

WIPO



PCT/AAQ/III/3
ORIGINAL: English
DATE: July 21, 1972

WORLD INTELLECTUAL PROPERTY ORGANIZATION
UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY
GENEVA

PATENT COOPERATION TREATY

INTERIM ADVISORY COMMITTEE FOR ADMINISTRATIVE QUESTIONS

Third Session: Geneva, October 4 to 9, 1972

REVISED EDITION OF OPTIONS FOR NATIONAL
LEGISLATIONS UNDER THE PATENT COOPERATION TREATY

Prepared by the International Bureau

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INTRODUCTION

1. The PCT Interim Advisory Committee for Administrative Questions (hereinafter referred to as "the Interim Committee"), in its first session held at Geneva in February 1971, invited the International Bureau to prepare "a document enumerating the options that the Patent Cooperation Treaty¹ allows for national legislations" (document PCT/AAQ/I/4, paragraph 15(i)).
2. The Interim Committee, in its second session held at Geneva in December 1971, examined the resulting draft document PCT/AAQ/II/2 entitled Options For National Legislations Under The Patent Cooperation Treaty and suggested certain changes thereto. The International Bureau was invited to prepare "a revised edition of the document" incorporating the changes suggested (see paragraphs 48 and 59 of the Report of the second session, document PCT/AAQ/II/6).
3. This revised edition was prepared in response to the invitation.
4. For the purposes of this revised edition, the term "national legislation" has been interpreted in its broadest sense. Consequently, whereas some of the chosen options must be implemented by a statute (meaning the law enacted by the legislative body of the State) others may be implemented by administrative measures (for example, by the regulations of the State's national (Industrial Property) Office), that is, by measures decided and promulgated by some organ of the executive branch of the State's Government. At least in connection with the option concerning the reservation as to the effect of the international application in respect of prior art (see paragraph 27), the term national "legislation" may include court decisions. In one case, the option must be exercised in a regional treaty (see paragraph 15). In another case, the option might be exercisable in a regional treaty (see paragraph 16). In five cases (see paragraphs 26 to 29 and 38), it must be reflected in a reservation under the PCT. It is to be noted that, whenever the PCT leaves a choice between two or more possible attitudes, one of them is inaction. Consequently, if a State does not take any positive action in connection with any of the options, the PCT still remains workable since it (the PCT) itself furnishes a solution which, in the absence of adoption of the other possible solution, or one of the other possible solutions, will apply. In a country in which the PCT would not be self-executing, the national law could not be silent on any matters offering an option to the Contracting States but must expressly provide for the solution preferred.
5. The present document enumerates 40 options (paragraphs 9 to 48) and 2 areas concerning which each Contracting State has an inherent right to legislate (paragraphs 49 to 50). Where appropriate, each option is presented according to the following scheme: the option is briefly described with reference to the applicable provisions of the Treaty or the Regulations;² then the choice of the State is defined; finally, the consequence of silence by the State on the point in question is indicated. There is also an indication of the way in which the option may or must be exercised. It should be noted that the summaries of the various provisions, because they are summaries, do not always reflect all the nuances of the texts of the Treaty and the Regulations.³ In any case, this document is not to be regarded as an official interpretation of those texts.

¹ In this document also called "the Treaty" or "the PCT."

² In this document, "the Regulations" means the Regulations under the Patent Cooperation Treaty.

³ In particular, it should be noted that references to patents must be construed as references also to inventors' certificates and that the receiving Office is not necessarily the national Office of the Contracting State but may, by agreement, be the national Office of another State, a regional Office, or an intergovernmental organization and, in turn, the references to a national Office must be construed as references also to such regional Office or intergovernmental authority.

6. The 40 options are grouped under four headings:
 - I. Options Open to a Contracting State qua Designated State (paragraphs 9 to 29)
 - II. Options Open to a Contracting State qua Elected State (paragraphs 30 to 39)
 - III. Options Open to a Contracting State as far as its National Office qua Receiving Office Is Concerned (paragraphs 40 to 46)
 - IV. Options Open to a Contracting State in Respect of National Applications (paragraphs 47 and 48)

7. It is to be noted that options open to a Contracting State qua designated State are also open to a Contracting State qua elected State as all elected States are also designated States for election is possible only in respect of designated States (see Article 31(4), last sentence).

8. The Interim Committee is invited to examine this revised edition and suggest any additional amendments thereto or make any additional comments thereon.

OPTIONS OPEN TO A CONTRACTING STATE QUA DESIGNATED STATE

9.1 Translations of International Applications. Any designated State which requires that a translation of the international application be furnished to it by the applicant must notify the International Bureau of the languages from which and the language into which it requires translation (see Article 22(1) and Rule 49.1). The language into which translation is required must be an official language. No translation, however, is required where the international application is already in one of several official languages, except where the use of one, other than the language of the international application, is prescribed for foreigners (see Rule 49.2).

9.2 Any Contracting State may decide that a translation into a certain language of any international application filed in another language be furnished to its national Office where such Office is a designated Office. (The limits and other details of this faculty are provided for in Rule 49.) Such decision, to be effective, must be notified to the International Bureau. No national law or regional treaty can require the applicant to furnish translation in more than one language, not even of part (for example, the claims) of the international application.

9.3 In the absence of such notification, the furnishing of a translation may not be required and the processing of the international application in the designated State will have to be effected on the international application in the language in which it was filed. The national Office of the designated State is free, however, in all other respects, to use the official language of the Office vis-à-vis the applicant of such international application.

