



C.PCT 931
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July 2, 2003

Madam,
Sir,

This Circular is addressed to your Office in its capacity as receiving Office, International Searching Authority (ISA), International Preliminary Examining Authority (IPEA) or designated and/or elected Office under the Patent Cooperation Treaty (PCT) for the purpose of consultation under Rule 89.2(b). It is also addressed to certain intergovernmental and non-governmental organizations.

This Circular concerns modifications to the Administrative Instructions under the PCT consequent to amendments of the Regulations under the PCT which will enter into force on January 1, 2004, as adopted by the PCT Assembly at its thirty-first (18th extraordinary) session held from September 23 to October 1, 2002.

For the purpose of this consultation, the modified Sections have been grouped into two principal categories, namely those concerning the enhanced international search and preliminary examination system, and those relating to the concept and operation of the new designation system. In addition to these two categories, there are two Sections which required minor editorial corrections.

This Circular does not include any proposed modifications to the Administrative Instructions for the purpose of implementing Rules 17.1(b-*bis*) and (d), 66.7(a) and 93*bis*.1(d) governing details of a system for making documents available to Offices via digital libraries. Any modifications required will be proposed once such a system has been further conceptualized.

This Circular also does not include any proposed modifications to Annex D of the Administrative Instructions relating to the information that will be published in the *PCT Gazette* under Rule 86.1(a)(i) in light of the operation of the new designation system. By separate Circular, your Office will be consulted on proposed new format of the front page of the PCT pamphlet and the *PCT Gazette* and, at that point, on any proposed modifications to Annex D.

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Enhanced International Search and Preliminary Examination System

The main feature of the new search and examination system is that one of the 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 this new system, the ISA will 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.

As a result of the adoption of the enhanced international search and preliminary examination system, a number of modifications are now proposed to Parts 4, 5, 6 and Annex C of the Administrative Instructions under the PCT. Comments explaining the proposed modifications are included immediately following the text of the provisions concerned.

Concept and Operation of the new Designation System

As of January 1, 2004, the filing of a request will have, in accordance with Rule 4.9(a), the effect of the automatic indication of all designations possible under the PCT. As a result of the new designation system, a number of modifications are now proposed to Parts 1 through 6, 8 and Annex E of the Administrative Instructions. Comments explaining the proposed modifications are included immediately following the text of the provisions concerned.

PCT Administrative Instructions

./ The proposed modified text of the Administrative Instructions is set out in the Annex to this Circular. Added and deleted text is indicated, respectively, by underlining and strikethrough.

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Comments on the proposed modifications to the Administrative Instructions

Comments, if any, are invited to be provided to the International Bureau by July 31, 2003, preferably by fax to (+41-22) 910 00 30 or by email to pct.legal@wipo.int.

Yours sincerely,



Francis Gurry
Assistant Director General

Enclosure: Annex—Proposed modifications of the Administrative Instructions under the PCT

ENHANCED INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION SYSTEM:

Section 415

Notification of Withdrawal Under Rule 90bis.1, 90bis.2, 90bis.3 or 90bis.4

(a) The fact of withdrawal by the applicant of the international application under Rule 90bis.1, of designations under Rule 90bis.2, or of a priority claim under Rule 90bis.3, together with the date on which the notice effecting withdrawal reached the International Bureau, the International Preliminary Examining Authority or the receiving Office, shall be recorded by the International Bureau and promptly notified by it to the receiving Office, the applicant, the designated Offices affected by the withdrawal ~~if they have already been notified of their designation~~ and, where the withdrawal concerns the international application or a priority claim and where the international search report and the written opinion of the International Searching Authority, or the declaration referred to in Article 17(2)(a), ~~has~~ has not yet issued, the International Searching Authority. However, where the withdrawal concerns the international application and where the notice effecting withdrawal was filed with the receiving Office before the sending of the record copy to the International Bureau, that Bureau shall send the notifications referred to in the preceding sentence and in Rule 24.2(a) to the receiving Office and the applicant only.

(b) and (c) [No change]

[COMMENT: Consequential to the deletion Rule 24.2(b) and in light of new Rule 43bis.]

