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

Memorandum of the International Bureau

INTRODUCTION

1. The present document is the second of several documents prepared for the Assembly by the International Bureau and containing proposed amendments to the PCT and to the Regulations under the PCT.
2. The introduction contained in document PCT/A/XI/3 applies also to the present document. Under the heading of each Chapter, it is indicated if the proposal has been revised as compared to the corresponding proposals made to the second session of the Committee for Administrative and Legal Matters (hereinafter referred to as "the Committee"). Where no such indication is given, only the explanations (including, in some cases, the Administrative Instructions contained in the explanations) have been revised.

* *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

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EXPLANATIONS OF THE PROPOSED AMENDMENTS

Chapter 3: Omitting any drawing from the publication of the abstract where the International Searching Authority finds that no drawing is useful for the understanding of the abstract

(Concerns Rules 8.2 and 48.2)

Revised proposal (drafting only)

(see documents PCT/CAL/II/2, pages 14 and 15, and PCT/CAL/II/9, paragraph 12)

1. *Ad Rule 8.2.* Under Rule 3.3(a) (iii), the applicant must indicate the (serial) number of the figure of the drawings which he suggests should accompany the abstract on the front page of the pamphlet and in the Gazette; in exceptional cases, the applicant may suggest more than one figure. Under present Rule 8.2, if the applicant fails to make that indication, or if the International Searching Authority finds that a figure (or figures) other than that figure (or those figures) suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, the said Authority must indicate the figure (or figures) which it so considers, and that figure (or those figures) will be used by the International Bureau in its publications, that is, in the pamphlet and in the Gazette (see Rules 48. 2(b) (ii) and 86.1(i)).
2. International Searching Authorities have found, in some cases, that none of the figures of the drawings even if one or some were suggested by the applicant for accompanying the abstract would help in understanding the abstract. Consequently, it is proposed to allow the International Searching Authority to notify, in such a case, the International Bureau that no drawing should accompany the abstract and to provide that, if so notified, the International Bureau would proceed accordingly. This change would be expressed in what would be a new paragraph (paragraph (b)) of Rule 8.2.
3. The existing (sole) paragraph of Rule 8.2 would become paragraph (a). It would refer, where necessary, to the exception contained in paragraph (b) and its drafting would be improved.
4. Item 4 of Box No. III in the international search report form (Form PCT/ISA/210) is proposed to be modified in order to allow for the International Searching Authority to indicate, where Rule 8.2(b) applies, that none of the figures of the drawings is useful for the understanding of the abstract. The revised first sheet of the form is reproduced on page 6, below.
5. *Ad Rule 48.2.* The amendment proposed to Rule 48.2(b)(ii) is consequential to the amendment of Rule 8.2.

TEXT OF THE PROPOSED AMENDMENTS

[Chapter 3]

Rule 8

The Abstract

8.1 [No change]

8.2 *Figure*

(a) If the applicant fails to make the indication referred to in Rule 3.3 (a) (iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall, subject to paragraph (b), indicate the figure or figures which should accompany the publications of the abstract by the International Bureau. In such case, the said publications shall be accompanied by the figure or figures so indicated by the International Searching Authority. Otherwise, the said publications shall, subject to paragraph (b), be accompanied by the figure or figures suggested by the applicant.

(b) If the International Searching Authority finds that none of the figures of the drawings is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, publications of the abstract by the International Bureau shall not be accompanied by any figure of the drawings even where the applicant has made a suggestion under Rule 3. 3(a)(iii).

8.3 [No change]

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference	FOR FURTHER ACTION see Form PCT/ISA/220 as well as, where applicable, item 5 below.	
International application No.	International filing date (<i>day/month/year</i>)	(Earliest) Priority Date (<i>day/month/year</i>)
Applicant		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of _____ sheets.

It is also accompanied by a copy of each prior art document cited in this report.

1. **Basis of the report**

a. With regard to the **language**, the international search was carried out on the basis of:

the international application in the language in which it was filed.

a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

b. This international search report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43.6bis(a)).

c. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

2. **Certain claims were found unsearchable** (see Box No. II).

3. **Unity of invention is lacking** (see Box No. III).

4. With regard to the **title**,

the text is approved as submitted by the applicant.

the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

the text is approved as submitted by the applicant.

the text has been established, according to Rule 38.2, by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the **drawings**,

a. the figure of the **drawings** to be published with the abstract is Figure No. _____

as suggested by the applicant.

as selected by this Authority, because the applicant failed to suggest a figure.

as selected by this Authority, because this figure better characterizes the invention.

b. none of the figures is to be published with the abstract.

[Chapter 3]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

(b) Subject to paragraph (c), the front page shall include:

(i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions,

(ii) a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies,

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first.

(c) to (f) [No change]

(g) and (h) [See Chapter 20 on page 45 of document PCT/A/XI/3]

(i) [No change]

48.3 *Languages*

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

(c) [See Chapter 21 on page 46 of document PCT/A/XI/3]

48.4 and 48.5 [No change]

48.6 *Announcing of Certain Facts*

(a) [No change]

(b) [See Chapter 13 on page 42, below]

(c) [See Chapter 14 on page 51, below]

Chapter 7: Providing for quicker information of the International Bureau
where charges are made under Rule 16bis, and providing for the
universal application of that Rule

(Concerns Rules 16bis.1, 16bis.2 and 16bis.3)

Proposals approved by the Committee

(see documents PCT/CAL/II/2, pages 26 to 30, and
PCT/CAL/II/9, paragraph 16)

1. *Ad Rule 16bis.1 (a) and (b)*. The amendments proposed for this Rule are consequential upon the amendments proposed for Rule 15.4 (see Chapter 6 in a subsequent document).
2. *Ad Rule 16bis.1 (d)*. The present Rule provides, where charges to cover amounts of fees not paid by the applicant have been made to the International Bureau, that the receiving Office must inform the International Bureau each month.
3. Experience has shown that it can happen that the information about any charges made to the International Bureau is being received at a time when the International Searching Authority has already started searching the international application. Such situation could to a large extent be avoided if the International Bureau would receive information about any charges made to it under Rule 16bis.1 as early as possible.
4. It is therefore proposed to provide for the information to the International Bureau to be made promptly after the latter has been charged. This would allow an earlier invitation to pay under Rule 16bis.2 and, consequently, earlier clarity about effective payment of any fee which had so far not been (completely) paid by the applicant. The proposed procedure would not allow notification of the International Bureau once a month only but would require a separate notification each time, and promptly, as the receiving Office charges an amount to the International Bureau. Since the cases are rare, no real increase in the workload of the receiving Offices would occur and, in fact, the proposed procedure already corresponds to the practice of all receiving Offices applying the procedure under Rule 16bis. In addition, it should be expressly provided that, in conformity with the practice established since the entry into force of Rule 16bis, the establishment of the international search report should be delayed until the applicant has paid the amounts due to cover the search fee and the surcharge. This would require that the International Searching Authority be informed too of any charge made to the International Bureau where the charge concerns (also) the search fee.
5. It is furthermore proposed to transfer the provisions embodying the proposed procedure into the Administrative Instructions and thus to delete Rule 16bis.1(d) in the form of new Sections 318 and 509, the texts of which could read as follows:

[Chapter 7]

Section 318

Information of Any Charge Made under Rule 16bis.1

(a) The receiving Office shall promptly inform the International Bureau of any charge made under Rule 16bis.1(a) or (b).

(b) Where the charge made under Rule 16bis.1(a) concerns the search fee or part of it, the receiving Office shall also promptly inform the International Searching Authority.

[Chapter 7]

Rule 16bis

Advancing Fees by the International Bureau

16bis.1 *Guarantee by the International Bureau*

(a) Where, by the time they are due under Rule 14.1(b), Rule 15.4(a)* and Rule 16.1(f), the receiving Office finds that in respect of an international application no fees were paid to it by the applicant, or that the amount paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and the search fee, the receiving Office shall charge the amount required to cover those fees, or the missing part thereof, to the International Bureau and shall consider the said amount as if it had been paid by the applicant at the due time.

(b) Where, by the time** they are due under Rule 15.4(b)*, the receiving Office finds that in respect of an international application the payment made by the applicant is insufficient to cover the designation fees necessary to cover all the designations, the receiving Office shall charge the amount required to cover those fees to the International Bureau and shall consider that amount as if it had been paid by the applicant at the due time.

(c) [No change]

(d) [Deleted]

* The amendment consists of deleting the reference to paragraph (c).

** The amendment consists of deleting, after the word “time,” the words “it or.”

[Chapter 7]

Section 509

Procedure where Information is received under Section 318(b)

Where the International Searching Authority has received information under Section 318 (b), it shall not proceed with the establishment and the transmittal of the international search report until it receives information from the International Bureau that the amounts due to cover the search fee and the surcharge have been paid by the applicant.

6. *Ad Rule 16bis.2(d) to (g)*. Paragraphs (d) to (g) of Rule 16bis.2 concern financial matters which interest only the receiving Office and the International Bureau. It is proposed to transfer the contents of paragraphs (d) and (f) to the Administrative Instructions. As far as paragraphs (e) and (g) are concerned, it is proposed to delete them altogether since they do not correspond to the practice. The practice is that no receiving Office keeps amounts charged to cover the basic fee and the designation fee. These amounts are transferred in all cases by the receiving Office to the International Bureau, irrespective of whether they have been paid by the applicant or charged under Rule 16bis and regardless of the fate of the international application and of the designations. Consequently, there is no amount which could be refunded by the receiving Office. As a matter of fact, paragraph (d) could also be deleted since it is clear from Rule 14.1 that the transmittal fee belongs to the receiving Office; however, in order to avoid any doubt, it is not proposed to delete that paragraph. The text of a new Section 319 could read as follows:

Section 319

Return of Amounts Charged under Rule 16bis.1

(a) The receiving Office shall not return to the International Bureau any amount that it has charged under Rule 16bis.1(a) to that Bureau for covering the transmittal fee.

(b) Where the international application is considered withdrawn, any search fee charged under Rule 16bis.1(a) by the receiving Office and transferred to the International Searching Authority shall be transferred by that Authority to the International Bureau unless the said Authority has already started the international search.

[Chapter 7]

16bis.2 Obligations of the Applicant, Etc.

(a) to (c) [No change]

(d) to (g) [Deleted]

16bis.3 *Notifications*

[Deleted]

[Chapter 7]

7. *Ad Rule 16bis. 3.* It is recalled that Rule 16bis was adopted by the Assembly of the PCT Union in June 1980 and entered into force on October 1, 1980. When discussing the proposal for Rule 16bis, some delegations felt that they could not accept such a Rule if it were to enter into force as it did only a few months later.

