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PCT/A/31/6
ORIGINAL:English
DATE:July24,2002

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
(PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT)

Document prepared by the International Bureau

INTRODUCTION

1. This document contains proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT) related to reform of the PCT. ¹Details of prior consideration by the Assembly, the Committee on Reform of the PCT ("the Committee") and the Working Group on Reform of the PCT ("the Working Group") appear in document PCT/A/31/5.
2. As requested by the Committee at its second session held in Geneva from July 1 to 5, 2002, redrafted proposals have been prepared by the International Bureau and are set out in the Annexes to this document. They relate to the following matters:

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).

- (i) enhanced international search and preliminary examinations system (see paragraphs 6 to 47, below);
- (ii) concept and operation of the designations system (automatic indication of all designations and all elections possible under the PCT; “flat” international filing fee; “communication on request” system (see paragraphs 48 to 64, below);
- (iii) language of the international application and translations (see paragraphs 65 to 72, below);
- (iv) missed time limit for entering the national phase (see paragraphs 73 to 81, below);
- (v) availability of priority documents from digital libraries (see paragraphs 82 and 83, below).

3. Proposals for entry into force and transitional arrangements in relation to the amendments proposed in this document are set out in document PCT/A/31/6 Add. 1. A “clean” copy of the proposed amended provisions (without underlining or striking through) appears in document PCT/A/31/6 Add. 2.

4. The implementation of the proposed amendments relating to the enhanced international search and preliminary examinations system, and those relating to 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, will require a considerable amount of preparation. New procedures will need to be developed, and extensive revision will be needed to the Administrative Instructions (including the Forms annexed thereto), the guidelines for international search and international preliminary examination, and the PCT Applicant’s Guide. Other explanatory materials will also need to be prepared for the purpose of informing users of the system about its new features. The Committee recommended that those amendments should enter into force on January 1, 2004. For ease of consideration by the Assembly, those amendments are set out in Annex II to this document.

5. Other proposed amendments, relating to the language of the international application and translations and to missed time limit for entering the national phase, would be able to be implemented at an earlier date. The Committee recommended that those amendments should, if possible, enter into force on January 1, 2003. A similar conclusion may be reached in relation to the proposed amendments relating to the availability of priority documents from a digital library. For ease of consideration by the Assembly, those amendments are set out in Annex I to this document.

ENHANCED INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION SYSTEM (*see Annex II, Rules 36.1, 43bis, 44 (title), 44.1, 44bis, 44ter, 52.1, 54bis, 57.3, 57.6, 58bis.1, 59.3, 61.4, 62 (title), 62.1, 62bis, 63.1, 66.1bis, 66.2, 69.1, 69.2, 70 (title), 70.15, 72.3, 73 (title), 73.2, 78.1, 78.2, 92bis.1, 94 .1)*)

6. For details of the prior consideration by the Assembly, the Committee and the Working Group of the proposed amendments of the Regulations related to the enhanced international search and preliminary examinations system, see documents PCT/R/1/2 (Annex, pages 4 and 5, items (6), (7) and (9)); PCT/R/1/26 (paragraphs 70 and 71); PCT/A/30/7 (paragraph 23); PCT/R/WG/1/2, 3, 3 Add. 1, 3 Add. 2, 7 and 9 (paragraphs 7 to 10);

PCT/R/WG/2/1,1Add.1,9,9Corr.10,11and12(paragraphs 31to49);andPCT/R/2/7 and 9(paragraphs 16to50).

Overview

7. The flowchart on the following page illustrates the main features of the proposed enhanced international search and preliminary examinations system.

8. During the discussions in the Working Group and the Committee on how to improve coordination of international search (Chapter I of the Treaty) and international preliminary examination (Chapter II of the Treaty), it has been recognized that a possible merger of the procedures under Chapters I and II would only be considered in the context of long-term reform of the PCT (see document PCT/R/WG/2/12, paragraph 33). While these separate procedures under Chapters I and II would be retained, the proposed enhanced international search and preliminary examinations system may be seen as an important first step towards a more extensive rationalization of the international search and international preliminary examination procedures, with a view ultimately to achieving greater convergence of the international and national procedures. The present proposal therefore strives, so far as possible, to bring the procedures under Chapters I and II into line.

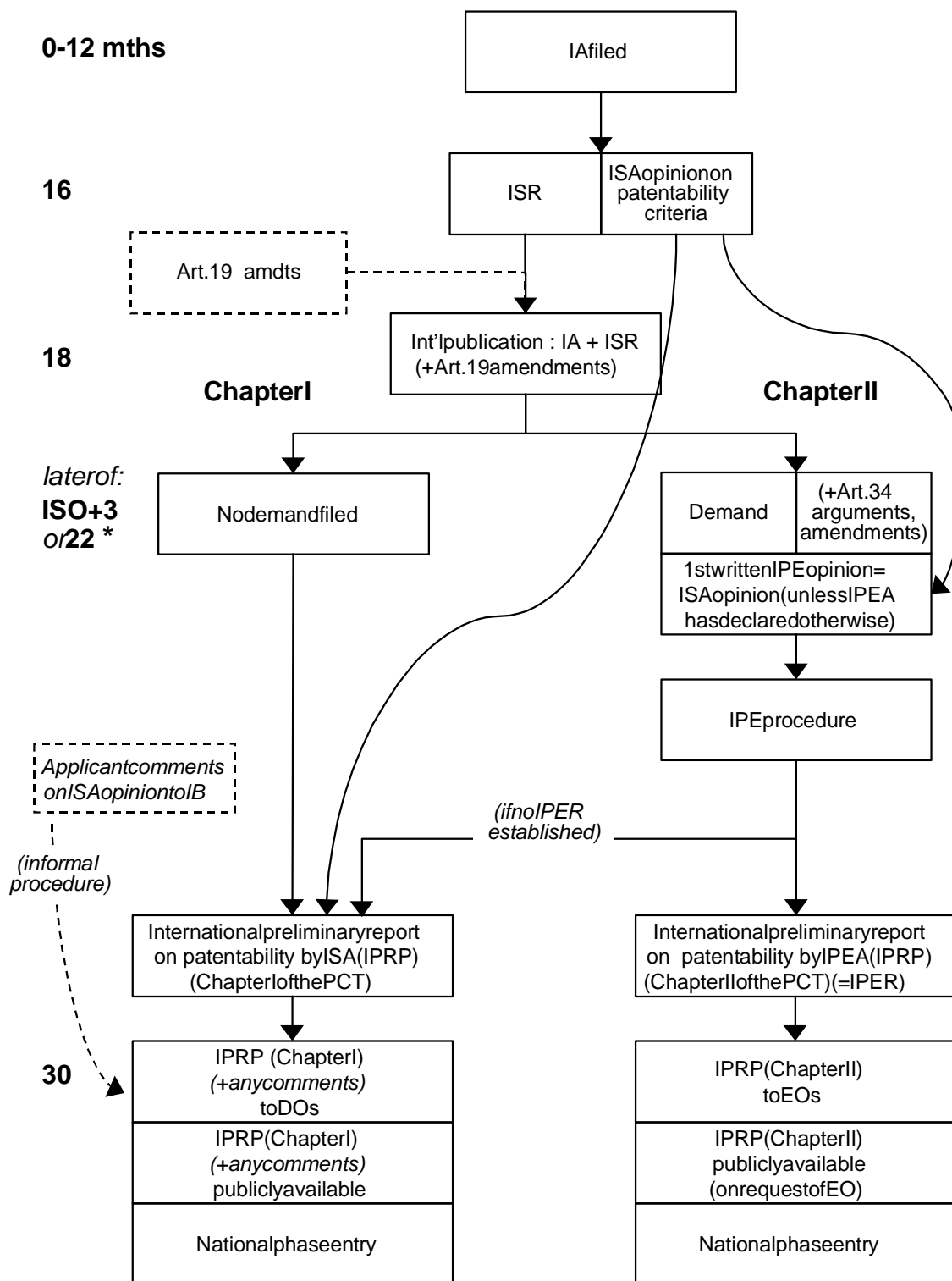
9. The main feature of the proposed new system is that one of the main elements of the present Chapter II procedure, namely, the establishment of an examiner's opinion, would in effect be advanced and incorporated into the Chapter I procedure. Under the new system, the International Searching Authority (ISA) would be responsible for establishing a preliminary and non-binding written opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. That written opinion of the ISA would be used for the purposes both of Chapter I and, if the applicant files a demand for international preliminary examination, of Chapter II, thus combining the international search and international preliminary examination procedures to a much greater extent than is the case at present.

