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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**

**MATTERS CONCERNING THE PCT UNION
(REPORT OF THE COMMITTEE ON REFORM OF THE EPCT)**

Memorandum prepared by the International Bureau

INTRODUCTION

1. The Assembly of the International Patent Cooperation Union (PCT Union), at its 30th (13th ordinary) session held in Geneva from September 24 to October 3, 2001, considered the report of the first session of the Committee on Reform of the Patent Cooperation Treaty (PCT) ("the Committee") (document PCT/R/1/26).
2. The Committee agreed that reform of the PCT should be based on a number of general objectives (see document PCT/R/1/26, paragraph 66). In addition, the Committee agreed on recommendations to the Assembly concerning the establishment of a working group (see document PCT/R/1/26, paragraphs 67 and 68), and concerning the referral to the working group, for its consideration and advice, of a number of matters (see document PCT/R/1/26, paragraphs 60 to 75).

3. The Committee also agreed on recommendations to the Assembly concerning the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly (see document PCT/R/1/26, paragraph 205):

“The Committee agreed to recommend to the Assembly that between the September 2001 and September 2002 sessions of the PCT Assembly, there should be three meetings devoted to the reform of the PCT: two meetings of a working group that would report to this Committee, and the second session of the Committee itself. The working group should meet once before the end of 2001 and once in March or April 2002. The working group should consider the matters set out in paragraphs 69 to 75, above, in the light of the general objectives set out in paragraph 66, above, on the basis of drafts to be prepared by the International Bureau. The results of the work of the working group would be submitted to the second session of the Committee. The objective would be to have a first set of Rule changes adopted by the Assembly in September 2002, in coordination with the preparation of further changes, including changes to the Treaty itself. Further discussion, including discussion of longer-term proposals, would take place after September 2002.”

4. The Committee's report also contains a record of the general discussion (see document PCT/R/1/26, paragraphs 13 to 65), and a record of the discussions on certain matters that were not recommended to be referred to the working group but would be open for reconsideration at a future session of the Committee (see document PCT/R/1/26, paragraphs 68, last sentence, and 76 to 199).

5. The Assembly (see document PCT/A/30/7, paragraph 23):

“(i) took note of the report of the first session of the Committee on Reform of the PCT contained in document PCT/R/1/26, and

“(ii) unanimously approved the Committee's recommendations concerning the establishment of a working group, the matters to be referred to the working group, and the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly, as set out, respectively, in paragraphs 67 and 68, 69 to 75, and 205 of the Committee's report.”

6. Pursuant to the Assembly's decision, the Director General convened the first session of the Working Group on Reform of the PCT, which was held in Geneva from November 12 to 16, 2001, and the second session of the Working Group held in Geneva from April 29 to May 3, 2002. The proceedings at the Working Group's sessions were informal, and there were no formal reports. Summaries of the sessions were prepared by the Chair, taking into account comments made by delegations on the draft versions (see documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively).

7. The second session of the Committee was held in Geneva from July 1 to 5, 2002. At its second session, the Committee considered the results of the work of the Working Group and proposals prepared by the International Bureau under the following three general headings:

(i) improved coordination of international search and international preliminary examination and the time limit for entering the national phase: enhanced international search and preliminary examination system;

(ii) the concept and operation of the designations system: automatic indication of all designations possible under the PCT and related proposals concerning elections, the international filing fee and a "communication on request" system;

(iii) changes related to the Patent Law Treaty (PLT): language of the international application and translations, missed time limit for entering the national phase, and right of priority and priority claims.

8. The report adopted by the Committee at its second session (document PCT/R/2/9) is reproduced in the Annex to this document. In the report, the Committee:

(i) noted the result to date of the work of the Working Group as set out in document PCT/R/2/2 (reproducing document PCT/R/WG/2/12) (see the Committee's report at paragraph 12);

(ii) approved the proposed amendments of the Regulations referred to in its report at paragraphs 21, 54, 93, 101 and 112 with a view to their submission to the Assembly, subject to the comments and clarifications appearing in the report and to possible further drafting changes to be made by the International Bureau;

(iii) agreed to recommend to the Assembly that no change was needed to the Regulations having regard to the language-related filing date requirements of the PLT, recognizing that the PCT procedure was already, in practice, consistent with those requirements, as explained in document PCT/R/2/3, paragraphs 3 to 10 (see the Committee's report at paragraph 92);

(iv) agreed to recommend to the Assembly that the proposed amendments of certain Rules relating to the right of priority and priority claims should be revised by the International Bureau, taking into account the comments and concerns expressed at the Committee's session, and submitted to the Working Group, together with certain other proposed amendments relating to priority claims, for discussion at the next session of the Working Group (see the Committee's report at paragraph 125);

(v) agreed on recommendations to the Assembly concerning the entry into force of the proposed amendments of the Regulations and transitional arrangements (see the Committee's report at paragraphs 130 and 131);

(vi) agreed to recommend to the Assembly that two sessions of the Working Group should be convened between the September 2002 and September 2003 sessions of the Assembly to consider certain matters outlined in the Committee's report at paragraphs 135 and 136, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary (see the Committee's report at paragraph 140(i));

(vii) agreed to recommend to the Assembly that financial assistance allocated to enable certain delegations to attend the next session of the Committee should, exceptionally, also be made available for those sessions of the Working Group, subject to the availability of sufficient funds (see the Committee's report at paragraph 139(ii)).

9. Revised proposed amendments of the Regulations, as referred to in paragraph 8(ii), above, are set out in document PCT/A/31/6. Proposals concerning entry into force of the amendments and transitional arrangements, as referred to in paragraph 8(v), above, are set out in document PCT/A/31/6Add.1.

10. The Assembly is invited:

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

(ii) to approve the Committee's recommendations referred to in paragraph 8(iii) to (vii), above.

[Annex follows]

ANNEX

REPORT OF THE
SECOND SESSION OF THE COMMITTEE ON REFORM OF THE PCT
(reproduced from document PCT/R/2/9)

INTRODUCTION

1. The second session of the Committee on Reform of the Patent Cooperation Treaty (PCT) was held in Geneva from July 1 to 5, 2002.
2. The following members of the Committee were represented at the session: (i) the following member States of the International Patent Cooperation Union (PCT Union): Armenia, Australia, Austria, Barbados, Belarus, Belgium, Brazil, Burkina Faso, Canada, China, Costa Rica, Croatia, Czech Republic, Democratic People's Republic of Korea, Denmark, Ecuador, Finland, France, Germany, Greece, Hungary, Indonesia, Ireland, Italy, Japan, Kazakhstan, Kenya, Latvia, Lithuania, Mexico, Morocco, Netherlands, Norway, Philippines, Portugal, Republic of Korea, Romania, Russian Federation, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Tunisia, United Kingdom, United States of America, Viet Nam; (ii) the European Patent Office (EPO).
3. The following member States of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as observers: Egypt, Libyan Arab Jamahiriya, Mauritius, Nigeria.
4. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Industrial Property Organization (ARIPO), Eurasian Patent Organization (EAPO), European Commission (EC).
5. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), Centre for International Industrial Property Studies (CEIPI), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Federation of Inventors' Associations (IFIA), Union of European Practitioners in Industrial Property (UEPIP).
6. The following national non-governmental organizations were represented by observers: Brazilian Association of Industrial Property (ABPI), Brazilian Association of Industrial Property Agents (ABAPI), Hungarian Chamber of Patent Attorneys (HCPA), Intellectual Property Institute of Canada (IPIC), Japan Patent Attorneys Association (JPAA).
7. The list of participants is contained in the Annex to this report. *
8. The agenda is contained in document PCT/R/2/1.