8. By September 1, 1980, notifications under Rule 16bis.3 had been received from the receiving Offices of Australia, Austria, Hungary and Japan. The receiving Offices of Australia, Austria and Hungary withdrew subsequently their notifications so that, at the present time, it is only in Japan that Rules 16bis.1 and 16bis.2 are not applicable. However, the Delegation of Japan declared at the 8th session of the Committee (April 1983) that the receiving Office of its country was now in a position to withdraw its notification.

9. It is therefore proposed to delete Rule 16bis.3.

Chapter 8: Clarifying various questions concerning the
submission of the priority document

(Concerns Rules 4.10 and 17.1)

Revised proposals

(see documents PCT/CAL/II/2, pages 32 to 34, and
PCT/CAL/II/9, paragraphs 17 and 18)

1. *Ad Rule 4.10(c)*. The present Rule provides that where the number of the earlier application (the priority of which is claimed in the international application) is not indicated in the request but is later, separately furnished, such number must be furnished to the International Bureau. During the discussion of the Committee at its second session, it was suggested to amend Rule 4.10(c) in order to allow also the furnishing of that number to the receiving Office (see document PCT/CAL/II/9, paragraph 18). The International Bureau has studied the proposal, agrees with it and submits it, as instructed by the Committee, to the Assembly for decision. However, the proposed amendment should, in the opinion of the International Bureau, be supplemented by a new Section 313bis and a consequential modification of Section 408(a) of the Administrative Instructions dealing with the notification of the said number to the International Bureau.
2. It is also proposed to delete the second and the third sentence of Rule 4.10(c) since they contain only instructions addressed to the International Bureau to be applied in the case where the priority application number is not furnished within the time limit of 16 months from the priority date. Their contents are already partially covered by Section 408 of the Administrative Instructions and require only a slight modification of paragraph (b) of that Section.
3. At the same time, it is proposed to modify the second part of paragraphs (b) and (c) of Section 408 of the Administrative Instructions dealing with the prescribed wording of the indication in the pamphlet of the fact that the priority application number was not furnished within the 16-month time limit. It is proposed to modify the text of those paragraphs by replacing the languages listed in the proviso at the end of those paragraphs by a reference to the language of publication of the international application. Such an amendment would improve the wording of those paragraphs and make them compatible with Rule 48.3(b) as proposed to be amended (by adding the Spanish language to the languages in which international applications are published (see Chapter 15 in a subsequent document)).
4. The text of the proposed new Section 313bis and the modified Section 408 of the Administrative Instructions could read as follows:

[Chapter 8]

Section 313bis

Later Indication of Priority Application Number

(a) Where the application number of the earlier application referred to in Rule 4.10(c) (priority application number) is furnished to the receiving Office, that Office shall enter the said number in the space provided therefore in the request Form or, where the record copy has already been transmitted to the International Bureau, promptly notify that Bureau of the said number.

(b) Where the priority application number is furnished to the receiving Office and reaches that Office after the expiration of 15 months and 20 days from the priority date, the said Office shall also notify the International Bureau of the date on which it received the priority application number.

[Chapter 8]

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) If the application number of the earlier application is not indicated in the request but is furnished by the applicant to the receiving Office or 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.*

(d) [See Chapter 1 on page 7 of document PCT/A/XI/3]

(e) [No change]

4.11 to 4.16 [No change]

4.17 [See Chapter I on page 8 of document PCT/A/XI/3]

* The amendment also consists of deleting the last two sentences of this paragraph and of transferring their contents to the Administrative Instructions (see proposed new Section 313bis on page 16 above, and Section 408 (a) and (b) on page 18 below).

[Chapter 8]

Section 408

Priority Application Number

(a) If the application number of the earlier application referred to in Rule 4.10(c) (priority application number) is furnished* within the prescribed time limit, the International Bureau shall enter the said number in the space provided therefore in the request Form.

(b) If the priority application number is furnished after the expiration of the prescribed time limit, the International Bureau shall inform the applicant and the designated Offices of the date on which the said number was furnished. It shall indicate the said date in the international publication by including on the front page of the pamphlet next to the priority application number the words “FURNISHED LATE ON (date)” and the equivalent of such words in the language in which the international application is published if that language is other than English.

(c) If the priority application number has not been furnished by the time of the international publication, the International Bureau shall indicate that fact by including on the front page of the pamphlet in the space provided for the priority application number the words “NOT FURNISHED” and the equivalent of such words in the language in which the international application is published if that language is other than English.

* The modification also consists of deleting, after the word “furnished,” the words “to the International Bureau.”

[Chapter 8]

Rule 17

The Priority Document

17.1 *Obligation to Submit Copy of Earlier National Application*

(a) 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.*

(b) 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.**

(c) [No change]

(d) [Deleted]

17.2 [No change]

* The amendment consists of deleting the last two sentences of this paragraph and of transferring their contents to the Administrative Instruction (see proposed new Section 314bis on page 20, below).

** The amendment consists of deleting the last sentence of this paragraph and of transferring its contents to the Administrative Instructions (see proposed new Section 314bis on page, below).

[Chapter 8]

5. *Ad Rule 17.1(a) and (b)*. The second and the third sentences of Rule 17.1 (a) and the last sentence of Rule. 17.1 (b) contain provisions addressed to the receiving Office concerning the transmittal of the priority document to the International Bureau and the indication of dates of receipt. It is proposed to transfer the contents of the said sentences to the Administrative Instructions as new Section 314bis. The text of this Section could read as follows:

Section 314bis

Transmittal of Priority Documents

(a) Any priority document which is submitted to the receiving Office shall be transmitted by that Office to the International Bureau together with the record copy or, if received after the record copy has been sent to the International Bureau, promptly after having been received by that Office.

(b) Where Rule 17.1(b) applies, the receiving Office shall, promptly after receipt of a request for transmittal of the priority document and, where applicable, the payment of the fee referred to in that Rule, transmit the priority document to the International Bureau. Where such request for transmittal has been made on the request Form and is considered by the receiving Office not to have been made for lack of payment of the required fee, that Office shall notify the International Bureau accordingly.

(c) Where the priority document is transmitted to the International Bureau after the expiration of 15 months and 20 days from the priority date by the receiving Office that Office shall indicate the date on which it received the priority document or the request under Rule 17.1(b).

6. *Ad Rule 17.1(c)*. In view of the proposed amendments to paragraphs (a) and (b) of Rule 17.1 (see the preceding paragraph), those paragraphs would no longer refer to requirements to be complied with by the receiving Office. Consequently, it is no longer proposed to amend paragraph (c) of Rule 17.1 in order to make it clear that it is only if requirements to be complied by the applicant as opposed to requirements to be complied by the receiving Office are not fulfilled that the priority claim may be disregarded by the designated States.

[Chapter 8]

7. *Ad Rule 17.1(d)*. This Rule prescribes, in the first and third sentences, the recording of the date on which the International Bureau has received the priority document and the notification of the applicant and of the designated Offices of such date. The second sentence of this Rule (“Where applicable, the date of receipt by the receiving Office of a request referred to under paragraph (b) shall be recorded as the date of receipt of the priority document.”) contains details on the question of which date has to be indicated. The important fact to be recorded and notified is whether the applicable time limit referred to in Rule 17.1 (a) has been complied with. If the time limit has been complied with, it is not important to record and notify the date on which the relevant event occurred (i.e., submission of the priority document to the International Bureau or to the receiving Office, under Rule 17.1 (a), or submission of a request to the receiving Office for transmitting the priority document to the International Bureau, under Rule 17.1(b)). Consequently, it is proposed to record and notify the date (on which the International Bureau received the priority document) in all cases where the said time limit was complied with and to record and notify the date (on which the receiving Office received the priority document or the request to transmit the priority document to the International Bureau) only in those cases where the said time limit was not complied with. It is proposed to provide for these administrative details in the Administrative Instructions rather than the Regulations and, consequently, delete Rule 17.1(d). The contemplated provisions of the Administrative Instructions could read as follows:

Section 411

Receipt of Priority Document

(a) Subject to paragraph (b), the International Bureau shall record the date on which the priority document has been received by it and shall notify the applicant and the designated Offices accordingly.

(b) Where the priority document has been received by the International Bureau from the receiving Office after the expiration of 16 months from the priority date, the date of receipt by the receiving Office of the priority document or of a request under Rule 17.1(b), as the case may be, shall be recorded as the date of receipt of the priority document.

(c) Where the date of receipt of the priority document is later than the date of expiration of the time limit referred to in Rule 17.1(a), the International Bureau shall notify the applicant and the designated Offices accordingly.

(d) Where, within the time limit referred to in Rule 17.1(a), the International Bureau has not received the priority document and the receiving Office has received neither the priority document nor a request (together with any required fee) to transmit the priority document, the International Bureau shall notify the applicant and the designated Offices accordingly.

Chapter 9: Making safer the transmittal of the record copy

(Concerns Rules 20.S, 22.1 to 22.5 and 23.1)

Proposals approved by the majority of the Committee
(see documents PCT/CAL/II/2, pages 36 to 38, 39 Rev.
(in document PCT/CAL/II/8) and 40 to 43, and
PCT/CAL/II/9, paragraphs 19 to 23)

1. *Ad Rules 20.5, 22.1, 22.2 and 22.3.* Under the present Rules, the obligation to transmit the record copy lies with the receiving Office. The receiving Office must mail the record copy to the International Bureau not later than five days prior to the expiration of the 13th month from the priority date (Rule 22.1(a)). The International Bureau notifies the applicant of the receipt of the record copy from the receiving Office. If the applicant is not in possession of such a notification by the expiration of 13 months and 10 days from the priority date that is, two weeks after the day on which the receiving Office must, at the latest, mail the record copy to the International Bureau then, and only then, the applicant himself may transmit the record copy (or a copy equivalent to the record copy) to the International Bureau. This is the procedure under the present Rule 22.1(b) and (c): it will be called hereinafter the “wait and act” procedure. It has, in fact, never been used by any applicant. There is also another procedure called, in the Regulations, “alternative procedure” under which, if the rules applicable in the receiving Office so permit, the applicant may, under certain conditions and without waiting for the expiration of any time limit, obtain the record copy from the receiving Office and forward himself the record copy so obtained to the International Bureau. This is the procedure under the present Rule 22.2, a somewhat involved Rule and one of the longest. It is to be noted that there are only two receiving Offices the Swedish Patent Office and the United States Patent and Trademark Office that allow the use of this alternative procedure and that, in fact, this procedure has also never been used by any applicant.
2. It is also to be noted that till now, as far as the International Bureau is aware, the record copies of all the international applications filed have reached the International Bureau within the prescribed time limit and through transmittal by the receiving Offices.
3. In view of these facts, and after more than five years of practical experience, one could conclude that both the “wait and act” procedure (Rule 22.1(b) and (c)) and the “alternative procedure” (Rule 22.2) are superfluous. Since, however, the theoretical possibility exists that a receiving Office might fail to transmit the record copy in time to the International Bureau, some kind of safeguard procedure should be provided for under which the applicant is reasonably protected against the consequence of any such failure on the part of the receiving Office, in other words, against the risk to lose his rights under Article 12(3).
4. It is therefore proposed to dispose of both the “wait and act” procedure (existing Rule 22.1 (b) and (c) and the “alternative procedure” (Rule 22.2) and to institute a new “safeguard” procedure.