10. Since all ISAs would be responsible for preparing written opinions which are similar in their content to international preliminary examination reports prepared by an IPEA, the qualifications for appointment of an ISA would be changed to include all of those which apply for the appointment of an IPEA. Similarly, the qualifications for appointment of an IPEA would be changed to include all of those which apply for appointment of an ISA.

11. It is to be noted that the adoption of the proposed changes outlined in paragraph 10, above, 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.

12. Under Chapter I of the Treaty (that is, if no demand for international preliminary examination is made), the written opinion of the ISA would form the basis for the issuance by the International Bureau, on behalf of the ISA, of an "international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)" (IPRP (Chapter I)) to be communicated to all designated Offices and to be made available for public inspection after the expiration of 30 months from the priority date.

Enhanced International Search and Preliminary Examination System



**must in practice file demand by 19 months for Article 22 transitional reservation countries*

13. In the designated Offices, following the entry into the national phase of an international application under Chapter I of the Treaty, the proposed IPRP (Chapter I) would meet the need for an “examiner’s opinion,” of particular importance for small and medium-sized Offices, including those in developing countries, following the recent adoption by the Assembly of a 30-month time limit for entering the national phase under Article 22. Following the adoption of that changed time limit, there is the expectation that many applicants will not opt to request the international preliminary examination procedure under Chapter II of the PCT, with the result that many international applications will enter the national phase with an international search report but without any examiner’s opinion.

14. The proposed IPRP (Chapter I) would fill that gap. The report would be equivalent to an international preliminary examination report which is established on the basis of a written opinion to which the applicant never responded, noting that, in such a case, it is the practice of International Preliminary Examining Authorities (IPEAs) to simply “convert” the written opinion into an international preliminary examination report. For the purposes of national phase processing, the IPRP (Chapter I) should carry the same weight as such an international preliminary examination report.

15. Under Chapter II, that is, if a demand for international preliminary examination is made, the written opinion of the ISA would, unless the IPEA specifically opts otherwise, take the place of the first written opinion established, under the present system, by the IPEA during the international preliminary examination procedure. International preliminary examination would be carried out on the basis of the international search report and the written opinion of the ISA, and would be concluded with the international preliminary examination report which, in order to stress the similarities between the report established under Chapter I and that established under Chapter II, is proposed to be entitled “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)” (IPRP (Chapter II)).

16. The main distinction between the IPRP (Chapter I) and the IPRP (Chapter II) would be that the former would be established on the basis of the international application as filed whereas the latter would be established following a dialogue between the applicant and the examiner, often on the basis of the international application as amended under Article 34, in response to the international search report and the written opinion of the ISA.

17. Further details of the proposed procedure are outlined in the following paragraphs.

Procedure under Chapter I

18. *Establishment of written opinion by ISA.* With regard to every international application, the ISA would establish, at the same time that it establishes the international search report, a written opinion as to whether the international application complies with certain requirements, which would correspond directly to the matters referred to in Article 34(2)(c), that is:

(i) whether the invention satisfies the criteria of novelty, inventive step and industrial applicability; and (ii) whether the international application complies with the requirements of the Treaty and the Regulations (so far as checked by the ISA). The written opinion of the ISA would also contain any other observations corresponding to those referred to in Article 35(2), last sentence. In other words, the scope of the ISA’s written opinion would be similar to the written opinion established by the IPEA during international preliminary examination.

19. The relevant date for determining prior art for the purposes of establishing the written opinion would be the international filing date or, where priority of an earlier application is claimed, the priority date, as is the case for the establishment of the international preliminary examination report. It is proposed, for the safeguard of the applicant, that the *international search* should continue to take into account prior art up to the international filing date, even if the international application claims the priority of an earlier application, and to apply the same prior art criteria as for international preliminary examination only to the establishment of the *written opinion* established by the ISA. That approach would put the written opinion of the ISA on equal footing with the written opinion of the IPEA, and should not pose any problems for examiners who are already used to taking different “relevant dates” into account for determining prior art for international search and international preliminary examination purposes.

20. The time limit for the ISA to establish the written opinion would be the same as that currently applicable for the international search report (see Rule 42.1), that is, three months from the date of receipt by the ISA of the search copy or nine months from the priority date, whichever time limit expires later. The written opinion of the ISA would be established in the language in which the international search report is established, and would be communicated, together with the international search report, to the applicant and to the International Bureau.

21. *Options for the applicant.* After having received the international search report and the written opinion of the ISA, the applicant would have a choice of the following options to pursue:

(i) submit to the International Bureau (informal) comments on the written opinion of the ISA (see paragraphs 22 and 23, below); and/or

(ii) submit to the International Bureau amendments of the claims under Article 19(1) (see paragraph 24, below); and/or

(iii) request international preliminary examination (see paragraphs 32 to 41, below);

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

(iv) withdraw the international application under Rule 90 *bis*.1; or

(v) not take any action.

22. *Informal comments on the written opinion of the ISA.* No special provisions would be included in the Regulations for the applicant to comment on the written opinion of the ISA. 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 the report resulting from the written opinion of the ISA (see paragraph 28, below). Designated Offices would be free to require a translation of such comments. Any formal response to the written opinion of the ISA would need to be submitted to the IPEA under Article 34 as part of the procedure under Chapter II, that is, by requesting international preliminary examination.

23. 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 ISA in the event that international preliminary examination is not requested, noting that the written opinion of the ISA will be “converted” to an IPRP, communicated to the designated Offices and made available for public inspection (see paragraphs 28 and 31, below).
24. *Amendments of the claims under Article 19.* As at present, after the receipt of the international search report and of the written opinion of the ISA (or the declaration under Article 17.2(a)), the applicant would have the opportunity under Article 19 to amend the claims (only), within the time limit under present Rule 46.1, in particular with a view to international publication (in which the Article 19 amendments are included) and any provisional protection the applicant may enjoy under national law. There would be no reason why such amendments (to the claims only, of course) under Article 19 could not respond to matters raised in the written opinion of the ISA.
25. *International publication.* Unless the applicant withdraws the international application, the international application would, as at present, be published promptly after the expiration of 18 months from the priority date, together with the international search report and any Article 19 amendments of the claims, but without the written opinion of the ISA or any comments thereon furnished informally by the applicant. Both the written opinion of the ISA and any such comments thereon would remain confidential until a later date (see paragraphs 30 and 31, below).
26. *International preliminary report on patentability (Chapter I).* If no demand for international preliminary examination is made (and thus no international preliminary examination report is to be established), the International Bureau would issue, on behalf of the ISA, an IPRP (Chapter I) with the same content as the written opinion established by the ISA. That procedure would correspond to the present procedure during international preliminary examination under which the IPEA issues a written opinion which, if the applicant does not respond, is “converted” by the IPEA into an international preliminary examination report. An IPRP (Chapter I) should thus carry the same weight for national phase purposes as an international preliminary examination report established at present in that way (see paragraph 14, above).
27. It is to be noted that the proposed title “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” would not be in conflict with Article 35(2) since the report would not “contain any statement on the question whether the claimed invention is or seem to be patentable or unpatentable according to any national law” (emphasis added); rather, the report would be limited to a statement, in relation to each claim, whether the claim appears 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 Rule 64 and 65).
28. *Communication to designated Offices.* The International Bureau would communicate the IPRP (Chapter I) and any (informal) comments on the written opinion of the ISA furnished by the applicant to all designated Offices, but not before the expiration of 30 months from the priority date (see paragraphs 30 and 31, below). Where the applicant makes an express request for early national phase entry before a designated Office before the expiration of 30 months from the priority date, the International Bureau would, if the IPRP (Chapter I) has not yet been established, communicate a copy of the written opinion by

the ISA to that Office (the content of which would, of course be identical to the subsequently produced IPRP (Chapter I)).