* The list of participants is available as the Annex to document PCT/R/2/9.

OPENING OF THE SESSION

9. Mr. Francis Gurry (Assistant Director General, WIPO), on behalf of the Director General, opened the session and welcomed the participants.

ELECTION OF A CHAIR AND TWO VICE -CHAIRS

10. The session unanimously elected Mr. Jørgen Smith (Norway) as Chair and Mr. Yin Xintian (China) and Mr. László Bretz (Hungary) as Vice -Chairs.

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

11. Discussion was based on document PCT/R/2/2, reproducing the summary prepared by the Chair (document PCT/R/WG/2/12) of the second session of the Working Group on Reform of the Patent Cooperation Treaty (PCT) (“the Working Group”).

12. The Committee noted the results to date of the work of the Working Group on Reform of the Patent Cooperation Treaty (PCT) as set out in document PCT/R/2/2.

CONSIDERATION OF PROPOSALS FOR REFORM OF THE PCT

13. The Committee considered proposals prepared by the International Bureau, taking into account the results of the work of the Working Group, under the following three general headings:

(i) improved coordination of international search and international preliminary examination and the time limit for entering the national phase (see document PCT/R/2/7 containing proposals for an enhanced international search and preliminary examination system);

(ii) the concept and operation of the designations system (see document PCT/R/2/6 containing proposals for the automatic indication of all designations possible under the PCT and related proposals concerning elections, the international filing fee and a “communication on request” system);

(iii) changes related to the Patent Law Treaty (PLT) (see proposals in document PCT/R/2/3 concerning the language of the international application and translations, document PCT/R/2/4 concerning the time limit for entering the national phase, and document PCT/R/2/5 concerning the right of priority and priority claims).¹

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO’s Website at http://www.wipo.int/pct/en/access/legal_text.htm). Reference to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. Reference to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Website at http://www.wipo.int/eng/document/pt_dc/index.htm).

14. It was noted that comments submitted by certain non-governmental organizations had been erroneously issued by the International Bureau in the form of formal proposals in documents PCT/R/2/7 Add.1 and 8. The International Bureau clarified that, under the General Rules of Procedure of WIPO, proposals could only be submitted by members of the Committee.

15. The International Bureau informed the Committee that any substantially redrafted proposals which it appeared to be necessary to include in the documents to be submitted to the Assembly, in addition to those agreed by the Committee at its present session, would if possible be made available as preliminary drafts on the page relating to the session on WIPO's Website.² Delegations were invited to register on the electronic mailing list, and to submit comments via the electronic forum, accessible on that Webpage.

ENHANCED INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION SYSTEM

16. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/7.

17. The Delegation of the Netherlands stated that, although it supported the proposed system in principle, it was of the opinion that a greater distinction should be made between the procedures under Chapters I and II. That distinction should be reflected in the use of distinct names for the reports established under those Chapters.

18. The Delegations of Japan and the United States of America and the Representative of the EPO stated that they supported the proposed system as it would simplify and streamline procedures and provide a basis for the long-term reform of the PCT. In response to a suggestion by the Delegation of Japan, supported by the Representative of the EPO, that there may be a need to include transitional provisions in respect of pending applications and to provide time for the legal and operational implementation of the system, the International Bureau observed that it would be preferable if a date could be agreed upon, for example, January 1, 2004, that would enable all International Authorities to implement the system at the same time. The Representative of CEIP emphasized the desirability of having a single date of entry into force to avoid having different systems operating in different International Authorities.

19. The Delegation of the Republic of Korea emphasized the confidential nature of the international preliminary examination procedure and stated that, under the proposed new system, the confidentiality of the proposed written opinion of the International Searching Authority should be ensured so that a negative opinion was not published to the detriment of the applicant. In addition, a formal procedure should be provided for comments by the applicant.

20. The Delegation of Germany referred to the need to keep in mind the limitations imposed by the wording of the Treaty itself and suggested that different names may be needed for the reports established under Chapters I and II.

² See <http://www.wipo.int/pct/en/meetings>.

Proposed Amendments of the Regulations

21. The proposed amendments of the Regulations set out in the Annex to document PCT/R/2/7 were approved by the Committee with a view to their submission to the Assembly in September 2002, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Rules 36.1 and 63.1

22. The Delegation of the Netherlands suggested that the effect of proposed Rules 36.1 (iv) and 63.1 (iv) would be that it would no longer be possible for an International Authority to be appointed in each of those provisions required the other to have been previously complied with. After some discussion, the Committee agreed that the wording as proposed was acceptable on the understanding 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. The need for a change in the French text of the proposed Rules was noted.

Rule 43 bis.1

23. A suggestion by the Delegation of the Netherlands that, where the international search and international preliminary examination were carried out in a combined procedure under Rule 69.1 (b), the first written opinion should be issued by the International Preliminary Examining Authority rather than the International Searching Authority, was not taken up, particularly noting that the suggestion would result in no written opinion being established if the demand was withdrawn before the written opinion had been prepared.

24. It was agreed, on the suggestion of the Delegation of the Netherlands, that the words "with the demand or in any event" should be deleted from paragraph (c) since they were inconsistent with Rule 66.2 (e).

Rule 44 bis.1

25. The Committee agreed, on the suggestion of the Representative of CEIPI, that in the English text the second use of the word "establish" in paragraph (a) should be replaced by the word "issue." The International Bureau would consider whether there was a need for consequential changes to be made in the title of the Rule, in paragraph (b) and in other provisions.

26. The Committee agreed that the reference to "Rule 43 bis.1 (a) (i) to (iii)" in paragraph (a) should be changed to "Rule 43 bis.1 (a)."

27. The Delegation of China, supported by the Delegations of the Netherlands and the United Kingdom and the Representative of AIPPI, suggested that the proposed new report under Chapter I of the Treaty referred to in proposed Rule 44 bis.1 (b) should not have the same title as the report under Chapter II of the Treaty under proposed Rule 70.15 (b). The International Bureau explained that the same title had been suggested since the contents of the two reports would be the same, the only difference being that the report under Chapter II would take account of arguments and/or amendments submitted by the applicant during the international preliminary examination procedure. Following some discussion, during which

the Delegations of the United States of America, Australia, Spain and Japan and the Representative of the EPO supported the use of the same title, it was agreed that the title under paragraph (b) should be changed to “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” and that a corresponding change should be made in proposed Rule 70.15(b) concerning the report under Chapter II (see paragraph 43, below).

28. The Committee noted that the reference to “patentability” in the reports’ titles would not prejudice the operation of Articles 27(5) and 35(2). It was always a matter for national law to determine substantive questions of patentability, and the reports could not contain any statement on the question whether the claimed invention was or seemed to be patentable or unpatentable according to any national law. An explanation to this effect should be included in the proposal to the Assembly.

Rules 44bis.2 and 73.2

29. Following a query by the Delegation of Japan, the Committee agreed that the proposal should contain a further provision requiring the International Bureau, in the circumstances referred to in proposed Rule 44bis.2(b), to prepare and send to designated Offices a translation into English of the written opinion established by the International Searching Authority. A similar provision should be added to Rule 73.2(b) in relation to elected Offices.

30. In response to a query by the Delegation of Sudan, the International Bureau explained that the proposed new Rule referred only to “designated Office” rather than to “designated or elected Office” since it related to the procedure under Chapter I of the Treaty.