[Chapter 9]

5. The proposed safeguard procedure would consist of the following steps. The receiving Office, when notifying the applicant of the international application number and the international filing date under Rule 20.5(c), would send to the International Bureau a copy of the notification sent to the applicant, unless the receiving Office has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1 (a). The said notification is to be made by using Form PCT/RO/105, which would be revised to indicate whether the record copy has been transmitted and whether a copy of the notification has been sent to the International Bureau. The thus revised form is reproduced on page 34, below. The notification under Rule 20.5(c) is required to contain only the indication of the international application number and the international filing date. The International Bureau, however, needs an indication also of the (earliest) filing date of any earlier application the priority of which is claimed in the international application to enable it to monitor the timely receipt of the record copy. That date is included on Form PCT/RO/105. Since the use of that Form, however, is not mandatory under Section 102 of the Administrative Instructions, it is proposed to add a new Section 30lbis to those Instructions which would provide for an indication of the said date-On the copy to be sent to the International Bureau under Rule 20.5(c). For the proposed text, see paragraph 15, below.

[Chapter 9]

Rule 20

Receipt of the International Application

20.1 to 20.4 [No change]

20.5 *Positive Determination*

(a) [No change]

(b) [No change]

(c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

20.6 to 20.9 [No change]

[Chapter 9]

6. Where the International Bureau receives a copy of the notification indicating that the record copy has not yet been transmitted, it would start monitoring the timely receipt of the record copy. The monitoring would consist of the following steps. If the International Bureau does not receive the record copy within 13 months from the priority date, it will remind the receiving Office to promptly transmit the record copy. If, notwithstanding the reminder, the International Bureau is still not in possession of the record copy by the expiration of 14 months from the priority date, it (the International Bureau) will notify the applicant and the receiving Office accordingly. The applicant thus alerted could then contact the receiving Office and make sure that the receiving Office sends the record copy to the International Bureau. He could also and this is expressly provided for in proposed new Rule 22.1(d), ask the receiving Office for a certified, copy of his international application and forward that copy himself to the International Bureau. The copy to be certified by the receiving Office would normally be a copy of the home copy, but it could also be a copy presented to the receiving Office, for certification, by the applicant. The certification would be free of charge and could be refused only on the ground that the copy to be certified is not identical with the international application as filed, that prescriptions concerning national security prevent the international application from being treated as such, or that the receiving Office has already transmitted and the International Bureau has received the record copy. The copy certified by the receiving Office would be considered to be the record copy unless or until the International Bureau receives the record copy.

7. It may be expected that the receiving Office, where it is contacted by the applicant or receives a request for a certified copy, would, itself, transmit the record copy to the International Bureau. The certification of the identity of a copy with the international application as filed would practically never have to be made since, where the receiving Office cannot find the record copy or where the record copy was sent to the International Bureau but got lost in the mail, the easiest solution would be for the receiving Office to prepare a new record copy on the basis of the home copy and to transmit such copy to the International Bureau.

8. In order to make the situation concerning the transmittal of the record copy even more reassuring to the applicant, it is also proposed that the time limit (by the expiration of which the international application is considered withdrawn under Article 12(3)) should start to run only from the date of the notification sent to the applicant under the proposed new Rule 22.1(c) namely, the notification that the International Bureau has not received the record copy by the expiration of 14 months from the priority date and that it be 3 months from the date of such notification. That time limit would leave ample time for the applicant to contact the receiving Office in order to find out what happened to the record copy and also where necessary for obtaining a certification from the receiving Office and forwarding the certified copy to the International Bureau. Since the time limit under Rule 22.3 would start to run only when the International Bureau sent the said notification to the applicant, the international application would never be considered withdrawn under Article 12(3) without a prior warning to the applicant by the International Bureau and a possibility to act. Where, in any given case, the International Bureau would fail to issue such an invitation, the time limit under Rule 22.3 would not start to run and, consequently, could not expire. In any case, however, the applicant would have to enter the national phase before the designated (or elected) Offices within the time limit applicable under Article 22 (or Article 39 (1)), failing which he would lose his rights under Article 24(1) (iii) (or Article 39(2)).

[Chapter 9]

9. When approving the proposed amendment to Rule 22.3, the Committee expressed an understanding that any designated Office may, if, by the expiration of the time limit applicable under Article 22 or Article 39(1), the International Bureau was not in possession of the record copy, consider the international application withdrawn unless evidence was produced that the international application in question had been filed with the receiving Office on the international filing date and that the necessary security clearance had been provided. The International Bureau has doubts about the compatibility of that understanding with Article 12(3), which provides that the international application is considered withdrawn if the record copy has not been received by the International Bureau within the prescribed time limit.

[Chapter 9]

Rule 22

Transmittal of the Record Copy

22.1 Procedure

(a) [No change]

(b) If the International Bureau has received a copy of the notification under Rule 20.5(c) but is not, by the expiration of 13 months from the priority date, in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly.

(c) If the International Bureau has received a copy of the notification under Rule 20.5(c) but is not, by the expiration of 14 months from the priority date, in possession of the record copy, it shall notify the applicant and the receiving Office accordingly.

(d) After the expiration of 14 months from the priority date, the applicant may request the receiving Office to certify a copy of his international application as being identical with the international application as filed and may transmit such certified copy to the International Bureau.

[Chapter 9]

The finding that the record copy has not been received within the prescribed time limit must be made by the International Bureau (see Article 25 (1) (a) and Rule 24. 2(b)). It is therefore proposed to adopt an amended understanding which could read as follows: “If, by the expiration of the time limit applicable under Article 22 or Article 39(1), the applicant has performed the acts referred to in these Articles but the designated or elected Office has not been informed by the International Bureau of the receipt of the record copy, it shall inform that Bureau, which shall proceed as provided for in the Treaty and the Regulations.”

10. The International Bureau would then proceed as follows: If it is in possession of the record copy, it would inform the national Office concerned accordingly. If it is not in possession of the record copy, it would contact the receiving Office and issue a notification under the proposed Rule 22.1(c). Should subsequently by the expiration of the time limit under Rule 22.3, the International Bureau not be in possession of the record copy and of the evidence that the international application had been filed with the receiving Office on the international filing date and that the necessary security clearance had been provided, then, but only then, it would make the finding under Article 12 (3), namely, that the international application is considered withdrawn.

11. It is to be noted that the possibility for the applicant to request, by the expiration of 14 months from the priority date, the receiving Office to certify a copy of the international application would exist irrespective of whether the applicant has been notified under Rule 22.1 (c) (notification of the fact that the International Bureau is not in possession of the record copy).

12. Furthermore, it should be noted that the proposed “safeguard” procedure would help in resolving any problem caused by an abnormally slow national security clearance. By the expiration of 14 months from the priority date, such clearance should normally have been obtained from or denied by the competent authorities. But where no decision concerning security clearance has been made by that time and the applicant asks for a certified copy of his international application, the applicant would have to be informed by the receiving Office that it is for the lack of such decision that his application cannot be treated as an international application and the requested certification cannot be given. Thus alerted, the applicant could urge a decision and if clearance and certification are obtained by the expiration of the time limit, under Rule 22.3, the international application would not lose its effect. It is to be noted also that in any case the applicant would have more time for obtaining national security clearance under the PCT than if he were to use the traditional Paris Convention route (with the 12-month time limit for filing abroad).

13. *Ad Rule 23.1(a)*. The amendment proposed in Rule 23.1(a) is consequential upon the deletion of the “wait and act” and “alternative” procedures. Similarly, Section 315 of the Administrative Instructions, which relates to the “alternative” procedure under Rule 22.2, would have to be deleted.

[Chapter 9]

14. *Ad Rules 22.4, 22.5 and 23.1(c)*. The Committee agreed to transfer Rules 22.4, 22.5 and 23.1(c) to the Administrative Instructions. It is proposed to include the text of Rule 22.5 in a new Section 322 and the text of Rules 22.4 and 23.1(c) in a new Section 420.

15. The various changes in the Administrative Instructions which are referred to in paragraphs 5, 13 and 14, above, would result in the following:

[Rule 22.1, continued]

[Chapter 9]

(e) Any certification under paragraph (d) shall be free of charge and may be refused only on any of the following grounds:

(i) the copy which the receiving Office has been requested to certify is not identical with the international application as filed;

(ii) prescriptions concerning national security prevent the international application from being treated as such;

(iii) the receiving Office has already transmitted the record copy to the International Bureau and that Bureau has informed the receiving Office that it has received the record copy.

(f) Unless the International Bureau has received the record copy, or until it receives the record copy, the copy certified under paragraph (e) and received by the International Bureau shall be considered to be the record copy.

22.2 Alternative Procedure

[Deleted]

22.3 Time Limit under Article 12(3)

The time limit referred to in Article 12(3) shall be 3 months from the date of the notification sent by the International Bureau to the applicant under Rule 22.1(c).

22.4 Statistics Concerning Non-Compliance with Rule 22.1 and 22.2

[Deleted]

22.5 Documents Filed with the International Application

[Deleted]

[Chapter 9]

Section 301bis

Copy of Notification under Rule 20.5(c)

The copy, sent to the International' Bureau, of the notification under Rule 20.5(c)" shall also include, if the priority of an earlier application is claimed in the international application, the date of filing as indicated in the international application of that earlier application. If the priority of several earlier applications is claimed, the earliest filing date shall be indicated.

Section 315

Notification of Non-Collection of Record Copy

[Deleted]

Section 322

Documents Filed with the International Application

Any power of attorney and any priority document filed with the international application referred to in Rule 3.3(a) (ii) shall accompany the record copy; any other document referred to in that Rule shall be sent only at the specific request of the International Bureau. If any document referred to in Rule 3.3(a) (ii) which is indicated in the check list as accompanying the international application is not, in fact, filed at the latest by the time the record copy leaves the receiving Office, that Office shall so note on the check list and the said indication shall be considered as if it had not been made.

