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PROPOSALS FOR AMENDMENT TO CERTAIN TIME LIMITS IN THE PCT
AND TO THE REGULATIONS UNDER THE PCT

Memorandum of the International Bureau

INTRODUCTION

General

1. The Assembly of the PCT Union (hereinafter referred to as “the Assembly”), in its seventh session, held in Geneva from June 29 to July 3, 1981, asked the International Bureau to carry out a study of possible improvements to the Patent Cooperation Treaty (PCT), particularly the PCT Regulations (see document PCT/A/VII/15, paragraphs 54 to 64).
2. On the basis of the first conclusions of the study undertaken by the International Bureau and taking into account proposals received in particular from interested non-governmental organizations, the International Bureau prepared draft proposals for the amendment to the time limit fixed in Article 22(2) of the PCT and for a number of amendments to the PCT Regulations. Those first proposals, contained in document BIG/227, were discussed with representatives of the said organizations in a meeting held in Geneva on April 1 and 2, 1982, to which the national Offices of all member States of the PCT Union, as well as the European

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Patent Office and the African Intellectual Property Organization, were invited. The Offices were also invited to make written proposals and several of them did so.

3. On the basis of the discussions of the said meeting and of the written communications received from national Offices, the International Bureau in continuing its study, revised its first proposals and added further proposals. They were submitted to the PCT Committee for Administrative and Legal Matters (hereinafter referred to as “the Committee”). The Committee considered those proposals and advised the International Bureau on them at its first session, held in Geneva from September 6 to 10, 1982.

4. The International Bureau prepared for the second session of the Committee a revised set of proposals which took into account the advice and the recommendations of the participants of the Committee at its first session. The revised set of proposals included also proposals concerning the transfer of some Rules, or parts of Rules, to the Administrative Instructions of the PCT. In its second session, held in Geneva from April 25 to 29, 1983, the Committee considered the said revised proposals and advised the International Bureau on them. In that session, it concluded its work on the proposed amendments to certain time limits in the Treaty and to the Regulations under the PCT. However, the proposed modifications to the Administrative Instructions could not, because of lack of time, be discussed in detail, and it was understood that further consultations would take place before their promulgation.

5. The present document is the first of several documents prepared for the Assembly by the International Bureau and containing the proposed amendments to the PCT and to the Regulations under the PCT. The proposals contained in the present document are the proposals which were approved by the Committee at its second session. The other preparatory documents will contain the. Proposals which required further study.

6. None of the proposals made in this document, or which will be made in subsequent documents, are of a nature that would require a decision by a revision conference. The proposals contain only two amendments to the Treaty but those amendments consist of modifications of time limits (fixed in Articles 22(2) and 39(1) (a)) which, under Article 47(2) (b), may be decided in the Assembly or through voting by correspondence, that is, without a revision conference. Those proposals will be included in one of the subsequent documents. All other proposals whether appearing in this document or to be included in subsequent documents concern amendments to the Regulations and such amendments require decision by the Assembly (see Article 58(2) (a)).

7. The presentation of the proposed amendments follows the manner adopted for the sessions of the Committee, namely, where a proposal concerning a given subject matter requires that several Rules be amended the proposed amendments are presented together, as a group (“chapter”). For the sake of easier reference to earlier documents, each such chapter bears the same number as did the corresponding chapter submitted to the second session of the Committee. Where an existing Rule deals with several subject matters, proposed amendments to such a Rule may appear, in anyone of the documents, in different places; in all such places, however, appropriate cross-references are included. The proposed amendments appear on the odd-numbered pages, whereas, the corresponding explanations appear on the opposite even-numbered pages. In the text itself, of the Articles or Rules proposed to be amended (including in the titles), under linings or footnotes indicate what is new as compared to the present text.

8. In a number of cases, the Committee approved the total or partial transfer of some Rules to the Administrative Instructions. The corresponding proposals for amending certain Sections of or for including new Sections into, the Administrative Instructions appear in the explanations of the proposed amendments to the corresponding Rules, with underlinings indicating what is new as compared with the present text of the Administrative Instructions.

9. As to the date on which the proposed amendments to the PCT and to the Regulations under the PCT would, if adopted by the Assembly, enter into force, it is proposed that they enter into force on January 1, 1985.

Questions of Special Interest to Developing Countries

10. The Assembly, in its seventh session, decided that the study to be undertaken by the International Bureau (see paragraph 1, above) should take into account the situation of the developing countries in order to allow those countries to derive full benefit from participating in the PCT system and thus promote accession by those countries not yet party to the Treaty (see document PCT/A/VII/15, paragraphs 56 and 60.A(vi)).

11. The Delegation of Brazil recalled, during the first session of the Committee, that in particular a proposal to consider lower fees in favor of nationals of developing countries should be studied (see document PCT/CAL/I/9, paragraph 61). However, it was considered that this question was closely linked with the proposals concerning preferential treatment for developing countries made in the context of the ongoing revision of the Paris Convention for the Protection of Industrial Property; those proposals, however, are still under consideration.

12. Nevertheless, since international search and preliminary examination fees have nothing to do with national patent fee structures the Assembly could recommend to all Contracting States to seek ways and means for financing at least part of the international search and preliminary examination fees payable by nationals of developing countries, and to all International Searching and Preliminary Examining Authorities to study the possibility to reduce the amount of those fees for the benefit of applicants from developing countries. Alternatively or additionally, national or regional funds could be put at the disposal of the International Bureau or of the International Searching and Preliminary Examining Authorities, in order to be used to assist applicants from developing countries in paying such fees.

13. During its second session, the Committee briefly discussed the questions referred to in paragraphs 10 to 12, above, and decided that, in particular in view of their political nature, they should be dealt with directly by the Assembly (see document PCT/CAL/II/9, paragraph 100).

14. A draft Resolution of the Assembly containing the recommendations referred to in paragraph 12, above, is contained in the Annex to this document.

15. The Assembly is invited

(i) to adopt the amendments to the PCT and the Regulations under the PCT which are contained in the present and the other preparatory documents;

(ii) to fix the date of entry into force of those amendments;

(iii) to adopt the Resolution contained in the Annex to the present document.

<u>Chapter</u>	<u>Objective</u>	<u>Provisions to be amended</u>	<u>Page</u>
1.	Informing the designated Offices of the cancellation of the priority claim or the correction of the filing date of the earlier application whose priority is claimed; allowing the Administrative Instructions to provide for the inclusion in the request of additional optional indications	Rules 4.10 and 4.17; Sections 314 and 402	8
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<u>Objective</u>	<u>Provisions to be amended</u>	<u>Page</u>
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<u>Objective</u>	<u>Provisions to be amended</u>	<u>Page</u>
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35. [See a subsequent document]		
36. [See a subsequent document]		
37. [See a subsequent document]		
38. [See a subsequent document]		

EXPLANATIONS OF THE PROPOSED AMENDMENTS

Chapter 1: Informing the designated Offices of the cancellation of the priority claim or the correction of the filing date of the earlier application whose priority is claimed; allowing the Administrative Instructions to provide for the inclusion in the request of additional optional indications

(Concerns Rules 4.10 and 4.17)

Proposals approved by the Committee
(see documents PCT/CAL/II/2, pages 6 to 9,
and PCT/CAL/II/9, paragraph 10)

1. *Ad Rule 4.10 (d)*. This rule provides that, if the international application contains a priority claim and the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the priority claim is to be cancelled ex officio unless the filing date of the earlier application was erroneously indicated and is corrected by the applicant; the International Bureau must notify the applicant and the International Searching Authority but not the designated Offices of the cancellation or correction.
2. However, the designated Offices which have been informed, in the notification sent to them by the International Bureau (of receipt of the record copy under Rule 24.2(a)), of the filing date of the earlier application as indicated in the request, have an interest in being also informed of the said cancellation or correction, since the computation of the date after which national processing may start is based on that date. It is therefore proposed to provide that the International Bureau must notify all designated Offices of any such cancellation or correction if the cancellation or correction concerns an international application whose receipt was already notified to them by the International Bureau under Rule 24.2(a). Such notification would allow the designated Offices to correct their records of pending international applications.
3. At the same time, it is proposed to transfer that part of Rule 4.10 (d) which provides for notifications by the receiving Office or the International Bureau of corrections or cancellations to the Administrative Instructions. The text of modified Sections 314 and 402 could read as follows:

Section 314

Manner of Indicating and Notification of Correction of the
Priority Date or Cancellation of the Priority Claim

(a) and (b) [No change]

(c) The receiving Office effecting the correction or cancellation shall notify the applicant accordingly and, if copies of the international application have already been sent to the International Bureau and the International Searching Authority, that Bureau and that Authority.

