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MATTERS CONCERNING THE PCT UNION
(PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
CHANGES AND CLARIFICATIONS OF DOCUMENTS PCT/A/31/6, Add. 1, Add. 2)

Document prepared by the International Bureau

INTRODUCTION

1. The present document sets out a number of minor changes and clarifications of the text of the Introduction to document PCT/A/31/6 and to the proposed amendments of the Regulations under the PCT that are contained in the Annexes to document PCT/A/31/6. It also sets out certain minor changes and clarifications of the contents of document PCT/A/31/6 Add. 1 (concerning entry into force and transitional arrangements) and document PCT/A/31/6 Add. 2 (containing a "clean" copy of the proposed amended provisions).
2. The changes and clarifications are set out and explained in the following paragraphs. Where a change to the text of a provision is made, the place in the text where the change has been made is marked by a box and there is a note for the change explained in a comment.

DOCUMENT PCT/A/31/6 (INTRODUCTION)

3. In the last sentence of *paragraph 29* of the Introduction to document PCT/A/31/6, the reference to Rule "73.2 bis" is erroneous and should be to Rule "72.2bis."

4. In thesecond sentenceof *paragraph41* oftheIntroductiontodocumentPCT/A/31/6, theerroneousreferenceto“theIPRP(ChapterII)bytheISA”shouldcorrectlyreferto“the IPRP(ChapterI)bytheISA”andtheerroneousreferenceto“theIPRP(ChapterI)bythe IPEA”shouldcorrectlyreferto“theIPRP(ChapterII)bytheIPEA.”

5. Inthelastsentenceof *paragraph51* oftheIntroductiontodocumentPCT/A/31/6,itis saidthatapplicants“could”mentionintherequestdetailsconcerningparentapplicationsor grantsincertaincases.Bywayofcorrection,itispointedoutthat,underproposedamended *Rule4.11(a)* (seedocumentPCT/A/31/6,AnnexII,pages8to9),suchdetailsare *required* to beindicatedinthecircumstancespecifiedinthatRule.Thosedetailsareneededduringthe internationalphaseforthepurposesoftheinternationalsearch,buttheyarenotrequiredfor thepurposesofthenationalphase –that is,formakingachoiceastothekindofprotection sought –untilthetimeofentryintothenationalphase(see proposedamendedRules4.9 and 4.11(b)).

6. Inthelastsentenceof *paragraph54* oftheIntroductiontodocumentPCT/A/31/6,the words“orachangeinthepersonoftheapplicantunderRule92 *bis*”shouldbedeleted.

DOCUMENTPCT/A/31/6(ANNEXI)

7. Itisproposedtoincludeanamendmentof *Rule12.3(e)* (seedocumentPCT/A/31/6, AnnexI,page3)asfollows:

“(e) Thefurnishingofatranslationaftertheexpirationofthetimelimitunder paragraph(a)maybesubjectedbythereceivingOfficetothe paymenttoit,foritsown benefit,ofalatefurnishingfeeequalto50%ofthebasicfee [referred to in item 1\(a\) of the Schedule of Fees](#).”

Comment:Thechangeclarifiesthemethodofcalculationofthelatefurnishingfee. Paragraph63oftheIntroductiontodocumentPCT/A/31/6shouldbeunderstoodsubjectto thesameclarification.

8. Thetextofproposednew *Rule12.4(e)* (seedocumentPCT/A/31/6,AnnexI,page3)is changedtoreadasfollows:

“(e) [Thefurnishingofatranslationaftertheexpirationofthetimelimitunder paragraph \(a\)maybesubjectedbythereceivingOfficetothe paymenttoit,foritsown benefit,ofalatefurnishingfeeequalto50%ofthebasicfee](#) [referred to in item 1\(a\) of the Schedule of Fees](#).”

Comment:Thechangeclarifiesthemethodofcalculationofthelatefurnishingfee. Paragraph63oftheIntroductiontodocumentPCT/A/31/6shouldbeunderstoodsubjectto thesameclarification.

9. The text of proposed new *Rule 49.6(a)* (see document PCT/A/31/6, Annex I, page 8) is changed to read as follows:

“(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, 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.”

Comment: The change consists in omitting the words “notwithstanding Rule 82 and” which appear in appropriate since the operation of Rule 49.6(a) would be separate and distinct from that of Rule 82.

10. The text of proposed new *Rule 49.6(b)* (see document PCT/A/31/6, Annex I, page 8) is changed to read as follows:

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

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

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

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

Comment: The change puts it beyond doubt that any designated Office may allow for longer time periods for submitting the request for reinstatement of rights under Rule 49.6(a).

DOCUMENT PCT/A/31/6 (ANNEX II)

11. In connection with proposed amended *Rule 4.5* (see document PCT/A/31/6, Annex II, pages 6 to 7), the following text should appear after paragraph (a):

“(b) to (e) [No change]”

12. The text of proposed amended *Rule 12.3(e)* (see document PCT/A/31/6, Annex II, page 10) is changed to read as follows:

“(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% 50% of the international filing basic fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.”

Comment: The change clarifies the method of calculation of the late furnishing fee (similarly to Rule 16bis.2(b) – see document PCT/A/31/6, Annex II, page 15). Paragraph 63 of the Introduction to document PCT/A/31/6 should be understood subject to the same clarification.

13. The text of proposed new Rule 12.4(e) (see document PCT/A/31/6, Annex II, page 10) is changed to read as follows:

“(e) The furnishing of a translation after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.”

Comment: The change clarifies the method of calculation of the late furnishing fee (similarly to Rule 16bis.2(b) – see document PCT/A/31/6, Annex II, page 15). Paragraph 63 of the Introduction to document PCT/A/31/6 should be understood subject to the same clarification.