[Chapter 9]

Rule 23

Transmittal of the Search Copy

23.1 *Procedure*

(a) The search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted -to the International Bureau.*

(b) [See Chapter 10 on page 19 of document PCT/A/XI/3]

(c) [Deleted]

* The amendment consists in deleting, at the end of the present text of this paragraph, the words “or, under Rule 22.2(d), to the applicants.”

[Chapter 9]

Section 420

Statistics Concerning Non-Compliance with
Rules 22.1(a) and 23.1(a)

(a) The number of instances in which, according to the knowledge of the International Bureau, any receiving Office has not complied with the requirements of Rule 22.1(a) shall be indicated, once a year, in the Gazette.

(b) The number of instances in which, according to the knowledge of the International Bureau, any receiving Office has not complied with the requirement of Rule 23.1(a) shall be indicated, once a year, in the Gazette.

16. It is also proposed to revise the Notes to the Form PCT/RO/105. The modified text of the Notes would, according to wishes expressed by the users, briefly describe the purpose of the notification. It would read as follows:

NOTES TO FORM PCT/RO/105

No action is required upon receipt of this Form.

It informs the applicant about the international filing date and the international application number accorded to the international application. It also indicates the earliest priority date claimed (if any). Time limits computed on the basis of the priority date are computed from this date or, if no priority is claimed, from the international filing date.

This Form indicates the date of transmittal of the record copy to the International Bureau where such transmittal has already taken place. Where such transmittal has not yet taken place, the reasons for this fact are to be given on the Form and the International Bureau receives a copy of it.

Where the International Bureau receives such copy, it monitors the timely receipt of the record copy. The International Bureau notifies the applicant if the record copy was received with Form PCT/IB/301. Should the record copy not have been received by the expiration of 14 months from the priority date, it will notify the applicant of that fact, who can then contact the receiving Office.

PATENT COOPERATION TREATY

TO

FROM

the RECEIVING OFFICE
identified at the bottom of this page

NOTIFICATION OF THE INTERNATIONAL
APPLICATION NUMBER AND OF THE
INTERNATIONAL FILING DATE
issued pursuant to PCT Rule 20.5(e)

Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT		DATE OF MAILING by the receiving Office
		APPLICANT'S OR AGENT'S FILE REFERENCE
IDENTIFICATION OF THE INTERNATIONAL APPLICATION		
International Application No.	International Filing Date	(Earliest) Priority Date Claimed
Applicant (Name)		
Title of Invention		
NOTIFICATION		
<p>The applicant is hereby notified that the above-identified international application has been accorded the international application number and the international filing date indicated.</p> <p>The record copy</p> <p><input type="checkbox"/> was transmitted to the International Bureau on ...</p> <p><input type="checkbox"/> has not yet been transmitted to the International Bureau</p> <p style="padding-left: 20px;"><input type="checkbox"/> because the necessary clearance for national security has not yet been obtained</p> <p style="padding-left: 20px;"><input type="checkbox"/> because (reason to be specified): ...</p> <p><input type="checkbox"/> A copy of this notification has been sent to the International Bureau (since the record copy has not yet been transmitted to the International Bureau)</p>		
THE RECEIVING OFFICE		
Name and Mailing Address		Authorized Officer

Chapter 12bis: Doing away with the obligation of the International Searching Authority to bring certain defects referred to in Article 14(1) (a) to the attention of the receiving Office

(Concerns Rule 28.1)

Revised proposal by the Delegation of Sweden

(see document PCT/CAL/II/7 and
document PCT/CAL/II/9, paragraph 99)

1. The Delegation of Sweden, after consultations with the European Patent Office, proposes to do away with the need for the International Searching Authority to bring to the attention of the receiving Office any possible finding made with respect to certain defects under Article 14(1) (a) (i), (ii) or (v), namely, that the international application is not signed as provided in the Regulations, does not contain the prescribed indications concerning the applicant, or does not comply to the extent provided in the Regulations with the prescribed physical requirements.
2. It is felt that the compliance with the requirements referred to in Rule 28.1(a) is sufficiently checked by the receiving Office and by the International Bureau. Past experience has shown that there are practically no cases where those defects were not noted by either the receiving Office or the International Bureau. Therefore, it is proposed to delete in Rule 28.1(a) the reference to the International Searching Authority. The deletion of that reference, however, would not mean that, should the International Searching Authority note any serious defect which had been overlooked it could not bring this defect to the attention of the receiving Office.
3. When the Committee considered the matter at its second session, it was agreed that the Guidelines for receiving Offices for the processing of international applications under the PCT should be revised in order to better clarify the formality examination standards, in particular, the requirements for reasonably uniform international publication referred to in Rule 26.3, so that the cases of application of Rule 28.1 would decrease in the future.

[Chapter 12bis]

Rule 28

Defects Noted by the International Bureau^{*}

28.1 *Note on Certain Defects*

(a) If, in the opinion of the International Bureau^{**}, the international application contains any of the defects referred to in Article 14 (1) (a) (i), (ii) or (v), the International Bureau^{***} shall bring such defects to the attention of the receiving Office.

(b) [No change]

* The amendment consists of deleting, after the word “Bureau,” the words “or the International Searching Authority.”

** The amendment consists of deleting, after the word “Bureau,” the words “or of the International Searching Authority.”

*** The amendment consists of deleting, after the word “Bureau,” the words “or the International Searching Authority, respectively.”

Chapter 13: Doing away with the notification and publication of certain events irrelevant under the circumstances

(Concerns Rules 29.2, 48.6 and 51.4)

Proposals approved by the Committee

(see documents PCT/CAL/II/2, pages 58 to 61 and 62 Rev.

(in document PCT/CAL/II/8), and PCT/CAL/II/9, paragraph 27)

1. *Ad Rules 29.2, 48.6(b) and 51.4.* The present text of Rule 29.2 provides for a notification of the International Bureau by the designated Office in two cases. The first case is where the effect of the international application provided for in Article 11 (3) ceased in the designated State concerned by virtue of Article 24(1) (iii), namely, because the applicant failed to perform the acts referred to in Article 22 (for entering the national phase') within the applicable time limit.
2. The second case is where the effect of the international application is maintained in the designated State concerned by virtue of Article 24(2), namely, where such effect is maintained (without being required to be maintained by virtue of Article 25(2)) in spite of the existence of one of the circumstances enumerated in items (i), (ii) and (iii) of Article 24(1).
3. Under the present Rule 51.4, each designated Office must notify the International Bureau where the effect of the international application is maintained in the designated State concerned after the review procedure provided for in Article 25.
4. Under the present Rule 48.6(b), the essence of any notification under Rule 29.2 and of any notification under Rule 51.4 is to be published in the Gazette and, if the notification reaches the International Bureau before the preparations for the publication of the pamphlet have been completed, also in the pamphlet.
5. Furthermore, Rule 86.1(iv) provides for the publication in the Gazette of information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned.
6. The combination of those Rules is not satisfactory for several reasons. First, no elected Office has the obligation to notify the International Bureau where the effect of the international application ceased in the elected State concerned by virtue of Article 39(2), namely, because the applicant failed to perform the acts referred to in Article 39(1) (for entering the national phase) within the applicable time limit. Secondly, it is difficult to imagine in which case a designated Office would maintain, under Article 24(2), the effect of the international application where the applicant has withdrawn his international application or the designation of the designated State concerned under Article 24(1) (i). Thirdly, no elected Office has the obligation to notify the International Bureau that the effect of the international application is maintained in the elected State concerned by virtue of Article 39(3) although the applicant failed to perform the acts referred to in Article 39(1) (for entering the national phase) within the applicable time limit. It is probably for these reasons that not all the designated Offices comply with their obligations under Rule 29.2. On the other hand, the

International Bureau has never proceeded with any publication under Rule 48.6(b) or Rule 86.1(iv), mainly because the required notifications under Rules 29.2 and 51.4 have not been received from all designated or elected Offices and, therefore, any such publications would be incomplete. Furthermore, such publications could not be complete as far as elected Offices are concerned.

[Chapter 13]

Rule 29

International Applications or Designations Considered
Withdrawn under Article 14 (1), (3) or (4)

29.1 [No change]

29.2 *Finding by Designated Office*

[Deleted]

29.3 and 29.4 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

(b) [See Chapter 3 on page 8, above]

(c) to (f) [No change]

(g) and (h) [See Chapter 20 on page 45 of document PCT/A/XI/3]

(i) [No change]

[Chapter 13]

7. Indeed, there is no real need for the publication of the cases referred to in Rules 29.2 and 51.4. With respect to the cases where the applicant failed to enter the national phase in any designated (or elected) State within the prescribed time limit or where the effect of the international application is maintained in a designated (or elected) State although the applicant failed to enter the national phase within the prescribed time limit, such publication would not give the public full and reliable information on the fate of the international applications since it would not cover withdrawals or refusals of protection occurring during the national phase. On the other hand, it may be interesting, from a statistical point of view, to know the percentage of international applications entering the national phase before a certain designated (or elected) Office and those not entering it. Furthermore, the publication of the cases where the effect of the international application is maintained in the designated State (either under Article 24(2) or under Article 25(2)) although the international application (or the designation of the State concerned) has been considered withdrawn, does not seem to make much sense since the international application itself (or the fact that a designation had been made in the request but was considered withdrawn) has not been published.

8. Consequently, it is proposed to delete Rule 48.6(b), thus deleting all the publications which, under that Rule and at the present time, should be (but, in fact, are not) made. It is furthermore proposed to delete Rule 29.2 since the notifications prescribed by that Rule do not serve any other purpose than to provide information for publication by the International Bureau, and such publication is proposed to be deleted.

9. On the other hand, it is proposed to maintain the principle of the notifications prescribed by Rule 51.4 since they provide important information to the International Bureau, but it is proposed to transfer the contents of Rule 51.4 to the Administrative Instructions and to add to those contents a recommendation to the designated Office to include in its notification the reasons for the decision under Article 25(2) (see the proposed new Section 112(b), below).

10. Moreover, it is proposed to introduce in the Administrative Instructions a new provision (Section 112 (a)) requiring the designated Offices to furnish once a year statistical information on the number of international applications entering or not entering the national phase. New Section 112(a) would also introduce a similar obligation for elected Offices, which presently are not required to make any notifications in this context to the International Bureau. The proposed new Section 112(a) would see to it that the International Bureau receive the information it needs in order to proceed with its publication under Rule 86.I(iv) which, since its present text already permits publication of statistical information, is not proposed to be amended.