10.1 Unsearched Parts of International Application. Where the international search report was not established on certain parts of the international application--because the application did not comply with the requirement of unity of invention and the applicant did not comply with the International Searching Authority's invitation to pay additional search fees--and the designated Office finds that the invitation was justified, such Office may consider the unsearched parts withdrawn unless a special fee is paid by the applicant to the designated Office (see Article 17(3)(b)).

10.2 Any Contracting State may decide that those parts of the international application which were not searched because of the reasons stated above must be considered withdrawn provided that the lack of searching was justified. Since, according to the Treaty, such withdrawal effect will not apply if the applicant pays a special fee, the Contracting State having made the said decision will have to allow the applicant to pay a special fee and thus avoid the withdrawal effect. The provision to that effect will have to fix the amount of the special fee and the time limit for payment thereof. The decision and the said details must be the subject of provisions in the national law.

10.3 If the national law is silent on the matter, even those parts of the international application which were not searched will not be considered withdrawn, provided that the lack of searching of certain parts of the application is only due to lack of unity of invention and lack of compliance with the justified invitation to pay additional fees. The same will apply even where the law provides that the unsearched parts must be considered withdrawn if the same law does not provide for--or does not specify the amount and a reasonable due date for the payment of--a special fee by the applicant to the designated Office.

11.1 Time Limit for Furnishing Designated Offices with Copy, Translation, Fee, and Data Concerning the Inventor. For the cases where the designated Office is to be furnished with a copy of the international application--this may be the normal requirement where the designated Office has chosen under Article 20(1)(a) to waive the requirement of communication of a copy of the international application in its entirety or in part, waiver in part meaning waiver in respect of copies of the international applications only or copies of the search reports (or declarations) only, but not meaning copies in a certain language only or relating to a certain technical field only or any like differentiation among copies--a translation thereof, a national fee, or data concerning the inventor, the time limit for doing so is 20 months from the priority date. In a special situation, namely, where the International Searching Authority declares that no

international search report will be established, the time limit for doing so is 2 months from the date of the notification sent to the applicant of the said declaration. However, any national law may fix time limits expiring later than those indicated (see Article 22).

11.2 Any Contracting State may decide to fix time limits expiring later than the 20 months (or the 2 months) in question. Such decision must be made through provisions in the national law.

11.3 If the national law is silent on the matter, the time limits in question (20 months, or 2 months) will apply.

12.1 "Provisional" Protection. The granting of provisional protection upon publication may, under the national law, be subject to the special conditions set forth below where the publication is an international publication.

12.2 The national law may provide that the effects of provisional protection shall be applicable when (i) a translation into the language of national publications has been published, or (ii) a translation into such language has been laid open to the public, or (iii) a translation into such language has been transmitted to an unauthorized user, or (iv) when certain combinations of the above events occur (see Article 29(2)).

12.3 The national law may provide that, where the international publication has been effected, on the request of the applicant before the expiration of 18 months from the priority date, the effects of provisional protection shall be applicable only from the expiration of 18 months from the priority date (see Article 29(3)).

12.4 The national law of any designated State may provide that the effects of provisional protection shall be applicable only from the date of receipt of a copy of the published international application by the national Office of that State (see Article 29(4)).

12.5 Any Contracting State may decide to subject "provisional protection" to any of the conditions admitted under Article 29(2) to (4). Such decision must be made through provisions in the national law.

12.6 If the national law is silent on the matter, provisional protection upon international publication will be governed by the same conditions as provisional protection upon national publication. The foregoing applies in the case of the option given to national law under Article 29(2) also to the extent that no translation may be required. It is understood that, where the national law does not provide for provisional protection in the case of the publication of national applications, there is no obligation to provide for provisional protection in the case of the international publication of international applications.

13.1 Time Limit for Amendments Before Designated Offices.

In any designated State in which processing or examination starts without special request, the applicant may, if he so wishes, exercise his right to amend the claims, the description and the drawings under Article 28(1) after the International Bureau has communicated to it the international application with the international search report (see Rule 47.1) and within 1 month from the date on which the applicant has fulfilled the requirements under Article 22 (i.e., after the copy, translation and fee have been furnished (they are generally furnishable within 20 months from the priority date)), provided that, if the said communication has not been effected by the expiration of the time limit applicable under Article 22, he must exercise the said right not later than 4 months after such expiration date. In either case, the applicant may also exercise the right of amendment at any other time if so permitted by the national law of the designated State (see Rule 52.1(a)).

13.2 Any Contracting State in which processing or examination starts without special request may decide to allow the applicant to exercise his right of amending his application before its national Office qua designated Office outside the time limits referred to above. Such decision must be made through provisions in the national law.

13.3 If the national law is silent on the matter, the said time limits will apply.

14.1 Priority in the Situations Contemplated by Article 8(2)(b).

An international application which claims the priority of one or more national applications filed in or for a Contracting State, or which claims the priority of an international application having designated only one Contracting State, may contain the designation of that Contracting State (see Article 8(2)(b)).

14.2 Any Contracting State may decide the conditions for, and the effects of such a priority claim in its national law.

14.3 In the absence of any provision on the matter in the national law, uncertainty would result as it would not be clear whether priority claims, made under the above circumstances, would be effective.

