

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-First (18th Extraordinary) Session
Geneva, September 23 to October 1, 2002

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/37/1 Prov.3): 1, 2, 5, 7, 8, 9, 12, 18, 23 and 24.
2. The report on the said items, with the exception of item 18, is contained in the General Report (A/37/14).
3. The report on item 18 is contained in the present document.
4. Mr. Jørgen Smith (Norway), the current Chair of the Assembly, presided over the session.

ITEM 18 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Appointment of the Canadian Commissioner of Patents as an International Searching and Preliminary Examining Authority Under the PCT; Approval of the Corresponding Agreement

5. Discussions were based on documents PCT/A/31/1 and 1 Add.1, and PCT/CTC/20/5.
6. The Chair noted that the PCT Committee for Technical Cooperation (PCT/CTC) had, at its twentieth session held from September 23 to October 1, 2002 (see document PCT/CTC/20/5, paragraph 25), unanimously recommended to the Assembly that the Canadian Commissioner of Patents be appointed as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA).
7. In response to an invitation by the Chair, the Delegation of Canada referred to the statement it had made before the PCT/CTC (see document PCT/CTC/20/5, paragraphs 12 to 15 and 24).
8. In response to a question from the Delegation of Sudan, which was in favor of the proposed Agreement, the International Bureau clarified that the Agreement would be terminated before December 2007 only in extraordinary situations, and that the body which would settle possible disputes between the parties would be the Assembly.
 9. The Assembly:
 - (i) approved the text of the Agreement between the Canadian Commissioner of Patents and the International Bureau as set out in Annex I to this report; and
 - (ii) appointed the Canadian Commissioner of Patents as ISA and IPEA with effect from the entry into force of said Agreement.
10. The Delegation of Canada, on behalf of the Government of Canada, expressed its gratitude to the Assembly for granting the Commissioner of Patents the status of an ISA and IPEA. It pointed out that the Canadian Intellectual Property Office had a highly qualified, competent and growing number of patent examiners. It also had a modern and efficient automated patent processing system as well as a vast collection of patent documents and on-line resources; it also had an organizational commitment to the pursuit of excellence in client service delivery. Canada was looking forward to working with WIPO and all of its Member States in the pursuit of improved services in industrial property Offices around the world. The anticipated commencement of the new services would be in the summer of 2004.

Appointment of the National Board of Patents and Registration of Finland as an International Searching and Preliminary Examining Authority Under the PCT

11. Discussions were based on documents PCT/A/31/2 and PCT/CTC/20/5.

12. The Chair noted that the PCT/CTC had, at its twentieth session held from September 23 to October 1, 2002 (see document PCT/CTC/20/5, paragraph 52), recommended to the Assembly that further consideration of the request by the National Board of Patents and Registration of Finland (“the Finnish Office”) for appointment as an ISA and IPEA be deferred until 2003. He stated that no delegation had questioned the right of the Finnish Office to seek appointment as an ISA and IPEA and that compliance by that Office with technical requirements was not at issue; indeed, many delegations had expressed their confidence in the competence and technical capacity of the Finnish Office.

13. In response to an invitation by the Chair, the Delegation of Finland made a short statement on behalf of its government. It welcomed the International Bureau’s positive consideration of the Finnish application to be appointed as a PCT International Authority. It recalled that all speakers who participated on this item had stated, during the session of the PCT/CTC, that the Finnish Office had the right to be appointed as International Authority, and had also stated that the Finnish Office had the capacity and ability to be a PCT International Authority. Such statements had been noted by the Finnish Office with great satisfaction. Therefore, the Finnish government was going to continue to pursue this application and expected that it would be decided during the upcoming session of the Assembly.

14. The Assembly deferred further consideration of the request by the Finnish Office for appointment as an ISA and IPEA until 2003.

Amendment of the Agreement Between the Japan Patent Office and the International Bureau of WIPO in Relation to the Functioning of the Japan Patent Office as an International Searching Authority and Preliminary Examining Authority Under the PCT

15. Discussions were based on document PCT/A/31/3.

16. The Assembly unanimously approved the text of the amended Agreement between the Japan Patent Office and the International Bureau, as set out in Annex II to this report.

Report of the Committee on Reform of the PCT: Proposed Amendments of the Regulations Under the PCT

17. Discussions were based on documents PCT/A/31/5, 6, 6 Add.1, 6 Add.2, 6 Add.3 and 9.

18. The representative of the EPO stated that the Assembly had before it a series of proposals which represented the most significant amendments of the PCT since its entry into force. On behalf of the European Patent Organisation, he congratulated the International Bureau on this important step in the PCT reform process.

19. The representative of the EPO noted that the first stage of reform of the PCT hailed the beginning of a process which may well, in due course, go on to consider even more far-reaching changes to the Treaty. He further noted that, over the last 30 years, the Treaty had proved itself to be an outstanding example of international cooperation in the field of industrial property, and had changed the face of patent prosecution at the global level. Many factors had combined to make the PCT the route of choice for the majority of applicants

seeking international patent protection. Its efficiency, legal certainty and attractiveness were the products of step-by-step reforms introduced under the stewardship of WIPO but with the active involvement of the national Offices and, in particular, the leading International Authorities, stemming back to the 1980's, continuing with undiminished energy right up to the present day.

20. Recalling that the proposals for amendment of the PCT Regulations had been thoroughly discussed in the Committee and the Working Group on Reform of the PCT, and also within the European Patent Organisation's Administrative Council and its Committee on Patent Law, the representative of the EPO stated that the proposed amendments would contribute to the originally stated objective of simplifying and improving the PCT system. In particular, the expanded international search system would bring concrete benefits in terms of improved quality for applicants and national Offices, in particular, smaller national Offices, and for developing countries. The expected alleviation of the workload problems would help to free up resources which might be better deployed elsewhere in the system. The EPO was confident that it would be in a position to implement the proposals by the target date, that is, for international applications filed as from January 1, 2004.

21. The representative of the EPO noted that the first stage of PCT reform had certainly led to a number of practical suggestions, and that much more rapid progress had been achieved than might have been thought possible two years ago when the exercise started. The question would now arise as to where to go from here. He expressed the view that much remained to be done, and emphasized that the European Patent Organisation was keen to play its part in shaping a vision for the long-term future.

22. The representative of the EPO stated that ensuring high quality work during the international phase of processing was essential to facilitate national and regional processing, but it also had a direct bearing on the quality of patents ultimately granted by national or regional Offices concerned. He believed that there could be no question of removing decisions from the exclusive competence of each Contracting State; this had never been the aim of the PCT. Sovereign decisions of the Contracting States should have a firm basis in the groundwork done in international processing, which would not only foster improved quality but would also help to ensure equality, since the high standard of work attributed to search and examination should not be the preserve of only a few selected Offices; rather, it should be freely accessible to applicants in all PCT Contracting States. The new expanded international search system would certainly represent a significant improvement in that regard.

23. The representative of the EPO stated that the European Patent Organisation would welcome discussion on quality management mechanisms such as continuing review of the PCT guidelines for international search and international preliminary examination. The representative further stated that, as a consequence, any progress achieved within the Standing Committee on the Law of Patents on harmonization of substantive patent law could only have a positive influence on quality. In fact, the "PCT Partnership" between the EPO and the Spanish and Swedish Offices could serve as a useful model for quality control, since the Partnership had considerable experience in establishing common standards and in joint training and monitoring. The Meeting of International Authorities under the PCT (PCT/MIA) had an important role to play in shaping quality standards. There were, of course, many other possibilities for ensuring greater uniformity and higher quality across the board, some of which were currently given effect within the PCT Partnership, including examiner exchanges

and common working tools and procedures, such as common classifications and common databases.

24. The representative of the EPO further stated that it would be difficult to say whether quality management in this context could be promoted by a more regulatory framework. At the moment, applicants and national Offices had the opportunity to decide where their expectations of quality could best be met. The EPO had certainly enjoyed considerable success in attracting applicants from all over the world. Freedom of choice established a *de facto* benchmark. The European Patent Organisation very much encouraged other Authorities to adopt a similar open and user conscious approach.