11. The new Administrative Instruction does not impose any additional burden on the national Offices. On the contrary, it simplifies the procedure and replaces the notifications concerning the entry into the national phase by furnishing only annual statistical information. The International Bureau, which had been asked by the Committee to reconsider the proposal, has come to the conclusion that the furnishing of the said statistical information should be required. The alternative, which would consist of not furnishing any statistical data, should not be adopted since the public would then have no possibility for assessing how many international applications and designations have not been followed up in the national phase. Without that information, a meaningful inclusion of data on PCT applications in the WIPO

Industrial Property Statistics or any other statistical survey is not possible. The absence of this information will, with an increasing number of PCT applications, more and more affect the reliability of international patent statistics.

12. The text of the new Section 112, referred to in paragraphs 9, 10 and 11, above, could read as follows:

[Chapter 13]

48.3 *Languages*

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

(c) [See Chapter 21 on page 48 of document PCT/A/XI/3]

48.4 and 48.5 [No change]

48.6 *Announcing of Certain Facts*

(a) [No change]

(b) [Deleted]

(c) [See Chapter 14 on page 51, below]

[Chapter 13]

Section 112

Ceasing of Effect under Articles 24(1) (iii) and 39(2) and
Review by Designated Office under Article 25(2)

(a) Each national Office shall, once a year, notify the International Bureau of the number of international applications designating or electing it, in respect of which, during the preceding calendar year,

(i) the requirements provided for in Article 22 or in Article 39(1) have been complied with within the applicable time limit;

(ii) the requirements provided for in Article 22 or in Article 39(1) have not been complied with within the applicable time limit.

(b) Where, under Article 25(2), the competent designated Office decides that the refusal, declaration or finding referred to in Article 25(1) was not justified it shall promptly notify the International Bureau that it will treat the international application as if the error or omission referred to in Article 25(2) had not occurred. The notification shall preferably contain the reasons for the decision of the designated Office.

[Chapter 13]

Rule 51

Review by Designated Offices

51.1 to 51.3 [No change]

51.4 *Notification to the International Bureau*

[Deleted]

Chapter 14: Allowing the filing of withdrawal of the international application, of designations or of the priority claim in all cases with the receiving Office; specifying other procedural matters in connection with withdrawals

(Concerns Rules 32.1, 32bis.1, 48.6, 74bis.1, 75.2 and 75.3)

Proposals approved by the majority 01: the Committee

(see documents PCT/CAL/II/2, pages 64, 65 Rev. (in document PCT/CAL/II/8) and 66 to 71, and PCT/CAL/II/9, paragraph 28)

1. *Ad Rule 32.1 (c) and (e)*. The present text of Rule 32.1(c) provides that a notice of withdrawal of the international application must be filed with the International Bureau or, if the record copy has not yet been sent to the International Bureau, with the receiving Office. (Under Rule 32bis.1(d) the same rule applies mutatis mutandis to the withdrawal of the priority claim.) It is proposed to allow the filing of a notice of withdrawal with the receiving Office even where the record copy has already been sent to the International Bureau. Where the record copy or a copy of the notification under Rule 20.5(c) has already been sent to the International Bureau, the receiving Office should be obliged, if it receives a notice effecting withdrawal, promptly to transmit such notice to the International Bureau. It is not proposed to provide for such an obligation in the Regulations but to provide for such obligation for transmittal of a notice of withdrawal in the Administrative Instructions. The contemplated text of a new Section 321 appears in paragraph 9, below. As a consequence of the amendment making it possible to file a notice of withdrawal with the receiving Office, it is necessary to make it clear that, naturally, the provision of Article 21(5), under which there is no international publication if the international application is withdrawn before the technical preparations have been completed, will, also in the case where the notice of withdrawal has been filed with the receiving Office, apply only if that notice reaches the International Bureau before completion of the said technical preparations. It is proposed to clarify this point in a new paragraph (e) of Rule 32.1. That paragraph would also cover the case where a designation and not the whole international application is withdrawn.
2. When the Committee approved Chapter 14 at its second session, it was understood that it was possible for an applicant to withdraw his international application on the condition that it would not be published under Article 21.
3. *Ad Rule 32bis.1(c)*. The present text of this Rule provides that the International Bureau, in case of withdrawal of the priority claim, may proceed with the international publication if the withdrawal is effected during the period of 15 days preceding the expiration of the time limit of 18 months referred to in Article 21 (2) (a). The proposed amendment to Rule 32.1 (c) (see paragraph 1, above), which applies under Rule 32bis.1 (d) mutatis mutandis to the withdrawal of the priority claim, permits the filing of such withdrawals with the receiving Office even where the record copy has already been sent to the International Bureau. For such cases, it is necessary to clarify that the expression “if the withdrawal is effected” means “if the notice effecting withdrawal reaches the International Bureau,” and it is proposed to amend Rule 32bis.1(c) accordingly.

[Chapter 14]

4. *Ad Rules 32.1 (d), 32 bis.1 (d), 74bis.1, 75. 2 and 75.3.* Rule 32.1 (d) concerns the recording of the date of receipt of the notice effecting withdrawal and its notification by the International Bureau to the applicant and to other authorities. Rule 74bis.1 provides for the notification of the International Preliminary Examining Authority in case of withdrawal of the international application or of the designation of all Contracting States as well as, under Rule 32bis.1(d), of the priority claim in certain cases. Rules 75.2 and 75.3 provide for the notification of the elected Offices and of the International Preliminary Examining Authority in case of withdrawal of the demand or of elections. (It is to be noted that the International Preliminary Examining Authority is to be notified, under Rule 75.3, only if, at the time of withdrawal, it had been informed of the existence of the demand, although one does not see in which case the International Preliminary Examining Authority would not be so informed since any demand must, under Article 31 (6) (a), be submitted to it.)

[Chapter 14]

Rule 32

Withdrawal of the International Application
or of Designations

32.1 *Withdrawals*

(a) and (b) [No change]

(c) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau or* to the receiving Office. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

(d) [Deleted]

(e) There shall be no international publication of the international application or of the designation, as the case may be, if the notice effecting withdrawal reaches the International Bureau before the technical preparations for publication have been completed.

* The amendment consists of deleting, after the word “or,” the following words: “if the record copy has not yet been sent to the International Bureau.”

[Chapter 14]

5. It is proposed to delete Rules 32.1(d), 74bis.1, 75.2 and 75.3 and to transfer their contents in the Administrative Instructions as new Sections 413 and 415, the contemplated texts of which appear in paragraph 9, below. Those new Sections should also provide, in accordance with Article 37(3) (b) and the present practice that the International Preliminary Examining Authority is notified where not all the designations are withdrawn but only one or more designations of States which had already been elected under Chapter II of the PCT, or not all the elections are withdrawn but only one or more elections of elected States. In addition, a new Section 414 should cover the case where the international application, or the designation of any designated State which had already been elected, is considered withdrawn under Article 14 (1), (3) or (4). As a consequence of the deletion of Rules 32.1(d) and 74bis.1, it is necessary to amend Rule 32bis.1 (d) by deleting the existing references to those Rules.

6. *Ad Rule 48.6(c)*. The present text of Rule 48.6(c) requires the International Bureau to publish, in the Gazette, the fact that the international application has been withdrawn after its international publication, but it does not expressly limit this requirement to withdrawals occurring during the international phase. It is proposed to clarify this issue by making in Rule 48.6(c) a reference to Rule 32.1, which deals with the withdrawal of the international application or of designations and which limits, for the purposes of the international procedure, such withdrawals to those occurring, as a general rule, prior to the expiration of 20 months from the priority date. Thus, it would be clear that the International Bureau would publish the withdrawal of an international application only if it is a withdrawal under Rule 32.1. Any declaration of withdrawal received by the International Bureau after the expiration of the time limit referred to in Rule 32.1 is without legal effect and is consequently not published in the Gazette. Furthermore, it is proposed to make it clear that the withdrawal must be published in the Gazette even where it occurs during the period between the completion of the technical preparations for international publication and the actual international publication of the international application.

7. Furthermore, the present text of Rule 48.6(c) does not provide for the publication, in the Gazette, of the fact that, after the international publication of the international application, the designation of any designated State (and not the whole international application) is withdrawn. Such fact, however, is published, in practice, by the International Bureau. It is proposed to amend Rule 48.6(c) in order to bring its wording in harmony with the practice.

8. Finally, the present text of Rule 48.6(c) does not provide for the publication, in the Gazette, of the fact that, after completion of the technical preparations for international publication but before such publication, the priority claim is withdrawn. If the priority claim has been withdrawn before international publication but during the 15-day period referred to in Rule 32bis.1 (c), the international application is published in case the technical preparations for international publication have been completed by the time the International Bureau received the notice effecting the withdrawal, and such publication mentions a priority claim which has been withdrawn in the meantime. The fact of withdrawal is subsequently published, in practice, by the International Bureau. It is proposed to amend Rule 48.6(c) in this respect also, in order to bring its wording in harmony with the practice.

9. The texts of the new Sections 321, 413, 414 and 415 referred to in paragraphs 1 and 5, above, of the Administrative Instructions could read as follows:

[Chapter 14]

Rule 32bis

Withdrawal of the Priority Claim

32bis.1 *Withdrawals*

(a) and (b) [No change]

(c) Where the withdrawal of the priority claim, or, in the case of more than one such claim, the withdrawal of any of them, causes a change in the priority date of the international application, any time limit which is computed from the original priority date and which has not already expired shall be computed from the priority date resulting from that change. In the case of the time limit of 18 months referred to in Article 21(2) (a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice effecting withdrawal reaches the International Bureau during the period of 15 days preceding the expiration of that time limit.

(d) For any withdrawal under paragraph (a), the provisions of Rule 32.1(c)* shall apply mutatis mutandis.

* The amendment also consists of deleting, after the words “Rule 32.1(c),” the words “and (d) and Rule 74bis.1.”

[Chapter 14]

Section 321

Transmittal of Withdrawal under Rule 32.1 or Rule 32bis.1

Where the notice effecting withdrawal under Rule 32.1 or Rule 32bis.1 is filed with the receiving Office, that Office shall promptly transmit it to the International Bureau, unless neither the record copy nor a copy of the notification under Rule 20.5(c) have been transmitted to that Bureau.

Section 413

Notification of Withdrawal under Rule 32.1 or Rule 32bis.1

(a) Where the record copy has already been sent to the International Bureau, the fact of withdrawal of the international application, of designations or of the priority claim, together with the date on which the notice effecting withdrawal has reached the International Bureau, shall be recorded by that Bureau and promptly notified by it to the receiving Office, the applicant, the designated Offices affected by the withdrawal and, where the withdrawal concerns the international application or the priority claim and where the international search report or the declaration referred to in Article 17(2) (a) has not yet issued, the International Searching Authority.

