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ASSEMBLY

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MATTERS CONCERNING THE PCT UNION
(PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS)

Document prepared by the International Bureau

INTRODUCTION

1. The present document contains proposals for entry into force and transitional arrangements in relation to the amendments of the Regulations under the Patent Cooperation Treaty (PCT)¹ contained in Annexes I and II of document PCT/A/31/6.
2. The Committee, at its second session, discussed the question of the entry into force of the proposed amendments and also discussed the need for transitional arrangements in two respects (see paragraphs 126 to 132 of document PCT/R/2/9, reproduced in document PCT/A/31/5):

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.

(i) in relation to international applications which are pending on the date of entry into force of the amended Regulations; and

(ii) in relation to the operation of the amended Regulations to different national Offices in their capacities as designated and deleted Offices under the PCT, bearing in mind that not all Offices as yet apply the modified time limit under Article 22(1) adopted by the Assembly in 2001.

3. The implementation of the proposed amendments relating to the enhanced international search and preliminary examinations system, 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 revisions to the Administrative Instructions (including the Forms annexed thereto), the guidelines for international search and international preliminary examination and the PCT Applicant's Guide will be needed. 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. A similar conclusion may be reached in relation to the proposed amendments relating to the availability of priority documents from a digital library, noting that it seems very unlikely that the systems for making priority documents available from digital libraries will be in place before January 1, 2004. Those amendments are set out in Annex II to document PCT/A/31/6.

4. On the other hand, the proposed amendments (set out in Annex II to document PCT/A/31/6) relating to the language of the international application and translations as well as reinstatement of rights after failure to comply with requirements for entering the national phase within the applicable time limit, 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.

5. In connection with paragraph 2(ii), above, it is recalled that the Assembly decided, at its 30th session held from September 24 to October 3, 2001, to modify the time limit under Article 22(1) to be the same as that applicable under Article 39(1)(a), namely, 30 months from the priority date (see document PCT/A/30/7, paragraph 49(i) and Annex II). In making the necessary modifications of Article 22(1), the Assembly adopted, *inter alia*, the following decisions (see document PCT/A/30/7, paragraph 49(ii) and Annex IV):

“(1) The modifications of the time limits fixed in Article 22(1) set out in Annex II shall, subject to paragraphs (2) and (3), enter into force on April 1, 2002. The modifications shall apply, so far as any designated Office is concerned, to any international application in respect of which the period of 20 months from the priority date expires on or after the date on which the modifications enter into force in respect of that Office and in respect of which the acts referred to in Article 22(1) have not yet been performed by the applicant.

“(2) If, on October 3, 2001, any such modification is not compatible with the national law applied by a designated Office, it shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office notifies the International Bureau accordingly by January 31, 2002. The notification shall be promptly published by the International Bureau in the Gazette.

“(3) Any notification sent to the International Bureau under paragraph (2) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette and the modifications shall enter into force two months after the date of such publication or on such earlier or later date as may be indicated in the notice of withdrawal.

“(4) It is recommended that any Contracting State whose national law is not compatible with the modification take urgent action to amend its law to make it compatible so that a notification does not have to be given under paragraph (2) or, if such a notification must be given, so that it can be withdrawn under paragraph (3) as soon as possible thereafter.”

6. As of January 31, 2002, 24 Offices sent such “transitional reservation” notification to the International Bureau. By the date of the present document, a small number of those notifications had been withdrawn, but most were still in effect. It appears likely that not all will have been withdrawn by the time that the amendments proposed in document PCT/A/31/6, if adopted by the Assembly, come into effect.

7. Further details concerning the proposed dates of entry into force of the amendments as proposed in document PCT/A/31/6, and the proposed transitional arrangements in relation to international applications which are pending at the dates of entry into force of those amendments, are set out in the following paragraphs. In the interest of clarity for applicants, Offices and third parties, it is proposed that, in general, the amended Rules should not apply to those pending applications. Special transitional arrangements are considered, however, in the following two circumstances:

(i) where the existing Rules (before amendment) would have to be applied for an unduly long period after the date of entry into force of the amendments;

(ii) where the amended Rules offer applicants a practical benefit which is so significant, for example, by way of avoiding loss of rights, that it should be applied to pending as well as new applications.

