

WIPO



PCT/A/VII/2
ORIGINAL: English
DATE: April 6, 1981

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Seventh Session (5th Extraordinary)*
Geneva, June 29 to July 3, 1981

PROPOSED REVISION OF THE REQUEST FORM

Memorandum prepared by the International Bureau

BACKGROUND

1. Certain proposals for the revision of the “request” form (form PCT/RO/101), made by one of the organizations representing users of the PCT system were brought to the attention of the Assembly at its fifth session (third extraordinary) held in Geneva from June 9 to 16, 1980, but, due to the need for further study, no proposal for the revision of the form was made at that session by the International Bureau. The International Bureau said (in document PCT/A/V/4 Corr.Add., page 2), however, that it agreed “that a change of the request form should be considered having particular regard to the mistakes made by applicants when filling in that form (see document PCT/A/V/6 Add.2).”
2. Furthermore, it was noted in the report of the said fifth session that, due to a lack of time, a discussion was not possible of the desirability of revising the request form during the consultations (relating to the Administrative Instructions as provided in Rule 89.2(a)) which were held on the occasion of the said fifth session with the receiving Offices and the International Searching and Preliminary Examining Authorities but that the question would be studied by the International Bureau (see document PCT/A/V/17, paragraph 59).

* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

3. The present document contains in its Annex A, a draft of a revised version of the request form (“the proposed request form”) and of the Notes thereto which is the result of a study carried out by the International Bureau.
4. In preparing the proposed request form, the International Bureau had regard to:
 - (i) the improvements requested by the organization representing users of the PCT system (see paragraph 1, above);
 - (ii) the most frequent mistakes it had noticed as having been made by applicants in completing the present version of the request form (“the current request form”), including those mentioned in document PCT/A/V/6 Add.2;
 - (iii) the desirability of omitting certain items dealt with in the current request form since, in practice, the matters provided therein arise only infrequently and either lead to confusion and error or occupy space which could be utilized more effectively for the purposes of other items included in the request form; and
 - (iv) changes effected in the last sessions of the PCT Assembly in the PCT Regulations which require consequential changes in the current request form.

Improvements Requested by PCT Users

5. The changes requested by the users of the PCT system (paragraph 4 (i), above) were:
 - (i) that particulars of the inventor need be given only once;
 - (ii) that, where one of the applicants has already, prior to the filing of the international application, given a general power of attorney for the agent named, the agent should be entitled to sign the international application for that applicant (the other applicants will still have to sign);
 - (iii) that more space should be provided in the appropriate boxes for Applicant, Designation of States and Priority Claim so that the cases in which the Supplemental Box is needed should become less frequent.

Mistakes Noticed by International Bureau

6. Some of the mistakes mentioned below (but not all) are probably due to the weaknesses of the current request form. They consist of:
 - (a) The following mistakes noticed by PCT users (see document PCT/A/V/6 Add.2):
 - (i) failure to complete Boxes Nos. II and IX of the current request form correctly (the applicant for the United States of America being indicated in Box No. IX but not also in Box No. II);
 - (ii) omission of indications of applicants’ nationality and residence when indications concerning applicants are given in the Supplemental Box;

- (iii) failure to indicate names of natural person in the manner prescribed in Rule 4.4(a) (which requires that the person's family name be indicated before the person's given name(s));
 - (iv) designating the "OAPI States" incorrectly;
 - (v) failure to indicate in the priority claim the country where the earlier application was filed;
 - (vi) indication of irrelevant matter in Box No. VII of the current request form due to apparent lack of understanding of its purpose; (indication of a priority application instead of a parent application);
 - (vii) failure, when there are different applicants for different designated States, to include in Box IX of the current request form indications regarding all of the applicants;
 - (viii) failure of persons signing specifically in a representative capacity (e.g., as representative of a legal entity) to also sign in a personal capacity when the person signing is also an applicant in his own right; and
- (b) The following additional mistakes noticed by the International Bureau:
- (i) the applicant's nationality is not completed correctly (because an adjective describing the nationality has been used and not the name of the country, e.g., "Austrian" rather than "Austria");
 - (ii) the applicant's residence (indicated by the name of the country) is left blank since it is the same country as that shown in the address;
 - (iii) inappropriate short titles are used for the designation of States;
 - (iv) failure to indicate that a regional (European) rather than a national patent was desired.

Recent Amendments to the regulations

7. The following amendments to the PCT Regulations have been taken into account:

- (i) with regard to indications concerning the agent (Box No. IV of the current request form), the possibilities now provided for in Rule 90.3(a) that, where there are several applicants, the agent may be appointed- by one or more applicants signing the request and by others signing a separate power of attorney and in Rule 90.3(d) that a general power of attorney may be utilized provided that a copy is supplied;
- (ii) with regard to the priority claim (Box No. VI of the current request form), the possibility provided for in Rule 17.1(b) of asking the receiving Office to

transmit the priority document to the International Bureau where that Office is the Office with which the earlier document was filed;

- (iii) with regard to a reference to an earlier international or international-type search, (Box No. VIII of the current request form), the inclusion, as provided in Rules 4.11 and 41.1, of reference to "other search."

The Proposed Request Form

8. The paragraphs below comment on each of the boxes of the proposed request form.

Box No. I

9. Apart from the size of the box being slightly reduced, this box is the same as in the current request form. Such reduction should invite applicants to use titles of the recommended length.