Section 417

Processing of Amendments Under Article 19

(a) to (c) [No change]

(d) If, at the time when the demand is received by the International Bureau, the international search report and the written opinion of the International Searching Authority ~~have~~ has been established and no amendments under Article 19 have been made, the International Bureau shall inform the International Preliminary Examining Authority accordingly.

[COMMENT: Consequential to new Rule 43bis.]

Section 421

Invitation to Furnish a Copy of the Priority Document

Where a request for a copy of the application whose priority is claimed in the international application is made under Rules ~~43bis.1(b)66.7(a)~~ by the International Searching Authority or, under Rule 66.7(a), by the International Preliminary Examining Authority before the International Bureau has received the priority document under Rule 17.1, the International Bureau shall, unless the applicable time limit referred to in Rule 17.1(a) has already expired, inform the applicant of such request and remind him of the requirements of Rule 17.1.

[COMMENTS: Consequential to new Rule 43*bis*.1(b).]

Section 422
Notifications Concerning Changes Recorded Under Rule 92*bis*.1

(a) The International Bureau shall ~~give notifications concerning~~notify changes recorded by it under Rule 92*bis*.1(a), except changes which are the subject of notifications under Section 425:

(i) [No change]

(ii) as long as the international search report and the written opinion of the International Searching Authority have ~~has~~ not been established, to the International Searching Authority;

(iii) to the designated Offices, ~~unless the change has been recorded after the expiration of the time limit referred to in Article 22(1) or~~ unless the change can be duly reflected in the pamphlet used for the purposes of the communication of the international application under Article 20;

(iv) to (vi) [No change]

(b) [No change]

[COMMENT: Represents a minor simplification in the first line of paragraph (a), and includes changes consequential to new Rule 43*bis* and the modification of the time limit under Article 22(1).]

Section 503
Method of Identifying Documents Cited in the International Search Report and the Written Opinion of the International Searching Authority

Identification of any document cited in the international search report shall be as provided in WIPO Standard ST.14 (Recommendation for the Inclusion of References Cited in Patent Documents).¹ Any document cited in the international search report may be referred to in a shortened form in the written opinion of the International Searching Authority, provided that the reference to the document is unambiguous.

[COMMENT: The proposed modification aligns the procedure before the International Searching Authority to that of the International Preliminary Examining Authority. See also Section 611 below.]

Section 509
International Search and Written Opinion of the International Searching Authority on the Basis of a Translation of the International Application

Where the International Searching Authority has carried out the international search and established the written opinion on the basis of a translation of the international application transmitted to that Authority under Rule 23.1(b), the international search report and the written opinion of the International Searching Authority shall so indicate.

¹ *Editor's Note:* Published in the *WIPO Handbook on Industrial Property Information and Documentation*.

[COMMENT: The proposed modification aligns the procedure before the International Searching Authority for the establishment of the international search report and of the written opinion.]

Section 513 **Sequence Listings**

(a) [No change]

(b) Where the international search report and the written opinion of the International Searching Authority ~~are~~ is based on a sequence listing that was not contained in the international application as filed but was furnished subsequently to the International Searching Authority, the international search report and the written opinion of the International Searching Authority shall so indicate.

(c) Where a meaningful international search cannot be carried out and a meaningful written opinion, as to whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable, cannot be established because a sequence listing is not available to the International Searching Authority in the required form, that Authority shall so state in the international search report and the written opinion.

(d) and (e) [No change]

[COMMENTS: Consequential to new Rule 43bis.]

Section 514 **Authorized Officer**

The officer of the International Searching Authority responsible, as referred to in Rule 43.8, for the international search report, ~~as referred to in Rule 43.8,~~ and, as referred to in Rule 43bis.1(b), for the written opinion of the International Searching Authority, means the person who actually performed the search work and prepared the search report and the written opinion of the International Searching Authority, or another person who was responsible for supervising the search and the establishment of the written opinion.

[COMMENT: Consequential to new Rule 43bis, the proposed modification aligns the procedure before the International Searching Authority for the establishment of the international search report and of the written opinion.]

Section 518 **Guidelines for Explanations Contained** **in the Written Opinion of the International Searching Authority**

For the purposes of establishing the written opinion of the International Searching Authority, Section 604 shall apply *mutatis mutandis*.