Rule 44bis.3

31. The Committee agreed, on the suggestion of the Representative of CEIPI, that the words “a report has been established under Rule 44bis.1” should replace “the report has been established” in the first line of paragraph (a).

Rule 44ter

32. Following a suggestion by the Delegation of the Netherlands, the Committee agreed that, in proposed Rule 44ter.1(a)(i), the words “subject to Rules 44bis.2(b), 62.1(i) and 73.2(b),” should be deleted, noting that the applicant, by requesting early commencement of the national phase (see Rules 44bis.2(b) and 73.2(b)) or by making a demand for international preliminary examination, implicitly authorized the International Bureau to allow access to the written opinion established under proposed Rule 43bis.1 by the designated or elected Office concerned and by the International Preliminary Examining Authority, respectively. The Committee noted that consequential drafting changes may need to be made by the International Bureau.

33. The Committee agreed that the reference in proposed Rule 44ter.1(a)(ii) to Rule 44bis.3(d) should be to Rule 44bis.4.

Rule 54bis

34. While noting that it might be desirable, as suggested by the Delegation of China, to fix a single time limit for the filing of the demand which would be applicable in all cases, the

Committee agreed to retain proposed new Rule 54bis.1(a) as set out in the Annex to document PCT/R/2/7, noting the need to maintain a degree of flexibility with regard to the time when the demand must be filed, in particular in cases where the establishment of the international search report and the written opinion established under Rule 43bis.1 may be delayed because of the workload problems faced by certain International Searching Authorities.

Rule 62bis

35. The Committee agreed that the last sentence of proposed new Rule 62bis.1(c) should be deleted, noting that present Rule 72.3, after which the wording of proposed new paragraph (c) was modeled, did not contain a similar provision.

Rule 66

36. The Representative of IPIC, supported by the Representatives of FICPI, JPAA, APAA and AIPPI, expressed concern that the proposed new system, under which the written opinion established by the International Searching Authority would automatically be considered to be the first written opinion by the International Preliminary Examining Authority, would result in a loss of certain safeguards under present Rule 66.1(c) and (d). The present provisions ensured that the applicant was notified, in a written opinion, of the extent to which the International Preliminary Examining Authority had considered any amendments and arguments submitted by the applicant under Articles 19 and/or 34 in response to the international search report, thus giving the applicant a further opportunity for dialogue with the Chapter II examiner and for further amendment of the application before the International Preliminary Examining Authority proceeded to establish the international preliminary examination report. Under the proposed new system, since the first written opinion would issue at the same time as the international search report, there would be no guarantee that the International Preliminary Examining Authority would explain its reaction to the first set of amendments or arguments submitted by the applicant. In addition, the applicant would have no opportunity to (further) amend or comment where the International Preliminary Examining Authority deviated from a written opinion established by the International Searching Authority when issuing the international preliminary examination report.

37. The Representative of IPIC urged the Committee to consider (i) giving the applicant an opportunity to respond to unfavorable views of the International Preliminary Examining Authority not previously communicated to the applicant in the written opinion established by the International Searching Authority, and (ii) providing the applicant with a further opportunity for dialogue with the International Preliminary Examining Authority before that Authority proceeded to issue the international preliminary examination report.

38. The Delegation of Australia, while sympathetic to some of the concerns expressed by the Representative of IPIC, pointed to the provisions of the International Preliminary Examination Guidelines, which the International Preliminary Examining Authorities are obliged to apply.

39. The Representative of the EPO, supported by the Delegations of the United States of America, Sweden, Spain and the Netherlands, stated that the suggestions made by the Representative of IPIC would, in effect, oblige the International Preliminary Examining Authority to issue a second written opinion in all cases where the applicant had submitted amendments under Articles 19 and/or 34, thus adding an additional feature which, under the present system, was not foreseen. The Representative of the EPO urged the Committee to

maintain the flexibility and discretion for the International Preliminary Examining Authority which existed under present Rule 66 and the applicable provisions of the International Preliminary Examination Guidelines. The Authority would consider any amendments or arguments submitted before commencement of the establishment of the international preliminary examination report and would decide whether a further written opinion, a telephoned discussion or an interview was necessary, subject to sufficient time being available having regard to the time limit for the establishment of the international preliminary examination report.

40. The Delegations of the United Kingdom and the Netherlands emphasized the need to avoid a general shift of work from the international phase to the national phase.

41. The Committee noted that, if the proposed enhanced international search and preliminary examinations system was adopted, the PCT International Search Guidelines and the PCT International Preliminary Examination Guidelines would have to be modified accordingly, with a view to implementing the amendments of the Regulations proposed in the Annex to document PCT/R/2/7 and to merging both Guidelines into a combined set of Guidelines addressed to the International Searching and Preliminary Examining Authorities. The Committee agreed that the issues raised by the Representative of IPIC should be borne in mind in the context of that review.

42. The Committee agreed that the last sentence of Rule 66.2(d) should be further amended by inserting the words “, subject to paragraph (e),” after “It shall.”

Rule 70.15

43. The Committee agreed that the title of the report under paragraph (b) should be changed to “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)” (see paragraph 27, above).

Rule 72

44. The Delegation of Sudan suggested that Rule 72.3 as proposed to be amended should include a time limit within which the applicant may make written observations as to the correctness of the translation of the international preliminary examination report. Noting that, at present, the Regulations are silent on the question as to whether and how the elected Offices are to take any observations made by the applicant into account during national phase processing, and that the matter is left to the applicable national law of the elected Office concerned, the Committee agreed that the matter did not need to be dealt with expressly in Rule 72.3.

Rule 73

45. The Committee agreed that, in proposed Rule 73.2(c), the reference to “Article 36(3)(a)” be replaced with a reference to “paragraph (a).”

Rules 52 and 78

46. The Committee agreed that Rule 52.1(a) should be amended, similarly to Rule 78.1(a), by replacing, in the last sentence of paragraph (a), the word “other” with the word “later.”

47. The Committee agreed to retain the word “applicable” in the last sentence of Rule 78.1(b) as proposed to be amended.

Rule 92bis

48. The Representative of OAPI expressed concern that one of the objectives of PCT reform, namely, to simplify the wording of the Treaty and the Regulations, had not been achieved, noting that the text would still appear to be not sufficiently user-friendly. With regard to Rule 92bis as proposed to be amended, the Representative questioned whether a designated or elected Office would be obliged to accept any change recorded by the International Bureau under that Rule if the change was recorded only after the applicant had entered the national phase before the Office concerned, and suggested that the wording of Rule 92bis be clarified accordingly. The International Bureau confirmed that such a case would be governed by the applicable national law of the elected Office concerned and that there would be no obligation for the designated or elected Office concerned to take any such change into account. The matter could be addressed and further clarified in the PCT Applicant’s Guide. The Committee noted the concern expressed by the Representative of OAPI.

Common Quality Framework

49. The Delegation of the United Kingdom, supported by the Delegations of Denmark, Australia, the United States of America, Finland and the Netherlands, expressed its satisfaction with the progress made so far in the effort to reform the PCT system, in particular by agreeing on the proposed enhanced international search and preliminary examination system and the proposal to reform the designations system, thereby achieving the every important goal of strengthening the international phase and avoiding duplication of work in the national phase. The Delegation urged that these improvements be built upon by establishing a common quality framework and a system for monitoring results. Such a system would also assist the progress of work on substantive patent law harmonization. The Committee agreed that this matter be put on the agenda of the Assembly for its next session in September of this year.