Boxes Nos. II and III

10. These Boxes permit indications to be given concerning three persons who are applicants and/or inventors provided that one person at least is an applicant. The latter (who may or may not also be inventor) must be indicated in Box No. II. Each of the additional persons may be in any of the following categories: applicant and inventor, applicant only, inventor only. The category must be shown by completion of the appropriate check box. The new arrangement not only meets the desire mentioned in paragraph 5(i), above, to avoid any need to repeat the name of a person who is both applicant and inventor (as is necessary with the current request form when there are several applicants not all of whom are inventors and there are different applicants for different designated States) but also makes provision for indications concerning possibly two (but always at least one) additional person(s) without restriction due to the category to which the person may belong before recourse must be had to the Supplemental Box. It is considered that the number of cases in which recourse to the Supplemental Box will be necessary (see paragraph 5(iii), above) will be reduced to reasonable proportions (less than 5% of the cases).

11. Since applicants may be indicated in Box No. III, provision has been made therein for all of the indications (name, address, nationality, residence) which must be given regarding an applicant. The text makes it clear that the indications as to nationality and residence are not to be given if the person indicated is inventor only.

12. The confusion which sometimes occurs as to how to complete Boxes Nos. II and IX of the current request form (see paragraphs 6(a) (i) and (vii), above) is avoided by the providing of indications (explained in the next paragraph) which allowed the deletion of Box No. IX of the current request form.

13. In practice, all except a small percentage of applicants fall into one of the following three categories;

- (i) applicant for all designated States (including the case of a single designated State) (i.e., there are no different applicants for different designated States);
- (ii) applicant for all designated States except the United States of America (i.e., the United States of America and other States are designated and there are applicants who are not inventors);
- (iii) applicant for the United States of America only (i.e., the United States of America and other States are designated and the inventors, who have assigned the invention, are the applicants for the purposes of the designation of the United States of America only).

Check boxes corresponding to these categories and an additional box for the (very few) cases, where none of these three categories is applicable (to be completed in such cases by precise indications in the Supplemental Box as to the particular States for, which the person in question is applicant) have been provided (and must be completed).

14. With a view to avoiding mistakes in the manner of indicating names (see paragraph 6(a) (iii), above), a footnote specifies the correct manner; likewise, an indication that it is the country of nationality or residence which must be given should limit the mistakes made in completing these indications (see paragraph 6(b) (i), above). A further footnote makes it unnecessary, in fact, to indicate the country of residence where that country is the same as that indicated in the address, thus avoiding any need to correct the omission of the indication of the country of residence (see paragraph 6(b) (ii), above).

15. The other footnote to Boxes Nos. II and III requires the indication in the Supplemental Box of the designated State for, which a person is inventor if there are different inventors for different designated States. Experience to date has shown that it is extremely rare for different inventors to be indicated for different designated States. The allocation of space in the request form for a Box for these indications does not seem justified and accordingly Box No. X of the current request form has been deleted from the proposed request form (see in this regard paragraph 4(iii), above).

Box No. IV

16. The box provides for the indication of the name and address of the agent (or, in the case of several agents having the same address, their names and addresses) or where, instead of an agent, one of the applicants is appointed common representative, the name of such common representative. Provision is also made for the indication of the telephone number, telegraphic address and teleprinter address of the agent(s) named in the box. The box has three check boxes one of which must always be checked. Starting with the left hand check box, the checking of the first check-box indicates that the appointment of the agent (or common representative) is effected by signature of the request; the checking of the second check-box indicates that the appointment was effected by a separate power of attorney signed by all of the applicants or at least those not signing the request; the checking of the third check-box indicates that the appointment was effected by a general power of attorney signed by all of the

applicants or at least by those not signing the request. The box provides for much more space than the current request form does.

17. The new text and format take into account the amendments to Rule 90.3(a) and (d) adopted at the fifth session of the Assembly (see paragraph 7(i), above).

Box No. V

18. The primary purpose of this box is the designation of the States in which protection is desired. Where a European patent as well as national patent is available, the applicant must indicate whether he wants a national patent or a European patent or both. The subsidiary purpose of the box is to allow indications regarding possible kinds of protection other than a patent or special kinds of treatment. By other kinds of protection is meant petty patents, utility models, inventors' certificates, whereas by other kinds of treatment is meant titles (e.g., patents, inventors' certificates) of addition and, in the United States of America, continuation or continuation-in-part.

19. The general purpose of Box No. V and the indications it may contain are not changed significantly in the proposed request form. But, whereas in the current request form a blank space is provided in which the applicant must write the names of the States in which he wishes the international application to have effect and any desired indications of the choice of a European patent and/or certain kinds of protection or treatment (but not of a continuation or continuation-in-part in the United States of America), this is changed in the proposed request form to the extent that the names of the PCT Contracting States are preprinted together with check boxes to be used for the indication of designations and the choice of a national and/or European patent. The indication as to kinds of protection and kinds of treatment (including continuation or continuation-in-part in the United States of America) would be simply written in by the applicant where desired in a space reserved for that effect after the check box relating to the national patent. A footnote (relating to certain check boxes) draws attention to the existence of instructions in the Notes to the proposed request form on how the indications are to be made. The check boxes have been arranged so as to provide space for the indications to be inserted in those cases where the applicant has a choice.

20. The names of the countries (and of the EPO and of OAPI) appear in the alphabetical order of the two-letter codes with the result that, whatever the language of the request form is, the order of the countries remains the same.