(b) If, at the time of the withdrawal, under Rule 32.1, of the international application or of the designation of any designated State which had been elected, or of the withdrawal, under Rule 32bis.1, of the priority claim, a demand has already been submitted and the international preliminary examination report has not yet issued, the International Bureau shall promptly notify the fact of withdrawal, together with the date on which the notice effecting withdrawal has reached the International Preliminary Examining Authority.

[Chapter 14]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

(b) [See Chapter 3 on page 7, above]

(c) to (f) [No change]

(g) and (h) [See Chapter 20 on page 45 of document PCT/A/XI/3]

(i) [No change]

48.3 *Languages*

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

(c) [See Chapter 21 on page 48 of document PCT/A/XI/3]

48.4 and 48.5 [No change]

48.6 *Announcing of Certain Facts*

(a) [No change]

(b) [See Chapter 13 on page 42, above]

(c) If the international application or the designation of any designated State is withdrawn under Rule 32.1, or if the priority Claim is withdrawn under Rule 32bis.1, after the technical preparations for international publication have been completed, this fact shall be published in the Gazette.

[Chapter 14]

Section 414

International Application or Designation Considered
Withdrawn under Article 14 (1), (3) or (4)

If a demand has been submitted and the international application or the designation of a designated State which has been elected is considered withdrawn under Article 14(1), (3) or (4), the International Bureau shall promptly notify the International Preliminary Examining Authority, unless the international preliminary examination report has already issued.

Section 415

Notification of Withdrawal under Rule 75.1

The fact of withdrawal of the demand or of any election, together with the date on which the notice effecting withdrawal has reached the International Bureau, shall be promptly notified by that Bureau to each elected Office affected by the withdrawal, except where it has not yet been informed that it had been elected, and to the International Preliminary Examining Authority.

[Chapter 14]

Rule 74bis

Notification of Withdrawal under Rule 32

74bis.1 *Notification of the International Preliminary Examining Authority*

[Deleted]

Rule 75

Withdrawal of the Demand, or of Elections

75.1 [See Chapter 32-33 in a subsequent document]

75.2 *Notification of Elected Offices*

[Deleted]

75.3 *Notification of the International Preliminary Examining Authority*

[Deleted]

75.4 [No change]

Chapter 18: Doing away with the need for submitting amendments in two languages (the language of the international application as filed and the language of publication of the international application) and allowing to submit them in only one language (the language of publication) in cases in which the language of filing and the language of publication are different; doing away with the need for submitting a translation of the international application to the International Preliminary Examining Authority in certain cases; clarifying the concept of amendment before the International Preliminary Examining Authority

(Concerns Rules 12.2, 46.3, 55.1, 55.2, 66.2, 66.3, 66.8, 66.9, 70.11, 70.16, 70.17 and 92.2)

Proposals approved by the Committee (except as to Rule 5.1)
(see documents PCT/CAL/II/3, pages 10 to 12, 13 Rev. (in document PCT/CAL/II/8) and 14 to 19, and PCT/CAL/II/9, paragraph 37)

1. *Ad Rules 12.2, 46.3, 66.9 and 70.17(b)*. Under the present Rule 46.3, amendments to the international application must be made in the language of the international application; however, where the language in which the international application is published is different from the language in which it was filed, amendments must also be made in the language of publication. The languages of publication are, at present, English, French, German, Japanese and Russian. The languages in which international applications may be filed but which are not languages of publication are at present six: Danish, Dutch, Finnish, Icelandic, Norwegian and Swedish. International applications filed in one of these six languages are published in English translation (see present Rule 48.3(b)).
2. The fact that the applicant has to furnish, in the cases referred to above, amendments in two languages (one of the said six languages and English), has been regarded by some applicants as an unnecessary burden since the amendments in the language of the international application would, later on, practically never be used. Naturally, amendments in the language of the international application are useful where that language is the language of a designated Office. This is, however, rather rare, as international applications filed in one of the six languages frequently claim the priority of an earlier application filed in that language. The Office with which such earlier application was filed will usually not be a designated Office, and the designated Offices will usually require the use of their own language. (If the language of a designated Office should be the language of the international application; the applicant would need amendments in such language, but this would occur only in very rare cases and at the time of entering the national phase.) Therefore, a general requirement to file amendments in two languages, when the language of the international application and the language of its publication are different, seems, indeed, to be superfluous.
3. It is therefore proposed to amend Rule 46.3 in order to provide that, where the language of publication is different from the language of filing, amendments made under Article 19 must be made only in the language in which the international application is published.

[Chapter 18]

Rule 12

Language of the International Application

12.1 *Admitted Languages*

(a) and (b) [See Chapter 4 on page 16 of document PCT/A/XI/3]

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

12.2 *Language of Changes in the International Application*

Any changes in the international application, such as amendments and corrections, shall, subject to Rules 46.3 and 66.9, be in the same language as the said application.

Rule 46

Amendment of Claims before the International Bureau

46.1 and 46.2 [See Chapter 17 on page 35 of document PCT/A/XI/3]

46.3 *Language of Amendments*

If the international application has been filed in a language other than the language in which it is published, any amendment made under Article 19 shall be in the language of publication.

46.4 [See Chapter 19 on page 39 of document PCT/A/XI/3]

46.5 [See Chapter 11 on page 24 of document PCT/A/XI/3]

[Chapter 18]

4. For amendments made under Article 34 (2) (b), there is, at present, no express provision requiring, for the case that the language of publication is different from the language of filing, that such amendments must be filed in two languages. It follows only indirectly from Rule 70.17 (b) that the said amendments must be in the language of filing and in the language of publication since they are to be annexed in these two languages to the international preliminary examination report*. It is proposed to amend the Regulations by deleting Rule 70.17(b) and replacing it by a new Rule 66.9. The latter Rule would provide that, where the language of publication is different from the language of filing, amendments made under Article 34(2) (b) (as well as any letter communicating an amendment consisting of the cancellation of an entire sheet) must be submitted only in the language in which the international application is published. Rule 70.17(b) becomes then obsolete, since the language of the annexes to the international preliminary examination report follows from the general provisions determining in which languages the amendments have to be submitted. Furthermore, it appears more appropriate to deal with the questions of languages for amendments within the framework of Rule 66 concerning the procedure before the International Preliminary Examining Authority than under Rule 70, since the latter Rule contains basically only instructions for the International Preliminary Examining Authority concerning the international preliminary examination report and not provisions addressed (also) to the applicant concerning the procedure before the International Preliminary Examining Authority.

5. The amendment proposed for Rule 12.2 is consequential upon the amendments just proposed.

6. *Ad Rule 55.1.* Rule 55.1 prescribes the language in which the demand must be made. The prescribed language is at present the language of the international application or, when a translation is required under Rule 55.2, the language of that translation. In addition, the International Preliminary Examining Authority may permit the demand to be in any language specified in its agreement with the International Bureau.

7. It was suggested, and approved by the Committee subject to a more careful study of that suggestion, that Rule 55.1 should be amended by replacing the reference to the language of the translation of the international application under Rule 55.2 by a reference to the language of the international publication (Rule 48.3(b)). The International Bureau has studied the suggestion and agrees with it. It would harmonize the language of the demand with the language to be used during the proceedings under Chapter II before the International Preliminary Examining Authority, which is the language of publication (see paragraph 4, above). After having studied the matter, the International Bureau suggests to go even one step further in amending Rule 55.1 by deleting the proviso under that Rule which permits the filing of the demand in any language specified in its agreement with the International Preliminary Examining Authority. The deletion of the possibility to file the demand in a language which is not a language of publication would lead to greater uniformity of the languages which may be used during the international proceedings. Moreover, Rule 56.5 provides that later elections must be in the language of the demand. Later elections are to be submitted to the International

* The French text of Rule 70.17(b), however, already seems to allow amendments to be annexed to the report in the language of publication only.

Bureau and if they are not in the language in which the international application is published that Bureau might have problems in understanding the later election (under the present Rule, for example, the Icelandic or Finnish languages are permitted). If an applicant, should the proposed amendment be adopted, erroneously used a language in which international applications can be filed but in which they are not published, that applicant would not risk losing any rights since the use of the wrong language is a correctable defect which does not affect the filing date of the demand (see Rule 60.1(a) and (b)).

8. *Ad Rules 55.2 and 92.2.* Rule 55.2 provides that, if the competent International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the competent International Searching Authority and if the international application was filed in a language not accepted by the International Preliminary Examining Authority, the International Preliminary Examining Authority may require the applicant to submit, for the purposes of international preliminary examination, a translation of his international application. There has not been a single case so far where this Rule applied and there appears to be no case where this Rule would apply in the future. In all cases where the International Searching Authority and the International Preliminary Examining Authority may be different, the language of filing of the international application is a language accepted by the International Preliminary Examining Authority.

[Chapter 18]

Rule 55

Languages (International Preliminary Examination)

55.1 *The Demand*

The demand shall be in the language of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication.

55.2 *The International Application*

[Deleted]

Rule 66

Procedure before the International Preliminary
Examining Authority

66.1 [No change]

66.2 *First Written Opinion of the International Preliminary Examining Authority*

(a) and (b) [No change]

(c) The notification shall invite the applicant to submit a written reply together, where appropriate, with amendments*.

(d) [No change]

* The amendment consists of deleting, after the word “amendments,” the words “ or corrections.”

[Chapter 18]

9. It is therefore proposed to delete Rule 55.2: that Rule provides only for a theoretical case which, as can be seen after several years of operations under the PCT, has never arisen in practice and is not likely to arise in the future. As a consequence of the proposed deletion of Rule 55.2, paragraph (c) of Rule 92.2, which may apply only in cases where Rule 55.2 is applicable, should also be deleted. (The deletion of the reference to paragraph (c) of Rule 92.2 in its paragraph (a) is consequential to the deletion of Rule 92.2 (c), whereas the reference to Rule 66.9 is proposed to be added in Rule 92.2(a) as a consequence of the insertion of new Rule 66.9.)

