

WIPO



PCT/A/XI/5

ORIGINAL: English

DATE: November 15, 1983

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Eleventh Session (7th Extraordinary)*
Geneva, January 30 to February 3, 1984

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 third 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

TABLE OF CONTENTS OF THIS DOCUMENT

<u>Chapter</u>	<u>Objective</u>	<u>Provisions to be amended</u>	<u>Page</u>
1.	[See document PCT/A/XI/3]		
2.	[See document PCT/A/XI/3]		
3.	[See document PCT/A/XI/4]		
4.	[See document PCT/A/XI/3]		
5.	[See document PCT/A/XI/3]		
6.	Clarifying the due date of payment of certain fees	Rule 15.4	5
7.	[See document PCT/A/XI/4]		
8.	[See document PCT/A/XI/4]		
9.	[See document PCT/A/XI/4]		
10.	[See document PCT/A/XI/3]		
11.	[See document PCT/A/XI/3]		
12.	[See document PCT/A/XI/3]		
12bis.	[See document PCT/A/XI/4]		
13.	[See document PCT/A/XI/4]		
14.	[See document PCT/A/XI/4]		
15.	Including certain patent documents published in the Spanish language into the PCT minimum documenting; including the Spanish language among the languages of international publication of international applications	Rules 12.1, 34.1 and 48.3	9
16.	[See document PCT/A/XI/3]		
17.	[See document PCT/A/XI/3]		
18.	[See document PCT/A/XI/4]		
19.	[See document PCT/A/XI/3]		
20.	[See document PCT/A/XI/3]		

<u>Chapter</u>	<u>Objective</u>	<u>Provisions to be amended</u>	<u>Page</u>
21.	[See document PCT/A/XI/3]		
22.	[See document PCT/A/XI/3]		
23.	[See document PCT/A/XI/3]		
24.	[See document PCT/A/XI/4]		
24bis.	[See document PCT/A/XI/4]		
25.	Making it possible for the applicant to present additional arguments to the International Preliminary Examining Authority even where he submits no amendments; making longer the time limit for establishing the international preliminary examining report	Rules 66.4 and 69.1	15
26.	[See document PCT/A/XI/4]		
27.	[See document PCT/A/XI/4]		
27bis.	[See document PCT/A/XI/3]		
28.	[See document PCT/A/XI/3]		
29.	[See document PCT/A/XI/3]		
30.	Making more liberal the rules concerning the rectification of obvious errors in the international application and other document of the applicant	Rules 4.10, 48.2 66.5, 91.1 and 91.2, Sections 109, 320, 401bis, 405, 501bis and 602bis; Annex D of the Administrative Instructions	20
31.	[See document PCT/A/XI/4]		
32-33.	Making uniform, and in some cases longer, the time limits for entering the national phase in designated or elected States	Articles 22(2) and 39(1); Rule 75.1; Section 422	35
34.	Making it unnecessary for the applicant to transmit Copies of his international application to the designated Offices	Rule 49.1	45

<u>Chapter</u>	<u>Objective</u>	<u>Provisions to be amended</u>	<u>Page</u>
35.	Specifying the requirements for entering the national phase, in particular, the contents of the translation of the international application	Rules 11.15 49.3 to 49.5, 76.1 to 76.3 76.5	47
36.	Making it clear that certain requirement to be complied with during the national phase must be complied with by the applicant only after entering with the national phase	Rules 51bis.1 and 51bis.2	57
37.	Improving the wording of Rule 74.1 and simplifying the time limit for the transmittal of the translation of any annexes to the international preliminary examination report	Rule 74.1	65
38.	Making it clear in which cases Contracting States Excuse delays in meeting time limits or rectify an Error made by an international authority	Rules 82bis.1, 82bis.2 and 82ter.1	68

EXPLANATIONS OF THE PROPOSED AMENDMENTS

Chapter 6: Clarifying the due date of payment of certain fees

(Concerns Rule 15.4)

Revised proposals partly approved by the Committee
(see documents PCT/CAL/II/2, pages 22 to 25, and
PCT/CAL/II/9, paragraph 15)

1. *Ad Rule 15.4(a) and (b).* From questions raised by applicants, it appears that the present text of Rule 15.4 is not always readily understood, in particular as far as the time of payment of the designation fee is concerned. This is probably due to the fact that Rule 15.4 deals, in its present wording, with the time of payment of the basic fee and with the time of payment of the designation fee and that, although the regimes applicable to those two fees are different, they are not clearly separated from each other (see paragraph (c) of the present Rule 15.4). For the sake of clarity, it is proposed to redraft the present contents of Rule 15.4 so that paragraph (a) would deal with the time of payment of the basic fee and paragraph (b) would deal with the time of payment of the designated fee.
2. At the same time, substantive changes are proposed too, changes which would make the time limit for the payment of the basic fee and the designation fee the same for all receiving Offices. Under the present Rule 15.4 (a) and (c), the basic fee is due on the date of receipt of the international application by the receiving Office (hereinafter referred to as “the date of receipt of the application”), except in respect of a receiving Office that authorizes later payment, the outside limit of such later payment being an additional month; the proposed change would consist in fixing the time limit, for all receiving Offices, at the expiration of one month from the date of receipt of the application. Under the present Rule 15.4(b) and (c), the designation fee is, in effect, due (i) where the international application does not contain a priority claim, within one year from the date of receipt of the application and (ii) where the international application contains a priority claim, within one year of the priority date except where, and in respect of, a receiving Office that authorizes later payment, the outside limit of such later payment being an additional month; the proposed change would consist in maintaining, for case (i), the present rule but, for case (ii), in fixing the time limit for all receiving Offices at the expiration of one month after the date of receipt of the application if that month expires after the expiration of the (12-month) priority period.
3. *Ad Rule 15.4(c).* The present Regulations do not contain special provisions for the case where, after the date on which the international application is received by the receiving Office but before the basic fee or the designation fee is paid, the amount of the basic fee or the designation fee is increased (be it an increase in the amount as set out in Swiss francs in the Schedule of Fees or be it an increase in the amount of the fee expressed in another currency (so-called “corresponding amount”). It is proposed to amend Rule 15.4 by providing in paragraph (c) whose contents would be completely different from its present contents a solution for the said situation. It is proposed to make a differentiation depending on whether the increased amount becomes applicable during the month which follows the date of receipt of the application or becomes applicable after that month. The proposed solution is that, in the first case, applicants should be allowed to pay the lower amount, that is, the amount applicable on the date of receipt of the application (see proposed Rule 15.4(c) (i)). In the second case, which in fact can only apply to the designation fee since the basic fee cannot be paid later than one month after the date of receipt of the application, applicants would have to

pay the higher amount (see proposed Rule 15.4(c)(ii)). It follows from the proposed new wording of Rule 15.4(c) that, if the amount of the basic fee or the designation fee decreases, the lower amount would be applicable for any payment made on or after the date on which the change becomes effective.

4. It is to be noted that through the reference in Rule 16.1(f) to Rule 15.4 the provisions of the proposed Rules 15.4(a) and (c) would also apply to the time of payment of the search fee.

[Chapter 6]

TEST OF THE PROPOSED AMENDMENTS

Rule 15

The International Fee

15.1 to 15.3 [No change]

15.4 *Time of Payment*

(a) The basic fee shall be paid within one month from the date of receipt of the international application.

(b) The designation fee shall be paid:

(i) where the international application does not contain a priority claim under Article 8, within one year from the date of receipt of the international application,

(ii) where the international application contains a priority claim under Article 8, within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date.

(c) Where the basic fee or the designation fee is paid later than the date on which the international application was received and where the amount of that fee is, in the currency in which it is payable, higher on the date of payment (“the higher amount”) than it was on the date on which the international application was received (“the lower amount”),

(i) the lower amount shall be due if the fee is paid within one month from the date of receipt of the international application,

(ii) the higher amount shall be due if the fee is paid later than one month from the date of receipt of the international application.

15.5 [No change: remains deleted]

15.6 [No change]

[Chapter 6]

5. The draft approved by the Committee also dealt with the handling fee and the supplement to the handling fee and provided, in essence, for the principle that where the amount of those fees changes between the date of making the demand or the later election and the date of paying those fees, the amount payable is the changed amount, that is, the amount in force on the date of payment (see document PCT/CAL/II/2, pages 22 to 25, and PCT/CAL/II/9, paragraph 15, as far as proposed Rule 57.3(e) is concerned). After reconsidering the matter, the International Bureau is of the opinion that it is not necessary to express such principle in the Regulations. It would be sufficient to record the agreement of the Assembly on that principle. For applicants, there is no risk of any kind if they did not pay the amount which they had to pay: under Rule 57.4(a) or Rule 57.5(a), they receive an invitation to pay the missing amount without having to pay any surcharge, and the invitation specifies the exact amount still to be paid. Moreover, since the handling fee is due at the time the demand is submitted and the supplement to the handling fee is due at the time the later election is submitted (see Rule 57.3(a) and (b)) as opposed to the basic fee and the designation fee, which may be paid after the act for which they are due (i.e., the filing of the international application) has been performed, the cases where the amount of the handling fee and the supplement to the handling fee would change between the due date and the time of actual payment would be extremely rare and would thus not warrant a special provision in the Regulations. Consequently, what in the texts before the Committee was draft paragraph (e) of Rule 57.3 is no longer proposed.

Chapter 15: Including certain patent documents published in the Spanish language into the PCT minimum documentation; including the Spanish language among the languages of international publication of international applications

(Concerns Rules 12.1, 34.1 and 48.3)

Revised proposals

(see documents PCT/CAL/II/2, pages 72 to 77 and Annex, and PCT/CAL/II/9, paragraphs 29 to 34)

1. *Spanish language.* The Assembly of the PCT Union, during its seventh session held in Geneva from June 29 to July 3, 1981, noted an intervention by the Delegation of Spain concerning the bearing of the use of the Spanish language upon its possible accession to the PCT. The Chairman of the Assembly, noting the urgency and importance of that matter in view of its bearing on the participation of Spain and the Latin American countries of Spanish language, said that the question of the use of Spanish language in the PCT system should be pursued with priority (see document PCT/A/VII/15, paragraph 67).
2. It is now proposed to amend Rules 34.1 (Minimum Documentation) and 48.3 (Languages [of the international publication of international applications]) by adding the Spanish language to the languages referred to in those Rules.
3. It is proposed that patent documents in the Spanish language should be part of the PCT minimum documentation under the combined conditions laid down now in Rule 34.1(c) (vi) for patent documents in English, French and German of countries other than those referred to in Rule 34.1(c) (i) and (ii) and in Rule 34.1(e) for patent documents in the Japanese and Russian languages, namely: first, if no priority is claimed in them and if the national Office of the interested country sorts out those documents and places them at the disposal of each International Searching Authority, the said documents would be included; second, if any International Searching Authority whose official language is not Spanish wishes to do so, it would be entitled not to include those among the said patent documents for which no abstracts in the English language are generally available. As recommended by the Committee during its first session, the technical questions raised by the proposed amendments to Rules 34.1(c) (vi) and 34.1(e) were submitted to the PCT Committee for Technical Cooperation/ excerpts from the relevant documents are contained in the annex to this document.
4. It is proposed that, as to the question in which languages an international application must be published by the International Bureau, the Spanish language should have the same status as have, under the present Rules, the English, French, German, Japanese and Russian languages: if the international application was filed in Spanish, it would have to be published in Spanish and not in an English translation. These proposals are reflected in the suggested amendments to paragraph (a), and the first sentence of paragraph (b), of Rule 48.3. (It is to be noted that paragraph (c) of Rule 48.3 would not be amended in this respect and that Rule 86.2(a) would remain unchanged which would mean the following: if the international application is published in Spanish, the abstract would be published in the pamphlet containing the international application in both Spanish and English; the abstract would be published in the Gazette entry concerning such application in English and French; the English and French translations of the abstract would be prepared by the International Bureau.) At the same time; it is proposed to change, for the sake of clarity, the wording of the second sentence of paragraph (b) of Rule 48.3; that amendment, however, is of a purely drafting nature and does not involve any change of substance.

[Chapter 15]

Rule 12

Language of the International Application

12.1 *Admitted Languages*

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

(c) Subject to paragraph (d), where the official language of the receiving Office is one of the languages referred to in Rule 48.3(a) but is a language not specified in the agreement referred to in paragraph (a), the international application may be filed in the said official language. If the international application is filed in the said official language, the search copy transmitted to the International Searching Authority under Rule 23.1 shall be accompanied by a translation into the language, or one of the languages, specified in the agreement referred to in paragraph (a); such translation shall be prepared under the responsibility of the receiving Office.

(d) Paragraph (c) shall apply only where the International Searching Authority has declared, in a notification addressed to the International Bureau that it accepts to search international applications on the basis of the translation referred to in paragraph (c).