25. In summarizing, the representative of the EPO stressed that the European Patent Organisation considered that it had a duty to participate fully in ensuring the proper development of the PCT system. Further development of the PCT would be desirable and, with this in mind, it was of the utmost importance that quality, which was the cornerstone of the system, be maintained and, where possible, improved. The current proposals represented a significant milestone in the reform process; they would simplify and improve the system. The European Patent Organisation fully supported the proposals and underlined its commitment to future reform work.

26. Noting that it was proposed, in paragraph 61 of document PCT/A/31/6, not to change the level of PCT fees in 2003, the Delegation of the United States of America expressed the view that there was no reason to postpone a possible further reduction of PCT fees to a later date. The Delegation repeated the proposal, which it had made during the discussions on the revised program and budget of WIPO for 2002-2003, to reduce the maximum number of designation fees payable to 4 as of January 1, 2003, as had been envisaged by the Assembly at its session last year. The Delegation further requested more detailed information on the proposed amount of the late furnishing fee under Rule 12.3(e) as proposed to be amended and proposed new Rule 12.4(e), and of the late payment fee under Rule 16*bis*.2(b) as proposed to be amended.

27. Responding to the intervention made by the Delegation of the United States of America, the International Bureau confirmed that the Assembly, at its thirtieth (13th ordinary) session held from September 24 to October 3, 2001, had envisaged that a further reduction of the maximum number of designation fees payable from 5 to 4 could take place with effect from January 1, 2003, in line with the business plan and objectives at the time. However, at the time, it had been impossible to predict that PCT reform would proceed as fast as it had and that, as one of the results of the discussions on PCT reform, the designation system and, as a consequence, the system of designation fees would in practice be abolished. Against this background, it was felt that a review of the fee structure and possible reductions of fees should best be undertaken, in the context of the necessary determination of the amount of the new international filing fee, in the course of preparing the program and budget of WIPO for 2004-2005.

28. With regard to the proposed amount of the late furnishing fee under Rule 12.3(e) as proposed to be amended and proposed new Rule 12.4(e), and of the late payment fee under Rule 16*bis*.2(b) as proposed to be amended, the International Bureau explained that, upon reflection, the percentage originally agreed upon in the Committee on Reform of the PCT, namely, 50% of the international filing fee, would have resulted in those fees being much higher than at present, namely, 50% of the basic fee. It was thus proposed to fix the amount at 25% of the international filing fee.

29. The Delegation of Japan expressed its support for the proposed new fee structure and the new international filing fee, but emphasized that, in the context of the necessary review of the fee structure that would take place in the course of preparing the program and budget of WIPO for 2004-2005, care and caution should be exercised in deciding whether to incorporate the handling fee (applicable under Chapter II of the PCT) into the new international filing fee (applicable under Chapter I) (see paragraph 62 of document PCT/A/31/6). The Delegation emphasized the need to ensure that applicants who, under the present system and fee structure, only used the Chapter I procedure would not be disadvantaged by having to pay considerably higher fees than was presently the case under Chapter I.

30. In response to the intervention made by the Delegation of Japan, the International Bureau stated that extensive consultations with all parties involved would take place in the process of preparing a proposal for the new fee structure.

31. Following the explanations given by the International Bureau, the Delegation of the United States of America, speaking on behalf of Group B, stated that Group B had noted the statements of the International Bureau proposing to delay the envisaged reduction of the maximum number of designation fees payable from 5 to 4, which was to bring about a reduction in PCT fees of approximately 8%, and that the International Bureau placed this proposal in the context of various other fee changes and a complete review of the fee structure. The Delegation further stated that Group B stressed its interest in continuing the reduction of PCT fees. Group B accepted the rationale of the International Bureau for the delay, but expected that, once the new fee structure had been elaborated in the course of preparing the program and budget of WIPO for 2004-2005, the new fees should be significantly lower, by a percentage which would represent not only the expected 8 per cent reduction but also a further percentage, in effect to compensate users for the one-year delay.

32. The Delegation of Barbados thanked WIPO for the PCT reform work, noting that the PCT had served Barbados extremely well over the years. While generally in agreement with all of the proposed reforms, and in particular with the proposal to introduce a procedure for establishing an examiner's opinion under Chapter I, the Delegation wished to express some concern about the quality of some of the international preliminary examination reports which Barbados had been receiving recently under Chapter II.

33. The Delegation of Barbados further stated that as a small Office with no substantive examination capacity, the Barbados Intellectual Property Office had always given great weight to the examiner's opinion on patentability contained in international preliminary examination reports. Over the years, those reports had provided to the Office important technical opinions on the basis of which a patent could be granted. However, the Office recently had noted a marked deterioration in the quality of some of the reports that it had received. For example, whereas the Office had grown accustomed to receiving detailed and well-reasoned reports that clearly identified the individual claims in respect of which a patent may or may not be issued, some of the reports received recently had simply indicated, in a mere one or two pages, that patentability criteria had not been met for some or all of the claims, or had only been met in part, without giving much additional information. Obviously, such reports left a small Office like the Barbados Intellectual Property Office with little technical basis or rationale on which to proceed.

34. The Delegation of Barbados expressed its hope that the examiner's opinion on patentability to be established under the new Chapter I proceedings would bear those quality

concerns in mind, and further, that the quality of the international preliminary examination reports under Chapter II would be improved.

35. The Delegation of Barbados noted further that, during the course of the session of the Committee on Reform of the PCT held in July this year, it had been understood that, unlike the current procedure under Chapter II in which the International Preliminary Examining Authority entered into a dialogue with the applicant, the International Searching Authority would not be entertaining a dialogue with the applicant during the course of the establishment of the written opinion on patentability under the proposed new Chapter I proceedings. Noting that some delegations at the Committee meeting had expressed the view that such a dialogue on the written opinion should instead take place during the national phase, the Delegation expressed its concern about the absence of a dialogue during the international phase on the proposed written opinion by the International Searching Authority under Chapter I and noted that the Barbados Intellectual Property Office, having no capacity in technical matters, would be unable to enter into a technical discussion on patentability with the applicant during the national phase. For obvious reasons, this could adversely affect the Office's ability to process international applications in the national phase.

36. The International Bureau confirmed that it was an important part of the proposed amendments that the International Searching Authority would prepare, in respect of all international applications, a written opinion at the same time as the international search report. For applicants, and also for small Offices for whom the opinion contained in the international preliminary examination report was essential, the proposed new Chapter I procedure would provide such opinion in all cases, instead of only about 80 per cent of cases as at present. In respect of quality, the International Bureau noted that certain International Preliminary Examining Authorities were under substantial work pressure and had adopted a truncated system of international preliminary examination as an interim measure; this was not intended to represent a system for the future. The future system aimed at full and high quality opinions.

37. With regard to the dialogue between the applicant and the examiner, the International Bureau stated that, while it would not be practical for such a dialogue to be introduced into the proposed new Chapter I procedure, it would remain one of the essential features of the Chapter II procedure. However, if more Offices, like the Barbados Intellectual Property Office, used international preliminary examination reports effectively, there would be a greater incentive for applicants to use Chapter II, thus reducing duplication of work around the world and increasing the benefits of the PCT system, especially to smaller Offices. In further developments of this aspect of the system, it would be essential that the needs of small Offices be borne particularly in mind.

38. The Delegation of South Africa requested clarification on when the single international filing fee was to be introduced and on the new role of the International Searching Authorities, the effect of which should be monitored by the International Bureau and by the Assembly.

39. The International Bureau, in response to the above request, explained that the single international filing fee was a consequence of the amendments proposed in Annex II of document PCT/A/31/6, which would come into effect on January 1, 2004. The new fee structure, including the amount of the new international filing fee and possible fee reductions, would be considered in the course of preparing the program and budget of WIPO for 2004-2005. The enhanced international search and preliminary examination procedure had been discussed in great detail by the Committee and Working Group on Reform of the PCT. The

changes were radical but represented an enhancement of the system, both for applicants and for Offices.

