

C. PCT 1664

February 28, 2024

Madam,
Sir,

Proposed modifications of the Administrative Instructions under the PCT (“the Administrative Instructions”) and certain Forms annexed to the Administrative Instructions

This Circular is addressed to your Office in its capacity as a receiving Office (RO), an International Searching Authority (ISA), an International Preliminary Examining Authority (IPEA), an Authority specified for supplementary search, and/or a designated or elected Office under the Patent Cooperation Treaty (PCT) for the purposes of consultation under PCT Rule 89.2(b). It is also addressed to certain non-governmental organizations representing users of the PCT System.

The main purpose of this Circular is to consult on the implementation of amendments to the Regulations under the PCT (“the Regulations”), adopted by the PCT Assembly at its fifty-fifth session held in Geneva from July 6 to 14, 2023 (see document PCT/A/55/2, Annex II, and document PCT/A/55/4, paragraph 32), which will enter into force on July 1, 2024.

The amendments to the Regulations relate to the procedure for handling international applications containing parts in different languages. Additionally, this Circular serves as an opportunity to propose modifications to the Administrative Instructions and certain Forms, which are not directly related to the aforementioned amendments to the Regulations.

I. Proposed modifications of the Administrative Instructions

Sections 305*bis* and 308 are proposed to be modified as a result of the amendments to Rules 26 and 29. Section 305*bis* is modified to require receiving Offices to prepare any additional copies needed and to mark all pages affected by the translation under Rule 26.3*ter*(e) accordingly. It is also proposed to modify Section 308 to require receiving Offices to mark the international application number on each sheet affected by the translation.

Furthermore, the occasion of this Circular is used to propose two additional modifications to the Administrative Instructions. Section 707(b) is proposed to be updated to reflect the amendments to the Schedule of Fees that entered into force as of July 1, 2015.

Section 804 (a) is proposed to be modified to bring it fully in line with the current practice of the International Bureau of the World Intellectual Property Organization (WIPO) concerning

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third party observations. Rather than only sending the first observation received to the applicant immediately and waiting to send any further observations until after the expiration of 28 months from the priority date, the International Bureau has already started to send any third party observations received to the applicant immediately. Given the volume of incoming observations, this approach is manageable by the International Bureau and would appear to be more helpful to the applicant.

./. The proposed modifications of the Administrative Instructions are set out in Annex I to this Circular.

II. Proposed modifications of certain Forms annexed to the Administrative Instructions

Form PCT/RO/117 is proposed to be modified, and a new Form PCT/RO/145 created, consequential to the amendments of Rules 26 and 29. Form PCT/RO/145 serves the purpose of inviting the applicant to submit a translation, to pay the late furnishing fee if applicable, and to warn the applicant of the risk of the international application being considered withdrawn should the required translation not be furnished. It is proposed that the potential withdrawal of the international application, under the amended Rules 26 and 29, is notified to the applicant by modified Form PCT/RO/117.

Forms PCT/RO/150 and PCT/RO/157 are proposed to be modified to fully align them with proposed new Form PCT/RO/145.

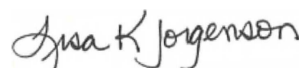
./. The PCT Forms which are proposed to be modified are set out in Annex II to this Circular. The proposed modifications to the Forms are shown in mark-up which indicates deleted and new text on separate pages. Thus, on the first marked-up page, the deleted text appears in red with the text struck out. This is followed by the second mark-up of the same page in which new text is underlined in blue. Each page indicates clearly where the modifications concern deleted or new text.

III. Comments on the Proposed Modifications of the Administrative Instructions and Certain Forms

Please be advised that modifications to the PCT Receiving Office Guidelines are currently under preparation and will be subject to consultation through a separate Circular.

Your Office is invited to provide comments, if any, by March 15, 2024, by e-mail to: pct.legal@wipo.int.