[COMMENT: Section 604 (Guidelines for Explanations Contained in the International Preliminary Examination Report) provides:

“(a) Explanations under Rule 70.8 shall clearly point out to which of the three criteria of novelty, inventive step (non-obviousness) and industrial applicability referred to in Article 35(2), taken separately, any cited document is applicable and shall clearly describe, with reference to the cited documents, the reasons supporting the conclusion that any of the said criteria is or is not satisfied.

(b) Explanations under Article 35(2) shall be concise and preferably in the form of short sentences.”

By the *mutatis mutandis*, it is proposed that these guidelines would also apply to explanations in the written opinion of the International Searching Authority.]

Section 611 **Method of Identification of Documents in** **the International Preliminary Examination Report**

Any document cited in the international preliminary examination report which was not cited in the international search report or the written opinion of the International Searching Authority shall be cited in the same form as required under Section 503 for international search reports and written opinions of the International Searching Authority. Any document cited in the international preliminary examination report which was previously cited in the international search report and/or the written opinion of the International Searching Authority may be cited in a shortened form, provided that the reference to the document is unambiguous.

[COMMENT: Consequential to new Rule 43*bis*.]

ANNEX C **STANDARD FOR THE PRESENTATION OF** **NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS** **IN INTERNATIONAL PATENT APPLICATIONS UNDER THE PCT**

Definitions

2. For the purposes of this Standard:

(i) to (vii) [No change]

(viii) “competent Authority” is the International Searching Authority that is to carry out the international search and to establish the written opinion of the International Searching Authority on the international application, or the International Preliminary Examining Authority that is to carry out the international preliminary examination on the international application, or the designated/elected Office before which the processing of the international application has started.

[COMMENT: Consequential to new Rule 43*bis*.]

CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM:

Section 202

[Deleted]

Kind of Protection

~~—(a) Where the applicant wishes his application to be treated in any designated State as an application not for a patent but for the grant of another kind of protection referred to in Article 43, he shall make the indication in the request referred to in Rule 4.12(a) by inserting the words “inventor’s certificate,” “utility certificate,” “utility model,” “petty patent,” “patent of addition,” “certificate of addition,” “inventor’s certificate of addition” or “utility certificate of addition,” or their equivalent in the language of the international application, immediately after the indication of the said State.~~

~~—(b) Where, in respect of a designated State which provides for the granting of a patent and of a utility model, the applicant is seeking two kinds of protection under Article 44, he shall make the indication referred to in Rule 4.12(b) by inserting, immediately after the indication of that State and in the language of the international application, the words “and utility model.”~~

[COMMENT: Consequential to the amendment of Rules 4.9(a)(ii) and 4.11, the deletion of Rule 4.12, and new Rule 49*bis*.]

Section 209

Indications as to Deposited Biological Material on a Separate Sheet

(a) [No change]

(b) For the purposes of ~~the Japan Patent Office when Japan is designated~~certain Offices in their function as designated Offices, paragraph (a) applies only to the extent that the said Form or sheet is included as one of the sheets of the description of the international application at the time of filing.

[COMMENT: Consequential to the amendment of Rule 4.9(a)(i), Japan along with other States which have the same, or similar requirements with relation to indications as to deposited biological material, will always be designated.]

Section 315

[Deleted]

Notification Concerning Confirmation of Designation

~~—Where a designation made under Rule 4.9(b) has been confirmed under Rule 4.9(c), the receiving Office shall promptly notify the applicant and the International Bureau.~~

[COMMENT: Consequential to the amendment of Rule 4.9(b) and the deletion of Rule 4.9(c).]

Section 336
Waivers Under Rule 90.4(d)

(a) Where, in accordance with Rule 90.4(d), a receiving Office waives the requirement under Rule 90.4(b) that a separate power of attorney be submitted, it shall notify the International Bureau accordingly.

(b) A receiving Office which has notified the International Bureau under paragraph (a), shall notify the International Bureau of any change to the information notified under that paragraph.

[COMMENT: This proposed new Section provides for the International Bureau to be informed when any receiving Office makes, or changes, a waiver under Rule 90.4(d).]