29. *Translation of IPRP (Chapter I).* As for an international preliminary examination report at present, the IPRP (Chapter I), when communicated to any designated Office, if not in English, would, if requested by that Office, be accompanied by a translation into English prepared by or under the responsibility of the International Bureau. The applicant would have an opportunity to submit observations on the translation. As is the case for international preliminary examination reports, an IPRP (Chapter I) in English or translated into English would have to be accepted by all designated Offices for the purposes of national phase processing, and no designated Office would be entitled to require the applicant to furnish a translation of the IPRP (Chapter I) into any other language. Not that, as agreed by the Committee (see document PCT/R/2/9, paragraph 29), further amendments of Rules 44bis.3(d), 44 bis.4, 73.2bis and 72.3 are proposed in Annex II so as to require the International Bureau, in the circumstances referred to in proposed Rule 44bis.2(b) and Rule 73.2(b), to prepare and send to designated or elected Offices a translation into English of the written opinion established by the ISA, with a proposed further consequential change to Rule 44ter.1(a) as set out in Annex II.

30. *Confidentiality of written opinion, IPRP (Chapter I), translation and comments.* As indicated above, the written opinion of the ISA, the IPRP (Chapter I), any translation thereof and any comments on the written opinion of the ISA submitted by the applicant would remain confidential as against third parties and designated Offices until 30 months from the priority date, corresponding to the time at which the file of the international preliminary examination presently becomes available for public inspection (via the elected Offices).

31. After the expiration of 30 months from the priority date, the IPRP (Chapter I), any translation into English thereof and any comments on the written opinion of the ISA submitted by the applicant would be communicated to all designated Offices. At the same time, the written opinion of the ISA, the IPRP (Chapter I), any translation into English thereof and any comments on the written opinion of the ISA submitted by the applicant would be made available for public inspection by the International Bureau. Public inspection would be possible even where a demand for international preliminary examination has been made, noting that third parties would, in any case, get access to those documents, once the international preliminary examination report has been established, via elected Offices.

Procedure under Chapter II

32. *Demand for international preliminary examination.* The international preliminary examination procedure under Chapter II would continue to be initiated by the filing of a demand. The existing possibility for ISAs and IPEAs to combine the procedures under Rule 69.1(b) would be retained.

33. The time limit for making a demand for international preliminary examination would be three months after the issuance of the international search report and the written opinion of the ISA or of the declaration under Article 17.2(a), or 22 months from the priority date, whichever is later. Any demand made after the expiration of the applicable time limit would be considered as if it had not been submitted and the IPEA would so declare. During the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 are still in force, the demand would have to be

filed within 19 months from the priority date if the applicant wished to have 30 months in which to enter the national phase in those countries.

34. *International preliminary examination procedure.* As at present, if the applicant files a demand for international preliminary examination, the further processing of the international application would be governed by Chapter II.

35. Upon receipt of a demand or a copy thereof from the IPEA, the International Bureau would transmit to the IPEA copies of the written opinion of the ISA (unless the same Office is acting as both ISA and IPEA). Any comments on the written opinion of the ISA submitted (informally) by the applicant to the International Bureau (see paragraph 22 and 23, above) would not be communicated to the IPEA; rather, any response to the written opinion of the ISA would need to be submitted by the applicant to the IPEA under Article 34 as part of the international preliminary examination procedure.

36. Upon the request of the IPEA, where the written opinion of the ISA is not in English or in a language accepted by the IPEA, a translation into English of the written opinion of the ISA would be prepared by the International Bureau and transmitted to the IPEA within two months following the request for translation. All IPEAs would be required to accept such written opinions established in or translated by the International Bureau into English.

37. *Written opinion of ISA considered to be written opinion for the purposes of international preliminary examination.* In general, the written opinion of the ISA would be considered to be a written opinion for the purposes of international preliminary examination (see paragraph 39, below, with regard to the exception from this general rule). Any arguments and/or amendments in response to the written opinion of the ISA would have to be submitted within the same time limit as the time limit for making the demand, that is, three months after the issuance of the written opinion of the ISA or 22 months from the priority date, whichever was later, if they are to be taken into account by the IPEA, failing which the IPEA would be free to proceed straight to the issuance of the international preliminary examination report without issuing any further notification to the applicant. That time limit would apply even where the demand had been filed earlier. Indications informing the applicant that, if a demand for international preliminary examination is made, the written opinion of the ISA will be considered to be a written opinion of the IPEA (except in the case outlined in paragraph 39, below) and an invitation to submit, within the applicable time limit, a written reply together, where appropriate, with amendments, would be included in the written opinion of the ISA submitted to the applicant.

38. The IPEA would not be obliged to issue a further written opinion, in addition to the written opinion of the ISA, before establishing the international preliminary examination report. However, if the applicant makes a serious attempt to meet the (search) examiner's objections by submitting, within the applicable time limit, arguments and/or amendments in response to the written opinion of the ISA, the International Preliminary Examination Guidelines, which the IPEAs are obliged to apply and observe in corresponding cases at present, require that "if there are still objections that require to be met, the examiner must consider, subject to sufficient time being available having regard to the time limit for the establishment of the international preliminary examination report... whether they could best be resolved by a further written opinion, a telephoned discussion or an interview."

39. *IPEA may decide not to accept written opinions of other ISAs for the purposes of international preliminary examination.* While, in general, the written opinion of the ISA would be considered to be a written opinion for the purposes of international preliminary examination, any IPEA would be entitled to inform the International Bureau that a written opinion of the ISA which had not been prepared by the same Office in its capacity as an ISA would not be considered to be its first written opinion in relation to the procedure before that IPEA. Such an IPEA would be obliged to notify the applicant accordingly, and the normal international preliminary examination procedure (as at present) would apply, although the IPEA would in any event be obliged to take the content of the written opinion of the ISA into account. As at present, the applicant would be entitled to receive one written opinion from the IPEA (in addition to the written opinion of the ISA), with the opportunity to submit arguments and/or amendments under Article 34.

40. *International preliminary report on patentability (Chapter II of the Patent Cooperation Treaty).* In the context of introducing the enhanced international search and preliminary examinations system, it is proposed to title the international preliminary examination report as an “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)” so as to stress the similarities between the report established under Chapter I and that established under Chapter II. As explained in paragraph 27, above, this proposed title would not be in conflict with Article 35(2).

41. *Communication of IPRP (Chapter II) to elected Offices.* The IPRP (Chapter II) by the IPEA would be established within the applicable time limit under Rule 69 (that is, usually within 28 months from the priority date) and communicated by the IPEA to the applicant and to the International Bureau. As is the case for the communication to all designated Offices of the IPRP (Chapter I) by the ISA, the International Bureau would communicate the IPRP (Chapter I) by the IPEA to all elected Offices, but not before the expiration of 30 months from the priority date. Where the applicant makes an express request for early national phase entry before an elected Office before the expiration of 30 months from the priority date, the International Bureau would, if the international preliminary examination report has not yet been established, communicate a copy of the written opinion by the ISA to that Office.

Guidelines for international search and preliminary examination

42. If the proposed enhanced system is adopted, the PCT International Search Guidelines and 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 this document and to merging both Guidelines into a single set of Guidelines addressed to the International Searching and Preliminary Examining Authorities, which would be responsible, in future, for conducting the international search and international preliminary examination in a more coordinated way than at present.

National phase processing

43. *Communication of IPRP (Chapter I or Chapter II) to designated and elected Offices.* In general, national phase processing before any designated or elected Office would not change as compared to today's situation. Any designated or elected Office would receive from the International Bureau, promptly after the expiration of 30 months from the priority date, a copy of an IPRP, established either under Chapter I or under Chapter II, as applicable, together with, if necessary, a translation into English, and a copy of any comments submitted informally to the International Bureau by the applicant on the written opinion of the ISA.