[Chapter 1]

TEXT OF THE PROPOSED AMENDMENTS

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) [No change]

(b) [See Chapter 30 in a subsequent document]

(c) [See Chapter 8 in a subsequent document]

(d) If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within 1 month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled ex officio.*

(e) [No change]

4.11 to 4.16 [No change]

* The amendment consists of deleting the last two sentences of the present text of this paragraph and including their contents in Section 314 and Section 402, respectively, of the Administrative Instructions which are contemplated to be modified as indicated in the explanations relating to this chapter.

[Chapter 1]

Section 402

Notification of Correction of the Priority Date or

Cancellation of the Priority Claim

(a) Where, under Rule 4.10 (d), the correction of the priority date or the cancellation of the priority claim is effected by the International Bureau, the manner of indicating the correction or cancellation set forth in Section 314 shall apply *mutatis mutandis*.

(b) The applicant, the receiving Office and the International Searching Authority shall be notified by the International Bureau of any correction or cancellation effected by the International Bureau under Rule 4.10 (d)

(c) Any designated Office which has been notified under Rule 24.2 (a) of the receipt of the record copy shall be notified by the International Bureau of any correction or cancellation effected under Rule 4.10(d).

4. *Ad Rule 4.17.* Rule 4 prescribes and enumerates the mandatory and optional contents of the request. It has been revised several times. The latest amendments were required in connection with the revision of the request form (Form PCT/RO/101).

5. The main objective of the amendment now proposed is to allow certain future modifications in the request form without having to resort to the relatively cumbersome procedure of amending the Regulations. Such modifications would be specified in the Administrative Instructions rather than the Regulations. Naturally, such modifications could only be of a nature which is not contrary to the Treaty or the Regulations; in particular, they cannot increase the requirements with which the request must comply. But they may allow the applicant to make statements in the request useful to him. This is why the proposed new sentence of paragraph (a) would allow but would not permit to require the inclusion of matters in the request which are not provided for in Rules 4.1 to 4.16 but which could, in the future, be specified in the Administrative Instructions. Had the proposed amendment been in force at the time of the above-mentioned revision of the request form, Rule 4.1(c), for example, would not have had to be changed since what that revision provided for was a permission not an obligation given to the applicant, namely, the permission to ask, in the request, the receiving Office to submit the priority document to the International Bureau.

[Chapter 1]

4.17 *Additional* Matter*

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.16, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to 4.16 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall ex officio delete the additional matter.

* The amendment consists of deleting the word “No” before the word “Additional”.

Chapter 2: Making it possible, in certain circumstances,
to formulate dependent claims in a manner different from the manner
otherwise prescribed by the PCT Regulations

(Concerns Rule 6.4)

Proposal approved by the Committee

(see documents PCT/CAL/II/2, pages 10, 11 Rev. (in document
PCT/CAL/II/8) and 12, and PCT/CAL/II/9, paragraph 11)

1. Rule 6.3 defines, in paragraph (b), the general requirements for the manner of claiming and provides, in paragraph (c), that the failure to use that manner of claiming has no effect in any designated State where the national law of that State does not require such manner of claiming. This provision, however, is presently not applicable to the special case referred to in Rule 6.4(a), second and third sentences, namely, that a dependent claim which refers to more than one other claim (“multiple dependent claim”) must refer to such claims in the alternative only and cannot serve as a basis for any other multiple dependent claim.

2. The national laws of several States party to the PCT and the European Patent Convention (EPC) allow, with respect to multiple dependent claims, a manner of claiming which is more liberal than the one provided for in Rule 6.4(a). In particular, they allow reference to other claims in cumulation and the use of multiple dependent claims as a basis for any other such claim. Where such is the case, the strict enforcement of the provision of Rule 6.4(a) has, for example, the effect that, if the international application claims the priority of an earlier national (or EPC) application using a manner of formulating multiple dependent claims consistent with that more liberal required by the national laws (or the EPC) of all designated States (or the EPC), the claims would still have to be redrafted, for the purposes of the international application, in order to conform with the stricter rules of the PCT Regulations, namely with present Rule 6.4 (a). Furthermore, where Chapter II applies and where the European Patent Office is, at the same time, International Preliminary Examining Authority and the only elected Office, it must, as International Preliminary Examining Authority, inform the applicant of non-compliance with Rule 6.4(a) if the claims have not been drafted in accordance with that Rule although it would, as elected Office, allow such manner of claiming. Moreover, it is not always understood why failure to comply with the general requirements of the manner of claiming provided for in Rule 6.3(b) should have no effect in certain designated States whereas failure to comply with the special requirements of the manner of claiming in the case of dependent claims under Rule 6.4(a) could not be disregarded by those States.

3. Consequently, it is proposed to amend paragraph (a) of Rule 6.4 to the effect that failure to use the manner of claiming provided for in the second and third sentences of that paragraph has no effect in a designated State if the manner of claiming actually used satisfies the national law of that State. This amendment would be the subject matter of the fifth (the last) sentence of paragraph (a).

4. It should be noted that, where the national law of a designated State requires a manner of formulating dependent claims as provided in present Rule 6.4(a), the international application has to use that manner of claiming; otherwise, the claims will, in the national phase before the Office of that State, have to be amended in order to comply with the requirements of the present Rule 6.4(a).

[Chapter 2]

Rule 6

The Claims

6.1 to 6.3 [No change]

6.4 *Dependent Claims*

(a) Any claim which includes all the features of one or more other claims (claim in dependent form, hereinafter referred to as “dependent claim”) shall do so by a reference, if possible at the beginning, to the other claim or claims and shall then state the additional features claimed. Any dependent claim which refers to more than one other claim (“multiple dependent claims”) shall refer to such claims in the alternative only. Multiple dependent claims shall not serve as a basis for any other multiple dependent claims. Where the national law of the national Office acting as International Searching Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the preceding two sentences, failure to use that manner of claiming may result in an indication under Article 17 (2) (b) in the international search report. Failure to use the said manner of claiming shall have no effect in a designated State if the manner of claiming actually used satisfies the national law of that State.

(b) and (c) [No change]

6.5 [No change]

[Chapter 2]

5. Where the national law of the national Office acting as International Searching Authority requires the manner of formulating dependent claims as provided for in the present paragraph (a) of Rule 6.4, a different manner of claiming should not be used since such International Searching Authority might find it difficult to make a search for an international application containing dependent claims formulated in a manner to which its examiners are not accustomed. It is therefore also proposed to provide in the said paragraph that failure to use the manner of claiming provided for in the second and third sentences of Rule 6.4(a) may result in an indication under Article 17(2) (b) in the international search report, namely, that certain claims fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out in respect of those claims. This amendment would be the subject matter of the fourth (the penultimate) sentence of paragraph (a) of Rule 6.4. .

Chapter 4: Allowing, where the language of publication is different
from the language of the international application, to file
the request in the language of publication

(Concerns Rule 12.1)

Proposal approved by the Committee
(see documents PCT/CAL/II/2, pages 18 and 19,
and PCT/CAL/II/9, paragraph 13)

1. Under Article 11(1) (ii), the receiving Office shall accord the international filing date if the international application is among other things in the prescribed language. According to present Rule 12.1, the prescribed language is the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of the international application. (If the agreement specifies several languages, the receiving Office may prescribe, among those languages, the language(s) in which any international application filed with it must be). All parts of the international application must be filed in the same language.