40. The Delegation of China noted that there were differences between the new system and existing Chinese law in respect of the possibilities for late entry into the national phase and concerning priority documents and that, consequently, China would need to take advantage of the transitional reservation provisions. The Delegation welcomed the development of digital libraries and hoped that WIPO would be able to accelerate the process of their creation. Furthermore, the Delegation expressed the wish for a clear medium- and long-term plan for future work on reform of the PCT so as to enable Offices to consult with users of the system on particular proposals.

41. The International Bureau proposed the following minor corrections to the text appearing in Annex II of document PCT/A/31/6, in addition to the amendments appearing in document PCT/A/31/6 Add.3:

(i) in Rule 16*bis*.1(c), since item (i) was deleted, items (ii) and (iii) should be renumbered as (i) and (ii), respectively (see document PCT/A/31/6, Annex II, page 14);

(ii) in Rule 47.2, since items (b) and (c) were deleted, leaving only (a), the letter “(a)” at the beginning of the paragraph should be deleted (see document PCT/A/31/6, Annex II, page 31);

(iii) in the title of Rule 60, since the part of the Rule relating to later elections had been deleted, the words “or Elections” should be deleted from the title (see document PCT/A/31/6, Annex II, page 44);

(iv) Rule 78.3, which was not mentioned in document PCT/A/31/6, should be indicated as remaining unchanged (see document PCT/A/31/6, Annex II, page 57);

(v) in item 1 of the Schedule of Fees set out on page 64 of Annex II to document PCT/A/31/6, the current amount of the basic fee (650 Swiss francs) should be indicated (rather than a blank space (“[...]”)) as the amount of the international filing fee, and a footnote should be added, stating that the fee structure and the amounts of the fees were subject to further consideration, and including a reference to paragraph 50 of this report.

42. With regard to the proposed amendment of the Schedule of Fees annexed to the Regulations under the PCT, set out in Annex I to document PCT/A/31/9 (fee reduction for international applications filed in electronic form), the Delegation of Japan stated that it strongly supported the proposal. Noting the advantages of electronic filing for applicants and the benefits for Offices resulting from a streamlined handling of international applications filed in fully electronic form, the Delegation stressed the importance of promoting electronic filing and of giving applicants an incentive to file international applications in electronic form in the form of a fee reduction.

43. The Delegation of France stated that it also supported the proposal set out in Annex I to document PCT/A/31/9, agreeing with the views expressed by the Delegation of Japan, and noting that Offices would greatly benefit from the exchange of information in fully electronic form, including priority documents.

44. The Assembly:

(i) took note of the report of the second session of the Committee on Reform of the PCT contained in document PCT/R/2/9 and reproduced in Annex II to document PCT/A/31/5;

(ii) unanimously approved the Committee's recommendations concerning the language-related filing date requirements of the Patent Law Treaty and the proposed amendments of certain Rules relating to the right of priority and priority claims, as set out, respectively, in paragraphs 92 and 125 of the Committee's report;

(iii) unanimously approved the Committee's recommendations concerning the work program in connection with reform of the PCT to be undertaken between the September 2002 and September 2003 sessions of the Assembly, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee, and financial assistance to enable attendance of certain delegations, as set out, respectively, in paragraphs 135 and 136, 140(i) and 140(ii) of the Committee's report.

45. The Assembly unanimously adopted:

(i) the amendments of the Regulations under the PCT contained in Annexes III, IV and V;

(ii) the decisions contained in Annex VI relating to entry into force and transitional arrangements in respect of those amendments.

46. In connection with amended Rules 36.1 and 63.1, the Assembly noted that those provisions as amended would require that any future appointment by the Assembly of an Office or organization as an International Searching Authority and an International Preliminary Examining Authority would need to be simultaneous.

47. The Assembly agreed that no special provision should be included in the Regulations to enable the applicant to comment on the written opinion of the International Searching Authority. Any formal response to the written opinion of the International Searching Authority would need to be submitted to the International Preliminary Examining Authority under Article 34 as part of the Chapter II procedure, that is, by requesting international preliminary examination. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent by the International Bureau to all designated Offices and made publicly available, as would be, under proposed new Rule 44*ter*, the report resulting from the written opinion of the International Searching Authority. Designated Offices would be free to require a translation of such comments. The main purpose of allowing for informal comments to be submitted would be to give the applicant an opportunity to rebut the written opinion of the International Searching Authority in the event that international preliminary examination was not requested.

48. In connection with new Rule 44*bis* and amended Rule 70, the Assembly agreed that the titles "international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)" and "international preliminary report on patentability (Chapter II

of the Patent Cooperation Treaty)” were not in conflict with Article 35(2), since such reports would not, as provided by that Article, “contain any statement on the question whether the claimed invention was or seemed to be patentable or unpatentable according to any national law.” Rather, the report would be limited to a statement, in relation to each claim, as to whether the claim appeared to satisfy the criteria of novelty, inventive step and industrial applicability as defined for the purposes of the international phase under the PCT (see Article 33 and Rules 64 and 65).

49. In connection with amended Rules 17.1(b-*bis*) and (d), 66.7(a) and 93*bis*.1(b), the Assembly noted that details of the system for making documents available via digital libraries would be governed by the Administrative Instructions, the necessary modifications of which would, under Rule 89.2(b), be the subject of consultation with interested Offices and Authorities, and agreed that it would be necessary to ensure that those Offices and Authorities found the proposed system acceptable before the modifications were promulgated.

50. In connection with amended Rule 15 and the Schedule of Fees, the Assembly agreed that, as a consequence of the change in the fee structure, the amount of the new international filing fee would be determined in the course of preparing the program and budget of WIPO for 2004-2005, taking into consideration the proposed level of budgetary resources, including reserve requirements, as outlined in document PCT/A/31/6, paragraphs 59 to 61.

51. The Assembly agreed that consideration should be given to incorporating the handling fee (see Rule 57 and the Schedule of Fees) into the new international filing fee, and that proposed amendments of the Regulations should be prepared by the International Bureau accordingly and submitted to the Assembly in 2003 for consideration in conjunction with the fixing of the amount of the international filing fee.

Common Quality Framework

52. Discussions were based on document PCT/A/31/8.

53. In introducing document PCT/A/31/8, the Delegation of the United Kingdom stated that the successful Roundtable held earlier this week had considered the growth in the number of patent applications and the burden this was placing on Offices around the world. The importance of issuing high quality patents had been emphasized. Increased demand and scarce resources made the achievement of that objective increasingly difficult.

54. The Delegation of the United Kingdom pointed to the progress made in agreeing on reforms of the PCT procedure which should enable better use of the international phase and a reduction in the duplication of effort involved in the way Offices work. The Delegation pointed out that there was a need for further substantive harmonization before States could reap the full rewards of an approach of “one search - one examination - many grants.” But something else needed to be done, which would not only give confidence but also help identify where further harmonization was needed and also where it was not needed: that “something else” was the construction of a quality management system providing a quality framework which was both transparent and objective. There were a number of ways in which this could be achieved, some of which were identified in the document; the European Patent Organisation, in its earlier statement, which was supported by the Delegation of the United

Kingdom, had identified others. The essential matter was recognizing the importance of quality levels. The Delegation referred to the earlier intervention of the Delegation of Barbados, which identified the importance of high quality reports for smaller Offices.

55. The Delegation of the United Kingdom emphasized that the transparency required of the system was such that quality must be publicly validated. Patent Offices might have the technical skills and systems to be confident of their own quality, but users and other stakeholders needed that confidence too. The Delegation stated that this could be provided by including monitoring and feedback in the system. The United Kingdom's Patent Office had chosen to use the International Organization for Standardization (ISO) quality standard, and such principles could well be applicable to the PCT system. However, the Delegation was not calling for a detailed and final decision on how to deal with the matter; rather, the question of a quality framework should be discussed by the Committee or the Working Group on Reform of the PCT as part of the program for future reform. The Delegation of the United Kingdom stated its intention to play a full and constructive role in this effort.

56. The Delegation of Denmark fully endorsed the proposal submitted by the United Kingdom. In the context of European discussions, Denmark had for many years argued that qualified resources in national patent Offices should be used, for instance, in dealing with backlogs, but only if a quality management system were created in such a way that users could feel sure that the work performed by such Offices was of the required quality. In this connection, Denmark had commissioned reports from an international consulting company which described how a quality system could be established. The Delegation had given a copy of those reports to the International Bureau in the hope that they would provide some inspiration in the future work related to quality.