15.1 Automatic Designation of Countries by Virtue of Regional Treaties. If, under a treaty concerning a regional patent, the applicant cannot limit his application to certain of the States party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent will be treated as designation of all the States party to the said regional patent treaty (see Article 4(1)(ii), third sentence).

15.2 Any two or more States may decide, in a treaty concluded by them in respect of a regional patent, that any patent granted under such treaty will necessarily have effect on the territory of all of them, that is, that no patent granted under that treaty can have effect in less than all of such States. The effect of such decision will be that even if the applicant did not designate all the States in question, his application will be treated as if it had designated all of them. As already stated, the decision must be made through the provisions of a treaty.

15.3 In the absence of such provisions in a regional patent treaty, the designation of States in an international application, coupled with a request for a regional patent under that treaty, will result in the obtaining of a regional patent effective in those States which have thus been designated.

16.1 Obliging the Applicant to Obtain Regional Patent Instead of National Patent. Any treaty providing for the grant of regional patents ("regional patent treaty"), and giving to all persons entitled to file international applications the right to file applications for such patents, may provide that international applications designating or electing a State party to both the regional patent treaty and the PCT may be filed as applications for such patents (see Article 45(1)). The national law or the said designated or elected State may provide that any designation or election of such State in the international application has the effect of an indication of the wish of the applicant to obtain a regional patent under the regional patent treaty (Articles 4(1)(ii), fourth sentence, and 45(2)).

16.2 Any Contracting State may decide that, if it is designated or elected in an international application, such designation or election will have the effect of an indication of the wish of the applicant to obtain a regional patent under a regional patent treaty of the said kind to which the State is a party. The decision must be made through provisions in the national law. The national law will have to specify the applicable regional patent treaty.

16.3 If the national law of a country party to a regional patent treaty of the said kind is silent on the matter, the designation or election will be considered as if a patent is being sought via the national route unless the applicant indicates in the international application the wish to obtain a patent under the relevant regional treaty to which the Contracting State is also party.

17.1 Requirement that the Inventor Be the Applicant. The Treaty provides that "where the applicant, for the purposes of any designated State, is not qualified according to the national law of that State to file a national application because he is not the inventor, the international application may be rejected by the designated Office" (see Article 27(3)).

17.2 Any Contracting State may decide to require that the applicant be the inventor (that is, that the applicant cannot be a person other than the inventor (for example, his employer or his assignee)). The decision must be made through provisions in the national law. Such law, however, can be applied only by the national Office qua designated Office and not by the national Office qua receiving Office.

17.3 If the national law is silent on the matter, applications filed by persons (including legal entities) other than the inventor may not be rejected by the designated Office for the reason that they were not filed by the inventor.

18.1 Naming of the Inventor. As far as the need to name the inventor is concerned, (and furnish his address: see Rule 4.6) in or in connection with the international application, the Treaty deals with three possible solutions for the national law of any designated State: (i) the national law may require that the name (and address) of the inventor must be indicated when a national application is filed, (ii) the national law may require that the name (and address) of the inventor must be indicated but may allow that such indication be furnished at a time later than the filing of a national application, (iii) the national law may be silent on the matter (see Article 4(1)(v) and (4)).

18.2 Consequently, any Contracting State may decide to adopt any of the said three kinds of solutions, provided that where the national law adopts the second kind it cannot apply it before the expiration of the time limit applicable under Article 22 (that is, generally 20 months from the priority date) (see Article 22(1)). Where the national law adopts a solution requiring the naming of the inventor, absence of such naming could be a ground for rejecting the application under the national law.

18.3 If the national law is silent on the matter, the designated State will not be entitled to require the naming of the inventor (or his address) at any time.

19.1 Utility Models. Any designated State in which the grant of a utility model is sought on the basis of an international application may apply, in respect of matters relating to claims regulated in Rules 6.1 to 6.4 (number and numbering of claims, references to other parts of the international application, manner of claiming, dependent claims) or in respect of matters relating to unity of invention regulated in Rules 13.1 to 13.4 (requirement of unity of invention in general and with respect to claims of different categories, claims of one and the same category and dependent claims), the provisions of national law concerning utility models once the national processing has started in that State and provided that the applicant is allowed at least 2 months from the applicable time limit under Article 22 to adapt his application to the requirements of the national law (see Rules 6.5 and 13.5).

19.2 Any Contracting State may decide that the provision of national law shall apply in respect of the said matters to the grant of a utility model subject to the said provisos.

19.3 In the absence of such decision, the designated State will have to apply the matters regulated in Rules 6.1 to 6.4 in respect of claims and to apply the matters regulated in Rules 13.1 to 13.4 in respect of categories of claims permitted under unity of invention.

20.1 Drawings Other than Those Necessary for the Understanding of the Invention. The Treaty provides that any designated Office may require that the applicant file with it, within the prescribed time limit, drawings where, without their being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings (see Article 7(2)(ii)). (Where drawings are necessary for the understanding of the invention, they are required, by virtue of the Treaty itself, as part of the international application.)

20.2 Consequently, any Contracting State may decide to require or not to require drawings of the said kind. If it decides to require such drawings, the requirement may be written into its law or regulations, or may be the subject merely of an ad hoc decision of the designated Office. In any case, the requirement is applicable only after the processing of the international application in the designated Office has started. No national Office qua receiving Office can require the filing of drawings of the said kind.

20.3 The silence of the national law on the matter does not necessarily mean that drawings of the said kind may not be required since the requirement may, as indicated, be formulated ad hoc by the designated Office.