14. In connection with proposed amended Rules 17.1(b -bis) and (d), 66.7(a) and 93bis.1(b) (see document PCT/A/31/6, Annex II, pages 16, 50 and 62), it is to be noted that details of the system for making documents available in digital libraries will be governed by the Administrative Instructions. The necessary modifications of the Administrative Instructions will, under Rule 89.2(b), be the subject of consultation with interested Offices and Authorities, and it will be necessary to be sure that those Offices and Authorities find the proposed system acceptable before the modifications are promulgated.

15. The text of proposed amended Rule 24.2(a) (see document PCT/A/31/6, Annex II, page 18) is changed to read as follows:

“(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(e).”

Comment: The word “under” preceding “Rule 4.9(a)” should obviously be deleted.

16. The French text (only) of proposed amended Rule 27.1(b) (see document PCT/A/31/6, Annex II, page 20) erroneously refers to “l’article 4.3)a) et b)” and should be corrected to refer to “l’article 14.3)a) et b).”

17. The text of proposed new *Rule 44 ter.1(a)* (see document PCT/A/31/6, Annex II, page 29) is changed to read as follows:

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

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

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

Comment: Items (i) and (ii) of paragraph (a) group together the provisions relating to, respectively, the written opinion established under Rule 43 *bis.1* and the international preliminary report on patentability (Chapter I) established under Rule 44 *bis.1*. Thereferences to Rules 62 *bis.1(a)*, 72.2 *bis* and 72.3 which appeared in the paragraph have been deleted since the documents dealt with in those Rules belong to the file of the international preliminary examination, access to which is already governed by Article 38 and Rule 94.

18. The text of proposed new *Rule 90.2(a) and (b)* (see document PCT/A/31/6, Annex II, page 59) is changed to read as follows:

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

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

Comment: An unnecessary reference to paragraphs (b) and (c) of Rule 4.5 is deleted in each case.

19. The text of proposed new *Rule 93 bis.1(b)* (see document PCT/A/31/6, Annex II, page 62) is changed to read as follows:

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

Comment: The change consists in replacing the words “takes action to make” by “makes” in order to avoid confusion as to the operation of the Rule. It is noted that Rule 47.1(c) *-bis* (see document PCT/A/31/6, Annex II, page 30 to 31) provides the necessary safeguard to applicants in relation to the operation of Articles 20 and 22.

20. It is proposed in document PCT/A/31/9 (see Annex I of that document) to amend *item 4 of the Schedule of Fees* with effect from October 17, 2002. That item as it appears in document PCT/A/31/6, Annex II, page 64, should therefore be read subject to that further amendment.

DOCUMENT PCT/A/31/6Add.1 (ANNEX)

21. The text of *items (i) and (ii) of paragraph 1(b) of the proposed decisions relating to entry into force and transitional arrangements* of the amendments set out in Annex I to document PCT/A/31/6 (see document PCT/A/31/6Add.1, Annex, page 1) is changed, and new *item (iii)* is added, as follows:

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

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

(iii) where a designated Office informs the International Bureau under paragraph (f) of Rule 49.6 that paragraphs (a) to (e) of that Rule are not compatible with the national law applied by that Office, items (i) and (ii) of this paragraph shall apply in respect of that Office except that each reference in those items to the date January 1, 2003, shall be read as a reference to the date of entry into force of Rule 49.6(a) to (e) in respect of that Office.”

Comment 1: New item (iii) makes it clear how the transitional arrangements for proposed new Rule 49.6 would apply to a designated Office which makes a transitional reservation under proposed new Rule 49.6(f). Paragraph 10(i) and (ii) of the Introduction to document PCT/A/31/6Add.1 should be understood to be changed in a similar way.

Comment 2: The reference in paragraph 1(b)(i) to Article 22(1) was too restrictive, since the time limit under Article 22(3) could be applicable, and a reference to Article 22 is therefore more appropriate. The reference in paragraph 1(b)(ii) to Article 39(1)(a) was too restrictive, since the time limit under Article 39(1)(b) could be applicable, and a reference to Article 39(1) is therefore more appropriate. The wording of paragraph 10(i) and (ii) of the Introduction to document PCT/A/31/6Add.1 is already correct in this respect.

22. The text of *paragraph 2(b)(i) of the proposed decisions relating to entry into force and transitional arrangements* of the amendments set out in Annex II to document PCT/A/31/6 (see document PCT/A/31/6Add.1, Annex, pages 1 to 2) is changed to read as follows:

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

Comment: The changes make it clear that the amendments concerned apply in all cases where a demand is filed on or after the date of entry into force of the amendments. Paragraph 14(i) of the Introduction to document PCT/A/31/6Add.1 should be understood to be changed in a similar way. A reference to Rule 90bis.5(b) has been added to the decision, having been mistakenly omitted although it was correctly included in paragraph 14(i).

DOCUMENT PCT/A/31/6Add.2

23. Changes corresponding to those made to Annexes I and II of document PCT/A/31/6 as outlined in paragraphs 7 to 20, above, should if necessary also be made to the “clean” copy of the corresponding provisions in Annexes I and II to document PCT/A/31/6Add.2.

24. The text of the “clean” copy of proposed new *Rule 60.1(a -bis)* (see document PCT/A/31/6Add.2, Annex II, page 41) is changed to read as follows:

“(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.”

Comment: The words “as required under Rule 53.4” were erroneously included and have been deleted.

25. *The Assembly is invited to take into account the changes and clarifications contained in the present document in considering documents PCT/A/31/6, 6 Add.1 and 6 Add.2.*

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