57. The Delegation of Australia strongly endorsed the proposal submitted by the United Kingdom. There were significant improvements to be made and a quality framework would play an important part. Offices around the world were struggling to keep up with an ever-increasing workload, and various suggestions had been put forward as to how this problem could be addressed. Given that many applicants filed applications for the same invention in a number of countries, and that those applications were then assessed against virtually the same criteria in each national Office, there should be ways of avoiding the duplication of effort currently occurring in Offices. The PCT system went some way towards addressing that situation by allowing for the filing of a single application which was then subjected to a single international search and possibly a single preliminary examination. However, it seemed that there was still considerable duplication of effort between Offices, even in the processing of PCT applications.

58. The Delegation of Australia stated that it believed that there should be only a single search and examination for applications around the world for the same invention. National Offices would do only the additional work necessary to ensure that applications met the requirements of national law. This could not be achieved unless Offices had confidence in the work performed by other Offices. One way of gaining that confidence would be to conduct "benchmarking" exercises among Offices, focusing on particular aspects of the patent process. IP Australia and the United Kingdom Patent Office had conducted formal benchmarking exercises involving the comparison of searches carried out on a number of applications across a range of technologies. As a result of those exercises, both Offices had been able to build confidence in the searches performed by one another, as well as to gain a greater understanding of their internal processes. The Delegation believed that similar exercises could provide greater understanding of common areas of practice, so that Offices

could assess the extent to which work done by other Offices was equivalent to work done domestically. An Office could then determine what, if any, other work was required to meet domestic requirements.

59. The Delegation of Australia pointed out that such benchmarking exercises could be time-consuming and costly. However, it was not necessary for Offices to conduct separate exercises if a common quality framework for the conduct of search and examination could be established. That framework would need to be based on recognized quality standards that were clear and transparent for both Offices and users of the system, together with procedures to assess and maintain quality. A possible starting point might be to adopt an internationally recognized standard for quality, such as the ISO 9000:2000 standard. Any Office that could demonstrate that it met the quality standard would be able to participate. As a result, all Offices, irrespective of whether or not they participated, could have confidence in the work done by the participating Offices.

60. The Delegation of Australia felt that an important issue in adopting any quality standard was to determine the level of quality required. It was possible to set the level so high that many Offices would be unable to achieve it without significant expenditure of resources, and consequent additional costs to users of the system. On the other hand, if the level were too low, some Offices would not have confidence in the work performed by other Offices, which would also damage user confidence. Benchmarking exercises could be used as one way of determining the standard. A possible starting point could be to include quality standards for search and examination in the PCT guidelines for international search and international preliminary examination.

61. The Delegation of the United States of America stated that, while it fully supported the proposal submitted by the United Kingdom to add a quality framework to the PCT system, it had a concern about the proposed role for WIPO in taking “an overview” (as outlined in document PCT/A/31/8, paragraph 9). The Delegation believed that the matter should be discussed in the context of the revision of the PCT guidelines on international search and international preliminary examination, and that the discussion should preferably be undertaken by PCT/MIA.

62. The Delegation of Japan expressed its satisfaction with the progress and the results achieved so far in reforming the PCT system. Noting the great importance of high quality international search and international preliminary examination reports, the Delegation stated that it fully supported the proposal by the United Kingdom, which should be further discussed within the context of PCT reform by either the Committee or the Working Group on Reform of the PCT.

63. The Delegation of the Netherlands wholeheartedly endorsed the proposal of the United Kingdom to develop a program for sustained quality and efficiency. The Delegation agreed with the proposal that quality standards for search and examination should be set out for Offices that wished to be appointed as International Searching and Preliminary Examining Authorities. The Delegation noted that a quality system based on the notion that “the higher the standard, the lower the number of applications for patent protection that will be granted protection” would effectively reduce the workload of Offices in an economic way. The Delegation expressed the view that, from a third party perspective, exclusive rights for a period of 20 years should not be earned too easily.

64. The Delegation believed that the International Bureau might be the most appropriate body to be responsible for the management of a quality control system, setting detailed criteria (to be agreed upon by the Assembly) and forming a group of experts of senior examiners from International Authorities to act as a “watch-dog” in terms of quality control.

65. The Assembly decided to refer the proposal for development of a common quality framework for further discussion by the Working Group on Reform of the PCT.

PCT-SAFE Project Status Report

66. Discussions were based on document PCT/A/31/4 Rev.

67. In introducing the document, the International Bureau provided the Assembly with a brief update on the status of the project.

68. The Delegation of the United States of America stated that it was encouraged with the progress on the PCT-SAFE project and supported continued efforts. The Delegation also expressed its desire for the International Bureau to bring into line Part 7 (relating to electronic filing and processing of international applications) and Part 8 (relating to international applications containing large nucleotide and/or amino acid sequence listings) of the Administrative Instructions under the PCT.

69. The Delegation of Cuba thanked the International Bureau for the progress made on this project, and noted the positive experience, since 2000, of applicants filing international applications with the Cuban Office, using the PCT-EASY software. The Delegation also noted that access to technology was very important for developing countries and that the different levels of technological development among developing countries had to be taken into account. The Delegation expressed the wish that the International Bureau would make Public Key Infrastructure (PKI) technology available to developing countries via the WIPONET services, considering the high cost of that technology.

70. The Assembly took note of the status report on the PCT-SAFE Project contained in document PCT/A/31/4 Rev.

IMPACT Project Status Report

71. Discussions were based on document PCT/A/31/7.

72. In introducing the document, the International Bureau provided the Assembly with a brief update on the status of the project.

73. The Assembly took note of the status report on the IMPACT Project contained in document PCT/A/31/7.

PCT minimum documentation

74. Discussions were based on documents PCT/CTC/20/4 and 5.

75. The Assembly took note of the contents of document PCT/CTC/20/4 and of the unanimous recommendation of the PCT/CTC, made at its twentieth session held from September 23 to October 1, 2002 (see document PCT/CTC/20/5, paragraph 10), and requested the Meeting of International Authorities under the PCT (PCT/MIA) to undertake the study proposed in that document and to make recommendations to the PCT/CTC on proposed modifications of Rule 34 and proposed mechanisms for reviewing and maintaining the non-patent literature part of the PCT minimum documentation.

76. The Delegation of Malaysia noted that the PCT had indeed eased the filing of patent applications throughout the world and that member countries were beginning to reap the benefits of the PCT system. The PCT reduced the cost of filing and thus encouraged patent owners to seek protection in more countries. In realizing the importance of providing wider protection for national industries in a globalized world, the Delegation wished to inform the Assembly that Malaysia was making final preparations for accession to the PCT and hoped to become a member of the PCT Union at the earliest possible time. It, however, emphasized that it was seeking WIPO's assistance towards making the accession of Malaysia to the PCT a success.

77. The Delegation of the Republic of Moldova thanked the International Bureau for the detailed analysis of the current state of patent-related matters, contained in the document provided, and also for devising a new overview based on principles for the future of the international patent system. The Republic of Moldova supported the initiatives proposed by WIPO, which would be implemented at the same time as substantive patent law was harmonized and together with the reform of the PCT. In order for work in this field to be more effective, the Delegation was of the view that it was essential to take steps, as a matter of priority, to implement the program. The Delegation further stated that the Republic of Moldova would support and participate in all the events held by WIPO for this purpose. In addition, the Delegation drew attention to the ongoing need for retraining of the staff of national offices, since, without good technical staff, the project to enhance the international patent system could not be carried out. This matter could be addressed within the framework of the WIPO Worldwide Academy, the European Patent Office (EPO), the Eurasian Patent Office (EAPO) and other regional patent offices.

78. Following the announcement by the Director General that Mr. Gary Smith, Senior Director of the Office of the PCT, would be leaving WIPO in October, the Assembly and the Chair expressed their thanks and best wishes to Mr. Smith.

