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PROPOSED AMENDMENTS OF THE PCT REGULATIONS

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT)¹ as recommended by the Working Group on Reform of the PCT (“the Working Group”). The proposed amendments relate to the following matters:

- (a) minimum requirements for International Searching and Preliminary Examining Authorities;
- (b) physical requirements of the international application: text size requirements; procedure for making corrections;
- (c) language-related requirements of the international application;
- (d) amendments previously adopted by the Assembly: clarifications and consequential amendments.

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. References to “national laws”, “national applications”, “the national phase”, etc., include reference to regional laws, regional applications, the regional phase, etc.

2. The proposed amendments recognize the growing importance of the quality of international search and preliminary examination, thereby building confidence in the PCT system among Contracting States and encouraging Offices to rely on the results of the work of the International Authorities. They also facilitate the use of modern information and communications technology in the processing of PCT applications and address certain language-related issues that had been found to exist in connection with the Regulations currently in force. Other proposed amendments are in the nature of clarifications and consequential amendments further to amendments previously adopted by the Assembly.
3. The text of the proposed amendments appears in Annex I. For proposed date of entry into force and transitional arrangements, see paragraphs 7 and 8, below, and Annex II. A brief outline of the purpose of each group of amendments appears in paragraph 6(a) to (d), below, and more detailed explanations are set out in Annex III. A “clean” text of all of the proposed amended provisions (without underlining or striking through) appears in Annex IV.

PROPOSED AMENDMENTS

4. Proposals were considered by the Working Group during its eighth session, held in May 2006, at which the Working Group agreed on proposed amendments to be submitted to the Assembly for adoption at the present session, subject to possible further drafting changes to be made by the Secretariat (document PCT/R/WG/8/9, reproduced in the Annex to document PCT/A/35/1).
5. The proposed amendments are set out in Annex I to the present document. Where further drafting changes have been included, beyond the text as agreed by the Working Group, attention is drawn to that fact in a footnote in the said Annex with an explanation, where necessary, in Annex III. Information concerning proposed changes was posted by the Secretariat on the PCT reform electronic forum on the WIPO web site² for comments and suggestions by delegations and representatives. The proposals contained in this document take into account the comments and suggestions received.
6. The purpose of the proposed amendments is outlined briefly in the following subparagraphs. More detailed explanations appear in Annex III.

(a) *Minimum requirements for International Searching and Preliminary Examining Authorities.* Proposed amendments of Rules 36.1 and 63.1 are set out in Annex I and explained in Annex III, paragraphs 2 to 4. The proposal is to add the requirement to “have in place a quality management system and internal review arrangements in accordance with the common rules of international search” and “international preliminary examination” to the list of minimum requirements which any Office or organization must satisfy before it can be appointed, and must continue to satisfy while it remains appointed, as International Searching Authority (see Rule 36.1) and International Preliminary Examining Authority (see Rule 63.1).

(b) *Physical requirements of the international application: text size requirements; procedure for making corrections.* Proposed amendments of Rules 11.9(d) and 26.4 are set out in Annex I and explained in Annex III, paragraphs 5 to 7. The proposal is to amend some of the physical requirements of the international application so as to facilitate the use of modern information and communications technology in the processing of PCT applications.

² See www.int/pct/reform/en/index.html.

(c) *Language-related requirements of the international application.* Proposed amendments of Rules 12.1*ter*, 12.2(c), 43.4, 48.3(c) and 55.2(a-*ter*), (c) and (d) are set out in Annex I and explained in Annex III, paragraphs 8 to 13. The proposal is to amend a number of Rules to address certain language-related problems that had been found in connection with the Regulations currently in force.

(d) *Amendments previously adopted by the Assembly: clarifications and consequential amendments.* Proposed amendments of Rules 20.8(a-*bis*) and (c), 54*bis*.1(a), 55.2(a-*bis*), 76.5 and 91.3(f) are set out in Annex I and explained in Annex III, paragraphs 14 to 21. The proposals are in the nature of clarifications and consequential amendments further to amendments previously adopted by the Assembly.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

7. As agreed by the Working Group (document PCT/R/WG/8/9, paragraph 82, reproduced in the Annex to document PCT/A/35/1), proposals concerning entry into force and transitional arrangements in respect of the proposed amendments were posted by the Secretariat on the PCT reform electronic forum on the WIPO web site³ for comments and suggestions by delegations and representatives. The proposals contained in this document take into account the comments and suggestions received.