The content of the file of the international preliminary examination, which would include the written opinion of the ISA, would be available to any elected Office from the IPEA (see present Rule 94.2).

44. *Public inspection (Chapter I).* A copy of the written opinion of the ISA and of any comments thereon submitted informally by the applicant to the International Bureau, of the IPRP (Chapter I) and any translation thereof into English, and of any observations on the translations submitted by the applicant, would be made available, after the expiration of 30 months from the priority date, to any person as part of the file held by the International Bureau (see present Rule 94.1).

45. *Public inspection (Chapter II).* As at present, access by third parties to the international preliminary examination report (and other parts of the file of the IPEA) would be available to any elected Office whose national law provides for such access (see present Rule 94.3). In the context of introducing the enhanced international search and preliminary examination system, it is now proposed to amend Rule 94.3 to provide for the International Bureau to make the international preliminary examination report available on behalf of any elected Office which so requests.

Demand filed at the same time as the filing of the international application

46. In the context of introducing the enhanced international search and preliminary examinations system, it is proposed to enable the applicant to submit the demand at the same time as the filing of the international application or at any time thereafter prior to the expiration of the time limit for filing the demand (see paragraph 32, above). In order to enable the applicant to do so, it is proposed to postpone the due date for the payment of the handling fee and the preliminary examination fee (at present, one month from the date of filing of the demand) and to provide that those fees only fall due within one month from the date of filing of the demand or 22 months from the priority date, whichever expires later (see, however, paragraph 47, below), with the same invitation procedure and further extension of the time limit for payment as applies at present if the fees are not paid (in full). Of course, international preliminary examination procedures would only start if the applicant pays in full, within the applicable time limit, the amount due for the handling fee and the preliminary examination fee, including, where applicable, a late payment fee.

47. As an exception to the general rule that the handling fee and the preliminary examination fee fall due within one month from the date of filing of the demand or 22 months from the priority date, whichever expires later (see paragraph 46, above), it is proposed to set an earlier due date for the payment of those fees where the IPEA is part of the same national Office or intergovernmental organization as the ISA and wishes to start the international preliminary examination at the same time as the international search. In such a case, the IPEA would be required to invite the applicant to pay those fees within one month from the date of the invitation. Otherwise, no special provision has been included at this stage which would introduce new possibilities for a combination of international search and international preliminary examination, beyond what is envisaged in present Rule 69.1(b); present Rule 69.1(b) appears sufficient to enable an IPEA to start the international preliminary examination at the same time as the international search.

CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM (see Annex II, Rules 4.1, 4.5, 4.9, 4.11, 4.12, 4.13, 4.14, 12.3, 12.4, 15 (title), 15.1, 15.2, 15.4, 15.5, 15.6, 16.1, 16bis.1, 16bis.2, 19.4, 24.2, 26.2bis, 27.1, 29 (title), 29.1, 32.1, 32.2, 47.1, 47.2, 47.4, 48.6, 49bis, 51.1, 51bis.1, 53.4, 53.7, 56, 60.1, 60.2, 61.1, 61.2, 73.2, 76.5, 76.6, 89bis (title), 89bis.3, 90.2, 90.4, 90bis.5, 92bis.1, 93bis, Schedule of Fees)

48. For details of the prior consideration by the Assembly, the Committee and the Working Group of the proposed amendments of the Regulations related to the concept and operation of the designation system (automatic indication of all designations and elections possible under the PCT; "flat" international filing fee; "communication on request" system), see documents PCT/R/1/2 (Annex, page 3, item (1)); PCT/R/1/26 (paragraph 69); PCT/A/30/7 (paragraph 23); PCT/R/WG/1/1, 7 and 9 (paragraphs 11 to 19); PCT/R/WG/2/2 and 12 (paragraphs 5 to 25); and PCT/R/2/6 and 9 (paragraphs 51 to 89).

Automatic indication of all designations possible under the PCT

49. *All-inclusive coverage*. By filing an international application, the applicant would obtain an automatic and all-inclusive coverage of all designations available under the Treaty, including all kinds of protection as well as both national and regional patent protection, without needing, at the time of filing the application, to designate individual Contracting States, to choose certain kinds of protection or to indicate expressly whether national or regional protection is sought. Such matters would be left to be dealt with in the national phase.

50. *Limited exclusions under transitional reservation provision*. The request form would include a box enabling applicants to exclude from the automatic and all-inclusive coverage any Contracting State which had made use of a transitional reservation provision applicable to certain States whose national law provides for the automatic withdrawal of an earlier international application if a later international application claimed priority of that earlier international application and designated the country concerned ("self-designation").

51. *Kind(s) of protection sought*. The ability to specify certain kinds of protection sought in particular designated States would be deferred until entry into the national phase in the States concerned; if no such specification is made at that stage, the international application would be treated as an application for the grant of a patent (only). Note that, as agreed by the Committee (see document PCT/R/2/9, paragraph 63), further amendments of new Rules 49bis.1(e) and 49bis.2(b) are proposed in Annex II. Applicants could still mention in the request, for the purposes of international search, details concerning a parent application in case of a continuation or continuation-in-part or concerning a parent application or parent grant in other cases.

52. *Withdrawal of designations*. Under the proposals, the applicant could, as at present, withdraw individual designations.

53. *Signatures; indications concerning applicants*. The present requirements in respect of signatures and indications in respect of applicants under Rules 4.5 and 4.15 would be maintained. However, in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide such signatures and certain indications (address, nationality, residence) in respect of all applicants (where there are two or more), it would be sufficient that the request be signed by at least one applicant and that those indications be provided in respect of at least one applicant who is entitled under Rule 19 to

file the international application with the receiving Office concerned. However, designated Offices would be permitted to require, in the national phase, the signature and required indications in respect of any applicants who had not provided them in the international phase.

54. *Powers of attorney*. Whereas one applicant is represented by an agent, or where all co-applicants are represented by a common agent or a common representative, the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the International Bureau would be entitled to waive the requirement that a separate power of attorney be submitted. It would be for the Office, the Authority or the International Bureau, as the case may be, to decide in what circumstances the requirement would be waived. The Office, the Authority or the International Bureau would be permitted to require a separate power of attorney in particular instances even if it had waived the requirement in general. The signature of all applicants would, however, be mandatory in the case of a withdrawal under Rule 90 *bis* or a change in the person of the applicant under Rule 92 *bis*.

Automatic indication of all elections possible under the PCT

55. *All-inclusive coverage*. The same concept as for designations would be applied to elections under Chapter II; all eligible States would be considered to have been elected. The Rules containing express provisions regulating the procedure for making "later elections" would be deleted as unnecessary, although the theoretical possibility of making later elections, as envisaged by Article 31(4)(a) and (6)(b), would not be excluded.

56. *Signatures; indications concerning applicants*. Safeguards corresponding to those provided in relation to the request (see paragraph 53, above) would be added in relation to the signature, and to the indications in respect of the applicant, required in relation to the demand.

57. *Withdrawal of elections*. Under the new approach, as at present, the applicant would be able to withdraw any or all elections.

Change in fee structure

58. *Flat "international filing fee"; elimination of basic fee and designation fees*. The concept of designation fees payable in addition to the basic fee would be eliminated; instead, a flat "international filing fee" would be introduced, which would include the prescribed fee for every designation referred to in Article 4(2).

59. *Amount of international filing fee*. It is to be noted that, as a consequence of the change in the fee structure, a new international filing fee would have to be fixed, the amount of which would need to 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.

60. In this context, it is also to be noted that, for the biennium 2002-2003, average fees were estimated on the basis of a reduction in the maximum number of designation fees payable from 6 to 5 as of January 1, 2002, and from 5 to 4 as of January 1, 2003, as outlined in paragraph 347 of document WO/PBC/4/2. The reduction in the maximum number of designation fees payable to 5 as of January 1, 2002, was approved by the Assembly at its thirtieth (13th ordinary) session held from September 24 to October 3, 2001 (see documents PCT/A/30/1 and 7).

