

WIPO



PCT/A/38/2

ORIGINAL: English

DATE: July 31, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirty-Eighth (22nd Extraordinary) Session
Geneva, September 22 to 30, 2008**

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

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 PCT Working Group (“the Working Group”). The proposed amendments relate to the following matters:

- (a) supplementary international search;
- (b) processing of the international application under Article 14(4);
- (c) amendment of claims.

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 references to regional laws, regional applications, the regional phase, etc.

2. The text of the proposed amendments appears in Annexes I and II. A brief outline of the purpose of each group of amendments appears in paragraph 5(a) to (c), below, and more detailed explanations are set out in Annex IV. For proposed dates of entry into force and transitional arrangements, see paragraphs 6 to 8, below, and Annex III. A “clean” text of all of the proposed amended provisions (without underlining or striking through) appears in Annex V.

PROPOSED AMENDMENTS

3. Proposals were considered by the Working Group during its first session, held in May 2008, 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/WG/1/16, reproduced in Annex I to document PCT/A/38/1).

4. The proposed amendments are set out in Annexes I and II to the present document, the amendments in the two Annexes having different proposed dates of entry into force. 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 with an explanation, where necessary, in Annex IV. Information concerning proposed further drafting changes was posted by the Secretariat on the Working Group’s electronic forum on the WIPO website² for comments and suggestions by delegations and representatives. The proposals contained in this document take into account the comments and suggestions received.

5. The purpose of the proposed amendments is outlined briefly in the following subparagraphs. More detailed explanations appear in Annex IV.

(a) *Supplementary international search.* Proposed amendments of Rules 45bis.2, 45bis.3, 90.1, 90.4, 90.5, 90bis.5 and 90bis.6, and the proposed addition of new Rule 90bis.3bis, are set out in Annex I and explained in Annex IV, paragraphs 3 to 12. The proposed amendments, which are in the nature of consequential amendments based on the amendments to the Regulations adopted by the Assembly on October 3, 2007, with effect from January 1, 2009, introducing the supplementary international search system, concern the refund of the supplementary search handling fee and the supplementary search fee; the right of agents to practice before any International Authority specified to carry out a supplementary international search; and the effects of a withdrawal of a request for supplementary international search.

(b) *Processing of the international application under Article 14(4).* Proposed amendments of Rule 29.4 are set out in Annex II and explained in Annex IV, paragraphs 13 to 15. The proposal is to clarify the procedure to be followed by the receiving Office where the receiving Office has accorded, albeit mistakenly, an international filing date and intends to issue a declaration under Article 14(4) that the international application is to be considered withdrawn because it does not contain the claim(s) *element* or the description *element* (Article 11(1)(iii)(d) and (e)).

² <http://www.wipo.int/pct-wg/en/index.html>

(c) *Amendment of claims.* Proposed amendments of Rules 46.5, 66.8 and 70.16 are set out in Annex II and explained in Annex IV, paragraphs 16 to 19. The proposal is to require that, in the case of amendments of the claims under Articles 19 and 34, applicants submit a replacement sheet or sheets containing a complete set of claims rather than, as at present, replacement sheets only for those sheets of claims which, on account of an amendment, differed from sheets previously filed.

ENTRY INTO FORCE

6. Proposals concerning entry into force and transitional arrangements in respect of the proposed amendments were posted by the Secretariat on the Working Group's electronic forum on WIPO's website³ for comments and suggestions by delegations and representatives. The proposals contained in this document take into account the comments and suggestions received.

7. Different dates of entry into force are proposed for the amendments set out in each of Annexes I and II, as follows:

(i) for the proposed amendments appearing in Annex I (concerning the supplementary international search system): January 1, 2009;

(ii) for the proposed amendments appearing in Annex II (concerning the processing of the international application under Article 14(4) and the making of amendments of claims): July 1, 2009.

