



C. PCT 1145  
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April 29, 2008

Madam,  
Sir,

*Proposed modifications of the Administrative Instructions under the PCT and the PCT Receiving Office Guidelines*

This Circular is addressed to your Office in its capacity as receiving Office (RO) for the purpose of consultation on proposed modifications to the Administrative Instructions under the PCT (AIs) and the PCT Receiving Office Guidelines (ROGLs). It is also addressed to certain non-governmental organizations representing users of the PCT system.

The proposed modifications are consequential to amendments of the Regulations under the PCT adopted by the PCT Assembly at its thirty-sixth session (see document PCT/A/36/13), which will enter into force on July 1, 2008. It is recalled that these amendments concern, in particular, the use of the results of earlier searches performed by an Office other than the Office acting as an International Searching Authority (ISA), the extension of the time limit to pay the prescribed fee for the restoration of the right of priority, and the non-publication of international applications in which declarations of withdrawal in a timely fashion reach the International Bureau (IB).

In addition, the proposed modifications of the ROGLS also reflect amendments to the Schedule of Fees annexed to the Regulations under the PCT adopted by the PCT Assembly at its thirty-seventh session (see document PCT/A/37/2 Prov., dated March 31, 2008), which will also enter into force on July 1, 2008. The amendments to the Schedule of Fees provide for a 90% reduction in the international filing fee and the handling fee for applicants from certain States.

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Reference is also made to Circular C.PCT 1132, dated February 21, 2008, consulting on modifications to certain Forms relating to ROs, ISAs and the IB, consequential to the same amendments to the Regulations under the PCT mentioned above. Moreover, certain paragraphs of the ROGLs are proposed to be modified to provide more specific guidance on the use of certain receiving Office Forms relating to the restoration of the right of priority, and the option for PCT Authorities to send advance copies of notifications by e-mail, if the applicant so authorizes. Section 337 is proposed to be added to clarify that receiving Offices are to forward to the ISA any results of earlier searches which the RO has received from, or prepared on request of, the applicant.

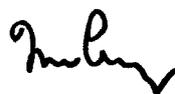
In addition, the proposed text of the ROGLs contains certain other clarifications and simplifications which are not consequential to the entry into force of the amended Regulations on July 1, 2008.

- ./. Proposed new Section 337 of the AIs is set out in Annex I to this Circular.
- ./. The paragraphs of the ROGLs which are proposed to be modified are set out in the Annex II to this Circular.

*Comments on the proposed modifications to the AIs and the ROGLs*

Noting that the modified AIs and the ROGLs should be promulgated with effect from July 1, 2008, or as soon as possible thereafter, and that further consultation may be required after consideration of the comments received in response to this Circular, you are invited to provide comments, if any, to the International Bureau by May 30, 2008, preferably by fax to (+41-22) 910 00 30 or by email to: [pct.legal@wipo.int](mailto:pct.legal@wipo.int).

Yours sincerely,



Francis Gurry  
Deputy Director General

Enclosures: Annex I – Proposed new Section 337 of the AIs

Annex II – Proposed modified paragraphs of the ROGLs

PROPOSED MODIFIED SECTION OF THE ADMINISTRATIVE INSTRUCTIONS

**Section 337**

**Transmittal of copy of results of earlier search**

Where the applicant has

(i) submitted a copy of the results of an earlier search to the receiving Office under Rule 12bis.1(a) together with the international application; or

(ii) requested the receiving Office under Rule 12bis.1(c) to prepare and transmit a copy of the results of the earlier search, a copy of the earlier application concerned and/or a copy of any document cited in the results of the earlier search;

the receiving Office shall promptly transmit any such copy to the International Searching Authority, preferably together with the search copy.

[Annex II follows]

[...]