Time Limit for the Establishment of the International Search Report and the Written Opinion

50. The Delegation of the United States of America recalled that it had suggested a relaxation of the time limit for the establishment of the international search report and the written opinion established by the International Searching Authority, as noted in paragraph 44 of the summary by the Chair of the second session of the Working Group (seed document PCT/R/WG/2/12). It thanked the Delegations which it had approached with regard to this issue prior to this session of the Committee for their responses. Noting that it would not appear to be possible to provide for such relaxation at the present time, the Delegation of the United States of America urged that this issue be reconsidered at future sessions of the Committee or the Working Group. The Delegation felt that, in particular in view of the recent adoption by the Assembly of a 30-month time limit for entering the national phase under Article 22 and of the fact that applicants rarely withdraw the international application in response to the international search report, it would not be necessary to retain the current time limit for establishing the international search report and the written opinion established by the International Searching Authority. Rather, additional time should be allowed for the establishment of those documents, not only in view of the additional work required but also so

asto allow national Offices to integrate international and national processes in the international application.

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

51. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/6.

52. The Delegation of Germany stated that it welcomed the proposals for the automatic indication of all designations possible under the PCT, including the proposed transitional arrangements.

53. The Representative of IFIA noted that paragraph 15 made no proposal as to the amount of the proposed new flat international filing fee, so that inventors did not know what that fee would be. He noted that, although inventors in about 80 States benefited from a 75% reduction of the main fees payable, inventors in other States received no such benefit. He suggested that, in order to encourage invention, a 50% reduction should be introduced for the benefit of those individual inventors who were not entitled to the present 75% reduction and that a study should be carried out by the International Bureau on the financial implications of such a reduction.

Proposed Amendments of the Regulations

54. The proposed amendments of the Regulations set out in Annexes I to IV of document PCT/R/2/6 were approved by the Committee with a view to their submission to the Assembly in September 2002, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Automatic Indication of all Designations Possible Under the PCT (document PCT/R/2/6, Annex I)

Rule 4.5

55. The Committee agreed that, in order to facilitate the drafting of proposed new Rule 26.2*bis* (see paragraphs 60 and 64, below), the indications listed in Rule 4.5(a) be presented as items (i) to (iii).

Rule 4.9

56. The Delegation of Japan, supported by the Delegation of the Republic of Korea, proposed that the reservation provision in proposed Rule 4.9(b) should not be transitional in nature, since provisions of national law providing for the automatic withdrawal of an earlier application resulting from “self-designation” were permissible under Article 8(2). Any Contracting State whose national law included such provisions should be able to continue to apply them without a transitional limitation. The Delegation of Germany stated that Germany was preparing to change its national law so as to abolish the provision for the automatic withdrawal of an earlier application resulting from “self-designation” but would have to rely on the transitional reservation provision as proposed until that change had taken effect. The

Delegation of the Russian Federation reported that the Russian Federation was also proposing to amend its national law in this respect.

57. The International Bureau explained that the effect of the change to Rule 4.9(b) suggested by the Delegation of Japan would be that the request for and PCT procedures would have to provide indefinitely for the exclusion of the designation of those States to which that Rule would apply. That would represent a departure from the agreed general principle that the operation of the designations system should be automatic and all-inclusive. For this reason, the Delegations of the United States of America and Australia opposed the changes suggested by the Delegation of Japan.

58. The International Bureau confirmed that the provisions in the national laws of Japan and the Republic of Korea that provided for the automatic withdrawal of an earlier application resulting from “self-designation” would not be contrary to the amended Rules relating to designations, even if the State concerned did not make a transitional reservation under Rule 4.9(b). It was noted that an applicant could avoid automatic withdrawal of an earlier application in those States under the “self-designation” provisions by withdrawing the designation concerned (under Rule 90bis.2) within the time limit applicable under their national laws, that is, 15 months from the priority date. While no change to the relevant national laws was therefore necessary, the States concerned would, of course, be free to consider possible future changes to their national laws and/or procedures. In the light of the discussion, the Committee approved Rule 4.9(b) as proposed in Annex I to document PCT/R/2/6.

Rule 26.2bis

59. The Representative of the EPO, supported by the Delegation of the Netherlands, suggested that, where there was more than one applicant, the signature of the common representative only should be sufficient instead of any applicant.

60. In response to a comment by the Delegation of China, supported by the Delegations of Austria, the Netherlands and Canada, as to the difficulty of determining what signatures might be required under proposed new Rule 51bis.1(a)(vi) if the names of applicants were not required for the purposes of Article 14(1)(a)(ii) (see paragraph 64, below), it was agreed that Rule 26.2bis(b) should be restricted to the indications of address, nationality and residence required under Rule 4.5(a)(ii) and (iii) as proposed to be amended (see paragraph 55, above).

61. The Committee agreed, on the suggestion of the Delegation of Australia, supported by the Delegations of the United States of America and Canada and the Representative of FICPI, that the text presented in square brackets in Rule 26.2bis(a) and (b) should be deleted. The Committee also agreed, on a suggestion by the Delegation of the Netherlands, that the words “at least” appearing in Rule 26.2bis(a) and (b) were superfluous and should be deleted.

Rule 49bis.2

62. The Delegation of Japan, supported by the Delegations of Morocco, the United States of America, the Republic of Korea and Austria, but opposed by the Representatives of FICPI and IPIC, suggested that the first sentence of Rule 49bis.2(b) should be deleted, since an Office that granted more than one type of protection would not know if the correct fee had been paid if the applicant did not furnish an indication of the type of protection that was sought. The International Bureau indicated that the first sentence of Rule 49bis.2(b) would

provider relief for the applicant that had failed to furnish the indication of the type of protection when entering the national phase, in particular before those designated Offices which did not provide for the possibility of later conversion from one kind of protection to another. The Committee agreed that these sentences should be deleted.

63. Following the agreement by the Committee on the proposals concerning relief in the case of a missed time limit for entry into the national phases set out in document PCT/R/2/4 (see paragraphs 100 to 110, below), the Committee agreed that the International Bureau should consider whether there was a need for a revised proposal concerning Rule 49bis.2, in particular so as to ensure that the applicant could not be prevented from indicating a choice of protection where relief was granted under proposed new Rule 49.6. The Delegation of the Netherlands questioned the need for such a provision and suggested that an applicant who made a request for relief should be obliged to comply with all requirements at the time when making such request. A comment by the Representative of IPIC that an extension of time for indicating a type of protection other than a patent should be provided as a safeguard for applicants was supported by the Delegation of Canada.

Rule 51bis.1

64. The Delegation of China noted that, on the face of Rule 4.5(a) and proposed Rule 26.2bis, a person might be an "applicant" even if that person's name did not appear in the request (see paragraphs 55 and 60, above). The Delegation, supported by the Delegations of the Netherlands and Austria, queried how the national Office would determine, for the purposes of proposed Rule 51bis.1(a)(vi) and (vii), how many applicants there were who had not signed the request and/or provided the required indications. The Delegation of Australia stated that any person who was not named could not be considered to be an applicant. Following a suggestion by the Delegation of Canada that, in order to address the concerns raised, the indication of the names of all applicants should continue to be required and thus not covered by Rule 26.2bis(b), the Committee agreed to amend Rule 4.5(a) accordingly (see paragraph 55, above) and to restrict Rule 51bis.1(a)(vii) to the indications of address, nationality and residence required under Rule 4.5(a)(ii) and (iii) as proposed to be amended.