21.1 Amendments Going Beyond the Disclosure. In connection with all three possibilities of making amendments--that is, before the International Bureau, before the designated Office, and before the elected Office--the Treaty provides that amendments must not go beyond the disclosure in the international application as filed (see Articles 19(2), 28(2) and 41(2)) unless the national law of the designated or elected State permits them to go beyond the said disclosure (see Articles 19(3), 28(2) and 41(2)).

21.2 Consequently, any Contracting State may decide to admit amendments which go beyond the disclosure. The decision must be made through provisions in the national law.

21.3 If the national law is silent on the matter, amendments made under Articles 19(2), 28(2) and 41(2) within the prescribed time limits but going beyond the disclosure will not be admitted.

22.1 Furnishing Proof of Allegations Made in the International Application. The Treaty provides that any national law may require, once the processing of the international application has started in the designated Office, the furnishing of documents which are not part of the international application but which constitute proof of allegations or statements made in that application (see Article 27(2)(ii)). The Treaty itself names an example: when the international application, as filed, was signed by the applicant's representative or agent, the designated Office may require that the international application be confirmed by the signature of the applicant (ibidem).

22.2 Consequently, any Contracting State may decide to require the said kind of proof, provided that such requirements can be applied only by a national Office qua designated Office (and not qua receiving Office) and only once the processing of the international application has started in the national Office qua designated Office. (In other words, such proof (including the signature of the applicant himself) need not be furnished in the international application when filed or thereafter up to the starting of the national processing.) The decision must be made through provisions in the national law.

22.3 If the national law is silent on the matter, no such proof (including such signature) may be required in the national processing.

23.1 Naming an Officer Where Applicant Is a Legal Entity. The Treaty provides that any national law may require, once the processing of the international application has started in the designated Office, the furnishing, when the applicant is a legal entity, of the name of an officer entitled to represent such legal entity (see Article 27(2)(i)).

23.2 Consequently, any Contracting State may decide to require that, when the applicant is a legal entity, the name of an officer entitled to represent the said entity must be furnished, provided that such a requirement can be applied only by a national Office qua designated Office (and not qua receiving Office) and only once the processing of the international application has started in the national Office qua designated Office. (In other words, the name of such an officer need not be furnished in the international application when filed or thereafter up to the starting of the national processing.) The decision must be made through provisions in the national law.

23.3 If the national law is silent on the matter, the naming of such an officer cannot be required in the national processing.

24.1 Representation of the Applicant by a Qualified Agent.

The Treaty provides that "any receiving Office or, once the processing of the international application has started in the designated Office, that Office may apply the national law as far as it relates to any requirement that the applicant be represented by an agent having the right to represent applicants before the said Office" (see Article 27(7)).

24.2 Typical requirements are that applicants who are foreigners or are not residents of the country must be represented by an agent who is a national and a resident of the country, that such agent must have certain professional qualifications and/or must appear on a roster of persons qualified to exercise the profession of attorney or patent agent before the national Office of the country. These or any other requirements, present or future, are compatible with the Treaty.

24.3 Consequently, any Contracting State may decide to require that the applicant be represented before its national Office (qua receiving Office and/or qua designated Office) by an agent having the right to represent applicants before that Office. The decision must be made through provisions in the national law.

24.4 If the national law is silent on the matter, representation of the applicant before the national Office by a qualified agent cannot be required.

25.1 Address in the Country for Receiving Notifications by the Applicant.

The Treaty provides that "once the processing of the international application has started in the designated Office, that Office may apply the national law as far as it relates to any requirement...that the applicant have an address in the designated State for the purpose of receiving notifications" (see Article 27(7)).

25.2 Where the law requires that applicants who are foreigners or are not residents of the country must be represented by a local agent (see paragraph 22, above), the need for having an address in the country for the purpose of receiving notifications is met by the appointment of such agent.

25.3 Consequently, any Contracting State may decide to require that the applicant have an address in that State qua designated State for the purpose of receiving notifications. The decision must be made through provisions in the national law.

25.4 If the national law is silent on the matter, the applicant cannot be required by the designated Office to have an address in the country for receiving notifications.

26.1 Reservation as to the Requirement of the International Publication of the International Application. Any State may declare that, as far as it is concerned, international publication of international applications is not required (see Article 64(3)(a)).

26.2 The consequence of such a declaration is that, where, at the expiration of 18 months from the priority date, the international application contains the designation only of such States as have made such a declaration, the international application is not going to be published by the International Bureau. Nevertheless, even such an international application will be published by the said Bureau.

(i) at the request of the applicant
(ii) when an application or a patent based on the international application is published by or on behalf of the national Office of any designated State having made the declaration in question (see Article 64(3) and Rules 48.2(g) and 48.4).

26.3 Any State, irrespective of its national law, may decide to make such a declaration.

26.4 In the absence of such a declaration, the international publication of the international application will take place promptly after the expiration of 18 months from the priority date of that application or, where the applicant has asked the International Bureau to publish his international application before that date, promptly after the applicant has asked for such publication (see Article 21 and Rule 48.4).

27.1 Reservation as to the Effect of the International Application in Respect of Prior Art. Any State whose national law--it being understood that for prior art purposes "national law" may consist also of court decisions--is as described below may declare that the filing outside that State of an international application is not equated to an actual filing in that State for prior art purposes. At the time of making such a declaration, the State must also state in writing (to be notified to the Director General of WIPO) the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State (this statement may be modified subsequently; see Article 64(4)).

