



C.PCT 970

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December 18, 2003

Madam,
Sir,

Transitional issues concerning the filing and processing of international applications filed before or on or after January 1, 2004

This circular, addressed to your Office in its capacity as a receiving Office under the Patent Cooperation Treaty (PCT), sets out certain transitional procedures to be followed in relation to international applications which are filed, on the one hand, before January 1, 2004 and, on the other hand, those filed on or after January 1, 2004.

Such transitional procedures are necessary as a consequence of the amendments of the Regulations under the PCT which will enter into force as of January 1, 2004, as adopted by the PCT Assembly at its thirty-first (18th extraordinary) session held from September 23 to October 1, 2002 (see document PCT/A/31/10), and as adopted by the PCT Assembly at its thirty-second (14th ordinary) session held from September 22 to October 1, 2003 (see the document PCT/A/32/8). Reference is made, in particular, to the transitional arrangements adopted by the PCT Assembly as contained in Annex VI of document PCT/A/31/10 and paragraph 22 to 24 of document PCT/A/32/8.

./ The transitional procedures, which are described in further detail in the Annex to this Circular, concern the payment of fees, the use of the request form (PCT/RO/101 and PCT-EASY format), the indication of inventors as applicants for the purpose of the designation of the United States of America and the withdrawal of designations of States.

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Inquiries with regard to these transitional procedures and other related issues should be directed to the PCT Legal Service, preferably by fax to (+41-22) 910 00 30 or by email to pct.legal@wipo.int.

Yours sincerely,



Francis Gurry
Deputy Director General

Enclosure: Annex – Detailed explanations of the transitional procedures to be followed by PCT receiving Offices

DETAILED EXPLANATIONS OF THE TRANSITIONAL PROCEDURES TO BE
FOLLOWED BY PCT RECEIVING OFFICES

General comment

It is recalled that the amendments of the Regulations adopted by the PCT Assembly in 2002 and 2003 will, in principle, and in particular as far as the procedures before the receiving Offices is concerned, apply only to international applications filed on or after 1 January 2004.

Payment of fees

It is recalled that with effect from January 1, 2004, Rule 15 and the Schedule of Fees have been amended. These amendments have the result that the basic and designation fee is replaced by the international filing fee. Since Rule 15.4(a) and (c), as in force until December 31, 2003, states that the amount of the basic and, with certain exceptions, the designation fee shall be the amount applicable on the date of receipt of the international application, the type and amount of fees payable are governed by the date of receipt of the international application at the receiving Office irrespective of the subsequently accorded international filing date.

Thus any international application received by the receiving Office before January 1, 2004, will be subjected to the payment of a basic and designation fee(s) in the amount set by the Schedule of Fees in force until December 31, 2003. This applies also in the case of an international application received before January 1, 2004 but in respect of which an international filing date on or after January 1, 2004 is granted (see paragraph 3(a)(i) of "Decision Relating to Entry into Force and Transitional Arrangements" adopted by the PCT Assembly at its thirty-first (18th extraordinary) session held from September 23 to October 1, 2002, Annex VI of document PCT/A/31/10). In such a case, even though the applicant might have made less than 5 specific designations in the request, under new Rule 4.9(a), the filing of a request constitutes the designation of all Contracting States that are bound by the PCT on the international filing date (see also below). The applicant should therefore pay, and be invited to pay, a basic fee and a maximum of 5 designation fees in respect of such an international application.

It is to be noted that Rule 15.4(c), second sentence, contains an exception to what was stated above in that this Rule provides that in a case where the designation fee is payable within a time limit of one year from the priority date (Rule 15.4(b)(i)) 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 of the designation fee payable shall be the amount applicable on the date of payment. Since, however, in a case where the payment would be effected on or after January 1, 2004, the Schedule of Fees, as in force on the day of payment will no longer provide for a designation fee,

the amount applicable should be the amount as fixed by the Schedule of Fees in force until December 31, 2003. As a result, no particular additional considerations have to be given to such exceptional cases.

Late payment fee

Under amended Rule 16*bis*.2(b), the maximum amount of the late payment fee shall not exceed the amount of 50% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets. Since in certain cases, the maximum amount of the international filing fee payable is reduced according to item 3 and 4 of the Schedule of Fees, the maximum amount of the late payment fee should also be based on the reduced amount of the international filing fee.

Use of the 2003 version of the Request Form for international applications filed on or after January 1, 2004

Under Rule 4.9(a), as applicable to international applications filed on or after January 1, 2004, the filing of a request constitutes the designation of all Contracting States that are bound by the PCT on the international filing date. If, therefore, an applicant files an international application on or after January 1, 2004 using a 2003 (or older) version of the PCT Request Form (PCT/RO/101 or PCT-EASY request form print-out) and regardless of the specific designation of States made by the applicant in Box V of the request, all designations possible on the international filing date are automatically made, including the designations of DE, KR and RU. As indicated above, the same applies if the international application was filed before January 1, 2004 but the international filing date of the application is changed to on or after 1 January 2004.