65. The Delegation of the United States of America proposed that Rule 51bis.1(a)(vi) should more specifically restrict the kinds of documents on which a national Office could require a signature, namely, on a copy of the request or on a declaration provided for in Rule 4.17. That proposal was supported by the Representative of IPIC. However, the Delegation of the Netherlands opposed the proposal on the grounds that the purpose of the provision was to enable the requiring of a signature that had not been provided under Rule 4. The International Bureau noted the desirability of avoiding unnecessary signature requirements but observed that the proposal would deny the applicant the opportunity of providing a signature in, for example, a simple letter associating the applicant with the application.

66. The Representative of the EPO commented that, where an international application had been assigned by a first applicant to a second applicant, proposed new item (vi) appeared to permit a national Office to require the signature of the first applicant if he had not signed the request.

67. The Delegation of Australia expressed the view that the “applicant for the designated State” was the applicant at the time of entry into the national phase in that State. The Committee agreed, and decided that item (vi) of Rule 51 *bis*.1(a) should be retained as proposed in the Annex to document PCT/R/2/6.

Rule 90

68. The Committee agreed that the text in Rule 90.2(a) and (b) presented in square brackets should be deleted (as in the case of Rule 26.2*bis*; see paragraph 61, above) and replaced by the word “and.”

69. In response to a query by the Delegation of Sudan as to the reason for permitting, under proposed Rule 90.4(d), the requirement for a separate power of attorney to be waived, the Delegation of Australia explained that in some States, such as Australia, separate powers of attorney were not required in respect of national applications, and failure by attorneys to file such powers in respect of international applications imposed a significant workload on the Office in seeking the necessary corrections. The International Bureau emphasized that the proposed Rule permitted, but did not oblige, an Office to waive the requirement to submit a separate power of attorney.

70. It was agreed that, consequential on the agreed deletion of proposed Rule 92*bis*.1(a-*bis*) (see paragraph 76, below), the reference to any request for the recording of a change in the person of the applicant in proposed new Rule 90.4(e) should be deleted.

71. In response to a question by the International Bureau, the Committee agreed that there was no need to amend Rule 90.5 to permit a receiving Office or an International Authority to waive the requirement under Rule 90.5(a)(ii) for a copy of a general power of attorney to be attached to the request, demand or separate notice.

Rule 90bis

72. On the suggestion of the Delegation of the Netherlands, the Committee agreed to retain in the second sentence of Rule 90 *bis*.5(a), as in the present text of that sentence, the words “subject to paragraph (b)”.

73. In response to queries by the Representatives of the EPO and CEIPI, the International Bureau pointed out that the second sentence of Rule 90 *bis*.5(a) would apply only to an applicant who is considered to be a common representative while Rule 90.3 provided that an appointed common representative could effect any action on behalf of all of applicants, including the signing of a notice of withdrawal.

74. The Delegation of Germany noted that if, as proposed, only one applicant was required to sign the request, the retention of the requirement under Rule 90 *bis*.5(a) that all applicants must sign the notice of withdrawal of the application could create a trap for any applicant who did not appreciate those different requirements.

75. The Delegation of the United States of America, supported by the Delegations of Morocco, Canada and the Russian Federation, suggested that proposed Rule 90 *bis*.6(d) should be deleted since it was contrary to the concept of the automatic designation of all Contracting States. The Delegations suggested that such a Rule could, for example, result in many applicants who did not intend to enter into the national phase in the United States of America,

withdrawing unnecessarily the designation of that State on the international filing date. The Delegation of Germany submitted that proposed Rule 90 *bis.6(d)* was required to give effect to Article 4(1)(ii) which provided the applicant with the right to designate as many Contracting States as he wished, including only one Contracting State; it stated that the position was similar to that concerning the indication under Article 43 that the international application was for the grant of certain types of protection. However, the Committee accepted the view of the Delegation of Canada that the lack of a possibility in the proposed Regulation to designate, on the international filing date, as a single Contracting State as referred to in Article 4(1)(ii) would not create a conflict, within the meaning of Article 58(5), between the Regulations and the provisions of the Treaty. Following some discussion, during which the Representative of IPIIC referred to the desirability of retaining the proposed new Rule to provide for cases in which the applicant did not have the contractual right to apply for protection in all Contracting States, it was agreed that proposed Rule 90 *bis.6(d)* should be deleted.

Rule 92bis.1

76. The International Bureau explained that, under its existing procedure, where it received a request for the recording of a change in the person of the applicant that was not signed by or on behalf of all applicants, while it would record such change, it would notify any applicant affected by the request (the “old” applicant) and would correct the recorded change if the “old” applicant objected to the change. In the light of this explanation, it was agreed that proposed new paragraph (a) *-bis* should be deleted; instead, the Committee agreed that the Administrative Instructions should expressly provide for a safeguard for applicants along the lines of the International Bureau’s practice.

Elections (document PCT/R/2/6, Annex II)

Rule 60

77. The Committee agreed that the signature requirements under proposed new Rule 60.1(a) *-bis* should be reviewed by the International Bureau so as to bring them in line with the corresponding signature requirements under proposed Rules 26.2 *bis* and 51 *bis.1(a)(vi)* (see paragraphs 60, 61 and 64 to 66, above). It was also agreed that the French text should be aligned with the English text.

Rule 90bis

78. For reasons similar to those applying in the case of proposed Rule 90 *bis.6(d)* (see paragraph 75, above), the Committee agreed that proposed Rule 90 *bis.6(e)* should be deleted.

International Filing Fee (document PCT/R/2/6, Annex III)

Rules 12, 15, 16 and 19

79. In response to a query by the Delegation of Morocco, the International Bureau explained that the second sentence of Rule 15.1 as proposed to be amended had been included to make it clear that the designation fee, which was specifically mentioned in Article 4(2), would be included as part of the proposed new international filing fee. After some discussion, the Committee agreed that the sentence could be omitted from the Rule and the matter explained in the accompanying text in the documents submitted to the Assembly.

80. In response to a question by the Delegation of Morocco, the International Bureau explained that the time limits for the payment of the designation fee in existing Rule 15.4(b) had not been applied to the payment of the proposed single new international filing fee under Rule 15.4 as proposed to be amended since that would mean that, in the case of an international application that did not claim priority, that single fee would not be payable until one year after the international filing date, which would not be reasonable. The International Bureau also noted that, under the proposed amended Schedule of Fees, the international filing fee would be reduced by 75% for an applicant who was a natural person and who was a national of and resided in a qualifying State, such as Morocco.

81. The Committee agreed that, consequential on the proposed amendment of Rule 15.4, the reference to “Rule 15.4(a)” in Rule 16.1(f) and the reference to “Rule 15.4(a) to (c)” in Rule 19.4(c) should each be changed to “Rule 15.4.” Furthermore, it was agreed, in Rules 12.3(e) and 16.1(f), to replace the reference to the “basic fee” with a reference to the “international filing fee.”

Schedule of Fees

82. The Committee agreed to replace the reference to “Rule 57.2(a)” in renumbered item 2 of the Schedule of Fees with a reference to “Rule 57.2.”

“Communication on Request” System (document PCT/R/2/6, Annex IV)

Rule 47.1

83. In order to expressly link the procedure under Rule 47.1(a *-bis*) with the proposed system for the communication of documents on request proposed in new Rule 93*bis*.1 (see paragraphs 88 and 89, below), the Committee agreed that Rule 47.1(a *-bis*) should read as follows:

“(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.”