8. More detailed explanations concerning dates of entry into force and proposed transitional arrangements, including draft decisions of the Assembly, are set out in Annex III.

9. The Assembly of the PCT Union is invited:

(i) to adopt the proposed amendments of the Regulations under the PCT set out in Annexes I and II; and

(ii) to adopt the proposed decisions set out in Annex III relating to entry into force and transitional arrangements.

[Annexes follow]

³ <http://www.wipo.int/pct-wg/en/index.html>

ANNEX I

AMENDMENTS OF THE PCT REGULATIONS¹
 PROPOSED TO ENTER INTO FORCE ON JANUARY 1, 2009²

TABLE OF CONTENTS

Rule 45bis	Supplementary International Searches	2
45bis.1	[No change]	2
45bis.2	<i>Supplementary Search Handling Fee</i>	2
45bis.3	<i>Supplementary Search Fee</i>	2
45bis.4 to 45bis.9	[No change]	2
Rule 90	Agents and Common Representatives	3
90.1	<i>Appointment as Agent</i>	3
90.2 and 90.3	[No change]	3
90.4	<i>Manner of Appointment of Agent or Common Representative</i>	4
90.5	<i>General Power of Attorney</i>	4
90.6	[No change]	4
Rule 90bis	Withdrawals	5
90bis.1 to 90bis.3	[No change]	5
<u>90bis.3bis</u>	<u><i>Withdrawal of Request for Supplementary International Search</i></u>	5
90bis.4	[No change]	5
90bis.5	<i>Signature</i>	5
90bis.6	<i>Effect of Withdrawal</i>	6
90bis.7	[No change]	6

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 Annex V.

² For dates of entry into force and transitional arrangements, see paragraphs 6 to 8 of the main body of this document and Annex III.

Rule 45bis
Supplementary International Searches

45bis.1 [No change]

45bis.2 *Supplementary Search Handling Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the [international application is withdrawn or considered withdrawn, or the](#) supplementary search request is withdrawn or considered not to have been submitted.

45bis.3 *Supplementary Search Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the [international application is withdrawn or considered withdrawn, or the](#) supplementary search request is withdrawn or considered not to have been submitted.

(e) [No change]

45bis.4 to 45bis.9 [No change]

Rule 90
Agents and Common Representatives

90.1 *Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, [any Authority specified for supplementary search](#) and the International Preliminary Examining Authority.

(b) [No change]

[\(b-bis\) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.](#)

(c) [No change]

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority, [any Authority specified for supplementary search](#) and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) specifically before the International Searching Authority, [any Authority specified for supplementary search](#) or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, [the Authority specified for supplementary search](#) or International Preliminary Examining Authority, as the case may be.

90.2 and 90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) [No change]

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), [\(b-bis\)](#), (c) or (d)(ii), it shall be submitted to the International Searching Authority, [the Authority specified for supplementary search](#) or the International Preliminary Examining Authority, as the case may be.

(c) [No change]

(d) Subject to paragraph (e), any receiving Office, any International Searching Authority, [any Authority competent to carry out supplementary searches](#), 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) [No change]

90.5 *General Power of Attorney*

(a) [No change]

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), [\(b-bis\)](#), (c) or (d)(ii), it shall be deposited with the International Searching Authority, [the Authority specified for supplementary search](#) or the International Preliminary Examining Authority, as the case may be.

(c) Any receiving Office, any International Searching Authority, [any Authority competent to carry out supplementary searches](#) and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules *90bis.1* to *90bis.4* to the receiving Office, the International Searching Authority, [the Authority specified for supplementary search](#) or the International Preliminary Examining Authority, [as the case may be](#), a copy of the general power of attorney shall be submitted to that Office or Authority.

