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DRAFT
PROPOSED AMENDMENTS TO CERTAIN TIME LIMITS
IN THE PCT AND TO THE REGULATIONS
UNDER THE PCT

FIRST OF THREE PREPARATORY MEMORANDA OF THE INTERNATIONAL BUREAU

INTRODUCTION

General

1. The PCT Committee for Administrative and Legal Matters (hereinafter referred to as “the Committee”) held its first session from September 6 to 10, 1982, in Geneva. The Committee considered proposals for amending certain time limits in the PCT and for amending a number of the Rules of the Regulations under the PCT. Those proposals were contained in documents PCT/CAL/I/2, 3, 4, 6 and 7. Documents PCT/CAL/I/2, 3 and 4 had been prepared by the International Bureau in the framework of its study of possible improvements to the PCT, entrusted to that Bureau by the Assembly of the International Patent Cooperation Union – (PCT Union) in its seventh session (see document PCT/A/VII/15, paragraphs 54 to 64). Documents PCT/CAL/I/6 and 7 contain proposals submitted to the Committee by the Delegations of Norway and Sweden, respectively. The Delegation of the Netherlands also submitted proposals, contained in document PCT/CAL/I/8, but their consideration was deferred to the second session of the Committee.

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2. The present document is the first one of three documents prepared for the second session of the Committee. They contain revised proposals for amendments, prepared with due regard to the report of the first session of the Committee (see document PCT/CAL/I/9, paragraphs 12 to 60), and to the observations, as noted by the Secretariat, made by the Delegations represented in the first session of the Committee.

3. The present document and document PCT/CAL/II/3 (scheduled to be available in January 1983) contain all proposals related to the international phase, whereas document PCT/CAL/II/4 (scheduled to be available in February 1983) contains the proposals related to the national phase. As a consequence, the order in which the proposed amendments appear in documents PCT/CAL/II/2 to 4 is different from the order in which they appeared in documents PCT/CAL/I/2 to 4. All proposed amendments which have been approved by the Committee during its first session are, for the sake of completeness, repeated in the new documents and the fact that they have already been approved is indicated. The explanations of each proposed amendment are preceded by an indication whether the proposal has been revised or not and by a reference to the documents of the first session of the Committee.

4. The presentation of the proposed amendments follows the manner adopted for the first session of the Committee, namely, where a proposal concerning a given subject matter requires that several Rules be amended, the proposed amendments are presented together, as a group (each such "chapter" is numbered with Arabic numerals to distinguish it from the numbering in Roman numerals used for the first session). Where an existing Rule deals with several subject matters, proposed amendments to such a Rule may appear, in any one of the three documents, in different places; in all such places, however, appropriate cross-references are included. The proposed amendments appear on the odd-numbered pages, whereas the corresponding explanations appear on the opposite even-numbered pages. In the text itself of the Articles or Rules proposed to be amended, underlinings indicate what is new as compared to the present text.

5. The proposals which had been withdrawn during the first session (see document PCT/CAL/I/9, paragraphs 33, 43 and 44)—they concerned new Rule 92*ter* (Chapter XIX of document PCT/CAL/I/3, pages 52 and 53) as well as Rule 17.2 (Chapter XXVI of document PCT/CAL/I/4, pages 21 and 22)—are no longer contained in documents PCT/CAL/II/2 to 4.

6. The proposals made by the Delegation of the Netherlands (see document PCT/CAL/I/8) have, with one exception (Rule 94.1), been included in the revised set of proposals with explanations drafted by the International Bureau. The proposed amendment to Rule 94.1 has not been taken up by the International Bureau since it is linked to the amendments which had been proposed to Rule 17.2 and those amendments have been withdrawn (see paragraph 5, above).

7. The possibility of transferring, wholly or partly, the Rules which are proposed to be amended to the Administrative Instructions has been examined by the International Bureau and has resulted in various proposals for amending the Administrative Instructions and deleting the text of the corresponding Rules. The contemplated texts of the amended or new Sections of the Administrative Instructions are included in the explanations of the proposed amendments to the corresponding Rules, with underlinings indicating what is new as compared with the present text of the Administrative Instructions.

8. The transfer to the Administrative Instructions of Rules which are not proposed to be amended in the documents prepared for the second session of the Committee will be considered by the International Bureau once the present proposals have been examined by the Committee and in the light of its deliberations.

Questions of Special Interest to Developing Countries

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

10. The Delegation of Brazil recalled, during the first session of the Committee, that in particular a proposal to consider lower fees in favor of nationals of developing countries should be studied (see document PCT/CAL/I/9, paragraph 61). The International Bureau replied that no proposals had been made so far with respect to this question since the question was intimately linked with the proposals concerning preferential treatment for developing countries made in the context of the ongoing revision of the Paris Convention for the Protection of Industrial Property; since the PCT was a special agreement under the Paris Convention, the outcome of the ongoing revision process in this matter would have to be awaited before the study of the International Bureau could revert to those questions (see document PCT/CAL/I/9, paragraph 62).

11. At the time of preparation of this document, no decision concerning preferential treatment for developing countries with respect to fees has been taken within the framework of the ongoing revision of the Paris Convention. It therefore appears premature to make and consider concrete proposals within the framework of the PCT.

12. However, the Committee could propose to the Assembly of the PCT Union a recommendation to all Contracting States to seek ways and means for financing at least part of the international search and preliminary examination fees payable by nationals of developing countries. National or regional funds could be put at the disposal of the International Bureau or of the International Searching and Preliminary Examining Authorities, in order to be used to assist such applicants from developing countries in paying such fees.

13. The Committee is invited to consider, and advise the International Bureau on, the proposed amendments (and corresponding explanations) and the questions of special interest for developing countries, contained in the present and the other preparatory documents.