12.2 [See Chapter 18 on page 55 of document PCT/A/XI/4]

[Chapter 15]

5. The Committee considered the proposals and no opposition was raised against them but a reservation of the countries of the European Patent Organisation was noted in view of a pending decision of the Administrative Council of that Organisation. The said Council, at its 16th session, held from June 7 to 10, 1983, in Munich, “expressed its support for the amendments to the Regulations under the PCT proposed by the International Bureau of WIPO with a view to facilitating the use of Spanish as a language of the Patent Cooperation Treaty; it also agreed that the [European Patent] Office act as an International Searching Authority for international applications filed in Spanish, on condition that a translation be produced in one of the EPO official languages before the application reaches the [European Patent] Office” (see Official Journal of the European Patent Office, No. 7/1983, page 258).

6. In order to accommodate the condition fixed by the Administrative Council of the European Patent Organisation in connection with its decision related to the acting of the European Patent Office as International Searching Authority for international applications filed in the Spanish language (see paragraph 5, above), the European Patent Office made a proposal to amend Rule 12.1 which would provide for the following: Whenever the receiving Office has an official language (e.g., Spanish) which is a language in which international applications are published under Rule 48.3 (a) (which would include Spanish if the amendment proposed to Rule 48.3 is adopted, see paragraph 4, above) but which is not specified in the agreement concluded between the International Bureau and the competent International Searching Authority, the international application may be filed in that official language. However, in order to permit the International Searching Authority to search such applications, the search copy transmitted by the receiving Office to that Authority must be accompanied by a translation, prepared under the responsibility of the receiving Office, into one of the languages specified in the agreement with the International Bureau. This procedure would apply to all International Searching Authorities which have declared, in a notification addressed to the International Bureau that they are prepared to accept for international searching a translation of the international application established under the responsibility of the receiving Office.

7. Having regard to the fact that none of the present International Searching Authorities are, for the time being, equipped and prepared to search international applications filed in Spanish and considering it of utmost importance that Spanish-speaking countries be allowed to use their language for the filing of international applications, it is proposed to amend Rule 12.1 accordingly, by adding two new paragraphs ((c) and (d)),

8. It is also proposed that if, at the time of adopting the amendments to Rules 12.1(c) and (d), 34.1 and 48.3, no Spanish speaking country is yet party to the PCT, the Assembly of the PCT Union decide that the said amendments would become applicable at the same time that the PCT will enter into force in respect of the country which, among Spanish speaking countries, is the first to ratify or accede to the PCT.

9. Other languages. Further amendments to Rule 48.3(b) were submitted to the second session of the Committee. Those proposals would have allowed international applications filed in a language other than one of the languages of publication to be translated under the responsibility of the International Searching Authority, for the purposes of international publication, into any of the languages of publication (and not only into English). In view of the lack of support of those proposals, both during the session of the Committee and subsequently, it is no longer proposed to amend Rule 48.3(b) in that respect.

[Chapter 15]

Rule 34

Minimum Documentation

34.1 *Definition*

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) to (v) [No change]

(vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.

(d) [No change]

(e) Any International Searching Authority whose official language or one of whose official languages is not Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan and the Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than 6 months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

[Chapter 15]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

- (a) [See Chapter 30 on page 24, below]
- (b) [See Chapter 3 on page 8 of document PCT/A/XI/4]
- (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) If the international application is filed in English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed.

(b) If the international application is filed in a language other than English, French, German, Japanese, Russian or Spanish, that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3) (b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

[Rule 48.3, continued]

[Chapter 15]

(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 of document PCT/A/XI/4]

(c) [See Chapter 14 on page 51 of document PCT/A/XI/4]

Chapter 25: Making it possible for the applicant to present additional arguments to the International Preliminary Examining Authority even where he submits no amendments; making longer the time limit for establishing the international preliminary examination report

(Concerns Rules 66.4 and 69.1)

Proposals approved by the Committee
(the approval of Rule 69.1 is subject to the approval
of the proposed amendment to Article 39 (1) (a))
(see documents peT/CAL/II/3, pages 40 to 43, and
PCT/CAL/II/9, paragraphs 45 and 46)

1. *Ad Rule 66.4.* Under the present text of Rule 66.3, the applicant may reply to a written opinion of the International Preliminary Examining Authority issued under Rule 66.2 by submitting amendments or corrections or if he disagrees with the opinion of that Authority by submitting arguments, as the case may be, or do both. The International Preliminary Examining Authority has, under Rule 66.4 (a), the possibility to issue one or more additional written opinions and the applicant has the same right to respond as outlined above. When, however, the applicant requests the International Preliminary Examining Authority, without having received an additional written opinion, to give him one or more additional opportunities under Rule 66.4(b), such opportunities are presently limited to the submission of amendments or corrections and do not include the possibility of submitting arguments.
2. Practice has shown that some applicants would like to have, during the international preliminary examination, also the right to request one or more additional opportunities for the submission of arguments in the expectation that their arguments will help in avoiding amendments that they do not wish to make.
3. It is therefore proposed to amend Rule 66.4(b) by allowing also a request for one or more additional opportunities to submit arguments. This amendment would contribute to the better acceptance of Chapter II by applicants since it would broaden the possibility for a dialogue between the applicant and the International Preliminary Examining Authority. It is to be noted that the practice of some of the International Preliminary Examining Authorities already allows applicants to present additional arguments and it would be useful to harmonize the practice of all International Preliminary Examining Authorities. Cases where an applicant may want to present additional arguments are, for example, that the applicant had further thoughts giving him better arguments in addition to those already submitted in response to an opinion of the International Preliminary Examining Authority, or that tests made by the applicant in the meantime have resulted in a better knowledge of the invention. In such cases, the applicant should be permitted to present his new arguments or knowledge to the International Preliminary Examining Authority. This would eventually result in an improvement of the international preliminary examination report, which is in the interest of both the applicant and the elected Offices.
4. Since the provision of Rule 66.4(b) uses the word “may,” the International Preliminary Examining Authority would have the possibility to refuse requests to submit additional arguments if the time limit for international preliminary examination is too short to permit to give the applicant a further opportunity to submit such arguments or if it appears to be a hopeless case, namely, where it is clear that additional arguments would not change the

opinion of the International Preliminary Examining Authority. The proposed amendment would thus not put a further burden on the International Preliminary Examining Authority nor increase the cost of the establishment of the international preliminary examination report.

5. For the reasons explained in paragraph 10 of Chapter 18 in document PCT/A/XI/4, it is furthermore proposed to delete all references to corrections in Rule 66.4.

[Chapter 25]

Rule 66

Procedure before the International Preliminary
Examining Authority

66.1 [No change]

66.2 [See Chapter 18 on page 58 of document PCT/A/XI/4]

66.3 [See Chapter 18 on page 60 of document PCT/A/XI/4]

66.4 *Additional Opportunity for Submitting Amendments or Arguments*

(a) [No change]

(b) On the request of the applicant, the International Preliminary Examining Authority may give him one or more additional opportunities to submit amendments or arguments.

66.5 [See Chapter 30 on page 29, below]

66.6 [No change]

66.7 [See Chapter 26 on pages 71 and 73 of document PCT/A/XI/4]

66.8 *Form of Amendments*

(a) [See Chapter 18 on page 60 of document PCT/A/XI/4]

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

66.9 [See Chapter 18 on page 61 of document PCT/A/XI/4]

[Chapter 25]

6. *Ad Rule 69.1.* Present Rule 69.1(a) provides for the establishment of international preliminary examination reports within maximum time limits and that the agreements with the various International Preliminary Examining Authorities must provide the same time limits for all International Preliminary Examining Authorities. Since the first agreement concluded with an International Preliminary Authority has fixed the time limits at the maxima allowed, it is those maxima which had to be and were provided in all the agreements. Naturally, the same time limits would have to be applied also to any agreement with additional International Preliminary Examining Authorities. Under those circumstances, reference in the Rule to agreements seems to be superfluous, and it is proposed to fix the time limit direct in Rule 69.1(a) and to no longer make reference to the agreements.

7. At the same time, it is proposed no longer to fix, for the usual case where the demand is filed prior to the expiration of 19 months from the priority date, a certain period after the start of the international preliminary examination within which the preliminary examination report must be established but to determine a date by which that report must be established at the latest. That date is proposed to be 28 months from the priority date. Such a time limit has a double advantage. First, it makes sure that the applicant will receive the international preliminary examination report at about two months before the expiration of the proposed time limit of 30 months for the entry into the national phase (see Chapter 32-33, below). Second, it gives the International Preliminary Examining Authority more time for preliminary examination and the applicant the possibility to influence the time available for that examination. The earlier he makes the demand, the longer the time for preliminary examination will be. If the applicant makes the demand immediately after receipt of the international search report, which is usually not later than 16 months from the priority date, and declares at the same time that he does not wish to make amendments under Article 19, international preliminary examination can start during that 16th month from the priority date and can last until the expiration of 28 months from the priority date, which is almost one year and should be sufficient for a complete and thorough preliminary examination.

8. It is to be noted that the proposal is linked to, and therefore subject to the adoption of the proposed extension of the time limit under Article 39(1) (a) to 30 months from the priority date (see Chapter 32-33, below).

9. For the exceptional case where the demand is filed after the expiration of 19 months from the priority date, it is proposed to maintain the present system, namely, that the international preliminary examination report must be established within a fixed period after the start of the international preliminary examination, and it is proposed to fix that period at 9 months. The reason for this different time limit is that in such a case the delayed start of the national processing of the international application under Article 39(1) does not apply. Such processing starts after the expiration of the time limit applicable under Article 22. If the international preliminary examination report should still serve a useful purpose, it should be established in a prescribed period. The extension of that period from 6 or 8 months under the present Rule 69.1(a) to 9 months follows from the fact that experience has shown that the present period is sometimes too short. Another reason for basing the time limit on the start of the international preliminary examination is that a demand can be made at any time, even after the expiration of 28 months from the priority date, so that the proposed time limit under Rule 69.1(a) (i) could not be applied.

[Chapter 25]

Rule 69

Time Limit for International Preliminary Examination

69.1 *Time Limit for International Preliminary Examination*

(a) The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;

(ii) 9 months after the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

(b) and (c) [No change]

Chapter 30: Making more liberal the rules concerning the rectification
of obvious errors in the international application and other
documents of the applicant

(Concerns Rules 4.10, 48.2, 66.5, 91.1 and 91.2)

Revised proposals

(see documents peT/CAL/II/3, pages 54 to 65, and
PCT/CAL/II/9, paragraphs 52 to 74)

1. *Ad Rule 91.1(a), (b) and (d)*. The present provisions allow the rectification of what are referred to as “obvious errors of transcription” in the international application and other papers submitted by the applicant. It is proposed to make those provisions somewhat more liberal and to allow also the correction of obvious errors which are not errors of transcription. Any obvious error and not only obvious errors “of transcription” should be rectifiable. If, for example, the error consists of the description or a claim containing the expression “1000 degrees Celsius” instead of “100 degrees Celsius,” and provided that the requirements of Rule 91.1(b) on the obviousness of both the error and the rectification are complied with, which, for instance, would be the case if the temperature indications concerned the water boiling temperature, the error should be rectifiable not only if the secretary of the applicant or of his agent who drafted the application made the mistake when typing the application whereas the manuscript contained the correct expression, but also if the error was already contained in the manuscript. Indeed, there is no real difference between the two situations since in any case the applicant or his agent is responsible for the contents of the application and in both cases something else was written than what was originally intended. Moreover, the proposed solution would be easier to administer since it would no longer oblige the authority (competent to decide on the authorization for rectification) to engage in quasi-judicial proceedings in order to determine the source of the error. Indeed, avoiding quasi-judicial proceedings in the framework of Rule 91 was a concern expressed by several delegations at the second session of the Committee. As far as the addition of a third sentence to Rule 91.1(d) is concerned, see paragraph 10, below.

2. *Ad Rules 91.1 (f) and (h)*. At present, paragraph (f) reads as follows: “The date of the authorization [to rectify] shall be recorded in the files of the international application,” whereas paragraph (h) reads as follows: “Any authority, other than the International Bureau, which authorizes any rectification shall promptly inform the International Bureau of such rectification.” It is proposed to delete paragraph (h) and to transfer the present contents of that paragraph to paragraph (f), in view of the fact that the notification of the authorization for rectification to the International Bureau is referred to in the proposed new text of paragraph (g) (see paragraph 5, below)). At the same time, the requirement of “recording” in the files of the international application would be omitted as not sufficiently clear (whose files are meant?) and unnecessary (since the files of the International Bureau would, in any case, show the rectification). On the other hand, in view of its importance to the applicant, it is proposed to transfer to the Regulations (paragraph (f) of Rule 91.1) the notification of the authorization (or the refusal thereof) to the applicant, which is at present only provided for in the Administrative Instructions (see Section 109, the deletion of which is proposed).

3. It is furthermore proposed to provide in paragraph (f) for a new procedure applicable in case of refusal of the authorization to rectify. Under that procedure, the applicant may, prior to the time by which an authorization becomes effective under Rule 91.1(g-bis) to (g-quater) (see paragraphs 6 to 8, below), request the International Bureau to publish the request for rectification together with the international application and to communicate a copy of the said request to the designated Offices under Article 20, or, where no publication is effected by virtue of Article 64 (3), to include such copy only in the communication under Article 20. Any such request would be subject to the payment of a fee which is to be fixed in the Administrative Instructions (see the proposed modification to Section 405 in paragraph 13, below).