90.6 [No change]

**Rule 90bis
Withdrawals**

90bis.1 to 90bis.3 [No change]

[90bis.3bis Withdrawal of Request for Supplementary International Search³](#)

[\(a\) The applicant may withdraw a request for supplementary international search at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45bis.8\(a\), of the supplementary search report or the declaration that no such report will be established.](#)

[\(b\) Withdrawal shall be effective on receipt, within the time limit under paragraph \(a\), of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in paragraph \(a\), the communication of that report or declaration under Article 20\(1\), as applicable by virtue of Rule 45bis.8\(b\), shall nevertheless be effected.](#)

90bis.4 [No change]

90bis.5 *Signature*⁴

(a) [No change]

(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 90bis.1 to 90bis.4 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 receiving Office, the International Bureau, [the Authority carrying out the supplementary international search](#) or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

³ Further drafting changes have been made to Rule 90bis.3bis, beyond the text as agreed by the Working Group (Annex IV, paragraph 10).

⁴ Further drafting changes have been made to Rule 90bis.5, beyond the text as agreed by the Working Group (Annex IV, paragraph 11).

[Rule 90bis.5(b), continued]

(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d), ~~or~~ 90bis.3(c) or 90bis.3bis(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) [No change]

90bis.6 *Effect of Withdrawal*⁵

(a) and (b) [No change]

(b-bis) Where a request for supplementary international search is withdrawn under Rule 90bis.3bis, the supplementary international search by the Authority concerned shall be discontinued.

(c) [No change]

90bis.7 [No change]

[Annex II follows]

⁵ Further drafting changes have been made to Rule 90bis.6, beyond the text as agreed by the Working Group (Annex IV, paragraph 12).

ANNEX II

AMENDMENTS OF THE PCT REGULATIONS¹
PROPOSED TO ENTER INTO FORCE ON JULY 1, 2009²

TABLE OF CONTENTS

Rule 29	International Applications Considered Withdrawn	2
29.1 to 29.3	[No change]	2
29.4	<i>Notification of Intent to Make Declaration Under Article 14(4)</i>	2
Rule 46	Amendment of Claims before the International Bureau.....	3
46.1 to 46.4	[No change]	3
46.5	<i>Form of Amendments</i>	3
Rule 66	Procedure before the International Preliminary Examining Authority.....	4
66.1 to 66.7	[No change]	4
66.8	<i>Form of Amendments</i>	4
66.9	[No change]	4
Rule 70	International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report).....	5
70.1 to 70.15	[No change]	5
70.16	<i>Annexes to the Report</i>	5
70.17	[No change]	5

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 Annex V.

² For dates of entry into force and transitional arrangements, see paragraphs 6 to 8 of the main body of this document and Annex III.

Rule 29
International Applications Considered Withdrawn

29.1 to 29.3 [No change]

29.4 *Notification of Intent to Make Declaration Under Article 14(4)*³

(a) Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefore. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within ~~one month~~ two months from the date of the notification.

(b) Where the receiving Office intends to issue a declaration under Article 14(4) in respect of an element mentioned in Article 11(1)(iii)(d) or (e), the receiving Office shall, in the notification referred to in paragraph (a) of this Rule, invite the applicant to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18. For the purposes of Rule 20.7(a)(i), the invitation sent to the applicant under this paragraph shall be considered to be an invitation under Rule 20.3(a)(ii).

(c) Paragraph (b) shall not apply where the receiving Office has informed the International Bureau in accordance with Rule 20.8(a) of the incompatibility of Rules 20.3(a)(ii) and (b)(ii) and 20.6 with the national law applied by that Office.

³ Further drafting changes have been made to Rule 29.4, beyond the text as agreed by the Working Group (Annex IV, paragraph 15).