2. Under present Rule 48.3, an English translation of the international application must be prepared under the responsibility of the International Searching Authority if the language in which the international application is filed is not English, French, German, Japanese, or Russian. That translation will be published. It has been proposed by the Delegation of Norway (see document PCT/CAL/I/6), and accepted by the Committee in its September 1982 session, to allow the filing of the request if the applicant prefers it in the language of publication rather than in the language of the rest of the international application. The rationale of this proposal is that some applicants may regard it as an unnecessary burden that they have to fill in the request form twice as they have to under the present Rules namely, once in the language in which the application was filed and once in the language of publication. Since the request in the language of filing would be of no real interest to anyone, the applicant concerned may prefer to file the request form in the language of publication. The new paragraph allows just that.

[Chapter 4]

Rule 12

Language of the International Application

12.1 *Admitted Languages*

(a) Any international application shall be filed in the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of that application, provided that, if the agreement specifies several languages, the receiving Office may prescribe among the specified languages that language in which or those languages in one of which the international application must be filed.

(b) If the international application is filed in a language other than the language in which it is to be published, the request may, notwithstanding paragraph (a), be filed in the language of publication.

(c) and (d) [See Chapter 15 in a subsequent document]

12.2 [See Chapter 18 in a subsequent document]

Chapter 5: Simplifying the wording of Rule 13bis.7

(Concerns Rule 13bis.7)

Proposal approved by the Committee

(see documents PCT/CAL/II/2, pages 20 and 21, and
PCT/CAL/II/9, paragraph 14)

1. The present text of Rule 13bis.7(b) provides, among other things, for notifications to be effected before the entry into force of Rule 13bis. Such entry into force occurred on January 1, 1981, and thus is in the past. It is proposed to delete any reference to both the said event and to future changes in the national law.

2. The proposed remaining text of Rule 13bis.7(b) would institute a permanent requirement that the national Offices must notify the International Bureau of the depositary institutions with which deposits may be made. Such a requirement clearly implies that, should a change occur with respect to such institutions, such change would have to be notified to the International Bureau.

[Chapter 5]

Rule 13bis

Microbiological Inventions

13bis.1 to 13bis.6 [No change]

13bis.7 *National Requirements: Notification and Publication*

(a) [No change]

(b) Each national Office shall notify the International Bureau* of the depositary institutions with which the national law permits deposits of microorganisms to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.

(c) [No change]

* The amendment consists of deleting, after the word “Bureau,” the following words: “a first time before entry into force of this Rule and then each time a change occurs.”

Chapter 10: Cancelling the obligation of the receiving Office to reimburse to the International Bureau the cost of making a substitute search copy

(Concerns Rule 23.1)

Proposal approved by the Committee

(see documents PCT/CAL/II/2, pages 44 and 45, and
PCT/CAL/II/9, paragraph 24)

1. The second sentence of present Rule 23.1(b) provides that “Unless the International Searching Authority has erred in alleging that it was not in possession of the search copy by the expiration of the 13th month from the priority date, the cost of making a copy for that Authority shall be reimbursed by the receiving Office to the International Bureau.”
2. The International Bureau knows only of two cases where it had to prepare a copy of the international application and to send it to the International Searching Authority under the first sentence of this Rule. In both those cases, it could not be clearly established whether the International Searching Authority erred or not. The administrative costs involved in establishing such facts and the invoicing of costs is higher for the International Bureau than the cost of making a copy. Therefore, it is proposed to delete the second sentence of Rule 23.1(b).

[Chapter 10]

Rule 23

Transmittal of the Search Copy

23.1 *Procedure*

(a) [See Chapter 9 in a subsequent document]

(b) If the International Bureau has not received, within 10 days from the receipt of the record copy, information from the International Searching Authority that that Authority is in possession of the search copy, the International Bureau shall promptly transmit a copy of the international application to the International Searching Authority.*

(c) [See Chapter 9 in a subsequent document]

* The amendment consists of deleting the second sentence of this paragraph. That sentence is quoted in the explanations (opposite page).

Chapter 11:Deleting the requirement to mark all sheets of the international application with the stamp of the International Bureau and deleting the requirement to mark replacement sheets with the stamp of the Authority to which they have been submitted

(Concerns Rules 24.1, 26.4, 26.5, 46.5 and 66.8)
Proposals approved by the Committee
(see documents PCT/CAL/II/2, pages 46, 47, 48 Rev.
(in document PCT/CAL/II/8) and 49 to 52, and
PCT/CAL/II/9, paragraph 25)

1. Under the present Rule 24.1, the International Bureau must mark on the request sheet the date of receipt of the record copy and on all sheets of the international application the stamp of the International Bureau. The requirement that all sheets of the international application must be marked with the stamp of the International Bureau could be deleted, since such marking seems to be unnecessary: all sheets of the international application have already been marked under Rule 20.1(a) by the receiving Office with the international application number and can thus be identified as pertaining to a specific international application. Furthermore, it is sometimes not possible to mark sheets with the said stamp without interfering with the text, namely where the applicant failed to leave a 2 cm margin on the bottom of the sheet as prescribed in Rule 11.6(a).
2. Under present Rules 26.4(b), 46.5(b) and 66.8(b), each replacement sheet submitted to the receiving Office under Rule 26.4(a), to the International Bureau under Rule 46.5(a) or to the International Preliminary Examining Authority under Rule 66.8(a), respectively, must be marked by the Authority having received it with a stamp identifying that Authority. For the same reasons as given in paragraph 1, above and since the international application number is marked on each replacement sheet by the said Authority, which is sufficient to identify the replacement sheet as pertaining to a given international application it is proposed to omit the requirement to mark the replacement sheets with the stamp of the Authority having received them.
3. Furthermore, it is proposed to delete all Rules dealing with the marking of sheets or other papers and with other procedural steps, in connection with corrections or amendments, which are of no direct interest to the applicant namely, Rules 24.1, 26.4(b) to (d), 26.5(b), 46.5(b) and (c) and 66.8 (b) and to transfer their contents, or what would remain of them after the amendments proposed in paragraphs 1 and 2, above, to the Administrative Instructions. The texts of amended or new Sections 308, 320, 401, 401bis, 401ter and 602 could read as follows:

Section 308

Marking of the Sheets of the International Application

- (a) [No change]
- (b) [Deleted]

[Chapter 11]

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 *Recording of Date of Receipt of the Record Copy*

[Deleted]

24.2 [No change]

Rule 26

Checking by, and Correcting Before, the Receiving Office of Certain
Elements of the International Application

26.1 [No change]

26.2 [See Chapter 12 on page 29, below]

26.3 [No change]

26.4 *Procedure*

(a) [No change]

(b) to (d) [Deleted]

26.5 *Decision of the Receiving Office*

(a) [See Chapter 12 on page 29, below]

(b) [Deleted]

26.6 [No change]

[Chapter 11]

Section 320
Corrections under Rule 26.4(a)
and Rectifications under Rule 91.1

(a) The receiving Office shall indelibly mark, so as to admit of direct reproduction in any of the manners set forth in Rule 11.2(a), in the upper right-hand corner of each replacement sheet submitted under Rule 26.4(a), the international application number and the date on which it was received. It shall mark on the letter containing the correction or accompanying any replacement sheet the date on which that letter was received. It shall keep in its files a copy of the letter containing the correction or, when the correction is contained in a replacement sheet, the replaced sheet, the letter accompanying the replacement sheet, and a copy of the replacement sheet.

(b) The receiving Office shall promptly transmit the letter and the replacement sheet to the International Bureau, and a copy thereof to the International Searching Authority.

(c) [See Chapter 30 in a subsequent document]

Section 401

Marking of the Sheets of the Record Copy

(a) The International Bureau shall, upon receipt of the record copy, mark the date of receipt of the record copy in the appropriate space on the request form*.

(b) [No change]

* The amendment consists of deleting, after the word “form,” the words “and place the stamp of the International Bureau in the lower right-hand corner of each sheet of the record copy.”