### **Kind of Protection or Treatment**

108. Under Rule 4.9(a)(ii), the filing of a request shall constitute 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. Upon filing of the request, the applicant will obtain an automatic and all-inclusive coverage of every kind of protection available in any designated State. The applicant may indicate, under Rule 4.11(a)(iii) and (iv), an intention to make an indication under Rule 49bis.1 of the wish for the international application to be treated as an application for certain kinds of protection in certain States (this applies only to applications for patents of addition, certificates of addition, inventors' certificates of addition, utility certificates of addition or continuation or continuation-in-part of an earlier application; see paragraph 116A), but this does not affect the extent of the designation made under Rule 4.9 (Rule 4.11(b)). Under Rule 4.9(a)(ii), no further specification as to the kind of protection and no exclusion of certain kinds of protection is possible. If such indications are included in the request, they should be deleted by the receiving Office *ex officio*, as provided for in Rule 4.19(b) and Section 303 (paragraphs 161 to 165). However, the applicant may submit a separate notice of withdrawal of certain kinds of protection (paragraphs 314 and 322).

[...]

111. The applicant wishes the international application to be treated in any designated State (whose national law provides for that kind of protection) as an application not for a patent but for an inventor's certificate, a utility certificate, a utility model, a "petty patent," a patent of addition, a certificate of addition, an inventor's certificate of addition or utility certificate of addition, he can indicate so to the national Office, under Rule 49bis.1, only when performing the acts referred to in Article 22 for entering the national phase (concerning the indications under Rule 4.11(a)(iii) and (iv), see paragraph 116A).

[...]

### **Reference to ~~Earlier Search~~, ~~Continuation or Continuation-in-Part~~, or ~~Patent~~ Parent Application or Grant**

~~116. Where a search (international, international type or other) has already been requested from or carried out by the International Searching Authority and the applicant requests that Authority to base the international search report wholly or in part on the results of that search, the corresponding indications must be made in Box No. VII of the request (Rule 4.11).~~

116A. If, for purposes of national processing, 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 under Rule 49bis.1(c) (Rule 4.11(a)(iii)), or the applicant intends to make an indication under Rule 49bis.1(d) of the wish that the international application be treated, as an application for a continuation or a continuation-in-part of an earlier application (Rule 4.11(a)(iv)), the request shall so indicate under item 2 or 3 in the supplemental box and shall, as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or indicate the relevant parent application or parent patent or other parent grant. The inclusion in the request of such an indication shall, with respect to the international phase, only serve the purpose of international search and has no effect on the all inclusive designation for every kind of protection available under Rule 4.9(a).

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**Reference to Earlier Search**

116A. *Reference to Earlier Search.* Where the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of an earlier international search, international-type search or national search carried out either by the same International Searching Authority, by another International Searching Authority or by a national (regional) Office, the corresponding indications must be made in Box No. VII of the request (Rule 4.12).

116B. Where the applicant has requested the International Searching Authority to take into consideration the results of an earlier search, the receiving Office checks whether the applicant has either submitted the results of the earlier search together with the international application or else requested either the receiving Office or the International Searching Authority to retrieve them (to the extent that the search was not conducted by the Office acting as International Searching Authority, in which case no such transmission or request is required). The receiving Office also checks whether the document(s) correspond to the indications made in Box No. VII of the request and whether the data indicated in Box No. VII is complete and appears to be correct. Furthermore, where the applicant has requested the receiving Office, under Rule 12bis.1(c), to prepare and transmit the results of the earlier search to the International Searching Authority, the receiving Office checks whether the earlier search referred to has been completed and, where applicable, whether the fee referred to in Rule 12bis.1(c) has been paid.

116C. Where the indications in Box No. VII and the results of the earlier search(es) submitted comply with the requirements mentioned in paragraph 116B, the receiving Office, as applicable, transmits, or prepares and transmits, the results of the earlier search(es) together with the search copy to the International Searching Authority (see Section 337). Where the applicant has furnished any other document in connection with the request under Rule 12bis.1(a) together with the international application, the receiving Office either informs the applicant that such documents should be submitted directly to the International Searching Authority or, at its choice, transmits those documents to the International Searching Authority.