8. Generally speaking, it is proposed that the proposed amendments appearing in Annex I enter into force on April 1, 2007, and apply to international applications whose international filing date is on or after that date, subject to transitional arrangements in relation to certain provisions. Proposed decisions relating to entry into force and transitional arrangements are set out in Annex II.

9. *The Assembly of the PCT Union is invited:*

(i) *to adopt the proposed amendments of the Regulations under the PCT set out in Annex I;*

(ii) *to adopt the proposed decisions set out in Annex II relating to entry into force and transitional arrangements; and*

(iii) *to adopt the proposed understanding relating to Rules 20.8(c), 76.5 and 82*ter*.1(b) set out in Annex III, paragraph 18.*

[Annexes follow]

³ See www.int/pct/reform/en/index.html.

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Rule 11
Physical Requirements of the International Application

11.1 to 11.8 [No change]

11.9 *Writing of Text Matter*²

(a) to (c) [No change]

(d) All text matter shall be in characters the capital letters of which are not less than 0.28 ~~0.21~~ cm high, and shall be in a dark, indelible color, satisfying the requirements specified in Rule 11.2, provided that any text matter in the request may be in characters the capital letters of which are not less than 0.21 cm high.

(e) [No change]

11.10 to 11.14 [No change]

² Further drafting changes have been made to Rule 11.9(d), beyond the text as agreed by the Working Group; see Annex III, paragraph 7.

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

12.1 and 12.1bis [No change]

12.1ter Language of Indications Furnished under Rule 13bis.4

Any indication in relation to deposited biological material furnished under Rule 13bis.4 shall be in the language in which the international application is filed, provided that, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), any such indication shall be furnished in both the language in which the application is filed and the language of that translation.

12.2 *Language of Changes in the International Application*

(a) and (b) [No change]

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or 12.4, any correction under Rule 55.2(c) of a defect in a translation furnished under Rule 55.2(a), or any correction of a defect in a translation of the request furnished under Rule 26.3ter(c), shall be in the language of the translation.

12.3 and 12.4 [No change]

³ The proposed amendments are shown relative to the text of Rule 12 including the amendments adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

Rule 20⁴
International Filing Date

20.1 to 20.7 [No change]

20.8 *Incompatibility with National Laws*⁵

(a) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving 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 April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(a-bis) Where a missing element or part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be.

(b) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that 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 April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(c) Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (b) of this Rule, the designated Office may treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as the case may be, provided that Rule 82ter.1(c) and (d) shall apply *mutatis mutandis*.

⁴ The proposed amendments are shown relative to the text of Rule 20 including the amendments adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

⁵ Further drafting changes have been made to Rule 20.8(c), beyond the text as agreed by the Working Group; see Annex III, paragraph 16. The Assembly is invited to adopt a proposed understanding in relation to Rule 20.8(c); see Annex III, paragraph 18. For transitional arrangements in relation to Rule 20.8(a-bis) and (c), see Annex II, paragraph (1). The full text of Rule 20.8(a) and (b) is shown, although unchanged, for convenient reference having regard to the proposed addition of new Rules 20.8(a-bis) and (c), and to the proposed understanding just mentioned.

Rule 26
Checking by, and Correcting before, the Receiving Office
of Certain Elements of the International Application

26.1 to 26.3~~ter~~ [No change]

26.4 *Procedure*⁶

A ~~Any~~ correction of the request offered to the receiving Office may be stated in a letter addressed to that Office if the correction is of such a nature that it can be transferred from the letter to the request ~~record-copy~~ without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise, and in the case of a correction of any element of the international application other than the request, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

26.5 and 26.6 [No change]

⁶ Further drafting changes have been made to Rule 26.4, beyond the text as agreed by the Working Group; see Annex III, paragraph 7.