SUBJECT MATTERS OF THE AMENDMENTS PROPOSED IN THIS DOCUMENT

Chapter	Objective	Provisions to be amended	Page
1.	Informing the designated Offices of the cancellation of the priority claim or the correction of the filing date of the earlier application whose priority is claimed; allowing the Administrative Instructions to provide for the inclusion in the request of additional optional indications	Rules 4.10 and 4.17; Sections 314 and 402	6
2.	Making it possible, in certain circumstances, to formulate dependent claims in a manner different from the manner otherwise prescribed by the PCT Regulations	Rule 6.4	10
3.	Omitting any drawing from the publication of the abstract where the International Searching Authority finds that no drawing is useful for the understanding of the abstract	Rules 8.2 and 48.2	14
4.	Allowing, where the language of publication is different from the language of the international application, to file the request in the language of publication	Rule 12.1	18
5.	Simplifying the wording of Rule 13 <i>bis</i> .7	Rule 13 <i>bis</i> .7	20
6.	Clarifying the due date of payment of certain fees and clarifying the requirement that the amount payable is the amount in force on the date of the actual payment	Rules 15.4 and 57.3	22
7.	Providing for quicker information of the International Bureau where charges are made under Rule 16 <i>bis</i> , and providing for the universal application of that Rule	Rules 16 <i>bis</i> .1, 16 <i>bis</i> .2 and 16 <i>bis</i> .3; Sections 318, 319 and 509	26
8.	Clarifying various questions concerning the submission of the priority document	Rule 17.1; Section 411	32

Chapter	Objective	Provisions to be amended	Page
9.	Making safer the transmittal of the record copy	Rules 20.5, 22.1, 22.2, 22.3, 22.4 and 23.1; Section 315	36
10.	Cancelling the obligation of the receiving Office to reimburse to the International Bureau the cost of making a substitute search copy	Rule 23.1	44
11.	Deleting the requirement to mark all sheets of the international application with the stamp of the International Bureau and deleting the requirement to mark replacement sheets with the stamp of the Authority to which they have been submitted	Rules 24.1, 26.4, 26.5, 46.5 and 66.8; Sections 308, 320, 401, 401 ^{bis} , 401 ^{ter} and 602	46
12.	Allowing the extension of the time limit fixed by the receiving Office for correcting certain defects in the international application; obliging that Office to accept corrections even if received after the expiration of such time limit but before making a decision; obliging that Office to excuse certain physical defects	Rules 26.2 and 26.5	54
13.	Doing away with the notification and publication of certain events irrelevant under the circumstances	Rules 29.2, 48.6 and 51.4; Section 112	58
14.	Allowing the filing of withdrawal of the international application, of designations or of the priority claim in all cases with the receiving Office	Rules 32.1, 32 ^{bis} .1, 48.6, 74 ^{bis} .1, 75.2, and 75.3; Sections 321, 413, 414 and 415	64
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 and allowing for international applications filed in a language other than one of the languages of international publication to be published in certain cases in a translation into any of these languages	Rules 34.1 and 48.3	72

EXPLANATIONS OF THE PROPOSED AMENDMENTS

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

(Concerns Rules 4.10 and 4.17)

Revised proposals

(Former Chapter XXI, see documents PCT/CAL/I/4, pages 4 to 7, and PCT/CAL/I/9, paragraphs 35 and 36)

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

Section 314

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

(a) and (b) [No change]

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

TEXT OF THE PROPOSED AMENDMENTS

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 Priority Claim

(a) [No change]

(b) [See document PCT/CAL/II/3]

(c) [No change]

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

(e) [No change]

4.11 to 4.16 [No change]

*

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

Section 402

Notification of Correction of the Priority Date or
Cancellation of the Priority Claim

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

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

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

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

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

4.17 Additional Matter

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

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

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

(Concerns Rule 6.4)

Revised proposal

(Former Chapter VIII, see documents PCT/CAL/I/3, pages 4 and 5,
and PCT/CAL/I/9, paragraph 19)

1. Rule 6.3 defines, in paragraph (b), the general requirements for the manner of claiming and provides, in paragraph (c), that the failure to use that manner of claiming has no effect in any designated State where the national law of that State does not require such manner of claiming. This provision, however, is presently not applicable to the special case referred to in Rule 6.4(a), second and third sentences, namely, that a dependent claim which refers to more than one other claim (“multiple dependent claim”) must refer to such claims in the alternative only and cannot serve as a basis for any other multiple dependent claim.
2. The national laws of several States party to the PCT and the European Patent Convention (EPC) allow, with respect to multiple dependent claims, a manner of claiming which is more liberal than the one provided for in Rule 6.4(a). In particular, they allow reference to other claims in cumulation and the use of multiple dependent claims as a basis for any other such claim. Where such is the case, the strict enforcement of the provision of Rule 6.4(a) has, for example, the effect that, if the international application claims the priority of an earlier national (or EPC) application using a manner of formulating multiple dependent claims consistent with that—more liberal—required by the national laws (or the EPC) of all designated States (or the EPC), the claims would still have to be redrafted, for the purposes of the international application, in order to conform with the stricter rules of the PCT Regulations, namely with present Rule 6.4(a). Furthermore, where Chapter II applies and where the European Patent Office is, at the same time, International Preliminary Examining Authority and the only elected Office, it must, as International Preliminary Examining Authority, inform the applicant of non-compliance with Rule 6.4(a) if the claims have not been drafted in accordance with that Rule although it would, as elected Office, allow such manner of claiming. Moreover, it is not always understood why failure to comply with the general requirements of the manner of claiming provided for in Rule 6.3(b) should have no effect in certain designated States whereas failure to comply with the special requirements of the manner of claiming in the case of dependent claims under Rule 6.4(a) could not be disregarded by those States.
3. Consequently, it is proposed to amend paragraph (a) of Rule 6.4 to the effect that failure to use the manner of claiming provided for in the second and third sentences of that paragraph has no effect in a designated State if the manner of claiming actually used satisfies the national law of that State. This amendment would be the subject matter of the fifth (the last) sentence of paragraph (a).
4. It should be noted that, where the national law of a designated State requires a manner of formulating dependent claims as provided in present Rule 6.4(a), the international application has to use that manner of claiming; otherwise, the claims will, in the national phase before the Office of that State, have to be amended in order to comply with the requirements of the present Rule 6.4(a).

Rule 6The Claims

6.1 to 6.3 [No change]

6.4 Dependent Claims

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

(b) and (c) [No change]

6.5 [No change]

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

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

(Concerns Rules 8.2 and 48.2)

Revised proposal (drafting only)

(Former Chapter XXII, see documents PCT/CAL/I/4, pages 8 to 11, and PCT/CAL/I/9, paragraph 37)

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

Rule 8The Abstract

8.1 [No change]

8.2 Figure

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

(b) If the International Searching Authority finds that none of the figures of the drawing or drawings is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, publications of the abstract by the International Bureau shall not be accompanied by any drawing even where the applicant has made a suggestion under Rule 3.3(a)(iii).