Section 402
Correction or Addition of a Priority Claim Under Rule 26bis

(a) to (c) [No change]

~~—(d) Any designated Office which has been notified under Rule 24.2(b) of the receipt of the record copy shall be notified by the International Bureau of any correction or addition of a priority claim under Rule 26bis.~~

[COMMENT: Consequential to the deletion Rule 24.2(b), the correction or addition of a priority claim under Rule 26bis will be reflected in the international publication of the international application.]

Section 422bis
Objections Concerning Changes in the Person of the Applicant
Recorded Under Rule 92bis.1(a)

(a) Where a change recorded by the International Bureau under Rule 92bis.1(a):

(i) consists of a change in the person of the applicant, and

(ii) the request under Rule 92bis.1(a) was not signed by or on behalf of all applicants,
and

(iii) an earlier applicant objects to the change in writing,

the change under Rule 92bis.1(a) shall be considered as if it had not been recorded.

(b) The International Bureau shall accordingly notify all those who received a notification under Section 422(a).

[COMMENT: This proposed new Section provides for a safeguard for applicants along the lines of the International Bureau's existing procedure whereby if the International Bureau receives a request for the recording of a change in the person of the applicant (resulting in that applicant being removed from the application) which was not signed by or on behalf of all applicants, while it would record such a change, it would notify (see Section 422(a)(vi)) any applicant

affected by the request (the “old” applicant) and would undo the recorded change if the “old” applicant objected to the change notification.]

Section 426

[Deleted]

~~Notification of Designation Under Rule 24.2(b)~~

~~— Each designated Office having notified the International Bureau under Rule 24.2(b) that it wishes to receive the notification under Rule 24.2(a) shall receive periodically, but at least once a month, a listing of the international applications containing the designation(s) of the State(s) for which that Office acts as a designated Office, including designations made under Rule 4.9(a) and those made under Rule 4.9(b) which have been confirmed under Rule 4.9(c). Such listing shall contain, in respect of each designation:~~

- ~~— (i) the international application number,~~
- ~~— (ii) the international filing date,~~
- ~~— (iii) the name of the applicant, and~~
- ~~— (iv) the earliest priority date claimed.~~

[COMMENT: Consequential to the deletion of Rule 24.2(b).]

Section 427

[Deleted]

~~Publication of Notice of Confirmation of Designation~~

~~— Where an international application has been published under Article 21(2)(b) before the confirmation of a designation under Rule 4.9(c), a notice of that confirmation shall be published in the Gazette.~~

[COMMENT: Consequential to the deletion of Rule 4.9(c).]

Section 429

[Deleted]

~~Notice of Extension~~

~~— Where a request for extension of the effects of an international application to a successor State, made in accordance with Rule 32.1(e), is received by the International Bureau after technical preparations for international publication have been completed, a notice of this fact shall be published in the Gazette.~~

[COMMENT: Consequential to the amendment of Rule 32.1, it will no longer be necessary to request extension to a successor State. Therefore, there will be no situations in which a request for extension is received after technical preparations for international publication have been completed.]

Section 430
Notification of Designations Under Rule 32 (~~Extensions~~)

Where the effects of any international application are extended to a successor State request for extension is made under Rule 32.1(ae), the International Bureau shall promptly, but not before the international publication of the international application, effect the communication under Article 20 to the designated Office concerned, and notify that Office under Rule 47.1(a-bis), ~~and notify it of the date of the receipt of the request for extension.~~

[COMMENT: Consequential to the amendment of Rule 32.1, it will no longer be necessary to request extension to a successor state.]

Section 433
Waivers Under Rule 90.4(d)

(a) Where, in accordance with Rule 90.4(d), the International Bureau waives the requirement under Rule 90.4(b) that a separate power of attorney be submitted, the International Bureau shall publish a notice of this fact in the Gazette.

(b) Any waivers of the requirement under Rule 90.4(b) that a separate power of attorney be submitted, or any changes to the information, notified to the International Bureau under Sections 336, 517, or 617 shall be promptly published in the Gazette. The effective date of any change shall be two months after the date of publication of the change in the Gazette, or such later date as may be determined by the International Bureau.