[Chapter 11]

Rule 46

Amendment of Claims before the International Bureau

46.1 and 46.2 [See Chapter 17 on page 35, below]

46.3 [See Chapter 18 in a subsequent document]

46.4 [See Chapter 19 on page 39, below]

46.5 *Form of Amendments*

(a) [No change]

(b) and (c) [Deleted]

Rule 66

Procedure before the International Preliminary
Examining Authority

66.1 [No change]

66.2 and 66.3 [See Chapter 18 in a subsequent document]

66.4 [See Chapter 25 in a subsequent document]

66.5 [See Chapter 30 in a subsequent document]

66.6 [No change]

66.7 [See Chapter 26 in a subsequent document]

[Chapter 11]

Section 401bis

Corrections under Rule 26.4(a)
and Rectifications under Rule 91.1

(a) Where the International Bureau receives from the receiving Office a letter containing a correction under Rule 26.4(a), or a replacement sheet and a letter accompanying it, it shall transfer the correction to the record copy, together with the indication of the date on which the receiving Office received the letter, or shall insert the replacement sheet in the record copy. The letter and the replaced sheet shall be kept in the files of the International Bureau.

(b) [See Chapter 30 in a subsequent document]

Section 401ter

Amendments under Rule 46.5(a)

(a) The International Bureau shall mark, in the upper right-hand corner of each replacement sheet submitted under Rule 46.5(a), the international application number and the date on which it was received. It shall keep in its files any replaced sheet, the letter accompanying the replacement sheet or sheets, and any letter referred to in the last sentence of Rule 46.5(a).

(b) The International Bureau shall insert any replacement sheet in the record copy and, in the case referred to in the last sentence of Rule 46.5(a), shall indicate the cancellations in the record copy.

66.8 Form of* Amendments

- (a) [See Chapter 18 in a subsequent document]
- (b) [Deleted]

66.9 [See Chapter 18 in a subsequent document]

* The amendment consists of deleting, after the word “of,” the words “Corrections and.”

[Chapter 11]

Section 602

Amendments under Rule 66.8(a)

(a) The International Preliminary Examining Authority shall indelibly mark, so as to admit of direct reproduction in any of the manners set forth in Rule 11.2(a), in the upper right-hand corner of each replacement sheet submitted under Rule 66.8 (a), the international application number and the date on which it was received. It shall keep in its files any replaced sheet, the letter accompanying the replacement sheet or sheets, and any letter referred to in the last sentence of Rule 66.8(a).

(b) [No change]

Chapter 12: Allowing the extension of the time limit fixed by
the receiving Office for correcting certain defects in the international application;
obliging that Office to excuse certain physical defects

(Concerns Rules 26.2 and 26.5)

Proposals approved by the Committee

(see documents PCT/CAL/II/2, pages 54 to 56, and
PCT/CAL/II/9, paragraph 26)

1. It is essential for the acceptance and the functioning of the PCT system that the risk of loss of rights for failure to meet certain time limits should be minimal.
2. *Ad Rule 26.2.* The present Rule prescribes that the time limit (for the correction of defects of the international application) referred to in Article 14(1) (b) must be reasonable under the circumstances of the particular case and must be fixed in each case by the receiving Office. The minimum time limit is one month from the date of the invitation to correct. A maximum time limit is not fixed in the Rule; however, it is provided that the time limit should normally not be more than two months. Neither the possibility for the applicant to request an extension of the time limit fixed by the receiving Office nor the possibility for that Office to grant such an extension is provided for in the present text of Rule 26.2. Experience shows that the time limit fixed by the receiving Office is sometimes too short: had a longer time limit been fixed, or had the time limit been extended, the applicant would have been able to submit the correction in time. Therefore, it would be appropriate to allow the ‘applicant, where he is not able to submit the required correction in time, to request an extension of the time limit fixed in the invitation to correct. It would also be appropriate to allow the receiving Office to grant ex officio namely, without a request from the applicant an extension where it realizes that such extension would be equitable and that a request from the applicant was not to reach it before the expiration of the originally fixed time limit. Any extension would, naturally, be subject to the general rule for fixing time limits, namely, it would have to be reasonable under the circumstances (see present Rule 26.2, first sentence).
3. It may also happen that a correction submitted by the applicant is received only after the expiration of the fixed (original or extended) time limit. In the most frequent case of this kind, the correction is received a few days, or even one day, after the expiration of the time limit. If the correction thus received is received before the decision under Rule 26.5(a) (whether the international application is or is not to be considered withdrawn) has been made, it would be unreasonable to disregard the correction. All corrections received from the applicant, be it before or after the expiration of the time limit fixed by the receiving Office, should be able to be taken into account if they are received before the decision on the question whether the international application is to be considered withdrawn is made. Naturally, if the correction is received after the decision under Rule 26.5(a) has been made it could no longer be taken into consideration.
4. It is therefore proposed to amend Rule 26.2 by adding to the existing text a second sentence which would allow an extension of the time limit for submitting the requested correction at any time before a decision (under Rule 26. 5 (a)) is made. Furthermore, it is proposed to delete the present “normal” maximum time limit of two months, which has the character of a guideline rather than of a legal rule and which, in any case, would not make much sense once extension of the time limit is introduced in Rule 26.2.

[Chapter 12]

Rule 26

Checking By, and correcting before; the Receiving-Office of certain
Elements of the International Application

26.1 [No change]

26.2 *Time Limit for Correction*

The time limit referred to in Article 14(1) (b) shall be reasonable under the circumstances* and shall be fixed in each case by the receiving Office. It shall not be less than 1 month** from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

26.3 [No change]

26.4 [See Chapter 11 on page 22, above]

26.5 *Decision of the Receiving Office*

(a) The receiving Office shall decide whether the applicant has submitted the correction within the time limit under Rule 26.2 and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

(b) [See Chapter 11 on page 22, above]

26.6 [No change]

* The amendment consists of deleting, after the word “circumstances,” the words “of the particular case.”

** The amendment consists of deleting, after the word “month,” the words “and normally not more than 2 months.”

[Chapter 12]

5. *Ad Rule 26.5.* The receiving Office must check whether the international application complies with the physical requirements prescribed by or under Article 14(1) (a) (v). Any corresponding defect may be serious or less serious. A typical example of a less serious defect would be a somewhat less than total compliance with the minimum margins prescribed under Rule 11.6. Some receiving Offices seem to have adopted the practice, when they invite the applicant to correct defects under Article 14 (1) (a), to mention all physical defects whether serious or less serious detected in the international application and to notify the applicant that the international application will be considered withdrawn should he fail to correct all the physical defects within the time limit fixed for that purpose in the invitation. If the applicant then fails to correct any minor (less serious) physical defect, the receiving Office might find itself in a dilemma. Under strict application of the Rules, the international application should be considered withdrawn although such a decision would be a legal consequence which is out of proportion in view of the nature of the defect. The present Rule 26.5 has therefore been interpreted by several Offices and in various cases in a way allowing to disregard failure to correct a minor (less serious) physical defect and to continue the processing of the international application.

6. The amendment proposed for Rule 26.5(a) would codify such interpretation by making it sure that a declaration considering the international application withdrawn could not be made where the nature of the physical defect is such that loss of the application would be excessive too harsh a legal consequence. Since physical requirements must, under Rule 26.3, be checked only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication, it is proposed to expressly provide that such principle must be applied at the time a decision is made under Rule 26.5(a) and that an international application should be considered withdrawn for lack of compliance with physical requirements only if the papers containing the application would not allow reasonably uniform international publication.