8.3 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) [No change]

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

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

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

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

(c) to (f) [No change]

(g) and (h) [See document PCT/CAL/II/3]

(i) [No change]

48.3 [See pages 75 and 77, below, and document PCT/CAL/II/3]

48.4 and 48.5 [No change]

48.6 [See pages 59 and 69, below]

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

(Concerns Rule 12.1)

Proposal approved by the Committee at its first session
(see documents PCT/CAL/I/6 and PCT/CAL/I/9, paragraph 20)

1. Under Article 11(1)(ii), the receiving Office shall accord the international filing date if the international application is—among other things—in the prescribed language. According to present Rule 12.1, the prescribed language is the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of the international application. (If the agreement specifies several languages, the receiving Office may prescribe, among those languages, the language(s) in which any international application filed with it must be). All parts of the international application must be filed in the same language.
2. Under present Rule 48.3, an English translation of the international application must be prepared under the responsibility of the International Searching Authority if the language in which the international application is filed is not English, French, German, Japanese, or Russian. That translation will be published. It has been proposed by the Delegation of Norway (see document PCT/CAL/I/6), and accepted by the Committee in its September 1982 session, to allow the filing of the request—if the applicant prefers it—in the language of publication rather than in the language of the rest of the international application. The rationale of this proposal is that some applicants may regard it as an unnecessary burden that they have to fill in the request form twice—as they have to under the present Rules—namely, once in the language in which the application was filed and once in the language of publication. Since the request in the language of filing would be of no real interest to anyone, the applicant concerned may prefer to file the request form in the language of publication. The new paragraph allows just that.

Rule 12

Language of the International Application

12.1 Admitted Languages

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

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

12.2 [See document PCT/CAL/II/3]

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

(Concerns Rule 13bis.7)

Proposal approved by the Committee at its first session
(Former Chapter XXIII, see documents PCT/CAL/I/4, pages 12 and 13,
and PCT/CAL/I/9, paragraph 38)

1. The present text of Rule 13bis.7(b) provides, among other things, for notifications to be effected before the entry into force of Rule 13bis. Such entry into force occurred on January 1, 1981, and thus is in the past. It is proposed to delete any reference to both the said event and to future changes in the national law.
2. The proposed remaining text of Rule 13bis.7(b) would institute a permanent requirement that the national Offices must notify the International Bureau of the depositary institutions with which deposits may be made. Such a requirement clearly implies that, should a change occur with respect to such institutions, such change would have to be notified to the International Bureau.

Rule 13bis

Microbiological Inventions

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

13bis.7 National Requirements: Notification and Publication

(a) [No change]

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

(c) [No change]

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

Chapter 6: Clarifying the due date of payment of certain fees and
clarifying the requirement that the amount payable is
the amount in force on the date of the actual payment

(Concerns Rules 15.4 and 57.3)

Proposals approved by the Committee at its first session
(Former Chapter XXIV, see documents PCT/CAL/I/4, pages 14 to 17,
and PCT/CAL/I/9, paragraph 39)

1. Ad Rule 15.4(a) and (b). From many 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 comes from 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 (including the permission for later payment of the basic fee, which is presently covered by paragraph (c)) and paragraph (b) would deal with the time of payment of the designation fee (including the permission for later payment of the designation fee, which is presently covered by paragraph (c)). (Paragraph (c), whose present contents would be included in paragraphs (a) and (b), would contain a new provision whose contents are explained in paragraphs 4 to 6, below.)
2. The proposed new wording of paragraph (a) of Rule 15.4 would deal with the time of payment of the basic fee and would contain only one change of substance, which concerns the extended period for the later payment of the basic fee. Under the present text, the receiving Office may grant an extension of up to one month, which means that the extension may be one week, two weeks, or any other period up to one month. It is now proposed to provide for a uniform period for later payment of one month, which corresponds to the present practice of all receiving Offices permitting later payment. Such a change would contribute to standardizing the time limits under the PCT.
3. The proposed new wording of paragraph (b) of Rule 15.4 would deal with the time of payment of the designation fee. It consists of two sentences. The first sentence covers the case where the international application contains no priority claim and makes it clear that the period for payment of the designation fee is always and in all receiving Offices one year from the date of receipt of the international application. The second sentence covers the case where the priority of an earlier application is claimed in the international application and makes it clear that the designation fee must be paid before the expiration of one year from the priority date or, where the receiving Office permits later payment, within one month from the date of receipt of the international application, whichever period expires later. (This means in practice, that an applicant would benefit from the one-month time limit for paying the designation fee only if he filed the international application during the 12th month from the priority date, because, if he filed the international application before the expiration of the 11th month from the priority date, the priority year would expire later than the one-month time limit granted for later payment.) The only change in substance which is proposed is that the period for later payment would always be one month, for the reasons outlined in paragraph 2, above.
4. Ad Rule 15.4(c). The present Rule 15 does not say clearly whether, in case the amount of the international fee is changed (be it a change of the amount as set out in the Schedule of Fees or be it a change of an equivalent amount in a prescribed currency), the new amount is payable also by applicants who have filed their international applications prior to the date on which the new amount becomes effective but are permitted—and use such permission—to make a later payment of the basic fee, the designation fee or both of those fees.

Rule 15

The International Fee

15.1 to 15.3 [No change]

15.4 Time of Payment

(a) The basic fee shall be due on the date of receipt of the international application. However, the receiving Office may permit applicants to pay the basic fee within one month from that date, provided that such later payment shall not be subject to any surcharge and shall be without loss of the international filing date.

(b) Where the international application does not contain any priority claim under Article 8, any designation fee shall be paid within one year from the date of receipt of the international application. Where the international application contains any priority claim under Article 8, any designation fee shall be paid prior to the expiration of one year from the priority date; however, the receiving Office may permit applicants to pay any designation fee within one month from the date of receipt of the international application, provided that such later payment shall not be subject to any surcharge and shall be without loss of the designations to which the payment relates.

(c) If the amount of the basic fee or of the designation fee as set out in the Schedule of Fees or any corresponding amount in any prescribed currency is changed and the new amount becomes applicable after the date of receipt of the international application, the new amount shall apply to any payment of the basic fee or of any designation fee made on or after the date on which the new amount becomes applicable.

