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Les documents de travail sont aussi disponibles sur le site Internet de l'OMPI (voir http://www.wipo.int/pct/fr/meetings/reform_wg/reform_wg2.htm).

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IMPROVED COORDINATION OF
INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION
AND THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE:

EXPANDED INTERNATIONAL SEARCH SYSTEM

Document prepared by the International Bureau

BACKGROUND

1. At its first session held in November 2001, the Working Group discussed proposals for an expanded international search report (EISR).¹ This document² contains revised proposals. The Working Group's discussions are outlined in paragraphs 7 to 10 of the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) ("first session summary"):

"7. Discussions were based on documents PCT/R/WG/1/2, 3, 3 Add.1, 3 Add.2 and 7, focusing on a proposed system for an expanded international search report (EISR),

¹ See WIPO's Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

² This and other working documents for the present session are available on WIPO's Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

which would include an opinion of the examiner in addition to the present contents of the ISR proper.

“8. The general concept of the proposed EISR attracted great interest and considerable support, subject to certain comments and concerns mentioned below. As a basic consideration, it was necessary to meet the needs of certain DOs and EOs, particularly small and medium-sized Offices, including those in developing countries, for examiners’ opinions, especially in view of the recent adoption by the Assembly of a 30-month time limit for entering the national phase under Article 22. While it was recognized that other proposals for reform of the PCT search and examination system might be elaborated, none had been put forward so far, and the EISR proposal was a useful starting point for discussion.

“9. The comments and concerns expressed by various delegations as to the implications of a possible EISR system included the following:

- (i) while the heavy workload faced by some ISAs and IPEAs was an important feature in the background, proposals which merely deferred the problem or shifted workload onto applicants or other Offices were not the most satisfactory;
- (ii) any increase in fees associated with the proposed EISR system compared to the present fees for IS would be a matter for serious concern, particularly for inventors and small enterprises; suggestions made by the larger ISAs as to maintaining the present fees for EISR, or containing any increases, and offsetting any increase by a reduction of the fees for IPE were, however, encouraging;
- (iii) the proposal was seen by certain delegations as a valuable step in the direction of greater mutual recognition of search and examination results and eventually towards the development of a world patent system;
- (iv) while recognizing the efficiencies that would result from search and examination being undertaken by the same examiner at the same time, some delegations would prefer to retain a separated system, at least as an option for applicants and/or Authorities;
- (v) some delegations felt that the EISR system, if adopted, should be optional for applicants, particularly if it would involve payment of higher fees at the time of filing the application; other delegations felt that the EISR system should be mandatory, particularly having regard to the consequences of the Assembly’s adoption of a 30-month time limit under Article 22;
- (vi) it was agreed that the EISR should be produced as part of the IS rather than the IPE procedure;
- (vii) while the examiner’s opinion and the ISR proper should, under an EISR system, be established at the same time by the same examiner, a number of delegations felt that the two components could, and should, then be processed separately;

- (viii) delegations differed as to whether the examiner's opinion should be made public or remain confidential between the ISA, DOs and the applicant; some believed that the opinion would contain little more of substance than the ISR proper, and should therefore be published with it; others believed that public availability of a negative opinion could be unfairly damaging, particularly if the applicant had no chance to rebut it;
- (ix) the interest of DOs in receiving the EISR, particularly smaller DOs, including those in developing countries, was clearly recognized;
- (x) many delegations expressed concern at the suggestion that the EISR might not be available in sufficient time to enable the applicant to withdraw the application before its publication if the EISR was negative; it was also noted, however, that certain ISAs are in any event finding difficulty in meeting the present time limit for producing ISRs;
- (xi) most delegations believed that IPE following the issuance of an EISR should not be mandatory but rather that it should follow only if the applicant so requested;
- (xii) while the maximum advantage from the EISR procedure would accrue if the same examiner carried out both the EISR and any subsequent IPE, it was not necessary to require that the same Authority must conduct both the IS and the IPE; it was already possible for IPEAs to declare themselves prepared to examine only those applications which they have searched as ISA, and certain IPEAs had already exercised that option;
- (xiii) while certain delegations believed that an EISR should be confined to an elaboration of details contained in the ISR, most delegations felt that it should cover similar matters to those dealt with in the present first written opinion in the IPE procedure;
- (xiv) certain delegations emphasized the distinction between, on the one hand, publication of the opinion part of the EISR as part of the published pamphlet, which could be unfairly damaging to applicants, and, on the other, making it available for public inspection like other parts of the application file;
- (xv) concern was expressed that the EISR procedure might add new burdens on the IB to prepare a translation of the opinion during the international phase and on applicants to prepare translations of comments for the purposes of the national phase;
- (xvi) the operation of the EISR procedure should be as simple as possible.

“Expanded international search (EIS) system: Possible features

“10. It was agreed that the International Bureau should prepare a revised proposal, along the lines of the system outlined in the following subparagraphs, for consideration by the Working Group at its next session:^{3, 4}

(a) For all international applications, the examiner in the ISA would, as part of the IS procedure, prepare a more detailed opinion (ISO) at the same time as preparing the ISR.

(b) The scope and contents of the ISO would be similar to the present first written opinion in the IPE procedure (see Rule 66.2(a)).

(c) The ISR should be published, as at present, with the international application itself (that is, 18 months from the priority date). It was recognized, however, that certain ISAs are facing difficulties in meeting the present deadline for production of ISRs and that that problem may need to be addressed soon, and certain delegations felt that increased flexibility in the time limit for establishing the ISR and ISO would be necessary.

(d) The ISO would be communicated to the applicant with the ISR.

(e) The applicant would have to choose which of the following options to pursue:

(i) request IPE within, say, [two months from the date of the ISO] [25 months from the priority date];

(ii) submit to the IB comments on the ISO (and the ISR) and/or submit Article 19 amendments and an accompanying statement;

(iii) withdraw the application;

(iv) do nothing.

(f) If the applicant requested IPE:

(i) the processing of the application would be governed by Chapter II;

(ii) the ISO would, if the same Office acted in the capacity of ISA and IPEA, be treated as a first written opinion in the IPE procedure; if different Offices carried out the IS and the IPE, the IPEA would be entitled, but would not be obliged, to treat the ISO as the first written opinion in the IPE procedure;

³ All references to time limits in the following subparagraphs should be understood as subject to review in the context of paragraph 10(o).

⁴ Square brackets indicate that alternatives would be included in the revised proposals.

- (iii) [the ISO would remain confidential as against third parties and DOs and EOs until such time as the IPER was established and the IPE file became available to public inspection (via the EO); if the demand was withdrawn before establishment of the IPER, the application would revert to Chapter I and the ISO would be made available for public inspection accordingly] [the ISO should be available for public inspection at an earlier stage, noting the interest of third parties in having access to it, even when IPE was requested];
 - (iv) any comments responding to the ISO would be treated as being submitted as arguments and/or amendments under Article 34;
 - (v) the IPER would be established and communicated in the usual way.
- (g) If the applicant did not request IPE:
- (i) the processing of the application would be governed by Chapter I;
 - (ii) the ISO, together with any comments, would be sent to DOs;
 - (iii) the ISO, together with any comments, would be made available for public inspection by the IB; when the IB's systems so permitted, this would be done by electronic means;
 - (iv) the ISO and any comments would not be included in the published pamphlet (or its electronic equivalent);
 - (v) the ISO would be made available for public inspection [at the expiry of the time limit for requesting IPE] [after the expiry of the time limit for submitting comments] [at a time corresponding to the time at which the IPER would normally issue (say, 28 months from the priority date)];
 - (vi) any Article 19 amendments and statement would, as at present, be published together with the published pamphlet (or its electronic equivalent) (unless the ISR was not yet available, in which case the amendments and statement would be published later).
- (h) Comments would need to be submitted at an early stage in order to be taken into account during the IPE procedure. If IPE was not requested, they should be submitted before the ISO was made publicly available if they were to be made available with the ISO, but comments submitted later in the international phase could still be made available and taken into consideration during the national phase.
- (i) Possibilities for greater incorporation of the Article 19 procedure into the EIS system should be investigated.
- (j) [If the applicant withdrew the application before its publication, the ISR would not be published and the ISO would not be made available for public inspection.] [If the ISR and ISO did not become available in sufficient time to enable withdrawal of

the application before its publication, the ISO would not be made available for public inspection if the applicant withdrew the application forthwith after receiving them.]

(k) Provision should be made to enable the demand to be filed, if the applicant so wished, at the same time as the filing of the application; in such a case:

- (i) the IPE would not commence until the necessary fees had been paid; those fees would not need to be paid at the time of filing but would fall due at the expiration of the time limit for requesting IPE;
- (ii) new possibilities for a combination of IS and IPE, such as was presently envisaged in present Rule 69.1(b), should be investigated and improved procedures for such a combined procedure should be developed.

(l) An outer time limit should be fixed for requesting IPE; the IPEA would be entitled to refuse to proceed with the IPE if it was requested after the expiration of that time limit.

(m) A system should also be introduced to enable the IPER to be made available for public inspection by the IB, on behalf of the EOs.

(n) Appropriate provision should be made to enable applicants to give notice of proposed amendments of the description and drawings (as well as the claims) in comments filed in response to the ISO, and for those proposed amendments to be taken into account by DOs in the event that the applicant did not request IPE.

(o) The fixing of appropriate time limits would require consideration of the following issues:

- (i) special provision should be made for international applications not claiming priority (PCT “first filings”) as, for example, the time limits under present Rule 46;
- (ii) the time limit for submitting comments on an ISO should enable them to be submitted in time to be made available for public inspection together with the ISO;
- (iii) the time limits for filing a demand and for filing amendments under Article 34 should be reviewed so as to ensure optimal coordination of the EIS and IPE procedures;
- (iv) earlier time limits may need to apply in cases where the same Office did not act in the capacity of both ISA and IPEA;
- (v) the need for flexibility for applicants and Authorities in meeting various different requirements would need to be balanced against the need for a system with clear and certain operation.

(p) Further consideration needed to be given to requirements relating to the language and possibly translations of the ISO and any comments submitted on it (noting

that the ISR and IPER are presently translated by the IB into English, and applicants are presently required to furnish translations of the application and annexes to the IPER for the purposes of the national phase).”

FEATURES OF THE PROPOSED EXPANDED INTERNATIONAL SEARCH SYSTEM

2. Proposed amendments of the Regulations⁵ for introducing an expanded international search system, taking into account, to the extent possible, the points mentioned in paragraphs 7 to 10 of the first session summary, are set out in the Annex.⁶ The key features of the proposed system are outlined in the following paragraphs.

Establishment of ISO

3. With regard to every international application (IA), the International Searching Authority (ISA) would establish, at the same time that it establishes the international search report (ISR), a non-binding, preliminary “international search opinion” (ISO) (see paragraph 10(a) of the first session summary). The ISO would contain an opinion as to whether the IA complies with certain requirements, which would correspond directly to the matters referred to in Article 34(2)(c), that is: (i) whether the invention satisfies the criteria of novelty, inventive step and industrial applicability; (ii) whether the IA complies with the requirements of the Treaty and the Regulations (so far as checked by the ISA); and (iii) any observations corresponding to those referred to in Article 35(2), last sentence. In other words, the scope of the ISO would be similar to the present written opinion in the international preliminary examination (IPE) procedure, except that, unlike the written opinion, the ISO would always be issued even if all of the conditions referred to in Article 34(2)(c) are fulfilled (see paragraph 10(b) of the first session summary). In this latter sense, the ISO would correspond more to the present IPER than to the first written opinion.

4. The time limit for establishing the ISO would be the same as that currently applicable for the ISR (see Rule 42.1), that is, three months from the date of receipt by the ISA of the search copy or 9 months from the priority date, whichever time limit expires later. The presently proposed amendments do not attempt to deal expressly with the possibility of a later time limit for the establishment of the ISR (see paragraph 10(c) of the first session summary and paragraphs 41 and 42, below).

5. The ISO would be established in the language in which the international search report is established. In order to ease the burden on the International Bureau (IB), which would be obliged to translate the ISO, if not in English, into English, and so as to reduce the costs for the International Bureau and keep the fees payable by the applicant to a minimum (see

⁵ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc.

⁶ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

paragraph 10(p) of the first session summary), the Working Group may, however, wish to consider an alternative approach under which the ISO would be established, at the option of the ISA, either in English or in the language in which the international search report is established. In this context, the Working Group may also wish to consider applying the same approach to the establishment of the ISR and the IPER and to allow the Authorities to establish those reports, if so wished, in English. With regard to the language of the comments on the ISO furnished by the applicant, see paragraph 15, below.

Communication of ISO to applicant

6. The ISO would be communicated by the ISA, together with the ISR, to the applicant and to the IB (see paragraph 10(d) of the first session summary).

Options for the applicant

7. After having received the ISR and the ISO, the applicant would have the choice of the following options to pursue (see paragraph 10(e) of the first session summary):

- (i) submit to the IB comments on the ISO (see paragraph 8, below); and/or
- (ii) submit to the IB amendments of the claims under Article 19.1 (see paragraph 16, below; and/or
- (iii) request international preliminary examination (IPE) (see paragraphs 25 to 33, below);

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

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

Comments on the ISO

8. After the receipt of the ISO, the applicant would be entitled to one opportunity to submit to the International Bureau (IB) comments on the ISO.

9. The main purpose of such comments would be to give the applicant an opportunity to rebut any opinion contained in the ISO with which he does not agree, noting that the ISO will be communicated to the designated Offices (DOs) (see paragraphs 19 and 20, below) and will be made available for public inspection (see paragraphs 22 and 23, below). Such opportunity would appear to be of particular importance in cases where no demand for IPE is submitted and thus no opportunity exists (besides any amendment of the claims under Article 19) to amend the international application during the international phase.

10. Furthermore, as had been suggested in paragraphs 10(f)(iv) of the first session summary, it is proposed to provide for the possibility that proposed amendments outlined in the comments on the ISO may be treated as amendments of the application, provided that they are clearly identified as amendments and provided that they would only need to be taken into account by the IB (under Article 19) or, where a demand had been submitted, by the IPEA

(under Article 34) if the requirements under Articles 19 and 34, respectively, and the requirements under the corresponding Rules, were met.

11. As regards the possibility of giving notice of proposed amendments to DOs in the comments on the ISO, it is proposed, as has been suggested in paragraph 10(n) of the first session summary, to provide for the possibility that proposed amendments outlined in the comments on the ISO may be treated as amendments of the application under Article 28. Such amendments would be required to be clearly identified as amendments and would only need to be taken into account by the DO if the requirements under Article 28 and the requirements under corresponding Rule 52 were met.

12. Where no demand is submitted, it is proposed to give the applicant the opportunity to submit comments within a time limit of 28 months from the priority date so as to ensure that the comments are available in time for being communicated, together with the ISO, to the DOs and for being made available, together with the ISO, for public inspection (both proposed to take place promptly after the expiration of 30 months from the priority date, see paragraphs 19 and 22, below; see also paragraph 10(h) and (o)(ii) of the first session summary).

13. Where a demand is submitted, it is proposed to give the applicant the opportunity to submit comments only until the time of filing of the demand, noting that, after the filing of the demand, the processing of the application would be governed by Chapter II and that the applicant would have other possibilities of rebutting the ISO, such as by submitting arguments and/or amendments under Article 34.

14. The same time limits for submitting comments would apply to both IAs claiming priority and IAs not claiming priority – no special provision would appear necessary in the case of the latter (as had been suggested in paragraph 10(o)(i) of the first session summary).

15. In order to ease the burden on the applicant (who, upon entry into the national phase, normally would have to translate any comments on the ISO for the purposes of the national phase procedure), it is proposed to give the applicant the option of furnishing the comments on the ISO either in English or in the language of publication and to require all DOs to accept, for the purpose of the national phase, comments in English (see paragraph 10(p) of the first session summary and paragraph 35, below).

Amendments of the claims under Article 19

16. As at present, after the receipt of the ISR (and the ISO), the applicant would have the opportunity under Article 19 to amend the claims (only), within the time limit under present Rule 46.1, in particular with a view to international publication (in which the Article 19 amendments are included) and any provisional protection the applicant may enjoy under the national law of DOs. While, in general, such Article 19 amendments would be distinct from, and processed separately and differently from, any comments on the ISO submitted by the applicant, such amendments may be included in any comments on the ISO and, under certain conditions, be taken into account as amendments under Article 19 (see paragraph 10, above). Of course, such amendments under Article 19 could include amendments to the claims filed in response not only to the ISR but also in response to the ISO, without the need for the amendments to be specifically indicated as being filed in response to one or the other (see also paragraph 10(i) of the first session summary).

International publication

17. Unless the applicant has withdrawn the IA, the IA would, as at present, be published promptly after the expiration of 18 months from the priority date, together with the ISR and any Article 19 amendments of the claims but without the ISO or any comments thereon furnished by the applicant (see paragraph 10(c) of the first session summary). Both the ISO and any comments thereon would remain confidential until a later date (see paragraphs 18 to 24, below).

Confidentiality of ISO and of comments thereon

18. The ISO and any comments thereon furnished by the applicant would remain confidential as against third parties and DOs until such time as, had a demand been filed, the IPER would have been established and the IPE file became available for public inspection (via the EOs) (see paragraph 10(g)(v) of the first session summary, third square-bracketed option). Since this is usually the case only after the expiration of 30 months from the priority date, it is proposed to apply the same time limit to both the communication to DOs of the ISO and any comments thereon (see paragraphs 19 to 21, below) and to the making available for public inspection of those documents (see paragraphs 22 to 24, below). The first square-bracketed option in paragraph 10(g)(v) of the first session summary, namely making the ISO available for public inspection at the expiration of the time limit for requesting IPE, has not been included at this stage. Although, strictly speaking, if no demand had been filed, Article 38 would not be applicable, given the similarity between ISO and written opinion, it would appear preferable to apply, with regard to confidentiality, the same principles to the ISO as are applied to the written opinion (and the IPER). The approach proposed in this document appears to be in line with the second square-bracketed option in paragraph 10(g)(v) of the first session summary, namely, making the ISO and any comments available after the expiration of the time limits for submitting comments (see paragraph 12, above).

Communication of ISO and of comments thereon to designated Offices

19. As indicated above, the ISO and any comments thereon furnished by the applicant would be communicated to DOs at 30 months from the priority date, that is, at the same point in time at which, had a demand been filed, the IPER would have been established and the IPE file would have become available for public inspection (via the EOs) (see paragraph 10(g)(v) of the first session summary, third square-bracketed option). As had been suggested in paragraphs 10(h)(i) and (iii) of the first session summary, the ISO and any comments thereon would be communicated only to DOs: where a demand has been submitted and an IPER established, the processing of the application would (continue to) be governed by Chapter II and EOs would rely on the Article 38 procedure to gain access to the ISO and any comments thereon (see paragraph 23, below). In the latter connection, see also other proposals being made to this session of the Working Group whereby all possible elections would automatically be made; if those proposals do not proceed, the question of access by EOs to the ISO may have to be reviewed.

20. The ISO, when communicated to the DOs, if not in English, would, if so requested by the DO, be accompanied by a translation into English, prepared by or under the responsibility of the IB (as is the case for the IPER), which would be required to have it ready in time for communication to interested DOs promptly after the expiration of 30 months from the priority date (see paragraph 19, above; see paragraph 29, below, with regard to the translation of the ISO for the purposes of IPE). As is the case for IPERs, an ISO in English or translated into

English would have to be accepted by all DOs for the purposes of national phase processing, and no DO would be entitled to require the applicant to furnish a translation of the ISO into any other language (see paragraph 10(p) of the first session summary).

21. Where a demand has been submitted and an IPER has been established and thus no communication of the ISO to DOs is to be effected (see paragraph 19, above), no translation of the ISO into English would be prepared (unless a translation is needed for the purpose of IPE, see paragraph 29, below).

Public inspection of ISO and of comments thereon

22. As indicated above, the ISO (and any translation into English thereof), together with any comments on the ISO submitted by the applicant, would be made available for public inspection by the IB, but not before the expiration of 30 months from the priority date, that is, not before the point in time at which, had a demand for IPE been filed, the IPER would have been made available, via elected Offices (EOs), to third parties (see paragraph 10(g)(v) of the first session summary, third square-bracketed option).

23. As has been suggested in paragraph 10(f)(iii) of the first session summary, it is proposed not to make the ISO (and any translation thereof and any comments thereon) available for public inspection if a demand for IPE has been filed and an IPER has been established. In such a case, the processing of the application would be governed by Chapter II and the ISO (and any translation thereof and any comments thereon) would remain confidential, with the exception that EOs (and, via the EOs, depending on the applicable national law, third parties) would get access to those documents once the IPER has been established (as is the case today, under Article 38(1), with regard to any other document relating to IPE). If a demand has been submitted but no IPER is established (for example, because the applicant has withdrawn the demand or the demand is considered not to have been submitted), the application would revert to Chapter I and the ISO (and any translation thereof and any comments thereon) would both be communicated to DOs and made available for public inspection (see paragraph 10(f)(iii) of the first session summary).