84. Following some discussion, the Committee agreed with a suggestion by the International Bureau that Rule 47.1(c) as proposed to be amended should be replaced by paragraphs (c) and (c *-bis*) worded as follows:

“(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 Office 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*) Thenotice referredtoinparagraph(c)shallbeacceptedbydesignated Offices:

(i) inthecaseofadesignatedOfficereferredtoinparagraph(c)(i),as conclusivееvidencethatthecommunicationprovidedforinArticle20waseffectedon the datespecifiedin thenotice;

(ii) inthecaseofadesignatedOfficereferredtoinparagraph(c)(ii),as conclusivееvidencethattheContractingStateforwhichthatOfficeactsasdesignated Officedoesnotrequirethefurnishing,underArticle22,bytheapplicantof a copyof theinternationalapplication.”

85. TheDelegationoftheNetherlandsstatedthatitwouldbepreferable,inproposed paragraph (c-*bis*),tousewordingsimilartothatusedinproposednewparagraph(e)andto providean explicitstatementthatthecommunicationunderArticle 20hadbeeneffected beforetheexpirationofthe28 -monthtimelimitbymakingthecopyoftheinternational applicationavailabletothedesignatedOffice;however,theDelegationstatedthatitco uld agree tothesuggestedtextifthattextwereacceptabletotheCommittee.

86. TheCommitteeagreedthatparagraph (e)shouldbeamendedconsequentiallytoreadas follows:

“(e) WhereanydesignatedOfficehasnot,beforethe expirationof28months fromtheprioritydate,requestedtheInternationalBureautoeffectthecommunication providedforinArticle 20inaccordancewithRule 93*bis*.1,theContractingStatefor whichthatOfficeactsasdesignatedOfficeshallbeconsi deredtohavenotifiedthe InternationalBureau,underRule 49.1(a-*bis*),thatitdoesnotrequirethefurnishing, underArticle22,bytheapplicantofacopyoftheinternationalapplication.”

Rule76.5

87. TheCommitteeagreedth attheopeningwordsofproposedRule76.5(v)shouldread “thereferenceinRule47.1(a)toRule47.4”insteadof“thereferenceinRule47.4to Rule 47.1(a).”

Rule93bis

88. TheDelegationofJapan,supportedbytheDelegationof China,suggestedthattheterm “digitallibrary”inproposedRule93 *bis*.1(b)shouldbedefined.TheDelegationoftheUnited StatesofAmericasuggestedthatthereferenceto“otherrepository”inthatprovisionwas vagueandshouldbedeleted.TheDeleg ationofAustraliaexplainedthatnewRule93 *bis*.1(b) requiredtheagreementofboththedesignatedorelectedofficeconcernedandthe InternationalBureau,andthatthereforenoOfficewouldbeobligedtoobtaindocumentsfrom anydigitallibrarywhichi tdidnotconsidersatisfactoryforthepurpose;moreover,thePLT madereferencetoa“digitallibrary”inasimilarcontext.TheInternationalBureaunotedthat proposedRule17.1(d)indocumentPCT/R/2/5,AnnexII,providedfortheuseofadigital libraryformakingavailableprioritydocuments“inaccordancewiththeAdministrative Instructions.”TheCommitteeagreedthatthosewordsshouldalsobeincludedin Rule 93*bis*.1(b)andthatthereferenceto“otherrepository”shouldbedeleted.

89. A suggestion by the Delegation of the United States of America to change the term “takes action to make the document available” in Rule 93 *bis*.1(b) to read “makes available” was not agreed, following an explanation by the International Bureau that the words “takes action...” were necessary in order to protect the applicant.

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

90. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/3.

Alignment with the Language - Related Filing Date Requirements of the PLT

91. The Committee noted that, for the reasons explained in paragraphs 3 to 10 of document PCT/R/2/3, Rule 19.4 already provided a mechanism such that the PCT procedure was aligned with the language -related filing date requirements of the PLT.

92. The Committee agreed to recommend to the Assembly that no change was needed to the Regulations having regard to the language -related filing date requirements of the PLT, recognizing that the PCT procedure was already, in practice, consistent with those requirements, as explained in document PCT/R/2/3, paragraphs 3 to 10.

Proposed Amendments of the Regulations

93. The proposed amendments of the Regulations set out in the Annex to document PCT/R/2/3 were approved by the Committee with a view to their submission to the Assembly in September 2002, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Translation of the International Application for the Purposes of International Publication

94. The Delegations of the Republic of Korea, the Netherlands and Sweden and the Representative of the EPO welcomed the proposal to transfer from the International Searching Authority to the applicant the responsibility for establishing a translation of an international application that is filed in a language which is accepted by the receiving Office and the International Searching Authority but is not a language of publication.

Rule 12.4

95. The Delegation of Germany, supported by the Delegations of Spain, France and the Netherlands, suggested that the applicants should be permitted to establish the translation in any language of publication. The Representative of FICPI, speaking in a personal capacity, said that he was very confident that FICPI would support the proposal of the Delegation of Germany. The Delegation of the United States of America, while not opposing the suggestion, noted that its national law afforded a “senior right effect” to international applications which were published in English. The Delegation of the United Kingdom expressed support for the proposal appearing in the Annex to document PCT/R/2/3. After some discussion, the Committee agreed that the word “English” in proposed Rule 12.4(a) should be replaced by “any language of publication which the receiving Office accepts for the purposes of this paragraph.” The Committee also agreed that the International Bureau should

review the wording of other provisions of Rule 12 to ensure consistency with that terminology.

96. The International Bureau stated that consideration was being given to the possibility of a system enabling publication of translations of the international application into additional languages, if furnished by the applicant, for the purposes of provisional protection in designated States. Such a possibility would not become practicable, however, until fully electronic publication had been implemented.

97. The Committee agreed that, as proposed in square brackets, the late furnishing fee under proposed Rule 12.4(e) should be equal to 50% of the international filing fee, consistent with the late furnishing fee under Rule 12.3(e) as proposed to be amended. r

Language of the request

Rule 12.1

98. The proposal to amend Rule 12.1(c) so as to enable a receiving Office to specify any language of publication which it was prepared to accept for the purpose of filing of the request was supported by the Delegations of the Netherlands and the United States of America. The Committee agreed that the words "that purpose" in Rule 12.1(c) should be replaced by "for the purposes of this paragraph."

99. The Representative of the EPO asked what procedures should be followed where an application was filed in a mixture of languages. The Delegation of the Netherlands noted that the case in which the abstract or any text matter of the drawings was filed in a language which was different from the language of the description and the claims was expressly regulated by Rule 26.3ter. The International Bureau explained that, except where Rule 26.3ter applied, the practice of the International Bureau as receiving Office was to consider that the filing of an international application in a mixture of languages was a correctable defect under Article 3(4)(i). However, it noted that some receiving Offices took the view that such an international application was not in a language accepted under Rule 12.1(a) by that Office and transmitted it under Rule 19.4(a)(ii) to the International Bureau as receiving Office. The Committee agreed, on the suggestions of the Delegations of Australia and the United States of America, that receiving Offices should either allow correction or apply Rule 19.4(a)(ii) in this way, and recommended that the practice be incorporated into the PCT Receiving Office Guidelines.

MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

100. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/4.

Proposed Amendments of the Regulations

101. The proposed amendments of the Regulations set out in Annex II to document PCT/R/2/4 were approved by the Committee with a view to their submission to the Assembly in September 2002, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Rule 49.6

102. The Delegation of Japan recalled that it had expressed strong concerns about the proposals at the second session of the Working Group (see the summary of the session prepared by the Chair, document PCT/R/WG/2/12, paragraph 52). The Delegation, supported by the Delegations of China and Sudan, repeated its view that the proposals dealt with matters which should be left to the national law to decide. The Delegation of Japan, supported by the Delegations of China and Sudan and the Representative of OAPI, also believed that the proposals would cause severe practical problems for designated Offices as well as third parties because of possible delays in national processing, which would result in legal uncertainty.