Chapter 16: Specifying the time limit for international search
in the PCT Regulations

(Concerns Rule 42.1)

Proposal approved by the Committee

(see documents PCT/CAL/II/3, pages 4 and 5, and
PCT/CAL/II/9, paragraph 35)

1. Present Rule 42.1 provides for the establishment of international search reports within maximum time limits and that the agreements with the various International Searching Authorities must provide the same time limits for all International Searching Authorities. Since the first agreement concluded with an International Searching Authority has fixed the time limits at the maxima allowed, it is those maxima which had to be and were provided in all the agreements. Naturally, the same time limits would have to be applied also to any agreement with additional International Searching Authorities. Under these circumstances, reference in the Rule to agreements seems superfluous, and it is proposed to convert the maxima provided in the present Rule into fixed time limits.
2. The last sentence of Rule 42.1 contains transitory provisions for the first three years from the entry into force of the PCT. This transitory period is over, and the related text is obsolete. It is therefore proposed to delete the last sentence.
3. When the Committee approved Chapter 16 at its second session, it was understood that where, due to the late payment of the search fee, the remaining time of the three month period did not allow the timely establishment of the international search report, the transmittal of that report could be effected exceptionally after the expiration of the three month time limit, but not later than one month after that expiration.

[Chapter 16]

Rule 42

Time Limit for International Search

42.1 *Time Limit for International Search*

The time limit for establishing the international search report or the declaration referred to in Article 17(2) (a) shall be 3 months from the receipt of the search copy by the International Searching Authority, or 9 months from the priority date, whichever time limit expires later.*

* The amendment also consists of deleting the last sentence of Rule 42.1, which reads as follows: “For a transitional period of 3 years from the entry into force of the Treaty, time limits for the agreement with any International Searching Authority may be individually negotiated, provided that such time limits shall not extend by more than 2 months the time limits referred to in the preceding sentence and in any case shall not go beyond the expiration of the 18th month after the priority date.”

Chapter 17: Giving more time to the applicant for filing,
during the international phase, amendments to the claims
in certain cases

(Concerns Rules 46.1 and 46.2)

Proposals approved by the Committee

(see documents PCT/CAL/II/3, pages 6 to 8, and

PCT/CAL/II/9, paragraph 36)

1. *Ad Rule 46.1.* The present text of Rule 46.1 provides for a time limit which is two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or, when such transmittal takes place before the expiration of 14 months from the priority date (for the definition of “priority date” see Article 2(xi)), three months from the date of such transmittal. The three-month time limit is applicable in all those cases where the international application has been filed early in the priority year or does not claim the priority of an earlier application. If, for example, the international search report is transmitted to the applicant 10 months after the priority date (which is the international filing date if no priority of an earlier application is claimed), the time limit presently applicable (for filing amendments under Article 19) is 13 months from that date. One does not see, however, why the applicant should not be given more time for filing amendments, since what is important in such a case is that the amendments reach the International Bureau early enough to permit their publication together with the international publication of the international application. If they reach the International Bureau before the expiration of 16 months after the date in question, they will certainly reach the International Bureau in time for including them in the publication of the international application by the International Bureau.

2. Consequently, it is proposed to replace the present time limit (three months from the transmittal of the international search report) by a time limit of 16 months from the priority date. The two-month time limit from the transmittal of the international search report would continue to apply whenever it expires later than 16 months from the priority date (that is, whenever the international search report is transmitted after the expiration of 14 months from the priority date; this is necessarily the case where the international application claims the priority of an earlier application and has been filed at the end of the priority year).

3. Concerning the authority with which any amendments to the claims must be filed under Article 19, the present text of Rule 46 is silent, but it follows from Article 19 that such amendments must be filed with the International Bureau. Experience shows that sometimes applicants file amendments with the receiving Office or with the International Searching Authority instead. Amendments (erroneously) filed with the receiving Office or the International Searching Authority are usually transmitted by that Office or Authority to the International Bureau so that eventually they are filed with the International Bureau, albeit indirectly. The present practice of receiving Offices or International Searching Authorities to transmit amendments filed with them to the International Bureau is satisfactory and should not be changed. When the Committee approved Chapter 17 at its second session, it was agreed that the Guidelines for receiving Offices for the processing of international

applications under the PCT and the Guidelines for International Search to be Carried Out under the PCT should state that, in those cases where amendments under Article 19 would be submitted to the receiving Office or to the International Searching Authority, that Office or Authority should transmit them promptly to the International Bureau.

[Chapter 17]

Rule 46

Amendment of Claims before the International Bureau

46.1 *Time Limit*

The time limit referred to in Article 19 shall be 2 months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later, provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

46.2 *Dating of Amendments*

[Deleted]

46.3 [See Chapter 18 in a subsequent document]

46.4 [See Chapter 19 on page 39, below]

46.5 [See Chapter 11 on page 23, above]

[Chapter 17]

4. Having regard to the purpose of the time limit for filing amendments under Article 19 namely, to make sure that the International Bureau should normally receive such amendments before the technical preparations for international publication have been completed it is furthermore proposed to amend Rule 46.1 so that amendments under Article 19, even if received by the International Bureau after the expiration of the applicable time limit, will be considered to have been received by that Bureau on the last day of that time limit if they are received before the completion of the technical preparations for international publication. This would allow the greatest possible flexibility in favor of the applicant without putting any additional burden on the International Bureau or any other Office or Authority.

5. *Ad Rule 46.2.* It is proposed to delete this Rule and to transfer its contents to the Administrative Instructions. The text of a new Section 416 could read as follows:

Section 416

Dating of Amendments

The date of receipt by - the International Bureau of any amendment made under Article 19 shall be recorded by that Bureau, which shall also notify the applicant of the date and indicate the date in any publication or copy issued by it.

Chapter 19: Making it possible for the applicant to state more
in his explanations of amendments of claims filed with the
International Bureau

(Concerns Rule 46.4)

Proposal approved by the Committee

(see documents PCT/CAL/II/3, pages 20 to 22, and
PCT/CAL/II/9, paragraph 38)

1. Under Article 19(1), the applicant may amend the claims before the International Bureau and file, at the same time, a brief statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings. Details concerning the statement are provided for in Rule 46.4. The statement is to be distinguished from the letter which is required under Rule 46.5 either in order to explain the differences between the replacement sheets (on which the amendments are submitted) and the replaced sheets or in order to cancel entire sheets. The statement must, under the present Rule 46.4(b), contain no comments on the international search report or the relevance of the citations contained in that report but it may refer to a citation (appearing in the said report) in order to indicate that a specific amendment of a claim is intended to avoid the cited document. The statement will not be published by the International Bureau if the latter finds that it does not comply with the provisions of Rule 46.4 (see Rule 48.2(h)).
2. *Ad Rule 46.4(a)*. The International Bureau has encountered difficulties in determining in papers received from the applicant what is meant by him to be a statement under Article 19(1) and what is to be taken as a letter explaining the differences between replaced and replacement sheets or cancelling an entire sheet. Yet the correct determination is important since: (i) the statement is, whereas the explanatory letter is not, to be published and (ii) any statement published and communicated to the designated Offices is considered to be part of the international application (see present Rules 49.3 and 76.3) and should be translated under Article 22(1) or Article 39 (1) (a) whereas the contrary is true for any explanatory letter. If the explanatory letter is taken by the International Bureau to be a statement but was not meant as such by the applicant, there is a risk that the applicant will fail to translate it for the designated Offices. On the other hand, it can also happen that what is taken by the International Bureau as an explanatory letter was meant by the applicant to be a statement under Article 19 and therefore would neither be published nor communicated to the designated Offices.
3. It is proposed to eliminate the risk of such confusion by adding to Rule 46.4(a) an additional sentence that would require that any statement under Article 19(1) must by the applicant be identified as such by a heading, preferably by using the words "Statement under Article 19(1)" or their equivalent in the language of the statement. It would follow from this rule that if a text is not so identified by the applicant, the International Bureau would consider it as an explanatory letter which, because it is a mere letter and not an explanatory statement, is neither published nor communicated to the designated Offices. The applicant would then also know that only what was meant to be a statement and has been identified as such by him through the said heading should be translated for the designated Offices.