10. *Ad Rules 66.2(c), 66.3(a), 66.8(a) and 70.11.* These Rules, as well as the present text of Rule 70.16(a) (and of Rule 66.4: see Chapter 25 in a subsequent document), deal with “amendments and corrections” made before the International Preliminary Examining Authority. Rule 66.5, however, defines an “amendment” as any change, other than the rectification of obvious errors of transcription, in the claims, the description or the drawings. Consequently, a “correction” could only be a change in a part of the international application other than the claims, the description or the drawings. It is doubtful, however, whether it is allowed to “correct” before the International Preliminary Examining Authority the request or the abstract, particularly in view of the wording of Article 34(2) (b), which gives the applicant the right to amend the claims, the description, and the drawings but not the request or the abstract before the establishment of the international preliminary examination report. It is even doubtful whether such possibility is desirable. It is therefore proposed to delete all references to “corrections” in Rules 66.2(c), 66.3(a), 66.8(a) and 70.11, as well as in Rule 70.16 (see the following paragraph) and in Rule 66.4 (see Chapter 25 in a subsequent document).

11. *Ad Rules 70.16 and 70.17(a).* The terminology used in the present English text of these Rules is not uniform: in some instances, the words “attachment” or “attached” are used (once in the title of Rule 70.16 and twice in the text of that Rule), whereas in other instances the words “annex,” “annexes” or “annexed” are used (twice in the text of Rule 70.16, once in the title of Rule 70.17 and once in the text of the latter Rule), although in all instances they speak of the same thing. The French text of the same Rules uses one and the same expression namely “annexe” and its derivatives in all these instances. From the many questions received by the International Bureau related to the interpretation of these two Rules, it appears to be appropriate to clarify the English text by using like in the French text only one expression. It is therefore proposed to use in the English text only the word “annex.” (The other amendments proposed to Rule 70.16 are either intended to clarify the contents of the annexes of the international preliminary examination report or are consequential to the proposals explained in the preceding paragraph and to the proposed deletion of Rule 66.8(b) (see Chapter 11 in document PCT/A/XI/3).

[Chapter 18]

66.3 *Formal Response to the International Preliminary Examining Authority*

(a) The applicant may respond to the invitation referred to in Rule 66. 2(c) of the International Preliminary Examining Authority by making amendments* or if he disagrees with the opinion of that Authority by submitting arguments, as the case may be, or do both.

(b) [No change]

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 on page 71, below]

66.8 *Form of** Amendments*

(a) The applicant shall be required, to submit a replacement sheet for every sheet of the international application which, on account of*** an amendment, differs from the sheet originally filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.

(b) [See Chapter 11 on page 26 of document PCT/A/XI/3]

* The amendment consists of deleting, after the word “amendments,” the words “or corrections.”

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

*** The amendments consists of replacing, after the word “of,” the words “a correction or” by the word “an.”

[Chapter 18]

66.9 *Language of Amendments*

If the international application has been filed in a language other than the language in which it is published, any amendment, as well as any letter referred to in Rule 66.8(a), shall be submitted in the language of publication.

Rule 70

The International Preliminary Examination Report

70.1 to 70.10 [No change]

70.11 *Mention of Amendments**

If, before the International Preliminary Examining Authority, amendments* have been made, this fact shall be indicated in the report.

70.12 to 70.15 [No change]

* The amendment consists of deleting, in the title, after the word “Amendments,” the words “or Correction of Certain Defects” and, in the Rule itself, after the word “amendments,” the words “or corrections.”

[Chapter 18]

70.16 *Annexes of the Report*

If the claims, the description, or the drawings, were amended* before the International Preliminary Examining Authority, each replacement sheet under Rule 66.8(a) shall be annexed to the report. Replacement sheets superseded by later replacement sheets and letters accompanying replacement sheets under the second sentence of Rule 66.8(a) shall not be annexed. If the amendment is communicated in a letter under the last sentence of Rule 66.8 (a), a copy of such letter shall** be annexed to the report.

70.17 *Languages of the Report and the Annexes*

(a) The report and any annex shall be in the language in which the international application to which they relate is published.

(b) [Deleted]

* The amendment also consists of deleting, after the word “amended”, the words “or any part of the international application was corrected.”

** The amendment also consists of deleting, after the word “shall,” the word “also.”

[Chapter 18]

Rule 92

Correspondence

92.1 [No change]

92.2 *Languages*

(a) Subject to Rule 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates.

(b) [No change]

(c) [Deleted]

(d) and (e) [No change]

92.3 and 92.4 [No change]

Chapter 24: Providing for a notification to the applicant by the International Preliminary Examining Authority, rather than the International Bureau, in case of attempted elections made in the demand

(Concerns Rule 60.3)

Proposal approved in substance by the Committee
(see documents PCT/CAL/II/3, pages 38 and 39, and
PCT/CAL/II/9, paragraph 44)

1. Present Rule 60.3 provides that, where the applicant has attempted to elect a State which is not a designated State or which is not bound by Chapter II, the International Bureau must notify the applicant that the attempted election is considered not to have been made. This provision applies irrespective of whether the attempted election was made in the demand (any other defect in a demand must be notified to the applicant by the International Preliminary Examining Authority; see present Rule 60.1 (a) and (d)) or in the Later election (any other defect in a later election must, be notified to the applicant by the International Bureau; see present Rule 60. 2(a)).

2. It is proposed to provide that, where the attempted election is in the demand, the International Preliminary Examining Authority rather than the International Bureau--must notify the applicant that such attempted election is considered not to have been made. This proposal is made because if it is the said Authority that has to make the notification, the applicant will receive it sooner than if it has to be made by the International Bureau (since the demand has to be first notified to the International Bureau; see Rule 61.1(a)).

3. It is furthermore proposed to transfer the contents of Rule 60.3 to the Administrative Instructions and consequently to delete that Rule. This proposal is made in order to harmonize the provisions applicable to “attempted designations” and to “attempted elections.” The Regulations do not contain any provisions applicable to the case of an attempted designation, although such case is much more frequent, in practice, than the case of an attempted election. Attempted designations, however, are dealt with in Section 201(b) of the Administrative Instructions, which provides, in essence, for the cancellation ex officio of any attempted designation. It is proposed to deal with attempted elections in the same way, mutatis mutandis, by adding a new paragraph (c) to Section 201. The text of such a modified Section 201 could read as follows:

Section 201

Names of States; Cancellation of Attempted
Designations and Elections

(a) and (b) [No change]

(c) The International Preliminary Examining Authority shall cancel ex officio the election of any State which is not a designated State or which is not bound by Chapter II if the attempted election is in the demand, and shall notify the applicant accordingly. The International Bureau shall, where the International Preliminary Examining Authority fails to do so or if the attempted election is in a later election, cancel ex officio such election and shall notify the applicant and the International Preliminary Examining Authority accordingly.

[Chapter 24]

Rule 60

Certain Defects in the Demand or Elections

60.1 and 60.2 [No change]

60.3 *Attempted Elections*

[Deleted]

[Chapter 24]

4. The Committee approved the substance of the proposed amendments but agreed that their contents should be included in the Regulations rather than in the Administrative Instructions since they involved notifications to applicants. Having studied the matter, the International Bureau maintains its proposal to deal with this matter in the Administrative Instructions. The present text of the Administrative Instructions contains in various Sections provisions for notifications to the applicant (e.g., Sections 309(b) (ii) and (c) (ii), 310(c) (ii) and (d) (i), 312, 315, 316, 317, etc.). Several proposals for transferring part of the Regulations to the Administrative Instructions contain also provisions for notifications to the applicant (e.g., Sections 314(c) and 402(b) in Chapter 1, Section 411(a) and (c) in Chapter 8, Section 413(a) in Chapter 14, Section 416 in Chapter 17, Section 419(b) in Chapter 31) and the Committee did not object to the proposed transfer to the Administrative Instructions.

Chapter 24bis: Transferring Rule 62.1 to Administrative Instructions

(Concerns Rule 62.1)
(see document PCT/CAL/II/8, pages 1 and 2)

1. Rule 62.1 deals with the copy of the international application which is to be used by the International Preliminary Examining Authority. It is proposed to delete this Rule and to transfer its contents to the Administrative Instructions as new Sections 420 and 605, the texts of which could read as follows:

Section 420

Copy for the International Preliminary Examining Authority

Where the competent International Searching Authority is not part of the same national Office or intergovernmental organization as the competent International Preliminary Examining Authority, the International Bureau shall, promptly upon receipt of the international search report or, if the demand was received after the international search report, promptly upon receipt of the demand, send a copy of the international application and the international search report to the said Preliminary Examining Authority. In cases where, instead of the international search report, a declaration under Article 17 (2) (a) has issued references in the preceding sentence to the international search report shall be considered references to the said declaration.

Section 605

File To Be Used for International Preliminary Examination

Where the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the same file shall serve the purposes of international search and international preliminary examination.

[Chapter 24bis]

Rule 62

Copy for the International Preliminary Examining Authority

62.1 *The International Application*

[Deleted]

62.2 [No change]

Chapter 26: Simplifying the procedure where the International Preliminary
Examining Authority needs the priority document “but the International
Bureau has not received it under Rule 17.1

(Concerns Rule 66.7)

Proposal approved by the majority of the Committee
(see documents PCT/CAL/II/3, pages 44 to 47, and
PCT/CAL/II/9, paragraph 47)

1. Under the present text of Rule 66.7(a), where the International Preliminary Examining Authority requests the International Bureau to furnish to it a copy of the priority document, and where the International Bureau has not yet received the priority document under Rule 17.1(a), the applicant must furnish a copy of the application whose priority is claimed in the international application.
2. It is proposed to amend Rule 66.7(a) by making reference to Rule 17.1 (rather to Rule 17.1(a)), which will make Rule 66.7(a) applicable also to Rule 17.1(b), namely, to the case where the receiving Office is requested by the applicant to transmit the priority document to the International Bureau.
3. At the same time, it is proposed to more closely link the procedure under Rule 66.7 to the procedure under Rule 17.1. Presently, those two procedures are separated in the (rare) case where the International Bureau has not received the priority document under Rule 17.1 before it is requested by the International Preliminary Examining Authority to furnish a copy thereof to it. In such a case, the applicant must, under the present Rule 66.7(a), furnish a copy of the earlier application to the International Bureau and directly to the International Preliminary Examining Authority. If the applicant failed to comply with the requirements of Rule 17.1 within the applicable time limit which is normally 16 months after the priority date the priority claim may be disregarded by the elected Offices under Rule 17.1(c) even if the applicant timely furnishes, under Rule 66.7(a), the requested copies to the International Bureau and to the International Preliminary Examining Authority. The result is that the International Preliminary Examining Authority will take the priority claim into account although such claim may be disregarded by the elected Offices. Such discrepancy is undesirable. Furthermore, present Rule 66.7(a) does not require the copy of the earlier application which the applicant has to furnish to the International Preliminary Examining Authority to be a certified copy. Some doubts may thus be created as to whether the copy received by the International Preliminary Examining Authority is a true copy or not.
4. In order to avoid the inconveniences of the present system, it is proposed to provide for a system whereby the copy of the earlier application which is furnished to the International Preliminary Examining Authority under Rule 66.7 is always a copy of the priority document furnished to the International Bureau under Rule 17.1. If the request of the International Preliminary Examining Authority for such a copy is made before the expiration of the 16-month time limit of Rule 17.1 which should be exceptional and the priority document has not yet been received by the International Bureau, that Bureau would remind the applicant of his obligations under Rule 17.1 and warn him at the same time that any delay in complying with those requirements may affect the result of the preliminary examination since it would allow the examination report to be established without taking into account the priority claim. It will thus be in the interest of the applicant to react to the reminder of the International Bureau. If,

on the other hand, the 16-month time limit has expired and the applicant has not complied with the requirements of Rule 17.1 at the time when the International Preliminary Examining Authority requests a copy of the earlier application, it is better to allow the examination report to be established without recourse to such a copy and, consequently, without taking into account the priority claim since, in such a situation, the priority claim may be disregarded by the elected Offices. It is to be noted that, in such a case, the international preliminary examination report will indicate, as it already does at present, that it has been established as if no priority had been claimed (see Form PCT/IPEA/409).