15.5 [No change: remains deleted]

15.6 [No change]

5. It is proposed to amend Rule 15 by making it clear in paragraph (c)—whose contents would be completely different from its present contents—that the amount which must be paid is the amount applicable on the date of payment and not the amount applicable on the date of receipt of the international application. If the latter were the case, the former amount of the designation fee would be payable up to one year after the entry into force of the new amount of the designation fee. Such parallel application of two different amounts for the same fee would be confusing and should be avoided, and the new amount should be applied in all cases as of the date on which it has become effective.
6. The proposed amendment would not involve particular risks for applicants who pay—inadvertently—less than the new amount since any difference between the amount paid and the new applicable amount would be charged to the International Bureau under Rule 16*bis*. Since it is also proposed to make Rule 16*bis* applicable for all receiving Offices, no applicant would risk losing his application if he pays the amount applicable on the date of receipt of the international application not knowing that the amount has changed in the meantime.
7. 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.
8. [Ad Rule 57.3](#). The amendment to this Rule, which consists of adding to it a new paragraph (e), is proposed to apply to the payment of the handling fee or of the supplement to the handling fee the same principles laid down in the proposed new text of Rule 15.4(c) for the international fee. It involves likewise no risk for the applicant if he pays less than the new amount since, where the required amount has not been paid on the due date (namely, when the demand or the later election was submitted), the applicant is invited to pay the missing amount and, if he complies with the invitation, the fee is considered to have been paid on the due date (see Rules 57.4(a) and (b) and 57.5(a) and (b)).

Rule 57

The Handling Fee

57.1 and 57.2 [No change]

57.3 Time and Mode of Payment

(a) to (d) [No change]

(e) If the amount of the handling fee or of the supplement to the handling fee as set out in the Schedule of Fees or any corresponding amount in any prescribed currency is changed and the new amount becomes applicable after the date of submission of the demand or of the later election, the new amount shall apply to any payment of the handling fee or of the supplement to the handling fee made on or after the date on which the new amount becomes applicable.

57.4 to 57.6 [No change]

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

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

Revised proposals

(Former Chapter XXV, see documents PCT/CAL/I/4, pages 18 and 19,
and PCT/CAL/I/9, paragraphs 40 and 41)

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

Section 318

Information of Any Charge Made under Rule 16bis.1

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

Rule 16bisAdvancing Fees by the International Bureau16bis.1 Guarantee by the International Bureau

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

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

(c) [No change]

(d) [Deleted]

16bis.2 Obligations of the Applicant, Etc.

(a) to (c) [No change]

(d) to (g) [Deleted]

16bis.3 [Deleted]

*

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

Section 509

Procedure Where Information is Received

under Section 318(b)

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

6. Ad Rule 16bis.2(d) to (g). Paragraphs (d) to (g) of Rule 16bis.2 concern financial matters which interest only the receiving Office and the International Bureau. It is proposed to transfer the contents of the said paragraphs into the Administrative Instructions in the form of a new Section 319, the text of which could read as follows:

Section 319

Return of Amounts Charged

under Rule 16bis.1

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

(b) Where the international application is considered withdrawn, any amount charged under Rule 16bis.1(a) or (b) to the International Bureau, other than the amount needed to cover the transmittal fee and the search fee transferred by the receiving Office to the International Searching Authority, shall be returned by the receiving Office to the International Bureau.

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

[Section 319, continued]

(d) Where Rule 16bis.2(c) applies, the amount charged under Rule 16bis.1(b) by the receiving Office to the International Bureau for designations which, as a consequence of the application of the order under Rule 16bis.2(c), are not maintained, shall be returned to the International Bureau by the receiving Office.

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

8. By September 1, 1980, notifications under Rule 16bis.3 had been received from the receiving Offices of Australia, Austria, Hungary and Japan. The receiving Office of Austria withdrew subsequently its notification so that, at the present times, it is only in the remaining three States that Rules 16bis.1 and 16bis.2 are not applicable. However, the Delegation of Australia declared at the first session of the Committee (September 1982) that the receiving Office of its country was in the process of withdrawing its notification.

9. The present proposal to delete Rule 16bis.3 is made in the hope that, by the time such deletion would come into effect, the receiving Offices still not applying Rules 16bis.1 and 16bis.2 would also be in a position to accept them—a move that would be clearly in the interest of the nationals of their countries—and would, consequently, withdraw their notifications under Rule 16bis.3.

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

(Concerns Rule 17.1)

Proposals approved by the Committee at its first session
(Part of former Chapter XXVI, see documents PCT/CAL/I/4, pages 20 to 22,
and PCT/CAL/I/9, paragraph 42)

1. Ad Rule 17.1(c). Under Rule 17.1(a), where the priority of an earlier national application is claimed under Article 8 in the international application, the applicant must submit, generally within 16 months after the priority date, a certified copy of such earlier application (“the priority document”) to the receiving Office or the International Bureau. If the priority document has been submitted to the receiving Office, that Office must transmit it to the International Bureau. Under Rule 17.1(b), the applicant may, instead of submitting the priority document, request the receiving Office to transmit it to the International Bureau, if the earlier application, the priority of which is claimed, had been filed with that Office.
2. Rule 17.1(c) provides that where the requirements of neither of paragraphs (a) and (b) of Rule 17.1 are complied with, any designated State may disregard the priority claim. Those requirements are the following: (i) the applicant must—within the prescribed time limit—submit the priority document or must request the receiving Office to transmit it to the International Bureau and (ii) where the receiving Office is involved, that Office must submit the priority document to the International Bureau. Present Rule 17.1(c) seems to mean that the priority claim may be disregarded by any designated State if either of the requirements mentioned under (i) or (ii) is not complied with. This may lead to the undesirable result that, where the applicant complied with the Rule but the receiving Office failed to transmit the priority document to the International Bureau, the applicant may lose his priority claim.
3. It is therefore proposed to amend Rule 17.1(c) by making it clear that the priority claim may only be disregarded if the applicant did not comply with the requirements of either Rule 17.1(a) or Rule 17.1(b). Failure of the receiving Office to transmit the priority document to the International Bureau would not result in such a serious sanction since the applicant should not be blamed for mistakes made by the receiving Office. Should it really happen—it has not happened so far and it is unlikely to happen in the future—that the receiving Office fails to transmit the priority document to the International Bureau, that Bureau will, should it be informed about such failure, remind the receiving Office to transmit the priority document promptly and then furnish copies to the designated Offices under Rule 17.2(a).
4. Ad Rule 17.1(d). This Rule prescribes, in the first and third sentences, the recording of the date on which the International Bureau has received the priority document and the notification of the applicant and of the designated Offices of such date. The second sentence of this Rule (“Where applicable, the date of receipt by the receiving Office of a request referred to under paragraph (b) shall be recorded as the date of receipt of the priority document.”) contains details on the question of which date has to be indicated. Since the important fact to be recorded (and notified) is whether the applicable time limit referred to in Rule 17.1(a) has been complied with—and not, if the time limit has been complied with, the date on which the relevant event occurred (i.e., submission of the priority document to the International Bureau or to the receiving Office under Rule 17.1(a), or submission of a request to the receiving Office for transmitting the priority document to the International Bureau, under Rule 17.1(b))—it is proposed to record (and notify) the date on which the International Bureau received the priority document in all cases where the said time limit was complied with and to record (and notify) the date on which the receiving Office received the priority document or the request to transmit the priority document to the International Bureau only in those cases where the said time limit was not complied with. It is proposed to provide for these administrative details in the Administrative Instructions rather than the Regulations and, consequently, delete Rule 17.1(d).