24. Furthermore, the ISO (and any translation thereof and any comments thereon) would not be made available for public inspection if the applicant withdraws the international application in time to prevent international publication (see paragraph 10(j) of the first session summary). Finally, as suggested in paragraph 10(j) of the first session summary, it is proposed not to make the ISO (and any translation thereof and any comments thereon) available for public inspection if the applicant withdraws the IA within two months after receipt of the ISO (even if the withdrawal of the IA occurs after international publication).

International preliminary examination

25. In the context of introducing the ISO, it is necessary to consider changes to the IPE procedure which would make it worthwhile for the applicant to still make use of the international preliminary examination procedure under Chapter II. To do so, it is proposed to fix a time limit for the filing of the demand which, on the one hand, would be later than the one being applied today (in practice, 19 months from the priority date) but which, on the other hand, would leave enough time for the IPEA to provide a “value added” IPE service to the applicant by establishing, in particular cases, in addition to the ISO established by the ISA, a “second” written opinion (see paragraphs 31 and 32, below). In the context of introducing the ISO, it is thus proposed to fix the time limit for filing the demand at two months after the

receipt by the applicant of the ISR and the ISO or 20 months from the priority date, whichever expires later.

26. Contrary to the suggestion inherent in paragraph 10(l) of the first session summary, if a demand was filed after the expiration of the applicable time limit, it is proposed not to give the IPEA the choice whether or not to carry out IPE. Instead, any demand made after the expiration of that time limit would be considered as if it had not been submitted and the IPEA would so declare. Such a clear “cut-off” date would appear preferable, in particular in view of the changes proposed in paragraphs 38 and 39, below (filing of the demand at the same time as filing of the IA).

27. As at present, if the applicant files a demand for IPE, the further processing of the IA would be governed by Chapter II (see paragraph 10(f)(i) of the first session summary).

28. Upon receipt of a demand or a copy thereof from the IPEA, the IB would transmit to the IPEA copies of the ISO (unless the IPEA has already established the ISO in its capacity as ISA) and any comments on the ISO submitted by the applicant (in the original language, if received prior to the filing of the demand).

29. Upon request of the IPEA, where the ISO is not in English or in a language accepted by the IPEA, a translation into English of the ISO would be prepared by the IB and transmitted to the IPEA within two months following the request for translation (see paragraph 10(p) of the first session summary). All IPEAs would be required to accept ISOs established in or translated by the IB into English.

30. If the comments on the ISO submitted by the applicant are not in English or a language accepted by the IPEA, the applicant would be invited by the IPEA to furnish a translation into the required language. If the applicant did not comply with that invitation, the comments would not need to be taken into account by the IPEA for the purposes of IPE (see paragraph 10(p) of the first session summary).

31. If the same Office acts in the capacity of ISA and IPEA, the ISO would be treated as a first written opinion in the IPE procedure (of course, only in case the ISO states that not all of the conditions referred to in Article 34(2)(c) are fulfilled) (see paragraph 10(f)(ii) of the first session summary).

(a) As at present, the IPEA would be required to take into account any Article 19 amendments made by the applicant and any Article 34 arguments/amendments made together with the demand or later during the IPE procedure. In addition, the IPEA would also be required to take into account any comments on the ISO submitted by the applicant prior to the filing of the demand (unless superseded by any arguments/amendments furnished by the applicant under Articles 19 and 34). In general, those comments would be treated in the same way as arguments submitted under Article 34, while any proposed amendments outlined in the comments would, under certain conditions (see paragraph 10, above), be treated as amendments under Article 34.

(b) Where the applicant files Article 34 amendments within two months from the time of filing the demand or 22 months from the priority date, whichever expires later, or where the applicant had submitted comments on the ISO prior to the filing of the demand, the applicant would be entitled to receive, and the IPEA required to establish, a second written opinion (of course, only where the IPEA still considers that not all of the conditions under

Article 34(2)(c) are fulfilled). As at present, further arguments/amendments would not need to be taken into account by the IPEA if they are received after the IPEA has begun to draw up the second written opinion or the IPER (see paragraph 10(o)(iii) of the first session summary).

(c) Where the applicant does not file any Article 34 arguments/amendments within the applicable time limit referred to in paragraph (b), above, and did not file any comments, the “normal” IPE procedure would apply. The ISO would still be treated as the (first) written opinion but, as at present, the IPEA may, but would not be obliged to, issue a second written opinion; as at present, the applicant would be entitled to submit further arguments/amendments under Article 34, provided that, as at present, such arguments/amendments would not need to be taken into account by the IPEA if they are received after the IPEA has begun to draw up (any second written opinion or) the IPER.

32. If the IS and the IPE are carried out by different Offices, the IPEA would be entitled, but not obliged, to treat the ISO as the first written opinion. If the IPEA is willing to treat the ISO as the first written opinion, the procedure as outlined in paragraph 31, above, would apply. If the IPEA is not willing to treat the ISO as a (first) written opinion (in which case the IPEA would be obliged to notify the applicant accordingly), the “normal” IPE procedure would apply: the applicant would be entitled, as at present, to receive one written opinion, with the opportunity to submit arguments/amendments under Article 34, provided that, as at present, arguments/amendments would not need to be taken into account by the IPEA if they are received after the IPEA has begun to draw up the written opinion or the IPER (see paragraph 10(f)(ii) of the first session summary).

33. As at present, in all cases, the IPER would be established within the applicable time limit under Rule 69 (that is, usually within 28 months from the priority date) and communicated by the IPEA to the applicant and to the IB (see paragraph 10(f)(v) of the first session summary).

National phase processing before DO

34. Upon national phase entry before a DO, the applicant would have the opportunity, as at present, under Article 28, to (further) amend the description, the claims and the drawings within the time limit under Rule 52, that is, within one month from the fulfillment of the requirements for national phase entry before the DO concerned (see paragraph 10(n) of the first session summary). As outlined in paragraph 11, above, any proposed amendments outlined in the comments on the ISO may also be treated as amendments of the application under Article 28, provided that they are clearly identified as such and provided that they only need to be taken into account by the DO if the requirements under Article 28 and the requirements under corresponding Rule 52 are met.

35. If the comments on the ISO are not in English or a language accepted by the DO for the purposes of national phase procedure and the applicant wishes the DO to take the comments into account during the national phase, the applicant would be required to furnish to the DO, together with any necessary translation of the IA and any amendments under Article 19, a translation of the comments into a language accepted by the DO for the purposes of the national phase procedure. If the applicant does not do so, the DO may invite the applicant to furnish a translation, failing which the DO would be entitled to disregard any comments (see paragraph 10(p) of the first session summary).

36. Of course, given the preliminary, non-binding character of the ISO, any DO may, but would not be obliged to, take the ISO into account for the purposes of the national phase.

National phase processing before EO

37. In general, national phase processing before any EO would not change as compared to today's situation. (See paragraph 19, above, as to the question of access by EOs to the ISO.)

DEMAND FILED AT THE SAME TIME AS THE FILING OF THE INTERNATIONAL APPLICATION

38. In the context of introducing the expanded international search system, it is proposed to enable the applicant, if he so wishes, to submit the demand at the same time as the filing of the international application or at any time thereafter prior to the expiration of the time limit for filing the demand (see paragraph 25, above), as has been suggested in paragraph 10(k) of the first session summary. In order to enable the applicant to do so, it is proposed to postpone the due date for the payment of the handling fee and the preliminary examination fee (at present, one month from the date of filing of the demand) and to provide that those fees only fall due within one month from the date of filing of the demand or 20 months from the priority date, whichever expires later (see, however, paragraph 39, below), with the same invitation procedure and further extension of the time limit for payment as applies at present if the fees have not been paid (in full). Of course, IPE procedures would only start if the applicant has paid in full, within the applicable time limit, the amount due for the handling fee and the preliminary examination fee, including, where applicable, a late payment fee.

39. As an exception to the general rule that the handling fee and the preliminary examination fee fall due within one month from the date of filing of the demand or 20 months from the priority date, whichever expires later (see paragraph 38, above), it is proposed to set an earlier due date for the payment of those fees where the IPEA is part of the same national Office or intergovernmental organization as the ISA and wishes to start the IPE at the same time as the IS, namely, one month from the date of filing of the demand. Otherwise, no special provision has been included at this stage which would introduce new possibilities for a combination of IS and IPE, beyond what is envisaged in present Rule 69.1(b), as had been suggested in paragraph 10(k)(ii) of the first session summary. Present Rule 69.1(b) appears sufficient to enable an IPEA to start the IPE at the same time as the IS.

DOCUMENTS AVAILABLE FOR PUBLIC INSPECTION AT THE INTERNATIONAL BUREAU ON BEHALF OF ELECTED OFFICES

40. In the context of introducing the expanded international search system, it is proposed to amend present Rule 94.3 so as to enable the IB to make available to third parties, on behalf of the EOs, a copy of the international preliminary examination report to which third parties at present only have access via the EOs, as had been suggested in paragraph 10(m) of the first session summary.

TIME LIMIT FOR INTERNATIONAL SEARCH

41. Under the proposed EIS system, the ISO would be established at the same time as the ISR, that is, within 3 months from the date of receipt by the ISA of the search copy or 9 months from the priority date, whichever expires later (see present Rule 42.1). The Working Group at its first session was informed that certain ISAs are facing difficulties in

meeting the present deadline for production of ISRs and that that problem may need to be addressed soon. However, at this stage, in the context of introducing the expanded international search system, it is not proposed to amend Rule 42.1 to allow for increased flexibility in the time limit for establishing the ISR (and ISO) (see paragraph 10(c) of the first session summary), as was suggested at the session by certain delegations.

42. Should the Working Group wish to introduce additional flexibility in the time limit for the international search, Rule 42 could be amended, for example, so as to permit the Director General, in consultation with the ISA concerned, if an ISA is unable, for reasons of excessive workload, in respect of certain technical fields, to meet the existing time limit for establishing the international search report under Rule 42, to fix a longer time limit for the establishment of international search reports in those technical fields by the ISA concerned, and to fix the period for which that longer time limit would apply. Any such longer time limit would then also automatically apply, under new Rule 45*bis*.1(a), to the establishment of ISOs in those technical fields by the Authority concerned.

43. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

EXPANDED INTERNATIONAL SEARCH SYSTEM

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Rule 32

**Extension of Effects of International Application to
Certain Successor States**

32.1 [No change]

32.2 *Effects of Extension to Successor State*

(a) [No change]

(b) Where, in the case of a successor State which is bound by Chapter II of the Treaty, the request for extension was made after, but the demand was made before, the expiration of the [time limit applicable under Rule 54bis.1\(a\)](#) ~~19th month from the priority date~~, and a later election is made of the successor State within three months from the date of the request for extension, the applicable time limit under paragraph (a)(ii) shall be at least 30 months from the priority date.

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed amendment of Rule 56.1(e) (see below).]

(c) [No change]

Rule 43bis

International Search Opinion

43bis.1 Establishment of International Search Opinion

(a) The International Searching Authority shall, at the same time as it establishes the international search report, establish an international search opinion.

(b) The objective of the international search opinion is to formulate a preliminary and non-binding opinion as to:

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

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

(iii) any other matters that these Regulations provide for.

[COMMENT: The matters to be reported on in the ISO correspond to those mentioned in Article 34(2)(c) in relation to the IPE written opinion; see paragraph 10(a) of the first session summary and paragraph 3 in the “Background” section of this document.]

43bis.2 Relevant Prior Art; Inventive Step or Non-Obviousness

For the purposes of establishing the international search opinion, Article 33(2) to (6) and Rules 64 and 65 shall apply *mutatis mutandis* and the relevant date referred to in those Rules shall be the international filing date.

[COMMENT: Proposed new Rule 43bis.2 appears necessary so as to clarify that, as is the case for the international search report, the relevant date for determining prior art is the international filing date and not, as may be the case for international preliminary examination, the priority date. Accordingly, as at present, the ISA would not be required to verify any claimed priority date (see PCT International Search Guidelines, paragraph VI-4.1).]

43bis.3 International Search Opinion

(a) The international search opinion shall be based on the international application as filed. Rule 66.1(f) shall apply *mutatis mutandis*.

[COMMENT: Proposed new paragraph (a) appears necessary so as to clarify that the ISA would not need to establish the ISO with regard to claims which have not been searched. Reference is made to Rule 66.1(f) instead of present Rule 66.1(e) only because Rule 66.1(e) has been renumbered (see below) but remains unchanged otherwise.]

(b) Articles 35.2 and 35.3, and Rules 67, 70.2(d), 70.3, 70.4(ii), 70.6 to 70.9 and 70.12 shall apply *mutatis mutandis*.

[COMMENT: While, in paragraph 10(b) of the first session summary, it is suggested that the scope and contents of the ISO would be similar to the present first written opinion in the IPE procedure, and reference is made to Rule 66.2(a), it appears more appropriate to refer to the corresponding provisions in Article 35(2) and 35(3) and Rule 70 since the ISO, as a document to be sent to the applicant separate from the ISR, appears to be, from a formal point of view, closer to an IPER-style “report” than to a written notification containing certain negative statements as listed in Rule 66.2. This also would appear to reflect the current practice under

[Rule 43bis.3(b), continued]

which the IPEAs send out, as the written opinion, a first draft of the IPER which contains more information than is required under Rule 66.2 (for example, not only a negative statement as referred to in Rule 66.2(a)(ii) but a full statement similar to the full IPER as referred to in Rule 70.6). Rule 70.12(iii) corresponds to Rule 66.2(a)(i), Rule 70.6 corresponds to Rule 66.2(a)(ii), Rule 70.12(i) corresponds to Rule 66.2(a)(iii), Rule 66.2(a)(iv) is not applicable in the context of the ISO, Rule 70.12(ii) corresponds to Rule 66.2(a)(v), Rule 70.2(d) corresponds to Rule 66.2(a)(vi), and Rule 70.12(iv) corresponds to Rule 66.2(a)(vii).]

(c) Every international search opinion shall be in the language in which the international search report is established.

[COMMENT: See paragraph 10(p) of the first session summary and paragraph 5 in the “Background” section of this document.]

43bis.4 Transmittal of International Search Opinion

The International Searching Authority shall, together with the international search report, transmit one copy of the international search opinion to the International Bureau and one copy to the applicant.

[COMMENT: See paragraph 10(d) of the first session summary.]

43bis.5 Translation of International Search Opinion for Designated Offices

(a) Any designated State may require that the international search opinion, established in any language other than the official language, or one of the official languages, of its national Office, be accompanied, when communicated to it under Rule 43quater.1, by a translation into English.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

(c) Any translation referred to in paragraph (a) of the international search opinion shall be prepared by or under the responsibility of the International Bureau.

(d) The International Bureau shall transmit a copy of the translation referred to in paragraph (a) of the international search opinion to the applicant at the same time as it communicates such translation to the interested designated Office or Offices. The applicant may make written observations, in English or the language of the international search opinion, on what, in his opinion, are errors of translation in the translation of the international search opinion and shall send a copy of any such observations to each of the interested designated Offices and a copy to the International Bureau.

[COMMENT: See paragraph 10(p) of the first session summary and proposed new Rule 43bis.3(c), above. See also paragraph 20 in the “Background” section of this document. While, if a demand has been submitted, no translation of the ISO would be established for any DOs, a translation of the ISO may nevertheless be prepared, for the purposes of international preliminary examination, if so requested by the IPEA (see Rule 43quater.2(b), below); in such a case, the applicant would also have the opportunity to comment on that translation, and to submit a copy of any such comments to the IPEA (see Rule 43quater.2(c), below). The wording of Rule 43bis.5 corresponds largely to that of present Rule 72 concerning translations of the IPER.]

Rule 43ter

Comments on International Search Opinion

43ter.1 Opportunity to Comment on International Search Opinion

(a) The applicant shall be entitled to one opportunity to submit, within 28 months from the priority date, written comments on the international search opinion, provided that, if a demand is submitted, such comments shall be submitted before or together with the demand.

[COMMENT: See paragraphs 10(h) and 10(o)(ii) of the first session summary and paragraphs 12 and 13 in the “Background” section of this document.]

(b) Any comments referred to in paragraph (a) shall be submitted directly to the International Bureau.

[COMMENT: See paragraph 10(e)(ii) of the first session summary.]

43ter.2 Language, Form and Contents of Comments

(a) Any comments submitted under Rule 43ter.1 shall, at the option of the applicant, be in English or in the language in which the international application is to be published. They shall be identified as such by a heading, preferably by using the words “Comments on the International Search Opinion” or their equivalent in the language of the comments.

[COMMENT: See paragraph 10(p) of the first session summary and paragraph 15 in the “Background” section of this document.]

(b) The comments shall contain no disparaging comments on the international search opinion or the international search report. They may contain arguments but shall preferably not contain any proposed amendments of the international application. Where any such proposed amendment is contained in the comments, it shall be considered to be:

(i) an amendment under Article 19 only if clearly identified as such and only if the requirements of Rule 46 are met;

(ii) an amendment under Article 34 only if clearly identified as such and only if the requirements of Rules 66.4bis, 66.5, 66.8 and 66.9 are met;

(iii) an amendment under Article 28 only if clearly identified as such and only if the requirements of Rule 52 are met.

[COMMENT: See paragraph 10(f)(iv) of the first session summary and paragraphs 9 to 11 in the “Background” section of this document.]

Rule 43^{quater}

Communication and Transmittal of International Search Opinion,

Translation and Comments

43^{quater}.1 Communication to Designated Offices

(a) Subject to paragraph (c), the international search opinion, together with any comments thereon (in the original language) submitted by the applicant under Rule 43^{ter}.1, shall be communicated by the International Bureau to each designated Office promptly after the expiration of 30 months from the priority date, unless communication at an earlier time is requested or authorized by the applicant.

[COMMENT: See paragraph 10(o)(ii) of the first session summary and paragraphs 19 and 20 in the “Background” section of this document.]

(b) Subject to paragraph (c), the International Bureau shall transmit a copy of the translation of the international search opinion referred to in Rule 43^{bis}.5(a) to any interested designated Office at the same time as it communicates to that Office the documents referred to in paragraph (a).

[COMMENT: See paragraph 10(o)(ii) of the first session summary and paragraphs 19 and 20 in the “Background” section of this document. The copy of the translation of the ISO would only be communicated to “interested” designated Offices, that is, designated Offices which, under Rule 34^{bis}.5(a), have requested to receive such translation.]

[Rule 43quater.1, continued]

(c) Paragraphs (a) and (b) shall not apply if a demand has been submitted and an international preliminary examination report has been established.

[COMMENT: See paragraph 10(f)(iii) of the first session summary and paragraph 19 in the “Background” section of this document.]

43quater.2 Transmittal to International Preliminary Examining Authority

(a) Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority a copy of the international search opinion and of any comments thereon (in the original language) submitted by the applicant under Rule 43ter.1, except that the copy of the international search opinion need not be transmitted to the International Preliminary Examining Authority where that Authority is the Office or intergovernmental organization that established the international search opinion in its capacity as International Searching Authority.

(b) Upon request of the International Preliminary Examining Authority, the international search opinion shall, when not in English or in a language accepted by that Authority, be translated into English. The translation shall be prepared by or under the responsibility of the International Bureau and shall be transmitted to the International Preliminary Examining Authority within two months from the date of receipt by the International Bureau of the request for translation.

[Rule 43quater.2, continued]

(c) The International Bureau shall transmit a copy of the translation referred to in paragraph (b) to the applicant at the same time as it communicates such translation to the International Preliminary Examining Authority. The applicant may make written observations on the accuracy of the translation of the international search opinion and shall send a copy of any such observations to the International Preliminary Examining Authority and a copy to the International Bureau.

(d) Any international search opinion established in or translated into English shall be accepted by all International Preliminary Examining Authorities for the purposes of international preliminary examination. The International Preliminary Examining Authority may take into account any written observations on the translation of the international search opinion sent to it by the applicant under paragraph (c).

[COMMENT: In view of the fact that, if a demand for IPE has been submitted, no translation into English of the ISO is prepared for the benefit of the designated Offices under proposed new Rule 43bis.5, it is proposed to add new paragraphs (b) to (d) so as to allow the IPEA to request a translation of the ISO into English where such translation is needed for the purposes of IPE and so as to clarify that an ISO in English or translated into English must be accepted by all IPEAs for the purposes of IPE (as is the case for the ISR).]

(e) Notwithstanding Rule 43ter.1(a), if, at the time when the International Bureau receives any comments made by the applicant under Rule 43ter.1, a demand has already been submitted, the International Bureau shall, promptly after the receipt of any comments, transmit a copy of such comments (in the original language) to the International Preliminary Examining Authority, except if a copy of the international preliminary examination report has already been received by the International Bureau.