21. Possible objections to the proposed pre-printing of the names of Contracting States may be that a mistake could be made in checking a box, or that the pre-printed names will have to be added to from time to time as more countries join the PCT, or that the order in which States are listed could have implications if some designation fees are unpaid.

22. The avoidance of mistake cannot, however, be ruled out with the current request form with which there may be a tendency to fail to list countries which it was intended to designate or to fail to indicate clearly whether a European or a national patent is sought. The only solution finally is to permit the correction of what can be demonstrated to be errors. It is not considered that the need to add new member countries is a major objection and, in the period from entry into force of the PCT for new States and their inclusion in the list printed in the form, the space at the bottom of Box No. V should be sufficient for the listing of such countries by the applicant.

23. The need existing under the current request form for users of the PCT system to frequently list countries in the Supplemental Box has been criticized (see paragraph 5(iii), above). The proposed request form ensures that recourse will never be needed to the Supplemental Box for the designation of States. Moreover, the printing of the correct names of the Contracting States in the form itself will not only avoid mistakes due to the use of incorrect names but serve as a guide to the names to be shown elsewhere in request.

24. As far as failure to pay designation fees is concerned, it must be agreed that the listing in the alphabetical order of country codes may lead to an unintended result flowing from the application of provisions such as Rule 16*bis*.2(c) (ii). However, at present many applicants probably act in ignorance of such provisions. Those who do not will have two possible safeguards. First of all, Rule 16*bis* is a safeguard since it requires a notification to be given to the applicant. Then the possibility of indicating preferences in the Supplemental Box is expressly invited in the note to that Box.

Box No. VI

25. This box has been changed in order to satisfy the demand for a revision of the form which would allow several priority claims to be indicated (see paragraph 5(iii), above) and to take into account the amendment of Rule 17.1(b) accepted at the fifth session of the Assembly (see paragraph 7(ii), above).

26. While certain changes to the text and layout have been made, the only substantive change is in the extreme left-hand column which now suggests the indication of only one country in the case of all kinds of earlier application (i.e., international and regional as well as national).

Box No. VII

27. Textual changes mainly reflect the amendment to Rules 4.11 and 41 adopted at the fifth session of the Assembly (see paragraph 7(iii), above).

Box No. VIII

28. This box has been enlarged to allow more signatures and, if so desired, the typing in of the name of the person signing and, where appropriate, the capacity in which the person is signing. Reference to signature by the agent as well as by the applicant has been included in the title.

Box No. IX

29. The changes take into account the documents which may, under the present practice, accompany the international application when it is filed.

Supplemental Box

30. This box has been changed in two main respects. First, it has a whole sheet devoted 'to it so that, when not used, it may be discarded and thereby ease the reproduction work. In fact, it is not expected that the sheet will be used often. This is so because the reason for the use of the box at present (insufficient space in certain boxes) should largely disappear with the other changes made in the proposed request form.

31. Secondly, certain items for which special boxes are provided in the current request form but for which no special box is included in the proposed request form are, as has been noted, envisaged to be indicated in the Supplemental Box. These items are listed in the heading of the Supplemental Box, and specific instructions are given as to the text matter which should be used when those items are to be included in the request. Furthermore, due to the pre-printing of the names of States for the purposes of indicating designations, the applicant may, if he wishes, indicate an order of designations which, however, will only be of relevance where not all designation fees are paid.

32. The possibility of using the Supplemental Box, as at present, in cases where there is insufficient space in a box to include the indications required will continue unchanged.

Consequential Amendments to Rules 3 and 4 of the PCT Regulations

33. Rule 3.3(a) (ii) containing the list of documents which make up the check list of the documents that may accompany the international application will need to be amended mainly to include a reference to the power of attorney or the copy of a general power of attorney referred to in paragraph 16, above.

34. Certain of the provisions of Rule 4 will also need to be amended mainly in view of the amendments referred to in paragraph 7(i) and (ii). Annex B contains (on its right hand side pages) the texts of proposed amendments and (on its left hand side pages) the explanations of the International Bureau of the reasons for the amendments.

35. It is to be noted that none of the proposed amendments affects in any way the rights and obligations of the receiving Offices, a fact that should facilitate their approval.

36. *The Assembly is invited to consider and, if it agrees,*

(i) *to adopt the amendments to the PCT regulations contained in Annex B;*

(ii) *to fix September 1, 1981, as the day on which the said amendments shall enter into force.*

Consequential Amendments to the Administrative Instructions

37. Certain Sections of the Administrative Instructions will need to be amended mainly having regard to the inclusion of preprinted indications with associated check boxes in the proposed request form.

38. Annex C contains (on its right hand side pages) the texts of proposed amendments to certain Sections and (on its left hand side pages) the explanations of the International Bureau.

[Annex A follows]

ANNEX A

CONTENTS OF ANNEX A

Request Form

- (1) First sheet (recto only)
- (2) Second sheet (recto only)
- (3) Supplemental sheet (recto only)
- (4) Last sheet (recto only)

Notes to Request Form

- (5) 1 sheet (recto-verso)

Box No. IV AGENT (IF ANY) OR COMMON REPRESENTATIVE (IF ANY). A common representative may be appointed only if there are several applicants and if no agent is or has been appointed; the common representative must be one of the applicants.