Rule 17

The Priority Document

17.1 Obligation to Submit Copy of Earlier National Application

(a) and (b) [No change]

(c) If the requirements of neither of the two preceding paragraphs are complied with by the applicant, any designated State may disregard the priority claim.

(d) [Deleted]

17.2 [No change]

5. The contemplated provisions of the Administrative Instructions could read as follows:

Section 411

Receipt of Priority Document

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

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

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

Chapter 9; Making safer the transmittal of the record copy

(Concerns Rules 20.5, 22.1f 22.2, 22.3, 22.4 and 23.1)

Revised proposals

(Former Chapter I, see documents PCT/CAL/I/2, pages 4 to 11,
and PCT/CAL/I/9, paragraph 12)

1. Ad Rules 20.5, 22.1, 22.2 and 22.3. Under the present Rules, the obligation to transmit the record copy lies with the receiving Office. The receiving Office must mail the record copy to the International Bureau not later than five days prior to the expiration of the 13th month from the priority date (Rule 22.1(a)). The International Bureau notifies the applicant of the receipt of the record copy from the receiving Office. If the applicant is not in possession of such a notification by the expiration of 13 months and 10 days from the priority date—that is, two weeks after the day on which the receiving Office must, at the latest, mail the record copy to the International Bureau—then, and only then, the applicant himself may transmit the record copy (or a copy equivalent to the record copy) to the International Bureau. This is the procedure under the present Rule 22.1(b) and (c): it will be called hereinafter the “wait and act” procedure. It has, in fact, never been used by any applicant. There is also another procedure—called, in the Regulations, “alternative procedure”—under which, if the rules applicable in the receiving Office so permit, the applicant may, under certain conditions and without waiting for the expiration of any time limit, obtain the record copy from the receiving Office and forward himself the record copy so obtained to the International Bureau. This is the procedure under the present Rule 22.2, a somewhat involved Rule and one of the longest. It is to be noted that there are only two receiving Offices—the Swedish Patent Office and the United States Patent and Trademark Office—that allow the use of this alternative procedure and that, in fact, this procedure has also never been used by any applicant.
2. It is also to be noted that till now, as far as the International Bureau is aware, the record copies of all the international applications filed have reached the International Bureau within the prescribed time limit and through transmittal by the receiving Offices.
3. In view of these facts, and after more than four and a half years of practical experience, one could conclude that both the “wait and act” procedure (Rule 22.1(b) and (c)) and the “alternative procedure” (Rule 22.2) are superfluous. Since, however, the theoretical possibility exists that a receiving Office might fail to transmit the record copy in time to the International Bureau, some kind of safeguard procedure should be provided for under which the applicant is fully protected against the consequence of any such failure on the part of the receiving Office, in other words, against the risk to lose his rights under Article 12(3).
4. It is therefore proposed to dispose of both the “wait and act” procedure (existing Rule 22.1(b) and (c)) and the “alternative procedure” (Rule 22.2) and to institute a new “safeguard” procedure.
5. The proposed safeguard procedure would consist of the following steps. The receiving Office, when notifying the applicant of the international application number and the international filing date under Rule 20.5(c), would send to the International Bureau a copy of the notification sent to the applicant, unless the receiving Office has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a). (The said notification is to be made by using Form PCT/RO/105, which would be revised to indicate whether the record copy has been transmitted and whether a copy of the notification has been sent to the International Bureau. The thus revised form is reproduced on page 42, below.) Where the International Bureau receives a copy of the notification indicating that the record copy has not yet been transmitted, it would start monitoring the timely receipt of the record copy. The monitoring would consist of the following steps. If the International Bureau does not receive the record copy within 13 months from the priority date, it will remind the receiving Office to promptly transmit the record copy. If, notwithstanding the reminder, the International Bureau is still not in possession of the record copy by the expiration of 14 months from the priority date, it (the International Bureau) will notify the applicant accordingly. The applicant thus alerted could then contact the

Rule 20

Receipt of the International Application

20.1 to 20.4 [No change]

20.5 Positive Determination

(a) [No change]

(b) [No change]

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

20.6 to 20.9 [No change]

receiving Office and make sure that the receiving Office sends the record copy to the International Bureau. He could also—and this is expressly provided for in proposed new Rule 22.1(d)—ask the receiving Office for a certified copy of his international application and forward that copy himself to the International Bureau. The copy to be certified by the receiving Office would normally be a copy of the home copy, but it could also be a copy presented to the receiving Office, for certification, by the applicant. The certification would be free of charge and could be refused only on the ground that the copy to be certified is not identical with the international application as filed, that prescriptions concerning national security prevent the international application from being treated as such, or that the receiving Office has already transmitted—and the International Bureau has received—the record copy. The copy certified by the receiving Office would be considered to be the record copy unless or until the International Bureau receives the record copy.

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

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

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

Rule 22

Transmittal of the Record Copy

22.1 Procedure

(a) [No change]

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

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

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

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

10. [Ad Rules 22.4 and 23.1](#). The amendments proposed in Rules 22.4 and 23.1 are consequential upon the deletion of the “wait and act” and “alternative” procedures. Similarly, Section 315 of the Administrative Instructions, which relates to the “alternative” procedure under Rule 22.2, would have to be deleted.