[Chapter 30]

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) [No change]

(b) If the request does not indicate both

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

(ii) the date on which it was filed,

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made except where, resulting from an obvious error^{*}, the indication of the said country or the said date is missing or is erroneous; whenever the identity or correct identity of the said country, or the said date or the correct date, may be established on the basis of the copy of the earlier application which reaches the receiving Office before it transmits the record copy to the International Bureau, the error shall be considered as an obvious error.

(c) [See Chapter 8 on page 17 of document PCT/A/XI/4]

(d) [See Chapter 1 on page 9 of document PCT/A/XI/3]

(e) [No change]

* The amendment consists of deleting, after the word “error,” the words “of transcription.”

[Chapter 30]

4. The purpose of the proposed procedure is to allow the applicant to inform the public and the designated Offices of the requested rectification and, if the national law of the designated Office so permits, obtain authorization for the requested rectification from that Office. The possibility to have obvious errors corrected before the designated Office is per se not new. What is new is the possibility to have the request for rectification published and communicated by the International Bureau to the designated Offices. The need for this new procedure follows from some national laws which would not permit the rectification of certain obvious errors once the application is published since the public relies on the publication; consequently, certain rectifications could not be authorized if they were of importance to the public and if at least their possibility had not been indicated in the publication.

5. *Ad Rule 91.1(g)*. Both the present paragraph (g) and paragraph (g) as proposed to be amended deal with the time limit or event until which a rectification can be made. The proposed changes would essentially be clarifications and would make the situation of the applicant more secure since the events and dates would be more precise. Thus, where the rectification is authorized by the receiving Office or the International Searching Authority, it would have to reach the International Bureau by the expiration of 17 months from the priority date, which should be ample and would secure that the international publication would take into account the rectification; where the rectification is authorized by the International Bureau, it would have to be effected by the expiration of the same time limit (which would have the same advantages). There is no change proposed in respect of rectifications authorized by the International Preliminary Examining Authority. It is to be noted that the provisions of paragraph (g) would be subject to three qualifications, which are dealt with in proposed paragraphs (g-bis), (g-ter) and (g-quater).

6. *Ad Rule 91.1(g-bis)*. The first qualification is contained in paragraph (g-bis). It would allow to accept rectifications even beyond the 17-month time limit in the cases covered by paragraph (9) (i) and (iii): where the rectification authorized by the receiving Office or the International Searching Authority reaches the International Bureau after the expiration of that time limit but at a moment when it can still be taken into account in the international publication the authorization will be effective. In practice, this could mean one or two weeks beyond the 17-month time limit; in other words, the possibility to rectify could go up to two or three weeks before the actual publication (to be effected promptly after the expiration of the 18-month time limit) of the international application. Similar flexibility would apply in the case of rectifications authorized by the International Bureau.

7. *Ad Rule 91.1(g-ter)*. The second qualification to paragraph (g) is contained in proposed paragraph (g-ter). It would apply where the applicant asked for early publication. The time limits in paragraph (g) are based on the assumption that international publication occurs promptly after the end of the 18th month from the priority date. Where international publication occurs earlier because the applicant asked for an early publication the time limits concerning rectifications must expire earlier, otherwise the rectifications could not be taken into account in the international publication. It is proposed that the time limit should be the date on which the request for early publication reaches the International Bureau. Thus, the International Bureau will be able to take into account the rectification in the early publication of the international application.

[Chapter 30]

4.11 to 4.16 [No change]

4.17 [See Chapter 1 on page 11 of document PCT/A/XI/3]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (v) [No change]

(vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4,

(vii) any request for rectification referred to in Rule 91.1(f).

(b) [See Chapter 3 on page 8 of document PCT/A/XI/4]

(c) to (f) [No change]

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

(i) [No change]

[Chapter 30]

8. *Ad Rule 91.1(g-guater)*. The third qualification to paragraph (g) is contained in paragraph (g-guater). It would apply where the international application is not published (because none of the designated States requires publication). In that case, obviously, the 18-month publication date is of no influence on setting a time limit. But the date of communication under Article 20 is of such influence, since the communication should take into account any rectification. This is why the proposed limit is the time of communication under Article 20. In fact, this means that the time limit will be between 18 and 19 months from the priority date which, in turn, means a few more weeks for rectifications. Such longer time limit is naturally an added advantage for the applicant.

9. *Ad Rule 91.1(h)*. See the observations under paragraph 2, above.

10. *Ad Rule 91.2*. It is proposed to delete Rule 91.2. As far as the manner of requesting rectifications under Rule 91.1 is concerned, it is proposed to add a new sentence to Rule 91.1(d). That new sentence would refer to Rule 26.4(a), which deals with the procedure relating to corrections required by the receiving Office under Article 14 (1). The latter Rule would apply *mutatis mutandis* to rectifications under Rule 91.1. In addition, it is proposed to deal with other procedural matters concerning rectifications in the Administrative Instructions (Sections 320, 401bis, 501bis and 602bis).

11. *Ad Rules 4.10 and 66.5*. It is proposed to adapt the wording of those two Rules to the new wording proposed for Rule 91.1, namely, to replace in the said Rules the expression “error (s) of transcription” by the word “error (s).”

12. *Ad Rule 48.2*. It is proposed to add a new item (vii) to Rule 48.2(a) in order to provide for the inclusion in the pamphlet of any request for publication referred to in Rule 91.1(f) as proposed to be amended (see paragraphs 3 and 4, above). As a further consequence of this proposal, Annex D of the Administrative Instructions should be completed in order to provide for a mention, in the Gazette, of the fact that a request for rectification is included in the pamphlet (see paragraph 13, below).

13. The amendments to the Administrative Instructions which are referred to in paragraphs 2, 3, 10 and 12, above, could be the following:

Section 109

Notification of Authorization or Refusal of Rectification

[Deleted]

Section 320

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

(a) and (b) [See Chapter 11 on page 23 of document PCT/A/XI/3]

(c) Paragraphs (a) and (b) shall apply mutatis mutandis to rectifications authorized by the receiving Office under Rule 91.1.

[Chapter 30]

48.3 *Languages*

(a) and (b) [See Chapter 15 on pages 13 above]

(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 of document PCT/A/XI/4]

(c) [See Chapter 14 on page 51 of document PCT/A/XI/4]

Rule 66

Procedure before the International Preliminary
Examining Authority

66.1 [No change]

66.2 [See Chapter 18 on page 58 of document PCT/A/XI/4]

66.3 [See Chapter 18 on page 60 of document PCT/A/XI/4]

66.4 [See Chapter 25 on page 17, above]

[Chapter 30]

Section 401bis

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

- (a) [See Chapter 11 on page 25 of document PCT/A/XI/3]
- (b) Paragraph (a) shall apply mutatis mutandis to rectifications authorized by the receiving Office or by the International Searching Authority under Rule 91.1.

Section 405

Special Fees

- (a) The special publication fee provided for in Rule 48.4 shall be 200 Swiss francs.
- (b) The special fee provided for in Rule 91.1(f) shall be 50 Swiss francs plus 12 Swiss francs for each sheet in excess of one.

Section 501bis

Rectifications under Rule 91.1

Where the International Searching Authority authorizes a rectification under Rule 91.1, it shall:

- (i) mark, in the upper right-hand corner of each replacement sheet submitted under Rule 26.4(a) (applicable under Rule 91.1(d)), the international application number and the date on which it was received;

[Chapter 30]

66.5 *Amendment*

Any change, other than the rectification of obvious errors^{*}, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

66.6 [No change]

66.7 [See Chapter 26 on pages 71 and 73 of document PCT/A/XI/4]

66.8 *Form of Amendments*

(a) [See Chapter 18 on page 60 of document PCT/A/XI/4]

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

66.9 [See Chapter 18 on page 61 of document PCT/A/XI/4]

Rule 91

Obvious Errors in Documents

91.1 *Rectification*

(a) Subject to paragraphs (b) to (g-quater), obvious errors^{*} in the international application or other papers submitted by the applicant may be rectified.

* The amendment consists of deleting, after the word “errors,” the words “of transcription.”

[Chapter 30]

[Section 501bis, continued]

(ii) mark, in the middle of the bottom margin of each replacement sheet, the words "substitute sheet" or their equivalent in the language of publication of the international application as well as an indication of the International Searching Authority as provided for in Section 107(b),

(iii) mark on the letter containing the rectification or accompanying any replacement sheet the date on which that letter was received,

(iv) keep in its files a copy of the letter containing the rectification or, when the rectification is contained in a replacement sheet, the replaced sheet, the letter accompanying the replacement sheet, and a copy of the replacement sheet;

(v) promptly notify the International Bureau of the authorization and transmit to it the letter and any replacement sheet.

Section 602bis

Rectifications under Rule 91.1

Where the International Preliminary Examining Authority authorizes a rectification under Rule 91.1, Rule 70.16 and Section 602 shall apply *mutatis mutandis*.

[Rule 91.1, continued]

[Chapter 30]

(b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors*. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.

(c) [No change]

(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be an obvious error** may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g-quater). Rule 26.4(a) shall apply mutatis mutandis to the manner in which rectifications shall be requested.

(e) [No change]

(f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (g-bis), (g-ter) or (g-quater) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification together with the international application and include a copy thereof in the communication under Article 20 or, where the international application is not published by virtue of Article 64(3), include a copy of the request for rectification in the communication under Article 20.

* The amendment consists of deleting, after the word “errors,” the words “of transcription.”

** The amendment consists of deleting, after the word “error,” the words “of transcriptions.”

[Chapter 30]

ANNEX D [of the Administrative Instructions]

Information from Pamphlet Front Page to be Included in the
Gazette under Rule 86.1(i)

The following information shall be extracted from the front page of the pamphlet of each published international application and shall, in accordance with Rule 86.1(i), appear in the corresponding entry of the Gazette:

1. as to the international publication:

1.1 and 1.2 [No change]

1.3 an indication whether the following items were published in the pamphlet:

1.31 to 1.35 [No change]

1.36 request for rectification under Rule 91.1(f);

2. to 5. [No change]

[Rule 91.1, continued]

[Chapter 30]

(g) The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g-bis), (g-ter) and (g-quater), be effective:

(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;

(ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;

(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.

(g-bis) If the notification made under paragraph (9) (i) reaches the International Bureau, or if the rectification made under paragraph (g) (iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.

(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g) (i) must reach, and any rectification made under paragraph (9) (iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time when the request for early publication reaches the International Bureau.

(g-quater) Where the international application is not published by virtue of Article 64 (3), any notification made under paragraph (g) (i) must reach, and any rectification made under paragraph (9) (iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.

[Rule 91.1, continued]

[Chapter 30]

(h) [Deleted]

91.2 *Manner of Carrying Out Rectifications*

[Deleted]

Chapter 32-33: Making uniform, and in some cases longer, the time limits for entering the national phase in designated or elected States

(Concerns Articles 22(2) and 39(1) and Rule 75.1)
Proposals approved by the Committee in principle
(see documents PCT/CAL/II/4, pages 4 to 10, and
PCT/CAL/II/9, paragraphs 76 to 85)

1. *Ad Article 22(2)*. It is often and rightly said that one, of the advantages of the PCT is the fact that the applicant enjoys at least 20 months after the priority date before any national processing of his international application can start (see Articles 22 (1) and 23 (1)). (Thus, expenses for translations, local agents and national fees are incurred 8 months later than if priority is claimed under the Paris Convention but the PCT is not used.) This 20 month-time limit, however, is subject to an exception which makes the time limit shorter. The exception is provided for in Article 22(2) and applies in the case where the International Searching Authority declares that no international search report will be established. Such cases are rare but, when they exist, the exception must be remembered by the applicant. In any case, keeping in mind two different time limits is a complication in itself. There is real danger that the applicant might overlook the requirement under Article 22(2) to enter the national phase within two months from the date of the notification of such declaration sent to the applicant rather than 20 months from the priority date. Furthermore, the short time limit in Article 22(2) also weakens the advantage, flowing from the use of the PCT route whereby the applicant is given considerable time to reflect upon the desirability of pursuing his application before the designated Offices. Moreover, there seems to be no particularly convincing reason why a shorter time limit in Article 22(2) is necessary. Finally, having the same time limit for the two different situations referred to in paragraphs (1) and (2) of Article 22 could only make it easier for the applicant to remember time limits under the PCT. It is to be noted that the majority of the national Offices, in their capacity of designated Offices, have already made use of the possibility provided under Article 22(3) to extend the time limit under Article 22(2) and have extended it to 20 months from the priority date, thus making it the same as it is under Article 22 (1); these are the Offices of Australia, Austria, Democratic People's Republic of Korea, Germany (Federal Republic of), Hungary, Luxembourg, Monaco, Romania, Soviet Union, Switzerland, as well as OAPI. (The Offices of Australia and Hungary have even extended the time limit to 21 months from the priority date.)