27.2 The effect of such a declaration cum statement is that the prior art effect of any international application designating that State will become effective in that State from the date, and under the conditions, which are set forth in the said statement.

27.3 This reservation may be made only by States whose national laws provide for prior art effect of their patents as from a date prior to publication but do not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State (see Article 64(4)(a)).

27.4 In the absence of such provision in the national law or such a declaration cum statement, the filing of an international application, even if effected outside the designated State, will be equated to an actual filing in that State also for prior art purposes.

28.1 Reservation as to the Jurisdiction of the International Court of Justice. Any State may declare that it does not consider itself bound by Article 59, an article which provides for the jurisdiction of the International Court of Justice in cases of disputes between Contracting States concerning the interpretation or application of the Treaty or the Regulations (see Article 64(5)).

28.2 The consequence of such a declaration is that, in the case of a dispute, such a State cannot be assigned (as a defendant) before the International Court of Justice (unless that State expressly and voluntarily agrees thereto).

28.3 Any State, irrespective of its national law, may decide to make such a declaration.

28.4 In the absence of such a declaration, the Contracting State will be bound by Article 59 providing for the jurisdiction of the International Court of Justice in cases of dispute between Contracting States concerning the interpretation or application of the Treaty or the Regulations.

29.1 Reservation as to Chapter II of the PCT. Any State may declare that it shall not be bound by the provisions of Chapter II (see Article 64(1)). Chapter II deals with international preliminary examination.

29.2 The effect of such a declaration is that the Contracting State will not be bound by Chapter II. Consequently:

- (i) such a Contracting State cannot be elected (see Article 31(4)(b)).

- (ii) the residents or nationals of such a Contracting State cannot ask for their international applications to be the subject of international preliminary examination:
- (a) unless--being residents or nationals (also) of another Contracting State which is bound by Chapter II--they file their international applications in such State (see Article 31(2) (a));
 - (b) unless the Assembly of the PCT Union decides that residents or nationals of such a Contracting State may demand that their international applications be the subject of international preliminary examination; such residents or nationals may elect only such Contracting States bound by Chapter II as have declared that they are prepared to be elected by such applicants (see Article 31(4) (b)).

29.3 Any State, irrespective of its national law, may decide to make such a declaration.

29.4 In the absence of such a declaration, the Contracting State will be bound by Chapter II.

II

OPTIONS OPEN TO A CONTRACTING STATE QUA ELECTED STATE

30.1 Translations of International Applications. Any elected State which requires that a translation of the international application be furnished to it by the applicant must notify the International Bureau of the languages from which and the language into which it requires translation (see Article 39(1) and Rule 76.1). The language into which translation is required must be an official language. No translation, however, is required where the international application is already in one of several official languages, except where the use of one, other than the language of the international application, is prescribed for foreigners (see Rule 76.2).

30.2 Any Contracting State may decide that a translation into a certain language of any international application filed in another language be furnished to its national Office where such Office is an elected Office. (The limits and other details of this faculty are provided for in Rule 76.) Such decision to be effective, must be notified to the International Bureau. No national law or regional treaty can require the applicant to furnish translation in more than one language, not even of part (for example, the claims) of the international application.

30.3. In the absence of such notification, the furnishing of a translation may not be required and the processing of the international application in the elected State will have to be effected on the international application as filed (i.e., in the language in which it was filed). The national Office of the elected State is completely free, in all other respects, to use the official language of the Office vis-à-vis the applicant of such international application.

31.1 Unexamined Parts of International Application. Where the international preliminary examination report was not established on certain parts of the international application because the application did not comply with the requirement of unity of invention, and

- (a) the applicant complied with the International Preliminary Examination Authority's invitation and chose to restrict the claims and the national law so provides (see Article 34(3)(b)), or
- (b) the applicant did not comply with the International Preliminary Examining Authority's invitation to restrict the claims or to pay additional fees and the elected Office finds that the invitation was justified (see Article 34(3)(c)).

the elected State may consider the unexamined parts withdrawn unless a special fee is paid by the applicant to the elected Office.

31.2 Any Contracting State may decide that those parts of the international application which were not examined because of the reasons stated above must be considered withdrawn provided that in the case of Article 34(3)(c) the lack of examination was justified. Since, according to the Treaty, such withdrawal effect will not apply if the applicant pays a special fee, the Contracting State having made the said decision will have to allow the applicant to pay a special fee and thus avoid the withdrawal effect. The provision to that effect will have to fix the amount of the special fee and the time limit for payment thereof. The decision and the said details must be the subject of provisions in the national law.

31.3 If the national law is silent on the matter, even those parts of the international application which were not examined will not be considered withdrawn provided that the lack of examining of certain parts of the application is only due to lack of unity of invention and, in the case of Article 34(3)(c), the invitation was justified. The same will apply even where the law provides that the unexamined parts must be considered withdrawn if the same law does not provide for--or does not specify the amount and a reasonable due date for the payment of--a special fee by the applicant to the elected Office.

32.1 Time Limit for Furnishing Elected Offices with Copy, Translation, and Fee. For the cases where a copy of the international application or a translation thereof has to be furnished, or a national fee has to be paid, to the elected Offices, the time limit for doing so is 25 months from the priority date. However, any national law may fix time limits expiring later than the 25 months in question (see Article 39).

32.2 Any Contracting State may decide to fix time limits expiring later than 25 months from the priority date. Such decision must be made through provisions in the national law.