Rule 46
Amendment of Claims before the International Bureau

46.1 to 46.4 [No change]

46.5 *Form of Amendments*⁴

(a) The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of the claims in replacement of all the claims originally filed ~~for every sheet of the claims which, on account of an amendment or amendments under Article 19, differs from the sheet originally filed.~~

(b) The replacement sheet or sheets shall be accompanied by a letter ~~accompanying the replacement sheets~~ which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed ~~replaced sheets~~ and the claims as amended ~~replacement sheets~~;

(ii) shall identify the claims originally filed which, on the account of the amendments, are cancelled. ~~To the extent that any amendment results in the cancellation of an entire claim sheet, that amendment shall be communicated in the a letter.~~

⁴ Further drafting changes have been made to Rule 46.5, beyond the text as agreed by the Working Group (Annex IV, paragraph 18).

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 *Form of Amendments*⁵

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter ~~accompanying the replacement sheets~~ which shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) [No change]

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

66.9 [No change]

⁵ Further drafting changes have been made to Rule 66.8, beyond the text as agreed by the Working Group (Annex IV, paragraph 18).

Rule 70
International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*⁶

(a) Each replacement sheet under Rule 66.8(a), ~~or~~ (b) or (c) and each replacement sheet under Rule 46.5(a) containing amendments under Article 19 shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Replacement sheets under Rule 46.5(a) containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rules 46.5(b) and Rule 66.8 shall not be annexed.

(b) [No change]

70.17 [No change]

[Annex III follows]

⁶ A further drafting change, beyond the amendments of the Regulations agreed by the Working Group, has been made to Rule 70.16; see Annex IV, paragraph 19.

ANNEX III

ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

1. This Annex sets out proposals, including draft decisions by the Assembly, for dates of entry into force and transitional arrangements in respect of the proposed amendments of the PCT Regulations set out in Annexes I and II (paragraphs 6 to 8 of the main body of this document).

Annex I: Proposed date of entry into force: January 1, 2009

2. As regards the proposed amendments relating to the *supplementary search system* set out in Annex I (Rules 45*bis*.2, 45*bis*.3, 90.1, 90.4, 90.5, 90*bis*.3*bis*, 90*bis*.5 and 90*bis*.6), it is to be noted that the PCT Assembly, when adopting the amendments to the PCT Regulations introducing the supplementary search system at its October 2007 session, decided that those amendments shall enter into force on January 1, 2009, and shall apply to international applications whose international filing date is on or after January 1, 2009, and shall further apply to any international application whose international filing date is before January 1, 2009, and in respect of which the time limit for making a supplementary search request under new Rule 45*bis*.1(a) expires on or after January 1, 2009.

3. It is proposed that the Assembly adopt the same decisions relating to entry into force and transitional arrangements also with regard to the proposed further amendments relating to the supplementary search system set out in Annex I.

Annex II: Proposed date of entry into force: July 1, 2009

4. Implementation of the amendments set out in Annex II, which relate to the *processing of the international application under Article 14(4) and to the making of amendments of claims*, will require more time, noting that revision of the Administrative Instructions, the PCT Receiving Office Guidelines and the PCT Applicant's Guide will be needed. It is thus proposed that these amendments should enter into force on July 1, 2009.

5. As regards the proposed amendments relating to the *processing of the international application under Article 14(4)* (Rule 29.4) set out in Annex II, no specific transitional arrangements appear to be necessary. It is thus proposed that those amendments should enter into force on July 1, 2009, and should apply to international applications whose international filing date is on or after July 1, 2009.

6. As regards the amendments relating to the *amendment of claims* (Rules 46.5, 66.8 and 70.16) set out in Annex II, it would appear preferable to avoid that applicants, the International Bureau (which is the recipient of Article 19 amendments) and International Preliminary Examining Authorities (which are the recipient of Article 34 amendments) have to deal with two different set of formality requirements for the filing of amendments, depending on whether the international application in respect of which the amendment is made was filed before, or on or after the July 1, 2009. It is thus proposed that those amendments should enter into force on July 1, 2009 and should apply to any international application in respect of which an amendment under Article 19 or 34 is made on or after that date, irrespective of the international filing date of the international application concerned.