[Rule 22.1, continued]

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

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

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

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

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

22.2 [Deleted]

22.3 Time Limit under Article 12(3)

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

22.4 Statistics Concerning Non-Compliance with Rule 22.1(a)

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

22.5 [No change]

PATENT COOPERATION TREATY

TO

FROM

the RECEIVING OFFICE
identified at the bottom of this page

NOTIFICATION OF THE INTERNATIONAL
APPLICATION NUMBER AND OF THE
INTERNATIONAL FILING DATE

issued pursuant to PCT Rule 20.5(c)⁽²⁾

Inscribe NAME and ADDRESS of the AGENT and if there
is no agent, of the APPLICANT (1)

DATE OF MAILING by the receiving Office
APPLICANT'S OR AGENT'S FILE REFERENCE (1)

IDENTIFICATION OF THE INTERNATIONAL APPLICATION

International Application No.	International Filing Date	(Earliest) Priority Date Claimed
-------------------------------	---------------------------	----------------------------------

Applicant (Name)

Title of Invention

NOTIFICATION

The applicant is hereby notified that the above-identified international application has been accorded the international application number and the international filing date indicated.⁽²⁾

The record copy

- was transmitted to the International Bureau on ...
- has not been transmitted yet to the International Bureau
 - because the necessary clearance for national security has not been obtained yet
 - because (reason to be specified): ...

A copy of this notification

- has been sent to the International Bureau (since the record copy has not been transmitted yet to the International Bureau)
- has not been sent to the International Bureau (since the record copy has been transmitted to the International Bureau)

THE RECEIVING OFFICE

Name and Mailing Address	Authorized Officer
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Rule 23

Transmittal of the Search Copy

23.1 Procedure

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

(b) [See page 45, below]

(c) [No change]

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

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

(Concerns Rule 23.1)

Proposal approved by the Committee at its first session
(Former Chapter XXVII, see documents PCT/CAL/I/4, pages 24 and 25,
and PCT/CAL/I/9, paragraph 45)

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

Rule 23

Transmittal of the Search Copy

23.1 Procedure

(a) [See page 43, above]

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

(c) [No change]

*

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

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

(Concerns Rules 24.1, 26.4, 26.5, 46.5 and 66.8)

Revised proposals

(Former Chapters XXVIII and XXIX, see documents PCT/CAL/I/4, pages 26 to 29, and PCT/CAL/I/9, paragraphs 46 and 47)

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

Section 308

Marking of Sheets of the Record Copy

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

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 Recording of Date of Receipt of the Record Copy

[Deleted]

24.2 [No change]

Rule 26

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

26.1 [No change]

26.2 [See page 55, below]]

26.3 [No change]

26.4 Procedure

(a) [No change]

(b) to (d) [Deleted]

26.5 Correction of Certain Elements

(a) [See page 55, below]

(b) [Deleted]

26.6 [No change]

Section 320

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

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

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

(c) [See document PCT/CAL/II/3]

Section 401

Marking of Sheets of the Record Copy

(a) The International Bureau shall, upon receipt of the record copy, mark the date of receipt of the record copy in the appropriate space on the request form and place the stamp of the International Bureau in the lower right-hand corner of each sheet of that form.

(b) [No change]

Rule 46

Amendment of Claims Before the International Bureau

46.1 and 46.2 [See document PCT/CAL/II/3]

46.3 and 46.4 [See document PCT/CAL/II/3]

46.5 Form of Amendments

(a) [No change]

(b) and (c) [Deleted]

Rule 66

Procedure Before the International Preliminary

Examining Authority

66.1 [No change]

66.2, 66.3, 66.4 and 66.5 [See document PCT/CAL/II/3]

66.6 [No change]

66.7 [See document PCT/CAL/II/3]

Section 401bis

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

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

(b) [See document PCT/CAL/II/3]

Section 401ter

Amendments under Rule 46.5(a)

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

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

66.8 [Form of Corrections and Amendments](#)

(a) [See document PCT/CAL/II/3]

(b) [Deleted](#)

66.9 [See document PCT/CAL/II/3]

Section 602

Amendments under Rule 66.8(a)

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

(b) [No change]

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

(Concerns Rules 26.2 and 26.5)

Revised proposals

(Former Chapter X, see documents PCT/CAL/I/3, pages 14 to 16, and
PCT/CAL/I/9, paragraph 22)

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

Rule 26

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

26.1 [No change]

26.2 Time Limit for Correction

The time limit referred to in Article 14(1)(b) shall be reasonable under the circumstances and shall be fixed in each case by the receiving Office. It shall not be less than 1 month from the date of the invitation to correct. It may be extended by the receiving Office either before it has expired or at any time before a decision is taken under Rule 26.5(a).

26.3 [No change]

26.4 [See page 47, above]

26.5 Decision of the Receiving Office

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

(b) [See page 47, above]

26.6 [No change]

5. [Ad Rule 26.5](#). It follows from present Rule 26.1(a) that the receiving Office must check whether the international application complies with the physical requirements prescribed by or under Article 14(1)(a)(v). Any corresponding defect may be serious or less serious. A typical example of a less serious defect would be a somewhat less than total compliance with the minimum margins prescribed under Rule 11.6. Some receiving Offices seem to have adopted the practice, when they invite the applicant to correct defects under Article 14(1)(a), to mention all physical defects—whether serious or less serious—detected in the international application and to notify the applicant that the international application will be considered withdrawn should he fail to correct all the physical defects within the time limit fixed for that purpose in the invitation. If the applicant then fails to correct any minor (less serious) physical defect, the receiving Office might find itself in a dilemma. Under strict application of the Rules, the international application should be considered withdrawn although such a decision would be a legal consequence which is out of proportion in view of the nature of the defect. The present Rule 26.5 has therefore been interpreted by several Offices and in various cases in a way allowing to disregard failure to correct a minor (less serious) physical defect and to continue the processing of the international application.

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

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

(Concerns Rules 29.2, 48.6 and 51.4)

Revised proposals

(Former Chapter XXX, see documents PCT/CAL/I/4, pages 30 to 34,
and PCT/CAL/I/9, paragraph 48)