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) to (iii) [No change]
- (iv) [that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;](#)
- (v) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

Rule 43⁷
The International Search Report

43.1 to 43.3 [No change]

43.4 *Language*⁸

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is to be published, provided that: ~~or~~,

(i) if a translation of the international application into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in the language of that translation;

(ii) if the international application is to be published in the language of a translation furnished under Rule 12.4 which is not accepted by the International Searching Authority and that Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in a language which is both a language accepted by that Authority and a language of publication referred to in Rule 48.3(a).

43.5 to 43.10 [No change]

⁷ The proposed amendments are shown relative to the text of Rule 43 including the amendments adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

⁸ For transitional arrangements in relation to Rule 43.4, see Annex II, paragraph (2)(a).

Rule 48⁹
International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*¹⁰

(a) and (b) [No change]

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations, [if not furnished by the applicant under Rule 12.3](#), shall be prepared under the responsibility of the International Bureau.

48.4 to 48.6 [No change]

⁹ The proposed amendments are shown relative to the text of Rule 48 including the amendments adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

¹⁰ For transitional arrangements in relation to Rule 48.3(c), see Annex II, paragraph (2)(b).

Rule 54bis
Time Limit for Making a Demand

*54bis.1 Time Limit for Making a Demand*¹¹

(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 [or the declaration referred to in Article 17\(2\)\(a\)](#), and [of](#) the written opinion established under Rule 43bis.1, ~~or of the declaration referred to in Article 17(2)(a)~~; or

(ii) 22 months from the priority date.

(b) [No change]

¹¹ For transitional arrangements in relation to Rule 54bis.1, see Annex II, paragraph (2)(c).

Rule 55¹²
Languages (International Preliminary Examination)

55.1 [No change]

55.2 *Translation of International Application*¹³

(a) [No change]

(a-*bis*) A translation of the international application into a language referred to in paragraph (a) shall include any element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b) or 20.6(a) and any part of the description, claims or drawings furnished by the applicant under Rule 20.5(b) or 20.6(a) which is considered to have been contained in the international application under Rule 20.6(b).

(a-*ter*) The International Preliminary Examining Authority shall check any translation furnished under paragraph (a) for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purposes of the international preliminary examination.

(b) [No change]

(c) If a requirement ~~the requirements~~ referred to in ~~of~~ paragraphs (a), ~~and~~ (a-*bis*) and (a-*ter*) is ~~are~~ not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation or the required correction, as the case may be, 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.

(d) If the applicant complies with the invitation within the time limit under paragraph (c), the said requirement ~~requirements~~ shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted and the International Preliminary Examining Authority shall so declare.

55.3 [No change]

¹² The proposed amendments are shown relative to the text of Rule 55 including the amendments adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

¹³ For transitional arrangements in relation to Rule 55.2(a-*bis*), see Annex II, paragraph (1). For transitional arrangements in relation to Rule 55.2(a-*ter*), (c) and (d), see Annex II, paragraph (2)(c).

Rule 63
Minimum Requirements for
International Preliminary Examining Authorities

63.1 *Definition of Minimum Requirements*

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

- (i) to (iii) [No change]
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;
- (v) that Office or organization must hold an appointment as an International Searching Authority.

Rule 76¹⁴

**Translation of Priority Document;
Application of Certain Rules to Procedures before Elected Offices**

76.1, 76.2 and 76.3 [*Remain deleted*]

76.4 [No change]

76.5 *Application of Certain Rules to Procedures before Elected Offices*¹⁵

Rules 13*ter*.3, [20.8\(c\)](#), 22.1(g), 47.1, 49, 49*bis*, 49*ter* and 51*bis* shall apply, provided that:

(i) to (v) [No change]

¹⁴ The proposed amendments are shown relative to the text of Rule 76 including the amendments adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

¹⁵ The proposal to amend Rule 76.5 has been added; see Annex III, paragraph 17. For transitional arrangements in relation to Rule 76.5, see Annex II, paragraph (1). The Assembly is invited to adopt a proposed understanding in relation to Rule 76.5; see Annex III, paragraph 18.

Rule 91¹⁶
Rectification of Obvious Mistakes
in the International Application and Other Documents

91.1 and 91.2 [No change]

91.3 *Authorization and Effect of Rectifications*

(a) to (e) [No change]

(f) A designated Office may disregard a rectification that was authorized under Rule 91.1 only if it finds that it would not have authorized the rectification under Rule 91.1 if it had been the competent authority, provided that no designated Office shall disregard any rectification that was authorized under Rule 91.1 without giving the applicant the opportunity to make observations, within a time limit which shall be reasonable under the circumstances, on the Office's intention to disregard the rectification.