2. For all these reasons, it is proposed that the Assembly decide that the time limit under Article 22(2) should as in the case of the time limit in Article 22(1) be 20 months from the priority date and that the words "Notwithstanding the provisions of paragraph (1)" be deleted, since there would no longer be a difference between paragraphs (1) and (2) of Article 22.

3. Such changes may be effected outside a diplomatic conference, namely, by a unanimous decision of the Assembly of the PCT Union or in a vote by correspondence, since Article 47 (2) allows "all time limits fixed in Chapters I and II" of the PCT to be modified by such a procedure. Replacing the now existing time limit by another time limit is clearly a modification allowed by Article 47 (2) and adapting the wording of Article 22 (2) to the change of the time limit is only consequential to the said modification of a time limit.

[Chapter 32-33]

4. The proposed extension of the time limit under Article 22(2) entails the need for some Contracting States to change the national law accordingly. It is therefore proposed that the Assembly adopt a transitory measure for those countries in which, on January 1, 1985 (the envisaged date of entry into force of the modification of the time limit), that modified time limit is incompatible with the national law and as long as it remains incompatible with that law. The transitory measure would be that the present time limit of 2 months from the date of the notification sent to the applicant of the declaration continues to apply until the national law of the designated State concerned has been changed to be compatible with the modification in question.

[Chapter 32-33]

Article 22

Copy, Translation, and Fee, to Designated Offices

The Assembly, in order to make the same time limit applicable under paragraphs (1) and (2) of Article 22, decides as follows:

“(1) Article 22(2) is modified as follows:

“*Where the International Searching Authority makes a declaration, under Article 17 (2) (a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).”

(2) The modification enters into force on January 1, 1985. However, as long as that time limit is incompatible with the national law applied by the designated Office, a time limit of two months from the date of the notification sent to the applicant of the said declaration shall, during that transitory period, apply with respect to that designated Office, provided that such Office has made a notification to that effect to the International Bureau.

(3) The notification referred to in paragraph (2) shall be addressed to the International Bureau before October 1, 1984. It shall be promptly published by the International Bureau in the Gazette, and it shall become effective on January 1, 1985.

(4) Any notification effected under paragraph (3) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette, and it shall be effective 2 months after its publication in the Gazette or at any later date as indicated in the notice of withdrawal.”

* The modification also consists of deleting, before the word “where,” the words “Notwithstanding the provisions of paragraph (1),”

[Chapter 32-33]

5. The transitory measure would apply if the designated Office concerned has made a notification to that effect to the International Bureau before October 1, 1984. Any such notification would be published in the Gazette and would become effective on January 1, 1985. Once the designated State has made the required change to its national law so that it becomes compatible with the modified time limit under Article 22(2), its notification would be withdrawn and the withdrawal would be published in the Gazette. The withdrawal would become effective 2 months after that publication or at any later date indicated in the notice of withdrawal.

6. In all other cases, the extended time limit would apply as from January 1, 1985. It would, in particular, apply as from that date to all pending applications. Where the International Searching Authority has made a declaration, under Article 17(2) (a), that no international search report would be established, and if the present two-month time limit applies on the date of the notification of the said declaration but has not expired on the date of entry into force of the modification of the time limit under Article 22 (2), the two-month time limit will automatically be extended to 20 months from the priority date.

7. The modification of the time limit under Article 22(2) implies a consequential amendment of Rule 47.1 (b) (see paragraph. 6 of Chapter 20 in document PCT/A/XI/3). However, any designated Office which has made a notification excluding, for a transitory period, the application of that modified time limit needs the communication of the international application prior to the date on which it may start national processing, i.e., prior to the expiration of two months from the date of the declaration by the International Searching Authority that no international search report will be established. It is therefore proposed to provide in a new Section (Section 422) of the Administrative Instructions for a provision which corresponds to the present third sentence of Rule 47.1(b). In other words, it is proposed to maintain, in respect of the said designated Office, the present time limit for the communication of the international application, until the modified time limit under Article 22(2) enters into force in respect of that Office. The text of new Section 422 could read as follows:

Section 422

Transitory Provisions Concerning Rule 47.1(b)

Notwithstanding Rule 47.1(b), where any designated Office has made a notification that the time limit under Article 22(2) as modified with effect from January 1, 1985, is incompatible with the national law applied by the designated Office and where the International Searching Authority makes a declaration, under Article 17(2) (a), that no international search report will be established, the communication provided for in Article 20 to such designated Office shall be effected, unless the international application is withdrawn, within one month from the date on which the International Bureau has been notified of the said declaration by the International Searching Authority; such communication shall be accompanied by an indication of the date of the notification sent to the applicant under Article 17(2) (a).

[Chapter 32-33]

Article 39

Copy, Translation, and Fee, to Elected Offices

The Assembly, in order to extend the time limit under Article 39(1) (a) from 25 to 30 months from the priority date, decides as follows:

“(1) Article 39(1) (a) is modified as follows:

“If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date.”

(2) The modification enters into force on January 1, 1985. However, as long as the said time limit of 30 months is incompatible in all cases with the national law applied by the elected Office, a time limit of 25 months from the priority date shall, during that transitory period, apply with respect to that elected Office, provided that such Office has made a notification to that effect to the International Bureau.

(3) The notification referred to in paragraph (2) shall be addressed to the International Bureau before October 1, 1984. It shall be promptly published by the International Bureau in the Gazette, and it shall become effective on January 1, 1985.

(4) Any notification effected, under paragraph (3) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette, and it shall be effective 2 months after its publication in the Gazette or at any later date as indicated in the notice of withdrawal.”

[Chapter 32-33]

8. It is proposed to include, in the publication of the official text of the Treaty, a footnote to Article 22(2) which would reproduce the text of Article 22(2) as adopted in 1970 by the Washington Diplomatic Conference, as well as the decision taken by the Assembly on February 3, 1984. The text of the footnote is proposed to read as follows:

The text of Article 22(2) (“Notwithstanding the provisions of paragraph (1), where the International Searching Authority makes a declaration, under Article 17(2) (a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be two months from the date of the notification sent to the applicant of the said declaration.”) was modified by a decision taken by the Assembly of the PCT Union on February 3, 1984. In addition to that modification, the decision of the Assembly contains the following provisions:

“(2) The modification enters into force on January 1, 1985. However, as long as that time limit is incompatible with the national law applied by the designated Office, a time limit of two months from the date of the notification sent to the applicant of the said declaration shall, during that transitory period, apply with respect to that designated Office, provided that such Office has made a notification to that effect to the International Bureau.

(3) The notification referred to in paragraph (2) shall be addressed to the International Bureau before October 1, 1984. It shall be promptly published by the International Bureau in the Gazette, and it shall become effective on January 1, 1985.

(4) Any notification effected under paragraph (3) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette, and it shall be effective 2 months after its publication in the Gazette or at any later date as indicated in the notice of withdrawal.”

9. *Ad Article 39(1) (a)*. The present text of Article 39(1) (a) provides in effect that the national phase must be entered at the latest at the expiration of 25 months from the priority date. It is proposed to extend this period by five months, so that the time limit becomes 30 months from the priority date. The main reason for this extension would be to allow enough time for the applicant to receive the international preliminary examination report in every case before he has to comply with the acts required for the entry into the national phase.

10. If the demand is filed, as is usually the case, during the 19th month from the priority date, the time limit for the establishment of the international preliminary examination report, which is normally 6 months after the start of the international preliminary examination (see present Rule 69.1(a) (i)), expires during the 25th month from the priority date. On the other hand, the applicant must enter the national phase before the elected Office prior to the end of that 25th month. In certain cases, the international preliminary examination report may even be established by as much as two months later (see present Rule 69.1(a) (ii)) that is, after the expiration of the existing 25-month time limit provided for in Article 39(1)(a). In both cases, the applicant cannot consider the international preliminary examination report before he has to enter the national phase.

[Chapter 32-33]

Rule 75

Withdrawal of the Demand, or of Elections

75.1 *Withdrawals*

(a) Withdrawal of the demand or all the elections may be effected prior to the expiration of 30 months from the priority date except as to any elected State in which national processing or examination has already started. Withdrawal of the election of any elected State may be effected prior to the date on which examination and processing may start in that State.

(b) [No change]

75.2 and 75.3 [See Chapter 14 on page 53 of document PCT/A/XI/4]

75.4 [No change]

[Chapter 32-33]

11. Even in cases where the demand is filed earlier than the 19th month from the priority date, the existing time limit has, in some cases, proven to be rather tight. Where the priority of an earlier application is claimed in an international application and this is normally the case the international search report will be mailed during the 16th month from the priority date. The international preliminary examination usually starts upon receipt by the International Preliminary Examining Authority of amendments under Article 19 or of a notice from the International Bureau that no such amendments have been filed (see Rule 69.1(b)). This occurs usually during the 18th month from the priority date. The time limit for the establishment of the international preliminary examination report expires in such a case during the 24th or 26th month from the priority date which is too close or even posterior, to the expiration of the present, 25-month time limit under Article 39(1) (a).

12. The main purpose of Chapter II of the Treaty is to provide the applicant with an international preliminary examination report before he must incur expenses for translations, local agents and national fees, that is, before entering the national phase. In many cases, the existing time limit of 25 months from the priority date is too short to allow the applicant to benefit from the said report before entering the national phase.

13. It is therefore proposed to extend as already stated the time limit under Article 39 (1) (a) from 25 months to 30 months from the priority date, which would permit the establishment of the international preliminary examination report in all cases in sufficient time before the applicant has to enter the national phase.

14. It is recalled that in Chapter 25, above, it is proposed that, if the demand is filed prior to the expiration of 19 months from the priority date, the international preliminary examination report must be established within 28 months from the priority date. This means that, where the demand is filed only shortly before the expiration of 19 months from the priority date, only 9 months would be allowed for the preparation of the international preliminary examination report. Compared to the time usually needed by national Offices for patent examination, even the said period of 9 months may appear to be rather short. If, in addition, the time is taken into consideration which will be saved by the elected Offices for any national examination where the international preliminary examination report has been established and has been considered by the applicant prior to the start of national processing, it becomes evident that the proposed extension of the time limit for starting such processing would not constitute an undue delay.

15. It is firmly believed that the proposed change would contribute to a much wider use of Chapter II for the benefit of the applicants and the elected Offices, since international preliminary examination reports would always be available before the national processing may start and thus reduce the number of applications reaching the national phase which are unlikely to become patents.

16. It is to be noted that the time limit in Article 39(1) (a) can be modified by a unanimous decision of the Assembly of the PCT Union or in a vote by correspondence under Article 47(2), as indicated in more detail in paragraph 3, above.

[Chapter 32-33]

17. The proposed extension of the time limit under Article 39(1) (a) from 25 to 30 months from the priority date entails the need for some Contracting States to change the national law accordingly. It is therefore proposed that the Assembly adopt a transitory measure for those countries in which, on January 1, 1985 (the envisaged date of entry into force of the modification of the time limit), that modified time limit is incompatible in all cases with the national law and as long as it remains incompatible with that law. The transitory measure would be that the present time limit of 25 months from the priority date continues to apply until the national law of the elected State concerned has been changed to be compatible with the modification in question. (The procedural aspects of the transitory measure would be the same as for Article 22(2), see paragraph 5, above.)

18. It should be noted that during consultations with the Japanese Patent Office, the Director General of that Office has indicated that the Japanese Delegation to the PCT Assembly will make a statement that the Japanese Government will be in a position to apply the 30-month period latest in the course of 1985. Since the Japanese situation was the only significant situation the proposal contained in paragraph 82 of document PCT/CAL/II/9 was intended to cover, and since the said statement would take care of that situation, there is no need to include provisions along the lines outlined in the said paragraph in the draft decision by the Assembly. In view of the fact that the modified time limit is proposed to enter into force on January 1, 1985, this would mean that the second sentence of item 2 of the decision, namely the transitory period, would cease to apply to Japan in the course of 1985.

19. It is proposed to include, in the publication of the official text of the Treaty, a footnote to Article 39(1) (a) which would reproduce the text of Article 39(1) (a) as adopted in 1970 by the Washington Diplomatic Conference, as well as the decision taken by the Assembly on February 3, 1984. The text of the footnote is proposed to read as follows:

The text of Article 39(1) (a) ("If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 25 months from the priority date.") was modified by a decision taken by the Assembly of the PCT Union on February 3, 1984. In addition to that modification, the decision of the Assembly contains the following provisions:

"(2) The modification enters into force on January 1, 1985. However, as long as the said time limit of 30 months is incompatible in all cases with the national law applied by the elected Office, a time limit of 25 months from the priority date shall, during that transitory period, apply with respect to that elected Office, provided that such Office has made a notification to that effect to the International Bureau.

(3) The notification referred to in paragraph (2) shall be addressed to the International Bureau before October 1, 1984. It shall be promptly published by the International Bureau in the Gazette, and it shall become effective on January 1, 1985.