Yours sincerely,



Lisa Jorgenson
Deputy Director General
Patents and Technology Sector

Enclosures: Annex I — Proposed modifications of the Administrative Instructions

Annex II — Proposed modifications of certain forms in Annex A of the Administrative Instructions (modified pages only)

PROPOSED MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS

Section 305bis
Preparation, Identification and Transmittal
of the Copies of the Translation of the International Application under Rules 12.3, 12.4
and 26.3ter(e)

(a) Where a translation of the international application is furnished under Rule 12.3, the receiving Office shall:

(i) be responsible for the prompt preparation of any additional copies required where the translation is furnished in less than the number of copies required for the purposes of this paragraph, and shall have the right to fix a fee for performing that task and to collect such fee from the applicant;

(ii) mark the words "RECORD COPY – TRANSLATION (RULE 12.3)" in the upper left-hand corner of the first page of the original copy of the translation and transmit that copy to the International Bureau;

(iii) mark the words "SEARCH COPY – TRANSLATION (RULE 12.3)" in the same space on one additional copy of the translation which, together with a copy of the request marked "SEARCH COPY" under Section 305(a)(ii), is considered pursuant to Rule 23.1(b) to be the search copy, and transmit such search copy to the International Searching Authority; and

(iv) mark the words "HOME COPY – TRANSLATION (RULE 12.3)" in the same space on the other such copy of the translation, and keep that copy in its files.

(a-bis) Where a translation of the description or the claims or any part thereof is furnished under Rule 26.3ter(e), the receiving Office shall:

(i) be responsible for the prompt preparation of any additional copies required where the translation is furnished in less than the number of copies required for the purposes of this paragraph, and shall have the right to fix a fee for performing that task and to collect such fee from the applicant;

(ii) mark the words "RECORD COPY – TRANSLATION (RULE 26.3ter(e))" in the upper left-hand corner of the relevant page(s) of the original copy of the translation and transmit that copy together with the rest of the record copy to the International Bureau;

(iii) mark the words "SEARCH COPY – TRANSLATION (RULE 26.3ter(e))" in the same space on one additional copy of the translation which, together with a copy of the request marked "SEARCH COPY" under Section 305(a)(ii), is considered pursuant to Rule 23.1(b) to be the search copy, and transmit such search copy together with the rest of the search copy to the International Searching Authority; and

(iv) mark the words "HOME COPY – TRANSLATION (RULE 26.3ter(e))" in the same space on the other such copy of the translation, and keep that copy together with the rest of home copy in its files.

(b) The receiving Office may, when marking the copies of the translation under paragraph (a) or paragraph (a-bis), use, instead of the words referred to in that paragraph, the equivalent of those words in the language of publication of the international application.

(c) Where a translation of the international application is furnished under Rule 12.4, the receiving Office shall:

(i) be responsible for the prompt preparation of any additional copies required where the translation is furnished in less than the number of copies required for the purposes of this paragraph, and shall have the right to fix a fee for performing that task and to collect such fee from the applicant;

(ii) mark the words “RECORD COPY – TRANSLATION (RULE 12.4)” in the upper left-hand corner of the first page of the original copy of the translation and transmit that copy to the International Bureau; and

(iii) mark the words “HOME COPY – TRANSLATION (RULE 12.4)” in the same space on the other such copy of the translation, and keep that copy in its files.

Section 308
Marking of the Sheets
of the International Application and of the Translation Thereof under Rules 12.3, 12.4, 20.2, 20.4, and 26.3ter(e)

(a) Upon receipt of papers purporting to be an international application, the receiving Office shall indelibly mark the date of actual receipt on the request of each copy received.

(b) The receiving Office shall indelibly mark the international application number referred to in Section 307 in the upper right-hand corner of each sheet of each copy of the purported international application and of any translation of the international application furnished under Rules 12.3, 12.4, 20.2, 20.4, and 26.3ter(a) or (e).

(c) If a positive determination is made under Rule 20.2, the receiving Office shall mark on the request the name of the receiving Office and the words “PCT International Application” or “Demande internationale PCT”. If the official language of the receiving Office is neither English nor French, the words “International Application” or “Demande internationale” may be accompanied by a translation of these words in the official language of the receiving Office.

(d) If a negative determination is made under Rule 20.4 or a declaration is made under Article 14(4), the letters “PCT” shall be deleted by the receiving Office from the indication of the international application number on any papers marked previously with that number, and the said number shall be used without such letters in any future correspondence relating to the purported international application.

Section 707
Calculation of International Filing Fee and Fee Reduction

(a) Where an international application is filed in electronic form, the international filing fee shall, subject to paragraph (a-bis), be calculated on the basis of the number of sheets that the application would contain if presented as a print-out complying with the physical requirements prescribed in Rule 11.¹

(a-bis) Where the international application as filed contains an electronic file appearing to be a sequence listing in a file format compliant with WIPO Standard ST.26, the calculation of the international filing fee shall, in the calculation of the number of sheets, not take into account any material contained in such an electronic file.