32.3 If the national law is silent on the matter, the time limit of 25 months from the priority date will apply. See, however, paragraph 38, below.

33.1 Languages of the International Preliminary Examination Report. Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office, be translated into English, French, German, Japanese, Russian or Spanish, provided it has notified the International Bureau of any such requirement (see Rule 72.1).

33.2 Any Contracting State may decide to require that any international preliminary examination report which was established in a language other than the official language or one of the official languages of its national Office be translated into English, French, German, Japanese, Russian or Spanish. Such decision, to be effective, must be notified to the International Bureau.

33.3 In the absence of such notification, no translation of the international preliminary examination report may be required by the elected Office.

34.1 Time Limit for Amendments Before Elected Offices. Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the applicant may, if he so wishes, exercise his right to amend the claims, the description, and the drawings under Article 41(1) after the transmittal of the international preliminary examination report and before the expiration of the time limit applicable under Article 39 (generally, 25 months from the priority date), provided that if the said transmittal has not taken place by the expiration of the time limit applicable under Article 39, he must exercise the said right not later than on such expiration date. In either case, the applicant may also exercise the said right at any other time if so permitted by the national law of the elected State, (see Rule 78.1(a)).

34.2 Any Contracting State may decide to allow the applicant to exercise his right of amending his application before its national Office qua elected Office outside the time limits referred to above. Such decision must be made through provisions in the national law.

34.3 If the national law is silent on the matter, the time limits referred to above will apply.

35.1 Utility Models. Any elected State in which the grant of a utility model is sought on the basis of an international application may apply, in respect of matters relating to claims regulated in Rules 6.1 to 6.4 (number and numbering of claims, references to other parts of the international application, manner of claiming, dependent claims) or in respect of matters relating to unity of invention regulated in Rules 13.1 to 13.4 (requirement of unity of invention in general and with respect to claims of different categories, claims of one and the same category and dependent claims), the provisions of national law concerning utility models once the national processing has started in that State and provided that the applicant is allowed at least 2 months from the applicable time limit under Article 22 or, where the election was made before the expiration of the 19th month, the applicant is allowed at least 2 months from the applicable time limit under Article 39 to adapt his application to the requirements of the national law (see Rule 78.3).

35.2 Any Contracting State may decide that the provisions of national law shall apply in respect to the grant of a utility model subject to the said provisions. Such decision to be effective must be announced by the Contracting State.

35.3 In the absence of such decision, the elected State will have to apply the matters regulated in Rules 6.1 to 6.4 in respect of claims and to apply the matters regulated in Rules 13.1 to 13.4 in respect of categories of claims permitted under unity of invention.

36.1 Effect of the Withdrawal of the Demand for International Preliminary Examination or of the Election of a Given State. Withdrawal of the demand for international preliminary examination has the same effect as if the international application had been withdrawn in respect of all elected States, and withdrawal of the election of a given State has the same effect as if the international application had been withdrawn as far as that State is concerned, except if the withdrawal is effected prior to the expiration of the applicable time limit under Article 22 (that is, generally, prior to the expiration of 20 months from the priority date). This is the rule. It means that if the withdrawal is effected within the said time limit, any elections become mere designations. However, any Contracting State may, as far as it is concerned, make one of the following two exceptions to the rule: (i) it may provide that the transformation of the election into a designation (by means of a withdrawal) will take place only if its national Office receives, within the said time limit, a copy of the international application, together with a translation thereof (if one is prescribed), and the national fee (see Article 37(4)(b)); or (ii) it may provide that the said transformation will take place without any time limit or condition (see Article 37(4)(a)).

36.2 Any Contracting State may decide that withdrawal of the demand or of the election of that State is not to be considered to be withdrawal of the international application if such withdrawal is effected prior to the expiration of the applicable time limit under Article 22 (that is, generally, prior to the expiration of 20 months from the priority date), but only if its national Office has received, within the said time limit, a copy of the international application, together with a translation (if required) and the national fee. Alternatively, any Contracting State may decide that the withdrawal of the demand or its election will transform the election into a designation, irrespective of when it was effected and without any conditions. Either decision must be made through provisions in the national law.

36.3 If the national law of any Contracting State is silent on the matter, withdrawal of the demand or of the election of that State will:

- (i) if effected prior to the expiration of the applicable time limit under Article 22, have the effect of transforming the election into a designation;
- (ii) if effected beyond the said time limit, have the effect of withdrawal of the international application for the purposes of that State.

37.1 Contracting States Electable by Certain Applicants. The Assembly of the PCT Union may decide to allow persons entitled to file international applications (i.e., residents or nationals of Contracting States or of such non-Contracting States party to the Paris Convention as are specified by the Assembly) to make a demand for international preliminary examination even if they are residents or nationals of a State not party to the PCT or not bound by Chapter II. Such applicants, however, may elect only such Contracting States as have declared that they are prepared to be elected by the said applicants (see Article 31(4)(b)). The declaration must be made to the Director General, who notifies all member countries of the Paris Union thereof (see Article 69(vii)).

37.2 Any Contracting State bound by Chapter II may decide that it is prepared to be elected by such applicants as are referred to above. Such decision, to be effective, must be notified to the Director General.