[Rule 43quater.2(e), continued]

[COMMENT: As is the case for amendments under Article 34 (see present Rule 66.4*bis*; see also proposed new Rule 66.1(e), below), any comments submitted by the applicant after the filing of the demand and late in the IPE procedure need, of course, not be taken into account if the IPEA has already begun to draw up the written opinion or the IPER.]

Rule 43quinquies

Confidential Nature of International Search Opinion, Translation and Comments

43quinquies.1 Confidential Nature

(a) Subject to Rule 43quater.2, neither the International Bureau nor the International Searching Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4), to the international search opinion, to any translation thereof, to any written observations on that translation sent by the applicant under Rule 43quater.2(c), or to any comments on the international search opinion submitted by the applicant under Rule 43ter.1, before the expiration of 30 months from the priority date. In any event, no such access shall, unless requested or authorized by the applicant, be allowed where

(i) no international publication of the international application is effected;

[COMMENT: See paragraph 10(j) of the first session summary, first square-bracketed option.]

(ii) the applicant withdraws the international application under Rule 90bis.1 within two months after the receipt by the applicant of the international search opinion;

[COMMENT: See paragraph 10(j) of the first session summary, second square-bracketed option.]

[Rule 43quinquies.1(a), continued]

(iii) a demand has been submitted and an international preliminary examination report has been established.

[COMMENT: See paragraph 10(f)(iii) of the first session summary and paragraphs 22 and 23 in the “Background” section of this document.]

(b) The International Preliminary Examining Authority shall not, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4), to the international search opinion, to any translation thereof, to any written observations on that translation sent by the applicant under Rule 43quater.2(c), or to any comments on the international search opinion submitted by the applicant under Rule 43ter.1, by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

[COMMENT: See paragraph 10(f)(iii) of the first session summary and paragraphs 22 and 23 in the “Background” section of this document. Modeled after Article 38(1).]

Rule 49

Copy, Translation and Fee Under Article 22

49.1 and 49.2 [No change]

49.3 *Statements Under Article 19; Indications Under Rule 13bis.4*

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1), ~~and~~ any indication furnished under Rule 13bis.4 [and any comments submitted under Rule 43bis.1\(a\)](#) shall, subject to Rule 49.5(c), ~~(c-ter)~~ and (h), be considered part of the international application.

[COMMENT: Rule 49.3 is proposed to be amended so as to clarify that, for the purposes of Article 22 and Rule 49 (in particular the translation requirements under Rule 49.5, below), any comments submitted by the applicant under proposed new Rule 43bis.1 are considered part of the international application and thus, depending on the requirements of the designated Office (see Rule 49.5 as proposed to be amended, below), may have to be translated upon entry into the national phase.]

49.4 [No change]

49.5 *Contents of and Physical Requirements for the Translation*

(a) For the purposes of Article 22, the translation of the international application shall contain the description (subject to paragraph (a-bis)), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs [\(a-ter\)](#), (b), (c-bis) and (e),

[Rule 49.5(a), continued]

(i) [No change]

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended, ~~and~~

(iii) if comments on the international search opinion have been submitted under Rule 43ter.1, contain those comments, and

(iv) be accompanied by a copy of the drawings.

(a-bis) [No change]

(a-ter) No designated Office shall require the applicant to furnish to it a translation of any comments on the international search opinion submitted under Rule 43ter.1 if such comments are in English.

[COMMENT: See paragraph 10(p) of the first session summary and paragraph 15 in the “Background” section of this document.]

(b) to (c-bis) [No change]

[Rule 49.5, continued]

(c-ter) Any designated Office requiring under paragraph (a) the furnishing of a translation of any comments submitted under Rule 43ter.1 shall, where the applicant failed to furnish such translation within the time limit applicable under Article 22, invite the applicant to furnish such translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the translation is not furnished within the time limit fixed in the invitation, the designated Office may disregard such comments.

[COMMENT: Modeled after Rule 49.5(c-bis).]

(d) to (l) [No change]

(k) No designated Office shall require the applicant to furnish to it a translation of the international search opinion.

[COMMENT: New paragraph (k) is proposed to be added so as to clarify that any necessary translation of the ISO into English could never be requested from the applicant, noting that the provision of such a translation is the responsibility of the International Bureau under Rule 43bis.5(c) and (d).]

Rule 54bis

Time limit for Making a Demand

54bis.1 Time Limit for Making a Demand

(a) A demand may be made at any time prior to the expiration of two months from the date on which the international search report was transmitted to the applicant under Rule 45bis.2 or 20 months from the priority date, whichever expires later.

[COMMENT: See paragraph 10(1) of the first session summary and paragraph 25 in the “Background” section of this document.]

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

[COMMENT: See paragraph 10(1) of the first session summary and paragraph 26 in the “Background” section of this document.]

Rule 55

Languages (International Preliminary Examination)

55.1 to 55.3 [No change]

55.4 Translation of Comments on International Search Opinion

(a) If the language in which the comments on the international search opinion have been submitted under Rule 43ter.1 is not English or a language accepted by the International Preliminary Examining Authority, that Authority shall, if practicable having regard to the time limit for establishing the international preliminary examination report, invite the applicant to furnish the comments in the required language within a time limit which shall be reasonable under the circumstances.

(b) If the applicant fails to comply, within the time limit under paragraph (a), with the invitation to furnish the comments in the required language, or if it is not practicable to issue such invitation having regard to the time limit for establishing the international preliminary examination report, the comments need not be taken into account for the purposes of the international preliminary examination.

[COMMENT: See first session summary, paragraph 10(p). Modeled in part after Rule 66.9(c) and (d).]

Rule 56

Later Elections

56.1 *Elections Submitted Later than the Demand*

(a) to (d) [No change]

(e) Any ~~If a~~ notice effecting a later election ~~is~~ submitted after the expiration of the time limit applicable under Rule 54bis.1(a) ~~19 months from the priority date~~ shall be considered as if it had not been submitted and, the International Bureau shall so declare ~~notify the applicant that the election does not have the effect provided for under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in respect of the elected Office concerned within the time limit applicable under Article 22.~~

[COMMENT: It is proposed to amend paragraph (e) so as align the time limit for the submission of a notice of later election to the time limit for filing of a demand under proposed new Rule 54bis.1(a) (see above). In view of the recent modification of the time limit under Article 22(1), one could, alternatively, consider to allow for a longer time limit for the submission of later elections, say, until the establishment of the IPER (usually, 28 months from the priority date) (Rule 78.2, see below, would also have to be amended accordingly.)]

(f) [No change]

56.2 to 56.5 [No change]

Rule 57

The Handling Fee

57.1 and 57.2 [No change]

57.3 *Time Limit for Payment; Amount Payable*

(a) Subject to paragraphs (b) and (c), the ~~The~~ handling fee shall be paid within one month from the date on which the demand was submitted or 20 months from the priority date, whichever expires later., ~~provided that,~~

(b) Where ~~where~~ the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the handling fee shall be paid within one month from the date of receipt by that Authority or 20 months from the priority date, whichever expires later.

[COMMENT: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

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

[Rule 57.3(c), continued]

[COMMENT: See paragraph 10(k)(ii) of the first session summary and paragraph 39 in the “Background” section of this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

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

[COMMENT: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

57.4 and 57.5 *[Remain deleted]*

57.6 [No change]

Rule 58bis

Extension of Time Limits for Payment of Fees

58bis.1 Invitation by the International Preliminary Examining Authority

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

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

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

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

[COMMENT: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document. The proposed change appears necessary for two reasons: (i) to clarify that the finding whether the amount paid is insufficient to cover the handling fee and the preliminary examination fee needs to be done already upon receipt of any amount intended to cover those fees and not only at the time fees are due (which may be as late as 20 months from the priority date); and (ii) to clarify that no invitation to pay fees should be send out to the applicant where the applicant has filed the demand early (say, at the same time as the international application) but where the fees are not yet due (in such a case, they would not be due before the expiration of 20 months from the priority date).]

(b) to (d) [No change]

58bis.2 [No change]

Rule 59

The Competent International Preliminary Examining Authority

59.1 and 59.2 [No change]

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

(a) and (b) [No change]

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

(i) [No change]

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

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

(d) to (f) [No change]

Rule 61

Notification of the Demand and Elections

61.1 to 61.3 [No change]

61.4 *Publication in the Gazette*

Where a demand has been filed before the expiration [the time limit applicable under Rule 54bis.1\(a\)](#) ~~of 19 months from the priority date~~, the International Bureau shall, promptly after the filing of the demand but not before the international publication of the international application, publish in the Gazette information on the demand and the elected States concerned, as provided in the Administrative Instructions.

[COMMENT: Proposed amendment of Rule 61.4 is consequential on the proposed introduction of new Rule 54bis. Section 431 of the Administrative Instructions, providing for the details as to which information on the demand and the elected States is to be published in the Gazette, would also have to be modified.]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 *Basis of the International Preliminary Examination*

(a) Subject to paragraphs (b) to [\(e\)](#) ~~(d)~~, the international preliminary examination shall be based on the international application as filed.

(b) [No change]

[COMMENT: After review, it is not proposed to introduce a shorter time limit for submitting Article 34 amendments, as was suggested in paragraph 10(o)(iii) of the first session summary, and to leave the present time limit unchanged.]

(c) and (d) [No change]

[\(e\) Any comments on the international search opinion submitted by the applicant under Rule 43ter.1 shall, subject to Rules 43ter.2\(b\)\(ii\) and 66.4bis, be taken into account for the purposes of the international preliminary examination in the same manner as arguments or amendments submitted under Article 34, unless superseded, or considered as reversed, by an amendment under Article 19 or 34.](#)

[COMMENT: See paragraph 10(f)(iv) of the first session summary and paragraph 10 in the “Background” section of this document.]

[\(f\)](#) ~~(e)~~ Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

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

(a) Subject to paragraphs (e) and (f), if ~~if~~ the International Preliminary Examining Authority

(i) to (vii) [No change]

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

(b) to (d) [No change]

[Rule 66.2, continued]

(e) If the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority and the international search opinion:

(i) states that the claimed invention does not appear to be novel, to involve an inventive step (to be non-obvious) or to be industrially applicable; or

(ii) states that the international application does not comply with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority; or

(iii) contains any other observations provided for in these Regulations;

the international search opinion shall be considered to be the first written opinion and the International Preliminary Examination Authority shall notify the applicant accordingly.
Rules 66.2(c) and (d) and 66.3 shall apply *mutatis mutandis*.

[COMMENT: See paragraph 10(f)(ii) of the first session summary and paragraph 31 in the “Background” section of this document.]

[Rule 66.2, continued]

(f) If the International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the International Searching Authority and the international search opinion contains any statement or observation as referred to in paragraph (e)(i) to (iii) of this Rule, the International Preliminary Examining Authority, at its option:

(i) may decide to consider the international search opinion to be the first written opinion, in which case it shall, promptly after the receipt of the demand, notify the applicant accordingly; Rules 66.2(c) and (d) and 66.3 shall apply *mutatis mutandis*; or

(ii) may decide not to consider the international search opinion to be the first written opinion, in which case it shall, promptly after the receipt of the demand, notify the applicant accordingly and proceed as provided in paragraph (a); it may, however, take the international search opinion into account for the purposes of international preliminary examination.

[COMMENT: See paragraph 10(f)(ii) of the first session summary and paragraph 32 in the “Background” section of this document.]

66.3 [No change]

66.4 *Additional Opportunity for Submitting Amendments or Arguments*

(a) Subject to paragraph (a-bis), if ~~If~~ the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and Rules 66.2 and 66.3 shall apply.

(a-bis) If, under Rule 66.2(e) or (f)(i), the International Preliminary Examining Authority treats the international search opinion as the first written opinion and the applicant responds to that written opinion within two months from the date on which the demand was submitted or 22 months from the priority date, whichever expires later, by making amendments or by submitting arguments under Article 34(2), the Authority shall, if it still considers that not all of the conditions referred to in Article 34(2)(c) are fulfilled, issue an additional written opinion, and Rules 66.2 and 66.3 shall apply.

[COMMENT: See paragraph 10(f)(ii) of the first session summary and paragraphs 25 and 31 in the “Background” section of this document.]

(b) [No change]

66.4bis 5 to 66.9 [No change]

Rule 69

Start of and Time Limit for International Preliminary Examination

69.1 *Start of International Preliminary Examination*

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

(i) the demand; ~~and~~

(ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2; and

(iii) ~~of~~ either the international search report or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established.

[COMMENT: See paragraph 10(k)(i) of the first session summary and paragraph 38 in the “Background” section of this document.]

(b) to (e) [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be:

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

whichever expires last.

[COMMENT: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document.]

Rule 78

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

78.1 *Time Limit Where Election Is Effected Prior to Expiration of the Time Limit Applicable Under Rule 54bis.1(a) ~~19 Months from Priority Date~~*

(a) Where the election of any Contracting State is effected prior to the expiration of the time limit applicable under Rule 54bis.1(a) ~~19th month from the priority date~~, the applicant shall, if he so wishes, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfillment of the requirements under Article 39(1)(a), provided that, if the transmittal of the international preliminary examination report under Article 36(1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any other time if so permitted by the national law of the said State.

(b) In any elected State in which the national law provides that examination starts only on special request, the national law may provide that the time limit within or the time at which the applicant may exercise the right under Article 41 shall, where the election of any Contracting State is effected prior to the expiration of the time limit applicable under Rule 54bis.1(a) ~~19th month from the priority date~~, be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under paragraph (a).

[Rule 78.1, continued]

[COMMENT: Proposed amendment of Rule 78.1 is consequential on the introduction of new time limit for the filing of a demand under proposed new Rule 54bis.1(a) (see above) and the recent modification of the time limit under Article 22(1).]

78.2 *Time Limit Where Election Is Effected After Expiration of the Time Limit Applicable*

Under Rule 54bis.1(a) ~~19 Months from Priority Date~~

Where the election of any Contracting State has been effected after the expiration of the time limit applicable under Rule 54bis.1(a) ~~19th month from the priority date~~ and the applicant wishes to make amendments under Article 41, the time limit for making amendments under Article 28 shall apply.

[COMMENT: Proposed amendment of Rule 78.2 is consequential on the proposed amendment of Rule 56.1(e) (see above). See also the Comment on Rule 56.1(e), above.]

Rule 92bis

Recording of Changes in Certain Indications

in the Request or the Demand

92bis.1 Recording of Changes by the International Bureau

(a) [No change]

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

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

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

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

Rule 94

Access to Files

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

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 [and Rule 43quinquies](#), furnish, subject to the reimbursement of the cost of the service, [a copy](#) ~~copies~~ of any document contained in its file, [including a copy of the international preliminary examination report where an elected Office has requested the International Bureau to provide access to that report on behalf of that Office.](#)

[COMMENT: See paragraphs 10(g)(iii) and (m) of the first session summary and paragraph 40 in the “Background” section of this document.]

94.2 and 94.3 [No change]

[End of Annex and of document]

WIPO



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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM:

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

Document prepared by the International Bureau

BACKGROUND

1. At its first session, held in Geneva from November 12 to 16, 2001, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals for a new concept and operation of the designation system, based on the proposed new or amended Rules set out in document PCT/R/WG/1/1 and on document PCT/R/WG/1/7.¹
2. Taking into account the comments and concerns expressed by various delegations during the discussions on this matter in the first session of the Working Group, and the areas where agreement has been reached, as summarized in paragraphs 12 to 20 of the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”), this

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

document² sets out revised proposals for amendment of the Regulations³ designed to implement the new concept and operation of the designation system.

3. Similar to the order of the discussions on this matter in the first session of the Working Group, revised proposals for new or amended Rules contained in this document are divided into four parts and contained in the four Annexes to this document:⁴

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

Annex II: Related proposals: Automatic indication of all designations possible under the PCT;

Annex III: Related proposals: “Flat” international filing fee;

Annex IV: Related proposals: “Communication-on request” system.

Automatic indication of all designations possible under the PCT

4. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

“12. The comments and concerns expressed by various delegations included the following:

- (i) the proposed new approach of Rule 4.9(a) and (b), in so far as it would enable applicants to make an automatic indication of all designations possible under the PCT, was fully supported;
- (ii) noting that the proposed Rule changes would defer to the national phase all decisions and choices by the applicant as to the countries in which protection was sought and as to the kinds of protection sought, certain delegations expressed the view that applicants should have the possibility of excluding designations at the time of filing the international application and/or of withdrawing designations later during the international phase, notwithstanding that this would retain a degree of complexity in the system; certain reasons expressed are noted in items (iii) to (vii), below;

² This and other working documents for the present session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

³ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc.

⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

- (iii) it was noted that Article 8(2)(b) expressly contemplated the possibility that an international application may include the designation of only one State; other Articles to be borne in mind in this context included Articles 22, 24 and 37;
- (iv) the applicable national law in certain countries would be incompatible with an automatic designation system which did not allow for exclusions of certain designations; for example, some national laws provided for the automatic withdrawal of an earlier national application if a later international application claimed priority based on that national application and designated the country concerned (“self-designation”); this was a matter of great concern to the Delegations of Germany and Japan, in particular;
- (v) applicants might be under contractual obligations not to seek protection in certain countries, although it was noted that contractual obligations could be expressed differently if the system were changed so as to operate on different principles;
- (vi) it would be necessary in some circumstances to be certain that the designation of a particular country did not have undesirable results arising from the prior art effect of the international application in that country;
- (vii) certain provisions relating to the requirement applicable in certain countries that the inventors be indicated as applicants would be burdensome to comply with in cases where the applicant had no intention of entering the national phase in those countries;
- (viii) it was noted that, where the international application was to be treated as an application for a continuation or continuation-in-part, information concerning the parent application involved was needed at the time of filing the international application;
- (ix) in the context of proposed amended Rule 4.15, most delegations expressed support for yet a further reduction of the requirement for signature of the international application; a review of the present requirements should include a review of provisions concerning the appointment of agents and common representatives;
- (x) Rule 32 should be reviewed to see whether, in the light of the proposed new all-inclusive approach to designations, successor States could not automatically be dealt with by the same kind of approach.

“13. It was agreed that the approach taken in document PCT/R/WG/1/1 in connection with Rules 4, 49*bis* and 90*bis* should be retained, subject to further consideration of the matters mentioned in paragraph 12, above, and to the following:

- (i) a [transitional] reservation provision should be included which would enable applicants to exclude and/or withdraw the designation of any State whose Office had notified the IB, [subject to the timing provisions usual for such

provisions,] that proposed Rule 4.9(a) and (b) were incompatible with the national law applicable in that State;

- (ii) a revised draft should include the following alternatives for consideration: (1) eliminate all signature requirements; (2) require the signature of only one applicant where the international application is filed by several applicants (and similarly in the case of the demand); (3) provide for an RO to waive the need for signature of the international application requirements for papers filed with that Office; (4) provide for an RO to waive the need for a power of attorney where the international application is filed by an agent;
- (iii) where the international application was to be treated as an application for a continuation or continuation-in-part, information concerning the parent application involved should continue to be required in the request;
- (iv) the International Bureau should study the issues mentioned above relating to Articles 8, 22, 24 and 37, prior art effect, the naming of inventors as applicants, and Rule 32, and should provide the results to the Working Group.”

5. Annex I to this document contains revised proposals for new or amended Rules, addressing, in particular, comments and concerns expressed during the first session of the Working Group with regard to the following issues:

(a) *Exclusion of State from being designated.* A transitional reservation provision has been included which would enable applicants to exclude the designation of any State whose Office had notified the International Bureau, subject to the timing provisions usual for such provisions, that the proposed automatic designation of all Contracting States Rule 4.9(a) and (b) were incompatible with the national law applicable in that State (see Rule 4.9(c) as proposed to be amended).

(b) *Withdrawal of individual designations.* So as to address concerns expressed by various delegations (in particular in view of the wording of Article 24(1)(i), see paragraphs 12(ii) and (iii) of the first session summary), it is no longer proposed to delete Rule 90bis.2, so that, under the new approach, as at present, the applicant may withdraw individual designations. This would also appear to address the concern with regard to the wording of PCT Article 8(2)(b), as noted in paragraph 12(iii) of the first session summary, since it would continue to be possible that an international application would contain the designation of only one State (in case the applicant withdraws all but one designation).

(c) *Continuation or continuation in part.* It is no longer proposed to delete Rules 4.1(b)(v) and 4.14, so that, under the new approach, as at present, the applicant would be required to indicate, in the request, the parent application concerned if he wishes his application to be treated, in any designated State, as a continuation or continuation in part.

(d) *Rule 32.* This Rule is proposed to be amended so as to bring it in line with the proposed new approach with regard to designations.