[COMMENT: This proposed new Section provides for the International Bureau to make, or change, a waiver under Rule 90.4(d), and to publish in the Gazette any waivers, or changes to such waivers, made by any receiving Office, International Searching Authority, International Preliminary Examining Authority, or by the International Bureau.]

Section 517
Waivers Under Rule 90.4(d)

(a) Where, in accordance with Rule 90.4(d), an International Searching Authority waives the requirement under Rule 90.4(b) that a separate power of attorney be submitted, it shall notify the International Bureau accordingly.

(b) An International Searching Authority which has notified the International Bureau under paragraph (a), shall notify the International Bureau of any change to the information notified under that paragraph.

[COMMENT: This proposed new Section provides for the International Bureau to be informed when any International Searching Authority makes, or changes, a waiver under Rule 90.4(d).]

Section 617
Waivers Under Rule 90.4(d)

(a) Where, in accordance with Rule 90.4(d), an International Preliminary Examining Authority waives the requirement under Rule 90.4(b) that a separate power of attorney be submitted, it shall notify the International Bureau accordingly.

(b) An International Preliminary Examining Authority which has notified the International Bureau under paragraph (a), shall notify the International Bureau of any change to the information notified under that paragraph.

[COMMENT: This proposed new Section provides for the International Bureau to be informed when any International Preliminary Examining Authority makes, or changes, a waiver under Rule 90.4(d).]

ANNEX E
INFORMATION TO BE PUBLISHED IN THE GAZETTE UNDER RULE 86.1(a)(v)

1. to 12. [No change]

~~13. The names of those designated Offices wishing to receive notifications under Rule 24.2(b).~~

~~14. The dates defining the period referred to in Rule 32.1(b) during which the international application, whose effects may be extended to a successor State under Rule 32.1, must have been filed.~~

[COMMENT: Consequential to the deletion of Rule 24.2(b).]

Section 105
Identification of International Application with Two or More Applicants

Where any international application indicates two or more applicants, it shall be sufficient, for the purpose of identifying that application, to indicate, in any Form or correspondence relating to such application, the name of the applicant first named in the request. The provisions of the first sentence of this Section do not apply to the demand ~~or to a notice effecting later elections.~~

[COMMENT: Consequential to the deletion of Rule 56.]

Section 334
Notification to Applicant of Submission of Demand
After the Expiration of 19 Months from the Priority Date

(a) Where the demand is submitted after the expiration of 19 months from the priority date to a receiving Office, and the time limit under Article 22(1), as in force from April 1, 2002, does not apply in respect of all designated Offices, ~~that~~ the receiving Office shall promptly notify the

applicant accordingly, ~~directing attention to the fact that the time limit under Article 39(1)(a) does not apply~~, and shall proceed under Rule 59.3.

[COMMENT: Consequential to the modification of the time limit under Article 22(1), and to new Rule 54*bis*.1.]

Section 414
Notification to the International Preliminary Examining Authority Where the International Application or the Designations of all Elected States Are Considered Withdrawn

If a demand has been submitted and the international application ~~or the designations of all designated States which have been elected are~~ considered withdrawn under Article 14(1), (3) or (4), the International Bureau shall promptly notify the International Preliminary Examining Authority, unless the international preliminary examination report has already issued.

[COMMENT: Consequential to the amendments of Rules 15.1 and 27.]

Section 423
Cancellation of Designations and Elections

(a) [No change]

(b) The International Bureau shall cancel *ex officio*:

(i) the election, in the demand ~~or in a notice effecting a later election~~, of any State which is not a designated State;

(ii) the election, in the demand, of any State not bound by Chapter II of the Treaty, if the International Preliminary Examining Authority has failed to do so.

~~— (iii) the election, in a notice effecting a later election, of any State not bound by Chapter II of the Treaty.~~

(c) [No change]

[COMMENT: Consequential to the deletion of Rule 56.]

Section 428
[Deleted]

Publication of Notice of Later Election

~~— Where a later election is made before the expiration of 19 months from the priority date, a notice of that fact shall be published in the Gazette.~~

[COMMENT: Consequential to the deletion of Rule 56.]