116D. *Incomplete or incorrect indications, or missing or inconsistent earlier search results.* Where the receiving Office has found that the indications made in Box No. VII are incomplete, do not correspond to the earlier search results submitted or seem otherwise incorrect, the receiving Office may proceed as outlined in paragraphs 161 to 165 (“*Ex Officio* Corrections”) or refer the applicant to Rule 91.1. The sending of the search copy to the International Searching Authority should, however, not be delayed by any such ongoing proceedings. Where any such incomplete or incorrect indications in Box No. VII cannot be resolved, or where the applicant has failed to submit the results of the earlier search(es) together with the international application or where the receiving Office could not prepare and transmit a copy of the results of the earlier search(es), the receiving Office should inform the applicant (Form PCT/RO/132) that his request for the International Searching Authority to take into account the results of an earlier search could not be acted upon and/or be forwarded to the International Searching Authority. A copy of this notification should be sent to the International Bureau and the International Searching Authority. Where the indications in Box No. VII do not seem to correspond to the earlier search results submitted by the applicant, and even if such inconsistencies could not be resolved, the receiving Office should nevertheless transmit the earlier search results to the International Searching Authority.

[...]

159. *Failure to Correct under Article 14(1)(b) and Rule 26.* If the receiving Office finds that defects under Article 14(1)(a) have not been corrected or have not been timely corrected, it declares the international application withdrawn and promptly notifies (Form PCT/RO/117) the applicant, the

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International Bureau and (if the search copy has already been transmitted) the International Searching Authority (Rule 29.1(ii) and (iii)). Since international publication can only be stopped if this notification reaches the International Bureau before completion of technical preparations for international publication (Rule 29.1(v)), it is critical that the declaration that the international application is considered withdrawn be made and notified to the International Bureau early enough to be able to have this effect. In urgent cases, it is strongly recommended that such notifications be faxed to the International Bureau. Together with the copy of Form PCT/RO/117 sent to the International Bureau, the receiving Office should enclose copies of all papers and correspondence relating to the decision declaring that the international application is considered withdrawn to facilitate any subsequent review of that decision by a designated Office under Article 25(1). As to a missing signature of an applicant/inventor for the United States of America who is unavailable or refuses to sign the international application, see paragraphs 129 to 131. In any event, in view of Rule 26.3, the receiving Office should, in general, not declare the international application withdrawn for failure to comply with the physical requirements under Rule 11; only in extreme cases of non-compliance with those requirements should the receiving Office make such declaration. Where the international application does not contain all the prescribed indications concerning the applicant (Article 14(1)(a)(ii) and Rules 4.4 and 4.5), the receiving Office should not issue a declaration under Rule 26.5 in a case where, for example, there is a minor error in an address (see the opening words of Rule 4.4(c)), or where the applicant's full name is misspelled or not indicated, even if the applicant fails to correct the defect, upon invitation, within the prescribed time limit. If there is more than one applicant, it is sufficient that the indications required under Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who is entitled according to Rule 19.1 to file the international application with the receiving Office (Rule 26.2*bis*(b)) (paragraph 84A). Where failure to correct a defect which would affect the reasonably uniform international publication is noticed at a late stage, it would be inappropriate for the receiving Office to declare the international application withdrawn without first issuing a reminder and extending the time limit under Rule 26.2.

[...]

166B. ***Restoration of the Right of Priority.*** The receiving Office checks if the request form contains a request by the applicant to restore the right of priority in Box No. VI. If such a request to restore is filed subsequently, the receiving Office promptly notifies the International Bureau of the request (item 6 of Form PCT/RO/118). The receiving Office then checks whether the following requirements are met:

(a) A priority claim to an earlier application is made in the international application or is subsequently added, pursuant to Rule 26*bis*.1(a).

(b) A statement of reasons for failure to file the international application within the priority period has been furnished (see also paragraph 166F below).

(c) The fee for requesting restoration, if applicable, has been paid (Rule 26*bis*.3(d)). The time limit for payment of the fee may be extended for a period of up to two months from the expiration of the time limit under Rule 26*bis*.3(e).