The following person is hereby/has been appointed as agent or common representative to act on behalf of the applicant(s) before the competent International Authorities:

Name and address (including postal code and country):

Telephone number:
(including area code)

Telegraphic address:

Teleprinter address:

If the present "Request" form is not signed by the applicant (or, where there are several applicants, by all of them), a separate power of attorney signed by the applicant (or at least those of the several applicants who do not sign the present form) must be attached to the present form. If a signed general power of attorney is already in the possession of the receiving Office, an unsigned copy thereof must be attached to this form.

the present Request form is signed by (all) the applicant(s)

a separate power of attorney is attached

copy of a general power of attorney is attached

Box No. V DESIGNATION OF STATES; POSSIBLE CHOICE OF EUROPEAN PATENT; POSSIBLE CHOICES OF CERTAIN KINDS OF PROTECTION OR TREATMENT. Where the name of a State is followed by two check boxes, a European patent and/or a national patent may be requested, that is, either or both of the boxes may be checked. Designation of Switzerland includes designation of Liechtenstein (and vice-versa).

The following States are hereby designated:		National Patent (if other national title or treatment desired, specify)*	European Patent
AT	Austria _____	<input type="checkbox"/> *	<input type="checkbox"/>
AU	Australia _____	<input type="checkbox"/> *	
BR	Brazil _____	<input type="checkbox"/> *	
CH and LI	Switzerland and Liechtenstein _____	<input type="checkbox"/>	<input type="checkbox"/>
DE	Federal Republic of Germany _____	<input type="checkbox"/> *	<input type="checkbox"/>
DK	Denmark _____	<input type="checkbox"/>	
FI	Finland _____	<input type="checkbox"/>	
FR	France _____ [no national title available] _____		<input type="checkbox"/>
GB	United Kingdom _____	<input type="checkbox"/>	<input type="checkbox"/>
HU	Hungary _____	<input type="checkbox"/>	
JP	Japan _____	<input type="checkbox"/> *	
KP	Democratic People's Republic of Korea _____	<input type="checkbox"/>	
LU	Luxembourg _____	<input type="checkbox"/> *	<input type="checkbox"/>
MC	Monaco _____	<input type="checkbox"/> *	
MG	Madagascar _____	<input type="checkbox"/>	
MW	Malawi _____	<input type="checkbox"/> *	
NL	Netherlands _____	<input type="checkbox"/>	<input type="checkbox"/>
NO	Norway _____	<input type="checkbox"/>	
OA	OAPI (Cameroon, Central African Republic, Chad, Congo, Gabon, Senegal, Togo) _____	<input type="checkbox"/>	
		OAPI Patent (if other OAPI title desired, specify)* _____	
RO	Romania _____	<input type="checkbox"/>	
SE	Sweden _____	<input type="checkbox"/>	<input type="checkbox"/>
SU	Soviet Union _____	<input type="checkbox"/> *	
US	United States of America _____	<input type="checkbox"/>	

Space reserved for designating countries which become party to the PCT after the issuance of the present form (September 1, 1981):

.....

.....

.....

.....

* If another kind of protection is desired or if, in the United States of America, treatment as a continuation or a continuation in part is desired, indicate according to the instructions given in the Notes.

Supplemental Box. Use this box:

(i) *if more than three persons are involved as applicants and/or inventors*; in such case, write "Continuation of Box No. III" and indicate for each additional person the same type of information as required in Box No. III;

(ii) *if, in Box No. II or any of the sub-boxes of Box No. III, the indication "the States indicated in the 'Supplemental Box,' is checked*; in such case, write "Elaboration to Box No. II" or "Elaboration to Box No. III" or "Elaboration to Boxes No. II and No. III" (as the case may be), indicate the name of the applicant(s) involved and, next to (each) such name, the country or countries (or OAPI) for the purposes of which he/she/it is applicant;

(iii) *if, in Box No. II or any of the sub-boxes of Box No. III, the person(s) indicated as "applicant and inventor" or "inventor only" are not inventors for the purposes of all designated States or for the purposes of the United States of America*; in such case, write "Elaboration to Box No. II" or "Elaboration to Box No. III" or "Elaboration to Boxes No. II and No. III" (as the case may be), indicate the name of the inventor(s) involved and, next to (each) such name, the country or countries (or OAPI) for the purposes of which the named person is inventor;

(iv) *if there is more than one agent and their addresses are not the same*; in such case, write "Continuation of Box No. IV" and indicate for each additional agent the same type of information as required in Box No. IV;

(v) *if the order of the designation of the designated States is desired to be different from the order in which the names of the States (and OAPI) appear in Box No. V*; in such case, write "Order of Designations" and list the designated States (and OAPI) in the order desired; the two-letter codes may be used;

(vi) *if, in Box No. V, the name of any country is accompanied by the indication "patent of addition," "certificate of addition," or "inventor's certificate of addition," or if, in Box No. V, the name of the USA is accompanied by an indication "Continuation" or "Continuation in part"*; in such case, write "Continuation of Box No. V" and the name of each country involved, and after the name of each such country, the number of the parent title or parent application and the date of grant of parent title or filing of parent application;

(vii) *if there are more than three earlier applications whose priority is claimed*; in such case, indicate "Continuation of Box No. VI" and indicate for each additional earlier application the same type of information as required in Box No. VI;

(viii) *if, in any of the Boxes, the space is insufficient to furnish all the information*; in such case, write "Continuation of Box No. ..." [indicate the number of the Box] and furnish the information in the same manner as required according to the captions of the Box in which the space was insufficient.

If this Supplemental Box is not used, this sheet need not be attached to the Request.