(b) Item 4(a), (b), and (c) ~~and (d)~~ of the Schedule of Fees annexed to the Regulations shall apply to reduce the fees payable in respect of an international application filed in electronic form with a receiving Office which has notified the International Bureau under Section 710(a) that it is prepared to receive international applications in electronic form or which has decided to receive such an application in accordance with Section 703(d).

¹ *Editor's Note:* Noting that Rule 11 leaves some flexibility as to the margins of the sheets (see Rule 11.6) and the size of the characters (see Rule 11.9(d)), the international filing fee should be calculated on the basis of the number of sheets that the application would contain if presented as a print-out complying with the minimum margin and character size requirements. In practice, however, the receiving Office should not print out the international application but rather rely on the number of pages of the international application as calculated by the electronic filing software and indicated in the request.

Section 804
Notification of Receipt of an Observation to the Applicant and
Comments by the Applicant in Response to an Observation

(a) The International Bureau shall notify the applicant if any~~when the first~~ third party observations are~~is~~ received in relation to an international application. ~~If further observations are received, the International Bureau shall notify the applicant of the receipt of all further observations promptly after the expiration of 28 months from the priority date.~~

(b) The applicant may, within 30 months from the priority date, submit comments in response to any third party observation which has been received. The comments shall be submitted in English, French or the language of publication of the international application, at the choice of the applicant, and shall be promptly made available for public inspection.

[Annex II follows]

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

NOTIFICATION THAT INTERNATIONAL
APPLICATION CONSIDERED
~~TO BE~~ WITHDRAWN

(PCT Article 14(1) or (3) and Rules 12.3(d) or 12.4(d),
29.1 or 92.4(g)(i))

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

IMPORTANT NOTIFICATION

International application No.

International filing date
(day/month/year)

Applicant

The applicant is hereby notified that **the international application is declared by this receiving Office to be considered withdrawn** for the reason indicated below:

1. **Failure to correct certain defects:** An invitation (Form PCT/RO/106) to correct defects in the international application was mailed by this receiving Office on _____
However: no corrections, in response to that invitation, have been received within the prescribed time limit.
 applicant's corrections as submitted do not properly correct the defects noted in that invitation.
2. **Failure to furnish the required translation of the international application and/or to pay the late furnishing fee:** An invitation (Form PCT/RO/150 or Form PCT/RO/157) ~~to furnish the required translation of the international application and to pay, where applicable, the late furnishing fee~~ was mailed by this receiving Office on _____
However, within the time limit referred to in that invitation:
 the required translation was not furnished. the required late furnishing fee was not paid.
3. **Failure to pay prescribed fees:** An invitation (Form PCT/RO/133) to pay the prescribed fees was mailed by this receiving Office on _____
However, within the time limit referred to in that invitation:
 no fees have been paid.
 the amounts paid are not sufficient to cover the transmittal fee, the international filing fee, the search fee and the late payment fee.
4. **Failure to furnish the original of the international application:** An invitation (Form PCT/RO/141) to furnish the original of the international application (transmitted earlier by facsimile machine/teleprinter/etc.) was mailed by this receiving Office on _____
However, the original was not furnished within the time limit fixed in that invitation.
5. A copy of this Notification has been sent to the International Bureau and to the International Searching Authority.

ATTENTION: This international application will not be published **only** if this Notification reaches the International Bureau before completion of technical preparations for international publication (Rule 29.1(v)).

Name and mailing address of the receiving Office

Facsimile No.

Authorized officer

Telephone No.

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

NOTIFICATION THAT INTERNATIONAL
APPLICATION CONSIDERED
WITHDRAWN

(PCT Article 14(1) or (3) and Rules 12.3(d) or 12.4(d),
26.3ter(e), 29.1 or 92.4(g)(i))

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

IMPORTANT NOTIFICATION

International application No.

