

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Fourth (19th Ordinary) Session
Geneva, September 23 to October 2, 2013

PROPOSED AMENDMENTS TO 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 PCT Working Group (“the Working Group”). The proposed amendments, which are set out in Annex I, relate to the following matters:

- (a) mandatory top-up searches (proposed amendment of Rules 66 and 70);
- (b) availability of written opinion by the International Searching Authority as of the date of international publication (proposed deletion of Rule 44~~ter~~ and proposed amendment of Rule 94).

¹ References in this document to “Articles” and “Rules” are to those of the 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.

PROPOSED AMENDMENTS

MANDATORY TOP-UP SEARCHES

2. The Working Group, at its sixth session held from May 21 to 24, 2013, approved the proposed amendments of Rules 66 and 70 with a view to their submission to the Assembly for consideration at its present session, subject to any further comments to be made by Contracting States or affected Offices during a short consultation period to be set by the International Bureau following the session (see paragraphs 33 of the Summary by the Chair of the session, document PCT/WG/6/23, reproduced in the Annex to document PCT/A/44/1).

3. The proposed amendments of Rules 66 and 70 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 and an explanation is given in a footnote in the said Annex. Information concerning proposed changes was posted by the Secretariat on the Working Group's electronic forum on the WIPO web site² for comments by Contracting States or affected Offices. The proposals contained in this document take into account the comments and suggestions received.

4. The effect of amendments of Rules 66 and 70 would be to require International Preliminary Examining Authorities to conduct a "top-up" search during international preliminary examination subject to various exceptions, such as subject matter which is not examined by the Office, cases which have not been searched by the International Searching Authority and other cases where it is considered that such a search would serve no useful purpose.

5. In approving the proposed amendments of Rules 66 and 70, the Working Group recognized that a number of details will need to be addressed in further discussions with regard to appropriate modifications of the Administrative Instructions (notably the relevant forms) and of the International Search and Preliminary Examination Guidelines. Proposals for appropriate modifications of the Administrative Instructions, including of Forms IPEA/408 and IPEA/409, and of the International Search and Preliminary Examination Guidelines will be the subject of further consultation with Member States prior to entry into force of the amendments, if approved by the Assembly.

AVAILABILITY OF WRITTEN OPINION BY THE INTERNATIONAL SEARCHING AUTHORITY AS OF THE DATE OF INTERNATIONAL PUBLICATION

6. The Working Group at its sixth session further approved the proposed deletion of Rule 44~~ter~~ and, consequential on that deletion, the proposed amendment of Rule 94 set out in Annex I to this document, with a view to their submission to the Assembly for consideration at its present session (see paragraphs 78 and 79 of the Summary by the Chair of the session, document PCT/WG/6/23, reproduced in the Annex to document PCT/A/43/1).

7. The effect of these changes would be to allow written opinions of the International Searching Authority (in their original language) and informal comments submitted by the applicant in response to such opinions (in their original language) to be available on PATENTSCOPE from the date of international publication. The international preliminary report on patentability and the translation of that report will continue to be established at 30 months from the priority date.

CLEAN" TEXT OF PROPOSED AMENDED PROVISIONS

8. A "clean" text of all of the proposed amended provisions (without underlining or striking through) appears in Annex II to this document.

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

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

9. Information concerning proposed dates of entry into force of the amendments and required transitional arrangements was posted by the Secretariat on the Working Group's electronic forum on WIPO's web site³ for comments and suggestions. The proposals contained in this document take into account the comments and suggestions received.

10. With regard to the proposed amendments of Rules 66 and 70, in order to allow for sufficient time for International Preliminary Examining Authorities to update existing IT systems and internal processes and procedures, it is proposed that those amendments should enter into force on July 1, 2014, and apply only to international applications in respect of which a demand is filed on or after that date.