[Annex II follows]

¹⁶ The proposed amendments are shown relative to the text of Rule 91 including the amendments adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

ANNEX II

PROPOSED DECISIONS RELATING TO
ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

It is proposed that the Assembly adopt the following decisions concerning entry into force and transitional arrangements in respect of the proposed amendments of the Regulations set out in Annex I:

“(1) The amendments set out in Annex I shall enter into force on April 1, 2007, and shall apply to international applications whose international filing date is on or after April 1, 2007, provided that Rules 20.8(a-*bis*) and (c), 55.2(a-*bis*) and 76.5 as amended shall not apply to international applications in respect of which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office before April 1, 2007.

“(2) The amendments set out in Annex I shall not apply to international applications whose international filing date is before April 1, 2007, provided that:

“(a) Rule 43.4 as amended shall apply to any international application in respect of which an international search report is established on or after April 1, 2007, whether the international filing date is before, on or after April 1, 2007;

“(b) Rule 48.3(c) as amended shall apply to any international application which is published under Article 21 on or after April 1, 2007, whether the international filing date is before, on or after April 1, 2007;

“(c) Rules 54*bis*.1 and 55.2(a-*ter*), (c) and (d) as amended shall apply to any international application in respect of which a demand for international preliminary examination is made on or after April 1, 2007, whether the international filing date is before, on or after April 1, 2007.”

[Annex III follows]

ANNEX III

EXPLANATORY NOTES

1. This Annex sets out more detailed explanations of the amendments of the PCT Regulations that are proposed in the main body of the document and set out in Annex I. Proposed decisions concerning entry into force and transitional arrangements are set out in Annex II. An understanding that is proposed to be adopted by the Assembly in connection with the adoption of amended Rules 20.8(c) and 76.5 is set out in this Annex in paragraph 18, below.

MINIMUM REQUIREMENTS FOR INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES

2. See the proposed amendments of Rules 36.1 and 63.1 set out in Annex I, with the proposed date of entry into force of April 1, 2007. Details of consideration of the matter by the Working Group at its eighth session are set out in document PCT/R/WG/8/9, paragraphs 65 to 68 (reproduced in the Annex to document PCT/A/35/1).

3. The proposal is to add the requirement to “have in place a quality management system and internal review arrangements in accordance with the common rules of international search” and “international preliminary examination” to the list of minimum requirements which any Office or organization must satisfy before it can be appointed, and must continue to satisfy while it remains appointed, as International Searching Authority (see Rule 36.1) and International Preliminary Examining Authority (see Rule 63.1).

4. The “common rules” of international search and international preliminary examination, as referred to in Rules 36.1 and 63.1, respectively, must be applied and observed by all International Authorities (see Articles 16(3)(b) and 32(3); the agreements with the International Bureau, as approved by the PCT Assembly, under which all Authorities operate; and the PCT International Search and Preliminary Examination Guidelines, which form part of those common rules, and particularly Chapter 21 thereof, which sets forth a Common Quality Framework for International Search and Preliminary Examination).

PHYSICAL REQUIREMENTS OF THE INTERNATIONAL APPLICATION: TEXT SIZE REQUIREMENTS; PROCEDURE FOR MAKING CORRECTIONS

5. See the proposed amendments of Rules 11.9(d) and 26.4 set out in Annex I, with the proposed date of entry into force of April 1, 2007. Details of consideration of the matter by the Working Group at its eighth session are set out in document PCT/R/WG/8/9, paragraphs 69 to 76 (reproduced in the Annex to document PCT/A/35/1).

6. More and more Offices are now converting international applications which have been filed on paper into electronic form, for example, by way of scanning and subsequent further conversion from image files to text files through Optical Character Recognition (OCR). In order to increase the accuracy of the conversion into electronic form, it is proposed to amend Rule 11.9(d) so as to increase the minimum font size to be used by applicants for all text matter in an international application (other than the request) to 0.28 cm and to amend Rule 26.4 so as to remove the provision allowing for handwritten entries in the international application (other than the request).