International filing date
(day/month/year)

Applicant

The applicant is hereby notified that **the international application is declared by this receiving Office to be considered withdrawn** for the reason indicated below:

1. **Failure to correct certain defects:** An invitation (Form PCT/RO/106) to correct defects in the international application was mailed by this receiving Office on _____
However: no corrections, in response to that invitation, have been received within the prescribed time limit.
 applicant's corrections as submitted do not properly correct the defects noted in that invitation.
2. **Failure to furnish the required translation of the international application and/or to pay the late furnishing fee:** An invitation (Form PCT/RO/145, Form PCT/RO/150 or Form PCT/RO/157) was mailed by this receiving Office on _____
However, within the time limit referred to in that invitation:
 the required translation was not furnished. the required late furnishing fee was not paid.
3. **Failure to pay prescribed fees:** An invitation (Form PCT/RO/133) to pay the prescribed fees was mailed by this receiving Office on _____
However, within the time limit referred to in that invitation:
 no fees have been paid.
 the amounts paid are not sufficient to cover the transmittal fee, the international filing fee, the search fee and the late payment fee.
4. **Failure to furnish the original of the international application:** An invitation (Form PCT/RO/141) to furnish the original of the international application (transmitted earlier by facsimile machine/teleprinter/etc.) was mailed by this receiving Office on _____
However, the original was not furnished within the time limit fixed in that invitation.
5. A copy of this Notification has been sent to the International Bureau and to the International Searching Authority.

ATTENTION: This international application will not be published **only** if this Notification reaches the International Bureau before completion of technical preparations for international publication (Rule 29.1(v)).

Name and mailing address of the receiving Office

Facsimile No.

Authorized officer

Telephone No.

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

INVITATION TO FURNISH TRANSLATION OF
DESCRIPTION OR CLAIMS OR ANY PART THEREOF
AND TO PAY, WHERE APPLICABLE,
LATE FURNISHING FEE

(PCT Rules 12.3 (c) and (e), and 26.3ter(e))

To:

<u>Date of mailing</u> <i>(day/month/year)</i>	
<u>TIME LIMIT</u>	<u>see paragraph 2 below</u>
<u>Applicant's or agent's file reference</u>	
<u>International application No.</u>	<u>International filing date/Date of receipt</u> <i>(day/month/year)</i>
<u>Applicant</u>	

1. The receiving Office informs the applicant that **the description and the claims are not in the same language** accepted by this receiving Office:
[identify the affected portion of the international application] _____
The applicant is invited to furnish a translation, such that the description and the claims are in a single language which is all of the following:
 – one of the languages contained in the description or claims as filed;
 – a language accepted by the International Searching Authority that is to carry out the international search; and
 – the language in which the international application is to be published,
that is, into the (or one of the) following language(s): _____

2. The applicant is hereby **invited**
 a. to furnish the required translation within one month from the date of receipt of the international application
(date of receipt: _____);
 b. and in the event that the required translation is not furnished within the time limit referred to in item 2.a, to furnish that translation
 – within one month from the date of mailing of this Invitation or
 – within two months from the date of receipt of the international application
(date of receipt: _____),
whichever expires later,
together with a late furnishing fee of _____.

WARNING: Failure to furnish the required translation and/or, where applicable, to pay the required late furnishing fee within the applicable time limit referred to in item 2.b will result in the international application being considered withdrawn. **However, any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 15 months from the priority date will be considered to have been received before the expiration of that time limit.**

A copy of this invitation is being sent to the International Bureau.

<u>Name and mailing address of the receiving Office</u>	<u>Authorized officer</u>
<u>Facsimile No.</u>	<u>Telephone No.</u>

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

INVITATION TO FURNISH TRANSLATION OF
INTERNATIONAL APPLICATION AND TO PAY,
WHERE APPLICABLE, LATE FURNISHING FEE

(PCT Rule 12.3(c) and (e))

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

TIME LIMIT
see paragraph 2 below

International application No.

International filing date/Date of receipt
(day/month/year)

Applicant

1. The applicant is hereby notified that this receiving Office has **not yet received the required translation of the international application** into a language which is all of the following:

- a language accepted by the International Searching Authority that is to carry out the international search; and
- a language of publication; and
- a language accepted by this receiving Office (unless the international application is filed in a language of publication); that is, into the (or one of the) following language(s):

2. The applicant is hereby **invited**

a. to furnish the required translation within one month from the date of receipt of the international application (date of receipt: _____);

b. in the event that the required translation is not furnished within the time limit referred to in item 2.a, to furnish that translation

- within one month from the date of mailing of this Invitation or
- within two months from the date of receipt of the international application (date of receipt: _____),

whichever expires later,

together with a late furnishing fee of _____ .

3. **Failure to furnish** the required translation and/or, where applicable, to pay the required late furnishing fee within the applicable time limit referred to in item 2.b will result in the international application being considered withdrawn.