[Annex I follows]

ANNEX I

AGREEMENT
BETWEEN THE CANADIAN COMMISSIONER OF PATENTS
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to
the functioning of the Canadian Commissioner of Patents
as an International Searching Authority
and International Preliminary Examining Authority
Under the Patent Cooperation Treaty

Preamble

The Canadian Commissioner of Patents and the International Bureau of the World Intellectual Property Organization,

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Canadian Commissioner of Patents;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

- (2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

- (1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided

under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, and, where applicable, that the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4 *Subject Matter Not Required to Be Searched or Examined*

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5 *Fees and Charges*

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its function as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is prepared to start functioning as an International Searching Authority and as an International Preliminary Examining Authority.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the Canadian Commissioner of Patents gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the Canadian Commissioner of Patents written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at Geneva, this [...] day of [...], in two originals in the English and French languages, each text being equally authentic.

For the Canadian Commissioner of Patents:
by:

For the International Bureau:
by:

(signature)
David Tobin
Canadian Commissioner of Patents

(signature)
Kamil Idris
Director General
World Intellectual Property Organization

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

(i) the following States:

Canada, and the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations;

(ii) the following languages:

English, French.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter which is searched or examined under the Canadian patent grant procedure.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Canadian dollars)</i>
Search fee (Rule 16.1(a))	[...]
Additional fee (Rule 40.2(a))	[...]
Preliminary examination fee (Rule 58.1(b))	[...]
Additional fee (Rule 68.3(a))	[...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1)	[...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, [*percentages under consideration*] of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

English, French.

[Annex II follows]

ANNEX II

AMENDED AGREEMENT
BETWEEN THE JAPAN PATENT OFFICE
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to
the functioning of the Japan Patent Office
as an International Searching Authority and
International Preliminary Examining Authority
Under the Patent Cooperation Treaty

Preamble

The Japan Patent Office and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of October 1, 1997, under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty in relation to the functioning of the Japan Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty was concluded for a period of 10 years from January 1, 1998, to December 31, 2007,

Desirous to continue the functioning of the Japan Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty,

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Japan Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it

considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement, as amended, shall enter into force upon approval by the Assembly of the International Patent Cooperation Union and subsequent signature.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at Geneva, this _____, in two originals in the English and Japanese languages, each text being equally authentic.

For the Japan Patent Office by:

For the International Bureau by:

(signature)
(name)
(function)
Japan Patent Office

(signature)
Kamil Idris
Director General
World Intellectual Property Organization

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

(i) the following States, so far as Article 3(1) is concerned:

Japan and any State that the Authority will specify;

(ii) the following States, so far as Article 3(2) is concerned:

where the Authority has prepared the international search report, Japan and any State the Authority will specify;

(iii) the following languages:

Japanese, English.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in Japanese national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Japanese yen)</i>
Search fee (Rule 16.1(a))	72,000
Additional fee (Rule 40.2(a))	63,000
Preliminary examination fee (Rule 58.1(b))	28,000
Additional fee (Rule 68.3(a))	18,000
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1), per document	1,400

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the Authority benefits from an earlier search to a considerable extent, the amount of 29,000 Japanese yen shall be refunded, upon request.

(3) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(4) As long as the refund of the search fee (in the case where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search) and the refund of the preliminary examination fee (in the case where the international application or the demand is withdrawn before the start of the international preliminary examination) continue not to be compatible with the national law applicable to the Authority, the Authority may abstain from refunding those fees.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Japanese, English.

[Annex III follows]

ANNEX III

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON OCTOBER 17, 2002¹*(fee reduction where international application filed in electronic form)*SCHEDULE OF FEES²

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(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 5 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
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The 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:

- (a) on paper together with a copy thereof in electronic form; or
- (b) in electronic form.

5. All fees payable (where applicable, as reduced under item 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.

[Annex IV follows]

¹ See Annex VI for details concerning entry into force and transitional arrangements.

² See Annex V for further amendments entering into force on January 1, 2004.

ANNEX IV

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON JANUARY 1, 2003¹

*(language of the international application;
missed time limit for entering the national phase)*

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¹ See Annex VI for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the Regulations.

Rule 12³
Language of the International Application and Translation
for the Purposes of International Search and International Publication

12.1 *Languages Accepted for the Filing of International Applications*

(a) and (b) [No change]

(c) Notwithstanding paragraph (a), the request shall be filed in any language of publication which the receiving Office accepts for the purposes of this paragraph.

(d) [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) 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;

(ii) [No change]

(c) [No change]

12.3 *Translation for the Purposes of International Search*

(a) to (d) [No change]

(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 referred to in item 1(a) of the Schedule of Fees.

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 any language of publication which the receiving Office accepts for the purposes of this paragraph.

(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

³ See Annex V for further amendments entering into force on January 1, 2004.

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. Any translation received by the receiving Office before that Office sends the invitation under the previous sentence shall be considered to have been received before the expiration of the time limit under paragraph (a).

(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.

(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 referred to in item 1(a) of the Schedule of Fees.

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.

22.2 *[Remains deleted]*

22.3 [No change]

Rule 26⁴

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]

⁴ See Annex V for further amendments entering into force on January 1, 2004.

(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.

26.3*bis* to 26.6 [No change]

Rule 29⁵
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) 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:

(i) to (iv) [No change]

(b) [No change]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 48⁶
International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) [No change]

(b) 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.⁷

(c) [No change]

48.4 to 48.6 [No change]

⁵ See Annex V for further amendments entering into force on January 1, 2004.

⁶ See Annex V for further amendments entering into force on January 1, 2004.

⁷ Paragraph (b) is deleted and paragraph (a-*bis*) is renumbered as paragraph (b).

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, and subject to paragraphs (b) to (e) 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.

(b) The request under paragraph (a) shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first:

- (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;

provided that the applicant may submit the request at any later time if so permitted by the national law applicable by the designated Office.

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

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

(e) 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.

(f) If, on October 1, 2002, paragraphs (a) to (e) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that designated Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by January 1, 2003. The information received shall be promptly published by the International Bureau in the Gazette.

[Annex V follows]

ANNEX V

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON JANUARY 1, 2004^{1, 2}

(*enhanced international search and preliminary examination system;
concept and operation of the designation system;
availability of priority documents from digital library*)

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¹ The amended provisions appearing in this Annex incorporate the amendments set out in Annex III (Schedule of Fees) and Annex IV (see Rules 12, 26, 29 and 48).

² See Annex VI for details concerning entry into force and transitional arrangements.

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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) 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) a reference to a parent application or parent patent,

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

(c) and (d) [No change]

4.2 to 4.4 [No change]

4.5 *The Applicant*

(a) The request shall indicate:

(i) the name,

(ii) the address, and

(iii) the nationality and residence

of the applicant or, if there are several applicants, of each of them.

(b) to (e) [No change]

4.6 to 4.8 [No change]

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

(a) The filing of a request shall constitute:

(i) the designation of all Contracting States that are bound by the Treaty on the international filing date;

(ii) an indication that the international application is, in respect of each designated State to which Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State;

(iii) an indication that the international application is, in respect of each designated State to which Article 45(1) applies, for the grant of a regional patent and also, unless Article 45(2) applies, a national patent.

(b) Notwithstanding paragraph (a)(i), if, on October 1, 2002, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request may, for as long as that national law continues to so provide, contain an indication that the designation of that State is not made, provided that the designated Office informs the International Bureau by January 1, 2003, that this paragraph shall apply in respect of designations of that State. The information received shall be promptly published by the International Bureau in the Gazette.

(c) *[Deleted]*

4.10 [No change]

4.11 *Reference to Earlier Search, Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

- (i) an international or international-type search has been requested on an application under Article 15(5);
- (ii) the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application;
- (iii) the applicant intends to make an indication under Rule 49*bis*.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
- (iv) the applicant intends to make an indication under Rule 49*bis*.1(c) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or indicate the relevant parent application or parent patent or other parent grant.

(b) The inclusion in the request of an indication under paragraph (a)(iii) or (iv) shall have no effect on the operation of Rule 4.9.

4.12 *[Deleted]*

4.13 *[Deleted]*

4.14 *[Deleted]*

4.14*bis* to 4.18 [No change]

Rule 12

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

12.1 and 12.2 [No change]

12.3 *Translation for the Purposes of International Search*

(a) to (d) [No change]

(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 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

12.4 *Translation for the Purposes of International Publication*

(a) to (d) [No change]

(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 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

Rule 15

The International Filing Fee

15.1 *The International Filing 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.