(e) *Prior art effect.* Noting that PCT Article 27(5) expressly states that "...any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art...", it would appear impossible to include, in the Regulations, a provision which would provide certainty, as has been suggested in paragraph 12(vi) of the first session summary, "that the designation of a particular country did not have undesirable results arising from the prior art effect of the international application in that country." In other words, in view of the fact that the definition as to what constitutes prior art (other than for the purposes of the international phase) is a matter of the national law of each Contracting State, each Contracting State may wish to review whether its national law may need to be adapted to the new approach with regard to designations. Already at present, the national laws of many Contracting States provide that an international application designating the particular State concerned is considered as comprised in the state of the art not as of the international filing date of the international application but only as of the date on which the applicant has performed the acts for entering the national phase before that Office.

(f) *Naming of applicant as inventor.* The concern expressed by various delegations (see paragraph 12(vii) of the first session summary) that the inventors would always need to be indicated as applicants since the international application would, under the new approach, always contain the designation of the United States (the only PCT Contracting State with such a requirement), resulting in a great burden for applicants who had no intention of entering the national phase in that State, has been addressed in the context of the proposals to simplify and streamline the signature requirements (see paragraph (g), below). It will be proposed in a separate document prepared for consideration by the Working Group that, while there would still be a requirement to indicate inventors as applicants, there would no longer be a requirement that such applicants must to sign the request or a power of attorney.

(g) *Signature requirements.* Given the importance of the provisions relating to signature requirements, proposals to simplify and streamline the present regime as to signature requirements have not been included in this document but will be presented to the Working Group in a separate document (see document PCT/R/WG/2/[...]).

Automatic indication of all designations possible under the PCT

6. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

"16. The comments and concerns expressed by various delegations included the following:

- (i) most delegations expressed support for the proposed new approach of Rules 53 and 56 in so far as it would enable applicants to make an automatic indication of all possible elections;
- (ii) similar considerations applied in the case of elections as in that of designations in relation to the possible need for applicants to be able to exclude and/or withdraw particular elections;

- (iii) it was noted that Article 31(4) expressly mentioned the possibility that Contracting States may be elected later and that Article 37 expressly stated that the applicant may withdraw any election;
- (iv) Rule 61.4 should be further reviewed with a view to aligning its current wording with the new approach with regard to elections.

“17. It was agreed that the approach taken in proposed Rules 53, 56 and 90bis should be retained, subject to further consideration of the matters mentioned in paragraph 16, above.”

7. Annex II to this document contains revised proposals for new or amended Rules, addressing, in particular, comments and concerns expressed during the first session of the Working Group with regard to the following issues:

(a) *Exclusion of State from being elected.* While Rule 4.9(c) as proposed to be amended allows for the exclusion of certain Contracting States from being designated, it appears not necessary to also allow for the exclusion of certain States from being elected (as mentioned in paragraph 13(ii) of the first session summary).

(b) *Withdrawal of individual elections.* So as to address concerns expressed by various delegations (in particular in view of the wording of PCT Article 37(1), see paragraphs 12(iii), 13(ii) and 13(iii) of the first session summary), it is no longer proposed to eliminate the concept of withdrawals of individual elections, so that, under the new approach, as at present, the applicant may withdraw individual elections.

(c) *Later elections.* While, in view of the proposed new concept of elections, there appears to be no real need to maintain, in the Regulations, a formal procedure for making “later elections”, noting the wording of Article 31(4), second sentence (“Additional Contracting States may be elected later”), it is not any longer proposed to eliminate the concept of “later elections”. In practice, since - under the new approach - automatically all designated States would always be elected, a “later election” could only occur where the applicant, after the filing of a demand, withdraws an individual election and later “corrects” this withdrawal by electing that State (again) (by way of a “later election” within the applicable time limit).

(d) *Rule 61.4.* Rule 61.4 has been reviewed, as suggested in paragraph 13(iv) of the first session summary, but no change is proposed to be made to Rule 61.4 in the context of this document. Section 431 of the Administrative Instructions would have to be modified so as to bring it in line with the proposed new concept of eliminating the need for individual elections and the fact that, under the proposed new approach, exclusion of elections would not any longer be possible.

“Flat” international filing fee

8. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

“14. The comments and concerns expressed by various delegations included the following:

- (i) the introduction of a flat international filing fee, replacing the current separate basic fee and designation fee(s), was fully supported;
- (ii) the proposed flat fee would be appropriate even if it were decided that applicants should continue to have the possibility of excluding and/or withdrawing designations;
- (iii) the fixing of the amount of the new fee, which would take place in the context of approving WIPO’s budget, should take into account the general objective of PCT reform to further reduce costs for applicants; certain delegations expressed the view that the new fee should be lower than the total amount of the basic fee and the maximum number of designation fees payable;
- (iv) the representative of IFIA proposed a study of the possibility of granting a fee reduction to all those applicants who are “natural persons”, irrespective of their nationality and residence;
- (v) there was a lack of available information for third parties as to whether and when international applications had entered the national phase; possibilities included: the (hitherto incomplete) provision of such information by DOs under Rule 86.1(a)(vi) and Section 112; a task already being undertaken in the context of WIPO’s Standing Committee on Information Technologies (see documents SCIT/6/5 and 7); and information produced as a by-product of the use by DOs of the communication-on-request (“COR”) system being developed under WIPO’s IMPACT project.

“15. It was agreed that the approach taken in proposed Rules 15, 16*bis*, 27, 29, 32 and 51, and in the Schedule of Fees, should be retained, subject to further consideration of the matters mentioned in paragraph 14, above.”

9. Annex III to this document contains (slightly) revised proposals for new or amended Rules concerning the introduction of a flat “international filing fee.”

“Communication on request” system

10. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

“18. The comments and concerns expressed by various delegations included the following:

- (i) the coming introduction of the new “communication on request” (COR) system, replacing the current systematic communication of documents to DOs, was noted with approval;
- (ii) certain delegations representing member States with large Offices indicated that, even under the COR system, they wished to continue to receive, preferably in electronic form, all documents related to international applications in which the Office concerned was designated, irrespective of whether national phase entry had taken place; the COR system would support such systematic communication;
- (iii) the COR system should be extended to include communications to ISAs and IPEAs as well as DOs/EOs;
- (iv) Rule 47.1(c), which contained provisions designed to safeguard applicants’ rights having regard to Article 22 in connection with the communication of international applications to DOs, should be reviewed to ensure that the safeguards would operate satisfactorily in conjunction with the COR system;
- (v) consideration should be given to combining Rules 47.1(b) and 47.4;
- (vi) Rule 61.2 should be reviewed to ensure that it would operate satisfactorily with the COR system, noting that Article 31(7) expressly stated that each EO must be notified of its election.

“19. It was agreed that the approach taken in proposed Rules 24.2, 47, 48, 73, 76.5 and 93*bis* should be retained, subject to further consideration of the matters mentioned in paragraph 18, above.”

11. Annex IV to this document contains revised proposals for new or amended Rules, addressing, in particular, comments and concerns expressed during the first session of the Working Group with regard to the following issues:

(a) *Extending the Communication On Request system to ISAs and IPEAs.* Upon further reflection, notwithstanding paragraph 18(iii) of the first session summary, it is proposed not to extend the “communication on request” system to International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs). Other than designated/elected Offices, which actually process only those international applications that enter the national phase before the Office concerned and thus need only the documents which relate to those applications, ISAs and IPEAs process all international applications in respect of which they have been chosen to act as ISA or IPEA and thus need the documents relating to all those applications. Furthermore, there are only a very limited number of provisions in

the PCT Regulations dealing with the communication of information, notifications etc. from the International Bureau to ISAs and IPEAs (see, for example, Rules 24.2(a) and (c), and 62.1), while the vast majority of provisions providing for copies of forms etc. to be sent to those Authorities are to be found in the Administrative Instructions. It thus appears preferable to retain, in principal, the present system under which all communications and notifications are sent to ISAs and IPEAs systematically but to provide, in the Administrative Instructions, specific exceptions with regard to specific communications or notifications the receipt of which ISAs and IPEAs should be able to waive.

(b) *Rules 47.1(c) and 47.4.* These Rules have been reviewed, as suggested in paragraphs 18(iv) and (v) of the first session summary, and amendments are proposed with a view to ensuring that the safeguards of the applicant's rights having regard to Article 22 in connection with the communication of the international application to designated Offices would operate satisfactorily in conjunction with the proposed "communication on request" system.

12. The Working Group is invited to consider the proposals contained in Annexes I to IV to this document.

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT

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Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) The request shall contain:

(i) to (iii) [No change]

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

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

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

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

(i) and (ii) [No change]

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

[Rule 4.1(b), continued]

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

~~(iii) (v) in the case referred to in Rule 4.14, a reference to a parent application or parent patent,~~

[COMMENT: In line with the proposed elimination of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see Rule 4.9(a)(ii) as proposed to be amended, and Rules 4.12 and 4.13 as proposed to be deleted, below), and of the need to specify whether national and/or regional patents are sought (see Rule 4.9(a)(iii) as proposed to be amended, below), it is proposed to delete present items (iii) and (iv) from the list of mandatory contents (where applicable) of the request and to amend and renumber present item (v) accordingly. New item (iii) (amended former item (v)) would still give the applicant the possibility to refer to a parent application where the international application is the continuation or continuation in part of such earlier (parent) application; see also Rule 4.14, below. See also proposed new Rule 49bis, below.]

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

(c) and (d) [No change]

4.2 to 4.8 [No change]

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

(a) The filing of a request shall:

(i) constitute the designation of all Contracting States;

(ii) have the effect of an indication of the wish of the applicant to treat the international application, in each designated State in respect of which Article 43 or 44 applies, as an application for every kind of protection which is available by way of the designation of that State and to defer the express indication referred to in those Articles to the time of performing the acts referred to in Article 22(1);

(iii) have the effect of an indication of the wish of the applicant to treat the international application, in each designated State in respect of which Article 45 applies, as an application for both a regional patent and, unless Article 45(2) applies, a national patent.

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

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

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

[COMMENT: Following comments by various delegations, paragraph (a) has been further amended so as to simplify the wording further. See paragraph (c) with regard to the possibility to exclude certain States from being designated.]

[Rule 4.9, continued]

(b) The national law applicable by a designated Office shall not require that any express indication referred to in Article 43, 44 or 45 be made prior to the time of performing the acts referred to in Article 22(1). ~~The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:~~

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

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

[COMMENT: The aim of paragraph (b) as proposed to be amended is to ensure that the applicant can indeed rely on the new concept of obtaining an automatic and all-inclusive coverage with regard to all possible kinds of protection without the risk of violating the national law applicable in any designated Office. Furthermore, in line with the new concept of designations, there is no need to maintain the present precautionary designation and confirmation system as provided in existing paragraphs (b) and (c).]

(c) Notwithstanding paragraph (a)(i), if, on [date], paragraph (a)(i) is not compatible with the national law applied by the designated Office, the request may, for as long as paragraph (a)(i) continues not to be compatible with that law, contain an indication that the designation of the State for which the said Office acts as designated Office is not made, provided that the said Office informs the International Bureau accordingly by [date]. The information received shall be promptly published by the International Bureau in the Gazette.
~~The confirmation of any designation made under paragraph (b) shall be effected by~~

[Rule 4.9(c), continued]

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

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

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

[COMMENT: Paragraph (c) is proposed to be amended so as to provide, in the form of a transitional reservation provision, for the possibility to exclude certain States from being designated if paragraph (a)(i) is not compatible with the national law applied by the designated Office concerned. Note that the possibility to exclude would only apply to the designation of States but not to kinds of protection or the choice between national and regional patents.]

(d) The applicant may correct or withdraw any indication made under paragraph (c) by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

[COMMENT: New paragraph (d) is proposed to be added since there appears to be a need to allow for the correction of mistakes made when excluding certain designations; without the possibility to correct, it would be impossible to get a designation back into the application once it has been (erroneously) excluded from the designations (such correction is possible under today's "confirmation of precautionary designation system"). It is not foreseen to allow the applicant to "add" an indication of exclusion, since this, in effect, would result in the withdrawal of a designation, an action which the applicant can still perform under

[Rule 4.9(d), continued]

existing Rule 90bis.2, which remains unchanged. As to the time limit within which the applicant can correct or withdraw an “indication of exclusion”, it is proposed to give the applicant more time as is presently the case under the “confirmation of precautionary designation system” (to be compared with that system since, in effect, the correction/withdrawal of an “indication of exclusion” is nothing else than an addition of a designation after the filing of the international application).]

4.10 and 4.11 [No change]

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

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

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

[COMMENT: Rule 4.12 is proposed to be deleted so as to eliminate of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see also Rule 4.9(a)(ii) as proposed to be amended, above, and Rule 4.13 as proposed to be deleted, below).]

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

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

[COMMENT: Rule 4.13 is proposed to be deleted so as to eliminate of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see also Rule 4.9(a)(ii) as proposed to be amended and Rule 4.12 as proposed to be deleted, above).]

4.14 *Continuation or Continuation-in-Part*

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

[COMMENT: Upon further review, as has been suggested in paragraph 12(viii) of the first session summary, it is no longer proposed to deleted Rule 4.14 (as was proposed in document PCT/R/WG/1/1).]

4.14*bis* and 4.15 [No change]

[COMMENT: No change of Rule 4.15 is proposed in the context of this Annex; see, however, changes proposed in the context of a separate document concerning signature requirements.]

4.16 to 4.18 [No change]

Rule 32

Extension of Effects of International Application to Certain Successor States

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

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

[COMMENT: Upon further review, as has been suggested in paragraph 12(x) of the first session summary, and in line with the proposed new approach with regard to designations, it is now proposed to amend Rule 32 so as to automatically extend the effects of an international application to a successor State which has deposited a declaration of continuation under Rule 32.1(a).]

(b) [No change]

[Rule 32.1, continued]

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

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

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

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

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

[COMMENT: Proposed deletion of paragraph (d) would appear consequential on the proposed amendment of paragraph (a).]

32.2 *Effects of Extension to Successor State*

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

(i) the successor State shall be considered as having been designated in the
international application, and

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

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

(b) and (c) [No change]

Rule 48

International Publication

48.1 to 48.5 [No change]

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

48.6 *Announcing of Certain Facts*

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

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

(b) *[Remains deleted]*

(c) [No change]

Rule 49bis

Indications as to Protection Sought for Purposes of National Processing

49bis.1 Choice of Certain Kinds of Protection

(a) If the applicant wishes the international application to be treated, in any designated State in respect of which Article 43 applies, as an application not for the grant of a patent but for the grant of another kind of protection referred to in that Article, the applicant shall so indicate within the time limit applicable under Article 22(1) or 39(1)(a). For the purposes of this paragraph, Article 2(ii) shall not apply.

(b) If the applicant wishes the international application to be treated, in any designated State in respect of which Article 44 applies, as an application for the grant of more than one kind of protection referred to in Article 43, the applicant shall so indicate within the time limit applicable under Article 22(1) or 39(1)(a) and shall also indicate, if applicable, which kind of protection is sought primarily and which kind is sought subsidiarily.

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

[Rule 49bis.1(c), continued]

[COMMENT: See comment to Rule 4.9(a)(ii), above. Under the new concept, the applicant would obtain, when filing an international application, an automatic and all-inclusive coverage with regard to all kind(s) of protection, without the need to specify, already upon filing, which kind(s) of protection he intends to seek in any of the designated States. Instead, under proposed new Rule 49bis, the applicant would be required to do so only upon entry into the national phase before the designated Office concerned. Of course, if the applicant does not make any choice of kind of protection, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)).]

49bis.2 Failure to Furnish Indication or Identification

Where the applicant fails to furnish any indication or identification referred to in Rule 49bis.1 within the time limit referred to in that Rule, the applicant shall have an opportunity to furnish any such indication or identification within a further time which shall be reasonable under the circumstances.

[COMMENT: New Rule 49bis.2 is proposed to be added so as to give the applicant who has not, upon entry into the national phase, complied with the requirement to make the choice of the kind(s) of protection sought, and/or to identify the parent application or grant, another opportunity to do so within a reasonable time limit. Note that there would be no obligation on the designated Office to invite the applicant to make such choice or to identify the parent application or grant. Where the applicant, after the expiration of the applicable time limit, still has not made any choice, or has not identified the parent application or grant, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)); furthermore, provisions under the applicable national law which provide for a conversion of an application for the grant of a patent into an application for the grant of another kind of protection, if any, apply.]

Rule 76

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

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain Deleted]*

76.4 [No change]

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

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

(i) to (iv) [No change]

76.6 [No change]

[Comment: It is proposed to amend Rule 76.5 so as to ensure that proposed new Rule 49bis is also applied with regard to elected Offices.]

Rule 90bis

Withdrawals

90bis.1 to 90bis.7 [No change]

[COMMENT: Upon further review, as has been suggested in paragraphs 12(ii) and (iii) of the first session summary, and in particular in view of the wording of PCT Articles 24(1)(i) and 37(1), it is no longer proposed to eliminate the possibility to withdraw individual designations or elections. Thus, no change is proposed to be made to Rule 90bis.]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RELATED PROPOSALS:

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT

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Rule 53

The Demand

53.1 to 53.6 [No change]

53.7 *Election of States*

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

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

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

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

[COMMENT: Rule 53.7 is proposed to be amended so as to align the concept of election of Contracting States with the proposed new concept of designation. The proposed new wording is necessary to ensure compliance with Article 31(4) which requires that the demand “shall indicate ... the Contracting ... States...in which the applicant intends to use the results of the international preliminary examination.” While Rule 4.9(c) as proposed to be amended allows for the exclusion of certain Contracting States from being designated, it appears not necessary to also allow for the exclusion of certain designated States from being elected.]

53.8 and 53.9 [No change]

Rule 61

Notification of the Demand and Elections

61.1 to 61.3 [No change]

61.4 Publication in the Gazette

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

[COMMENT: Rule 61.4 has been reviewed (as suggested in paragraph 13(iv) of the first session summary) but no change is proposed to be made to Rule 61.4 in the context of this document. However, Section 431 of the Administrative Instructions, providing for the details as to which information on the demand and the elected States is to be published in the Gazette, would have to be modified so as to bring it in line with the proposed new concept of eliminating the need for individual elections and the fact that, under the proposed new approach, exclusion of elections would not any longer be possible. Note that Rule 61.4 is proposed to be amended in the context of the proposed introduction of the expanded international search system and that the 19-months time limit under Rule 61.4 has thus been put in square brackets.]

[Annex III follows]

ANNEX III

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RELATED PROPOSALS:
“FLAT” INTERNATIONAL FILING FEE

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Rule 15

The International Filing Fee

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

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

~~(i) a “basic fee,” and~~

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

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

15.2 *Amounts*

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

[Rule 15.2, continued]

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

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

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

15.3 *[Remains deleted]*

15.4 *Time Limit for Payment; Amount Payable*

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

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

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

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

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

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

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

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

15.6 *Refund*

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

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

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

Rule 16bis

Extension of Time Limits for Payment of Fees

16bis.1 Invitation by the Receiving Office

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

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

[Rule 16bis.1, continued]

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

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

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

(iii) proceed as provided in Rule 29.

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

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

16bis.2 *Late Payment Fee*

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) ~~or (b)~~ may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of 50% of the international filing ~~basic~~ fee referred to in item 1 ~~(a)~~ of the Schedule of Fees.

[COMMENT: The proposed amendments of Rule 16bis are consequential on the proposed elimination of the designation fee and the basic fee.]

Rule 27

Lack of Payment of Fees

27.1 *Fees*

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

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

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

Rule 29

International Applications ~~or Designations~~ Considered Withdrawn

29.1 *Finding by Receiving Office*

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

(i) to (iv) [No change]

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

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

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 51

Review by Designated Offices

51.1 *Time Limit for Presenting the Request to Send Copies*

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

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

51.2 and 51.3 [No change]

SCHEDULE OF FEES

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

Reductions

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

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

[COMMENT: The amount of the international filing fee remains to be determined in the context of WIPO's budget.]

[Annex IV follows]

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

ANNEX IV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RELATED PROPOSALS:
“COMMUNICATION ON REQUEST” SYSTEM

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Rule 24

Receipt of the Record Copy by the International Bureau

24.1 *[Remains deleted]*

24.2 *Notification of Receipt of the Record Copy*

(a) The International Bureau shall promptly notify:

(i) to (iii) [No change]

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

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

[Rule 24.2, continued]

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

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

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

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

(c) [No change]

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) [No change]

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

(a-ter) [No change]

(b) The ~~Such~~ communication provided for in Article 20 shall be effected upon request by the designated Office but, subject to Rule 47.4, not prior to ~~promptly after~~ the international publication of the international application ~~and, in any event, by the end of the 19th month after the priority date~~. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

[Rule 47.1, continued]

(c) The International Bureau shall send a notice to the applicant indicating the designated Offices to which the communication has been effected and the date of such communication. Such notice shall be sent on the same day as the communication. ~~Each designated Office shall be informed, separately from the communication, about the sending and the date of mailing of the notice. The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice.~~

[COMMENT: Upon further review, as has been suggested in paragraph 18(iv) of the first session summary, it appears that, in view of paragraph (e) as proposed to be amended (see below), there is no longer a need for an additional safeguard for the applicant and that paragraph (c) can be amended accordingly. Under paragraph (c) as proposed to be amended, the IB would have to send out a notification to the applicant, informing him about the fact that a particular DO has requested the communication under Article 20 to take place, no matter whether such request was made at the time of publication (“systematic communication”), or later, for example, after national phase entry (“communication on request”).]