Box No. VI PRIORITY CLAIM (IF ANY). The priority of the following earlier application(s) is hereby claimed:

Country (when the earlier application is a national application, country in which it was filed; where the earlier application is a regional or an international application, one of the countries for which it was filed)	Filing Date (day, month, year)	Application No.	Office of Filing (fill in only if the earlier application is an international application (indicate receiving Office) or a regional application (indicate "EPO" or "OAPI"))
(1)			
(2)			
(3)			

When the earlier application was filed with the Office which, for the purposes of the present international application, is the receiving Office, the applicant may, against payment of the required fee, ask the following:

the receiving Office is hereby requested to transmit to the International Bureau a certified copy of the above-mentioned earlier application(s).

Box No. VII EARLIER SEARCH (IF ANY). Fill in where a search (international, international-type or other) by the International Searching Authority has already been requested (or completed) and the said Authority is now requested to base the international search, to the extent possible, on the results of the said earlier search. Identify such search or request either by reference to the relevant application (or the translation thereof) or by reference to the search request.

International application number or country and number of national application: _____ (International) filing date: _____

Date of request for search: _____ Number (if available) given to search request: _____

Box No. VIII SIGNATURE OF APPLICANT(S) OR AGENT

Box No. IX CHECK LIST (To be filled in by the Applicant)

<p>This international application contains the following number of sheets:</p> <p>1. request sheets</p> <p>2. description sheets</p> <p>3. claims sheets</p> <p>4. abstract sheets</p> <p>5. drawings sheets</p> <p style="text-align: right;">Total sheets</p> <p>Figure number of the drawings (if any) is suggested to accompany the abstract for publication.</p>	<p>This international application as filed is accompanied by the items checked below:</p> <p>1. <input type="checkbox"/> separate signed power of attorney (see Box No. IV)</p> <p>2. <input type="checkbox"/> copy of general power of attorney (see Box No. IV)</p> <p>3. <input type="checkbox"/> priority document(s) (see Box No. VI)</p> <p>4. <input type="checkbox"/> receipt of the fees paid or revenue stamps</p> <p>5. <input type="checkbox"/> cheque for the payment of fees</p> <p>6. <input type="checkbox"/> other document (specify)</p>
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(The following is to be filled in by the receiving Office)

1. Date of actual receipt of the purported international application: _____

2. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application: _____

3. Date of timely receipt of the required corrections under Article 11 of the PCT: _____

4. Drawings Received No Drawings

(The following is to be filled in by the International Bureau)

Date of receipt of the record copy: _____

NOTES TO THE REQUEST FORM (PCT/RO/101)

These Notes are intended to facilitate the filling in of the request form. For authentic information, see the text of the Patent Cooperation Treaty and the texts of the Regulations and the Administrative Instructions under that Treaty. (See also the PCT Applicant's Guide, a publication of WIPO.) In case of discrepancy between these Notes and the said texts, the latter are applicable.

"Article" refers to Articles of the Treaty, "Rule" refers to Rules of the Regulations and "Section" refers to Sections of the Administrative Instructions.

MANDATORY AND OPTIONAL CONTENTS OF THE REQUEST

"The request shall contain:

- (i) a petition [already pre-printed on the request form],
- (ii) the title of the invention,
- (iii) indications concerning the applicant and the agent, if there is an agent,
- (iii)bis indications concerning a separate power of attorney, if an agent or common representative is appointed by a separate power or, where the separate power of attorney is a general power of attorney, indications concerning a copy of the general power of attorney;
- (iv) the designation of States,
- (v) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application." (Rule 4.1(a))

"The request shall, where applicable, contain:

- (i) a priority claim,
- (ii) a reference to any earlier international, international-type or other search,
- (iii) choices of certain kinds of protection,
- (iv) an indication that the applicant wishes to obtain a regional patent and the names of the designated States for which he wishes to obtain such a patent,
- (v) a reference to a parent application or parent patent." (Rule 4.1(b))

"The request may contain:

- (i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application,
- (ii) a request to the receiving Office to transmit the priority document to the International Bureau where the application which constitutes the priority document was filed with the national Office or intergovernmental authority which is the receiving Office". (Rule 4.1(c))

"The request shall be signed." (Rule 4.1(d))

NOTES TO BOX No. I

Title of Invention. "The title of the invention shall be short (preferably from two to seven words when in English or translated into English) and precise." (Rule 4.3)

NOTES TO BOXES No. II and III

Applicant. "The request shall indicate the name, address, nationality and residence of the applicant or, if there are several applicants, of each of them." (Rule 4.5(a))

Different Applicants for Different Designated States. "The international application may indicate different applicants for the purposes of different designated States, provided that, in respect of each designated State, at least one of the applicants indicated for the purposes of that State is entitled to file an international application according to Article 9 [i.e., is a national or resident of a Contracting State]." (Rule 18.4(a)) *Where the United States of America is one of the designated States the applicant or applicants named in respect of the United States of America must be the inventor or inventors.*

Inventor. "The request shall contain the name of and other prescribed data concerning the inventor where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application". (Article 4.1(v)) "Where Rule 4.1(a)(v) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them." (Rule 4.6(a)) "If the applicant is the inventor, the request, in lieu of the indication under paragraph (a), shall contain an indication to that effect (Rule 4.6(b))". "..... Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for that State not later than at the expiration of 20 months from the priority date." (Article 22(1))

Names. "Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s)." (Rule 4.4(a)) "Names of legal entities shall be indicated by their full, official designations." (Rule 4.4(b))