[19 continued]

[Chapter 32-33]

(4) Any notification effected under paragraph (3) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette, and it shall be effective 2 months after its publication in the Gazette or at any later date as indicated in the notice of withdrawal.”

20. *Ad Rule 75.1(a)*. The proposed amendment, which consists of replacing the present time limit of 25 months from the priority date by a time limit of 30 months from such date for withdrawing the demand or all the elections, is equal to, and is consequential on, the proposed extension of the time limit under Article 39(1) (a).

Chapter 34: Making it unnecessary for the applicant to transmit copies
of his international application to the designated Offices

(Concerns Rule 49.1)

Proposals approved by the Committee

(see documents PCT/CAL/II/4, pages 12 and 13, and
PCT/CAL/II/9, paragraph 86)

1. Article 24(1) (iii) provides that the effect of the international application provided for in Article 11(3) (i.e., the same effect as that of a national (or regional) application) shall cease in any designated State with the same consequence as the withdrawal of a national (or regional) application, if the applicant fails, inter alia, to furnish to the designated Office a copy of the international application within the 20-month time limit, unless a copy of the international application has already reached the designated Office through transmittal (under Article 20 and Rule 47.1 (a)) by the International Bureau.
2. In practice, however, the designated Offices rely entirely on the communication of the international application by the International Bureau. Where they are not in possession of a copy of the international application at the expiration of the 20-month time limit, they ask the International Bureau to supply a copy of the international application, or they refer to the copy contained in the complete set of all published international applications received by them under Rule 87.2, and they do not, in fact, consider the international application as an application that has lost its Article 11(3) effect only because no copy transmitted by the applicant reached them in time. In other words, and in practice, lack of compliance by the applicant with his Obligation to furnish a copy of the international application under Article 22 does not, in fact, entail any adverse consequences for him.
3. It is proposed to codify this de facto situation by providing in effect that the said practice of the designated Offices be the subject matter of notifications to the International Bureau. The International Bureau would publish such notifications. In respect of any designated Office that made such notification and it is reasonable to expect that all would do so the applicant could then be sure that the effect of his international application could not cease on the ground that a copy was not furnished by him to the designated Office. The notification could taking into account the fact that the way through which Contracting States wish to arrive at the same result may be different either state that the furnishing of the copy is not required (paragraph (a-bis)) or state that the non-furnishing of the copy is not required (paragraph (a-ter)). These are two ways of obtaining the same result, namely the exclusion of the danger of the applicant's losing his rights as a consequence of the non-furnishing of a copy of his international application. The publication of the notification would be provided for in paragraph (b) as modified.

[Chapter 34]

Rule 49

Copy, Translation and Fee under Article 22

49.1 *Notification*

(a) [No change]

(a-bis) Any Contracting State not requiring the furnishing, under Article 22, by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau under Rule 47 has not taken place by the expiration of the time limit applicable under Article 22) shall notify the International Bureau accordingly.

(a-ter) Any Contracting State which, pursuant to Article 24(2), maintains, if it is a designated State, the effect provided for in Article 11(3) even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under Article 22 shall notify the International Bureau accordingly.

(b) Any notification received by the International Bureau under paragraphs (a), (a-bis) or (a-ter) shall be promptly published by the International Bureau in the Gazette.

(c) [No change]

49.2 [No change]

49.3 to 49.5 [See Chapter 35 on pages 48, and 51, below]

Chapter 35: Specifying the requirements for entering
the national phase, in particular, the contents of the
translation of the international application

(Concerns Rules 11.15, 49.3 to 49.5, 76.1 to 76.3 and 76.5)

Revised proposals

(see documents PCT/CAL/II/4, pages 14 to 22, and
PCT/CAL/II/9, paragraphs 87 to 92)

1. *Ad Rule 49.3.* The amendment proposed for Rule 49.3 namely, the inclusion of the words “subject to Rule 49.5(c) and (h)” is a consequence of the proposed inclusion of that Rule (see paragraphs 14 to 17, below).
2. *Ad Rule 49.4 and 49.5 (in general).* The provisions of Article 22(1) list exhaustively the acts that must be performed as a condition for entering the national phase. That the said listing is exhaustive follows also from Article 24(1) (iii), which cites only the acts referred to in Article 22 as acts whose non-performance within the time limit for entering the national phase may result in the loss of the effect of the international application in the designated States (“may” because Article 24(2) enables the designated Office to maintain the effect notwithstanding such non-performance).
3. The applicant who files an international application is entitled to expect especially having regard to the provisions of Article 24(1) (iii) that nothing more is required of him prior to the time limit applicable under Article 22 than to pay the national fee, to provide any necessary translation of his application as well as, in certain cases, a copy of that application, and to furnish certain indications concerning the inventor unless they were contained in the request, and he is entitled to expect that he cannot lose his rights if he complies with those conditions.
4. The International Bureau has learned from its discussions with the national Offices in connection with its publication of Volume II of the PCT Applicant’s Guide (which deals with the procedure before them as designated and elected Offices) and from letters it receives from users of the PCT that some designated Offices ask, for the entering of the national phase, for compliance with conditions additional to those permitted by the PCT and the Regulations. Furthermore, the requirements in respect of the translation of the international application are different in most of the designated Offices, and clarification is urgently needed.
5. The first point concerns the use of a special national form for entering the national phase. Such requirement is contrary to Article 22(1) in the sense that it would oblige the applicant to perform an act namely, to use a special national form which is not comprised in the exhaustive listing, set forth by that Article, of the acts to be performed for entering the national phase. Naturally, when the applicant wishes to initiate a certain action during the national phase, he may be required to use a special national form for that purpose, as prescribed by the national law, but such a requirement cannot be imposed upon him for the entry into the national phase. In order to clarify the matter, it is proposed to expressly negate such requirement for the entry into the national phase in what would be a new Rule, namely, Rule 49.4. That Rule would not prevent any designated Office from issuing a special national form which could be used for the entry into the national phase. However, the use of such form would be optional and not mandatory.

[Chapter 35]

Rule 11

Physical Requirements of the International Application

11.1 to 11.14 [No change]

11.15 Translations

[Deleted]

Rule 49

Copy, Translation and Fee under Article 22

49.1 [See Chapter 34 on page 46, above]

49.2 [No change]

49.3 *Statements under Article 19; Indications under Rule 13bis.4*

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall subject to Rule 49.5(c) and (h), be considered part of the international application.

49.4 *Use of National Form*

No applicant shall be required to use a national form when performing the acts referred to in Article 22.

[Chapter 35]

6. *Ad Rule 49.5(a) and (b)*. The second point concerns the contents of the translation to be furnished for entering the national phase. Article 22 (1) provides that a translation of the international application, “as prescribed,” may be required. The words “as prescribed,” whenever used in the Treaty, mean as prescribed in the Regulations (cf. also Article 58(1) (i)). This permits prescribing in the Regulations not only the languages from or into which a translation may be required but also the determination of the scope of the translation. That scope does not necessarily have to coincide with the contents of an international application as specified under Article 3 (2), as confirmed by the fact that Rule 49.3 already as adopted at the Washington Diplomatic Conference includes, for the purposes of Article 22 and Rule 49, any statement made under Article 19 (1) in the contents of the international application although such statement is not among the elements listed in Article 3(2). It is proposed that a new Rule, Rule 49.5(a), specify the parts that have to be translated. Those parts comprise, as a general Rule, the description, the claims (as originally filed or as amended under Article 19, including any statement made under Article 19) and any text matter of drawings. Where it is required by the designated Office, the translation must also comprise the request and/or comprise both the claims as filed and as amended and/or be accompanied by a copy of the drawings.

7. Since requiring a translation of the request creates difficulties for the applicant where no version of the request form exists in the language of the translation, it is proposed to provide in Rule 49.5(b) that the Office requiring a translation of the request must put the request form in the language of the translation free of charge at the disposal of the applicants where no version of the request form exists in the language of the translation. The request form in the language of the translation should have the same form and contents as the request under Rules 3 and 4. In particular, it should not ask for information additional to what has been indicated by the applicant in the request in the original language. In any case, the use of the request form in the language of the translation would be optional only an applicant not using it but furnishing his own version of the request in the language of the translation could not be considered not to have complied with the requirements of the designated Office.

8. *Ad Rule 49.5(d) to (g)*. The third point is what the applicant has to furnish in connection with drawings, when he furnishes a translation of the international application under Article 22. One has to distinguish between two cases, depending on whether the drawings contain text matter or not.

9. Where a drawing contains text matter, a translation of the text matter must be furnished as part of the translation of the international application, as specified in the first sentence of new Rule 49.5(a). New Rule 49.5(d) defines the manner of furnishing the translation of such text matter by giving the applicant the option either to furnish a copy of the original drawing with the translation of the text matter pasted on the text matter in the original language or to furnish a drawing executed anew. The applicant would furnish a drawing executed anew, for instance, if the text is longer in the translation than in the original language so that pasting the translation over the text matter in the original language on a copy of the original drawing is physically impossible. On the other hand, if such pasting is physically possible, the applicant cannot be forced to furnish, as a condition for entering the national phase, a drawing executed anew since such requirement would amount to obliging the applicant to perform an act which is not comprised in the exhaustive listing, set forth in Article 22(1), of the acts to be performed for entering the national phase. Furthermore, new Rule 49.5(g) makes it clear that, where the copy of the drawing, or the drawing executed anew, which is furnished by the

applicant does not comply with the physical requirements referred to in Rule 11 (for instance, because the translation of the text matter was furnished separately whereas it results from Rule 11.11 that the text matter of a drawing must be contained in the drawing and cannot be furnished separately), the designated Office has the right to request the applicant to correct such defect (but it may not consider the international application withdrawn since this sanction can be applied only where no translation of the text matter has been furnished within the time limit applicable for entering the national phase).

[Chapter 35]

49.5 Contents of and Physical Requirements for the Translation

(a) For the purposes of Article 22, the translation of the international application shall contain the description, the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b) and (e),

(i) contain the request,

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended, and (iii) be accompanied by a copy of the drawings.

(b) Any designated Office requiring the furnishing of a translation of the request shall furnish copies of the request form in the language of the translation free of charge to the applicants. The form and contents of the request form in the language of the translation shall not be different from those of the request under Rules 3 and 4; in particular, the request form in the language of the translation shall not ask for any information that is not in the request as filed. The use of the request form in the language of the translation shall be optional.

(c) Where the applicant did not furnish a translation of any statement made under Article 19(1), the designated Office may disregard such statement.

(d) If any drawing contains text matter, the translation of that text matter may be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

[Chapter 35]

10. Where a drawing does not contain text matter, the applicant does not have to, as a general rule, furnish drawings when he furnishes a translation of the international application for the purposes of entering the national phase. Each designated Office, however, may require, under new Rule 49.5(a) (iii), the translation to be accompanied by a copy of the drawing (but it may not require the translation to be accompanied by a drawing executed anew). Furthermore, new Rule 49.5(g) makes it clear that, where the copy of the drawing which is furnished by the applicant does not comply with the physical requirements referred to in Rule 11, the designated Office has the right to request the applicant to correct such defect (but it may not consider the international application withdrawn). On the other hand, new Rule 49.5(e) deals with the case where a designated Office requires under the proposed new Rule 49.5(a) (iii) that the translation of the international application to be furnished under Article 22 must be accompanied by a copy of the drawings, but the applicant failed to comply with such requirement. The Rule makes it clear that the applicant would not risk a loss of his international application before such designated Office. The designated Office should either invite the applicant to furnish the missing copy of the drawings (Rule 49.5(e)(i)) or, where such invitation procedure is not compatible with that law, that Office should disregard the drawings of which no copies were furnished (Rule 49.5(e) (ii)). The latter Rule would, to the knowledge of the International Bureau, apply only in Japan, since the present Patent Law of that country would not permit an invitation procedure as provided under Rule 49.5(e) (i) but requires that drawings which were not furnished under Article 22 with the translation be disregarded.

11. It is to be noted that, if the applicant amends his application during the national phase, it may be necessary to furnish new drawings. This case, however, is completely different from the cases under consideration, which deal with what the applicant is required or may not be required to furnish as a condition for entering the national phase.

12. Finally, it is proposed to expressly exclude in new Rule 49.5(f) the requirement that the expression "Fig." be translated into any language since that expression is commonly used and understood whatever the language of the international application.

13. *Ad Rules 11.15 and 49.5(j)*. Present Rule 11.15 provides that no designated Office may require that the translation of the international application furnished to it under Article 22 comply with requirements a word which, in the context of Rule 11, means physical requirements other than those prescribed for the international application as filed. That Rule would find a more appropriate place in the Regulations if it were included in the provisions relating to the furnishing of the translation of the international application for the purposes of the entry into the national phase. Consequently, it is proposed to transfer the contents of present Rule 11.15 into what would be a new Rule 49.5(j) and to delete Rule 11.15.