11. With regard to the proposed deletion of Rule 44~~ter~~ and the proposed amendment of Rule 94, it is proposed that this deletion and this amendment should enter into force on July 1, 2014, and should apply only to international applications filed on or after July 1, 2014. No specific transitional arrangements appear to be necessary.

12. It is thus 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 to this document:

"The amendments of Rules 66 and 70 set out in Annex I to this document shall enter into force on July 1, 2014, and shall apply to any international application, irrespective of its international filing date, in respect of which a demand for international preliminary examination is made on or after July 1, 2014."

"The deletion of Rule 44~~ter~~ and the amendment of Rule 94 set out in Annex I to this document shall enter into force on July 1, 2014, and shall apply to any international application whose international filing date is on or after July 1, 2014."

13. *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 to this document; and

(ii) to adopt the proposed decisions set out in paragraph 12, above, relating to entry into force and transitional arrangements.

[Annexes follow]

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

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. A “clean” copy of the proposed amended provisions (without underlining or striking through) appears in Annex II.

Rule 44ter

[Deleted]

**~~Confidential Nature of Written Opinion,
Report, Translation and Observations~~**

~~44ter.1—Confidential Nature~~

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

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

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

~~(b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.~~

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 and 66.1bis [No Change]

66.1ter Top-up Searches²

The International Preliminary Examining Authority shall conduct a search (“top-up search”) to discover documents referred to in Rule 64 which have been published or have become available to the said Authority for search subsequent to the date on which the international search report was established, unless it considers that such a search would serve no useful purpose. If the Authority finds that any of the situations referred to in Article 34(3) or (4) or Rule 66.1(e) exists, the top-up search shall cover only those parts of the international application that are the subject of international preliminary examination.

66.2 to 66.8 [No Change]

² Further drafting changes have been made to Rule 66.1ter, beyond the text as agreed by the Working Group, based on comments by a Contracting State received by the International Bureau following the sixth session of the Working Group (see paragraphs 2 and 3 in the main body of this document). So as to clarify the meaning of the second sentence of proposed new Rule 66.1ter as originally agreed by the Working Group (“Article 34(3) and (4) and Rules 66.1(e) and 68 shall apply *mutatis mutandis*.”), the second sentence of proposed new Rule 66.1ter has been further changed, in line with the discussions during the sixth session of the Working Group and Comment 2 set out in Annex I to document PCT/WG/6/23 (“The final sentence covers the specific cases where the top-up search should be omitted or limited because of no (or limited) main international search, subject matter not to be examined or lack of unity of invention.”).

Rule 70

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

70.1 *[No Change]*

70.2 *Basis of the Report*

(a) to (e) [No change]

[\(f\) The report shall indicate the date on which a top-up search under Rule 66.1ter was made, or else state that no top-up search was made.](#)

70.3 to 70.17 *[No Change]*

Rule 94

Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 ~~and Rule 44ter.1~~, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(c) [No change]

94.2 and 94.3 *[No change]*

[Annex II follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

(CLEAN TEXT)

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 provisions as they would stand after amendment.

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Rule 44ter

[Deleted]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 and 66.1.bis *[No Change]*

66.1ter *Top-up Searches*

The International Preliminary Examining Authority shall conduct a search (“top-up search”) to discover documents referred to in Rule 64 which have been published or have become available to the said Authority for search subsequent to the date on which the international search report was established, unless it considers that such a search would serve no useful purpose. If the Authority finds that any of the situations referred to in Article 34(3) or (4) or Rule 66.1(e) exists, the top-up search shall cover only those parts of the international application that are the subject of international preliminary examination.

66.2 to 66.8 *[No change]*

Rule 70

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

70.1 *[No change]*

70.2 *Basis of the Report*

(a) to (e) *[No change]*

(f) The report shall indicate the date on which a top-up search under Rule 66.1*ter* was made, or else state that no top-up search was made.

70.3 to 70.17 *[No change]*

Rule 94

Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(c) [No change]

94.2 and 94.3 *[No change]*

[End of Annex II and of document]