61. With regard to the envisaged reduction in the maximum number of designation fees payable to 4 as of January 1, 2003, as a consequence of the change in the fee structure which would enter into force on January 1, 2004, it is now proposed not to change the level of PCT fees for 2003. Rather, it is proposed that, in 2003, in the context of the necessary determination of the amount of the new international filing fees as referred to in paragraph 59, above, a complete review of the entire fee structure and possible reductions of fees should be undertaken in the course of preparing the program and budget of WIPO for 2004-2005, taking into account possible further changes to the fee structure (see, for example, paragraph 62, below) and possible further fee reductions, for example, in relation to international applications filed in electronic form using the PCT-SAFE software.

62. In the context of a review of the entire fee structure, it may be worthwhile to consider whether the handling fee under Rule 57, which is for the benefit of the International Bureau for its work related to the processing of international applications under Chapter II, should also be included in the "flat" international filing fee, in which case further amendments of the Regulations would be required.

63. *Late furnishing fee; late payment fee*. With regard to the amount of the late furnishing fee under proposed Rule 12.4(e), the Committee agreed to recommend to the Assembly that that fee 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 (see document PCT/R/2/9, paragraph 97). Without prejudice to the determination of the amount of the international filing fee referred to in paragraph 60, above, upon further reflection, that percentage appears to be too high and would result in a late furnishing fee which would be much higher than the late furnishing fee under present Rule 12.3(e) (50% of the basic fee). It is thus proposed to fix the late furnishing fee under Rule 12.3(e) as proposed to be amended and proposed new Rule 12.4(e) as well as the late payment fee under Rule 16 bis.2(b) at 25% of the international filing fee. Rules 12.3(e), 12.4(e) and 16 bis.2(b) are proposed to be further amended accordingly in Annex II. Note further that new Rule 12.4(e), which is proposed to enter into force on January 1, 2003, is proposed to be further amended in Annex I so as to refer to the "basic fee" instead of the "international filing fee", consequential on the fact that the latter fee will only be introduced by the amendments proposed to enter into force on January 1, 2004.

"Communication on request" system

64. *Communication of documents*. The present system of "systematic communication" to a designated Office of all documents relating to international applications designating that Office would be replaced by a "communication on request" system, under which documents would be communicated to a designated Office only upon request by the Office and at the times specified by it. While it would still be possible for a designated Office to request the communication of a class or classes of documents, it would be expected that most Offices would request communications only in relation to international applications which have actually entered the national phase before them. Note that a further amendment of Rule 76.5 is proposed in Annex II so as to clarify that Rule 47.1 is also applicable in relation to elected Offices.

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS (see Annex I, Rules 12.1, 12.2, 12.4, 22.1, 26.3, 29.1, 48.3)

65. See document PCT/A/31/5 as to the question of consistency of the PCT with the language-related filing date requirements of the PLT.

Translation of the international application for the purposes of international publication

66. For details of the prior consideration by the Committee and the Working Group of the proposed amendments of the Regulations related to the translation of the international application for the purposes of international publication, see documents PCT/R/WG/1/8; PCT/R/WG/2/5, 5 Add. 1 and 12 (paragraphs 28 to 30); and PCT/R/2/3 and 9 (paragraphs 94 to 97). 90

67. At present, where the international application is filed in a language which is accepted by the receiving Office and by the International Searching Authority that is to carry out the international search but is not a language of publication, it is the International Searching Authority which is responsible for the establishment of a translation of the international application into English (see present Rule 48.3(b)).² In practice, it is normally the applicant who prepares the translation and furnishes it to the International Searching Authority. However, if the applicant does not do so, the International Searching Authority must prepare the translation itself. Although the Authority may charge a fee for preparing the translation (see present Rule 48.3(b), second sentence), this creates extra work for the Authority. In addition, in some cases the Authority is unable to recover the cost of preparing the translation, since there is no sanction if the applicant fails to pay the fee for the translation. The preparation of a translation appears to be a matter which should properly be the responsibility of the applicant.

68. It is proposed to amend the Regulations so as to require the applicant, rather than the International Searching Authority, to furnish the required translation and to introduce a sanction if the applicant fails to do so. Under the proposals, the applicant would be required to furnish to the receiving Office a translation of the international application into any language of publication which the receiving Office would be prepared to accept for that purpose.

Language of the request

69. For details of the prior consideration by the Committee and the Working Group of the proposed amendments of the Regulations related to the language of the request, see documents PCT/R/WG/2/12 (paragraph 30); and PCT/R/2/3 (paragraphs 15 to 17) and 9 (paragraphs 90 and 98 and 99).

² At present, this is the case, in practice: (i) where the international application is filed in Dutch with the Netherlands Industrial Property Office or the Belgium Industrial Property Office and the European Patent Office as International Searching Authority carries out international search (in Dutch); (ii) where the international application is filed with the Danish Patent and Trademark Office in Danish, Norwegian or Swedish, with the Finnish National Board of Patents in Finnish or Swedish, the Icelandic Patent Office in Danish, Norwegian or Swedish, the Norwegian Patent Office in Norwegian, or the Swedish Patent Office in Danish, Finnish, Norwegian or Swedish, and the Swedish Patent Office as International Searching Authority carries out the international search (in Danish, Finnish, Norwegian or Swedish); and (iii) where the international application is filed with the Korean Intellectual Property Office in Korean and that Office as International Searching Authority carries out international search (in Korean).

70. Present Rule 12.1(c) requires that the request be in a language which is both a language accepted by the receiving Office for the purposes of filing international applications and a language of publication. If the request meets that requirement, the receiving Office is not entitled, having regard to Rules 12.3(b) and 26.3 *ter*(c), to require a translation of it, even though a translation of the remainder of the application may be required under Rule 12.3(a). This restriction may limit the capacity of some receiving Offices to adopt a more flexible approach in relation to the languages which it is prepared to accept for the purposes of Rule 12.1(a).

71. It is proposed to amend the PCT Regulations so as to allow a receiving Office to require a translation of the request part of an international application for the purposes of processing by it, even though it may be prepared to accept, for the purposes of according an international filing date, the filing of an international application ³ in any language.

72. Under the proposals, a receiving Office would be able to specify any language of publication which it accepts for the purposes of filing the request. This would enable receiving Offices to accept, for the purposes of according the international filing date, the filing of the international application ³ in any language while, at the same time, enabling it to limit the languages that it is prepared to accept for the purposes of filing of the request, and to require a translation of the request if not in such a language.

MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE (see Annex I, Rule 49.6)

73. For details of the prior consideration by the Committee and the Working Group of the proposed amendments of the Regulations related to reinstatement of rights after failure to comply with requirements for entering the national phase within the time limits under Articles 22 and 39(1), see documents PCT/R/WG/1/9 (paragraphs 21(v) and 24); PCT/R/WG/2/4 and 12 (paragraphs 50 to 52); and PCT/R/2/4 and 9 (paragraphs 100 to 110).

Presentsituation

74. If the applicant fails to perform the acts referred to in PCT Article 22 or 39(1) (generally, the furnishing of a translation of the international application and the payment of the national fee) before any designated or elected Office within the applicable time limit, the international application ceases to have the effect provided for in PCT Article 11(3) (that is, the effect of a regular national application) as far as that State is concerned, with the same consequences as the withdrawal of any national application in that State (see PCT Article 24(1)(iii)).

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

³ More precisely, the description and the claims; language defects in the request, the abstract and any text matter in the drawings are considered formal defects under PCT Rule 26.3 *ter*.

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

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

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

Patent Law Treaty (PLT)

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

Intervening rights of third parties

80. Note 12.10 on PLT Article 12 describes intervening rights of third parties as “the rights, if any, acquired by a third party for any acts which were started, or for which effective and serious preparations were started, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated” and the right of third parties to intervene (that is, to intervene in the matter of a request for the reinstatement of rights by furnishing, to the Office concerned, grounds for refusing such request). Noting that any such rights are, and remain, a matter for the national law applied by the designated or elected Office, there appears to be no need to expressly include a provision covering them in the PCT Regulations as was suggested in document PCT/R/WG/2/12, paragraph 51.