AMENDMENTS PROPOSED TO ENTER INTO FORCE ON JANUARY 1, 2003; TRANSITIONAL ARRANGEMENTS

8. As already indicated in the preceding paragraphs, it is proposed that the amendments set out in Annex I to document PCT/A/31/6 (which relate to the language of the international application and translations and to the missed time limit for entering the national phase) should enter into force on January 1, 2003.

9. It is also proposed that the amendments set out in Annex I to document PCT/A/31/6 should apply to all international applications whose international filing date is on or after January 1, 2003.

10. It is further proposed that the amendments set out in Annex I to document PCT/A/31/6 should not, in general, apply to international applications whose international filing date is before January 1, 2003. However, the following special transitional provisions appear to be warranted:

(i) new Rule 49.6, relating to reinstatement of rights in certain cases where the applicant fails to enter the national phase on time, should apply to international applications whose international filing date is before January 1, 2003, in respect of which the applicable time limit under Article 22 expires on or after January 1, 2003;

(ii) to the extent that new Rule 49.6 would be applicable by virtue of Rule 76.5, the latter Rules should apply to international applications whose international filing date is before January 1, 2003, in respect of which the applicable time limit under Article 39(1) expires on or after January 1, 2003.

11. It should be noted that the transitional provisions referred to in paragraph 10, above, would be applicable in respect of all designated and elected Offices, whether or not they have, as designated Offices, made a transitional reservation referred to in paragraphs 5 and 6, above, in relation to the modification of the time limit under Article 22(1), and that no special provision is needed in this respect.

AMENDMENTS PROPOSED TO ENTER INTO FORCE ON JANUARY 1, 2004; TRANSITIONAL ARRANGEMENTS

12. As already stated, it is proposed that the amendments set out in Annex II to document PCT/A/31/6 (which relate to the enhanced international search and preliminary examination system, 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, and to the availability of priority documents from a digital library) should enter into force on January 1, 2004.

13. It is proposed that the amendments set out in Annex II to document PCT/A/31/6 should, in general, apply to all international applications whose international filing date is on or after January 1, 2004. However, the following special transitional provisions appear to be warranted:

(i) where an international application is received by the receiving Office before January 1, 2004, but is accorded an international filing date that is on or after January 1, 2004, the fees payable in relation to that application should be those due on the date of receipt; that is, Rule 15.4 and the Schedule of Fees (providing for the payment of an international fee comprising the basic fee plus designation fees) should continue to apply to such applications;

(ii) where a designated Office has made (and not withdrawn) a transitional reservation referred to in paragraphs 5 and 6, above, Rule 47.1(c) and (e) as amended would not be appropriately worded so far as that designation is concerned; this difficulty can be removed, however, by providing for two notices to be sent under Rule 47.1(c), the first being sent at 19 months from the priority date (in relation to designated Offices of the kind just mentioned) and the second at 28 months from the priority date (in relation to other designated Offices).

14. It is proposed that the amendments set out in Annex II to document PCT/A/31/6 should not, in general, apply to international applications whose international filing date is before January 1, 2004. However, the following special transitional provisions appear to be warranted:

(i) the amended Rules relating to the automatic indication of all elections possible when filing a demand for international preliminary examination (Rules 53.4, 53.7, 56, 60.1, 60.2, 61.1, 61.2 and 90 *bis*.5(b), as well as the Rules referred to in those Rules) should apply in relation to all demands for international preliminary examination filed on or after January 1, 2004, including those filed in respect of international applications whose international filing date is before January 1, 2004;

(ii) new Rule 94.1(c), relating to the availability to third parties of a copy of the international preliminary examination report from the International Bureau (on behalf of an elected Office), should apply in relation to all requests for the furnishing of a copy of the international preliminary examination report that are made on or after January 1, 2004, including those made in respect of international applications whose international filing date is before January 1, 2004.