4. *Ad Rule 46.4(b)*. The checking of compliance of a statement with the provisions of the existing Rule 46.4(b) is, in practice, sometimes a difficult task: the statement must, on the one hand, contain no comments on the relevance of the citations contained in the international search report but it may, on the other hand, refer to such a citation to indicate that a specific amendment of a claim is intended to avoid the document cited and this reference often contains a kind of explanation that the cited document is not relevant in relation to what is still claimed in the amended claim. The borderline between such an explanation and a comment which is not admitted under the present Rule is not always entirely clear. The applicant has problems when drafting a statement complying with Rule 46.4(b) and the International Bureau when checking the compliance of the statement with that Rule.

[Chapter 19]

Rule 46

Amendment of Claims before the International Bureau

46.1 and 46.2 [See Chapter 17 on page 35, above]

46.3 [See Chapter 18 in a subsequent document]

46.4 *Statement*

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published and shall not exceed 500 words if in the English language or if translated into that language. The statement shall be identified as such by a heading, preferably by using the words “Statement under Article 19 (1)” or their equivalent in the language of the statement.

(b) The statement shall contain no disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

46.5 [See Chapter 11 on page 24, above]

[Chapter 19]

5. It cannot and should not be the task of the International Bureau to examine each statement received under Article 19(1) as to whether a reference made in such statement to a citation contained' in the international search report in order to indicate that a specific amendment of a given claim is intended to avoid the document cited is or is not at the same time to be considered as a comment on the international search report or the relevance of a citation contained in that report.

6. It is therefore proposed to permit the inclusion, in statements explaining amendments, of comments on the international search report and on the relevance of citations contained in that report to the extent that they are not disparaging. The statement, which is published together with the international application, is, naturally, not the appropriate forum for dissatisfied applicants, to argue about the quality of the work of an International Searching Authority. If, however, the applicant has an opinion about the prior art cited in the international search report in the context of its relevance for the amendment of the claims, he should be permitted to present his views. Such views may be of interest to the public as well as to the designated Offices. In any case, general comments which are made although no claim is amended cannot be permitted, since Article 19(1) provides for the possibility to make a statement only where amendments have been filed. Therefore any statement referring to citations contained in the international search report must remain prohibited if they are not linked to a specific amendment, and proposed Rule 46.4(b) clearly implies this rule. E.g., a statement saying that none of the documents cited is considered to be relevant and that no amendments seem to be required, would be excluded. The proposed Rule 46.4(b) would, however, give an opportunity for the applicant to comment on the relevance of citations' contained in the international search report if a claim is being amended and only if a claim is amended and if the citations are relevant to the amended claim. Such comments would add useful information for any reader of the published international applications and for the national Offices.

Chapter 20: Simplifying the communication under Article 20 of the international application; changing the date which is relevant for an indication in the pamphlet if certain events have not occurred before that date

(Concerns Rules 47.1 and 48.2)

Proposals approved by the Committee
(see documents PCT/CAL/II/3, pages 24 to 29, and
PCT/CAL/II/9, paragraphs 39 and 40)

1. Present Rule 47.1(b) provides that if, at the time the communication under Article 20 of the international application is effected, the time limit under Rule 46.1 (for making amendments to the claims under Article 19) has not expired and the International Bureau has neither received amendments to the claims nor a declaration that the applicant does not wish to make such amendments, the applicant and the designated Offices must be notified accordingly. Similarly, under present Rule 48.2(h), if, at the time when publication is due, the time limit under Rule 46.1 has not expired, the pamphlet must refer to that fact and indicate that, should amendments to the claims be received later by the International Bureau, they would be published subsequently.
2. Communication under Article 20 is normally effected immediately after international publication. It may occur that, when the time limit under Rule 46.1 expires after the preparation of the pamphlet is achieved but before the communication is effected, amendments or the applicant's declaration are received during that period. In such a situation, the pamphlet, which is used for communication to all designated Offices, contains an indication that the time limit under Rule 46.1 has not expired which implies that neither amendments nor a declaration have been received from the applicant but in fact such amendments or such declaration have been received at the time of the communication. Moreover, such an indication on the pamphlet is not true in those cases where the amendments have been received after the completion of the technical preparations for the international publication but before actual publication.
3. It is proposed to bring this somewhat anomalous situation to an end by amending Rules 47.1(b) and 48.2(h).
4. *Ad Rule 48.2(g) and (h)*. Any pamphlet can only reflect the situation that exists at the end of the time of the preparation for the printing ("technical preparations") of the international application, which, naturally, is earlier than the time when publication is due. This applies not only to the indication concerning the time limit under Rule 46.1 for amending the claims under Article 19 (Rule 48.2 (h)) but also to the indication concerning the receipt of the international search report (Rule 48.2 (g)). Consequently, it is proposed to replace, both in paragraph (g) and in paragraph (h) of Rule 48.2, the words "at the time when publication is due" appearing in each of those paragraphs by the words "at the time of the completion of the technical preparations for international publication."
5. *Ad Rule 47.1(b)*. Since the pamphlet is used for the purposes of communication under Article 20, it seems superfluous to notify again facts which are already indicated in the pamphlet. It is therefore proposed to delete the first half of the second sentence of present Rule 47.1(b) concerning the situation where the time limit under Rule 46.1 has not expired at

the time when the communication is effected. The second half of the second sentence of present Rule 47.1(b) should be amended by providing for the subsequent communication (and a corresponding notification of the applicant) of any amendment which was received within the time limit under Rule 46.1 but which was not included in the first communication since it was received after the completion of the technical preparations for the international publication and therefore not included in the pamphlet. (In such a case the amendments will be published under Rule 48.2(h)).

[Chapter 20]

Rule 47

Communication to Designated Offices

47.1 *Procedure*

(a) [No change]

(b) Such communication shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.*

(c) to (e) [No change]

47.2 and 47.3 [No change]

* The amendment also consists of deleting the last sentence of Rule 47.1(b).

[Chapter 20]

6. Should the amendment of the time limit under Article 22(2) as proposed in Chapter 32-33, in a subsequent document, be adopted, the last sentence of Rule 47.1(b) would become obsolete, since the communication of an international application within one month from the date on which the International Bureau has been notified by the International Searching Authority of a declaration under Article 17(2) (a) to the effect that no international search report will be established is no longer required. The time before which national processing of such application may not start would be 20 months from the priority date and the pamphlet containing a reference to such a declaration (see Rule 48.2 (a) (v) could be used for communication under Article 20.

7. *Ad Rule 47.2 (c)*. All designated Offices have accepted that the International Bureau uses copies of the pamphlet under Rule 48 for the purposes of the communication of the international application under Article 20. The advantages of this practice are evident. The use of the pamphlet has also brought about considerable economies for the International Bureau. In order to secure that any future designated Office would follow the general practice of all present designated Offices, the International Bureau had proposed to the Committee to delete from the present text of Rule 47.2(c) the words "Except to the extent that any designated Office notifies the International Bureau otherwise." During the second session of the Committee, however, it was agreed not to amend the present text of Rule 47.2(c) on the understanding that the International Bureau could ask at any time for a reconsideration of that provision if the exceptions to the general rule that copies of the pamphlet under Rule 48 may be used- for the purposes "of the communication of the international application under Article 20 were to increase to such an extent that they would put a substantial additional burden on the International Bureau.

[Chapter 20]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

(b) [See Chapter 3 in a subsequent document]

(c) to (f) [No change]

(g) If, at the time of the completion of the technical preparations for international publication, the international search report is not yet available (for example, because of publication on the request of the applicant as provided in Articles 21 (2) (b) and 64 (3) (c)) (i)), the pamphlet shall contain, in place of the international search report, an indication to the effect that that report was not available and that either the pamphlet (then also including the international search report) will be republished or the international search report (when it becomes available) will be separately published.

(h) If, at the time of the completion of the technical preparations for international publication, the time limit for amending the claims under Article 19 has not expired, the pamphlet shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after such amendments, either the pamphlet (containing the claims as amended) will be republished or a statement reflecting all the amendments will be published. In the latter case, at least the front page and the claims shall be republished and, if a statement under Article 19 (1) has been filed, that statement shall be published as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4.