15.2 *Amount*

(a) The amount of the international filing fee is as set out in the Schedule of Fees.

(b) The international filing 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 shall be freely convertible into Swiss currency. The amount of the international filing fee shall be established, for each receiving Office which prescribes the payment of that fee 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 amount so established shall be the equivalent, in round figures, of the amount in Swiss currency set out in the Schedule of Fees. It 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 of the international filing fee set out in the Schedule of Fees is changed, the corresponding amount in the prescribed currencies shall be applied from the same date as the amount 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 amount in the prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after the date of its 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 amount shall become applicable from that date.

15.3 *[Remains deleted]*

15.4 *Time Limit for Payment; Amount Payable*

The international filing 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.

15.5 *[Deleted]*

15.6 *Refund*

The receiving Office shall refund the international filing fee to the applicant:

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

Rule 16 The Search Fee

16.1 *Right to Ask for a Fee*

(a) to (e) *[No change]*

(f) As to the time limit for payment of the search fee and the amount payable, the provisions of Rule 15.4 relating to the international filing fee shall apply *mutatis mutandis*.

16.2 and 16.3 *[No change]*

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 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 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 16*bis*.2, within a time limit of one month from the date of the invitation.

(b) *[Deleted]*

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) 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 16*bis*.2, the receiving Office shall, subject to paragraph (d):

(i) make the applicable declaration under Article 14(3), and⁴

(ii) proceed as provided in Rule 29.⁴

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

16bis.2 Late Payment Fee

(a) The payment of fees in response to an invitation under Rule 16*bis*.1(a) 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 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

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

⁴ Item (i) is deleted and items (ii) and (iii) are renumbered as items (i) and (ii).

Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) [No change]

(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, as the case may be, 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.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office 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.

(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.

17.2 [No change]

Rule 19 **The Competent Receiving Office**

19.1 to 19.3 [No change]

19.4 *Transmittal to the International Bureau as Receiving Office*

(a) and (b) [No change]

(c) For the purposes of Rules 14.1(c), 15.4 and 16.1(f), where the international application was transmitted to the International Bureau under paragraph (b), the date of receipt of the international application shall be considered to be the date on which the international application was actually received by the International Bureau. For the purposes of this paragraph, the last sentence of paragraph (b) shall not apply.

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 designated Offices and, in the case of a designated Office which is responsible for granting regional patents, of the Contracting States designated for such regional patent.

(b) *[Deleted]*

(c) [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]

26.2bis Checking of Requirements Under Article 14(1)(a)(i) and (ii)

(a) For the purposes of Article 14(1)(a)(i), if there is more than one applicant, it shall be sufficient that the request be signed by one of them.

(b) For the purposes of Article 14(1)(a)(ii), if there is more than one applicant, it shall be sufficient that the indications required under Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who is entitled according to Rule 19.1 to file the international application with the receiving Office.

26.3 to 26.6 [No change]

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 international filing fee (Rule 15.1), 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 international filing fee (Rule 15.1) and, where required, the late payment fee (Rule 16*bis*.2).

Rule 29
International Applications Considered Withdrawn

29.1 *Finding by Receiving Office*

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) 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:

(i) to (iv) [No change]

(b) [*Deleted*]

29.2 [*Remains deleted*]

29.3 and 29.4 [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 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.

(b) [No change]

(c) Information on 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 in the Gazette.

(d) [*Deleted*]

32.2 *Effects of Extension to Successor State*

(a) Where the effects of the international application are extended to the successor State in accordance with Rule 32.1,

(i) [No change]

(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 months from the date of the publication of the information under Rule 32.1(c).

(b) The successor State may fix a time limit which expires later than that provided in paragraph (a)(ii). The International Bureau shall publish information on such time limits in the Gazette.⁵

Rule 36 **Minimum Requirements for International Searching Authorities**

36.1 Definition of Minimum Requirements

The minimum requirements referred to in Article 16(3)(c) shall be the following:

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

Rule 43bis **Written Opinion of the International Searching Authority**

43bis.1 Written Opinion

(a) Subject to Rule 69.1(b-bis), the International Searching Authority shall, at the same time as it establishes the international search report, establish a written 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.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.2(a), (b) and (e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

(c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under Rule 66.1bis(a) but subject to Rule 66.1bis(b), be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a), in which case the applicant is invited to submit to that Authority, before the expiration of the time limit under Rule 54bis.1(a), a written reply together, where appropriate, with amendments.

⁵ Paragraph (b) is deleted and paragraph (c) is renumbered as paragraph (b).

Rule 44
Transmittal of the International Search Report, Written Opinion, Etc.

44.1 Copies of Report or Declaration and Written Opinion

The International Searching Authority shall, on the same day, transmit one copy of the international search report and the written opinion established under Rule 43*bis*.1, or of the declaration referred to in Article 17(2)(a), to the International Bureau and one copy to the applicant.

44.2 and 44.3 [No change]

Rule 44*bis*
**International Preliminary Report on Patentability by
the International Searching Authority**

44bis.1 Issuance of Report

(a) Unless an international preliminary examination report has been or is to be established, the International Bureau shall issue a report on behalf of the International Searching Authority (in this Rule referred to as “the report”) as to the matters referred to in Rule 43*bis*.1(a). The report shall have the same contents as the written opinion established under Rule 43*bis*.1.

(b) The report shall bear the title “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” together with an indication that it is issued under this Rule by the International Bureau on behalf of the International Searching Authority.

44bis.2 Communication to Designated Offices

(a) Where a report has been issued under Rule 44*bis*.1, the International Bureau shall communicate it to each designated Office in accordance with Rule 93*bis*.1 but not before the expiration of 30 months from the priority date.

(b) Where the applicant makes an express request to a designated Office under Article 23(2), the International Bureau shall communicate a copy of the written opinion established by the International Searching Authority under Rule 43*bis*.1 to that Office promptly upon the request of that Office or of the applicant.

44bis.3 Translation for Designated Offices

(a) Any designated State may, where a report has been issued under Rule 44*bis*.1 in a language other than the official language, or one of the official languages, of its national Office, require a translation of the report into English. Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

(b) If a translation is required under paragraph (a), it shall be prepared by or under the responsibility of the International Bureau.

(c) The International Bureau shall transmit a copy of the translation to any interested designated Office and to the applicant at the same time as it communicates the report to that Office.

(d) In the case referred to in Rule 44*bis*.2(b), the written opinion established under Rule 43*bis*.1 shall, upon request of the designated Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the designated Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

44bis.4 Observations on the Translation

The applicant may make written observations as to the correctness of the translation referred to in Rule 44*bis*.3(b) or (d) and shall send a copy of the observations to each of the interested designated Offices and to the International Bureau.

Rule 44*ter* **Confidential Nature of Written Opinion, Report, Translation and Observations**

44ter.1 Confidential Nature

(a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:

(i) to the written opinion established under Rule 43*bis*.1, to any translation thereof prepared under Rule 44*bis*.3(d) or to any written observations on such translation sent by the applicant under Rule 44*bis*.4;

(ii) if a report is issued under Rule 44*bis*.1, to that report, to any translation of it prepared under Rule 44*bis*.3(b) or to any written observations on that translation sent by the applicant under Rule 44*bis*.4.

(b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.

Rule 47 **Communication to Designated Offices**

47.1 Procedure

(a) The communication provided for in Article 20 shall be effected by the International Bureau to each designated Office in accordance with Rule 93*bis*.1 but, subject to Rule 47.4, not prior to the international publication of the international application.

(a-*bis*) The International Bureau shall notify each designated Office, in accordance with Rule 93*bis*.1, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document.

(a-*ter*) [No change]

(b) Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication provided for in Article 20 shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

(c) The International Bureau shall, promptly after the expiration of 28 months from the priority date, send a notice to the applicant indicating:

(i) the designated Offices which have requested that the communication provided for in Article 20 be effected under Rule 93*bis*.1 and the date of such communication to those Offices; and

(ii) the designated Offices which have not requested that the communication provided for in Article 20 be effected under Rule 93*bis*.1.