Section 431
Publication of Notice of Submission of Demand

(a) The publication in the Gazette of information on the demand and the elected States concerned, as referred to in Rule 61.4, shall consist of a notice indicating that a demand has been submitted prior to the expiration of 19 months from the priority date and, as applicable, indicating and that consequently, subject to paragraph (b), all eligible Contracting States which were designated and were bound by Chapter II of the Treaty have been elected, or,

(b) In the case of an international application whose international filing date is prior to January 1, 2004, where not all eligible States have been elected, the notice shall indicate~~indicating~~ those eligible States which have not been elected.

(c) Where the demand is made subsequent to the expiration of 19 months from the priority date and the time limit under Article 22(1), as in force from April 1, 2002, does not apply in respect of all designated Offices, the notice shall also indicate that fact.

[COMMENT: Consequential to the amendment of Rule 61.4]

Section 432
Notification to Applicant of Submission of Demand
After the Expiration of 19 Months from the Priority Date

(a) Where the demand is either, submitted after the expiration of 19 months from the priority date and subsequently transmitted to the International Bureau under Rule 59.3(a), or, where the demand is submitted after the expiration of 19 months from the priority date to the International Bureau, and the time limit under Article 22(1), as in force from April 1, 2002, does not apply in respect of all designated Offices, the International Bureau shall, together with the notification sent to the applicant under Rule 59.3(c)(i) or the invitation sent to the applicant under Rule 59.3(c)(ii), as the case may be, promptly notify the applicant accordingly, directing attention to the fact that the time limit under Article 39(1)(a) does not apply, and shall proceed under Rule 59.3.

[COMMENT: Consequential to the modification of the time limit under Article 22(1), and to new Rule 54bis.1.]

Section 516
Notification to Applicant of Submission of Demand
After the Expiration of 19 Months from the Priority Date

(a) Where the demand is submitted after the expiration of 19 months from the priority date to an International Searching Authority, and the time limit under Article 22(1), as in force from April 1, 2002, does not apply in respect of all designated Offices, that Authority shall promptly notify the applicant accordingly, directing attention to the fact that the time limit under Article 39(1)(a) does not apply, and shall proceed under Rule 59.3.

[COMMENT: Consequential to the modification of the time limit under Article 22(1), and to new Rule 54bis.1.]

Section 601
Notification to Applicant of Submission of Demand
After the Expiration of 19 Months from the Priority Date

(a) Where the demand is submitted after the expiration of 19 months from the priority date, and the time limit under Article 22(1), as in force from April 1, 2002, does not apply in respect of all designated Offices, the International Preliminary Examining Authority shall promptly notify the applicant accordingly, ~~directing attention to the fact that the time limit under Article 39(1)(a) does not apply.~~

(b) Where the demand is submitted after the expiration of 19 months from the priority date to an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, and the time limit under Article 22(1), as in force from April 1, 2002, does not apply in respect of all designated Offices, that Authority shall promptly notify the applicant accordingly, ~~directing attention to the fact that the time limit under Article 39(1)(a) does not apply,~~ and shall proceed under Rule 59.3.

[COMMENT: Consequential to the modification of the time limit under Article 22(1), and to new Rule 54bis.1.]

Section 606
Cancellation of Elections

The International Preliminary Examining Authority shall, ~~if the election is in the demand,~~ cancel *ex officio* the election of any State which is not bound by Chapter II of the Treaty, shall enclose that election within square brackets, shall draw a line between the square brackets while still leaving the election legible and shall enter, in the margin, the words “CANCELLED EX OFFICIO BY IPEA” or their equivalent in the language of the demand, and shall notify the applicant accordingly.

[COMMENT: Consequential to the amendment of Rule 53.7.]

Section 210
[Deleted]

Calculation of Designation Fee for the Purposes of National and Regional Patents

~~—Where the request of the international application contains a designation of a Contracting State without an indication of the wish to obtain a regional patent and also a designation of the same Contracting State with an indication of the wish to obtain a regional patent and the national law of the Contracting State does not contain a provision referred to in Article 45(2), the designation fees shall be calculated on the basis that a separate fee is payable in respect of the designation of the Contracting State in addition to the designation fee payable in respect of that Contracting State as a Contracting State or as one of a group of Contracting States for which a regional patent is sought.~~

[COMMENT: Consequential to the amendment of Rule 15.1.]