(i) [No change].

[Chapter 20]

48.3 *Languages*

(a) and (b) [See Chapter 15 in a subsequent document]

(c) [See Chapter 21 on page 47, below]

48.4 and 48.5 [No change]

48.6 *Announcing of Certain Facts*

(a) [No change]

(b) [See Chapter 13 in a subsequent document]

(c) [See Chapter 14 in a subsequent document]

Chapter 21: Including in the publication of the international application in a language other than English also an English translation of the title of the invention and of any text matter pertaining to figures accompanying the abstract

(Concerns Rule 48.3)

Proposal approved by the Committee

(see documents PCT/CAL/II/3, pages 30 and 31, and PCT/CAL/II/9, paragraph 41)

1. Under the present Rule 48.3(c), if the international application is published in a language other than English, its publication must include a translation into English of the abstract. Text matter contained in the figure (or figures) accompanying the abstract and published with it is, at present, not required to be published also in English.
2. Interest has been expressed in including in the pamphlet, where a figure published with the abstract contains any text matter, also a translation of such text matter. In most cases, the abstract requires to be accompanied by a figure in order that the technical features of the invention can more readily be understood. If such figure consists of a table or contains explanatory text matter, the technical features of the invention cannot be readily understood if such text matter is not also in the English language.
3. Consequently, it is proposed to amend Rule 48.3(c) and to provide for the publication in English of any text matter pertaining to the figure (or figures) published with the abstract. The translation of such text matter would be the responsibility of the International Bureau and would not constitute an additional burden since that Bureau has to prepare such translation for publication in the PCT Gazette in the English language anyway. In some cases, it would be possible to present on the front page of the pamphlet a figure with text matter in both the original language and the English language. But in the (more frequent) cases where tables and diagrams are involved, such bilingual solution would not be feasible since the manner in which such tables or diagrams have been drawn up by the applicant does not provide for enough space to include also the translation into English of the text matter. In such cases, the figure would have to be published twice, namely, once with the text matter in English (together with the English text of the abstract) and once with the text matter in the original language (together with the abstract in that original language).
4. Furthermore, it is proposed to specify in Rule 48.3(c) that, if the international application is published in a language other than English, its publication must include a translation into English of the title of the invention, as it does in practice. The text of Rule 48.3(c) would thus be fully harmonized with the practice under that Rule.

[Chapter 21]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

- (a) [No change]
- (b) [See Chapter 3 in a subsequent document]
- (c) to (f) [No change]
- (g) and (h) [See Chapter 20 on page 45, above]
- (i) [No change]

48.3 *Languages*

(a) and (b) [See Chapter 15 in a subsequent document]

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a) (v), or the declaration referred to in Article 17(2) (a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

48.4 and 48.5 [No change]

48.6 *Announcing of Certain Facts*

- (a) [No change]
- (b) [See Chapter 13 in a subsequent document]
- (c) [See Chapter 14 in a subsequent document]

Chapter 22: Reducing from two to one the number of copies of
the demand to be filed by the applicant

(Concerns Rules 53.1 and -61.1)

Proposals approved by the Committee

(see documents PCT/CAL/II/3, pages 32 and 33, and
PCT/CAL/II/9, paragraph 42)

1. Under present Rule 53.1(d), the demand must be submitted in two identical copies: one of the copies is kept in the files of the International Preliminary Examining Authority with which the demand was filed and the other the original copy is sent by the said Authority to the International Bureau (see Rule 61.1(a)).
2. Although it is not a particular burden for the applicant to submit the demand in two copies, that requirement may be forgotten, and applicants have expressed interest in changing the rule so that one copy only should be required.
3. It is therefore proposed to delete paragraph (d) of Rule 53.1 and to provide in Rule 61.1(a) for the preparation of a copy of the demand by the International Preliminary Examining Authority. The original would be sent to the International Bureau whereas the copy prepared by the said Authority would be kept in the files of that Authority. The burden which is placed on the International Preliminary Examining Authority through this amendment is a light one. Moreover, it will largely be compensated by the fact that the International Preliminary Examining Authority would be relieved from the burden of issuing an invitation to the applicant to file a second copy if he filed the demand only in one copy (see Rule 60.1 (a)) and of checking the identity of the two copies. In fact, it is already the practice of some of the International Preliminary Examining Authorities to make such copy instead of sending an invitation to the applicant, since making a copy is cheaper, easier and faster than the invitation procedure provided for in Rule 60.1(a).

[Chapter 22]

Rule 53

The Demand

53.1 *Form*

(a) to (c) [No change]

(d) [Deleted]

53.2 to 53.8 [No change]

Rule 61

Notification of the Demand and Elections

61.1 *Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority*

(a) The International Preliminary Examining Authority shall indicate on* the demand the date of receipt or, where applicable, the date referred to in Rule 60.1(b). The International Preliminary Examining Authority shall promptly send the demand to the International Bureau, and shall prepare and keep a copy in its files.

(b) [See Chapter 23 on page 51, below]

(c) [No change]

61.2 and 61.3 [No change]

* The amendment consists of deleting, after the word “on,” the words “both copies of.”

Chapter 23: Making clear the consequences if a demand is made by
an applicant not entitled to do so, and providing for a
refund of the preliminary examination fee in such a case

(Concerns Rules 54.3, 54.4, 5~.3 and 61.1)

Proposals approved by the Committee

(see documents PCT/CAL/II/3, pages 34 to 37, and
PCT/CAL/II/9, paragraph 43)

1. *Ad Rules 54.3 and 54.4.* Present Rule 54.3(b) provides that, in the (exceptional) case of different applicants indicated for the purposes of different elected States, the election of a State is considered not to have been made if none of the applicants indicated for the purposes of that State is qualified to make a demand under Article 31(2).
2. Rule 54 does not contain a provision for the (more common) case where the applicant or, in case of several applicants indicated for the purposes of all elected States, none of them is qualified under Article 31(2) to make a demand.
3. Although there are no doubts about the legal consequence in cases where none of the applicants is qualified to make a demand, it is proposed to clarify the situation by adding a new Rule 54.4 to Rule 54. Paragraph (a) would provide that the demand shall be considered not to have been made if the applicant or, in case of several applicants, none of them is entitled to make a demand. Paragraph (b) would be practically identical to the present text of Rule 54.3(b), which is proposed to be transferred to Rule 54.4 in order for that Rule to cover all cases of applicants not qualified to make a demand.
4. *Ad Rule 58.3.* Where the demand is considered not to have been submitted because of non-payment of the handling fee or the preliminary examination fee in spite of an invitation to pay (Rules 57.4(c) and 58.2(c)) or because the applicant did not comply with an invitation to correct a defect in the demand (Rule 60.1(c)), a refund of any amount paid as preliminary examination fee is provided for in present Rule 58.3. It seems to be justified to apply the same Rule to the case where the demand would be considered not to have been made under the proposed new Rule 54.4(a). In addition, there may be other cases where a demand is considered not to have been made, for example, the case where a national of a Contracting State not bound by Chapter II of the PCT makes a demand under Article 31 (2) but elects only States which have not declared that they are prepared to be elected by such an applicant (see Article 31(4) (b)). In order to be sure that all such cases are covered by Rule 58.3, it is proposed to amend it by deleting all references to other provisions.
5. *Ad Rule 61.1(b).* Where the demand is considered not to have been submitted under Rules 57.4(c), 58.2(c) or 60.1(c), the International Preliminary Examining Authority must, under the present text of Rule 61.1(b), notify the applicant but not the International Bureau. On the other hand, where the demand is considered not to have been submitted under the proposed new Rule 54.4 (see paragraph 4, above), the International Preliminary Examining Authority must, under the present text of Section 601 of the Administrative Instructions, notify not only the applicant but also the International Bureau. It is proposed to eliminate such discrepancy by providing for a notification to the International Bureau also in Rule 61.1(b) and to extend the scope of Rule 61.1(b) to the cases referred to in the proposed new Rule 54.4(a) and (b). As a consequence, it is proposed to delete Section 601, the contents of which

would be incorporated into Rule 61.1 (b). In addition, it is proposed to add a new Section (Section 418) to the Administrative Instructions in order to provide for a notification by the International Bureau to all elected Offices concerned where they have been notified of their elections and the demand is considered not to have been

[Chapter 23]

Rule 54

The Applicant Entitled to Make a Demand

54.1 and 54.2 [No change]

54.3 *Several Applicants: Different for Different Elected States*

(a) [No change]

(b) [Deleted]

54.4 *Applicant Not Entitled to Make a Demand or an Election*

(a) If the applicant does not have the right or, in the case of several applicants, if none of them has the right to make a demand under Article 31(2), the demand shall be considered not to have been submitted.