Proposed Decisions

7. 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 Annexes I and II:

“(1) The amendments of Rules 45*bis*.2, 45*bis*.3, 90.1, 90.4, 90.5, 90*bis*.3*bis*, 90*bis*.5 and 90*bis*.6 set out in Annex I shall enter into force on January 1, 2009, and shall apply to any international application in respect of which the time limit for making a supplementary search request under new Rule 45*bis*.1(a) expires on or after January 1, 2009.

“(2) The amendments of Rule 29.4 set out in Annex II shall enter into force on July 1, 2009, and shall apply to any international application whose international filing date is on or after July 1, 2009.

“(3) The amendments of Rule 46.5, 66.8 and 70.16 set out in Annex II shall enter into force on July 1, 2009, and shall apply shall apply to any international application in respect of which an amendment under Article 19 or 34 is made on or after July 1, 2009.”

[Annex IV follows]

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 Annexes I and II. Proposed decisions concerning entry into force and transitional arrangements are set out in Annex III.

2. 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 Annexes I and III, with an explanation, where necessary, in this Annex. Information concerning proposed further drafting changes was posted by the Secretariat on the Working Group's electronic forum on the WIPO website¹ for comments and suggestions by delegations and representatives. The proposals contained in this document take into account the comments and suggestions received.

SUPPLEMENTARY INTERNATIONAL SEARCH

3. See the proposed amendments of Rules 45*bis*.2, 45*bis*.3, 90.1, 90.4, 90.5, 90*bis*.5 and 90*bis*.6, and the proposed addition of new Rule 90*bis*.3*bis*, set out in Annex I, with the proposed date of entry into force of January 1, 2009, and proposed transitional arrangements set out in Annex III. Details of consideration of the matter by the Working Group at its first session are set out in document PCT/WG/1/16, paragraphs 98 to 105 (reproduced in Annex I to document PCT/A/38/1).

4. The proposed amendments, which are in the nature of consequential amendments based on the amendments to the Regulations adopted by the Assembly on October 3, 2007, with effect from January 1, 2009, introducing the supplementary international search system, concern the refund of the supplementary search handling fee and the supplementary search fee (Rules 45*bis*.2 and 45*bis*.3); the right of agents to practice before any International Authority specified to carry out a supplementary international search (Rules 90.1, 90.4 and 90.5.); and the effects of a withdrawal of a request for supplementary international search (Rules 90*bis*.3*bis*, 90*bis*.5 and 90*bis*.6).

Proposed amendments of Rules 45bis.2 and 45bis.3

5. At present, the provisions concerning the refund of the supplementary search handling fee and the supplementary search fee (Rules 45*bis*.2(d) and 45*bis*.3(d) and (e), respectively, as adopted by the Assembly on October 3, 2007, with effect from January 1, 2009) only provide for a refund of those fees where the request for supplementary search is withdrawn by the applicant or considered not to have been submitted. The present provisions do not, however, provide for a refund of those fees where the international application itself is withdrawn or considered withdrawn.

¹ www.wipo.int/pct-wg/en/index.html

6. It is thus proposed to fill this apparent gap by amending Rules 45bis.2(d) and 3(d) accordingly. Similar to the provisions governing the refund of the (main) search fee where the international application is withdrawn or considered withdrawn (Rule 16.2(ii): the main search fee is refunded only where the application is withdrawn or considered withdrawn before the transmittal of the search copy to the International Searching Authority), it is proposed to provide that the supplementary search handling fee and the supplementary search fee will only be refunded if the international application is withdrawn or considered withdrawn, or if the request for supplementary international search is withdrawn or considered not to have been submitted, before the transmittal of the documents referred to in Rule 45bis.4(e)(i) to (iv) to the Authority specified for supplementary search.