37.3 If the Contracting State is silent on the matter, applicants referred to above may not elect that State.

38.1 Reservation as to Certain Time Limits in Chapter II. Any State bound by Chapter II may declare that (i) it shall not be bound by the provisions of Article 39(1) with respect to the furnishing of a copy of the international application and the translation thereof (as prescribed), (ii) the obligation to delay national processing, as provided for under Article 40, shall not prevent publication, by or through its national Office, of the international application or a translation thereof, it being understood however, that such State is not exempted from the limitations provided for in Articles 30 and 38 (see Article 64(2) (a)).

38.2 The effects of such a declaration are those stated in the declaration. Consequently,

- (i) applicants electing such a State will have to furnish to the national Office qua elected Office of that State a copy and (where applicable) the required translation of their international applications within the time limit (generally, 20 months from the priority date) applicable under Article 22 rather than the time limit (generally, 25 months from the priority date) provided for in Article 39(1); and
- (ii) the national Office of the elected State may publish the international application (and/or its translation) before the expiration of the time limit (generally, 25 months from the priority date) applicable under Article 39, provided, however, that no national Office shall generally publish an international application or its translation before the international publication or, if international publication has not taken place by the expiration of 20 months from the priority date, before the expiration of 20 months from the said priority date.

38.3 Any State, irrespective of its national law, may decide to make such a declaration.

38.4 In the absence of such a declaration, the Contracting State will be bound by the provisions of Articles 39 and 40.

39.1 Amendments Going Beyond the Disclosure. See paragraph 21, above.

III

OPTIONS OPEN TO A CONTRACTING STATE AS FAR AS
ITS NATIONAL OFFICE QUA RECEIVING OFFICE IS CONCERNED

- 40.1 Request Forms. The request (a part of the international application) must be made on a printed form. Copies of the printed form must be furnished free of charge to the prospective applicants by the receiving Office, unless the receiving Office chooses to require that such copies be furnished by the International Bureau (see Rules 3.1 and 3.2).
- 40.2 Any receiving Office may decide that it will not itself furnish request forms to prospective applicants. Such decision will have to be announced.
- 40.3 In the absence of such announcement, the receiving Office will itself have to furnish request forms to prospective applicants.
- 41.1 Number of Copies of International Application. The international application must be filed in one copy, unless the receiving Office chooses to require that it be filed in two or three copies (see Rule 11.1(b)). Where the filing of only one copy is required, the receiving Office must prepare the required home copy and/or search copy and where the filing of only two copies is required, the receiving Office must prepare the required home copy. A fee may be charged to the applicant for the preparation of the additional copies (see Rule 21.1(a)). No special fee is provided for under Rule 11.1(b) for the verifying of the identity of copies where two or three copies are required to be filed but the cost of checking may be taken into account when fixing the amount of the transmittal fee (see Rule 14.1).
- 41.2 Any receiving Office may decide to require that international applications must be filed with it in two or three copies. Such decision will have to be announced.
- 41.3 In the absence of such announcement, the receiving Office will have to accept international applications filed in one copy (it will then have to prepare two more copies itself). It may accept two or three copies (but then it will have to check the identity of all copies) or it may refuse any additional copies (but then it will have to prepare the additional copies needed).
- 42.1 Language of the International Application. If the International Searching Authority competent for the searching of international applications filed with the receiving Office has agreed to work in several languages, the receiving Office may specify one or more of these languages as the language(s) in which international applications must be filed with it (see Rule 12.1).
- 42.2 Where the competent International Searching Authority works in more than one language, the receiving Office may decide not to accept international applications in all--but only in one or some--of the languages agreed upon by the competent International Searching Authority. Such decision will have to be announced.
- 42.3 In the absence of an announcement by the receiving Office prescribing a certain language, it will have to accept international applications written in any of the languages stipulated in the agreement between the competent International Searching Authority and the International Bureau.
- 43.1 Transmittal Fee. Any receiving Office may require that the applicant pay a fee ("transmittal fee") to it for the services it performs as receiving Office. If such transmittal fee is introduced, its amount and due date must be fixed (see Rules 14.1 and 86.1(ii)).
- 43.2 The receiving Office may decide to require payment of a transmittal fee, and, if it does, it will have to fix its amount and due date. It will have to announce its decision.
- 43.3 In the absence of such announcement, the receiving Office will not be able to collect a transmittal fee.

44.1 Transmittal of Record Copy. The record copy of the international application must be transmitted to the International Bureau. Such transmittal is effected by the receiving Office, unless the receiving Office decides to provide that the transmittal will be effected by the applicant himself if he so desires (see Rules 22.1 and 22.2).

44.2 Any receiving Office may decide to follow the procedure described in Rule 22.2 allowing the applicant to choose between transmittal of the record copy by the receiving Office and transmitting it himself. Such decision will have to be announced by the receiving Office.

44.3 In the absence of such announcement, transmittal will follow the procedure described in Rule 22.1 (no option for the applicant; transmittal by the receiving Office).

45.1 Due Date of Certain Fees. The basic fee part of the international fee and the search fee must be paid on the date of receipt of the international application. This is the rule. However, any receiving Office may, if it so desires, notify the applicant of any lack of receipt or insufficiency of any amount received and permit later payment, provided it is not later than within 1 month from the date of receipt of the international application (see Rules 15.4(a) and 16.1(b), last sentence).