103. The Delegation of Sudan questioned whether the proposals were consistent with Article 22(1) and expressed its view that legal problems would result from the adoption of the proposals. The appropriate solution was for applicants to make sure that time limits were met.

104. The Delegation of Mexico noted that Mexican national law was not in compliance with the proposals set out in document PCT/R/2/4 and that it therefore would have to make use of the transitional reservation provision contained in proposed Rule 49.6(g). In view of the concern expressed by other delegations, the Delegation questioned whether the proposals were ripe for submission to the Assembly.

105. The Delegation of Australia, supported by the Delegations of the United States of America, Canada, Switzerland, the United Kingdom, the Russian Federation, Denmark, Slovakia and by the Representative of the EPO, strongly supported the proposals and stressed the importance for applicants of provisions dealing with relief where time limits were remitted, referring to its positive experience with similar provisions in Australian national law. The Delegation stressed the importance of provisions dealing with intervening rights of third parties but noted that it agreed with the statement in paragraph 13 of document PCT/R/2/4 that such matter was, and would remain, one for the national law applied by the designated or elected Office. The Delegation felt that it was appropriate to introduce the proposals now in the context of the PCT, notwithstanding that provisions to the same effect would come into force when the PLT came into force.

106. The Delegation of Japan, having heard the interventions of other delegations, reiterated its concern that the proposals should not override the national law, but stated that it did not wish to stand in the way of a consensus, and therefore agreed that the proposals should be submitted to the Assembly, although it would have preferred in that case that the period provided for in proposed Rule 49.6(b)(ii) be six months rather than 12 months. The Delegation of Mexico also stated that, in the circumstances, it could go along with the proposals.

107. The Delegation of Australia pointed to the fact that inequality of treatment of applicants arose from the present position under which some countries excused missed national phase time limits but others did not. The Delegation of Germany agreed, noting that the proposals were in line with the goals of uniformity of procedure, equality of treatment and predictability.

108. The Delegation of the Netherlands, while not objecting to the proposals, noted the transitional character of proposed Rule 49.6, observing that Article 48(2) and Rule 82bis would apply on ceasing national laws applicable by designated Offices had been brought into compliance with PLT Article 12.

109. Following a question by the Delegation of the United States of America, the Committee agreed that proposed Rule 49.6 was in the nature of a minimum obligation in the sense that any designated or elected Office would be free to provide in the national law applicable in that Office for requirements which, from the viewpoint of the applicant, were more favorable than the requirements provided for in proposed Rule 49.6, such as by permitting requests for reinstatement of rights to be filed later than the times provided for in Rule 49.6(b) or by following a more liberal invitation procedure under proposed Rule 49.6(e). In that context, the Committee agreed that proposed Rule 49.6(e) should be deleted, noting that the provisions contained in that paragraph would further extend the period of uncertainty for third parties and that the PLT did not contain any similar provision.

110. The Committee agreed that the International Bureau would review other provisions relating to compliance with certain requirements at the time of entry into the national phase to ascertain whether a amendment would be desirable in the light of the approval of proposed Rule 49.6, notably in Rule 51 bis and proposed Rule 49 bis (in particular in connection with the deletion of the first sentence of proposed Rule 49 bis.2(b) in Annex I of document PCT/R/2/6; see paragraph 56, above).

RIGHT OF PRIORITY AND PRIORITY CLAIMS

111. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/5.

Availability of Priority Document from a Digital Library

Proposed Amendments of the Regulations

112. The proposed amendments of Rules 17.1 and 66.7 set out in Annex II to document PCT/R/2/5 were approved by the Committee with a view to their submission to the Assembly in September 2002, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Rules 17.1 and 66.7

113. The Delegation of Japan expressed its concern that, under the proposed enhanced international search and preliminary examination system, the time limit of 16 months under Rule 17.1(a) for the furnishing by the applicant of a priority document could be too long and caused delays in the establishment of the written opinion by the International Searching Authority (ISA) if a copy of the priority document was required by the Authority.

114. The Delegation of Australia and the Representative of ARIPO referred to the practical difficulties that could be expected in obtaining a copy of a priority document earlier than 16 months from the priority date. In addition, the Delegation of the Netherlands questioned whether the need for a copy of the priority document by the International Searching Authority would indeed arise in many instances, noting that this was not the case under the present

Chapter II procedure for the purposes of establishing the international preliminary examination report.

115. The Committee agreed to retain the 16 -month time limit for the furnishing of the priority document under Rule 17.1(a), noting that, under proposed new Rule 43bis.1(b), the procedure outlined in Rule 66.7 would apply *mutatis mutandis* to the establishment of the written opinion by the International Searching Authority (see document PCT/R/2/7).

116. The Committee agreed to delete the reference to “other repository” from Rules 17.1(b-*bis*) and 66.7(a) as proposed to be amended. In response to questions by the Delegation of China and the Representatives of OAPI and ARIPO, the International Bureau explained that the precise nature of a (central) digital library or several (decentralized) digital libraries from which priority documents could be obtained under proposed new Rule 17.1(b-*bis*) was not yet clear. When proposals were being prepared for the necessary modification of the Administrative Instructions, it would be necessary to ensure that the system worked smoothly for all Offices; in particular, the use of a digital library should not impose financial or other burdens on small Offices with limited resources. The system would also have to take account of any requirement for certification of priority documents in electronic form; in this connection, Annex F of the Administrative Instructions would be expected to provide the necessary framework.

Restoration of Priority Claims

117. The Delegation of Canada, supported by the Delegations of Australia and the United States of America, stated that, while it supported in principle the concept of providing relief where the 12 -month priority period was not complied with, it was concerned that the restoration of a priority claim as proposed in Rule 26bis.3 could be considered to be a matter of substance. Noting that the PLT and the PCT operated in different contexts, the Delegation suggested that such relief might, instead, be provided by amendment of Rules 4.10 and 26bis.1.

118. The Delegation of Japan stated that, although it supported the proposed restoration of priority claims in principle, it was concerned that, in some cases, such restoration could leave insufficient time for the transmittal of the record copy and translation within 13 months as required by Rule 22.1. The Delegation of Kenya also referred to the need to avoid problems of meeting time limits that might arise where a priority claim was restored.

119. The Delegation of Austria, supported by the Delegations of Spain, Germany, Ireland, France, Sweden, Portugal, Denmark, the Netherlands and Greece and the Representative of the EPO, suggested that the criterion for restoration under proposed new Rule 26bis.3(a)(iii) should be changed from “unintentional” to “due care.” The Delegation of the United Kingdom emphasized a preference for retaining a single criterion; otherwise, there was a possibility that applicants who had missed the 12 -month priority period might shop around for receiving Offices with the most liberal criterion. The suggested change was opposed by the Delegation of Australia, supported by the Delegations of the United States of America and Canada, on the grounds that the “unintentional” criterion was broader and therefore more applicant-friendly.

120. The Committee agreed that the words “or the International Bureau, as the case may be,” in proposed new Rule 26 *bis*.3(e) were unnecessary.

121. The Delegation of the United Kingdom and the Representative of the EPO suggested, in connection with proposed Rule 26 *bis*.3(g), that express provisions should be made, where the receiving Office refused a request for restoration of priority claim, for a designated Office to review that decision, noting that Articles 24 and 25 would not appear to be applicable in such a case. The Committee agreed that the revised proposals should contain such a provision. The Delegation of the United Kingdom also questioned whether the review by a designated Office should be based on its own criterion or that used by the receiving Office.