Proposed amendments of Rules 90.1, 90.4 and 90.5

7. Present Rule 90 does not deal with the issue of the right of an agent to practice in respect of the international application before any International Searching Authority which the applicant has requested to carry out a supplementary international search. It is thus proposed to amend Rule 90 to include provisions relating to the appointment of an agent to practice before the Authority specified for supplementary search (Rule 90.1), the manner of such an appointment (Rule 90.4) and procedures where the appointment is made in a general power of attorney (Rule 90.5).

Proposed amendments of 90bis.5 and 90bis.6, and proposed addition of new Rule 90bis.3bis

8. Although a right to withdraw a request for supplementary international search is implied by the wording of Rule 45bis.2(d) as adopted by the Assembly on October 3, 2007, with effect from January 1, 2009, at present, the Regulations do not provide for the requirements nor for the effects of such a withdrawal, as does present Rule 90bis for the other types of withdrawal, such as withdrawal of the international application, of priority claims, of the demand and of elections.

9. It is thus proposed to amend Rule 90bis so as to provide, in particular:

(a) for a time limit within which a withdrawal of a request for supplementary search can be made (at any time prior to the date of transmittal to the applicant and to the International Bureau of the supplementary search report, or the declaration that no such report will be established (proposed new Rule 90bis.3bis(a));

(b) the date as of which a request for withdrawal shall be effective (the date of receipt of the notice of withdrawal by the Authority specified for supplementary search or by the International Bureau (proposed new Rule 90bis.3bis(b)); and

(c) the effects of a withdrawal of a request for supplementary international search (the supplementary international search by the Authority specified for supplementary search shall be discontinued (proposed new Rule 90bis.6(b-bis)).

10. Further drafting changes have been made to Rule 90*bis.3bis*(b), beyond the text as agreed by the Working Group, to ensure that the communication under Article 20(1) (as applicable by virtue of Rule 45*bis.8*) of the supplementary search report, or of the declaration that no such report would be established, will be effected not only where the supplementary search request was validly withdrawn in a notice submitted to the International Bureau and transmitted by that Bureau to the Authority carrying out the supplementary international search only after that Authority had sent the supplementary search report to the applicant (and to the International Bureau), but also in the case where the supplementary search request was validly withdrawn in a notice submitted to the Authority, but received by that Authority too late to prevent the transmission of the supplementary search report to the applicant (and to the International Bureau) (document PCT/WG/1/16, paragraph 102).

11. Further drafting changes have been made to Rule 90*bis.5*(b)(i), beyond the text as agreed by the Working Group. The text now also refers to “the Authority carrying out the supplementary international search” as a possible recipient of a statement explaining the lack of signature of one of the applicants (document PCT/WG/1/16, paragraph 103).

12. Further drafting changes have been made to 90*bis.6*(b-*bis*)), beyond the text as agreed by the Working Group. The words “the processing of the international application by the Authority specified for supplementary search shall be discontinued” have been replaced with the words “the supplementary international search by the Authority concerned shall be discontinued” so as to clarify that, where a request for supplementary search was withdrawn under Rule 90*bis.3bis*, it was the supplementary international search by the Authority carrying out that search, and not the processing of the entire international application, that would be discontinued (document PCT/WG/1/16, paragraph 104).

PROCESSING OF THE INTERNATIONAL APPLICATION UNDER ARTICLE 14(4)

13. See the proposed amendments of Rule 29.4 set out in Annex I, with the proposed date of entry into force of January 1, 2009. Details of consideration of the matter by the Working Group at its first session are set out in document PCT/WG/1/16, paragraphs 135 to 139 (reproduced in Annex I to document PCT/A/38/1).

14. The proposal is to provide that the receiving Office, where it has accorded, albeit mistakenly, an international filing date and intends to issue a declaration under Article 14(4) that the international application is to be considered withdrawn because it does not contain the claim(s) *element* or the description *element* (Article 11(1)(iii)(d) and (e)), shall, when it notifies the applicant of its intent to issue such declaration, invite the applicant to confirm that the element in question is incorporated by reference. In this context, it is also proposed to extend the time limit for response to the notification of intent from one to two month so as to correspond to the time limit for response to an invitation to incorporate by reference any missing element or part.