7. Further drafting changes have been made to Rules 11.9(d) and 26.4, beyond the text as agreed by the Working Group. Upon consideration of the difficulties noted by the Secretariat at the eighth session of the Working Group (see document PCT/R/WG/8/9, paragraph 76) which may arise in that the new minimum font size under Rule 11.9(d) would not be immediately compatible with the computer-generated forms made available by the International Bureau (both editable PDF and PCT-SAFE (EASY) formats) and that it may not be appropriate to apply the new correction requirements under Rule 26.4 to the making by receiving Offices of *ex officio* corrections in the request, Rule 11.9(d) continues to allow for text matter in the request to be, as at present, in characters not less than 0.21 cm, and Rule 26.4 continues to allow for handwritten entries in the request.

LANGUAGE-RELATED REQUIREMENTS OF THE INTERNATIONAL APPLICATION

8. See the proposed amendments of Rules 12.1*ter*, 12.2(c), 43.4, 48.3(c) and 55.2(a-*ter*), (c) and (d) set out in Annex I, with the proposed date of entry into force of April 1, 2007, and transitional arrangements set out in Annex II. Details of consideration of the matter by the Working Group at its eighth session are set out in document PCT/R/WG/8/9, paragraphs 33 and 34 (reproduced in the Annex to document PCT/A/35/1).

Language of indications in relation to deposited biological material

9. It is proposed to add new Rule 12.1*ter* so as to fill an apparent gap in the present Regulations, which do not provide for the language in which indications related to deposited biological material furnished under Rule 13*bis*.4 separately from the description are to be furnished.

Language of corrections of defects in translations

10. Rule 12.2(c) as worded at present would appear to incorrectly imply that the check for, and correction of, defects under Rule 11 in a translation furnished under Rule 55.2(a) are made “under Rule 26” and thus by the receiving Office rather than by the competent International Preliminary Examining Authority to which such a translation is to be furnished. It is thus proposed to amend Rule 12.2(c) so as to clarify that a correction of a translation furnished under Rule 55.2(a) is done “under Rule 55.2(c)” and thus by the International Preliminary Examining Authority. Furthermore, it is proposed to amend Rule 12.2(c) by adding a reference to a translation furnished under Rule 12.4, noting that it would appear that the addition of such reference was overlooked when Rule 12.4 was added to the Regulations.

11. In this context, it is also proposed to add a new Rule 55.2(a-*ter*) so as to expressly provide for the International Preliminary Examining Authority to carry out the Rule 11 check, but only to the extent that compliance with Rule 11 is necessary for the purposes of international preliminary examination, and to amend Rule 55.2(c) and (d) so as to expressly provide for that Authority to invite the applicant to correct any defect.

Language of international search report

12. It is proposed to amend Rule 43.4 so as fill an apparent gap in the present Regulations under which the International Searching Authority may, in certain circumstances, be required to establish the international search report in a language not accepted by that Authority: under present Rule 43.4, where the Authority conducts the search on the basis of the international application in the language of filing which is not a language of publication and the applicant

furnishes, for the purposes of international publication, a translation of the application into a language of publication which is not, however, accepted by that Authority, the Authority is nevertheless required to establish the international search report in that language. It is thus proposed to amend Rule 43.4 to permit the International Searching Authority to establish the international search report in a language which is both accepted by that Authority and a language of publication referred to in Rule 48.3(a).

Translation of international search reports, abstracts, etc.

13. It is proposed to amend Rule 48.3(c) so as to clarify that any necessary translation into English of the international search report, the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract will be prepared under the responsibility of the International Bureau only if it has not already been furnished by the applicant under Rule 12.3.

AMENDMENTS PREVIOUSLY ADOPTED BY THE ASSEMBLY: CLARIFICATIONS AND CONSEQUENTIAL AMENDMENTS

14. See the proposed amendments of Rules 20.8(a-bis) and (c), 54bis.1(a), 55.2(a-bis), 76.5 and 91.3(f) set out in Annex I, with the proposed date of entry into force of April 1, 2007, and transitional arrangements set out in Annex II. The proposals are in the nature of clarifications and consequential amendments further to amendments previously adopted by the Assembly. Details of consideration of the matter by the Working Group at its eighth session are set out in document PCT/R/WG/8/9, paragraphs 15 to 18 (reproduced in the Annex to document PCT/A/35/1).