1. [Ad Rules 29.2, 48.6\(b\) and 51.4](#). The present text of Rule 29.2 provides for a notification of the International Bureau by the designated Office in two cases. The first case is where the effect of the international application provided for in Article 11(3) ceased in the designated State concerned by virtue of Article 24(1)(iii), namely, because the applicant failed to perform the acts referred to in Article 22 (for entering the national phase) within the applicable time limit.
2. The second case is where the effect of the international application is maintained in the designated State concerned by virtue of Article 24(2), namely, where such effect is maintained (without being required to be maintained by virtue of Article 25(2)) in spite of the existence of one of the circumstances enumerated in items (i), (ii) and (iii) of Article 24(1).
3. Under the present Rule 51.4, each designated Office must notify the International Bureau where the effect of the international application is maintained in the designated State concerned after the review procedure provided for in Article 25.
4. Under the present Rule 48.6(b), the essence of any notification under Rule 29.2 and of any notification under Rule 51.4 is to be published in the Gazette and, if the notification reaches the International Bureau before the preparations for the publication of the pamphlet have been completed, also in the pamphlet.
5. Furthermore, Rule 86.1(iv) provides for the publication in the Gazette of information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned.
6. The combination of those Rules is not satisfactory for several reasons. First, no elected Office has the obligation to notify the International Bureau where the effect of the international application ceased in the elected State concerned by virtue of Article 39(2), namely, because the applicant failed to perform the acts referred to in Article 39(1) (for entering the national phase) within the applicable time limit. Secondly, it is difficult to imagine in which case a designated Office would maintain, under Article 24(2), the effect of the international application where the applicant has withdrawn his international application or the designation of the designated State concerned under Article 24(1)(i). Thirdly, no elected Office has the obligation to notify the International Bureau that the effect of the international application is maintained in the elected State concerned by virtue of Article 39(3) although the applicant failed to perform the acts referred to in Article 39(1) (for entering the national phase) within the applicable time limit. It is probably for these reasons that not all the designated Offices comply with their obligations under Rule 29.2. On the other hand, the International Bureau has never proceeded with any publication under Rule 48.6(b) or Rule 86.1(iv), mainly because the required notifications under Rules 29.2 and 51.4 have not been received from all designated or elected Offices. Furthermore, such publications could not be complete as far as elected Offices are concerned.

Rule 29

International Applications or Designations Considered

Withdrawn under Article 14(1), (3) or (4)

29.1 [No change]

29.2 Finding by Designated Office

[Deleted]

29.3 and 29.4 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 [See page 17, above, and document PCT/CAL/II/3]

48.3 [See pages 75 and 77, below, and document PCT/CAL/II/3]

48.4 and 48.5 [No change]

48.6 Announcing of Certain Facts

(a) [No change]

(b) [Deleted]

(c) [See page 69, below]

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

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

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

10. Moreover, the proposal to introduce a new provision requiring the designated Offices to furnish once a year statistical information on the number of international applications entering or not entering the national phase, is not maintained in the form of a new Rule 92quinquies but is proposed to be the subject of a new Section (Section 112(a)) of the Administrative Instructions. New Section 112(a) would also introduce a similar obligation for elected Offices, which presently are not required to make any notifications in this context to the International Bureau. The proposed new Section 112(a) would allow the International Bureau to receive the information it needs in order to proceed with its publication under Rule 86.1(iv) which, since its present text already permits publication of statistical information, is not proposed to be amended.

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

Rule 51

Review by Designated Office

51.1 to 51.3 [No change]

51.4 Notification to the International Bureau

[Deleted]

Section 112

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

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

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

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

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

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

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

Proposals made by the Delegation of the Netherlands
(see document PCT/CAL/I/8) and consequential amendments;
concerning Rule 48.6, see former Chapter XXX (documents PCT/CAL/I/4,
pages 33 and 34, and PCT/CAL/I/9, paragraph 48)

1. [Ad Rule 32.1\(c\) and \(e\)](#). The present text of Rule 32.1(c) provides that a notice of withdrawal of the international application must be filed with the International Bureau or, if the record copy has not yet been sent to the International Bureau, with the receiving Office. (Under Rule 32*bis*.1(d), the same rule applies *mutatis mutandis* to the withdrawal of the priority claim.) It is proposed to allow the filing of a notice of withdrawal with the receiving Office even where the record copy has already been sent to the International Bureau. Where the record copy or a copy of the notification under Rule 20.5(c) has already been sent to the International Bureau, the receiving Office should be obliged, if it receives a notice effecting withdrawal, promptly to transmit such notice to the International Bureau. It is not proposed to provide for such an obligation in the Regulations but to provide for such obligation for transmittal of a notice of withdrawal in the Administrative Instructions. The contemplated text of a new Section 321 appears in paragraph 8, below. As a consequence of the amendment making it possible to file a notice of withdrawal with the receiving Office, it is necessary to make it clear that, naturally, the provision of Article 21(5), under which there is no international publication if the international application is withdrawn before the technical preparations have been completed, will, in the case where the notice of withdrawal has been filed with the receiving Office, apply only if that notice has been received by the International Bureau before completion of the said technical preparations. It is proposed to clarify this point in a new paragraph (e) of Rule 32.1.
2. [Ad Rule 32*bis*.1\(c\)](#). The present text of this Rule provides that the International Bureau, in case of withdrawal of the priority claim, may proceed with the international publication if the withdrawal is effected during the period of 15 days preceding the expiration of the time limit of 18 months referred to in Article 21(2)(a). The proposed amendment to Rule 32.1(c) (see paragraph 1, above), which applies under Rule 32*bis*.1(d) *mutatis mutandis* to the withdrawal of the priority claim, permits the filing of such withdrawals with the receiving Office even where the record copy has already been sent to the International Bureau. For such cases, it is necessary to clarify that the expression “if the withdrawal is effected” means “if the notice effecting withdrawal is received by the International Bureau,” and it is proposed to amend Rule 32*bis*.1(c) accordingly.
3. [Ad Rules 32.1\(d\), 32*bis*.1\(d\), 74*bis*.1, 75.2 and 75.3](#). Rule 32.1(d) concerns the recording of the date of receipt of the notice effecting withdrawal and its notification by the International Bureau to the applicant and to other authorities. Rule 74*bis*.1 provides for the notification of the International Preliminary Examining Authority in case of withdrawal of the international application or of the designation of all Contracting States—as well as, under Rule 32*bis*.1(d), of the priority claim—in certain cases. Rules 75.2 and 75.3 provide for the notification of the elected Offices and of the International Preliminary Examining Authority in case of withdrawal of the demand or of elections. (It is to be noted that the International Preliminary Examining Authority is to be notified, under Rule 75.3, only if, at the time of withdrawal, it had been informed of the existence of the demand, although one does not see in which case the International Preliminary Examining Authority would not be so informed since any demand must, under Article 31(6)(a), be submitted to it.)

Rule 32

Withdrawal of the International Application
or of Designations

32.1 Withdrawals

(a) and (b) [No change]

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

(d) [Deleted]

(e) Where the notice effecting withdrawal is filed with the receiving Office, there shall be no international publication, in accordance with Article 21(5), if the notice effecting withdrawal is received by the International Bureau before the technical preparations for publication have been completed.