122. In response to a comment by the Delegation of China, the International Bureau explained that the transitional reservations provided for in proposed Rule 26 *bis*.3(h) were intended to apply only to the provisions of Rule 26 *bis*.3 and not to Rules 26 *bis*.1 and 26 *bis*.2, since the latter provisions were already in force and were not subject to reservations. So as to clarify the matter, the Committee agreed that the words “this Rule” should be replaced by “paragraphs (a) to (g).”

123. Having regard to the number of outstanding issues connected with the proposed provisions relating to restoration of priority claims, and noting that the proposal had not been extensively considered by the Working Group, the Committee felt that they were not yet ripe to proceed to the Assembly.

Correction and Addition of Priority Claims

124. The proposed amendments of Rules 26 *bis*.1, 26 *bis*.2 and 80.8 set out in Annex II to document PCT/R/2/5 could not, in the time available, be discussed by the Committee.

Further Consideration

125. The Committee agreed to recommend to the Assembly that the proposed amendments of Rules 4.10, 26 *bis*.3 and 48.2 set out in Annex II to document PCT/R/2/5 should be revised by the International Bureau, taking into account the comments and concerns expressed at the Committee's session, and submitted to the Working Group, together with the proposed amendments of Rules 26 *bis*.1, 26 *bis*.2 and 80.8, for discussion at its next session.

ENTRY INTO FORCE; TRANSITIONAL ARRANGEMENTS

126. In connection with the proposed amendments relating to the enhanced international search and preliminary examinations system, the Delegation of Japan, supported by the Representative of the EPO, stated that there was a need to include transitional provisions in respect of pending applications and to provide adequate time for the legal and operational implementation of the system by the International Authorities. The International Bureau observed that it would be preferable if a date could be agreed upon that would enable all Authorities to implement the system at the same time. The Representative of CEIPI emphasized the desirability of having a single date of entry into force to avoid having different systems operating in different International Authorities.

127. The International Bureau reported to the Committee on the results of informal consultations with delegations concerning entry into force and transitional provisions. During those consultations, it had been suggested that similar considerations applied to both the proposed enhanced international search and preliminary examination system and the proposed system of automatic indication of all designations possible under the PCT and related proposals. Most delegations had agreed with the suggestion made by the International Bureau that January 1, 2004, would be a suitable implementation date to aim for. The Delegation of Japan had reserved its final position and indicated that it thought, for example, September 2004 (that is, two years after the adoption of the amendments by the Assembly) would be more realistic, or alternatively that the date could be left to be fixed when all International Authorities had indicated that they were ready to commence operations under the amended Rules.

128. As to the application of the enhanced international search and preliminary examination system, the International Bureau indicated that the informal consultations had suggested that considerations should be given to the possibility of applying the new provisions to existing applications in relation to which an international search report under the present system had not yet been established. The Delegation of the Netherlands observed that there may be difficulties relating to calculating the fees payable in respect of such pending applications in the event that the International Authorities fixed new fee amounts under the enhanced system. at

129. The Representative of the EPO stated that no change was, or should be, envisaged to the existing principle under which each Authority was free to decide on the fees which it wished to charge. The International Bureau noted that any modification of the fees payable would need to be reflected in the Agreements between the Authorities and the International Bureau under which the Authorities performed their functions.

130. The Committee agreed to recommend to the Assembly that the proposed amendments relating to the enhanced international search and preliminary examination system, as well as those relating to the automatic indication of all designations possible under the PCT (and related proposals), should enter into force on January 1, 2004. The Committee noted that a decision would need to be made as to whether the amended provisions should apply only to applications filed after the date of entry into force or to those applications and also to specified classes of pending applications, for example, those applications in respect of which the international search report had not yet been established under the present system and those applications in respect of which a demand for international preliminary examination had not yet been submitted.

131. The Committee also agreed to recommend to the Assembly that the proposed amendments relating to language of the international application and translations, and to missed time limits for entering the national phase, should, if possible, enter into force on January 1, 2003.

132. Following an observation by the Representative of CEIPI, the Committee agreed that the International Bureau should consider the possible inclusion of transitional provisions applicable in the case of those Contracting States which had not so far implemented under their national law the new 30-month time limit under Article 22.

FURTHERWORK

133. The International Bureau made a number of observations on the subject of the future work program concerning reform of the PCT.

134. As to the structure of the bodies which would undertake the work, the International Bureau noted that the informal procedure followed by the Working Group had proved to be successful, enabling matters to be discussed and developed in a highly efficient manner and brought quickly to the stage of submission of concrete proposals to the Committee and the Assembly. Considerations should be given to what would be the most suitable structure for future discussions, in particular involving possible revision of the Treaty itself.

135. As to the future work program, the International Bureau suggested that, following the session of the Assembly in September - October 2002, PCT reforms should focus on issues of two kinds. First, those proposals for reform which had already been submitted to the Committee or the Working Group, but not yet considered in detail, should be reviewed. Those proposals involved possible changes to both the Treaty Articles and the Regulations. Second, considerations should be given to options for revising the Treaty itself.

136. The International Bureau offered to prepare, for the next meeting at the working level, a document listing all outstanding proposals, indicating whether they would involve changes to the Regulations or the Treaty itself, as well as a document outlining options for a possible revision of the Treaty itself. In addition, delegations should be invited to make any (further) proposals related to those matters.

137. The Delegations of the United States of America, Japan, South Africa, Mexico, Australia, China, Germany, Canada, the United Kingdom and Ecuador and the Representative of the EPO welcomed the suggestions made by the International Bureau. As to the proposed work program, delegations emphasized the need for a stock taking of previously made proposals, which needed to be reviewed as to their relevance and priority, taking particular account of the progress already made in reforming the PCT system. The Delegation of Canada called for an early and fundamental reform of the Treaty itself. The Delegation of China proposed that the long-term goal of PCT reforms should be clarified and that the next stage of PCT reforms should commence with the review of all of the objectives of reform that had been set out by the Committee and subsequently approved by the Assembly.

138. With regard to the present structure of the involved bodies, including the Committee and the Working Group, all delegations taking the floor on the matter expressed satisfaction, particularly noting that rapid progress had been achieved in the Working Group because of its informal and flexible procedures which encouraged an open and efficient dialogue. Some delegations indicated that it would be desirable to reduce the number of working level meetings to two per year.

139. The Delegations of South Africa, Mexico and Ecuador noted that financial assistance, which was necessary to enable delegations from developing countries to attend working level meetings in Geneva, was available for sessions of the Committee but not of the Working Group, and requested that this be taken into account in any recommendation to the Assembly concerning future meetings at the working level.

140. The Committee agreed to recommend to the Assembly that:

(i) two sessions of the Working Group should be convened between the September 2002 and September 2003 sessions of the Assembly to consider the matters outlined in paragraphs 135 and 136, above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary;

(ii) financial assistance allocated to enable certain delegations to attend the next session of the Committee should, exceptionally, also be made available for those sessions of the Working Group, subject to the availability of sufficient funds.

141. The International Bureau indicated that, subject to the Assembly's approval, the third session of the Working Group was tentatively scheduled for November 18 to 22, 2002, and the fourth session for May 12 to 16, 2003.

ADOPTION OF THE REPORT OF THE SESSION

142. The Committee unanimously adopted this report on July 5, 2002.

[End of Annex and of document]