Incorporation by reference of a missing element or part of the application: incompatibility with national laws

15. It is proposed to amend Rule 20.8 by adding new paragraphs (a-bis) and (c) so as to clarify the procedure to be followed by a receiving Office or a designated Office which has notified the International Bureau of the incompatibility of any of the Rules concerning incorporation by reference of a missing element or part of the application (as referred to in Rule 20.8(a) and (b), respectively) with the national law applied by that Office.

16. A further drafting change has been made to Rule 20.8(c), beyond the text as agreed by the Working Group. The provision has been changed from a "shall" to a "may" provision so as to give a designated Office which, because of the operation of Rule 20.8(b), does not apply the Rules concerning incorporation by reference, flexibility with regard to the according or correction of the filing date for the purposes of the procedure before that Office, also noting that such change would align the wording of Rule 20.8(c) with that of Rule 82ter.1(b) as already adopted by the Assembly with effect from April 1, 2007.

17. Furthermore, a proposal to amend Rule 76.5 has been added so as to ensure that Rule 20.8(c) also applies to elected Offices.

Proposed understanding

18. As agreed by the Working Group, it is proposed that the Assembly, in connection with the adoption of amended Rules 20.8(c) and 76.5, adopt the following understanding in relation to Rules 20.8(c), 76.5 and 82*ter*.1(b):

“In connection with the adoption of amended Rules 20.8(c) and 76.5, the Assembly noted that:

“(i) where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated or elected Office because of the operation of Rule 20.8(b), the time limit for performing the acts referred to in Articles 22 and 39 before such designated or elected Office would be calculated on the basis of the priority date referred to in Article 2(xi) having due regard to the international filing date as accorded by the receiving Office; and

“(ii) the same should apply where that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated or elected Office because of the operation of Rule 82*ter*.1(b) as adopted by the Assembly in October 2005 with effect from April 1, 2007.”

Time limit for making a demand

19. On October 5, 2004, with effect from April 1, 2005, the Assembly adopted amendments of Rules 43*bis*.1, 44.1 and 69.1 so as to clarify that a written opinion under Rule 43*bis*.1 is to be established by the International Searching Authority even in the case that no international search report is established in accordance with Article 17(2)(a) (that is, where the International Searching Authority declares that no international search report will be established) (see documents PCT/A/33/2 and 7). It is proposed to make a consequential amendment of Rule 54*bis*.1(a)(i) accordingly.

Translation of international application for the purposes of international preliminary examination

20. It is proposed to amend Rule 55.2(a-*bis*) so as to clarify that the translation furnished by the applicant under Rule 55.2(a) should only include those missing elements or parts furnished by the applicant under Rule 20.3(b) or 20.6(a), or furnished under Rule 20.5(b) or 20.6(a), which, under Rule 20.6(b), are considered to have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.

Rectification of obvious mistakes

21. It is proposed to amend Rule 91.3(f) so as to ensure that the applicant has an opportunity to react to the intention of the designated Office to disregard the rectification that was authorized under Rule 91.1.

[Annex IV follows]

ANNEX IV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS
(clean text)

A number of proposed amendments of the PCT Regulations are set out in Annex I, in which additions and deletions are shown, respectively, by underlining and striking-through of the text concerned. This Annex contains, for convenient reference, a “clean” text of the relevant Rules as they would stand after amendment.

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Rule 11
Physical Requirements of the International Application

11.1 to 11.8 [No change]

11.9 *Writing of Text Matter*

(a) to (c) [No change]

(d) All text matter shall be in characters the capital letters of which are not less than 0.28 cm high, and shall be in a dark, indelible color, satisfying the requirements specified in Rule 11.2, provided that any text matter in the request may be in characters the capital letters of which are not less than 0.21 cm high.

(e) [No change]

11.10 to 11.14 [No change]

Rule 12
Language of the International Application
and Translations for the Purposes of International Search
and International Publication

12.1 and 12.1*bis* [No change]

12.1*ter* *Language of Indications Furnished under Rule 13bis.4*

Any indication in relation to deposited biological material furnished under Rule 13*bis.4* shall be in the language in which the international application is filed, provided that, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), any such indication shall be furnished in both the language in which the application is filed and the language of that translation.