Amendments of the PCT Regulations

81. Noting that the PLT has not yet entered into force, it is proposed, as suggested in paragraph 24 of the first session summary, to incorporate into the PCT Regulations a provision with similar effect to PLT Article 12 and PLT Rule 13(2) so as to oblige all designated and elected Offices to provide for there in statement of rights of the applicant if the applicant has missed the applicable time limit under Article 22 or 39(1) for entry into the national phase in spite of due care required by the circumstances having been taken or, at the option of the designated or elected Office, where the delay was unintentional. Annex I to the present document contains specific proposals to amend the PCT Regulations accordingly. A transitional reservation provision is included, recognizing that some national laws will need to be amended to bring them into line with the PCT Regulations as proposed to be amended.

AVAILABILITY OF PRIORITY DOCUMENTS FROM DIGITAL LIBRARIES (*see Annex II, Rules 17.1 and 66.7*)

82. For details by the Committee and the Working Group of the proposed amendments of the Regulations related to the furnishing of priority documents, see documents PCT/R/WG/1/5; PCT/R/WG/2/3 and 12 (paragraph 53); and PCT/R/2/5 and 9 (paragraphs 111 to 116).

83. It is proposed to amend the PCT Regulations so as to include provisions similar to those in the Patent Law Treaty (PLT) with regard to the possibility that priority documents may be available, in the future, from digital libraries.

84. *The Assembly is invited:*

- (i) *to adopt the amendments of the Regulations under the PCT as proposed in Annexes I and II;*
- (ii) *to agree, in connection with the adoption of the amendments of the Regulations under the PCT as proposed in Annex II, with the understandings outlined in paragraphs 11, 27, and 58 to 62, above.*

[Annexes follow]

ANNEXI

AMENDMENTS OF THE PCT REGULATIONS ¹
 PROPOSED TO ENTER INTO FORCE ON JANUARY 1, 2003 ²

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. A “clean” copy of the proposed amended provisions (without underlining or striking through) appears in document PCT/A/31/6Add.2.

² See paragraph 5 of the Introduction.

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 a language of publication which ~~is both a language accepted by~~ the receiving Office accepts for the purposes of this paragraph ~~under that paragraph and a language of publication~~.

(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 applications shall be in the language in which the application is filed, provided that:

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

(ii) [No change]

12.3 [No change]

12.4 *Translation for the Purposes of International Publication*

(a) Where the language in which the international application is filed is not a language of publication and no translation is required under Rule 12.3(a), the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into any language of publication which the receiving Office accepts for the purposes of this paragraph.

³ While the amendments of Rule 12 set out in this Annex (Annex I) would enter into force on January 1, 2003, further proposed amendments of Rule 12 set out in Annex II would enter into force on January 1, 2004 (see document PCT/A/31/6 Add.1).

[Rule 12.4, continued]

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

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

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]

(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]

⁴ While the amendments of Rule 26 set out in this Annex (Annex I) would enter into force on January 1, 2003, further proposed amendments of Rule 26 set out in Annex II would enter into force on January 1, 2004 (see document PCT/A/31/6Add.1).

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 Rules 12.3(d) or 12.4(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iv) [No change]

(b) [No change]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

⁵ While the amendments of Rule 29 set out in this Annex (Annex I) would enter into force on January 1, 2003, further proposed amendments of Rule 29 set out in Annex II would enter into force on January 1, 2004 (see document PCT/A/31/6 Add.1).

Rule 48⁶
International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) [No change]

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

~~(b) [Deleted] If the international application is filed in a language which is not a language of publication and no translation into a language of publication is required under Rule 12.3(a), that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the relevant portions of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.~~

(c) [No change]

48.4 to 48.6 [No change]

⁶ While the amendments of Rule 48 set out in this Annex (Annex I) would enter into force on January 1, 2003, further proposed amendments of Rule 48 set out in Annex II would enter into force on January 1, 2004 (see document PCT/A/31/6Add.1).

Rule 49
Copy, Translation and Fee Under Article 22

49.1 to 49.5 [No change]

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

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, notwithstanding Rule 82 and subject to paragraphs (b) to (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.

(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 (a) 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.

[Rule 49.6, continued]

(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 that 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 II follows]

ANNEXII

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. A “clean” copy of the proposed amended provisions (without underlining or striking through) appears in document PCT/A/31/6 Add.2.

² See paragraph 4 of the Introduction.

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Rule 4
The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) The request shall contain:

(i) to (iii) [No change]

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

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

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

(i) and (ii) [No change]

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

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

(iii) ~~(v)~~ a reference to a parent application or parent patent,

(iv) ~~(vi)~~ 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

[Rule 4.5(a), continued]

(iii) the nationality and residence

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

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.

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

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

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

(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 inform 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.

[Rule 4.9(b), continued]

~~The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:~~

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

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

~~(e) [Deleted] The confirmation of any designation made under paragraph (b) shall be effected by~~

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

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

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

4.10 [No change]

4.11 *Referenceto 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) ~~;~~ ~~or if~~

(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

[Rule 4.11(a), continued]

(iv) the applicant intend 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, contain a reference to that fact. Such reference shall either identify the application (or its translation, as the case may be) in respect of which the earlier search was made by indicating country, date and number, or otherwise identify the said search, by indicating, where applicable, date and number of the request for such 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] *Choice of Certain Kinds of Protection*~~

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

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

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

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

4.14 ~~[Deleted] *Continuation or Continuation-in-Part*~~

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

4.14bis to 4.18 [No change]

Rule 12³
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%⁴ ~~50%~~ of the international filing ~~basic~~ fee.

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%⁵ of the international filing fee.

³ These amendments are based on the text of Rule 12 as proposed to be amended, with effect from January 1, 2003, in Annex I of this document.

⁴ See paragraph 63 of the Introduction.

⁵ See paragraph 63 of the Introduction.

Rule 15
The International Filing Fee

15.1 *The International Filing Basic Fee and Designation Fee*

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau ("international filing fee") to be collected by the receiving Office ~~and consisting of,~~

~~(i) a "basic fee," and~~

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

15.2 *Amounts*

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

(b) The international filing basic fee and the designation fees shall be payable in the currency or one of the currencies prescribed by the receiving Office ("prescribed currency"), it being understood that, when transferred by the receiving Office to the International Bureau, ~~it they~~ shall be freely convertible into Swiss currency. The amount amounts of the international filing basic fee and of the designation fees shall be established, for each receiving Office which prescribes the payment of ~~that those~~ fee ~~s~~ 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 ~~s~~ so established shall be the equivalent ~~s~~, in round figures, of the amount ~~s~~ in Swiss currency set out in the Schedule of Fees. ~~It They~~ shall be notified by the International Bureau to each receiving Office prescribing payment in that prescribed currency and shall be published in the Gazette.

(c) Where the amount amounts of the international filing fee ~~fees~~ set out in the Schedule of Fees ~~is are~~ changed, the corresponding amount ~~s~~ in the prescribed currencies shall be applied from the same date as the amount ~~s~~ 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 ~~s~~ in the prescribed currency according to directives given by the Assembly. The newly established amount ~~s~~ shall become applicable two months after the date of ~~its their~~ publication in the Gazette, provided that the receiving Office referred to in the second sentence of paragraph (b) and the Director General may agree on a date falling during the said two-month period, in which case the said amount ~~s~~ shall become applicable from that date.

15.3 *[Remains deleted]*

15.4 *Time Limit for Payment; Amount Payable*

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

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

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

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

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

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

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

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

15.6 *Refund*

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

(i) to (iii) [No change]

Rule16
TheSearchFee

16.1 *RighttoAskforaFee*

(a)to(e) [Nochange]

(f) Astothetimelimitforpaymentofthesearchfeeandtheamountpayable,the provisionsofRule15.4 ~~(a)~~relatingtothe [internationalfiling](#) ~~basie~~fee shallapply *mutatis mutandis*.