(c-*bis*) The notice referred to in paragraph (c) shall be accepted by designated Offices:

(i) in the case of a designated Office referred to in paragraph (c)(i), as conclusive evidence that the communication provided for in Article 20 was effected on the date specified in the notice;

(ii) in the case of a designated Office referred to in paragraph (c)(ii), as conclusive evidence that the Contracting State for which that Office acts as designated Office does not require the furnishing, under Article 22, by the applicant of a copy of the international application.

(d) [No change]

(e) Where any designated Office has not, before the expiration of 28 months from the priority date, requested the International Bureau to effect the communication provided for in Article 20 in accordance with Rule 93*bis*.1, the Contracting State for which that Office acts as designated Office shall be considered to have notified the International Bureau, under Rule 49.1(a-*bis*), that it does not require the furnishing, under Article 22, by the applicant of a copy of the international application.

47.2 *Copies*

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*]

(c) [*Deleted*]

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, the

International Bureau shall, upon request of the applicant or the designated Office, promptly effect the communication provided for in Article 20 to that Office.

Rule 48
International Publication

48.1 to 48.5 [No change]

48.6 *Announcing of Certain Facts*

(a) If any notification under Rule 29.1(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.

(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 a 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, when performing the acts referred to in Article 22, shall so indicate to the designated Office.

(b) If the applicant wishes the international application to be treated, in a 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, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall 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 a designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition, the applicant, when performing the acts referred to in Article 22, shall indicate the relevant parent application, parent patent or other parent grant.

(d) If the applicant wishes the international application to be treated, in a designated State, as an application for a continuation or a continuation-in-part of an earlier application, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall indicate the relevant parent application.

(e) Where no express indication under paragraph (a) is made by the applicant when performing the acts referred to in Article 22 but the national fee referred to in Article 22 paid by the applicant corresponds to the national fee for a particular kind of protection, the payment of that fee shall be considered to be an indication of the wish of the applicant that the international application is to be treated as an application for that kind of protection and the designated Office shall inform the applicant accordingly.

49bis.2 Time of Furnishing Indications

(a) No designated Office shall require the applicant to furnish, before performing the acts referred to in Article 22, any indication referred to in Rule 49bis.1 or, where applicable, any indication as to whether the applicant seeks the grant of a national patent or a regional patent.

(b) The applicant may, if so permitted by the national law applicable by the designated Office concerned, furnish such indication or, if applicable, convert from one kind of protection to another, at any later time.

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 Rule 20.7(i), 24.2(c) or 29.1(ii).

51.2 and 51.3 [No change]

Rule 51bis
Certain National Requirements Allowed Under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iv) [No change]

(v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time;

(vi) the confirmation of the international application by the signature of any applicant for the designated State who has not signed the request;

(vii) any missing indication required under Rule 4.5(a)(ii) and (iii) in respect of any applicant for the designated State.

(b) to (f) [No change]

51bis.2 and 51bis.3 [No change]

Rule 52
**Amendment of the Claims, the Description, and the Drawings,
Before Designated Offices**

52.1 Time Limit

(a) In any designated State in which processing or examination starts without special request, the applicant shall, if he so wishes, exercise the right under Article 28 within one

month from the fulfillment of the requirements under Article 22, provided that, if the communication under Rule 47.1 has not been effected by the expiration of the time limit applicable under Article 22, 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 later time if so permitted by the national law of the said State.

(b) [No change]

Rule 53 **The Demand**

53.1 to 53.3 [No change]

53.4 The Applicant

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*.

53.5 and 53.6 [No change]

53.7 Election of States

The filing of a demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty.

53.8 and 53.9 [No change]

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 whichever of the following periods expires later:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a); or

(ii) 22 months from the priority date.

(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.

Rule 56 *[Deleted]*

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 handling fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later.

(b) Subject to paragraph (c), 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 22 months from the priority date, whichever expires later.

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

(d) The amount of the handling fee payable shall be the amount applicable on the date of payment.

57.4 and 57.5 [Remain deleted]

57.6 Refund

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

- (i) [No change]
- (ii) if the demand is considered, under Rule 54.4 or 54bis.1(b), not to have been submitted.

Rule 58bis
Extension of Time Limits for Payment of Fees

58bis.1 Invitation by the International Preliminary Examining Authority

- (a) Where the International Preliminary Examining Authority finds:
 - (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), that 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.

- (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 the 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 54*bis*.1(a) or 15 days from the date of the invitation, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

(d) to (f) [No change]

Rule 60
Certain Defects in the Demand

60.1 *Defects in the Demand*

(a) Subject to paragraphs (a-*bis*) and (a-*ter*), 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 53.8 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.

(a-*bis*) For the purposes of Rule 53.4, if there are two or more applicants, it shall be sufficient that the indications referred to in Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who has the right according to Rule 54.2 to make a demand.

(a-*ter*) For the purposes of Rule 53.8, if there are two or more applicants, it shall be sufficient that the demand be signed by one of them.

(b) to (g) [No change]

60.2 *[Deleted]*

Rule 61
Notification of the Demand and Elections

61.1 *Notification to the International Bureau and the Applicant*

(a) and (b) [No change]

(c) *[Deleted]*

61.2 *Notification to the Elected Offices*

(a) [No change]

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed) and the date of receipt by the International Preliminary Examining Authority of the demand.

(c) [No change]

(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, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect the communication provided for in Article 20 to that Office.

61.3 [No change]

61.4 *Publication in the Gazette*

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.

Rule 62

Copy of the Written Opinion by the International Searching Authority and of Amendments Under Article 19 for the International Preliminary Examining Authority

62.1 *Copy of Written Opinion by International Searching Authority and of Amendments Made Before the Demand Is Filed*

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

(i) a copy of the written opinion established under Rule 43*bis*.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and

(ii) a copy of any amendment under Article 19, and any statement referred to in that Article, unless that Authority has indicated that it has already received such a copy.

62.2 [No change]

Rule 62*bis*

Translation for the International Preliminary Examining Authority of the Written Opinion of the International Searching Authority

62*bis*.1 *Translation and Observations*

(a) Upon request of the International Preliminary Examining Authority, the written opinion established under Rule 43*bis*.1 shall, when not in English or in a language accepted

by that Authority, be translated into English by or under the responsibility of the International Bureau.

(b) The International Bureau shall transmit a copy of the translation to the International Preliminary Examining Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

(c) The applicant may make written observations as to the correctness of the translation and shall send a copy of the observations to the International Preliminary Examining Authority and to the International Bureau.

Rule 63
Minimum Requirements for
International Preliminary Examining Authorities

63.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 32(3) shall be the following:

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must hold an appointment as an International Searching Authority.

Rule 66
Procedure Before the International Preliminary Examining Authority

66.1 [No change]

66.1*bis* *Written Opinion of the International Searching Authority*

(a) Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43*bis*.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

(b) An International Preliminary Examining Authority may notify the International Bureau that paragraph (a) shall not apply to the procedure before it in respect of written opinions established under Rule 43*bis*.1 by the International Searching Authority or Authorities specified in the notification, provided that such a notification shall not apply to cases where the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority. The International Bureau shall promptly publish any such notification in the Gazette.

(c) Where the written opinion established by the International Searching Authority under Rule 43*bis*.1 is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of

Rule 66.2(a), the International Preliminary Examining Authority shall notify the applicant accordingly in writing.

(d) A written opinion established by the International Searching Authority under Rule 43*bis*.1 which is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a) shall nevertheless be taken into account by the International Preliminary Examining Authority in proceeding under Rule 66.2(a).

66.2 Written Opinion of the International Preliminary Examining Authority

(a) to (c) [No change]

(d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall, subject to paragraph (e), not be more than three months after the said date.

(e) The time limit for replying to the notification may be extended if the applicant so requests before its expiration.

66.3 to 66.6 [No change]

66.7 Copy and Translation of Earlier Application Whose Priority is Claimed

(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.

(b) [No change]

66.8 and 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:

(i) the demand;

- (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58*bis*.2; and
- (iii) either the international search report and the written opinion established under Rule 43*bis*.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established;

provided that the International Preliminary Examining Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54*bis*.1(a) unless the applicant expressly requests an earlier start.