A copy of this invitation is being sent to the International Bureau.

Name and mailing address of the receiving Office

Facsimile No.

Authorized officer

Telephone No.

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

INVITATION TO FURNISH TRANSLATION OF
INTERNATIONAL APPLICATION AND TO PAY,
WHERE APPLICABLE, LATE FURNISHING FEE

(PCT Rule 12.3(c) and (e))

To:

Date of mailing <i>(day/month/year)</i>
--

Applicant's or agent's file reference

TIME LIMIT see paragraph 2 below
--

International application No.

International filing date/Date of receipt <i>(day/month/year)</i>
--

Applicant

1. The applicant is hereby notified that this receiving Office has **not yet received the required translation of the international application** into a language which is all of the following:
 - a language accepted by the International Searching Authority that is to carry out the international search; and
 - a language of publication; and
 - a language accepted by this receiving Office (unless the international application is filed in a language of publication); that is, into the (or one of the) following language(s):

2. The applicant is hereby **invited**
 - a. to furnish the required translation within one month from the date of receipt of the international application
_____ (date of receipt:);
 - b. and in the event that the required translation is not furnished within the time limit referred to in item 2.a, to furnish that translation
 - within one month from the date of mailing of this Invitation or
 - within two months from the date of receipt of the international application
(date of receipt: _____),
 whichever expires later,

 together with a late furnishing fee of _____ .

WARNING: Failure to furnish the required translation and/or, where applicable, to pay the required late furnishing fee within the applicable time limit referred to in item 2.b will result in the international application being considered withdrawn. **However, any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 15 months from the priority date will be considered to have been received before the expiration of that time limit.**

A copy of this invitation is being sent to the International Bureau.

Name and mailing address of the receiving Office	Authorized officer
Facsimile No.	Telephone No.

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

INVITATION TO FURNISH TRANSLATION OF
INTERNATIONAL APPLICATION AND TO PAY,
WHERE APPLICABLE, LATE FURNISHING FEE

(PCT Rule 12.4(c) and (e))

To:		Date of mailing (day/month/year)	
Applicant's or agent's file reference		TIME LIMIT see item 2 below	
International application No.	International filing date/Date of receipt (day/month/year)	Priority date (day/month/year)	
Applicant			

1. The applicant is hereby notified that this receiving Office has **not yet received the required translation of the international application** into a language of publication accepted by this receiving Office that is, into the (or one of the) following language(s):

2. The applicant is hereby **invited**:

- a. to furnish the required translation within 14 months from the priority date
- b. in the event that the required translation is not furnished within the time limit referred to in item 2.a, to furnish the required translation within 16 months from the priority date

together with a late furnishing fee of _____

3. **Failure to furnish** the required translation and/or, where applicable, to pay the required late furnishing fee within the applicable time limit referred to in item 2.b will result in the international application being considered withdrawn and so declared by the receiving Office. **However**, any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 17 months from the priority date will be considered to have been received before the expiration of that time limit.

A copy of this invitation is being sent to the International Bureau

Name and mailing address of the receiving Office	Authorized officer
Facsimile No.	Telephone No.

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

INVITATION TO FURNISH TRANSLATION OF
INTERNATIONAL APPLICATION AND TO PAY,
WHERE APPLICABLE, LATE FURNISHING FEE

(PCT Rule 12.4(c) and (e))

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

TIME LIMIT
see item 2 below

International application No.

International filing date/Date of receipt
(day/month/year)

Priority date (day/month/year)

Applicant

1. The applicant is hereby notified that this receiving Office has **not yet received the required translation of the international application** into a language of publication accepted by this receiving Office that is, into the (or one of the) following language(s):

2. The applicant is hereby **invited**:

- a. to furnish the required translation within 14 months from the priority date;
- b. and in the event that the required translation is not furnished within the time limit referred to in item 2.a, to furnish the required translation within 16 months from the priority date

together with a late furnishing fee of _____

WARNING: Failure to furnish the required translation and/or, where applicable, to pay the required late furnishing fee within the applicable time limit referred to in item 2.b will result in the international application being considered withdrawn and so declared by the receiving Office. **However**, any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 17 months from the priority date will be considered to have been received before the expiration of that time limit.

A copy of this invitation is being sent to the International Bureau

Name and mailing address of the receiving Office

Facsimile No.

Authorized officer

Telephone No.