(b) If the requirement under Rule 54.3(a) is not fulfilled in respect of any elected State, the election of that State shall be considered not to have been made.

[Chapter 23]

submitted, or the relevant election is considered not to have been made. The amendments to the Administrative Instructions which are referred to in this paragraph could be the following:

Section 418

Notifications to Elected Offices Where the Demand or an Election
is Considered Not to Have Been Submitted or Made

Where, after any elected Office has been notified of its election under Article 31 (7), the demand or the election is considered not to have been submitted or made, the International Bureau shall notify the said Office accordingly.

Section 601

Determination Whether Applicant is entitled to make a Demand

[Deleted]

[Chapter 23]

Rule 58

The Preliminary Examination Fee

58.1 and 58.2 [No change]

58.3 *Refund*

The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted*, and the International Bureau shall promptly publish such information.

Rule 61

Notification of the Demand and Elections

61.1 *Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority*

(a) [See Chapter 22 on page 50, above]

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 54. 4 (b) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) [No change]

61.2 and 61.3 [No change]

* The amendment consists of deleting, after the word “submitted,” the words “under Rule 57.4(c), Rule 58.2(c) or Rule 60.1(c).”

Chapter 27bis: Eliminating a discrepancy between the English and French texts of Rule 82.1(c)

(Concerns Rule 82.1)

Proposal approved by the Committee

(see documents PCT/CAL/II/5 and

PCT/CAL/II/9, paragraph 49)

1. It has come to the attention of the International Bureau that there is a discrepancy between the English and French texts of Rule 82.1(c), which prescribes a time limit for performing certain acts in case of delay or loss in the mail. The difference consists in the following: in the case where a document or letter was lost, the time limit provided for in the English text is a time limit for submitting the substitute document or letter but not for submitting evidence concerning its identity with the document or letter lost, whereas in the French text it is a time limit for submitting the said evidence but not the document or letter lost.
2. Both texts appear to be defective. Under Rule 82.1(b), the applicant must offer a substitute document or letter for the one lost in the mail and evidence concerning the identity between the substitute document or letter and the document or letter lost. Rule 82.1(c) should, therefore, prescribe a time limit for both acts. Thus, it is proposed to amend both the English and the French texts of Rule 82.1(c) so that they provide that the substitute document or letter and the evidence concerning its identity with the lost one must be submitted within the time limit fixed by this Rule.

[Chapter 27bis]

Rule 82

Irregularities in the Mail Service

82.1 *Delay or Loss in Mail*

(a) and (b) [No change]

(c) In the cases provided for in paragraph (b), evidence of mailing within the prescribed time limit, and, where the document or letter was lost, the substitute document or letter as well as the evidence concerning its identity with the document or letter lost shall be submitted within 1 month after the date on which the interested party noticed or with due diligence should have noticed the delay or the loss, and in no case later than 6 months after the expiration of the time limit applicable in the given case.

82.2 [No change]

Chapter 28: Deleting a Rule whose period of applicability has expired

(Concerns Rules 88.2 and 88.4)

Proposals approved by the Committee

(see documents PCT/CAL/II/3, pages 50 and 51, and
PCT/CAL/II/9, paragraph 50)

1. *Ad Rule 88.2.* This Rule contains provisions applicable only “during the first 5 years after the entry into force of the Treaty.” Since that period expired on January 24, 1983, the Rule has ceased to be applicable from that date. Its continued presence in the Regulations is therefore superfluous. It is suggested that it be deleted.

2. *Ad Rule 88.4.* The proposed amendment to that Rule, which consists of deleting the reference to Rule 88.2, is consequential to the proposed deletion of that same Rule 88.2.

[Chapter 28]

Rule 88

Amendment of the Regulations

88.1 [No change]

88.2 *Requirement of Unanimity during a Transitional Period*

[Deleted]

88.3 [No change]

88.4 *Procedure*

Any proposal for amending a provision referred to in Rules 88.1* or 88.3 shall, if the proposal is to be decided upon in the Assembly, be communicated to all Contracting States at least 2 months prior to the opening of that session of the Assembly which is called upon to make a decision on the proposal.

* The amendment consists of deleting, after the expression "Rule 88.1," the expression "88.2."

Chapter 29: Correcting a mistake in Rule 90.3(c)

(Concerns Rule 90.3)

Proposal approved by the Committee

(see documents peT/CAL/II/3, pages 52 and 53 Rev.

(in document PCT/CAL/II/B), and PCT/CAL/II/9, paragraph 51)

1. This amendment is intended to correct an oversight that occurred in the fifth session of the Assembly of the PCT Union. Rule 90.3(a), in its original text (1970), provided in essence that the appointment of any agent or common representative, if the said agent or representative is not designated in the request signed by all applicants, must be effected in a separate signed power of attorney (emphasis added). In 1980, Rule 90.3(a) was amended by the Assembly of the PCT Union. As amended, that Rule now provides that the appointment of any agent or common representative must 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. This amended text of paragraph (a) of Rule 90.3 no longer requires the separate power of attorney to be signed since such requirement of signature is contained in paragraph (c) of Rule 90.3. The text of this latter paragraph, however, refers still to paragraph (a) in connection with the said requirement of signature, but such reference has no object. It is therefore proposed to delete the words “as provided in paragraph (a)” in Rule 90.3(c).

2. At the same time, it is contemplated to modify the text of Section 106 of the Administrative Instructions in order to harmonize it with the amended text of Rule 90.3(a). The text of the modified Section 106 could read as follows:

Section 106

Common Agent for Several Applicants

(a) In the case of several applicants, any agent designated under Rule 4.7 in the request^{*}, or appointed under Rule 90.3 in a separate power of attorney^{**}, shall be considered a common agent.

(b) [No change]

* The amendment consists of deleting, after the word “request,” the words “signed by all the applicants.”

** The amendment consists of deleting, after the word “attorney,” the words “signed by all the applicants.”

[Chapter 29]

Rule 90

Representation

90.1 and 90.2 [No change]

90.3 Appointment

(a) and (b) [No change]

(c) If the separate power of attorney is not signed*, or if the required separate power of attorney 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 non-existent unless the defect is corrected.

(d) [No change]

90.4 [No change]

[Annex follows]

* The amendment consists of deleting, after the word “signed,” the words “as provided in paragraph (a).”

PCT/A/XI/3

ANNEX

Draft

Resolution

The Assembly of the International Patent Cooperation Union
(PCT Union)

Noting that the number of developing countries which are members of the PCT Union is relatively small,

Noting further that the number of international application emanating from those developing countries which are members of the PCT Union is extremely small,

Assuming that one of the reasons for such unsatisfactory situation may be the high cost of international search and international preliminary examination for applicants of developing countries,

Resolves to:

(1) Recommend to all States members of the PCT Union to seek ways and means for financing at least part of the fees payable by nationals of developing countries for international search and international preliminary examination;

(2) Recommend to all International Searching and Preliminary Examining Authorities to study the possibility to reduce the amount of the fees payable by nationals of developing countries for international search and international preliminary examination;

(3) Recommend to all States members of the PCT Union to study whether national or regional funds could be put at the disposal of the International Bureau or of the International Searching and Preliminary Examining Authorities, in order to be used to assist such applicants from developing countries in paying such fees.

[End of Annex and of document]