14. *Ad Rule 49.5(c)*. Under Rule 49.3, a statement explaining amendments made under Article 19 is considered to be part of the international application. Consequently, if a translation is required, such statement must also be translated. However, as far as the translation of the statement is concerned, the applicant should not be in jeopardy because of being held not to have filed the required translation if he omits to file a translation of the statement. The fact that this minor defect in the translation may lead to the international application ceasing to have the effect provided for in Article 11(3) in the designated State with the same consequences as the withdrawal of a national application (see Article 24(1) (iii)) is out of proportion with the significance of the statement for the designated Office. In practice, it seems that the Offices probably exercise leniency with regard to the statement but the applicant should not be in the position of having to rely on leniency.

[Rule 49.5, continued]

[Chapter 35]

(e) If any drawing does not contain any text matter, any designated Office requiring under paragraph (a) the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under Article 22,

(i) invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation, or

(ii) disregard the said drawing if such invitation, on February 3, 1984, is not compatible with the national law applied by that Office and as long as it continues to be not compatible with that law.

(f) The expression "Fig." does not require translation into any language.

(g) Where any copy of the drawings or any drawing executed anew which has been furnished under paragraph (d) or (e) does not comply with the physical requirements referred to in Rule 11, the designated Office may invite the applicant to correct the defect within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(h) Where the applicant did not furnish a translation of any indication furnished under Rule 13bis.4, the designated Office shall invite the applicant to furnish such translation, if it deems it to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(i) Information on any requirement and practice of designated Offices under the second sentence of paragraph (a) shall be published by the International Bureau in the Gazette.

(j) No designated Office shall require that the translation of the international application comply with physical requirements other than those prescribed for the international application as filed.

[Chapter 35]

15. It is therefore proposed in paragraph (c) of the new Rule 49.5 that the designated Office may disregard any statement if not translated. Consequently, Article 24(1) (iii) would not apply in such a case. The designated Office would not be obliged to disregard the statement if not translated; it could take it into account, for instance, if it was drafted in a language which is understood by the examiners of the designated Office. On the other hand, disregarding the statement would be the only possible sanction in case of failure to furnish a translation thereof.

16. *Ad Rule 49.5(h)*. The inclusion in the Regulations of a new Rule 49.5(h) is proposed in order to take care of the special case of microbiological inventions under Rule 13bis. That Rule provides, inter alia, that, where a reference to a deposited microorganism appears in an international application, the applicant must furnish certain indications, in particular, the date of deposit and the accession number of the deposit. Under the present Regulations, failure to furnish a translation of those indications within the time limit applicable under Article 22 would lead to the applicant losing his rights in the designated State concerned, which seems to be an excessive sanction, particularly in view of the fact that some of those indications (e.g., those mentioned above) do not require translation.

17. It is therefore proposed that failure of the applicant to furnish a translation of the indications furnished under Rule 13bis.4 should not automatically lead to a loss of rights but that, where the designated Office considers it necessary to have a translation of any such indication, the applicant be given an opportunity to furnish that translation. It is only where he does not comply with the invitation to furnish a translation that he could lose his rights.

18. *Ad Rule 49.5(i)*. Having regard to the importance of the correct compliance by the applicant with the requirements concerning the furnishing of a translation of the international application existing in each designated Office, it is proposed to provide for the publication in the Gazette of the applicable requirements. The International Bureau would obtain the necessary indications from the national Offices and would publish the information so received under Rule 49.5(i) in the Gazette.

19. *Ad Rules 76.1 to 76.3 and 76.5*: Present Rules 76.1, 76.2 and 76.3 repeat, in connection with Chapter II of the PCT, what is provided in present Rules 49.1, 49.2 and 49.3 in relation to Chapter I, with a few differences which are necessary in order to take account of the applicability of Chapter II. The proposed amendments to Rules 49.3 to 49.5 should also apply to Chapter II. They could be repeated, with a few differences, in Rule 76. However, it is not proposed to do so. In view of the length of the whole Rule 49 as proposed to be amended, such repetition in Rule 76 would be cumbersome and is, in fact, not necessary. It is therefore proposed to state in what would be a new Rule 76.5 that Rule 49 is applicable to cases pertaining to Chapter II, while indicating the few differences which are to be made in order to take into account the applicability of Chapter II, and to delete Rules 76.1, 76.2 and 76.3. On the other hand, Rule 76.4, which corresponds to the last sentence of Rule 17.2(a), would be maintained. (It is to be noted that the proposed new Rule 76.5 would also make Rule 51bis which is a new Rule proposed to be included in the Regulations and explained in Chapter 36, below applicable to cases pertaining to Chapter II.)

[Chapter 35]

Rule 76

Copy, Translation and Fee under Article 39(1);
Translation of Priority Document

76.1 *Notification*

[Deleted]

76.2 *Languages*

[Deleted]

76.3 *Statements under Article 19; Indications under Rule 13bis.4*

[Deleted]

76.4 [No change]

76.5 *Application of Rules 49 and 51bis*

Rules 49 and 51bis shall apply, provided that:

(i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) any reference in the said Rules to Article 22 shall be construed as a reference to Article 39(1);

(iii) the words “international applications filed” in Rule 49.1(c) shall be replaced by the words “a demand submitted.”

Chapter 36: Making it clear that certain requirements to be complied with during the national phase must be complied with by the applicant only after entering the national phase

(Concerns new Rules 51bis.1 and 51bis.2)

Revised proposals

(see documents PCT/CAL/II/4, pages 24 to 29, and PCT/CAL/II/9, paragraph 93)

1. The preceding Chapter (Chapter 35) deals with requirements which can or which cannot be imposed on the applicant by the national law of the designated Office as a condition for entering the national phase. The present Chapter (Chapter 36) deals with requirements which can be imposed by the national law of the designated Office on the applicant once the national phase has started, because they are in conformity with Article 27 (1), (2), (6) or (7), but which cannot be imposed as a condition for entering the national phase, either because Article 27 so provides or because they are contrary to Article 22(1), or for both reasons.

2. Proposed Rule 51bis.1 lists all the allowed requirements the International Bureau could think of. If any national Office can think of further requirements, it is invited to make them known so that their inclusion could be considered by the Assembly. However, in order to cover also possible cases of which neither the International Bureau nor any national Office can think at the present time, the cases listed are introduced by the words “in particular”. Any such additional cases would also be governed by Rule 51bis.2(a). The essence of Rule 51bis.2(a) is that, whenever an allowed requirement exists, it cannot be imposed as a condition for entering the national phase. Compliance with any of those allowed requirements may be required only after the entry into the national phase and the applicant should, in case of failure to comply with such allowed requirements when entering the national phase, have, once the national processing has started, an opportunity to comply before the non-compliance may result in a loss of rights. It would be up to the national law and national practice to determine the terms of such an opportunity. There are various possibilities how such opportunity can be given to the applicant. For instance, the national Office may invite the applicant to comply with the requirement in question within a certain reasonable time limit which would be fixed in the invitation; the national Office may remind- the applicant of the said requirement which has to be complied with within a certain time limit or before a certain event (e.g., decision to grant a patent) occurs; the national law may fix a grace period for the compliance or determine a certain event by which the requirement must be complied with after national processing has started; the national Office may, unless the national law expressly provides otherwise, simply accept a later compliance with the requirement or excuse a late compliance, etc.

3. In practice, as can be seen in Volume II of the PCT Applicant’s Guide (which deals with the procedure before the designated and elected Offices), all national Offices except those of Australia, Japan, the United Kingdom and the United States of America already apply what is proposed under the new Rule 51bis.

[Chapter 36]

4. It is to be noted that, under the new Rule 76.5, which is proposed in Chapter 35 (see paragraph 19, in fine, of the explanations relating to that Chapter), Rule 510is as proposed in the present Chapter would also apply to cases pertaining to Chapter II of the PCT. Consequently, whenever the expressions “designated Office” and “Article 22” are used in the present Chapter, they must be understood as covering also, where appropriate, elected Offices and Article 39(1).

5. Rule 51bis.1 (a) lists certain requirements which are allowed under Article 27(2) (ii) or Article 27(6). As can be seen from the words “in particular” which appear just before the listing starts, that listing is not necessarily exhaustive.

[Chapter 36]

Rule 51bis (New)

Certain National Requirements Allowed under
Article 27 (1), (2), (6) and (7)

5bis.1 Certain National Requirements Allowed

(a) The documents referred to in Article 27(2) (ii), or the evidence referred to in Article 27 (6), which the applicant may be required to furnish under the national law applicable by the designated Office are, in particular:

- (i) any document relating to the identity of the inventor,
- (ii) any document relating to any transfer or assignment of the right to the application,
- (iii) any document containing an oath or declaration by the inventor alleging his inventorship,
- (iv) any document containing a declaration by the applicant designating the inventor or alleging the right to the application,
- (v) any document containing any proof of the right of the applicant to claim priority where he is different from the applicant having filed the earlier application the priority of which is claimed,
- (vi) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

[Chapter 36]

6. The requirements referred to in items (i) to (iv) of Rule 51bis.1(a) mention documents relating to the identity of the inventor, his inventorship and the right to file the application.

7. The documents referred to in item (v) of Rule 51bis.1(a), namely, those which contain any proof of the right of the applicant to claim priority where he is different from the applicant having filed the earlier application the priority of which is claimed, include any document relating to the identity of the applicant having filed that earlier application.

8. Item (vi) of Rule 51bis.1(a) deals with evidence concerning non-prejudicial disclosures or exceptions to lack of novelty. What is meant to be covered here are, for example, the provisions of the European Patent Convention and of the national laws of several European countries under which, for the purposes of evaluating the novelty of the invention, a disclosure of the invention is not taken into consideration if it occurred within six months before the filing date of the application and was due to, or in consequence of, an evident abuse in relation to the applicant or his legal predecessor, or the fact that the applicant or his legal predecessor has displayed the invention at certain exhibitions. Also meant to be covered are provisions such as those of the national law of Japan, under which a disclosure of the invention by the person having the right to obtain a patent does not affect the patentability of the invention if such person files a patent application within six months from the said disclosure. Under those two kinds of provisions, the applicant wishing to avail himself of them must, at least in most cases, furnish a statement to that effect at the time of filing the patent application and, later on, evidence of the veracity of the Statement. That evidence would be covered by the proposed new Rule 51bis. In other words, the applicant would not lose the possibility to take advantage of the provisions in question if he did not furnish the evidence before or at the time of entering into the national phase. On the other hand, the statement itself would not be covered by the proposed new Rule 51bis. It is proposed that the statement, if not contained in the description, should be required to be furnished in the request. This could be achieved by adding a new optional box to the request form or by adding the case of non-prejudicial disclosures among the cases in which the supplemental box may be used, as would be possible with the proposed new text of Rule 4.17(a) (see Chapter 1 in document PCT/A/XI/3). Thus, the evidence would fall under Article 27(2) (ii) as a document constituting proof of a statement made in the international application which, under Article 27 (2) (ii), may be required only once the processing of the international application has started in the designated Office. For an exception to this Rule during a transitory period, see Rule 51bis.2(c) and paragraph 13, below.

9. Rule 51bis.1(b), read in combination with Rule 51bis.2(a), specifies that, if the national law of the designated Office requires the applicant to be represented by an agent having the right to represent applicants before that Office and/or have an address for service in the designated State, or requires the applicant to duly appoint his agent, such requirements may be imposed upon the applicant only after the entry into the national phase. An applicant entering the national phase within the time limit applicable under Article 22 but without having complied with such requirements within that time limit would not lose his rights before having had, after the expiration of such time limit, an opportunity to comply with the requirements and having failed to so comply. This proposal is made in accordance with Article 27(7), under which the national law of the designated Office may be applied in connection with this issue only “once the processing of the international application has

started in the designated Office.” It does not introduce a new principle, but is a mere clarification of the meaning and the consequences of Article 27(7). Likewise, it does not mean that it would not be desirable for the applicant to be represented before the designated Office for the entry into the national phase, even where he is not required to be so represented. For an exception to this Rule during a transitory period, see Rule 51bis.2(c) and paragraph 13, below.

[Rule 51bis.1, continued]

[Chapter 36]

(b) The national law applicable by the designated Office may, in accordance with Article 27(7), require that

(i) the applicant be represented by an agent having the right to represent applicants before that Office and/or have an address in the designated State for the purpose of receiving notifications,

(ii) the agent, if any, representing the applicant be duly appointed by the applicant.

(c) The national law applicable by the designated Office may, in accordance with Article 27(1), require that the international application, the translation thereof or any document relating thereto be furnished in more than one copy.

(d) The national law applicable by the designated Office may, in accordance with Article 27(2) (ii), require that the translation of the international application furnished by the applicant under Article 22 be verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful.

51bis.2 Opportunity to Comply with National Requirements

(a) Where any of the requirements referred to in Rule 51bis.1, or any other requirement of the national law applicable by the designated Office which that Office may apply under Article 27(1), (2), (6) or (7), is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.

[Chapter 36]

10. Rule 51bis.1(c) states that a designated Office may, under its national law, require the applicant to furnish the international application or the translation thereof in more than one copy. However, if such requirement exists, it may be imposed only during the national phase and not as a condition for entering the national phase.