Section 304
Invitation to Pay Fees Before Date on Which They Are Due

(a) If the receiving Office finds, before the date on which they are due, that the transmittal fee, the ~~basic~~international filing fee (including any supplement per sheet over 30) or the search fee are lacking in whole or in part, it may invite the applicant to pay the missing amounts within one month from the date of receipt of the international application.

~~— (b) If the receiving Office finds, before the date on which they are due, that the designation fees for designations made under Rule 4.9(a) are lacking in whole or in part, it may invite the applicant to pay the missing amount within the time limit applicable under Rule 15.4(b).~~

~~— (c) If the receiving Office finds that the applicant filed a written notice under Rule 4.9(c)(i), but failed to pay the designation fees and/or the confirmation fee under Rule 4.9(c)(ii) or that the amount paid is not sufficient, it may invite the applicant to pay the missing amount within the time limit under Rule 4.9(b)(ii).~~

[COMMENT: Consequential to the amendment of Rule 15.1 and the deletion of Rule 4.9(c).]

Section 320
Invitation to Pay Fees Under Rule 16bis.1(a) and (b)

~~— (a) If invitations to pay fees are required to be issued by the receiving Office under both paragraph (a) and paragraph (b) of Rule 16bis.1, those invitations may be issued as separate invitations unless the due dates for the fees concerned are less than 15 days apart, in which case those invitations shall preferably be issued as a single invitation.~~

~~— (b) Where the receiving Office requires the payment of the late payment fee under Rule 16bis.2, it shall calculate the amount of that fee on the basis of the total amount of the fees due referred to in the invitation under paragraph (a).~~

~~— (c) When issuing an invitation under Rule 16bis.1(a) paragraph (a), the receiving Office shall, if it received moneys from the applicant before the due date, inform the applicant of the fees to which those moneys have been applied.~~

[COMMENT: Consequential to the amendment of Rule 16bis.]

Section 321
Application of Moneys Received by the Receiving Office in Certain Cases

(a) The receiving Office shall, to the extent that it has received instructions from the applicant as to the fees to which it shall apply moneys received by it from the applicant, apply those moneys accordingly.

(b) Where the receiving Office receives moneys from the applicant which, together with any other moneys so received, are not sufficient to cover in full the transmittal fee (if any), the

international filing fee and the search fee (if any), the receiving Office shall, to the extent that it has not received instructions from the applicant as to the fees to which it shall apply the moneys which are available for the purpose, apply those moneys in payment, successively, of the fees set out below to the extent that they are due and unpaid and in the order in which they appear below:

(i) the transmittal fee;

(ii) ~~the basic fee part of the~~ international filing fee;

(iii) the search fee;

~~— (iv) the designation fee part of the international fee for designations made under Rule 4.9(a).~~

~~— (c) Where, pursuant to paragraph (b), the receiving Office allocates moneys in payment of the designation fees to cover designations made under Rule 4.9(a), it shall apply them to those fees as follows:~~

~~— (i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly but, if the amount received is insufficient to cover the designations indicated, it shall be applied in the order chosen by the applicant in indicating the designations;~~

~~— (ii) to the extent that the applicant has not given the indications referred to in item (i), the amount, or the balance thereof, shall be applied to the designations in the order in which they appear in the request part of the international application;~~

~~— (iii) where the designation of a State is for the purposes of a regional patent, and provided that the required designation fee is, under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.~~

(~~c~~d) Where the receiving Office receives moneys from the applicant in response to an invitation under Rule 16*bis*.1 which are not sufficient to cover all the unpaid fees, including, where required, the late payment fee under Rule 16*bis*.2, the moneys shall be applied in the order referred to in paragraphs (b) and (~~e~~) to as many of the fees due, including any late payment fee, as can be covered.