45.2 Any receiving Office may decide that it will notify the applicant whenever it has not received the basic fee part of the international fee and/or the search fee, or whenever the amount received was insufficient to cover the said fees, and that it will permit him to make or complete the payment within a certain period of time. (N.B.: The deadline cannot be fixed beyond one month from the date of receipt of the international application.) Such decision will have to be announced. (N.B.: The Regulations deal only with the basic fee part of the international fee and with the search fee but there is no provision in the Regulations which would prohibit an analogous decision in the case of any other fees, in particular the transmittal fee. The situation, however, is different for the supplement of the search and preliminary examination fees; see paragraphs 10 and 31.)

45.3 In the absence of such announcement, applicants will have to assume that they will not be notified by the receiving Office of any lack of receipt or insufficiency of any amount received of the basic fee part of the international fee and the search fee, and that there is no "grace period" for making or completing the payment of these fees.

46. Representation of the Applicant by a Qualified Agent. See paragraph 24, above.

IV

OPTIONS OPEN TO A CONTRACTING STATE
IN RESPECT OF NATIONAL APPLICATIONS

47.1 International-Type Search on the Initiative of the National Office. If the national law of the Contracting State so permits, the national Office of such State may subject any national application filed with it to an international-type search (see Article 15(5)(b)). If the national application is in a language which the competent International Searching Authority considers it is not equipped to handle, the international-type search will be carried out on a translation prepared by the applicant in a language prescribed for international applications and which the International Searching Authority has undertaken to accept for international applications. The national application and the translation (when a translation is required) must be presented in the form prescribed for international applications (see Article 15(5)(c)).

47.2 Any Contracting State may decide to require that national applications must be subjected to an international-type search. Such decision must be made through provisions in the national law. The conditions to be provided for in the national law should provide for appropriate fees (if any) and appropriate time limits.

47.3 If the national law is silent on the matter, the national Office may not subject national applications to international-type searches having the effects provided for in the Treaty.

48.1 International-Type Search on the Initiative of the Applicant. If the national law of the Contracting State so permits, the applicant who files a national application with the national Office of such State may, subject to the conditions provided for in such law, request that a search similar to an international search ("international-type search") be carried out on such application (see Article 15(5)(a)). If the national application is in a language which the competent International Searching Authority considers it is not equipped to handle, the international-type search will be carried out on a translation prepared by the applicant in a language prescribed for international applications and which the International Searching Authority has undertaken to accept for international applications. The national application and the translation (when a translation is required) must be presented in the form prescribed for international applications (see Article 15(5)(c)).

48.2 Any Contracting State may decide to allow applicants who file national applications in that State to request that international-type searches be carried out on such applications. Such decision must be made through provisions in the national law. The conditions to be provided for in the national law should provide for appropriate fees (if any) and time limits. Where any Contracting State has exercised the option mentioned in paragraph 47 and requires that national applications must be subject to an international-type search, there would be no reason to exercise the option set forth in this paragraph.

48.3 If the national law is silent on the matter, no applicant will be able to ask for an international-type search on national applications.

V

SUBSTANTIVE CONDITIONS OF PATENTABILITY

49.1 The PCT provides that "nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires" (see Article 27(5)).

49.2 Typical substantive conditions of patentability are that the invention must be new, that it must represent an inventive step (that is, must be non-obvious), and that it must be useful or industrially applicable. However, since the freedom of each Contracting State in matters of the substantive conditions of patentability is complete, whether any of these conditions, or any other substantive condition of patentability, is incorporated in the national law of any Contracting State is of no importance as far as compliance with the Treaty is concerned. The same is true in respect of the definitions given to any of the said concepts. For example, the concept of novelty is usually defined as something new in relation to "prior art." The notion of "prior art" is particularly important in practice. It is defined, in the Treaty, for the purposes of international search and international preliminary examination. However, it is only for those purposes that it is defined and not for the purpose of patentability (cf. Article 33(3)). In order to emphasize that with regard to the latter purpose--the only purpose in which the national law is interested--the freedom of each Contracting State is complete, Article 27(5) also provides that "any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art."

49.3 Among other conditions of patentability "not constituting requirements as to the form and contents of applications" (see Article 27(5), in fine), there is also the important one which specifies that the invention must concern a technological or scientific field not excluded from the fields concerning which patents may be granted. For example, there is nothing in the Treaty which would prevent any Contracting State from excluding from patentability inventions in the field of medicaments or food-stuffs.

49.4 Further examples of substantive conditions of patentability are that the invention must not have been known, used, patented, described or abandoned by certain persons within certain time limits and in certain countries. Another substantive condition of patentability is constituted by the solution given to the question whether the patent should go to the person who was the first to apply for protection or the first to invent, or whether a certain combination of these circumstances should obtain. In all these respects, it is repeated, Contracting States have complete freedom to adopt the solution or system they wish to adopt.

49.5 Such freedom applies also in respect of the proof of patentability: Article 27(6) provides that "the national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law."

VI

PRESERVATION OF NATIONAL SECURITY
AND GENERAL ECONOMIC INTEREST

50.1 Any Contracting State may apply measures deemed necessary for the preservation of its national security or to limit, for the protection of the general economic interests of that State, the right of its own residents or nationals to file international applications (see Article 27(8)).

50.2 Typical measures of this type are the requirement of obtaining by the applicant the permission to file an application abroad or the requirement of filing an application for the protection of an invention in the home country before the protection for the same invention is applied for abroad.

50.3 It is understood that Article 27(8) could be applied by any Contracting State to its residents or nationals regardless of where the international application is filed.

50.4 However, the Treaty does not require any Contracting State to legislate on the matter in any way whatsoever.

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