11. Rule 51bis.1(d) deals with the verification of the translation of the international application furnished under Article 22. Verification of a translation means a statement by the applicant or by the translator that, to the best of his knowledge, the translation is complete and faithful. The verification of a translation may be considered as proof under Article 27(2) (ii) of the faithfulness and completeness of the translation. Again, if the requirement for verification exists, it may be imposed only during the national phase and not as a condition for entering the national phase, since the furnishing of the statement constituting the verification is not included in the exhaustive listing of Article 22(1).

12. Some national laws contain provisions under which the designated Office may require a certification of a translation by a public authority or a sworn translator (as distinguished from the verification by the applicant or the translator). It is proposed in new Rule 51bis.2(b) to admit such requirement expressly in the Regulations but to limit its application to the case where the designated Office deems such certification to be necessary under the circumstances, e.g., if it has serious doubts in respect of the completeness or faithfulness of the translation furnished by the applicant. It is evident that such circumstances can be identified only after the entry into the national phase and that, consequently, a special invitation must be issued by which the applicant is invited to furnish a certification of the translation within a time limit which will be reasonable and will be fixed in the invitation.

13. Rule 51bis.2(c) contains an exception, for a transitory period, to the general rule (reflected in Rule 51bis.2(a)) that the designated Office should give the applicant who failed to comply with the national requirements referred to in Rule 51bis.1 an opportunity to comply with the requirement in question. The exception relates to the evidence concerning non-prejudicial disclosures or exceptions to lack of novelty referred to in Rule 51bis.1 (a) (vi) and to the representation before the designated Office referred to in Rule 51bis.1(b) (i). In these two cases, the applicant would not have an opportunity to comply with these requirements after the expiration of the time limit applicable under Article 22 if such opportunity is not compatible with the national law of the designated Office and as long as such incompatibility exists. This exception would, to the knowledge of the International Bureau, apply only in Japan since the present Patent Law of that country would not be compatible with the new Rule 51bis.2(a) until an appropriate amendment has been made.

[Rule 51bis.2, continued]

[Chapter 36]

(b) The national law applicable by the designated Office may, in accordance with Article 27(2) (ii), require that the applicant, upon invitation by the designated Office, furnish a certification of the translation of the international application by a public authority or a sworn translator, if the designated Office deems such certification to be necessary under the circumstances, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(c) If, on February 3, 1984, paragraph (a) is, with respect to the requirements referred to in Rule 51bis.1(a) (vi) and (b) (i), not compatible with the national law applied by the designated Office and as long as it continues to be not compatible with that law, the applicant shall have no opportunity to comply with any of the requirements after the expiration of the time limit applicable under Article 22. Information on the application of this paragraph shall be published by the International Bureau in the Gazette.

Chapter 37: Improving the wording of Rule 74.1 and simplifying
the time limit for the transmittal of the translation of any annexes
to the international preliminary examination report

(Concerns Rule 74.1)

Revised proposal

(see documents PCT/CAL/II/4, pages 30, 31 Rev. (in document PCT/CAL/II/8)
and 32, and PCT/CAL/II/9, paragraph 94)

1. The present text of Rule 74.1 consists of one very long sentence covering various alternatives with different time limits applying to the furnishing of translations of any replacement sheet referred to in Rule 70.16, or of translations of any amendment referred to in the last sentence of that Rule, namely, an amendment communicated in a letter which is to be annexed to the international preliminary examination report.
2. It is proposed to completely revise the text of this Rule, in particular, in order to make it more readily understandable. It is proposed to change the title of Rule 74.1 and to divide the text of the Rule into two sentences. The proposed amended title should make it clear that this Rule does not only deal with the time limit for the transmittal of a translation of the annexes to the international preliminary examination report but also prescribes the contents of such translation.
3. The first sentence of the proposed new text of Rule 74.1 deals with the normal case, namely, where the furnishing of a translation of the international application is governed by Article 39(1) and it requires the “translation of any replacement sheet referred to in Rule 70.16, or any letter referred to in the last sentence of that Rule, which is annexed to the international preliminary examination report” to be transmitted to the elected Office within the time limit applicable under Article 39(1), as under the present text of the Rule.
4. It is no longer proposed to maintain a special grace period for the case where the international preliminary examination report is transmitted to the applicant less than one month before, or at any time after, the expiration of the time limit under Article 39(1) (see the second sentence of Rule 74.1(a) as proposed to the second session of the Committee as well as the present text of Rule 74.1). In view of the proposed amendment to Rule 69.1(a) under which the time limit for the establishment of the international preliminary examination report is 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date, it will be sure that, in all cases, the said report is transmitted to the applicant more than one month before the expiration of the time limit for entering the national phase under Article 39(1) as proposed to be modified, namely, 30 months from the priority date (see Chapters 25 and 32-33 in this document).
5. The second sentence of the proposed new text of Rule 74.1 deals with the exception, namely, where the furnishing of the translation of the international application is governed by Article 22 (rather than by Article 39(1)) because the elected State has made a declaration under Article 64(2) (a) (i). The only Contracting State which made a declaration under Article 64(2) (a) (i) is, at present, Japan. It is proposed to apply the same time limit for the furnishing of the translation of the annexes of the international preliminary examination report as under the first sentence of Rule 74.1 because the applicant should not be obliged to furnish a

translation before he knows what has been annexed by the International Preliminary Examining Authority to its report. Naturally, the obligation of the applicant to furnish a Japanese translation of the international application by the expiration of 20 months from the priority date would not be affected by the proposed amendment.

6. It is to be noted that the furnishing of a translation of the annexes to the international preliminary examination report is not governed by Article 39 (1). That Article applies only to the furnishing of a translation of the international application as filed or, where amended under Article 19(1), as amended. The translation of the annexes to the international preliminary examination report must be furnished pursuant to Article 36(3) (b). The sanction provided for the non-furnishing of a translation of the international application in Article 39 (2) does not apply to the failure to furnish a translation of the annexes to the international preliminary examination report. As a consequence, the sanction for the non-furnishing of a translation of those annexes is left to the national law applied by the elected Office.

[Chapter 37]

Rule 74
Translations of Annexes of the
International Preliminary Examination Report and
Transmittal Thereof

74.1 Contents of Translation and Time Limit for Transmittal Thereof

Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39 (1), transmit a, translation of any replacement sheet referred to in Rule 70.16, or of any letter referred to in the last sentence of that Rule, which is annexed to the international preliminary examination report. The same time limit shall apply where the furnishing of a translation of the international application to an elected Office must, because of a declaration made under Article 64(2) (a) (i), be effected within the time limit applicable under Article 22.

Chapter 38: Making it clear in which cases Contracting States must
excuse delays in meeting time limits or rectify an error
made by an international authority

(Concerns new Rules 82bis.1, 82bis.2 and 82ter.1)
Proposals approved by the majority of the Committee
(see documents PCT/CAL/II/4, pages 34 to 44, and
PCT/CAL/II/9, paragraphs 95 to 97)

1. *Ad Rule 82bis.1.* Article 48 deals with excusing the missing of time limits. Paragraph (1) of that Article speaks about “any time limits fixed in this Treaty [that is, the PCT] or the Regulations [that is, the PCT Regulations],” whereas paragraph (2) speaks in both of its two ((a) and (b) subparagraphs of “any time limit.” Practical experience has shown that there is some uncertainty about the meaning of the expression “any time limit” used in paragraph (2) and that, in particular, some interpret the latter expression as if it were also qualified by the words “fixed in this Treaty or the Regulations.” But since that qualification does not appear in paragraph (2), the meaning of “any time limit” is obviously broader in paragraph (2) than in paragraph (1) and, if correctly interpreted, “any time limit” appearing in paragraph (2) cannot but mean all the time limits relevant in a procedure covering an international application and not only time limits fixed in the PCT or the Regulations.

2. The proposed new Rule 82bis.1 is intended to make all this clear by referring to the various kinds of time limits falling within the realm of Article 48(2). There are three kinds of such time limits, and they are referred to in subparagraphs (i), (ii) and (iii) of the proposed Rule.

3. The first kind are the time limits fixed in the Treaty or the Regulations. They comprise in particular the time limits:

- for entering the national phase (Articles 22 and 39(1)),
- for electing a Contracting State in order to obtain the delaying effect of Chapter II of the PCT (Articles 39(1) (a) and 40(1)),
- for furnishing the application number of the earlier application the priority of which is claimed (Rule 4.10(c)),
- for complying with the invitation of the receiving Office to ask for the cancellation of the declaration of priority or for the correction of the filing date of the earlier application (Rule 4.10(d)),
- for furnishing certain indications in connection with microbiological inventions (Rule 13bis.4),
- for paying the basic fee, the designation fee and the search fee (Rules 15.4 and 16.1),

- for paying any amount charged to the International Bureau (Rule 16bis.2(a)),
- for submitting the priority document or requesting the receiving Office to transmit it (Rule 17.1),
- for furnishing papers completing the international application (Rule 20.2(a)(i)),
- for furnishing missing drawings (Rule 20.2(a) (iii)),
- for the record copy to be received by the International Bureau (Rule 22.3),
- for submitting arguments when the receiving Office intends to make a declaration under Article 14(4) (Rule 29.4),
- for withdrawing the international application, designations or the priority claim during the international phase (Rules 32.1(a) and 32bis.1(a)),

[Chapter 38]

Rule 82bis (New)

Excuse by the Designated or Elected State of Delays
in Meeting Certain Time Limits

82bis.1 Meaning of “Time Limit” in Article 48(2)

The reference to “any time limit” in Article 48(2) shall be construed as comprising a reference:

- (i) to any time limit fixed in the Treaty or these Regulations;
- (ii) to any time limit fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau or applicable by the receiving Office under its national
- (iii) to any time limit fixed by, or in the national law applicable by, the designated or elected Office, for the performance of any act by the applicant before that Office.

82bis.2 Provisions to which Article 48(2) Applies

The provisions of the national law which is referred to in Article 48(2) concerning the excusing of any delay in meeting any time limit are those provisions which provide for reinstatement of rights, restoration, restitutio in integrum or further processing in spite of non-compliance with a time limit, and any other provision providing for the extension of time limits or for excusing delays in meeting time limits.

[Chapter 38]

- for commenting on the abstract established by the International Searching Authority (Rule 38.2(a)),
- for requesting copies of documents cited in the international search report (Rule 44.3 (a)),
- for amending claims during the international phase (Rule 46.1),
- for requesting the sending of documents in the file (Rule 51.1),
- for paying the national fee and furnishing the appropriate translation (Rule 51.3),
- for amending the international application before the designated Office (Rule 52.1 (a) and (b)),
- for transmitting a translation of the international application to the International Preliminary Examining Authority (present Rule 55.2(b) and (d)),
- for paying the handling fee and the supplement to the handling fee (Rules 57.3, 57.4 and 57.5),
- for correcting defects in the demand or in later elections (Rules 60.1 and 60.2),
- for submitting a copy of the priority document and a translation thereof to the International Preliminary Examining Authority (present Rule 66. 7(c)),
- for requesting copies of documents cited in the international preliminary examination report (Rule 71.2(a)),
- for transmitting a translation of the annexes to the international preliminary examination report (Rule 74.1),
- for withdrawing the demand or elections (Rule 75.1(a)),
- for amending the international application before the elected Office (Rules 78.1(a) and 78.2)),
- for submitting evidence of mailing and a substitute document or letter (Rule 82.1(c)),
- for furnishing the contents of a document sent by certain means of communication (Rule 92.4(a)),
- for requesting certain changes (proposed Rule 92bis.2(b)).

[Chapter 38]

4. The second kind of time limits covered by Article 48(2) are the time limits fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, or applicable by the receiving Office under its national law, namely, the time limits:

- for paying the transmittal fee (Rule 14.1(b)),
- for making a late payment of the basic fee, the designation fee and the search fee (present Rules 15.4 and 16.1),
- for correcting defects under Article 11 (Rule 20.6(b)),
- for correcting defects under Article 14 (Rule 26.2),
- for paying additional fees to the International Searching Authority (Rule 40.3),

[Chapter 38]

Rule 82ter (New)

Rectification of Errors Made by the Receiving Office
or by the International Bureau

82ter.1 Errors Concerning the International Filing Date and the Priority Claim

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the declaration made under Article 8(1) has been erroneously cancelled or corrected by the receiving Office or the International Bureau, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the declaration under Article 8(1) had not been cancelled or corrected, as the case may be.

[Chapter 38]

- for commenting on the translation made by the International Searching Authority (Rule 48.3(b)),
- for paying the preliminary examination fee to the International Preliminary Examining Authority (Rules 58.1 and 58.2),
- for replying to a written opinion of the International Preliminary Examining Authority (Rule 66.2(d)),
- for restricting the claims or paying additional fees to the International Preliminary Examining Authority (Rule 68.2),
- for submitting a letter accompanying a paper to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau (Rule 92.1(b)).