~~— (e) Where, pursuant to Rule 15.5(b), the receiving Office allocates moneys in payment of fees under Rule 15.5(a) in respect of the confirmation under Rule 4.9(c) of designations made under Rule 4.9(b), the receiving Office shall apply those moneys as follows:~~

~~— (i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly, but, if the amount is insufficient to cover the designations indicated, it shall be applied to the designations in the order chosen by the applicant in indicating the designations;~~

~~— (ii) to the extent that the applicant has not given the indications referred to in item (i), the amount, or the balance thereof, shall be applied to the designations in the order in which they appear in the notice containing the confirmation;~~

~~— (iii) where the designation of a State is for the purposes of a regional patent, and provided that the required designation fee is, under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.~~

~~— (f) When allocating moneys as provided in paragraph (e), both the designation fee and the confirmation fee must be covered in respect of each designation.~~

~~— (g) Where moneys have been applied by the receiving Office in accordance with indications given by the applicant as mentioned in paragraph (e)(i) or (e)(ii), the receiving Office shall inform the International Bureau as to the effect of the said indications, preferably by sending the International Bureau a copy of any relevant written communication received from the applicant.~~

[COMMENT: Consequential to the amendment of Rules 4.9, 15.1, and 16*bis*.]

Section 803 **Calculation of ~~Basic~~International Filing Fee for International Applications Containing Sequence Listings and/or Tables**

Where sequence listings and/or tables are filed in electronic form under Section 801(a), the ~~basic~~international filing fee payable in respect of that application shall ~~comprise~~include the following two components:

(i) a basic component calculated as provided in the Schedule of Fees in respect of all pages filed on paper (that is, all pages of the request, description (excluding sequence listings and/or tables if also filed on paper), claims, abstract and drawings), and

(ii) an additional component, in respect of sequence listings and/or tables, equal to 400 times the fee per sheet as referred to in item 1(b) of the Schedule of Fees, regardless of the actual length of the sequence listings and/or tables filed in computer readable form and regardless of the fact that sequence listings and/or tables may have been filed both in written form and in computer readable form.

[COMMENT: Consequential to the amendment of Rule 15.1.]

Section 114 *[Deleted]*

~~Electronic Transmission of Notices~~

~~— Where the Treaty, the Regulations or these Administrative Instructions provide for a notification or other communication to be transmitted by one national Office or intergovernmental organization to another, that notification or communication, except where otherwise provided, may, where so agreed by both the sender and the receiver, be transmitted by electronic means or in electronic form.~~

[COMMENT: Rule 89*bis*.3 removes any need to retain Section 114]

Section 325
Corrections of Defects Under Rule 26.4(a), Rectifications
of Obvious Errors Under Rule 91.1, and Corrections Under Rule 9.2

(a) Where the receiving Office receives a correction of defects under Rule 26.4(a) or authorizes a rectification of an obvious error under Rule 91.1, it shall:

(i) to (v) [No change]

(vi) where transmittals under Article 12(1) have not yet been made, transmit any letter and any replacement sheet to the International Bureau together with the record copy and, except where the international application is considered withdrawn and Rule 29.1(a)(iii) applies, a copy of the said letter or replacement sheet to the International Searching Authority together with the search copy. The record copy and the search copy shall contain any replaced sheet.

(b) and (c) [No change]

[COMMENT: Consequential to the amendment of Rule 26.4, the reference to Rule 26.4(a) should be modified to read “Rule 26.4”. Consequential to the amendment of Rule 29, the reference to Rule 29.1(a)(iii) should be modified to read “Rule 29.1(iii)”.]

Section 413
Corrections of Defects Under Rule 26.4(a), Rectifications of
Obvious Errors Under Rule 91.1, and Corrections Under Rule 9.2

(a) Where the International Bureau receives from the receiving Office a letter containing a correction of any defects under Rule 26.4(a), or a replacement sheet and the letter accompanying it, the International Bureau shall transfer the correction to the record copy, together with the indication of the date on which the receiving Office received the letter, or shall insert the replacement sheet in the record copy. Any letter and any replaced sheet shall be kept in the file of the international application.

(b) [No change]

[COMMENT: Consequential to the amendment of Rule 26.4, the reference to Rule 26.4(a) should be modified to read “Rule 26.4”.]

[End of Annex]