(d) [No change]

(e) No designated Office shall require the applicant to furnish a copy of the international application under Article 22(1) unless it has requested the International Bureau, under paragraph (b), to effect the communication and has been informed by the International Bureau that the international application is not in its files. ~~Where any designated Office has waived the requirement provided under Article 20, the copies of the documents which otherwise would have been sent to that Office shall, at the request of that Office or the applicant, be sent to the applicant at the time of the notice referred to in paragraph (c).~~

[Rule 47.1(e), continued]

[COMMENT: Proposed amendments to Rule 47.1(e) would give the applicant the assurance that he could always rely on the fact that a designated Office would not require the applicant to furnish a copy of the international application under Article 22(1) (before or after expiration of the time limit under Article 22(1)) unless it has first requested the International Bureau to effect the communication (“on request) and has been informed by the International Bureau that the international application is not in its files.]

47.2 *Copies*

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

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

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

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

47.3 [No change]

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

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

[COMMENT: Notwithstanding paragraph 18(v) of the first session summary, it is not proposed to combine Rule 47.4 with Rule 47.1(b). Rather, Rule 47.4 is proposed to be amended so as to bring it in line with the new approach taken under Rule 47.1(b) (communication of the pamphlet on request only). Rule 47.1(b) deals with the “usual” case where communication of the pamphlet to a DO will only take place upon request by the DO concerned and only after international publication of the IA; Rule 47.4, on the other hand, deals with the “exceptional” case where the applicant has entered the national phase early before international publication has taken place; in that case, the communication of the international application may take place, upon request of the applicant or the DO concerned, already before international publication.]

Rule 61

Notification of the Demand and Elections

61.1 [No change]

61.2 *Notification to the Elected Offices*

(a) to (c) [No change]

[COMMENT: No change to paragraphs (a), (b) and (c) is proposed in the context of this Annex. See, however, the proposed amendment of paragraphs (b) and (c) in Annex II, above.]

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

[COMMENT: Proposed amendment of paragraph (d) is consequential on the proposed move from a “systematic communication system” to a “communication on request system”. See also Rule Rule 47.4 as proposed to be amended, above.]

61.3 and 61.4 [No change]

Rule 73

**Communication of the
International Preliminary Examination Report**

73.1 [No change]

73.2 *Time Limit for Communication*

The communication provided for in Article 36(3)(a) shall be effected upon request by the elected Office ~~as promptly as possible~~ but not earlier than the communication under Article 20.

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

Rule 76

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

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

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

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

(i) to (iv) [No change]

[COMMENT: Proposed amendment of Rule 76.5 is consequential on the proposed amendment to Rule 47.1.]

76.6 [No change]

Rule 93bis

Communication, Notification and Transmittal on Request

93bis.1 Communication, Notification and Transmittal on Request

Where the Treaty, these Regulations or the Administrative Instructions provide for documents, notifications, communications or correspondence to be communicated, notified or transmitted by the International Bureau to any designated or elected Office, such communication, notification or transmittal shall be effected only upon request by the Office concerned.

[COMMENT: With regard to the suggestion to extend the communication on request system also to ISAs and IPEAs, see paragraph [11(a)] in the "Background" section of this document. In line with the proposed new concept of designations, it is proposed to move from the current communication system under which documents relating to international applications are systematically communicated to all designated/elected Offices to a system under which such communication would only be effected upon request of the designated/elected Office concerned. Without such new approach as to communication, since all Contracting States would always be (considered to be) designated in all international applications, and elected in each demand, each designated/elected Office would be flooded with a vast amount of documents related to international applications which may never enter the national phase before the Office concerned. Of course, any Office which wishes to do so would be entitled to continue to request to receive all documents on a systematic basis.]

[End of Annex and of document]

WIPO



PCT/R/WG/2/3

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

RIGHT OF PRIORITY AND PRIORITY CLAIMS

Document prepared by the International Bureau

BACKGROUND

1. During its first session, held in Geneva from November 12 to 16, 2001, the Working Group discussed proposals to amend the Regulations so as to align the requirements of the Patent Cooperation Treaty (PCT) with regard to priority matters to those of the Patent Law Treaty (PLT) (see document PCT/R/WG/1/5, paragraphs 12 and 13, and Annex III) and proposals to amend Rule 26*bis*.1(a) (see document PCT/R/WG/1/4, paragraph 4).¹ This document² contains revised proposals.

2. As reported in the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”):

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

² This and other working documents for the present session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

“Right of priority and priority claims

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

- (i) there was general agreement with the idea of providing for a means of restoration of priority rights, consistently with corresponding provisions of the PLT, during the international phase of the PCT procedure;
- (ii) noting that the administration of those provisions in the national phase would be a matter for ROs [receiving Offices], the importance of a single standard, or at least consistent practice, among the various ROs was emphasized by several delegations;
- (iii) delegations differed in their views as to the appropriate criterion which should apply in the context of the PCT (under Rule 26bis.3(a)(iii)) in cases where the applicant failed to file the international application within the 12-month priority period, noting that the PLT provided for Contracting Parties to choose between two criteria:
 - most delegations favored adopting the more liberal criterion of “unintentional” failure in the context of the PCT;
 - certain delegations favored adopting the more strict criterion of “due care”;
 - certain delegations favored giving ROs a choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT;
- (iv) it was recognized by the Working Group that provision for restoration of the priority right in the international phase implied that the RO’s decision would need to have effect for the purposes of the national phase;
- (v) most delegations believed that the RO’s decision should be binding on DOs [designated Offices] (as under proposed Rule 26bis.3(f)), but certain delegations believed that the RO’s decision should be subject to review by DOs in at least some circumstances, although there was no agreement as to what circumstances should be relevant in this context;
- (vi) it was pointed out that, if the PCT were to require that one particular criterion be applied by all ROs, it would be possible for an Office to have to apply one criterion in its capacity as a PCT RO and the other criterion in its capacity as a national Office processing national applications or as a DO processing international applications entering the national phase;
- (vii) it was recognized that priority dates had two related but distinct effects:

- “procedural” in the sense that certain important time limits under the PCT were calculated by reference to the priority date;
 - “substantive” in the sense that it was at the priority date that it would be determined whether the invention satisfied the requirements of novelty and inventive step (non-obviousness);
- (viii) the recognition in the national phase of an RO’s decision to restore the priority right was more particularly related to the procedural effect; the procedural effect was the dominant consideration in, for example, PCT Article 2(xi) and Rule 26*bis*.2(a);
- (ix) the fact that a considerable number of countries’ national laws did not presently provide for restoration of priority rights, at least according to PLT criteria, suggested that transitional reservations would need to be allowed for if restoration provisions were to be introduced under the PCT.

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

- (i) provide for restoration of the priority right by the RO based on the “unintentional” criterion, but identifying alternatives in the related comments or explanation;
- (ii) make it clear that it was the procedural effect of the priority right, rather than the substantive effect, that should be recognized for the purposes of the national phase.

“Proposal to amend Rule 26bis.1(a) (see document PCT/R/WG/1/4)

“32. The comments and concerns expressed by various delegations included the following:

- (i) while some delegations expressed concern about the current wording of Rule 26*bis*.1(a) being too complex and indicated that an attempt should be made to simplify the calculation of the time limit under that Rule, most delegations supported the approach of the proposal, subject to further clarification, noting that, in any event, opportunity to correct or add a priority claim should be given only prior to publication of the international application concerned;
- (ii) it was felt that the presentation of examples as to how Rule 26*bis*.1 as proposed to be amended would operate would facilitate discussions.

“33. It was agreed that a revised proposal to amend Rule 26*bis*.1, including examples, should be included in revised proposals to be prepared by the International Bureau in the context of PLT-related proposals concerning priority rights and priority claims, taking into account the matters mentioned in paragraph 32, above.”

3. This document contains a redraft of the proposals and comments contained in documents PCT/R/WG/1/5, Annex III, and PCT/R/WG/1/4, paragraph 4, taking into account

the views expressed, and agreements reached, at the first session of the Working Group, as reported in document PCT/R/WG/1/9, paragraphs 22 and 23 and paragraphs 32 and 33 (see above).

4. The Annex³ to this document sets out specific proposals to include, in the PCT Regulations,⁴ provisions relating to the restoration of the right of priority (see Rules 4 as proposed to be amended and proposed new Rule 26bis.3) as well as provisions relating to the possibility, in line with PLT requirements, that priority documents may be available, in the future, from digital libraries (see Rules 17.1 and 66.7 as proposed to be amended). It also includes proposals to amend Rules 26bis.1 and 26bis.2 and to add new Rule 80.8 relating to the possibility for the applicant to correct or add priority claims.

5. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

⁴ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 and the Regulations under the PLT (see document PT/DC/47 on WIPO’s web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RIGHT OF PRIORITY AND PRIORITY CLAIMS

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Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

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

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

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

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 17

The Priority Document

17.1 Obligation to Submit Copy of Earlier National or International Application

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

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

(b) [No change]

[Rule 17.1, continued]

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

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

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

[COMMENT: See PLT Rule 4(3). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the receiving Office or the International Bureau for the purposes of this paragraph.]

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

[Rule 17.1, continued]

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

[COMMENT: See PLT Rule 4(3). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the designated Office for the purposes of this paragraph.]

17.2 [No change]

Rule 26bis

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

[COMMENT: Although it was suggested at the first session of the Working Group that the term “priority right” should be used for consistency with PLT Article 13(3), upon further reflection, the term “priority claim” has been retained since what the receiving Office actually does is to decide, with regard to the *priority claim*, to consider it not to have been made (see Rule 26bis.2(b)) or to restore it (under proposed new Rule 26bis.3) (see also Article 8(2)(a), defining the effect of a “priority claim” rather than of the “priority right”). By retaining the term “priority claim”, it would also be put beyond doubt that the effect of a restored priority claim would be the same as that of a “conventional” priority claim without implying any additional “substantive” rights (in the way that the term “priority right” appears to do: see paragraphs 22(vii) and (viii) and 23(ii) in the first session summary).]

26bis.1 Correction or Addition of Priority Claim

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

[COMMENT: Is it proposed to amend Rule 26bis.1(a) and to add a new Rule 80.8(b) and (c) (see below) so as to extend the period available to the applicant for the correction or addition of a priority claim prior to international publication of the international application where the applicant mistakenly makes a priority claim which is more than 12 months preceding the international filing date (see the situation referred to by the United States of America in document PCT/R/WG/1/4, paragraph 4, and paragraphs 32 and 33 in the first session summary). Since, under proposed new Rule 80.8(b) and (c), a priority claim which does not comply with Rule 4.10(a)(i) (that is, a priority claim related to an earlier application which has a filing date not falling within the period of 12 months preceding the international filing date) would not be taken into account for the purposes of computing the 16-month time limit under Rule 26bis.1, the applicant would always have 16 months from the corrected priority

[Rule 26bis.1(a), continued]

date to submit a request for correction). The previous “four month from the international filing date” minimum time limit seems to be no longer needed and is thus proposed to be deleted. The following examples illustrate the operation of both Rule 26bis.1 as proposed to be amended and proposed new Rule 80.8(b) and (c):

EXAMPLE 1 (corrected *later* priority date, initial priority date *earlier* than 12 months): international filing date: 1 June 2002; priority date claimed in international application as filed: 2 June 2000; corrected priority date: 2 June 2001; under proposed new Rule 80.8(b), the priority date claimed in the international application as filed is not taken into account for the purposes of computing the 16 months time limit under Rule 26bis.1(a); under Rule 26bis.1(a), the applicant would have 16 months from the corrected priority date (2 June 2001) for submitting a notice of correction, that is, until 2 October 2002; international publication date: 2 December 2002 (based on corrected priority date).

EXAMPLE 2 (corrected *later* priority date, initial priority date *within* 12 months): international filing date: 1 June 2002; priority date claimed in international application as filed: 2 June 2001; corrected priority date: 3 August 2001; under Rule 26bis.1 as proposed to be amended, the applicant would have 16 months from the priority date mistakenly claimed (2 June 2001) for submitting a notice of correction, that is, until 2 October 2002; international publication date: 3 February 2003 (based on corrected priority date).

EXAMPLE 3 (corrected *earlier* priority date; initial priority *earlier* than 12 months): Not possible since already the initial priority date was earlier than 12 months preceding the international filing date.

EXAMPLE 4 (corrected *earlier* date with earlier priority date, initial priority date *within* 12 months): international filing date: 1 June 2002; priority date claimed in international application as filed: 4 September 2001; corrected priority date: 2 June 2001; under Rule 26bis.1 as proposed to be amended, the applicant would have 16 months from the corrected priority date (2 June 2001) for submitting a notice of addition, that is, until 2 October 2002; international publication date: 2 December 2002 (based on corrected priority date).]

EXAMPLE 5 (*added* priority claim, *no initial* priority claim): international filing date: 1 June 2002; priority date claimed in international application as filed: none; added priority claim with priority date: 2 June 2001; under Rule 26bis.1 as proposed to be amended, the applicant would have 16 months from the added priority date (2 June 2001) for submitting a notice of addition, that is, until 2 October 2002; international publication date: 2 December 2002 (based on added priority claim).

EXAMPLE 6 (*added* priority claim with *later* priority date, initial priority claim with *earlier* priority date (i.e., without change of “the” priority date as defined in Article 2(xi)): international filing date: 1 June 2002; priority date claimed in international application as filed: 2 June 2001; added priority claim with priority date: 3 August 2001; time limit for submitting notice of addition: 2 October 2002; international publication date: 2 December 2002 (based on initial priority claim).]

[Rule 26bis.1, continued]

(b) [No change]

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

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

26bis.2 Invitation to Correct Defects in Priority Claims

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

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

(ii) a priority claim does not comply with the other requirements of Rule 4.10;⁵ or

(iii) ~~that~~ any indication in a priority claim is not the same as the corresponding indication appearing in the priority document;⁵

[Rule 26bis.2(a), continued]

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

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

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

[COMMENT: Paragraph (b) is proposed to be amended so as to clarify that a priority claim cannot be considered not to have been made under Rule 26bis.2(b) where the applicant has filed a request for restoration. Rather, the decision by the receiving Office on whether or not to consider the priority claim not have been made is governed by proposed new Rule 26bis.3(e), below (i.e., the decision to restore the priority claim or to refuse the request for restoration). In this context, it is also proposed to delete the words, “in response to an invitation under paragraph (a),” which appear to be superfluous; whether or not the notice of correction or the request for restoration is received as a result of an invitation would seem irrelevant.]

[Rule 26bis.2, continued]

(c) [no change]

26bis.3 Restoration of Priority Claim

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

[COMMENT: See PLT Article 13(2)]

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

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

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

[COMMENT: See PLT Article 13(2)(ii) and PLT Rule 14(4)(b). Item (ii) of paragraph (a) is proposed to be further amended in response to suggestions at the first session of the Working Group that this provision was ambiguous. On further consideration, it is considered that a request for restoration received by the receiving Office just before the completion of technical preparations (as previously proposed) is too late as it could never be taken into account by the International Bureau for publication.]

[Rule 26bis.3(a), continued]

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

[COMMENT: See PLT Article 13(2)(iv), which leaves it at the option of each PLT Contracting State to decide whether the Office requires the failure to file the subsequent application to have been “unintentional” or that it “occurred in spite of due care required by the circumstances having been taken”. At the first session of the Working Group on Reform of the PCT it was agreed that, in the context of the PCT, restoration of priority claim should be based on the more liberal requirement that the failure was “unintentional”, as favored by most delegations. However, certain delegations favored adopting the more strict criterion of “due care”. Certain other delegations favored giving receiving Offices the choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT. It was pointed out that, if the PCT were to require that one particular criterion be applied by all receiving Offices, it would be possible for an Office to have to apply one criterion in its capacity as a PCT receiving Office and the other criterion in its capacity as a national Office processing international applications or as a designated Office processing international applications entering the national phase. On the other hand, the importance of a single standard, or at least consistent practice, among offices in their capacity as PCT receiving Offices was emphasized by several delegations. See the first session summary, paragraphs 22(ii), (iii) and (vi) and 23(i).]

(b) The priority period referred to in paragraph (a) shall be 12 months calculated from the priority date.

[COMMENT: See also proposed new Rule 80.8(c), below, which is intended to ensure that a priority period calculated from a priority date outside the 12 month period is not excluded under proposed new Rule 80.8(b), below.]

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

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

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

[Rule 26bis.3(c), continued]

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

[COMMENT: See PLT Rule 14(5)(ii).]

(d) The receiving Office:

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

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

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

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

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

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

[Rule 26bis.3, continued]

(e) Where the restoration of a priority claim under paragraph (a) causes a change in the priority date, Rule 80.8(a) shall apply *mutatis mutandis*.

[COMMENT: Proposed new paragraph (e) is needed so as to ensure that, for procedural purposes in the international and national phases, where the restoration of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired is computed from the priority date as so changed. See the first session summary, paragraphs 22(vii) and 23(ii).]

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

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

[Rule 26bis.3(g), continued]

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

(h) Where the receiving Office has restored a priority claim under paragraph (a), no designated Office shall disregard that priority claim merely because the international application has an international filing date which is later than the date on which the priority period referred to in Rule 4.10(a)(i) expired unless:

(i) the designated Office finds that a requirement under paragraph (a)(i) or (ii) was not complied with; or

(ii) the designated Office has reasonable doubts that the failure to file the international application within the priority period was unintentional, and subsequently finds that the failure was intentional, in which case the designated Office shall notify the applicant of the reasons for those doubts [and shall give the applicant an opportunity to comment on its finding].

[COMMENT: New paragraph (h) is proposed to be added with a view to striking an equitable balance between the interests of the applicant in not having the reinstatement of a priority claim routinely reviewed by designated Offices and the right of designated Offices to revoke an incorrectly restored priority claim. Designated Offices, during the national phase, would have to respect the decision taken by the receiving Office during the international phase unless they have good reason not to.]

[Rule 26bis.3, continued]

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

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 to 66.6 [No change]

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

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

[COMMENT: See PLT Rule 4(3). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the International Preliminary Examining Authority for the purposes of this paragraph.]

[Rule 66.7, continued]

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority [and the validity of the priority claim is relevant to the formulation of an opinion under Article 35\(1\)](#), that Authority may invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

[COMMENT: See PLT Rule 4(4).]

66.8 and 66.9 [No change]

Rule 80

Computation of Time Limits

80.1 to 80.7 [No change]

80.8 Time limits Computed From the Priority Date

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

[COMMENT: See comment on Rule 26bis.1(c), above. It is proposed to move the content of current Rule 26bis.1(c) to proposed new Rule 80.8(a) so as to deal with all matters relating to time limits computed from the priority date in one place.]

(b) For the purposes of computing time limits, if a priority claim does not comply with Rule 4.10(a)(i) because the date on which the earlier application was filed was not a date falling within the 12 months preceding the international filing date, that priority claim shall not, subject to Rule 26bis.3(a), be taken into account for the purposes of determining the priority date.

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

[Rule 80.8, continued]

(c) Paragraph (b) shall not apply to the computation of the priority period under Rule 26bis.3(b).

[COMMENT: Proposed new paragraph (c) appears to be needed so as to clarify that a priority claim which does not comply with Rule 4.10(a)(i) that the date on which the earlier application was filed is a date falling within the 12 months preceding the international filing date is to be taken into account for the purposes of computing the “priority period” as defined in proposed new Rule 26bis.3(b) (that Rule defines the “priority period as “12 months calculated from the priority date”) although, strictly speaking, the “priority period” does not appear to be a “time limit” in the meaning of proposed new Rule 80.8(b).]

(b) and (c) [no change]

[End of Annex and of document]

WIPO



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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):
MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

Document prepared by the International Bureau

BACKGROUND

1. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT), inter alia, in respect of time limits. This document¹ contains further proposals dealing with the question of reinstatement of rights in certain cases where the time limit for entering the national phase has been missed. As reported in the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”):²

¹ This and other working documents for the present session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

² See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

“CHANGES RELATED TO THE PATENT LAW TREATY (PLT)

“20. Discussions were based on document PCT/R/WG/1/5.