[Chapter 26]

Rule 66

Procedure before the International Preliminary
Examining Authority

66.1 [No change]

66.2 [See Chapter 18 on page 58, above]

66.3 [See Chapter 18 on page 60, above]

66.4 [See Chapter 25 in a subsequent document]

66.5 [See Chapter 30 in a subsequent document]

66.6 [No change]

66.7 *Priority Document*

(a) If the International Preliminary Examining Authority needs a copy of the application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1, the international preliminary examination report may be established as if the priority had not been claimed.

[Chapter 26]

5. Furthermore, it is proposed to deal with the procedure envisaged in the preceding paragraph in a new Section 417 of the Administrative Instructions rather than in Rule 66.7, while maintaining in that Rule but in its paragraph (a) rather than paragraph (c) the principle that the international preliminary examination report may be established as if the priority had not been claimed if the applicant failed to meet the prescribed time limit. This time limit, however, would be as outlined in paragraph 4, above the time limit under Rule 17.1. It is also proposed to transfer the remainder of present paragraph (c) of Rule 66.7 to paragraph (b) of that Rule, so that paragraph (c) could be deleted. It is to be noted that, in those two cases, it is proposed not to oblige the International Preliminary Examining Authority as under the present text but to allow it to disregard the priority claim, in order to give more flexibility to the system. (Similarly, the designated States are allowed but not obliged, under Rule 17.1(c), to disregard the priority claim if the applicant failed to comply with the requirements of Rule 17.1). The text of the new Section 417 of the Administrative Instructions could read as follows:

Section 417

Invitation to Furnish a Copy of the Priority Document

Where a request for a copy of the application whose priority is claimed in the international application is made under Rule 66.7(a) by the International Preliminary Examining Authority before the International Bureau has received the priority document under Rule 17.1, the International Bureau shall, unless the applicable time limit referred to in Rule 17.1(a) has already expired, inform the applicant of such request and remind him of the requirements of Rule 17.1.

[Chapter 26]

[Rule 66.7, continued]

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may invite the applicant to furnish a translation in the said language or one of the said languages within 2 months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

(c) [Deleted]

66.8 *Form of Amendments*

(a) [See Chapter 18 on page 60, above]

(b) [See Chapter 11 on page 26 of document PCT/A/XI/3]

66.9 [See Chapter 18 on page 61, above]

Chapter 27: Making uniform for all receiving Offices the
manner of computing time limits

(Concerns Rule 80.6)

Proposal approved by the Committee

(see documents PCT/CAL/II/3, pages 48 and 49, and
PCT/CAL/II/9, paragraph 48)

1. The Assembly of the PCT Union amended, during its fifth session, held in Geneva from June 9 to 16, 1980, the text of Rule 80.6 by adding a second sentence to the text and by adding a second paragraph (paragraph (b)) allowing the exclusion, by any receiving Office that so wishes, of the application of the said second sentence. The national Offices (in their capacity as receiving Offices) of Australia, Denmark, Finland, Japan, Norway and Sweden have notified the International Bureau under this Rule that they exclude the application of the said second sentence. The receiving Office of Australia has withdrawn subsequently its notification.
2. The possibility of excluding the application of the second sentence of Rule 80.6(a) was introduced to allow an early entry into force of the amended Rule for those receiving Offices whose national laws or regulations did not have to be modified in order to comply with the said second sentence or could be modified before the said entry into force. It was, however, the understanding of the Assembly that the exclusion of the application of that second sentence would be a temporary measure and that, after a reasonable period left for amending the national laws or regulations, all Contracting States would apply the second sentence.
3. More than three years have expired since the adoption of the said second sentence and there will be additional time until the amendment now proposed, if adopted, enters into force. Thus, there was and will be ample time to adopt amendments to the national laws and regulations in the five countries in question. In fact, the Committee was informed by the Delegations of Denmark, Finland, Norway and Sweden that they expected to be able to withdraw their notifications under this Rule before the entry into force of the proposed amendment, and the receiving Office of Japan expects to be also in a position to withdraw its notification before that date. It is therefore proposed to delete Rule 80.6(b).

[Chapter 27]

Rule 80

Computation of Time Limits

80.1 to 80.5 [No change]

80.6 *Date of Documents*

(a) [No change]

(b) [Deleted]

80.7 [No change]

Chapter 31: Fixing a time limit for the possibility of asking for the
recording of certain changes in the request or the demand

(Concerns Rules 92bis.1 and 92bis.2)

Revised proposal*

(see documents PCT/CAL/II/3, pages 66 to 70, and
PCT/CAL/II/9, paragraph 75)

1. *Ad Rule 92bis.1.* Under Rule 92bis.1, certain indications made in the request part of the international application or in the demand may be changed on the request of the applicant or the receiving Office, and the International Bureau must record the change.
2. However, the said Rule does not provide for a time limit after the expiration of which the recording of changes may no longer be requested. It makes no sense to allow recordings of such changes by the International Bureau once the time limit for delaying national procedure has expired since, from the expiration of that time limit, the international application is entirely under the control of the national Offices.
3. Consequently, it is proposed that a new paragraph (paragraph (b)) in Rule 92bis.1 provide that the International Bureau would not record the said changes if the request for changes is received by it after the expiration of a certain time limit. If Article 39(1) is applicable with respect to at least one Contracting State (that is, if there is at least one elected State), that time limit would be the time limit referred to in Article 39(1) (a), that is, 2.5 months (or, if the proposal contained in Chapter 32-33 (see a subsequent document) is accepted, 30 months) from the priority date. If Article 39(1) is not applicable with respect to any Contracting State, the time limit in question would be the time limit referred to in Article 22(1), that is, 20 months from the priority date. If the requested change is not recorded due to the expiration of the applicable time limit, the International Bureau would notify the applicant and, if the change was requested by the receiving Office, that Office accordingly (see paragraph (c) of the proposed new Section 419 of the Administrative Instructions). The notification sent in such a case to the applicant could explain that the request to record the change should be sent by the applicant to each designated or elected Office.
4. *Ad Rule 92bis.2.* Three changes are proposed to be made in connection with Rule 92bis.2. First, it is proposed' to transfer the contents of that Rule, which deals with the notification of changes recorded under Rule 92bis.1, to the Administrative Instructions.

* The revision consists of the proposed transfer to Section 419 of the Administrative Instructions, as paragraph (c) thereof, of what was proposed as Rule 92bis.1(c) in document PCT/CAL/II/3.

5. Second, if the change recorded concerns an indication relating to the inventor, it is proposed to limit the requirement to notify the designated and elected Offices (see items (iii) and (v) of present Rule 92bis. 2(a)) to those cases where the technical preparations for the international publication of the international application have already been completed. Before the international application is communicated under Article 20, those Offices do not know who the inventor is, since the various notifications they have received before that time do not contain any indications concerning the inventor. Since the international application is communicated under Article 20 in the form of the pamphlet containing the published international application, it is proposed to refer to the completion of the technical preparations for international publication as the decisive time before which the designated and elected Offices do not need to be notified of a change affecting the inventor. If, however, for a certain designated or elected Office, an inventor is at the same time an applicant, that Office will be notified in all cases, because in such a case the change recorded also concerns an indication relating to the applicant.

[Chapter 31]

Rule 92bis

Recording of Changes in Certain Indications in the Request
or the Demand

92bis.1 *Recording of Changes by the International Bureau*

(a) The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:

- (i) person, name, residence, nationality or address of the applicant,
- (ii) person, name or address of the agent, the common representative or the inventor.

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration:

- (i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;
- (ii) of the time limit referred to in Article 39(1) (a), where Article 39(1) is applicable with respect to at least-one Contracting State.

92bis.2 *Notifications*

[Deleted]

[Chapter 31]

6. Third, it is proposed to add a sentence to the text which presently constitutes Rule 92bis.2 (b), to the effect that- in the case of change in the person of the applicant, a copy of the related notification must be sent to both the earlier applicant and the new applicant. If, however, the earlier applicant and the new applicant are both represented by the same agent, which is frequently the case, then, in practice, only one single copy will be sent to the said agent.

7. The text of a new Section 419 of the Administrative Instructions could read as follows:

Section 419

Notifications under Rule 92bis.1

(a) The International Bureau shall give notifications concerning changes recorded by it under Rule 92bis.1(a):

(i) to the receiving Office where the change has been recorded on the request of the applicant;

(ii) as long as the international search report or the declaration referred to in Article 17(2) has not yet issued, to the International Searching Authority;

(iii) until the expiration of the time limit referred to in Article 22(1), to the designated Offices; where the change concerns an indication relating to the person, name or address of the inventor, the designated Offices shall be notified only if the change has been recorded after the technical preparations for the international publication of the international application have been completed;

(iv) as long as the international preliminary examination report has not yet issued, to the International Preliminary Examining Authority;

(v) until the expiration of the time limit referred to in Article 39(1) (a), to the elected Offices; where the change concerns an indication relating to the person, name or address of the inventor, the elected Offices shall be notified only if the change has been recorded after the technical preparations for the international publication of the international application have been completed.

[Chapter 31]

[Section 419, continued]

(b) A copy of each notification sent under paragraph (a) shall be sent to the applicant by the International Bureau. If the change consists of a change in the person of the applicant, the said copy shall be sent to the earlier applicant and the new applicant.

(c) Where Rule 92bis.1(b) applies, the International Bureau shall notify the applicant accordingly and, if the change was requested by the receiving Office, that Office.

[End of document]