16.2 [Nochange]

Rule 16 bis
Extension of Time Limits for Payment of Fees

16 bis.1 Invitation by the Receiving Office

(a) Where, by the time they are due under Rules 14.1(c), 15.4 (a) and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing basic fee and the search fee, the receiving Offices 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] Where, by the time they are due under Rule 15.4(b), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Offices 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. The amount payable in respect of any designation fee shall be the amount applicable on the last day of the one year period from the priority date if the time limit under Rule 15.4(b)(i) applies or the amount applicable on the date of receipt of the international application if the time limit under Rule 15.4(b)(ii) applies.~~

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

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

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

(iii) proceed as provided in Rule 29.

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

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

16 bis.2 Late Payment Fee

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

[Rule 16bis.2(a), continued]

- (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%⁶ of the international filing base fee referred to in item 1 (a) of the Schedule of Fees , not taking into account any fee for each sheet of the international application in excess of 30 sheets.

⁶ See paragraph 63 of the Introduction.

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 paragraph (b) and (b -bis), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(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 requests 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~~ ~~neither~~ of the ~~three~~ ~~two~~ preceding paragraphs are complied with, any designated ~~Office~~ ~~State~~ may subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed within 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 ~~(a) to (e)~~ 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 notifications 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 notifications sent to the applicants shall also contain a list of the ~~States~~ designated Offices under ~~Rule 4.9(a)~~ and, in the case of a designated Office which is responsible for granting regional patents, of the Contracting States designated for such regional patent ~~where applicable, of those States whose designations have been confirmed under Rule 4.9(c)~~.

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

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

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

(c) [No change]

Rule 26⁷
**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]

⁷ These amendments are based on the text of Rule 26 as proposed to be amended, with effect from January 1, 2003, in Annex I of this document.

Rule 27
Lack of Payment of Fees

27.1 *Fees*

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

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

Rule 29⁸

International Applications ~~or Designations~~ Considered Withdrawn

29.1 *Finding by Receiving Office*

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

(i) to (iv) [No change]

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

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

⁸ These amendments are based on the text of Rule 29 as proposed to be amended, with effect from January 1, 2003, in Annex I of this document.

Rule 32
Extension of Effects of International Application to
Certain Successor States

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

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

(b) [No change]

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

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

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

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

32.2 *Effects of Extension to Successor State*

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

(i) [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 ~~three~~ months from the date of the publication of the information under Rule 32.1(c) ~~request for extension~~.

[Rule 32.2, continued]

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

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

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 43 bis
Written Opinion of the International Searching Authority

43 bis.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 insofar as checked by the International Searching Authority.

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

(b) For the purposes of establishing the written opinion, Article 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 opinions shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinions shall, under Rule 66.1 bis(a) but subject to Rule 66.1 bis(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 54 bis.1(a), a written reply together, where appropriate, with amendments.

Rule44
TransmittaloftheInternationalSearchReport, WrittenO pinion,Etc.

44.1 *CopiesofReportorDeclaration* andWrittenOpinion

TheInternationalSearchingAuthorityshall,onthesameday,transmitonecopyofthe internationalsearchreport andthewrittenopinionestablishedunderRule43 bis.1,or ofthe declarationreferredtoinArticle17(2)(a) .totheInternationalBureauandonecopytothe applicant.

44.2 and 44.3 [Nochange]

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 44bis.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 requirements 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.

[Rule 44bis.3, continued]

(d) In the case referred to in Rule 44bis.2(b), the written opinion established under Rule 43bis.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 44bis.3(b) or (d) and shall send a copy of the observations to each of the interested designated Offices and to the International Bureau.

Rule44 ter
ConfidentialNatureofW rittenOpinion,Report,TranslationandObservations

44ter.1 ConfidentialNature

(a) TheInternationalBureauandtheInternationalSearchingAuthorityshallnot,unless requestedorauthorizedbytheapplicant,allowaccessbyanypersonorauthority beforethe expirationof30monthsfromtheprioritydate:

(i) tothewrittenopinionestablishedunderRule43 bis.1,toanytranslationthereof preparedunderRule44 bis.3(d)orRule 72.2bis,ortoanywrittenobservationsonsuch translationsentbythe applicantunderRule 44bis.4orRule 72.3;

(ii) ifareportisissuedunderRule44 bis.1,tothatreport,toanytranslationofit preparedunderRules44 bis.3(b)or62 bis.1(a)ortoanywrittenobservationsonthat translationsentbytheapplicantunde rRule 44bis.4.

(b) Forthepurposesofparagraph(a),theterm“access”coversanymeansbywhich thirdpartiesmayacquirerecognizance,includingindividualcommunicationandgeneral 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 at the time of the communication provided for in Article 20, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. ~~Such notifications shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.~~

(a-ter) [No change]

(b) ~~Such communications shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date.~~ Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication 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 to 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.

~~Such notices shall be sent on the same day as the communication. Each designated Office shall be informed, separately from the communication, about the sending and the date of mailing of the notice. The notices shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the dates specified in the notice.~~

(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 dates specified in the notice;

[Rule 47.1(c -bis), continued]

(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 93bis.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. ~~Where any designated Office has waived the requirement provided under Article 20, the copies of the documents which otherwise would have been sent to that Office shall, at the request of that Office or the applicant, be sent to the applicant at the time of the notice referred to in paragraph (e).~~

47.2 Copies

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

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

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

47.3 [No change]

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

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

Rule 48⁹
International Publication

48.1 to 48.5 [No change]

48.6 *Announcing of Certain Facts*

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

(b) [Remains deleted]

(c) [No change]

⁹ These amendments are based on the text of Rule 48 as proposed to be amended, with effect from January 1, 2003, in Annex I of this document.

Rule 49 bis
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 49 bis.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.

Rule51
ReviewbyDesignatedOffices

51.1 *TimeLimitforPresentingtheRequesttoSendCopies*

The timelimitreferredtoinArticle25(1)(c)shallbetwomonthscomputedfromthe dateofthenotificationsenttotheapplicantunderRules 20.7(i),24.2(c) or29.1 ~~(a)~~(ii); ~~or 29.1(b)~~.

51.2and51.3 [Nochange]

Rule 51 bis
Certain National Requirements Allowed Under Article 27

51 bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51 bis.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]

51 bis.2 and 51 bis.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 ~~other~~ 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*. ~~Only applicant for the elected States are required to be indicated in the demand.~~

53.5 and 53.6 [No change]

53.7 *Election of States*

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

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

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

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

53.8 and 53.9 [No change]

Rule 54 bis
Time Limit for Making a Demand

54 bis.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 43 bis.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 Later Elections

~~56.1—Elections Submitted Later than the Demand—~~

~~(a) The election of a State subsequent to the submission of the demand (“later election”) shall be effected by a notice submitted to the International Bureau. The notice shall identify the international application and the demand, and shall include an indication as referred to in Rule 53.7(b)(i).~~

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

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

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

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

~~(d) An applicant for a State elected by a later election need not have been indicated as an applicant in the demand.~~

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

~~(f) If, notwithstanding paragraph (a), a notice effecting a later election is submitted by the applicant to the International Preliminary Examining Authority rather than the International Bureau, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.~~

~~56.2—Identification of the International Application—~~

~~The international applications shall be identified as provided in Rule 53.6.~~

~~56.3 Identification of the Demand~~

~~The demand shall be identified by the date on which it was submitted and by the name of the International Preliminary Examining Authority to which it was submitted.~~

~~56.4 Form of Late Elections~~

~~The notice effecting the late elections shall preferably be worded as follows: "In relation to the international application filed with... on... under No.... by... (applicant) (and the demand for international preliminary examinations submitted on... to...), the undersigned elects the following additional State(s) under Article 31 of the Patent Cooperation Treaty:..."~~

~~56.5 Language of Later Elections~~

~~The late elections shall be in the language of the demand.~~

Rule 57
The Handling Fee

57.1 and 57.2 [No change]

57.3 *Time Limit for Payment; Amount Payable*

(a) Subject to paragraphs (b) and (c), the ~~The~~ handling fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later ~~. provided that,~~

(b) Subject to paragraph (c), where ~~Where~~ the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the handling fee shall be paid within one month from the date of receipt by that Authority or 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 ~~that date of submit~~ ~~al or date of receipt, as the case may be. For the purposes of the preceding two sentences, Rule 59.3(c) shall not apply~~.