“21. There was wide agreement as to the following general observations made by various delegations:

- (i) while the international phase was in general exempt from the provisions of the PLT, the principles of the PLT should so far as possible be taken up in the PCT in order to achieve the same benefits for applicants and Offices in the filing and processing of international applications as would be available for national applications; however, particular PLT-related matters should be examined on their merits to ascertain how best to deal with them in the context of the PCT;
- (ii) certain features of the PCT system differed from national and regional patent systems, and those differences needed to be borne in mind; some aspects of the PLT were less relevant than others in the context of the PCT system; factors to be taken into account included the following:
 - the PCT system is administered by a plurality of Offices and Authorities and the IB rather than by a single national or regional Office;
 - there are certain time constraints peculiar to the PCT, such as the time limit for establishing the international search report;
 - in some practical respects, the filing of a national application bears more similarity to national phase entry under the PCT than to the filing of an international application;
 - some of these differences would result in greater complexity in terms of procedures and/or drafting when considering implementation under the PCT than was the case under the PLT, for example, provisions as to language of filing and the furnishing of translations;
 - international applications were usually filed after, and claiming priority from, previously filed national applications.
- (iii) while some provisions of the PLT could be implemented readily by changing the PCT Regulations, others would require changing the Articles of the Treaty itself; some amendments to the Regulations proposed in document PCT/R/WG/1/5 raised difficulties of possible inconsistency, to varying degrees, with the Articles, for example, in providing for the according of a filing date where no claims were present in an international application;
- (iv) while changes to the Regulations could be implemented more quickly, the formulation of proposed changes to the Articles should also be addressed at an early stage;

- (v) priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following:
- provisions for restoration of the priority right in certain circumstances;
 - relief when time limits were missed, especially the time limit for entering the national phase.

[...]

“Time limit for entering the national phase

“24. It was agreed that the International Bureau should prepare a proposal which would provide in the PCT Regulations for extensions of the time limit for entering the national phase, similarly to PLT Article 3(1)(b)(i) read in the light of PLT Articles 11 and 12.”

PROPOSAL FOR THE REINSTATEMENT OF RIGHTS AFTER FAILURE TO COMPLY WITH REQUIREMENTS FOR ENTERING THE NATIONAL PHASE WITHIN THE TIME LIMITS UNDER ARTICLES 22 AND 39(1)

2. A proposal for the reinstatement of rights after failure to comply with the requirements for national phase entry within the time limits under PCT Articles 22 and 39(1),³ based on paragraphs 20, 21 and 24 of the first session summary, is set out in the Annex.⁴ The key features of this proposal are outlined in the following paragraphs.

Present situation

3. If the applicant fails to perform the acts referred to in PCT Article 22 or 39(1) (generally, the furnishing of a translation of the international application and the payment of the national fee) before any designated or elected Office within the applicable time limit, the international application ceases to have the effect provided for in PCT Article 11(3) (that is, the effect of a regular national application) as far as that State is concerned, with the same

³ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 and the Regulations under the PLT (see document PT/DC/47 on WIPO’s web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

consequences as the withdrawal of any national application in that State (see PCT Article 24(1)(iii)).

4. As regards the possibility for the applicant to excuse any delay in meeting the time limits under PCT Article 22 and 39(1), at present, the PCT provides for such possibility only in the particular case of irregularities in the mail service (delay or loss in mail, interruption in the mail service) under PCT Article 48(1) and PCT Rule 82.

5. In all other cases (that is, not related to irregularities in the mail service), the possibility of excusing a missed time limit under PCT Article 22 or 39(1) must be pursued before each designated or elected Office individually, and only as far as that Office is concerned. For each designated or elected Office where the applicant wishes to attempt to have such a delay excused, the applicant must perform all acts required for entry into the national phase and, at the same time, request the Office to maintain the effect of the application and to excuse the delay. In determining whether a delay may be excused, each Office must apply the conditions laid down by the applicable national law in the same way and under the same conditions as they are applied to national applications, including any time limit for filing a request to excuse the delay (see PCT Article 48(2)).

6. Examples of national provisions for excusing delays are those that allow reinstatement of rights, restoration, *restitutio in integrum*, revival of abandoned applications, further processing, continuation of proceedings, and so on (see PCT Rule 82*bis*.2).

7. While the national laws of many designated and elected Offices contain provisions which allow for the excuse of delays in meeting time limits, including the time limits applicable under PCT Articles 22 and 39(1), this is not the case in respect of all designated and elected Offices. Where the applicant misses the applicable time limit for entry into the national phase before an Office whose national law does not contain such provisions, the international application ceases to have the effect as far as that State is concerned, with the same consequences as the withdrawal of any national application in that State, and no further remedy is generally available.

Patent Law Treaty

8. In order to provide a remedy for applicants in such situations, PLT Article 3(1)(b)(i) expressly provides that the provisions of the PLT and the Regulations under the PLT (once in force) would be applicable, subject to the provisions of the PCT, to international applications in respect of the time limits applicable under PCT Articles 22 and 39(1) in the Office of the PLT Contracting Party. In other words, under the PLT, any national Office of a State which is a Contracting Party of both the PLT and the PCT and which acts as a designated or elected Office under the PCT would be obliged to apply the provisions of the PLT, in particular PLT Article 12 (“Reinstatement of Rights After Finding of Due Care or Unintentionality by the Office”), to an international application which missed the applicable time limit for entry into the national phase before that Office.

Amendments of the PCT Regulations

9. Noting that the PLT has not yet entered into force, it is now proposed, as suggested in paragraph 24 of the first session summary, to incorporate into the PCT Regulations a provision with similar effect to PLT Article 12 and PLT Rule 13(2) so as to oblige all designated and elected Offices to provide for the reinstatement of rights of the applicant if the

applicant has missed the applicable time limit under Article 22 or 39(1) for entry into the national phase in spite of due care required by the circumstances having been taken or, at the option of the designated/elected Office, where the delay was unintentional. The Annex to this document contains specific proposals to amend the PCT Regulations accordingly.

10. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:
MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

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Rule 49

Copy, Translation and Fee Under Article 22

49.1 to 49.5 [No change]

49.6 Reinstatement of Rights After Failure to Perform the Acts Referred to in Article 22

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, notwithstanding Rule 82 and subject to paragraphs (b) to (d) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken.

[COMMENT: See PLT Article 12(1)(iv). As is the case in PLT Article 12(1)(iv), it is proposed to leave it at the option of the designated Office to decide which standard it wishes to apply in deciding whether or not to reinstate the rights of an applicant who failed to perform the acts referred to in Article 22 within the applicable time limit. Note that the provisions of Rule 82 would still apply as a *lex specialis*.]

[Rule 49.6, continued]

(b) The request referred to in paragraph (a) for reinstatement of rights shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within:

(i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or

(ii) 12 months from the date of the expiration of the applicable time limit under Article 22;

whichever expires first.

[COMMENT: See PLT Article 12(1)(ii) and PLT Rule 13(2).]

(c) The request referred to in paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22.

[COMMENT: See PLT Article 12(1)(iii).]

[Rule 49.6, continued]

(d) The national law applicable by the designated Office may require:

(i) that a fee be paid in respect of a request under paragraph (a);

[COMMENT: See PLT Article 12(3).]

(ii) that a declaration or other evidence in support of the reasons referred to in paragraph (a) be filed.

[COMMENT: See PLT Article 12(4).]

(e) Where any of the requirements referred to in paragraphs (c) and (d) are not already fulfilled during the same period within which the request referred to in paragraph (a) for reinstatement of rights must, under paragraph (b), be submitted, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation.

[COMMENT: Modeled after present Rule 51bis.3(a).]

[Rule 49.6, continued]

(f) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[COMMENT: See PLT Article 12(5).]

(g) If, on [date], paragraphs (a) to (f) are not compatible with the national law applied by the designated Office, paragraphs (a) to (f) shall not apply in that respect of that designated Office for as long as those paragraphs continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [date]. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 76

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

Translation of Priority Document

76.1 to 76.3 *[Remain deleted]*

76.4 to 76.6 [No change]

[COMMENT: No amendment of Rule 76.5 appears necessary since the current text of that Rule would ensure that proposed new Rule 49.6, including the transitional provision under Rule 49.6(g), would also apply to elected Offices.]

[End of Annex and of document]

WIPO



PCT/R/WG/2/5

ORIGINAL: English

DATE: March 26, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

Document prepared by the International Bureau

BACKGROUND

Language of the international application: alignment with language-related filing date requirements of the PLT

1. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT), based on document PCT/R/WG/1/5.¹ While certain PLT related matters (including the issues of right of priority and priority claims, missed time limit for entering the national phase, international applications filed without claims and “reference filings”) were discussed in detail, there was not enough time to discuss all proposed changes related to the PLT as set out in document PCT/R/WG/1/5. Among the issues that were not discussed during the first session was the issue of the language of the international application and translations. This document² contains revised proposals in relation to that issue.

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

² This and other working documents for the present session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

2. Annex II to document PCT/R/WG/1/5 set out specific proposals to align the language-related filing date requirements under the PCT with those under the PLT, with far reaching consequences on certain non-filing date related provisions dealing with the language of the international application for receiving Office processing, international search, international publication and international preliminary examination. Some of those proposals would have resulted in much greater complexity of the PCT system, mainly for the reason that the proposals had to accommodate the fact that, under the PCT, several Offices and Authorities (and not just one national Office, as is the case under the PLT) are involved in the processing of the application during the international phase, and each PCT Office and Authority is entitled, within certain limits, to decide on its own working languages.

3. In view of this apparent contradiction to one of the objectives of PCT reform, namely, to simplify, clarify and, where possible, shorten the wording of the provisions of the Regulations, the International Bureau has reconsidered the issue in substance and now proposes a new approach for addressing the issue of the language of the international application, as outlined in the following paragraphs.

4. The main difference between the language-related filing date requirements of the PLT and those of the PCT is that, *under the PLT*, only two elements of the application (“an express or implicit indication to the effect that the elements are intended to be an application” and “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office”) must, for the purposes of the filing date, be in a language accepted by the Office, whereas the “part which on the face of it appears to be a description” may, for the purposes of according a filing date, be in any language (see PLT Article 5(2)).³ *Under the PCT*, both the “part which on the face of it appears to be a description” and the “part which on the face of it appears to be a claim or claims” must, for the purposes of according an international filing date, be in a language accepted by the receiving Office (see PCT Article 11(1)(ii) and PCT Rule 20.4(c)).

5. While, at first glance, there would appear to be a need to align the PCT language-related filing date requirements with those of the PLT, as originally proposed by the International Bureau in Annex II to document PCT/R/WG/1/5, upon further reflection, such approach overlooked the fact that an international application filed in any language with any receiving Office is in practice entitled, at present, to be accorded an international filing date (provided, of course, that all other filing date requirements are met). This arises because, pursuant to PCT Rule 19.4(a)(ii), if the international application⁴ is not in a language accepted (under PCT Rule 12.1(a)) by the receiving Office with which it was filed, it is considered to have

³ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 and the Regulations under the PLT (see document PT/DC/47 on WIPO’s web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

⁴ More precisely, the description and/or the claims; language defects in the request, the abstract or any text matter in the drawings are considered formal defects under PCT Rule 26.3*ter*.

been received by the receiving Office on behalf of the International Bureau as receiving Office and would be transmitted to the International Bureau, which accepts any language for the purposes of filing of the international application. Such an application would therefore be accorded an international filing date by the International Bureau as receiving Office (if all other filing date requirements are met).

6. In other words, the PCT is already, in practice, “PLT-compliant” in relation to language-related filing date requirements, since an international application will be entitled to an international filing date no matter in which language and with which Office it was filed. In a sense, the PCT is even more applicant-friendly than the PLT in this respect since it does not require, as does the PLT, that at least two elements of the application (“an express or implicit indication to the effect that the elements are intended to be an application” and “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office”) must, for the purposes of the filing date, be in a language accepted by the Office. For the purposes of according an international filing date, the International Bureau as receiving Office accepts any element of the international application in any language.

7. The International Bureau therefore proposes not to proceed with changes to the current PCT Rules concerning the language-related filing date requirements nor any related provisions dealing with the language of the international application for receiving Office processing, international search, international publication and international preliminary examination, with the following exception.

Translation of the international application for the purposes of international search

8. At present, where the international application is filed in a language which is accepted by the receiving Office and by the International Searching Authority that is to carry out the international search but is not a language of publication, it is the International Searching Authority which is responsible for the establishment of a translation of the international application into English (see present Rule 48.3(b)).⁵ In practice, it is normally the applicant who in practice prepares the translation and furnishes it to the International Searching Authority. However, if the applicant does not do so, the International Searching Authority must prepare the translation itself. Although the Authority may charge a fee for preparing the translation (see present Rule 48.3(b), second sentence), this creates extra work for the Authority. In addition, in some cases the Authority is unable to recover the cost of preparing the translation, since there is no sanction if the applicant fails to pay the fee for the translation. The preparation of a translation appears to be a matter which should properly be the responsibility of the applicant.

⁵ At present, this is the case: (i) where the international application is filed in Dutch with the Netherlands Industrial Property Office or the Belgium Industrial Property Office and ISA/EP carries out international search (in Dutch); (ii) where the international application is filed with the Danish Patent and Trademark Office in Danish, Norwegian or Swedish, with the Finnish National Board of Patents in Finnish or Swedish, the Icelandic Patent Office in Danish, Norwegian or Swedish, the Norwegian Patent Office in Norwegian, or the Swedish Patent Office in Danish, Finnish, Norwegian or Swedish, and ISA/SE carries out international search (in Danish, Finnish, Norwegian or Swedish); and (iii) where the international application is filed with the Korean Intellectual Property Office in Korean and ISA/KR carries out international search in Korean.

9. The Annex to this document contains proposals to amend the PCT Regulations⁶ so as to require the applicant, rather than the International Searching Authority, to furnish the required translation and to introduce a sanction if the applicant fails to do so. The proposals are in line with earlier proposals submitted by the Republic of Korea during the first session of the Working Group (see document PCT/R/WG/1/8) and by the Korean Industrial Property Office, the Netherlands Industrial Property Office, the Swedish Patent and Registration Office and the European Patent Office, which were discussed in 1997 by an ad hoc advisory group on proposed amendments of the PCT Regulations.

10. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

⁶ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

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Rule 12

Language of the International Application and Translation for the Purposes of International Search

12.1 [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

(b) Any rectification under Rule 91.1 of an obvious error in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), [12.4\(a\)](#) ~~48.3(b)~~ or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language of the application and the language of that translation;

[COMMENT: The proposed amendment of item (i) is consequential on the proposed addition of new Rule 12.4 (see below).]

(ii) [No change]

12.3 [No change]

12.4 Translation for the Purposes of International Publication

(a) Where the language in which the international application is filed is not a language of publication and no translation is required under Rule 12.3(a), the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into English. Rule 12.3(b) shall apply *mutatis mutandis*.

[COMMENT: See paragraphs 8 and 9 in the “Background” section of this document. As at present (see present Rule 48.3(b), which is proposed to be deleted), the international application would be translated into, and published in, English.]

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

(c) Where the applicant has not, within the time limit referred to in paragraph (a), furnished a translation required under that paragraph, the receiving Office shall invite the applicant to furnish the required translation, and to pay, where applicable, the late furnishing fee required under paragraph (e), within 16 months from the priority date.

(d) Where the applicant has not, within the time limit under paragraph (c), furnished the required translation and paid any required late furnishing fee, the international application shall be considered withdrawn and the receiving Office shall so declare. 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 shall be considered to have been received before the expiration of that time limit.

[Rule 12.4, continued]

(e) The furnishing of a translation after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to 50% of the basic fee.

[COMMENT: With regard to the proposal to add new Rule 12.4, see paragraphs 8 and 9 in the “Background” section of this document. See also Rule 48.3(b), which is proposed to be deleted, below.]

Rule 22

Transmittal of the Record Copy and Translation

22.1 *Procedure*

(a) to (g) [No change]

(h) Where the international application is to be published in the language of a translation furnished under Rule 12.3 [or 12.4](#), that translation shall be transmitted by the receiving Office to the International Bureau together with the record copy under paragraph (a) or, if the receiving Office has already transmitted the record copy to the International Bureau under that paragraph, promptly after receipt of the translation.

[COMMENT: The proposed amendment of paragraph (h) is consequential on the proposed addition of new Rule 12.4 (see above).]

22.2 [*Remains deleted*]

22.3 [No change]

Rule 26

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

26.1 and 26.2 [No change]

26.3 *Checking of Physical Requirements Under Article 14(1)(a)(v)*

(a) [No change]

(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:

(i) [No change]

(ii) any translation furnished under Rule 12.3 [or 12.4](#) and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

[COMMENT: The proposed amendment of item (ii) is consequential on the proposed addition of new Rule 12.4 (see above).]

26.3*bis* to 26.6 [No change]

Rule 29

International Applications or Designations Considered Withdrawn

29.1 *Finding by Receiving Office*

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rules [12.3\(d\)](#) [or 12.4\(d\)](#) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed addition of new Rule 12.4 (see above).]

(i) to (iv) [No change]

Rule 48

International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) [No change]

(a-*bis*) If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 [or 12.4](#), that application shall be published in the language of that translation.

[COMMENT: The proposed amendment of paragraph (a-*bis*) is consequential on the proposed addition of new Rule 12.4 (see above).]

(b) ~~[Deleted] If the international application is filed in a language which is not a language of publication and no translation into a language of publication is required under Rule 12.3(a), that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the~~

[Rule 48.3(b), continued]

~~circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the relevant portions of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.~~

[COMMENT: The proposed deletion of paragraph (b) is consequential on the proposed addition of new Rule 12.4 (see Comment on Rule 12.4, above).]

(c) [No change]

48.4 to 48.6 [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/2/6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

OTHER PLT-RELATED CHANGES

Document prepared by the International Bureau

BACKGROUND

1. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT).¹ As reported in the Summary of the Session prepared by the Chair (paragraphs 20 and 21 of document PCT/R/WG/1/9) (“first session summary”):

“CHANGES RELATED TO THE PATENT LAW TREATY (PLT)

“20. Discussions were based on document PCT/R/WG/1/5.

“21. There was wide agreement as to the following general observations made by various delegations:

- (i) while the international phase was in general exempt from the provisions of the PLT, the principles of the PLT should so far as possible be taken up in the PCT in order to achieve the same benefits for applicants and Offices in

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

the filing and processing of international applications as would be available for national applications; however, particular PLT-related matters should be examined on their merits to ascertain how best to deal with them in the context of the PCT;

- (ii) certain features of the PCT system differed from national and regional patent systems, and those differences needed to be borne in mind; some aspects of the PLT were less relevant than others in the context of the PCT system; factors to be taken into account included the following:
- the PCT system is administered by a plurality of Offices and Authorities and the IB [International Bureau] rather than by a single national or regional Office;
 - there are certain time constraints peculiar to the PCT, such as the time limit for establishing the international search report;
 - in some practical respects, the filing of a national application bears more similarity to national phase entry under the PCT than to the filing of an international application;
 - some of these differences would result in greater complexity in terms of procedures and/or drafting when considering implementation under the PCT than was the case under the PLT, for example, provisions as to language of filing and the furnishing of translations;
 - international applications were usually filed after, and claiming priority from, previously filed national applications.
- (iii) while some provisions of the PLT could be implemented readily by changing the PCT Regulations, others would require changing the Articles of the Treaty itself; some amendments to the Regulations proposed in document PCT/R/WG/1/5 raised difficulties of possible inconsistency, to varying degrees, with the Articles, for example, in providing for the according of a filing date where no claims were present in an international application;
- (iv) while changes to the Regulations could be implemented more quickly, the formulation of proposed changes to the Articles should also be addressed at an early stage;
- (v) priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following:
- provisions for restoration of the priority right in certain circumstances;
 - relief when time limits were missed, especially the time limit for entering the national phase.”

2. During the time available for discussion on PLT-related matters, the first session discussed in detail proposals to align PCT and PLT requirements in relation to several matters. Documents prepared for the second session of the Working Group deal with the following matters:

(i) *right of priority and priority claims*: see paragraphs 22 and 23 of the first session summary and document PCT/R/WG/2/3;

(ii) *missed time limit for entering the national phase*: see paragraph 24 of the first session summary and document PCT/R/WG/2/4;

(iii) *absence of substantive claims*: see paragraphs 25 and 26 of the first session summary; a further document is, at the date of the present document, still in preparation for the second session.

3. The question of *reference filings* was also discussed at the first session. As suggested in paragraph 28 of the first session summary, the International Bureau has reconsidered the question of reference filings in substance and in terms of its priority among the other proposals before the Working Group. As this matter appears to be of relatively low priority, it is proposed that a revised proposal not be submitted to the Working Group until a future session.

4. Certain PLT-related proposals contained in document PCT/R/WG/1/5 were not discussed during the first session of the Working Group. The Working Group desired to give priority “to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities” (see paragraph 21(v) of the first session summary. In addition, the International Bureau indicated, in paragraph 18 of document PCT/R/WG/1/5, that it would prepare, for the second session of the Working Group, a document “identifying and addressing the further changes necessary or desirable to bring the PCT in line with the letter and spirit of the PLT.”