12.2 *Language of Changes in the International Application*

(a) and (b) [No change]

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or 12.4, any correction under Rule 55.2(c) of a defect in a translation furnished under Rule 55.2(a), or any correction of a defect in a translation of the request furnished under Rule 26.3*ter*(c), shall be in the language of the translation.

12.3 and 12.4 [No change]

Rule 20
International Filing Date

20.1 to 20.7 [No change]

20.8 *Incompatibility with National Laws*

(a) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving 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 April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(a-*bis*) Where a missing element or part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be.

(b) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that 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 April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(c) Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (b) of this Rule, the designated Office may treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as the case may be, provided that Rule 82*ter*.1(c) and (d) shall apply *mutatis mutandis*.

Rule 26
Checking by, and Correcting before, the Receiving Office
of Certain Elements of the International Application

26.1 to 26.3~~ter~~ [No change]

26.4 *Procedure*

A correction of the request offered to the receiving Office may be stated in a letter addressed to that Office if the correction is of such a nature that it can be transferred from the letter to the request without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise, and in the case of a correction of any element of the international application other than the request, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

26.5 and 26.6 [No change]

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) to (iii) [No change]
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;
- (v) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

Rule 43
The International Search Report

43.1 to 43.3 [No change]

43.4 *Language*

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is to be published, provided that:

(i) if a translation of the international application into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in the language of that translation;

(ii) if the international application is to be published in the language of a translation furnished under Rule 12.4 which is not accepted by the International Searching Authority and that Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in a language which is both a language accepted by that Authority and a language of publication referred to in Rule 48.3(a).

43.5 to 43.10 [No change]

Rule 48
International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) and (b) [No change]

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations, if not furnished by the applicant under Rule 12.3, shall be prepared under the responsibility of the International Bureau.

48.4 to 48.6 [No change]

Rule 54bis
Time Limit for Making a Demand

54bis.1 Time Limit for Making a Demand

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later:

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

(ii) 22 months from the priority date.

(b) [No change]

Rule 55
Languages (International Preliminary Examination)

55.1 [No change]

55.2 *Translation of International Application*

(a) [No change]

(*a-bis*) A translation of the international application into a language referred to in paragraph (a) shall include any element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b) or 20.6(a) and any part of the description, claims or drawings furnished by the applicant under Rule 20.5(b) or 20.6(a) which is considered to have been contained in the international application under Rule 20.6(b).

(*a-ter*) The International Preliminary Examining Authority shall check any translation furnished under paragraph (a) for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purposes of the international preliminary examination.

(b) [No change]

(c) If a requirement referred to in paragraphs (a), (*a-bis*) and (*a-ter*) is not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation or the required correction, as the case may be, 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.

(d) If the applicant complies with the invitation within the time limit under paragraph (c), the said requirement shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted and the International Preliminary Examining Authority shall so declare.

55.3 [No change]

Rule 63
Minimum Requirements for
International Preliminary Examining Authorities

63.1 *Definition of Minimum Requirements*

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

- (i) to (iii) [No change]
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;
- (v) that Office or organization must hold an appointment as an International Searching Authority.

Rule 76
Translation of Priority Document;
Application of Certain Rules to Procedures before Elected Offices

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 *Application of Certain Rules to Procedures before Elected Offices*

Rules 13^{ter}.3, 20.8(c), 22.1(g), 47.1, 49, 49^{bis}, 49^{ter} and 51^{bis} shall apply, provided that:

(i) to (v) [No change]

Rule 91
Rectification of Obvious Mistakes in the
International Application and Other Documents

91.1 and 91.2 [No change]

91.3 *Authorization and Effect of Rectifications*

(a) to (e) [No change]

(f) A designated Office may disregard a rectification that was authorized under Rule 91.1 only if it finds that it would not have authorized the rectification under Rule 91.1 if it had been the competent authority, provided that no designated Office shall disregard any rectification that was authorized under Rule 91.1 without giving the applicant the opportunity to make observations, within a time limit which shall be reasonable under the circumstances, on the Office's intention to disregard the rectification.

[End of Annex IV and of document]