(d) If required by the receiving Office, a declaration or evidence in support of the statement of reasons for failure to file the international application within the priority period has been furnished.

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If any of the above requirements are not complied with, the receiving Office notifies the applicant (Form PCT/RO/158) of the deficiency. If the receiving Office intends to refuse the request to restore the right of priority, it should so indicate in detail in Form PCT/RO/158 and provide the applicant an opportunity to make observations within a reasonable time limit.

[...]

166E. Decision to Restore the Right of Priority. The receiving Office, when deciding on a request for restoration, is free to apply either the more strict criterion of “due care” or the less strict criterion of “unintentionality” (Rule 26bis.3(a)). The receiving Office may also apply both criteria. In such a case, the Office is free to apply, upon request by the applicant or at its own initiative, first the “due care” criterion and, if it finds that that criterion is not satisfied, the “unintentionality” criterion. If the receiving Office applies both criteria and finds that the failure to timely file the international application was unintentional but that due care had not been exercised, the receiving Office may indicate this intent to partially refuse restoration of priority under the due care criterion in Form PCT/RO/158, and explain that restoration will nevertheless be allowed under the unintentional criterion, by text in the Annex to that Form. If the applicant requests the restoration of multiple priority claims, and where the use of a single Form (PCT/RO/158 and/or PCT/RO/159) would not be sufficiently clear, the receiving Office should use a separate Form for each priority claim concerned.

[...]

247. ***Reduction of International Filing Fee for Applicants from Certain States.*** An applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below 3,000 US dollars (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), or who is a national of and resides in one of the following States: Antigua and Barbuda, Bahrain, Barbados, the Libyan Arab Jamahiriya, Oman, the Seychelles, Singapore, Trinidad and Tobago and the United Arab Emirates, or an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations is entitled, in accordance with the Schedule of Fees, to a reduction of ~~75~~<sup>90</sup>% of certain PCT fees including the international filing fee. Information about the PCT Contracting States whose nationals and residents are entitled to such reduction is contained in the *PCT Applicant's Guide, Volume I-International Phase*, Annex C. If there are several applicants, each must satisfy the above-mentioned criteria. The reduction of the international filing fee applies automatically to any international application whose applicant or applicants are so entitled on the basis of the indications of name, nationality and residence given in Boxes Nos. II and III of the request. No specific request for such reduction need to be made by the applicants concerned.

[...]

249. Where the applicant is, or all applicants are, as the case may be, entitled to the reduction of the international filing fee, the amount payable (Box I of the Fee calculation sheet) is ~~25~~<sup>10</sup>% of international filing fee (Box I of the Fee calculation sheet).

[...]

### **Failure to Pay the Prescribed Fees under Article 14(3)**

267. If the applicant has failed to pay to the receiving Office the amount required under Rule 16bis or has paid less than what is needed to cover the transmittal fee, the international filing fee, where required, the late payment fee, and the search fee, the receiving Office declares the international application withdrawn under Article 14(3) and promptly notifies the applicant using

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Form PCT/RO/117. It sends a copy of that notification to the International Bureau and, where the search copy has already been transmitted, to the International Searching Authority (Rules 16*bis*.1(c) and 29.1). Since international publication can only be stopped if this notification reaches the International Bureau before completion of technical preparations for international publication (Rule 29.1(v)), it is critical that this declaration be made and notified to the International Bureau early enough to be able to have this effect. In urgent cases, it is strongly recommended that such notifications be faxed to the International Bureau.

[...]

**Receipt of Request to Record a Change**

[...]

309B. Where the request for the recording of a change concerns the indication of an e-mail address of the applicant or the agent, the receiving Office, when filling-in Form PCT/RO/113, checks the appropriate box next to the e-mail address, if the applicant or agent has given his express authorization that the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority may use the e-mail address provided to send advance copies of notifications in respect of this international application.

[End of Annex II]