliminary Examining Authorities**

63.1 Definition of Minimum Requirements

The minimum requirements referred to in Article 32(3) shall be the following:

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iii) that Office or organization must hold an appointment as an International Searching Authority.

[COMMENT: Rule 63.1 is proposed to be amended so to ensure that the qualifications for appointment of an International Preliminary Examining Authority include all of those which apply for appointment of an International Searching Authority (see Rule 36.1) (see document PCT/R/WG/2/12, paragraph 34). Rule 36.1 is also proposed to be amended accordingly (see above).]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 [No change]

66.1bis *Written Opinion of the International Searching Authority*

(a) Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43bis.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

[COMMENT: See paragraphs 35 and 36 of the Introduction to this document.]

(b) An International Preliminary Examination Authority may notify the International Bureau that paragraph (a) shall not apply to the procedure before it in respect of written opinions established under Rule 43bis.1 by the International Searching Authority or Authorities specified in the notification, provided that such a notification shall not apply to cases where the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority. The International Bureau shall promptly publish any such notification in the Gazette.

[COMMENT: See paragraph 37 of the Introduction to this document.]

[Rule 66.1bis, continued]

(c) Where the written opinion established by the International Searching Authority under Rule 43bis.1 is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of this paragraph, the International Preliminary Examining Authority shall notify the applicant accordingly in writing.

(d) A written opinion established by the International Searching Authority under Rule 43bis.1 which is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a) shall nevertheless be taken into account by the International Preliminary Examining Authority in proceeding under Rule 66.2(a).

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

(a) to (c) [No change]

(d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall not be more than three months after the said date.

(e) The time limit for replying to the notification ~~but~~ may be extended if the applicant so requests before its expiration.

[COMMENT: Paragraph (d) is proposed to be amended and new paragraph (e) proposed to be added so as to clarify that paragraph (e) applies to both the notification under paragraph (d) and the notification under proposed new Rule 43bis.1(c) (see also proposed new Rule 43bis.1(b), which includes a reference to Rule 66.2(e)).]

66.3 to 66.9 [No change]

Rule 69

Start of and Time Limit for International Preliminary Examination

69.1 *Start of International Preliminary Examination*

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession ~~both~~ of all of the following:

- (i) the demand; ~~and~~
- (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2; and
- (iii) ~~of~~ either the international search report and the written opinion established under Rule 43bis.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established;

provided that the International Preliminary Examination Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54bis.1(a) unless the applicant expressly requests an earlier start.

[Rule 69.1, continued]

[COMMENT: Paragraph (a) is proposed to be amended so as to clarify that the IPEA must start the international preliminary examination procedure only after having received the demand, the fees due and either the international search report and the written opinion of the ISA or the declaration under Article 17(2)(a), and that it must not start before the expiration of the time limit under Rule 54bis(a), that is, before the expiration of 3 months from the date of transmittal to the applicant of the written opinion or 22 months from the priority date, whichever expires later. The latter provision is intended to ensure that the IPEA, after the filing of a demand does not proceed straight to the issuance of an international preliminary examination report (in particular in cases where the demand has been filed early with regard to Article 22 transitional reservation countries) without giving the applicant sufficient time to respond to the international search report and the written opinion of the ISA.]

(b) If the ~~competent International Preliminary Examining Authority is part of the same~~ national Office or intergovernmental organization that acts as ~~the competent~~ International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization ~~the International Preliminary Examining Authority~~ so wishes and subject to paragraphs (d) and (e), start at the same time as the international search.

(b-bis) Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization need not, in its capacity as International Searching Authority, establish a written opinion under Rule 43bis.1.

[COMMENT: See comment on proposed new Rule 43bis.1, above.]

(c) [No change]

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:

(i) it has received a copy of any amendments made under Article 19~~;~~

(ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19~~;~~ or

(iii) the expiration of the applicable time limit under Rule 54bis.1(a). ~~20 months from the priority date,~~

~~whichever occurs first.~~

[COMMENT: Proposed amendment of paragraph (d)(iii) is consequential on proposed new Rule 54bis.1(a); the first sentence of paragraph (d) is proposed to be amended for clarification purposes only.]

(e) [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

- (i) 28 months from the priority date~~;~~ or
- (ii) six eight months from the time provided under Rule 69.1 for the start of the international preliminary examination; ~~date of payment of the fees referred to in Rules 57.1 and 58.1(a);~~ or
- (iii) six eight months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2~~;~~

~~whichever expires last.~~

[COMMENT: Proposed amendment of items (i) to (iii) of Rule 69.2 is consequential on the introduction of a new time limit for filing the demand under Rule 54*bis*.1(a); the first sentence of Rule 69.2 is proposed to be amended for clarification purposes only.]

Rule 70

**International Preliminary Report on Patentability by
the International Preliminary Examining Authority**
~~The~~ (International Preliminary Examination Report)

70.1 to 70.14 [No change]

70.15 *Form; Title*

(a) The physical requirements as to the form of the report shall be prescribed by the Administrative Instructions.