Addresses. "Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. It is recommended to indicate any telegraphic and teleprinter address and telephone number in respect of the agent or common representative or, in the absence of the designation of an agent or common representative in the request, of the applicant first named in the request." (Rule 4.4(c)) "For each applicant, inventor, or agent, only one address may be indicated." (Rule 4.4(d))

Nationality. "The applicant's nationality shall be indicated by the name of the State of which he is a national." (Rule 4.5(b))

Residence. "The applicant's residence shall be indicated by the name of the State of which he is a resident." (Rule 4.5(c))

Names of States. "The name of any State referred to in the request shall be indicated by the full name of the State or by a generally accepted short title which, if the indications are in English or French shall be as appears in Annex A [i.e., Annex A to the Administrative Instructions under the PCT; the pre-printed names of PCT Contracting States appearing in Box No. V of the request form are in accordance with the said Annex A]." (Section 201(a), first sentence)

NOTES TO BOX No.IV

Agent or Common Representative. *When listing several agents, list first the agent to whom it is desired that any correspondence shall be addressed.* (See Section 108) "If agents are designated, the request shall so indicate, and shall state their names and addresses." (Rule 4.7) "If there is more than one applicant and the request does not refer to an agent representing all the applicants ("a common agent"), the request shall designate one of the applicants who is entitled to file an international application according to Article 9 [i.e., is a national or resident of a Contracting State] as their common representative." (Rule 4.8(a)) "If the applicants designate a common representative in the request in accordance with Rule 4.8(a), such common representative shall be designated by indicating that the named applicant is the common representative." (Section 206)

Appointment of Agent or Common Representative. "Appointment of any agent, or of any common representative within the meaning of Rule 4.8(a), shall be effected by each applicant, at his choice, either by signing the request in which the agent or common representative is designated or by a separate power of attorney (i.e., a document appointing an agent or common representative)." (Rule 90.3(a))

Power of Attorney. "The power of attorney may be submitted to the receiving Office or the International Bureau." (Rule 90.3(b)) "If the separate power of attorney is not signed or is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered nonexistent unless the defect is corrected." (Rule 90.3(c)) "Where, in respect of an agent designated in the request, a separate power of attorney is submitted, as provided in Rule 90.3(b), at the time of filing, the request shall so indicate." (Rule 4.7(b)) "In the case of the designation of the common representative in the request, Rule 4.7(b) applies *mutatis mutandis*." (Rule 4.8(c)) "A general power of attorney may be deposited with the receiving Office for purposes of the processing of the international application as defined in Rule 90.2(d). Reference may be made in the request to such general power of attorney, provided that a copy thereof is attached to the request by the applicant." (Rule 90.3(d))

For Names (including Names of States) and Addresses, see Notes to Boxes Nos. II and III.

NOTES TO BOX No. V

Designation of States. "Contracting States shall be designated in the request by their names." (Rule 4.9)

Where one or more States are designated twice (once for the purposes of a European patent and once for the purposes of a national patent), one designation fee must be paid in respect of the European patent and as many designation fees must be paid in respect of the national patents as there are designated States. (See Section 203bis and Rule 15.1(ii))

Possible Choices of Certain Kinds of Protection or Treatment. *If, in any country where that is possible, instead of a patent, a national title other than a patent is desired, write after the (first) box of that country, the name of the title, that is, "petty patent" (available in Australia), "utility model" (available in Brazil, the Federal Republic of Germany, Japan and OAPI) or "inventor's certificate" (available in the Soviet Union). Where, in the Federal Republic of Germany (only country in which these possibilities exist), in addition to a patent, a utility model is also desired, write, after the first box of that country "and utility model" or, where subsidiarily to a patent a utility model is desired, write, after the said box "and auxiliary utility model".* (See Section 202)

Where, in respect of any country where that is possible, it is desired that the application be treated as an application for a certain title "of addition" or as an application for a continuation or a continuation in part, write after the (first) box of that country, the appropriate words, that

is, "patent of addition" (available in Australia, Austria, the Federal Republic of Germany, Japan, Malawi, Soviet Union), "certificate of addition" (available in Luxembourg, Monaco, OAPI), "inventor's certificate of addition" (available in the Soviet Union), "continuation" or "continuation in part" (both available in the United States of America). If any of these indications is used, indicate in the "Supplemental Box" the country for which such treatment is desired, the number of the parent title or parent application and the date of grant of the parent title or the date of filing of the parent application, as the case may be.

For Names of States, see Notes to Boxes Nos. II and III.

NOTES TO BOX No. VI

Priority claim "The declaration [containing the priority claim] shall be made in the request; it shall indicate:

- (i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, the country or countries for which it was filed,
- (ii) the date on which it was filed,
- (iii) the number under which it was filed, and
- (iv) when the earlier application is a regional or an international application, the national Office or intergovernmental organization with which it was filed." **Rule 4.10(a)**

"If the request does not indicate both

- (i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, at least one country for which it was filed, and
- (ii) the date on which it was filed,

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made" **(Rule 4.10(b))**

"If the application number of the earlier application is not indicated in the request but is furnished by the applicant to the International Bureau prior to the expiration of the 16th month from the priority date, it shall be considered by all designated States to have been furnished in time." **(Rule 4.10(c), first sentence)**