15. Further drafting changes have been made to Rule 29.4, beyond the text as agreed by the Working Group. A new paragraph (c) has been added to clarify that receiving Offices which had informed the International Bureau of the incompatibility of the provisions relating to the incorporation by reference with their applicable national law would not be required to issue an invitation to confirm that the element in question is incorporated by reference (document PCT/WG/1/16, paragraph 139).

AMENDMENT OF CLAIMS

16. See the proposed amendments of Rules 46.5 and 66.8 set out in Annex I, with the proposed date of entry into force of January 1, 2009. Details of consideration of the matter by the Working Group at its first session are set out in document PCT/WG/1/16, paragraphs 144 to 149 (reproduced in Annex I to document PCT/A/38/1).

17. Currently, when amending the claims in an international application under Articles 19 or 34, the applicant is required to submit a replacement sheet only for those sheets of claims which, on account of an amendment, differ from the sheet previously filed. This can result in confusion and increased workload for examiners, both in Chapter II and in the national/regional phase, as they must then sort through multiple sets of claims to determine which sheets contain the actual set of claims to be examined. The proposal is to require that, in the case of amendments of the claims under Articles 19 and 34, applicants submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed rather than, as at present, replacement sheets only for those sheets of claims which, on account of an amendment, differed from sheets previously filed.

18. Further drafting changes have been made to Rules 46.5 and 66.8, beyond the text as agreed by the Working Group. Rules 46.5(a) and (b) as proposed to be amended have been further changed to state more clearly that the applicant, when making amendments under Article 19, is required to submit a replacement sheet or sheets containing a complete set of the claims in replacement of all the claims originally filed. Furthermore, a new sentence has been added to Rule 66.8(c) to state more clearly that the set of claims furnished by the applicant shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

19. A further drafting change, beyond the amendments of the Regulations agreed by the Working Group, has been made to Rule 70.16. Consequential on the proposed amendments of Rules 46.5 and 66.8, it is proposed to amend Rule 70.16 accordingly.

[Annex V follows]

ANNEX V

PROPOSED AMENDMENTS OF THE PCT REGULATIONS
(clean text)

Proposed amendments of the PCT Regulations are set out in Annexes I and II, 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.

TABLE OF CONTENTS

Rule 29	International Applications Considered Withdrawn	2
	29.1 to 29.3 [No change]	2
	29.4 <i>Notification of Intent to Make Declaration Under Article 14(4)</i>	2
Rule 45bis	Supplementary International Searches.....	3
	45bis.1 [No change].....	3
	45bis.2 <i>Supplementary Search Handling Fee</i>	3
	45bis.3 <i>Supplementary Search Fee</i>	3
	45bis.4 to 45bis.9 [No change]	3
Rule 46	Amendment of Claims before the International Bureau.....	4
	46.1 to 46.4 [No change]	4
	46.5 <i>Form of Amendments</i>	4
Rule 66	Procedure before the International Preliminary Examining Authority.....	5
	66.1 to 66.7 [No change]	5
	66.8 <i>Form of Amendments</i>	5
	66.9 [No change]	5
Rule 70	International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report).....	6
	70.1 to 70.15 [No change]	6
	70.16 <i>Annexes to the Report</i>	6
	70.17 [No change]	6
Rule 90	Agents and Common Representatives	7
	90.1 <i>Appointment as Agent</i>	7
	90.2 and 90.3 [No change].....	7
	90.4 <i>Manner of Appointment of Agent or Common Representative</i>	8
	90.5 <i>General Power of Attorney</i>	8
	90.6 [No change]	8
Rule 90bis	Withdrawals	9
	90bis.1 to 90bis.3 [No change].....	9
	90bis.3bis <i>Withdrawal of Request for Supplementary International Search</i>	9
	90bis.4 [No change].....	9
	90bis.5 <i>Signature</i>	9
	90bis.6 <i>Effect of Withdrawal</i>	10
	90bis.7 [No change].....	10

Rule 29
International Applications Considered Withdrawn

29.1 to 29.3 [No change]

29.4 *Notification of Intent to Make Declaration Under Article 14(4)*

(a) Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefore. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within two months from the date of the notification.