15. It would be possible to make further exceptions which might be seen as appropriate from the theoretical point of view, for example, in relation to the preparation of written opinions by the International Searching Authority under proposed new Rule 43 *bis* in the case of an international application whose international filing date is before January 1, 2004, where the International Searching Authority has not yet started to prepare the international search report. However, any practical advantages which might arise from such special transitional provisions would appear to be outweighed by the confusion which would be likely to result.

16. In the example just given, such confusion would be very likely to arise in the event that the International Searching and Preliminary Examining Authorities were to introduce new fee amounts in connection with the enhanced international search and preliminary examination procedure. In practice, if the applicant files a demand for international preliminary examination, there will be little practical difference whether the written opinion is labeled as having been prepared by the International Searching Authority or the International Preliminary Examining Authority, and the first written opinion could be prepared by the examiner who carried out the international search and adopted by the examiner who carries out the international preliminary examination.

17. No further special provision seems to be needed, in addition to the one proposed in paragraph 13(ii), above, with regard to the amendments proposed in Annex II of document PCT/A/31/6 in respect of any designated Office that has made (and not withdrawn) a transitional reservation referred to in paragraphs 5 and 6, above, in relation to the modification of the time limit under Article 22(1). In the case of an international application whose international filing date is on or after January 1, 2004, a first written opinion would be established by the International Searching Authority under new Rule 43 *bis*, and either an international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) would be issued under Rule 44 *bis*.1(b) or an international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) would be issued under Rule 70.15(b). It should be noted that, if the applicant enters the national phase under Chapter I before such a designated Office, the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) would be communicated to that Office, but *not* before the expiration of 30 months from the priority date (see Rule 44 *bis*.2(a) as proposed to be amended).

Draft Decision by the Assembly

18. A draft text of decisions which are proposed to be adopted by the Assembly in adopting the amendments set out in Annexes I and II of document PCT/A/31/6 is set out in the Annex to the present document.

19. The Assembly is invited to consider and adopt the proposed draft decisions as contained in the Annex to this document, relating to entry into force and transitional arrangements, in respect of the proposed amendments of the Regulations as set out in Annexes I and II to document PCT/A/31/6.

[Annex follows]

ANNEX

PROPOSED DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

1. The amendments set out in Annex I to document PCT/A/31/6:

(a) shall enter into force on January 1, 2003, and shall apply to any international application whose international filing date is on or after January 1, 2003;

(b) shall not apply to any international application whose international filing date is before January 1, 2003, provided that:

(i) new Rule 49.6 shall apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 22(1) expires on or after January 1, 2003;

(ii) to the extent that new Rule 49.6 is applicable by virtue of Rule 76.5, the latter Rules shall apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 39(1)(a) expires on or after January 1, 2003.

2. The amendments set out in Annex II to document PCT/A/31/6:

(a) shall enter into force on January 1, 2004, and shall apply to any international application whose international filing date is on or after January 1, 2004, provided that:

(i) Rule 15.4 and the Schedule of Fees as worded before their amendments shall continue to apply to any international application which is received by the receiving Office before January 1, 2004, and is accorded an international filing date that is on or after January 1, 2004;

(ii) Rule 47.1(c) and (e) as amended shall apply to any international application whose international filing date is on or after January 1, 2004, in respect of a designated Office which has made a notification under paragraph (2) of the decisions of the Assembly set out in Annex IV of document PCT/A/30/7, and which has not withdrawn that notification under paragraph (3) of those decisions, as though the reference in each of Rule 47.1(c) and (e) to "28 months" was a reference to "19 months," with the consequence that two notifications under Rule 47.1(c) shall, if applicable, be sent in respect of such an application;

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

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

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

[End of Annex and of document]