In such cases, in order to draw the attention of the applicant to this fact, Form PCT/RO/132 should be issued by the RO with the following text:

“The attention of the applicant is drawn to the fact that since the above indicated international application has a filing date on or after 1 January 2004, according to PCT Rule 4.9(a), the filing of the request constitutes the designation of all Contracting States that are bound by the PCT on the international filing date and an indication that the international application is for the grant of every kind of protection which is available by way of the designation of that State. This applies regardless of what specific designations have been made in the request form.

If the applicant does not wish to designate all States, the attention of the applicant is drawn to the fact that, under Rule 90*bis*.2, the designation of a State may be withdrawn.”

In order to simplify the handling of such cases for receiving Offices, the International Bureau and the applicant, no *ex officio* corrections to the request form need to be made by the receiving Office, and the applicant should not be invited to furnish a corrected request form since what is being described is the legal effect of requests filed on or after 1 January 2004. The confirmation of the designations made will be provided to the applicant by way of Form PCT/IB/301.

Use of the 2004 version of the Request Form for international applications filed before January 1, 2004

In case an international application is filed before January 1, 2004, but the applicant uses the January 2004 version of the request form (PCT/RO/101 or PCT-SAFE produced request form print-out), receiving Offices should interpret the pre-printed indication in the 2004 version of the request that all possible designations are made as an indication of the intention of the applicant to designate all States bound by the PCT on the international filing date.

In order to simplify the handling of such cases for both receiving Offices, the International Bureau and the applicant, no *ex officio* corrections to the request form have to be made by the RO and the applicant should not be invited to furnish a corrected request form. The confirmation of the designations will be provided to the applicant by way of Form PCT/IB/301.

Indication of inventors as applicants for the purposes of the designation of the United States of America

It is recalled that the revised Receiving Office Guidelines provide in paragraph 93 that:

“Where, for the purposes of the designation of the United States of America,

(i) the inventor(s) is (are) named but not also indicated as applicant(s) for the purposes of that designation, and unless the inventor(s) is (are) deceased (see paragraphs 96 to 99 and 161 to 165), or

(ii) no inventor is indicated,

and the designation of the United States of America has not been withdrawn, the receiving Office notifies the applicant that the application may be rejected by the United States Patent and Trademark Office as a designated Office because only the inventor is qualified to file a national application in the United States of America (Article 27(3)). Any response by an applicant requesting that an inventor be indicated as an applicant for the United States of America will be treated as a request under PCT Rule 92*bis*. ”

In light of the suggested procedure to be followed by receiving Offices, the following standard text for Form PCT/RO/132 is proposed to be used by receiving Offices, as necessary:

“The applicant's attention is drawn to the fact that according to the national law of the United States of America, only the inventor is entitled to file a national application (Article 27(3)). The United States of America is designated in the international application, however,

- (i) the named inventor(s) is (are) not also indicated as applicant(s) for the purposes of the designation of the United States of America, and is (are) not indicated as being deceased; or
- (ii) no inventor is indicated.

If no inventor is indicated as applicant for the purposes of the designation of the United States of America, the application may be rejected by the United States Patent and Trademark Office as a designated Office.”

Withdrawal of designations of States

It is recalled that paragraph 314 of the Receiving Office Guidelines has been modified as follows:

“The applicant may file with the receiving Office a notice of withdrawal of the international application (Rule 90*bis*.1(b)), of any designation, including the withdrawal of a designation for the purpose of a given kind of protection (Rule 90*bis*.2(d)), or of any priority claim (Rule 90*bis*.3(c)). The applicant may also file such notice of withdrawal directly with the International Bureau. Any notice of withdrawal has to be signed by, or on behalf of, all applicants indicated as such in the international application at the time the notice of withdrawal is submitted. Upon receipt of such a notice, the receiving Office marks the date of receipt on the notice of withdrawal and checks whether the withdrawal is effective, that is, whether:

- (i) the notice of withdrawal is received within the time limit referred to in Rule 90*bis*.1(a), 90*bis*.2(a) or 90*bis*.3(a), as the case may be;
- (ii) the notice of withdrawal is signed by or on behalf of all the applicants.”

Receiving Offices are reminded that in a case where the applicant wishes to withdraw the designation of a particular State, in order for the withdrawal to be effective, the signature of all applicants indicated as such is required, regardless of whether they are also indicated as applicants for the particular State the designation of which is desired to be withdrawn.

Transitional provisions applicable to Administrative Instructions and Guidelines

Receiving Offices are reminded that the transitional arrangements which apply in relation to certain of the Rules as amended with effect from January 1, 2004, (see PCT/A/31/10, Annex VI and PCT/A/32/8, paragraph 9) are also applicable to the as modified or amended versions of the Administrative Instructions under the PCT and the Receiving Office Guidelines which implement the amended Rules.

[End of Annex]