(b) Where the receiving Office intends to issue a declaration under Article 14(4) in respect of an element mentioned in Article 11(1)(iii)(d) or (e), the receiving Office shall, in the notification referred to in paragraph (a) of this Rule, invite the applicant to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18. For the purposes of Rule 20.7(a)(i), the invitation sent to the applicant under this paragraph shall be considered to be an invitation under Rule 20.3(a)(ii).

(c) Paragraph (b) shall not apply where the receiving Office has informed the International Bureau in accordance with Rule 20.8(a) of the incompatibility of Rules 20.3(a)(ii) and (b)(ii) and 20.6 with the national law applied by that Office.

Rule 45bis
Supplementary International Searches

45bis.1 [No change]

45bis.2 *Supplementary Search Handling Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

45bis.3 *Supplementary Search Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

(e) [No change]

45bis.4 to 45bis.9 [No change]

Rule 46
Amendment of Claims before the International Bureau

46.1 to 46.4 [No change]

46.5 *Form of Amendments*

(a) The applicant, when making amendments under Article 19, shall be required to submit a complete set of the claims in replacement of all the claims originally filed.

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;

(ii) shall identify the claims originally filed which, on the account of the amendments, are cancelled.

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 *Form of Amendments*

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) [No change]

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

66.9 [No change]

Rule 70
International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a), (b) or (c) and each replacement sheet under Rule 46.5(a) containing amendments under Article 19 shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Replacement sheets under Rule 46.5(a) containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rules 46.5(b) and 66.8 shall not be annexed.

(b) [No change]

70.17 [No change]

Rule 90
Agents and Common Representatives

90.1 *Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority.

(b) [No change]

(b-bis) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) [No change]

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) specifically before the International Searching Authority, any Authority specified for supplementary search or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, the Authority specified for supplementary search or International Preliminary Examining Authority, as the case may be.

90.2 and 90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) [No change]

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (b-*bis*), (c) or (d)(ii), it shall be submitted to the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

(c) [No change]

(d) Subject to paragraph (e), any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches, 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) [No change]

90.5 *General Power of Attorney*

(a) [No change]

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (b-*bis*), (c) or (d)(ii), it shall be deposited with the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

(c) Any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 to the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be, a copy of the general power of attorney shall be submitted to that Office or Authority.

90.6 [No change]

Rule 90bis
Withdrawals

90bis.1 to 90bis.3 [No change]

90bis.3bis Withdrawal of Request for Supplementary International Search

(a) The applicant may withdraw a request for supplementary international search at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45bis.8(a), of the supplementary search report or the declaration that no such report will be established.

(b) Withdrawal shall be effective on receipt, within the time limit under paragraph (a), of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in paragraph (a), the communication of that report or declaration under Article 20(1), as applicable by virtue of Rule 45bis.8(b), shall nevertheless be effected.

90bis.4 [No change]

90bis.5 *Signature*

(a) [No change]

(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 90bis.1 to 90bis.4 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 receiving Office, the International Bureau, the Authority carrying out the supplementary international search or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d), 90bis.3(c) or 90bis.3bis(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) [No change]

90bis.6 *Effect of Withdrawal*

(a) and (b) [No change]

(b-*bis*) Where a request for supplementary international search is withdrawn under Rule 90bis.3*bis*, the supplementary international search by the Authority concerned shall be discontinued.

(c) [No change]

90bis.7 [No change]

[End of Annex V and of document]