5. The present document² outlines possible further PLT-related changes to the PCT. in general, the International Bureau suggests that most of those matters do not need to be addressed as matters of high priority.

PROPOSED PLT-RELATED CHANGES SET OUT IN DOCUMENT PCT/R/WG/1/5 NOT YET DISCUSSED BY THE WORKING GROUP

6. Due to time constraints, the Working Group did not discuss the following matters during its first session:

² This and other working documents for the present session are available on WIPO's Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

(i) *drawing as description*: see Annex I of document PCT/R/WG/1/5 and paragraph 7, below);

(ii) *missing part requirements*: see Annex I of document PCT/R/WG/1/5 and paragraphs 8 and 9, below;

(iii) *language of the international application and translations*: see Annex II of document PCT/R/WG/1/5 and paragraph 10, below).

“Drawing as description”

7. Under the PLT, a Contracting Party may, for the purposes of the filing date, accept a drawing as the “part which on the face of it appears to be a description” (see PLT Article 5(1)(b)).³ There is no equivalent provision in the PCT. Annex I of document PCT/R/WG/1/5 contained a proposal to amend Rule 20.4 so as to provide that, for the purposes of Article 11(1)(iii)(d), a drawing shall be accepted as the part which appears to be a description. In light of the discussions at the first session of the Working Group, this proposal is considered to have a relatively low priority and would not be resubmitted for consideration by the Working Group until a later date.

“Missing part” requirements

8. Under the PLT, missing part requirements (missing part of the description and missing drawing) are contained in PLT Article 5(5) and (6) and PLT Rule 2(3) and (4). “Missing part” requirements under the PCT are contained in PCT Article 14(2) and PCT Rule 20.2. The main difference between the requirements of the PLT and those of the PCT is that, under the PLT, the applicant can rectify the omission of a part of the description or of a drawing without loss of the filing date if the application claims the priority of an earlier application and the missing part of the description or the missing drawing is completely contained in that earlier application (see PLT Article 5(6) and PLT Rule 2(3) and (4)). Under the PCT, later submission of a missing part of the description or of a missing drawing results in the loss of the originally accorded international filing date (except in the case of an authorized rectification of an obvious error under PCT Rule 91), and in the according of a new international filing date (being the date on which the papers completing the international application were received or the date on which all international filing date requirements were fulfilled, whichever is later) (see PCT Article 14(2) and PCT Rule 20.2).

³ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 and the Regulations under the PLT (see document PT/DC/47 on WIPO’s web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

9. Annex I of document PCT/R/WG/1/5 contained proposals to amend the PCT Regulations (see, in particular, proposed new Rule 20*bis*) with the aim of aligning PCT requirements with those of the PLT. In light of the discussions at the first session of the Working Group, this proposal is considered to have a relatively low priority and will not be resubmitted for consideration by the Working Group until a later date.

Language of the international application and translations

10. This question is discussed further in document PCT/R/WG/2/5, which proposes a simplified approach to bringing PCT requirements into line with the PLT.

POSSIBLE FURTHER PLT-RELATED CHANGES

Extension of time limits and/or continued processing; reinstatement of rights where time limits are missed (other than the time limit for entering the national phase)

11. PLT Article 11 obliges a Contracting Party to provide relief in respect of time limits in the form of extension of that time limit after the expiration of that time limit (PLT Article 11(1)(ii)) and/or continued processing (PLT Article 11(2)). In addition, a Contracting Party may, but is not obliged to, provide for the extension of a time limit before it has expired. Relief under this Article is subject only to compliance with formal requirements; the applicant cannot be required to provide grounds in support of the extension. However, it is expressly restricted to “time limits fixed by the Office for an action in a procedure before the Office” and thus does not apply to time limits established by national law, under a treaty providing for the grant of regional patents, or under the PCT or PCT Regulations. In addition, a Contracting Party may exclude relief in the case of a limited number of prescribed time limits (PLT Article 11(3)).

12. PLT Article 12 obliges a Contracting Party to provide for the reinstatement of rights lost for failure to comply with a time limit for an action in a procedure for an action before the Office. In contrast to PLT Article 11, PLT Article 12 is not restricted to time limits fixed by the Office. It therefore applies to time limits fixed by the Office, established by national law, under a treaty providing for the grant of regional patents, or under the PCT or PCT Regulations. Also in contrast to PLT Article 11, reinstatement of rights under PLT Article 12 is subject to a finding by the Office that the failure to comply with the time limit occurred in spite of all due care required by the circumstances or, at the option of the Contracting Party, was unintentional (PLT Article 12(1)(iv)). As in the case of PLT Article 11, a Contracting Party may exclude reinstatement of rights in the case of a limited number of prescribed time limits (PLT Article 12(2)).

13. Document PCT/R/WG/2/4 includes proposals to allow for the reinstatement of rights where the time limit for entering the national phase has been missed. The International Bureau suggests that any further proposals to align PCT requirements with PLT Articles 11 and 12 in the above respects not be presented to the Working Group until a future session. While this issue appears to be a matter of relatively high priority, it requires further consideration. In particular, the inclusion into the PCT Regulations of general provisions providing for the extension (by not less than two months) of time limits fixed by the Office for an action in a procedure before the Office (see PLT Article 11) is inherently problematic noting that the proper functioning of the PCT system relies to a great extent on actions taking place in a very limited time and within strict deadlines. For example, there are reasons for certain time limits such as those under PCT Rule 13*ter*.1 (time limit for furnishing sequence

listings in electronic form), PCT Rule 26.2 (time limit to correct formality defects) and PCT Rules 60.1 and 60.2 (time limit to correct defects in the demand or later elections). Moreover, already today, many time limits fixed by the Office under the PCT are already subject to the possibility of extension, albeit that the granting of an extension is in some cases discretionary for the Office.

Correction of mistakes

14. The PLT sets out the requirements that a Contracting Party is permitted to apply as regards requests for correction by the Office of mistakes in respect of an application (see PLT Rule 18). In particular, it sets out the contents of the request that an Office may require; it also obliges the Office to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. However, it does not regulate what mistakes may be corrected. PCT Rule 91.1 provides for rectification of obvious errors in the international application or other papers. However, it does not set out any requirements as to the contents of the request for rectification. It also does not require the receiving Office, International Searching Authority or International Preliminary Examining Authority or International Bureau, as the case may be, to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements.

15. The International Bureau suggests that any proposals to align the PCT with PLT Rule 18 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority.

Recording changes

16. The PLT sets out requirements that a Contracting Party is permitted to apply as regards requests for recording changes in the name or address of the applicant or agent (PLT Rule 15) and in the person of the applicant (PLT Rule 16). In particular, those Rules prescribe the indications regarding the applicant, representative or new applicant concerned that a Contracting Party may require. They also oblige the Contracting Party to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. PCT Rule 92*bis* sets out the PCT requirements as regards recording changes in the following indications appearing in the request or demand: (i) person, name, residence, nationality or address of the applicant; (ii) person, name or address of the agent, the common representative or the inventor. However, PCT Rule 92*bis* does not set out the indications that are to be included in requests for recording of changes. It also does not require the applicant to be informed of any non-compliance with one or more applicable requirements and to be provided with an opportunity to subsequently comply with those requirements.

17. The International Bureau suggests that any proposals to align PCT requirements with PLT Rules 15 and 16 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority.

Agents

18. The PLT sets out certain procedures in respect of which a Contracting Party is obliged to permit the applicant to act for himself without appointing an agent. These procedures are the filing of an application for the purposes of the filing date, the mere payment of a fee, the filing of a copy of an earlier application to support the filing of a missing part of the description or missing drawing, the filing of a copy of an earlier application to support a “reference filing”, and issue of a receipt or notification by the Office in respect of such procedures (see PLT Article 7(2) and Rule 7(1)). Under the PCT, the receiving Office or designated Office may apply its national law as far as it relates to any requirement that the applicant shall be represented by an agent (see Article 27(7)). In particular, the national law applicable by the designated Office may require that the applicant shall be represented by an agent (see PCT Rule 51*bis*.1(b)(i)).

19. In addition, the PLT in effect obliges a Contracting Party to accept the submission of a power of attorney in any language, provided that, if it is not in a language accepted by the Office concerned, it is accompanied by a translation (see PLT Rule 7(2) and (3)). The PCT contains no express provisions concerning the language of powers of attorney. However, under PCT Rule 92.2(a), the International Searching Authority or the International Preliminary Authority may require that certain documents, including powers of attorney, be submitted in the language of the international application or its language of translation.

20. the International Bureau suggests that any proposal to align PCT requirements with PLT Article 7(2) and Rule 7(1) to (3) in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority.

Invitations to comply with certain time limits and to make observations; time limits

21. Under the PLT, where one or more requirements in respect of the form or contents of an application are not complied with, the Office is obliged to notify the applicant, giving the opportunity to comply with any such requirement, and to make observations within a time limit of not less than two months from the date of the notification (see PLT Article 6(7) and Rule 6(1)). Exceptionally, where a notification has not been made because indications allowing the applicant to be contacted by the Office have not been filed, the time limit for compliance with any such requirement is not less than three months from the date on which one or more elements of the application were first received (see PLT Rule 6(2)). Similar provisions apply with regard to compliance with other requirements in respect of the application, as well as other procedures.

22. Under the PCT, the provisions that apply depend on which is the requirement that has not been complied with. In some cases, there is no express provision for the applicant to be given an opportunity to comply. In the case of lack of unity of invention, express provision is made for the applicant to submit observations and these must be in the form of a reasoned statement (PCT Rules 40.2(c) and 68.3(c)). Also, many of the time limits for complying with PCT requirements are shorter than the corresponding time limits applicable under the PLT.

23. Proposals to align certain provisions under the PCT with the corresponding provisions under the PLT in the above respects have already been referred to above. The International Bureau suggests that any proposals to align other provisions under the PCT, for example, certain provisions under PCT Rule 13*bis* (Inventions Relating to Biological Material), Rule 13*ter* (Nucleotide and/or Amino Acid Sequence Listings), Rule 16*bis* (Extension of

Time Limits for Payment of Fees), Rule 20 (Receipt of the International Application), Rule 26 (Checking by, and Correcting Before, the Receiving Office of Certain Elements of the International Application), Rule 40 (Lack of Unity of Invention (International Search)), Rule 49 (Copy, Translation and Fee Under Article 22), Rule 55 (Languages (International Preliminary Examination)), Rule 58*bis* (Extension of Time limits for Payment of Fees), Rule 60 (Certain Defects in the Demand or Elections), Rule 68 (Lack of Unity of Invention (International Preliminary Examination)) and Rule 92 (Correspondence), not be presented to the Working Group until a future session, as this does not appear to be a high priority.

24. The Working Group is invited to discuss the further PLT-related changes outlined in this document, including their relative priority, with a view to their possible inclusion in the work program of the Working Group.

[End of document]

WIPO



PCT/R/WG/2/7

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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

GENERAL SIMPLIFICATION AND STREAMLINING OF PCT PROCEDURES:

SIGNATURE OF THE INTERNATIONAL APPLICATION
AND RELATED DOCUMENTS

Document prepared by the International Bureau

BACKGROUND

1. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed, based on documents PCT/R/WG/1/1 and PCT/R/WG/1/7, proposals related to the concept and operation of the designation system; see paragraphs 11 to 19 of the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”).¹ In the context of those discussions, it was agreed that the signature requirements under the PCT should be reviewed with a view to further simplifying and streamlining or even eliminating them (see paragraph 13 of the first session summary):

“13. It was agreed that the approach taken in document PCT/R/WG/1/1 in connection with Rules 4, 49*bis* and 90*bis* should be retained, subject to further consideration of the matters mentioned in paragraph 12, above, and to the following:

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

- (i) [...]
- (ii) a revised draft should include the following alternatives for consideration: (1) eliminate all signature requirements; (2) require the signature of only one applicant where the international application is filed by several applicants (and similarly in the case of the demand); (3) provide for an RO [receiving Office] to waive the need for signature of the international application requirements for papers filed with that Office; (4) provide for an RO to waive the need for a power of attorney where the international application is filed by an agent;

[...]"

ALTERNATIVE PROPOSALS

2. Annexes I and II to this document² contain alternative sets of proposals for amendment³ of the provisions of the PCT Regulations⁴ relating to signature requirements. Other proposals related to the concept and operation of the designation system are set out in document PCT/R/WG/2/2.

3. Annex I sets out proposals for amendment of the Regulations with the aim of *eliminating all signature requirements* under the PCT, as in alternative (1) mentioned in paragraph 13(ii) of the first session summary. Annex II sets out proposals for amendment of the Regulations with the aim of *simplifying and streamlining the present signature requirements* but without eliminating them altogether. Annex II represents a combination of alternatives (2), (3) and (4) mentioned in paragraph 13(ii) of the first session summary. That combination is proposed by the International Bureau because, on reflection, it was felt that each of three latter alternatives, considered on its own, would not result in a coherent and conclusive solution of the problems related to signature requirements.

FIRST ALTERNATIVE: ELIMINATION OF ALL SIGNATURE REQUIREMENTS

4. Under the proposals set out in Annex I to this document, all signature requirements under the PCT would be eliminated. That is, the international application itself could be filed without the need for any signature – whether by the applicant, an agent or a common representative – as could any other document furnished during the course of the international phase to the receiving Office, the International Searching Authority, the International

² This and other working documents for the present session are available on WIPO's Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

⁴ References in this document to "Articles," "Rules" and "Sections" are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT ("the Regulations") and of the Administrative Instructions under the PCT ("the Administrative Instructions"), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO's Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to "national law," "national applications," "national Offices," etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO's web site at <http://www.wipo.int/pct/eng/texts/index.htm>.

Preliminary Examining Authority and the International Bureau (such as a demand for international preliminary examination, later elections, withdrawals or any other (general) correspondence). Powers of attorney would also no longer be required.

5. It is noted that certain national Offices have effectively eliminated signature requirements with no disastrous consequence in terms of safeguarding the rights of applicants or of convenient administration of the PCT system.

SECOND ALTERNATIVE: SIMPLIFICATION AND STREAMLINING OF PRESENT SIGNATURE REQUIREMENTS

6. Under the proposals set out in Annex II to this document, the present requirements as to signature would not be eliminated altogether but rather would be simplified and streamlined, along the lines of the suggestions made in paragraph 13(ii), alternatives (2), (3) and (4) of the first session summary.

7. As suggested in paragraph 13(ii), alternative (2), only one signature would be required for the request, the demand, any later election or any withdrawal where the international application is filed by several applicants. As suggested in paragraph 13(ii), alternative (3), even that (limited) signature requirement could be waived, if so wished, by any receiving Office, and by any International Searching Authority, International Preliminary Examining Authority or by the International Bureau. Moreover, as suggested in paragraph 13(ii), alternative (4), any receiving Office, International Searching Authority or International Preliminary Examining Authority, or the International Bureau, could waive the requirement that a power of attorney be furnished where the applicant is, or all applicants are, represented by an agent or where all applicants are represented by a common representative.

NATIONAL PHASE

8. By virtue of Article 27(1), designated Offices would generally be precluded from requiring, in the national phase, a signature on the international application itself or of documents filed during the international phase. This would not of itself, of course, preclude any Office from requiring evidence, where reasonable doubt arises, as to the validity of documents relating to an international application. However, many national laws do require signatures as part of the ordinary national procedure, and signatures could be required, for example, on documents filed in connection with an international application after it has entered the national phase.

9. If such a possible conflict with national requirements were thought to pose a serious problem, consideration might be given to the possibility of amending Rule 51*bis* so as to expressly entitle the national law of a designated State to require the furnishing, for the purposes of the national phase, the signature of any applicant who has not signed the request and who is indicated as an applicant for the purpose of the designation of that State.

10. The Working Group is invited to consider the alternative proposals contained in Annexes I and II to this document.

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

SIGNATURE OF THE INTERNATIONAL APPLICATION:
FIRST ALTERNATIVE: ELIMINATION OF ALL SIGNATURE REQUIREMENTS

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Rule 2

Interpretation of Certain Words

2.1 to 2.2*bis* [No change]

2.3 [\[Deleted\]](#) ~~“Signature”~~

~~Whenever the word “signature” is used, it shall be understood that, if the national law applied by the receiving Office or the competent International Searching or Preliminary Examining Authority requires the use of a seal instead of a signature, the word, for the purposes of that Office or Authority, shall mean seal.~~

[COMMENT: The proposed deletion of Rule 2.3 is consequential on the proposed elimination of all signature requirements.]

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) to (c) [No change]

(d) The request need not ~~shall~~ be signed.

[COMMENT: While it would possible simply to delete paragraph (d), that may be problematic in view of the wording of Article 14.1(a)(i): “The receiving Office shall check whether the international application contains any of the following defects, that is to say: (i) it is not signed as provided in the Regulations”]

4.2 *The Petition*

The petition shall be to the following effect and shall preferably be worded as follows:

“The applicant ~~undersigned~~ requests that the present international application be processed according to the Patent Cooperation Treaty.”

[COMMENT: The proposed amendment of Rule 4.2 is consequential on the proposed elimination of the signature requirements with regard to the request (see Rule 4.15, which is proposed to be deleted, below).]

4.3 to 4.14bis [No change]

4.15 ~~[Deleted]~~ *Signature*

~~(a) Subject to paragraph (b), the request shall be signed by the applicant or, if there is more than one applicant, by all of them.~~

~~(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.~~

[COMMENT: As suggested in alternative (1) in paragraph 13(ii) of the first session summary, it is proposed to delete Rule 4.15 and thus to eliminate all signature requirements with regard to the request. In other words, under this proposal, the request (and thus the international application) could be filed without any signature by the applicant(s) or by an agent or common representative.]

4.16 to 4.18 [No change]

Rule 28

Defects Noted by the International Bureau

28.1 *Note on Certain Defects*

(a) If, in the opinion of the International Bureau, the international application contains any of the defects referred to in Article 14(1)(a)~~(i)~~, (ii) or (v), the International Bureau shall bring such defects to the attention of the receiving Office.

[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed elimination of the signature requirements with regard to the request (see Rule 4.15, which is proposed to be deleted).]

(b) [No change]

Rule 53

The Demand

53.1 [No change]

53.2 *Contents*

(a) [No change]

(b) The demand need not ~~shall~~ be signed.

[COMMENT: See also Rule 4.1(d), above, the equivalent provision for the request.]

53.3 *The Petition*

The petition shall be to the following effect and shall preferably be worded as follows:

“Demand under Article 31 of the Patent Cooperation Treaty: The applicant ~~undersigned~~ requests that the international application specified below be the subject of international preliminary examination according to the Patent Cooperation Treaty.”

[COMMENT: The proposed amendment of Rule 53.3 is consequential on the proposed elimination of the signature requirements with regard to the demand (see Rule 53.8, which is proposed to be deleted).]

53.4 to 53.7 [No change]

53.8 ~~[Deleted]~~ *Signature*

~~(a) Subject to paragraph (b), the demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.~~

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

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

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

[COMMENT: As suggested in alternative (1) in paragraph 13(ii) of the first session summary, it is proposed to delete Rule 53.8 and thus to eliminate all signature requirements with regard to the demand. In other words, under this proposal, the demand could be filed without any signature by the applicant(s) or by any agent or common representative.]

53.9 [No change]

Rule 56

Later Elections

56.1 *Elections Submitted Later than the Demand*

(a) [No change]

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

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

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

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

[Rule 56.1(c), continued]

[COMMENT: As suggested in alternative (1) in paragraph 13(ii) of the first session summary, it is proposed to delete Rule 56.1(b) and (c) and thus to eliminate all signature requirements with regard to later elections. In other words, under this proposal, later elections could be filed without any signature by the applicant(s) or by an agent or common representative.]

(d) to (f) [No change]

56.2 and 56.3 [No change]

56.4 Form of Later Elections

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

[COMMENT: The proposed amendment of Rule 56.4 is consequential on the proposed elimination of the signature requirements with regard to later elections (see Rule 56.1(b) and (c), which are proposed to be deleted).]

56.5 [No change]

Rule 60

Certain Defects in the Demand or Elections

60.1 *Defects in the Demand*

(a) If the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to [53.7](#) ~~53.8~~ and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) and (c) [No change]

(d) Where, after the expiration of the time limit under paragraph (a), ~~a signature required under Rule 53.8 or~~ a prescribed indication is lacking in respect of an applicant for a certain elected State, the election of that State shall be considered as if it had not been made.

[COMMENT: The proposed amendment of Rule 60.1 is consequential on the proposed elimination of the signature requirements with regard to the demand (see Rule 53.8, which is proposed to be deleted).]

(e) to (g) [No change]

60.2 *Defects in Later Elections*

(a) to (c) [No change]

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

[COMMENT: The proposed amendment of Rule 60.2(d) is consequential on the proposed elimination of the signature requirements with regard to later elections (see Rule 56.1(b) and (c), which are proposed to be deleted).]