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

4. It is proposed to delete Rules 32.1(d), 74**bis**.1, 75.2 and 75.3 and to transfer their contents in the Administrative Instructions as new Sections 413 and 415, the contemplated texts of which appear in paragraph 8, below. Those new Sections should also provide, in accordance with Article 37(3)(b) and the present practice, that the International Preliminary Examining Authority is notified where not all the designations are withdrawn but only one or more designations of States which had already been elected under Chapter II of the PCT, or not all the elections are withdrawn but only one or more elections of elected States. In addition, a new Section 414 should cover the case where the international application, or the designation of any designated State which had already been elected, is considered withdrawn under Article 14(1), (3) or (4). As a consequence of the deletion of Rules 32.1(d) and 74**bis**.1, it is necessary to amend Rule 32**bis**.1(d) by deleting the existing references to those Rules.

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

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

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

8. The texts of the new Sections 321, 413, 414 and 415 referred to in paragraphs 1 and 4, above, of the Administrative Instructions could read as follows:

Rule 32bis

Withdrawal of the Priority Claim

32bis.1 Withdrawals

(a) and (b) [No change]

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

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

Rule 48

International Publication

48.1 [No change]

48.2 [See page 17, above, and document PCT/CAL/II/3]

*

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

Section 321

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

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

Section 413

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

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

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

48.3 [See pages 75 and 77, below, and document PCT/CAL/II/3]

48.4 and 48.5 [No change]

48.6 [Announcing of Certain Facts](#)

(a) [No change]

(b) [See page 59, above]

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

[Rule 74*bis*](#)

[Notification of Withdrawal under Rule 32](#)

74*bis*.1 [Notification of the International Preliminary Examining Authority](#)

[\[Deleted\]](#)

Section 414

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

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

Section 415

Notification of Withdrawal under Rule 75.1

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

Rule 75

Withdrawal of the Demand, or of Elections

75.1 [See document PCT/CAL/II/4]

75.2 Notification of Elected Offices

[Deleted]

75.3 Notification of the International Preliminary Examining Authority

[Deleted]

75.4 [No change]

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 and allowing for international applications filed in a language other than one of the languages of international publication to be published in certain cases in a translation into any of these languages

(Concerns Rules 34.1 and 48.3)

Revised proposals

(Former Chapters IX and XXI, see documents PCT/CAL/I/3, pages 6 to 13, PCT/CAL/I/4, pages 36 to 39, and PCT/CAL/I/9, paragraphs 21 and 49)

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 in Spanish only. These proposals are reflected in the suggested amendments to paragraphs (a) and (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 that 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, that the abstract would be published—in the Gazette entry concerning such application—in English and French, and that the English and French translations would be prepared by the International Bureau.)
5. It is proposed that if, at the time of adopting the amendments to Rules 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 enter into force 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.

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]

6. [Other languages](#). The proposals contained in Chapter IX of document PCT/CAL/I/3, pages 6 to 13, concerning the filing of an international application in a language that is not admitted and/or with an office which is not competent to receive it, appear to be problematic in view of the present text of the Treaty and do not seem to be feasible without a revision of Article 11. The said proposals are therefore not maintained. However, as far as the language of filing is concerned, a different solution is proposed below.
7. The background of the proposal to allow the filing of international applications in a non-admitted language, was the interest of applicants of Contracting States having an official language which, under Rule 12.1, cannot be used as a language of filing. An earlier national application cannot be used by such an applicant for a subsequent international application without first translating it, which is a requirement depriving him of a major advantage of the PCT.
8. The first condition under the present text for admitting a language as a language of filing is that the language is familiar and acceptable to the receiving Office, since, without a good knowledge of the language of the international application, no receiving Office will be able to fulfil its functions properly. Rule 12.1 takes care of this fact by providing for admitted languages to be prescribed by the receiving Office. No change is proposed in this respect.
9. The second condition under the present text is that a language can be prescribed as an admitted language by a receiving Office only if it is the language (or one of the languages) which has (or have) been specified, in its agreement with the International Bureau, by the International Searching Authority competent for the international searching of the international application. No change is proposed in this respect.
10. The third condition under the present text is that, if the language of filing is not one of the, at present, five languages of publication, namely, English, French, German, Japanese or Russian, a translation must, for the purposes of international publication, be prepared under the responsibility of the International Searching Authority, and such translation may only be a translation into English. With respect to this restriction of the language of translation, an amendment is proposed. The proposal is to allow that international applications filed in a language other than one of the languages of publication be translated, for the purposes of international publication, into [any](#) of the languages of publication (and not only into English) and to amend Rule 48.3(b) accordingly. International Searching Authorities having languages other than English as official languages, would then—if they wish—be in a position to assume the responsibility for translations into French, German, Japanese or Russian (or Spanish, if the proposals discussed in paragraph 4, above, are adopted). This could open the advantageous possibility for an applicant to choose a language most suited for his purposes if the International Searching Authority would accept such a language. It would also provide an incentive for International Searching Authorities to specify, in the agreements with the International Bureau referred to in Rule 12.1, additional languages which would be languages of receiving Offices for which they act as International Searching Authorities. Each International Searching Authority would have to specify in the said agreement that language of publication, or those languages of publication, into which it is prepared to assume the responsibility for translations.
11. At the same time, it is proposed to change, for the sake of clarity, the wording in Rule 48.3(b), second sentence, related to the time by which the translation of the international application has to be ready. It is proposed to replace the words “to permit the communication under Article 20 by the prescribed date, or, if the international publication is due at an earlier date from the said communication, to permit international publication by the prescribed date” by the following words, which would now appear in the third sentence of Rule 48.3(b): “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.” That proposed amendment is of a purely drafting nature and does not involve any change of substance.

Rule 48

International Publication

48.1 [No change]

48.2 [See page 17, above, and document PCT/CAL/II/3]

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, a translation into one of these languages shall be published. The translation shall be prepared under the responsibility of the International Searching Authority and shall be into the language or one of the languages specified in the agreement concluded between the International Bureau and the International Searching Authority. The International Searching Authority shall be obliged to have the translation 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

[Rule 48.3(b), continued]

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.

(c) [See document PCT/CAL/I/3]

48.4 and 48.5 [No change]

48.6 [See pages 59 and 69, above]

[Annex follows]

(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.
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).*

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Not reproduced in this Annex to document Annex, page 2

(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 (51)	58 (96)
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)
NIGARAGUA	–	–	–	–
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)
URUGUAY	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)

Patents 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.

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]

* 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).