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 54 bis.1(b), not to have been submitted.

Rule 58 bis
Extension of Time Limits for Payment of Fees

58 bis.1 Invitation by the International Preliminary Examining Authority

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

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

(ii) by the time they are due under Rules 57.3 and 58.1(b), 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 58 bis.2, within a time limit of one month from the date of the invitation.

(b) to (d) [No change]

58 bis.2 [No change]

Rule 59
The Competent International Preliminary Examining Authority

59.1 and 59.2 [No change]

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

(a) and (b) [No change]

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

(i) [No change]

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

(d) to (f) [No change]

Rule 60
Certain Defects in the Demand or Elections

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] *Defects in Later Elections*~~

~~(a) If a notice effecting a later election does not comply with the requirements of Rule 56, the International Bureau 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 Bureau at any time before a decision is taken.~~

~~(b) If the applicant complies with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had been received on the actual filing date, provided that the notice as submitted contained at least one election and permitted the international application to be identified; otherwise, the notice shall be considered as if it had been received on the date on which the International Bureau receives the correction.~~

~~(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted and the International Bureau shall so declare.~~

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

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] The International Bureau shall promptly notify the applicant of the receipt, and the date of receipt, of any notice effecting a later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b). Where the notice has been considered under Rule 60.2(c) as if it had not been submitted or where a later election has been considered under Rule 60.2(d) as if it had not been made, the International Bureau shall notify the applicant accordingly.~~

61.2 Notification to the Elected Offices

(a) [No change]

(b) The notifications 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 ~~and, and in the case of a later election the date of receipt of the notice effecting the later election. The latter dates shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b).~~

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

61.3 [No change]

61.4 Publication in the Gazette

~~Where a demand has been filed before the expiration of 19 months from the priority date, the~~ 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 Written Opinion by 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, ~~to that Authority~~, unless that Authority has indicated that it has already received
such a copy.

62.2 [No change]

Rule 62 bis
Translation for International Preliminary Examining Authority
of Written Opinion of 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.

Rule63
MinimumRequirementsfor
InternationalPreliminaryExaminingAuthorities

63.1 DefinitionofMinimumRequirements

TheminimumrequirementsreferredtoinArticle32(3)shallbethefollowing:

(i) and(ii) [Nochange]

(iii) that Officeororganizationmusthaveastaffwhichiscapableofexaminingin therequiredtechnicalfieldsandwhichhasthelanguagefacilitiestounderstandatleastthose languagesinwhichtheminimumdocumentationreferredtoinRule34iswrittenoris translated;

(iv) thatOfficeororganizationmustholdanappointmentasanInternational SearchingAuthority.

Rule 66
Procedure Before the International Preliminary Examining Authority

66.1 [No change]

66.1bis 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 Examination 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 ~~First~~ *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 ~~but~~ 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 ~~Document~~

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

(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 ~~both~~ of all of the following:

- (i) the demand; ~~and~~
- (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58 bis.2; and
- (iii) ~~of~~ 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 Examination 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 ~~competent International Preliminary Examining Authority is part of the same~~ national Office or intergovernmental organization that acts as the competent International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization the International Preliminary Examining Authority 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 5

[Rule 69.1(d), continued]

(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 54bis.1(a). ~~20 months from the priority date,~~

~~whichever occurs first.~~

(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~~ six ~~eight~~ months from the time provided under Rule 69.1 for the start of the international preliminary examination; ~~date of payment of the fees referred to in Rules 57.1 and 58.1(a),~~ or

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

~~whichever expires last.~~

Rule70

**InternationalPreliminary ReportonPatentabilityby
theInternationalPreliminaryExaminingAuthority**
~~The~~ (InternationalPreliminaryExaminationReport)

70.1to70.14 [Nochange]

70.15 *Form; Title*

(a) Thephysicalrequirementsastotheformofthereportshallbeprescribedbythe
AdministrativeInstructions.

(b) Thereportshallbearthetitle“ internationalpreliminaryreportonpatentability
(ChapterIIof thePatentCooperationTreaty) ”togetherwithanindicationthatitisthe
internationalpreliminaryexaminationreportestablishedbytheInternationalPreliminary
ExaminingAuthority.

70.16and70.17 [Nochange]

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

72.1 and 72.2 [No change]

72.2bis Translation of 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 ~~on what, in his~~
~~opinion, are errors of translation in~~ 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 any such~~ observation to each of
the interested elected Offices and ~~a copy~~ to the International Bureau.

Rule 73

**Communication of the International Preliminary Examination Report
on the Written Opinion of the International Searching Authority**

73.1 [No change]

73.2 ~~Time Limit for~~ 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. ~~The communication provided for in Article 36(3)(a) shall be effected as promptly as possible but not earlier than the communication under Article 20.~~

(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](#), [49 bis](#) and [51 bis](#)

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] *Transitional Provision*~~

~~If, on July 12, 1991, Rule 76.5(iv) is not compatible with the national law applied by the elected Office in respect of claims amended under Article 19, Rule 76.5(iv) shall not apply in that respect to that elected Office for as long as it continues not to be compatible with that law, provided that the said Office inform the International Bureau accordingly by~~

~~December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.~~

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

78.1 *Time Limit* ~~Where Election Is Effected Prior to Expiration of 19 Months from Priority Date~~

(a) ~~Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the~~ 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 ~~other~~ time if so permitted by the national law of the said State.

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

78.2 [Deleted] ~~Time Limit Where Election Is Effected After Expiration of 19 Months from Priority Date~~

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

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

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

89 bis.3 Communication ~~Transmittal~~ Between Offices

Where the Treaty, these Regulations or the Administrative Instructions provide for the
communication, notification or transmittal (“communication”) of an international application, _____
~~documents~~, notification ~~s~~, communication, ~~or~~ correspondence or other document ~~to be~~
~~transmitted~~ by one national Office or intergovernmental organization to another, such
communication ~~transmittal~~ 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) to (c) 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) to (c) 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

90bis.1 to 90bis.4 [Nochange]

90bis.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 ~~Where one of the applicants~~ 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 ~~, such notice shall, subject to paragraph (b), require the signature of all the applicants~~.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 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) [Nochange]

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

90bis.6 and 90.7 [Nochange]

Rule 92 bis
Recording of Changes in Certain Indications
in the Request or the Demand

92 bis.1 *Recording of Changes by the International Bureau*

(a) [No change]

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

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

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

Rule 93 bis
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 communications shall be effected only upon request by the Office concerned and at the times specified by that Office. Such request may be made in relation to individually specified documents or as specified 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 takes action to make 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.

Rule94
AccesstoFiles

94.1 *AccesstotheFile HeldbytheInternationalBureau*

(a) [Nochange]

(b) TheInternationalBureaushall,attherequestofanyersonbutnotbeforethe internationalpublicationoftheinternationalapplicationandsubjecttoArticle 38 [and Rule 44ter.1](#),furnish,subject tothereimbursementofthecostoftheservice,copiesofany documentcontainedinitsfile.

(c) TheInternationalBureaushall,ifsorequestedbyanelectedOffice,furnishcopies oftheinternationalpreliminaryexaminationreportunderparagraph(b)onbehalfofthat Office.TheInternationalBureaushallpromptlypublishdetailsofanysuchrequestinthe Gazette.

94.2 and94.3 [Nochange]

SCHEDULE OF FEES

Fees	Amounts
1. <u>International Filing Basic Fee:</u> (Rule 15.2 (a))	[...] ¹⁰ <u>650 Swissfrancs plus 15 Swissfrancs for each sheet of the international application in excess of 30 sheets</u>
(a) if the international application contains not more than 30 sheets	650 Swissfrancs
(b) if the international application contains more than 30 sheets	650 Swissfrancs plus 15 Swissfrancs 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 Swissfrancs per designation provided that any designation made under Rule 4.9(a) in excess of 6 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c) *	140 Swissfrancs per designation
<u>3.</u> Handling Fee: (Rule 57.2 (a))	233 Swissfrancs

Reductions

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

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

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

[End of Annex II and of document]

¹⁰ See paragraph 59 of the Introduction.