Rule 89bis

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

89bis.1 International Applications

(a) and (b) [No change]

(c) The Administrative Instructions shall set out the provisions and requirements in relation to the filing and processing of international applications filed, in whole or in part, in electronic form or by electronic means, including but not limited to, provisions and requirements in relation to acknowledgment of receipt, procedures relating to the according of an international filing date, physical requirements and the consequences of non-compliance with those requirements, ~~signature of documents~~, means of authentication of documents and of the identity of parties communicating with Offices and authorities, and the operation of Article 12 in relation to the home copy, the record copy and the search copy, and may contain different provisions and requirements in relation to international applications filed in different languages.

[COMMENT: The proposed amendment of Rule 89bis.1(c) is consequential on the proposed elimination of all signature requirements under the PCT.]

(d) and (e) [No change]

89bis.2 and 89bis.3 [No change]

Rule 90

Agents and Common Representatives

90.1 to 90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) The appointment of an agent or, if there are two or more applicants, of a common agent or common representative, shall be effected in ~~by the applicant signing~~ the request, the demand or a separate power of attorney. ~~Where there are two or more applicants, the appointment of a common agent or common representative shall be effected by each applicant signing, at his choice, the request, the demand or a separate power of attorney.~~

[COMMENT: While an agent or a common representative would still have to be appointed in the same way as today (that is, in the request, the demand or a separate power of attorney), signatures would not be any longer required to effect such appointment.]

(b) [No change]

(c) If ~~the separate power of attorney is not signed, or if~~ the required separate power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered non-existent unless the defect is corrected.

[COMMENT: The proposed amendment of paragraph (c) is consequential on the proposed elimination of all signature requirements.]

90.5 *General Power of Attorney*

(a) Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:

(i) [No change]

(ii) a copy of it is attached to the request, the demand or the separate notice, as the case may be; ~~that copy need not be signed.~~

[COMMENT: The proposed amendment of item (ii) is consequential on the proposed elimination of all signature requirements.]

(b) [No change]

90.6 *Revocation and Renunciation*

(a) to (c) [No change]

[Rule 90.5, continued]

(d) An agent or a common representative may renounce his appointment by a notification ~~signed by him~~.

[COMMENT: Proposed amendment of paragraph (d) is consequential on the proposed elimination of all signature requirements.]

(e) [No change]

Rule 90bis

Withdrawals

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

90bis.5 [Deleted] *Signature*

~~(a) Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, subject to paragraph (b), be signed by the applicant. Where one of the applicants is considered to be the common representative under Rule 90.2(b), such notice shall, subject to paragraph (b), require the signature of all the applicants.~~

~~(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and~~

~~(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or~~

[Rule 90bis.5(b), continued]

~~(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d) or 90bis.3(e), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or~~

~~(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with, or did not sign the later election concerned but the requirements of Rule 56.1(c) were complied with.~~

[COMMENT: The proposed deletion of Rule 90bis.5 is consequential on the proposed elimination of all signature requirements. In the absence of any replacement provision, the effect of this deletion would be to permit one co-applicant to withdraw an international application, etc., without (or even contrary to) the agreement of the other co-applicants.]

90bis.6 and 90bis.7 [No change]

Rule 92

Correspondence

92.1 *Need for Letter and for Signature*

(a) Any paper submitted by the applicant in the course of the international procedure provided for in the Treaty and these Regulations, other than the international application itself, shall, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates. ~~The letter shall be signed by the applicant.~~

(b) If the requirements provided for in paragraph (a) ~~is~~ ~~are~~ not complied with, the applicant shall be informed as to the non-compliance and invited to remedy the omission within a time limit fixed in the invitation. The time limit so fixed shall be reasonable in the circumstances; even where the time limit so fixed expires later than the time limit applying to the furnishing of the paper (or even if the latter time limit has already expired), it shall not be less than 10 days and not more than one month from the mailing of the invitation. If the omission is remedied within the time limit fixed in the invitation, the omission shall be disregarded; otherwise, the applicant shall be informed that the paper has been disregarded.

(c) Where non-compliance with the requirements provided for in paragraph (a) has been overlooked and the paper taken into account in the international procedure, the non-compliance shall be disregarded.

[COMMENT: The proposed amendment of Rule 92.1 is consequential on the proposed elimination of all signature requirements.]

92.2 to 92.4 [No change]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

SIGNATURE OF THE INTERNATIONAL APPLICATION:
SECOND ALTERNATIVE: SIMPLIFICATION AND STREAMLINING OF
PRESENT SIGNATURE REQUIREMENTS

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Rule 4

The Request (Contents)

4.1 to 4.14 [No change]

4.15 *Signature*

(a) ~~The Subject to paragraph (b), the~~ request shall be signed by the applicant or, if there is more than one applicant, by at least one ~~all~~ of them.

[COMMENT: As suggested in alternative (2) in paragraph 13(ii) of the first session summary, it is proposed that, where the international application is filed by two or more applicants, the signature of one of them would be sufficient for the purposes of the international phase.]

~~(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.~~

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

4.16 to 4.18 [No change]

Rule 26

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

26.1 to 26.3~~ter~~ [No change]

26.3~~quater~~ Checking of Signature Requirements Under Article 14(1)(a)(i)

Any receiving Office may waive the requirement that the request comply with Rule 4.15, in which case that Office shall not be required to issue the invitation under Article 14.1(b) to correct a defect under Rule 4.15 and the non-compliance with that Rule shall be disregarded.

[COMMENT: As suggested in alternative (3) in paragraph 13(ii) of the first session summary, it is proposed that, where a receiving Office so wishes, it could waive the signature requirements under Rule 4.15 as proposed to be amended (see above), in which case no signature at all – whether of (any of) the applicant(s) or from any agent or common representative – would be required in relation to the request during the international phase.]

26.4 to 26.6 [No change]

Rule 53

The Demand

53.1 to 53.7 [No change]

53.8 *Signature*

(a) ~~The Subject to paragraph (b), the~~ demand shall be signed by the applicant or, if there is more than one applicant, by at least one of the them ~~all applicants making the demand.~~

[COMMENT: As suggested in alternative (2) in paragraph 13(ii) of the first session summary, it is proposed that, where the demand is filed by two or more applicants, the signature of one of them would be sufficient. Note that it would not be required that the applicant signing the demand is applicant for a particular elected State, so that, for example, an applicant who is applicant/inventor for the US only could sign the demand even if the US is not elected. Note further that it is not proposed to amend Rule 54.2, so that, as at present, the applicant or, if there are several applicants, at least one of them must have the right to make the demand, that is, be a national or resident of a Contracting State bound by Chapter II. However, it would not be required that the applicant who signs the demand has the right to make the demand, so that the demand could be signed by an applicant who does not have the right to make a demand.]

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

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

[Rule 53.8(b), continued]

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

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

53.9 [No change]

Rule 56

Later Elections

56.1 *Elections Submitted Later than the Demand*

(a) [No change]

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

[COMMENT: As suggested in alternative (2) in paragraph 13(ii) of the first session summary, it is proposed that, where there is more than one applicant, the later election could be signed by just one of them. Note that it would not be required that the applicant signing the later election is applicant for the particular elected State, so that, for example, an corporate applicant who is applicant for all States except US could sign the notice effecting the later election of the US.]

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

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

[Rule 56.1(c), continued]

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

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

(d) to (f) [No change]

56.2 to 56.5 [No change]

Rule 60

Certain Defects in the Demand or Elections

60.1 *Defects in the Demand*

(a) [No change]

(a-bis) Any International Preliminary Examining Authority may waive the requirement that the demand comply with Rule 53.8, in which case that Authority shall not be required to issue the invitation under paragraph (a) to correct a defect under that Rule and the non-compliance with that Rule shall be disregarded.

[COMMENT: Similar to the proposed amendment of Rule 26.3 (see proposed new Rule 26.3*quater*, above), it is also proposed, along the lines of what has been suggested in alternative (3) in paragraph 13(ii) of the first session summary, to enable the International Preliminary Examining Authority, if it so wishes, to waive the signature requirements under Rule 53.8 as proposed to be amended (see above), in which case no signature at all – whether from (any of) the applicant(s) or from any agent or common representative – would be required for the demand.]

(b) and (c) [No change]

[Rule 60.1, continued]

(d) Where, after the expiration of the time limit under paragraph (a), ~~a signature required under Rule 53.8 or~~ a prescribed indication is lacking in respect of an applicant for a certain elected State, the election of that State shall be considered as if it had not been made.

[COMMENT: Proposed amendment of paragraph (d) is consequential on the proposed amendment of Rule 53.8 (see above). Under that Rule as proposed to be amended, where there are several applicants, the signature of just one of them is sufficient to elect all designated States, so that the lack of the signature of an applicant for a certain elected State should not have any consequences.]

(e) to (g) [No change]

60.2 *Defects in Later Elections*

(a) [No change]

(a-bis) The International Bureau may waive the requirement that the later election comply with Rule 56.1(b) and (c), in which case that Bureau shall not be required to issue the invitation under paragraph (a) to correct a defect under that Rule and the non-compliance with that Rule shall be disregarded.

[COMMENT: Similarly to the proposed amendment of Rule 26.3 (see proposed new Rule 26.3*quater*, above), it is proposed, along the lines of what has been suggested in alternative (3) in paragraph 13(ii) of the first session summary, to enable the International Bureau, if it so wishes, to waive the signature requirements under Rule 56.1(b) and (c) as proposed to be amended (see above), in which case no signature at all – whether from (any of) the applicant(s) or from any agent or common representative – would be required to effect a later election.]

[Rule 60.2, continued]

(b) and (c) [No change]

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

[COMMENT: Proposed amendment of paragraph (d) is consequential on the proposed amendment of Rule 56.1(b) (see above). Under that Rule as proposed to be amended, where there are several applicants, the signature of just one of them is sufficient to submit a notice of later election of any designated State, so that the lack of the signature of an applicant for a certain elected State should not have any consequences.]

Rule 90

Agents and Common Representatives

90.1 to 90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) to (c) [No change]

(d) Any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement provided in paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply and any defect under that paragraph shall be disregarded.

[COMMENT: As has been suggested in alternative (4) in paragraph 13(ii) of the first session summary, it is proposed to enable any receiving Office, International Searching Authority, International Preliminary Examining Authority and the International Bureau, if so wished, to waive the requirement that a power of attorney is furnished where the applicant is represented by an agent, or where several applicants are represented by a common agent or a common representative.]

90.5 *General Power of Attorney*

(a) and (b) [No change]

(c) If the general power of attorney has not been deposited in accordance with paragraph (a)(i), or if the required copy of the general power of attorney is not attached in accordance with paragraph (a)(ii), the power of attorney shall be considered non-existent unless the defect is corrected.

[COMMENT: It is proposed to add new paragraph (c), modeled after present Rule 90.4(c), so as to clarify that a general power of attorney may be considered non-existent if any of the requirements referred to in paragraph (a) is not complied with and that defect is not corrected.]

(d) Any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirements provided in paragraph (a)(i) and (ii), where applicable, in which case paragraph (c) shall not apply and any defect under that paragraph shall be disregarded.

[COMMENT: See the Comment on proposed new Rule 90.4(d).]

90.6 [No change]

Rule 90bis

Withdrawals

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

90bis.5 *Signature*

(a) Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, subject to paragraph (b), be signed by the applicant or, if there is more than one applicant, by at least one them. ~~Where one of the applicants is considered to be the common representative under Rule 90.2(b), such notice shall, subject to paragraph (b), require the signature of all the applicants.~~

[COMMENT: Along the lines of what has been suggested in alternative (2) in paragraph 13(ii) of the first session summary, it is proposed that, where the international application is filed by two or more applicants, the signature of one of them is sufficient for a withdrawal under Rule 90bis. In the absence of any replacement provision, the effect of this deletion would be to permit one co-applicant to withdraw an international application, etc. without (even contrary to) the agreement of the other co-applicant(s).]

(b) ~~[Deleted] Where two or more applicants file an international application which State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and~~

[Rule 90bis.5(b), continued]

~~(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or~~

~~(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d) or 90bis.3(e), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or~~

~~(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with, or did not sign the later election concerned but the requirements of Rule 56.1(c) were complied with.~~

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

90bis.6 and 90bis.7 [No change]

Rule 92

Correspondence

92.1 *Need for Letter and for Signature*

(a) and (b) [No change]

(b-bis) Any national Office or intergovernmental organization may waive the signature requirement provided for in paragraph (a) in which case that Office or intergovernmental organization shall not be required to issue the invitation under paragraph (b) and the non-compliance with that signature requirement shall be disregarded.

[COMMENT: Along the lines of what has been suggested in alternative (4) in paragraph 13(ii) of the first session summary, it is proposed to enable any receiving Office, International Searching Authority, International Preliminary Examining Authority and the International Bureau, if so wishes, to waive the requirement that every letter sent to it must be signed.]

(c) [No change]

92.2 to 92.4 [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/2/8

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

ABSENCE OF “FORMAL” CLAIMS

Document prepared by the International Bureau

BACKGROUND

1. During its first session, held in Geneva from November 12 to 16, 2001, the Working Group discussed proposals to amend the Regulations so as to align the requirements of the Patent Cooperation Treaty (PCT) with regard to claims as a filing date requirement to those of the Patent Law Treaty (PLT) (see document PCT/R/WG/1/5, paragraphs 5 and 6, and Annex I).¹ PCT Article 11(1)(iii)(e) requires that for an international filing date to be accorded, an international application shall, *inter alia*, contain a part which on the face of it appears to be a claim or claims. In contrast, under PLT Article 5(1), claims are not required for a filing date to be accorded. As reported in the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”):

“25. Discussions were based on document PCT/R/WG/1/5, and in particular on proposed new Rules 20.4(d) and 26.3*ter*, contained in Annex I to that document, which would provide for claims to be considered to be filed as a legal fiction and to be added

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

later as a correction of a formality defect. The comments and concerns expressed by various delegations included the following:

- (i) the idea of according a filing date under the PCT to an international application without claims was widely supported, but the wording of Articles 11(1)(iii)(e) and 58 did not support the draft Rules proposed; it would be necessary to develop a proposal to revise the Treaty itself;
- (ii) to adopt amended Regulations that were so clearly inconsistent with the Treaty itself would jeopardize the rights of applicants;
- (iii) the Treaty provided no basis for adding claims before the international search took place; a problem may also be posed by Articles 19 and 34 which provide that amendments shall not go beyond the disclosure in the international application as filed;
- (iv) the representatives of users emphasized the need to find a solution in the PCT for such cases; PCT applicants should not be at a disadvantage in this respect compared to applicants filing national applications.

“26. The Working Group would be prepared to consider other ways of dealing with international applications having no claims pending revision of the Treaty itself. The International Bureau would attempt to elaborate proposals bearing in mind, in particular, the following possibilities:

- (i) the Treaty distinguishes between the “international application” on the one hand and the “record copy” on the other; different treatment may be able to be accorded to papers according to those different notions;
- (ii) advantage might be able to be taken in cases where there is “claim-like” wording appearing in the description; it was noted that the procedure under the European Patent Convention provided for the description to repeat, in effect, the wording of the claims;
- (iii) the request form could include pre-printed wording sufficient to constitute “a part which on the face of it appears to be a claim or claims” for the purposes of Article 11(1)(iii)(e);
- (iv) the international search might be able to be undertaken without the presence of formal claims, or on the basis of a “search statement” furnished by the applicant;
- (v) new possibilities being developed for combined search and examination under the PCT might allow for claims furnished under Article 34 to be taken into account for both international search and international preliminary examination.”

2. As requested by the Working Group, the International Bureau has studied various proposals, bearing in mind, in particular, the possibilities outlined in paragraph 26(i) to (v) of

the first session summary. This document² contains revised proposals designed to align the PCT requirements with those under the PLT as regards according an international filing date to international applications filed without “formal” claims, based on the possibilities set out in paragraph 26(ii) and (iii) of the first session summary.

ABSENCE OF “FORMAL” CLAIMS

3. The proposals set out in the Annex³ are based on the following approach:

(i) a suitably worded *pre-printed statement*, which would be included in the printed request form proposed new Rule 4.1(c)(iv),⁴ would be sufficient to constitute “a part which on the face of it appears to be a claim or claims” and hence to support the according of an international filing date;

(ii) the presence of “*claim-like*” wording in the description is sufficient to constitute “a part which on the face of it appears to be a claim or claims” and hence to support the according of an international filing date, noting that Article 11(1)(iii)(e) does not prescribe where that part shall be included in the international application and does not require that the claims be expressly identified as such); while that position is true at present, proposed new Rule 20.4(e) would put the matter beyond doubt;

(iii) where compliance with Article 11(1)(iii)(e) relies solely on either of the two possibilities just mentioned, the application should be considered to contain a formal defect under Article 14; such a defect can be remedied by the *furnishing of “formal” claims as a correction* under Rule 26.

4. The pre-printed statement referred to in paragraph 3(i), above, is proposed to read as follows:

“In the absence of any other claim or claims in the international application, the following matter for which protection is sought is hereby claimed: The invention set out in the description and illustrated in the drawings, if any, of this international application.”

² This and other working documents for the present session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

⁴ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 and the Regulations under the PLT (see document PT/DC/47 on WIPO’s web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

The proposed statement would not apply, under its own terms, if the international application contains a “formal” claim or claims.

5. If the approach just outlined is acceptable, there is no need to further consider, for the time being, the possibilities mentioned in paragraph 26(iv) of the first session summary, since the formal claims so furnished would form the basis for the international search. An appropriate provision may be needed to deal with the consequences for the application if the formal claims added by way of correction went beyond the disclosure in the international application as filed (see, for example, Articles 19(2) and (3), 28(2)(b) and 34(2)(b)).

6. As mentioned in paragraph 26(i) of the first session summary, the Treaty distinguishes between the “international application” on the one hand and the “record copy” on the other, so that different treatment might be accorded to papers according to those different notions. However, at this point, it is proposed that this possibility should only be investigated if the proposals contained in this document do not find favor with the Working Group.

7. As mentioned in paragraph 26(v) of the first session summary, new possibilities developed for combined search and examination under the PCT might allow for claims furnished under Article 34 to be taken into account for both international search and international preliminary examination. However, pending discussions in the Working Group on the issue of an expanded international search system (see document PCT/R/WG/2/1), such new possibilities have not been further investigated, but they should be looked at more closely at a later stage as a supplementary procedure to the proposal outlined in this document.

8. In the event that the correction procedure mentioned in paragraph 3(iii), above, is found not to be appropriate, it would be possible for the international search to be undertaken, in the absence of “formal” claims, on the basis of a “search statement” that the applicant would have the option of furnishing. Such a “search statement” would, while not forming part of the international application, replace “formal” claims for the purposes of the international search. It would be worded in accordance with Rule 6 (which outlines the requirements for “formal” claims”), would be published together with the international application and the international search report, and would be taken into account when determining whether the international application complies with the requirement of unity of invention. It would be used for the purposes of international search only but not for the purposes of international preliminary examination since, following the establishment of the international search report, the applicant has several opportunities to amend the claims (under Articles 19 and 34) so as to have international preliminary examination carried out on the basis of the claims so amended.

9. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

ABSENCE OF “FORMAL” CLAIMS

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Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [no change]

(c) The request may contain:

(i) and (ii) [no change]

(iii) declarations as provided in Rule 4.17.:

(iv) a claim worded as provided in the Administrative Instructions.

(d) [No change]

[COMMENT: The following text would be included in a new box in the PCT request (Form PCT/RO/101), provided for in the Administrative Instructions: “In the absence of any other claim or claims in the international application, the following matter for which protection is sought is hereby claimed: The invention as set out in the description and illustrated in the drawings, if any, of this international application.”.]

Rule 6

The Claims

6.1 to 6.5 [No change]

6.6 *Inclusion of Formal Claims*

Where the receiving Office finds that the international application includes a part which on the face of it appears to be a claim or claims only by virtue of Rule 4.1(c)(iv) or 20.4(e), the international application shall be considered not to comply with Article 14(1)(a)(v) and Rule 26 shall apply accordingly.

[COMMENT: New Rule 6.6 would enable the applicant to include “formal” claims by way of correction of a formal defect under Rule 26.]

Rule 20

Receipt of the International Application

20.1 to 20.3 [No change]

20.4 *Determination Under Article 11(1)*

(a) to (d) [No change]

(e) For the purposes of Article 11(1)(iii)(e), it shall be sufficient that there is wording in any part of the international application which makes it clear what is the matter for which protection is sought.

[COMMENT: Paragraph (e) is included for the sake of clarification to cover cases where there is no part headed “Claims” but where there is clearly “claim-like” wording in the description; see paragraph 26(ii) of the first session summary and paragraph 3(ii) under Background, above. Article 6 refers to claims as defining “the matter for which protection is sought.”]

20.5 to 20.9 [No change]

[End of Annex and of document]