Certified Copy of Earlier Application. "Where the priority of an earlier national application is claimed under Article 8 in the international application, a copy of the said national application, certified by the authority with which it was filed ("the priority document"), shall, unless already filed with the receiving Office together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or, in the case referred to in Article 23(2), not later than at the time the processing or examination is requested" **(Rule 17.1(a))** "Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request shall be made not later than the expiration of the applicable time limit referred to under paragraph (a) and may be subjected by the receiving Office to the payment of a fee" **(Rule 17.1(b))** "The request to the receiving Office to transmit the priority document to the International Bureau referred to in Rule 17.1(b), first sentence, may be made in the request following the indications in the priority claim identifying the earlier application of which the priority document is a certified copy." **(Rule 4.10bis)**

Dates. "Any date in the international application, or used in any correspondence emanating from International Authorities relating to the international application, shall be indicated by the Arabic number of the day, by the name of the month, and by the Arabic number of the year." **(See Section 110)**

NOTES TO BOX No. VII

Earlier Search. "If an international or international-type search has been requested on an application under Article 15(5) or if the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application, the request shall contain a reference to that fact. Such reference shall either identify the application (or its translation, as the case may be) in respect of which the earlier search was made by indicating country, date and number, or the said search by indicating, where applicable, date and number of the request for such search." **(Rule 4.11)**

For Dates, see Notes to Box No. VI.

NOTES TO BOX No. VIII

Signature. The signature **(Rule 4.1(d))** must be that of the applicant (if there are several applicants all must sign **(Rule 4.15))**; however, the signature may be that of the agent **(Rule 2.1)** where there is attached to the request a separate power of attorney appointing the agent or the copy of a general power of attorney already in the possession of the receiving Office. "Appointment of any agent, or of any common representative within the meaning of Rule 4.8(a), shall be effected by each applicant, at his choice, either by signing the request in which the agent or common representative is designated or by a separate power of attorney (i.e., a document appointing an agent or common representative)." **(Rule 90.3(a))** "Where the international application is filed with reference to a general power of attorney not signed by all the applicants, it shall be sufficient for the purpose of appointment of a common agent under Rule 90.3, if the request or a separate power of attorney is signed by the applicant, who did not sign the general power of attorney." **(Section 106(b))**

NOTES TO BOX No. IX

Check List (see Rule 3.3)

Missing Drawings (see Rule 26.6(a) and Section 310(a))

NOTES TO "SUPPLEMENTAL BOX"

Different Inventors for Different (Groups of) Designated States. "The request may, for different designated States, indicate different persons as inventors where, in this respect, the requirements of the national laws of the designated States are not the same. In such a case, the request shall contain a separate statement for each designated State or group of States in which a particular person, or the same person, is to be considered the inventor, or in which particular persons, or the same persons, are to be considered the inventors." **(Rule 4.6(c))**

Parent Application or Grant. "If the applicant wishes his international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, he shall identify the parent application or the parent patent, parent inventor's certificate, or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph Article 2(ii) shall not apply." **(Rule 4.13)** "If the applicant wishes his international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, he shall so indicate in the request and shall identify the parent application involved." **(Rule 4.14)**

PCT/A/VII/2

ANNEX B

PROPOSED AMENDMENTS TO THE REGULATIONS
UNDER THE PCT

Ad rule 3.3(a) (ii)

This provision needs to be amended to include in the check list of documents accompanying the international application as filed a reference to a copy of the general power of attorney required to be attached to the request (Rule 90.3(d), second sentence).

References to an international or an international-type search report and a document in evidence of the fact that the applicant is the successor in title of the inventor should be deleted. Such documents are, in practice, never filed with the international application but their inclusion in the check list creates the impression they may have to be furnished, which, however, is not the case.

RULE 3.3

3.3 *Check List*

- (a) The printed form shall contain a list which, when filled in, will show.
 - (i) [No change]
 - (ii) Whether or not the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a receipt for the fees paid or a check for the payment of fees and any other required document (to be specified in the check list);
 - (iii) [No change]
- (b) [No change]

Ad Rule 4.1(a) (iii) bis and (c)

The mandatory and optional contents of the request have been amended to take into account the additional indications therein for which provision is made in the proposed amendments to Rules 4.7(b), 4.8(c) and 4.10*bis* set out below

RULE 4.1

4.1 Mandatory and Optional Contents; Signature

- (a) The request shall contain;
 - (i) [No change]
 - (ii) [No change]
 - (iii) [No change]
 - (iii) *bis* indications concerning a separate power of attorney, if an agent or common representative is appointed by a separate power of attorney or, where the separate power of attorney is a general power of attorney, indications concerning a copy of the general power of attorney;
 - (iv) [No change]
 - (v) [No change]
- (b) [No change]
- (c) The request may contain
 - (i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application; and
 - (ii) a request to the receiving Office to transmit the priority document to the International Bureau where the application which constitutes the priority document was filed with the national Office or intergovernmental authority which is the receiving Office.
- (d) [No change]

Ad Rule 4.4(c)

In practice, if there is an agent or common representative, it is only useful to have the telegraphic and teleprinter address and the telephone number of the agent or common representative.

In the absence of the designation of an agent or common representative in the request, it would be useful to have the telegraphic and teleprinter address and the telephone number of at least the applicant first named in the request who will usually be the common representative by virtue of Rule 4.8(b).

RULE 4.4

4.4 Name and Addresses

(a) [No change]

(b) [No change]

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. It is recommended to indicate any telegraphic and teleprinter address and telephone number in respect of the agent or common representative or, in the absence of the designation of an agent or common representative in the request, of the applicant first named in the request.