5. The third kind of time limits covered by Article 48(2) are the time limits fixed by the designated or elected Office, or fixed in the national law applicable by that Office, for the performance of any act by the applicant before the said Office, in particular, the time limits:

- for adapting the international application to the requirements of the national law concerning utility models (Rules 6.5, 13.5 and 78.3),
- for furnishing drawings not necessary for the understanding of the invention (Rule 7.2),
- for furnishing certain indications in connection with microbiological inventions (Rules 13bis.4 and 13bis.7(a)),
- for furnishing a certified translation of the priority document, possibly together with a copy of the priority document (Rules 17.2(a) and 76.4),
- for furnishing certain elements of the international application in connection with the furnishing of the translation of the international application (proposed Rule 49.5(e) (i), (g) and (h)),
- for complying with certain requirements allowed under Article 27(1) , (2), (6) and (7) (proposed Rule 51bis).

6. The question arises during which procedural phase the excusing of the delay in meeting a time limit may take place. Article 48 (2) says that any Contracting State shall (subparagraph (a)) or may (subparagraph (b)), as far as that State is concerned, excuse the delay, which indicates clearly that it is during the national phase only that the excusing may take place. In other words, independent of whether the delay to be excused concerns a time limit pertaining to the international phase or a time limit pertaining to the national phase, the excuse procedure applies only during the national phase (and not during the international phase). The procedure would therefore, necessarily, take place before the designated or elected Office (or before a court or other competent body of the designated or elected State). Whenever that Office (or

court or other competent body) finds that the delay is to be excused, the consequence of the delay will be eliminated: for instance, if the time limit which was not met was the time limit within which the applicant had to correct a defect under Article 14 before the receiving Office and, as a consequence of the delay, the international application was considered withdrawn, the designated Office will maintain the effect of national application of the international application under Article 24(2); if the time limit which was not met was the time limit for entering the national phase, the international application will be processed in the designated State as if the time limit had been met.

7. The reasons for which delays must be excused under subparagraph (a) are not the same as the reasons for which delays may be excused under subparagraph (b) of Article 48(2): in the first case, the reasons are reasons admitted in the national law of the Contracting State whose organs (its national Office qua designated or elected Office and its courts or other competent body) are asked to excuse the delay, whereas, in the second case, the reasons are reasons other than reasons admitted in the national law. What these other reasons are is not specified; consequently, it may be any reason, including mistakes by others than the applicant, for instance, a mistake made by a PCT Authority.

8. *Ad Rule 82bis.2.* The proposed new Rule 82bis.2 is intended to enumerate the more common remedies that result in excusing delays in meeting time limits, namely, reinstatement of rights, restoration, restitutio in integrum and “further processing [of the international application] in spite of non-compliance with a time limit.” It is, furthermore, intended to make it clear that the said listing of certain remedies is not exhaustive: this is why the proposed draft speaks of “any other provisions.”

9. It should be understood that, for the purposes of Article 48(2), the provisions referred to in Rule 82bis.2 may be applied under the conditions set forth by the national law. If, for example, the remedy provided for by the national law is only available before the expiration of a certain time limit, the applicant will have to initiate the necessary proceedings within that time limit, as would be the case for a national application filed outside the PCT. However, since the provisions of the national law which deal with the excusing of delays in meeting time limits do not, in most cases, make reference to acts to be performed before an international authority under the PCT such as the receiving Office, for example but make reference to acts to be performed before the national Office, the provisions in question should be applied to an international application as if the international authority before which the act was not performed in due time were the national Office. This follows from the effect of an international application provided for under Article 11 (3). That effect of a regular national application in each designated State as of the international filing date makes it possible to apply national provisions to international applications as of the international filing date since international applications are equal to national applications as of that date. If the national provision is worded in such a way that it is limited to the procedure before the national Office which acts as a designated Office, the provision must be applied *mutatis mutandis*, which follows from Article 48(2) (a). The purpose of Article 48(2) (a) is to oblige the Contracting States to extend the benefit of all excuse provisions existing under national law for the benefit of national applications to international applications in order to assure an equal treatment of applicants, be they national applicants or PCT applicants. If, for example, the applicant fails to pay a filing fee or to correct a defect within a certain time limit and if such failure can be excused for national applications, it must, likewise, be excused for international applications.

[Chapter 38]

10. *Ad Rule 82ter.1.* Experience has shown that errors made by the receiving Office or by the International Bureau but which do not lead to a delay in meeting a time limit may have adverse consequences for the applicant without any possibility under the Treaty and the Regulations to rectify such error in the national phase.

11. The first case may be illustrated by following example: The receiving Office considers erroneously a replacement sheet as a later submitted sheet under Rule 20.2 and accords as international filing date the date of receipt of the replacement sheets or errs otherwise in the date which is accorded as the international filing date. Such date, if later than the date which should have been accorded as international filing date, might have negative consequences for a priority claimed if the erroneous date is later than 12 months from the priority date, or it might otherwise affect the novelty of the invention. The purpose of the proposed new Rule 82ter.1 is to provide a mechanism for rectification of such errors made by the receiving Office.

12. The second case which might have consequences similar to those referred to in the preceding paragraph is an error made by the receiving Office or the International Bureau in cancelling or correcting a priority claim under Rule 4.10(d). If the applicant can prove that the filing date of an earlier application is different from what has been decided by the receiving Office or the International Bureau to be the priority date, or that the declaration claiming priority has been erroneously cancelled, the designated or elected Office should rectify the error and proceed on the basis of the rectification. Rule 82ter.1 will apply only in very few cases, but those cases may be very important for the applicant and he should not have to bear the negative consequences of an error made by the receiving Office or the International Bureau.

13. In any case, it would be advisable for an applicant facing one of the two situations covered by the proposed new Rule 82ter.1 to first try to obtain, during the international phase, the correction of what he considers to be an error of a PCT Authority. For that purpose, he should address himself to the Authority which took the allegedly erroneous decision in order to obtain the requested rectification, and should have recourse to any remedy available under the national law applicable to that Authority. Thus, it is only in the case where he would not succeed in obtaining the rectification during the international phase that the remedy proposed in Rule 82ter.1 would become necessary.

[Annex follows]

ANNEX

(Extract from document PCPI/P 41/79 Rev.4, Annex 16)

PCT RULES 34.1(c) (vi) and 34.1(e): PATENT DOCUMENTS IN THE
SPANISH LANGUAGE

prepared by the International Bureau

1. During its first session held in September 1982 the PCT Committee for Administrative and Legal Matters (PCT/CAL) discussed proposed amendments to PCT Rules 34.1(c) (vi) and 34.1(e) to refer also to patent documents published in the Spanish language. Those discussions were based upon a preparatory document prepared by the International Bureau, document PCT/CAL/I/4 pages 36 and 37, reproduced as Appendix I* to this Annex. The conclusions of the PCT/CAL were given in the report of the session, document PCT/CAL/I/9, paragraph 49, reproduced as Appendix II* to this Annex.
2. Appendix III to this Annex gives statistical information, in so far as it is available, concerning the number of patent documents published in the Spanish language in each of the years 1979 to 1981. Figures are given in respect of patents granted to residents of the countries concerned. Additionally, for Cuba, Mexico, Spain and Uruguay, figures are available giving the number of patent grants in which no priority is claimed, and such figures are indicated in brackets in Appendix III. No figures are given in respect of published patent applications since no Spanish speaking country publishes patent applications.
3. It is noted that the average number of patents granted per year in Spanish speaking countries to residents of those countries is 3,110. For those above stated four countries, the average number of patents granted in those countries in which no priority is claimed is 1.57 times the number of patents granted to residents in those countries. Accordingly, it can be safely deduced that the number of patents granted in Spanish speaking countries in which no priority is claimed is 1.57 times 3,110, or just under 5,000 per year. The proposed amendment to Rule 34.1(c) (vi) could thus result in an additional 5,000 documents at the most to be included in the PCT Minimum Documentation each year, or less than one percent of the annual increase of the said documentation.
4. It should be noted, however, that such documents would only fall within the PCT Minimum Documentation if the condition of Rule 34.1(c) (vi) is met, viz. that "the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority". No Spanish speaking country presently prints or otherwise publishes patent documents in multiple copies. Copies of patent documents are made available only upon request.

* Not reproduced in this Annex to document PCT/A/XI/5.

5. Furthermore, the proposed amendment to PCT Rule 34.1(e) reduces even further the already rather small number of patent documents in the Spanish language which might have to be included in the PCT minimum documentation, since it limits such inclusion to those documents for which English language abstracts are generally available. The International Bureau is aware of only one source making English-language abstracts of Spanish language patent documents generally available, viz. Chemical Abstracts Service (CAS). In the years 1979 to 1981, CAS published English language abstracts of the patent documents published by Argentina, Cuba, Mexico and Spain at the rate of approximately 200 per year, or 0.04% of the estimated maximum annual increase in the number of patent documents forming the PCT Minimum Documentation.

6. The PCT/CTC is invited to consider the technical questions raised by the above proposed amendments to PCT Rules 34.1(c) (vi) and 34.1(e).

(Annex 16, Appendix III of document PCPI/P 41/79 Rev. 4)

PATENTS GRANTED IN SPANISH-SPEAKING COUNTRIES 1979-1981

COUNTRY	1979 RESIDENTS	1980 RESIDENTS	1981 RESIDENTS	AVERAGE NUMBER OF GRANTS TO RESIDENTS
ARGENTINA	1 244	1 590	820	1 218
BOLIVIA	20	9	6	12
CHILI	-	71	-	71
COLOMBIA	36	12	-	24
COSTA RICA	6	13	8	9
CUBA	-	84 (140)	32 (151)	58 (69)
DOMINICAN REPUBLIC	-	-	-	-
ECUADOR	7	1	3	4
EL SALVADOR	6	5	-	6
EQUATORIAL GUINEA	-	-	-	-
GUATEMALA	-	-	-	-
HONDURAS	0	2	-	1
MEXICO	236	165 (408)	188	197 (408)
NICARAGUA	-	-	-	-
PANAMA	-	9	-	9
PARAGUAY	-	-	-	-
PERU	37	31	32	34
SPAIN	1 569 (2 560)	1 485 (2 041)	1 115 (1 576)	1 389 (2 059)
URAGUAY	15 (44)	41 (71)	21 (70)	27 (62)
VENEZUELA	39	55	58	51
			TOTAL	3 110 (2 625)

Note: Figures in brackets refer to the number of patents granted in which no priority was claimed.

(Extract from document PCT/CTC/V/2)

Patent documents in the Spanish language

13. The Committee based its discussions on Annex 16 of Project file P 41 and noted that the PCT Committee for Administrative and Legal Matters had referred this question to it for consideration of the technical questions involved with the proposed amendments of PCT Rules 34.1(c) (vi) and 34.1(e).

14. The Committee noted with satisfaction a declaration by the Special Observer of Spain, in respect of paragraph 4 of Annex 16 that his Office had for several years distributed and exchanged copies of its currently issuing patent documents in the form of microfiches. It was further noted that Spain had microfilmed its whole backlog from 1968 in this form.

15. The Committee noted that if the proposed amendments to Rules 34.1(c) (vi) and 34.1(e) were adopted, the increase in the number of documents was likely to be relatively small vis-à-vis the yearly total of patent documents falling within the PCT Minimum Documentation*. Some of the delegations expressed the view that the inclusion of Spanish language documents could lead to an increase in quality of the results of the international search and also make the PCT system more attractive for Spanish speaking countries. It was felt, however, that only the documents published after the date of entry into force of the amendments to the said Rule, or published at the earliest two years before that date, should become part of the PCT Minimum Documentation, which would be in line with earlier decisions of the PCT Interim Committees in respect of the application of the Rule in similar cases.

16. The Committee agreed that if the proposed amendments to Rules 34.1(c) (vi) and 34.1(e) were adopted it would be necessary that the countries in question, i.e. Spain or the Spanish speaking Latin American countries, would make the sorted collections of Spanish language documents available in the form of one paper copy for insertion in the search files and one copy for the numerical collections which could be a copy in microform. The paper copy should be accompanied by an English language abstract. It was noted however that at present very few (approximately 200) English language abstracts of Spanish patent documents were generally available in any given year.

* *Note by the International Bureau.* According to the statistics of the years 1979, 1980 and 1981, the increase in the number of documents that would fall within the PCT Minimum Documentation if the proposed amendment to PCT Rule 34.1(c) (vi) would be adopted would be no more than 5,000 per annum. This is less than one percent of the annual increase of the number of patent documents that fall within the PCT Minimum Documentation as presently defined by PCT Rule 34.1(c).

17. The Special Observer of Spain said that it was the intention of his Office to prepare the sorted collections in exactly the way explained above i.e. one paper copy of each of its patents in which no priority is claimed, together with an English language abstract prepared by it and a numerical collection in the form of microfiches. The Committee noted this declaration with great interest.

18. As far as the proposal to insert in Rule 34.1(c) (vi), after the words “in which,” the words “or from which” is concerned it was observed that it was practically impossible for any Office to know at the time of publication whether further members of the same patent family existed. Later filings in other countries could be identified only two or three years later.

[End of Annex and of document]