(b) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes and subject to paragraphs (d) and (e), start at the same time as the international search.

(b-*bis*) Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization need not, in its capacity as International Searching Authority, establish a written opinion under Rule 43*bis*.1.

(c) [No change]

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:

- (i) it has received a copy of any amendments made under Article 19;
- (ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19; or
- (iii) the expiration of the applicable time limit under Rule 54*bis*.1(a).

(e) [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

- (i) 28 months from the priority date; or
- (ii) six months from the time provided under Rule 69.1 for the start of the international preliminary examination; or

(iii) six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2.

Rule 70
International Preliminary Report on Patentability by
the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 to 70.14 [No change]

70.15 *Form; Title*

(a) The physical requirements as to the form of the report shall be prescribed by the Administrative Instructions.

(b) The report shall bear the title “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)” together with an indication that it is the international preliminary examination report established by the International Preliminary Examining Authority.

70.16 and 70.17 [No change]

Rule 72
Translation of the International Preliminary Examination Report and of the Written
Opinion of the International Searching Authority

72.1 and 72.2 [No change]

72.2bis *Translation of the Written Opinion of the International Searching Authority*
Established Under Rule 43bis.1

In the case referred to in Rule 73.2(b)(ii), the written opinion established by the International Searching Authority under Rule 43bis.1 shall, upon request of the elected Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the elected Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

72.3 *Observations on the Translation*

The applicant may make written observations as to the correctness of the translation of the international preliminary examination report or of the written opinion established by the International Searching Authority under Rule 43bis.1 and shall send a copy of the observations to each of the interested elected Offices and to the International Bureau.

Rule 73
Communication of the International Preliminary Examination Report
or the Written Opinion of the International Searching Authority

73.1 [No change]

73.2 *Communication to Elected Offices*

(a) The International Bureau shall effect the communication provided for in Article 36(3)(a) to each elected Office in accordance with Rule 93*bis*.1 but not before the expiration of 30 months from the priority date.

(b) Where the applicant makes an express request to an elected Office under Article 40(2), the International Bureau shall, upon the request of that Office or of the applicant,

(i) if the international preliminary examination report has already been transmitted to the International Bureau under Rule 71.1, promptly effect the communication provided for in Article 36(3)(a) to that Office;

(ii) if the international preliminary examination report has not been transmitted to the International Bureau under Rule 71.1, promptly communicate a copy of the written opinion established by the International Searching Authority under Rule 43*bis*.1 to that Office.

(c) Where the applicant has withdrawn the demand or any or all elections, the communication provided for in paragraph (a) shall nevertheless be effected, if the International Bureau has received the international preliminary examination report, to the elected Office or Offices affected by the withdrawal.

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, 49, 49bis and 51bis*

Rules 22.1(g), 47.1, 49, 49*bis* and 51*bis* shall apply, provided that:

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

(iv) for the purposes of Article 39(1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report;

(v) the reference in Rule 47.1(a) to Rule 47.4 shall be construed as a reference to Rule 61.2(d).

76.6 *[Deleted]*

Rule 78
**Amendment of the Claims, the Description, and the Drawings,
Before Elected Offices**

78.1 *Time Limit*

(a) 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 later 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 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).

78.2 *[Deleted]*

78.3 *[No change]*

Rule 89bis
**Filing, Processing and Communication of International Applications and Other
Documents in Electronic Form or by Electronic Means**

89bis.1 and 89bis.2 *[No change]*

89bis.3 *Communication Between Offices*

Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, notification, communication, correspondence or other document by one national Office or intergovernmental organization to another, such communication may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

Rule 90
Agents and Common Representatives

90.1 *[No change]*

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 and in respect of whom all indications required under Rule 4.5(a) have been provided may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office and in respect of whom all indications required under Rule 4.5(a) have been provided shall be considered to be the common representative of all the applicants.

90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) to (c) [No change]

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

(e) Where the agent or the common representative submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4, the requirement under paragraph (b) for a separate power of attorney shall not be waived under paragraph (d).

90.5 and 90.6 [No change]

Rule 90*bis* Withdrawals

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

90*bis*.5 *Signature*

(a) Any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 shall, subject to paragraph (b), be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, subject to paragraph (b), not be entitled to sign such a notice on behalf of the other 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 90*bis*.1 to 90*bis*.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

(i) and (ii) [No change]

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

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

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.

Rule 93bis
Manner of Communication of Documents

93bis.1 Communication on Request; Communication via Digital Library

(a) Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, notification, communication, correspondence or other document (“document”) by the International Bureau to any designated or elected Office, such communication shall be effected only upon request by the Office concerned and at the time specified by that Office. Such request may be made in relation to individually specified documents or a specified class or classes of documents.

(b) A communication under paragraph (a) shall, where so agreed by the International Bureau and the designated or elected Office concerned, be considered to be effected at the time when the International Bureau makes the document available to that Office in electronic form in a digital library, in accordance with the Administrative Instructions, from which that Office is entitled to retrieve that document.

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 44*ter*.1, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(c) The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph (b) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.

94.2 and 94.3 [No change]

SCHEDULE OF FEES⁶

Fees	Amounts
1. International Filing Fee: (Rule 15.2)	650 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling Fee: (Rule 57.2)	233 Swiss francs

Reductions

3. The international filing fee 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:

- (a) on paper together with a copy thereof in electronic form; or
- (b) in electronic form.

4. All fees payable (where applicable, as reduced under item 3) 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.

[Annex VI follows]

⁶ The fee structure and the amounts of the fees are subject to further consideration; see paragraph 50 of this report.

ANNEX VI

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

1. The amendments set out in Annex III shall enter into force on October 17, 2002, and shall apply to any international application whose date of receipt is on or after October 17, 2002.
2. The amendments set out in Annex IV:
 - (a) shall enter into force on January 1, 2003, and shall apply to any international application whose international filing date is on or after January 1, 2003;
 - (b) shall not apply to any international application whose international filing date is before January 1, 2003, provided that:
 - (i) new Rule 49.6(a) to (e) shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 22 expires on or after January 1, 2003;
 - (ii) to the extent that new Rule 49.6(a) to (e) is applicable by virtue of Rule 76.5, the latter Rule shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 39(1) expires on or after January 1, 2003;
 - (iii) where a designated Office informs the International Bureau under paragraph (f) of Rule 49.6 that paragraphs (a) to (e) of that Rule are not compatible with the national law applied by that Office, items (i) and (ii) of this paragraph shall apply in respect of that Office except that each reference in those items to the date January 1, 2003, shall be read as a reference to the date of entry into force of Rule 49.6(a) to (e) in respect of that Office.
3. The amendments set out in Annex V:
 - (a) shall enter into force on January 1, 2004, and shall apply to any international application whose international filing date is on or after January 1, 2004, provided that:
 - (i) Rule 15.4 and the Schedule of Fees as worded before their amendment shall continue to apply to any international application which is received by the receiving Office before January 1, 2004, and is accorded an international filing date that is on or after January 1, 2004;
 - (ii) Rule 47.1(c) and (e) as amended shall apply to any international application whose international filing date is on or after January 1, 2004, in respect of a designated Office which has made a notification under paragraph (2) of the decisions of the Assembly set out in Annex IV of document PCT/A/30/7, and which has not withdrawn that notification under paragraph (3) of those decisions, as though the reference in each of Rule 47.1(c) and (e) to "28 months" was a reference to "19 months," with the consequence that two notifications under Rule 47.1(c) shall, if applicable, be sent in respect of such an application;

(b) shall not apply to any international application whose international filing date is before January 1, 2004, provided that:

(i) Rules 53.4, 53.7, 60.1, 61.2 and 90*bis*.5(b) as amended, the Rules as amended that are referred to in those Rules and the deletion of Rules 56, 60.2 and 61.1(c) shall apply to any international application in respect of which a demand for international preliminary examination is filed on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004;

(ii) new Rule 94.1(c) shall apply to the furnishing on or after January 1, 2004, of copies of the international preliminary examination report in respect of any international application, whether the international filing date of the application is before, on or after January 1, 2004.

[End of Annex VI and of document]