(d) [No change]

Ad Rule 4.6(b)

Under the flexible system adopted for Boxes Nos. II and III of the proposed request form, preprinted indications with associated check boxes allow in every case an indication to be given that the person indicated is inventor as well as applicant. The same applies when an applicant who is also inventor is indicated in the Supplemental Box. Consequently, the reference in the Rule at present to the repetition of the applicant's name in the space reserved for indicating the inventor should be deleted.

RULE 4.6

4.6 The Inventor

- (a) [No change]
- (b) If the applicant is the inventor, the request, in lieu of the indication under paragraph (a), shall contain a statement to that effect.
- (c) [No change]

Ad Rule 4.7

It is desirable that reference be made in the request to the signing of a separate power of attorney in respect of any agent designated in the request. According to Rule 90.3(b), such a separate power of attorney may be submitted either to the receiving Office or to the International Bureau. The making of a reference to a general power of attorney is already provided for in Rule 90.3(d).

RULE 4.7

4.7 The Agent

- (a) The existing text of Rule 4.7
- (b) Where, in respect of an agent designated in the request, a separate power of attorney is submitted, as provided in Rule 90.3(b), at the time of filing, the request shall so indicate.

Ad Rule 4.8(c)

The situation with regard to a separate power of attorney relating to the common representative is the same as that explained above with regard to a separate power of attorney relating to an agent (see pages 10 and 11, above, relating to Rule 4.7(b)).

RULE 48

4.8 Representation of several applicants not having a Common Agent

(a) [No change]

(b) [No change]

(c) In the case of the designation of the common representative in the request, Rule 4.7(b) applies *mutatis mutandis*.

Ad Rule 4.10bis

It was discussed at the fifth session of the Assembly that the applicant should be able to give an indication in the request which has the effect of a request to the receiving Office to prepare and transmit the priority document to the International Bureau (see document PCT/A/V/17, paragraph 22). Having regard to Rule 4.17, it is desirable that specific provisions be made in Rule 4 to allow the request to contain such an indication.

Rule 4.10bis

4.10bis Request to transmit the priority document to the International Bureau

The request to the receiving Office to transmit the priority document to the International Bureau referred to in Rule 17.1(b), first sentence, may be made in the request following the indications in the priority claim identifying the earlier application or which the priority document is a certified copy.

[Annex C follows]

ANNEX C

Proposed Modification of the Administrative Instructions
under the PCT

Ad Section 201

Since the names of States are preprinted in the part of the request in which designations are made together with the corresponding two-letter country codes, the Section has to be amended so as not to apply to such names. Likewise, the indication of a sample for the indication of the two-letter country code seems to be no longer necessary and has therefore been deleted.

SECTION 201

NAMES OF STATES: CANCELLATION OF DESIGNATIONS

(a) The name of any State referred to in the request shall be indicated either by the full name of the State or by a generally accepted short title which, if the indications are in English or French, shall be as appears in Annex A. If the name is inserted in the request by the applicant for the purpose of designating that State, the receiving Office, or the International Bureau where the receiving Office fails to do so, shall insert, preferably before the name of the State, the two-letter country code indentifying the State, as appears in Annex B.

(b) [No change]

Ad Section 202

Having regard to the fact that in practice the law of only one Contracting State (the Federal Republic of Germany) permits an application for two kinds of protection, it appears appropriate to amend Section 202 by indicating the existing options and using the terms which are commonly used, particularly since the wording of Rule 4.12(b) and the former Section 202 has rarely been correctly understood and applied by applicants. For the situation where the applicant seeks protection by way of utility model only in the event that a patent is refused, it is usual to say that the applicant seeks an “auxiliary utility model”. Instead of the indication that primarily a patent is sought and subsidiarily a utility model is sought as at present, it is proposed to introduce the term “auxiliary utility model” which has the same meaning.

SECTION 202

KIND OF PROTECTION

(a) [No change]

(b) Where, in respect of the designation of the Federal Republic of Germany, the applicant is seeking two kinds of protection under Article 44, he shall make the indication referred to in Rule 4.12(b) by inserting, immediately after the indication of the Federal Republic of Germany and in the language of the international application, one of the two following indications:

- (i) “and utility model”;
- (ii) “and auxiliary utility model”.

Ad Section 203 (a)

The provision in the request form of a preprinted list matches perfectly with the provisions of Rule 4.1(b) (iv) and does not require any further elaboration in the Administrative Instructions for the indication that the applicant wishes to obtain a regional patent. Section 203 is therefore only required to give instructions for the said indication where a country newly adhering to the PCT for which a European patent is desired is not included in the preprinted list. The amendment makes this situation clear but leaves the Section otherwise unchanged.

SECTION 203

REGIONAL PATENTS

(a) If the applicant wishes to obtain a regional patent in respect of any designated State and the request form does not contain preprinted indications permitting the application to make the indication in the request referred to in Rule 4.1(b) (iv), the applicant shall make the said indication by inserting the words “regional patent”, or their equivalent in the language of the international application, immediately after the indication of the said State or, where an indication has been made under Section 202, after that indication, provided that;

(i) [No change]

(ii) [No change]

(b) [No change]

(c) [No change]

Ad Section 206

The requirement of the present Section that the designation of the common representative be indicated on the front page of the request is no longer applicable once the proposed request form is adopted. Section 206 is therefore redrafted in order to be compatible with Box No. IV of the proposed request form.

SECTION 206

COMMON REPRESENTATIVE DESIGNATED IN THE REQUEST

If the applicants designate a common representative in the request in accordance with Rule 4.8(a), such common representative shall be designated by indicating that the named applicant is the common representative.

[End of Annex
and of document]