(b) The report shall bear the title “international preliminary report on patentability” together with an indication that it is the international preliminary examination report established by the International Preliminary Examining Authority.

[COMMENT: See paragraphs 25 and 38 of the Introduction to this document.]

70.16 and 70.17 [No change]

Rule 72

Translation of the International Preliminary Examination Report

72.1 and 72.3 [No change]

72.3 Observations on the Translation

The applicant may make written observations as to the correctness of ~~on what, in his opinion, are errors of translation in~~ the translation of the international preliminary examination report and shall send a copy of the ~~any such~~ observations to each of the interested elected Offices and ~~a copy~~ to the International Bureau.

[COMMENT: Rule 72.3 is proposed to be amended for clarification purposes only and so as to align the wording used in Rule 72.3 with the wording used in proposed new Rule 44bis.4 (see above).]

Rule 73

**Communication of the International Preliminary Examination Report
or the Written Opinion of International Searching Authority**

73.1 [No change]

73.2 ~~Time Limit for~~ Communication to Elected Offices

(a) The International Bureau shall effect the communication provided for in Article 36(3)(a) to each elected Office in accordance with Rule 93bis.1 but not before the expiration of 30 months from the priority date. ~~The communication provided for in Article 36(3)(a) shall be effected as promptly as possible but not earlier than the communication under Article 20.~~

[COMMENT: Rule 73.2 is proposed to be amended so as to align, in proposed new paragraph (a), the time limit before the expiration of which the IPRP by the IPEA may be communicated to elected Offices with the time limit before the expiration of which the IPRP by the ISA may be communicated to designated Offices (see proposed new Rule 44bis.2, above).]

(b) Where the applicant makes an express request to an elected Office under Article 40(2), the International Bureau shall, upon the request of that Office or of the applicant,

(i) if the international preliminary examination report has already been transmitted to the International Bureau under Rule 71.1, promptly effect the communication provided for in Article 36(3)(a) to that Office;

[Rule 73.2(b), continued]

(ii) if the international preliminary examination report has not been transmitted to the International Bureau under Rule 71.1, promptly communicate a copy of the written opinion established by the International Searching Authority under Rule 43bis.1 to that Office.

[COMMENT: New paragraph (b) is proposed to be added so as to ensure that, where the applicant makes an express request for early national phase entry, the elected Office concerned would get either a copy of the written opinion of the ISA or, if already available, a copy of the IPRP by the IPEA.]

(c) Where the applicant has withdrawn the demand or any or all elections, the communication provided for in Article 36(3)(a) shall nevertheless be effected, if the International Bureau has received the international preliminary examination report, to the elected Office or Offices affected by the withdrawal.

[COMMENT: New paragraph (c) is proposed to be added so as to ensure that any national Office would either, as a designated Office, receive the IPRP by the ISA or, as an elected Office, receive the IPRP by the IPEA. Without such provision, the applicant could, by withdrawing the demand or any or all elections after the international preliminary report on patentability has been established by the IPEA, prevent any Office from receiving either the report established by the ISA or the report established by the IPEA: the former would not be available to any designated Office if an international preliminary examination report is established or is to be established (see proposed new Rule 44bis.1(a), above), and the latter, without the addition of proposed new paragraph (c), would not be available to any elected Office affected by the withdrawal.]

Rule 78

**Amendment of the Claims, the Description, and the Drawings,
Before Elected Offices**

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

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

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

~~78.2 [Deleted] *Time Limit Where Election Is Effected After Expiration of 19 Months from Priority Date*~~

~~Where the election of any Contracting State has been effected after the expiration of the 19th month from the priority date and the applicant wishes to make amendments under Article 41, the time limit for making amendments under Article 28 shall apply.~~

[COMMENT: The proposed amendment of Rule 78.1 and proposed deletion of Rule 78.2 are consequential on the introduction of proposed new Rule 54bis.1(b).]

Rule 92bis

**Recording of Changes in Certain Indications
in the Request or the Demand**

92bis.1 Recording of Changes by the International Bureau

(a) [No change]

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date;

~~(i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;~~

~~(ii) of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.~~

[COMMENT: In the context of the proposed introduction of the expanded international search system, it is also proposed to amend Rule 92bis. The existing time limits for the recording of a change under Rule 92bis is either 20 or 30 months from the priority date, depending on whether it is the time limit under Article 22(1) or 39(1)(a) which is applicable. That distinction has become meaningless since, following the recent modification of the time limit under Article 22(1), the time limits under Articles 22(1) and 39(1)(a) are both 30 months. Section 422 of the Administrative Instructions, providing for the details as to notifications concerning changes recorded under Rule 92bis, would also have to be modified accordingly.]

Rule 94

Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 [and Rule 44ter.1](#), furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

[\(c\) The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph \(b\) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.](#)

[COMMENT: See paragraph 43 of the Introduction to this document.]

94.2 and 94.3 [No change]

[End of Annex and of document]