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

SECOND OF THREE PREPARATORY MEMORANDA OF THE INTERNATIONAL
BUREAU

INTRODUCTION

1. The present memorandum is the [second](#) of three documents prepared by the International Bureau within the framework of its study of possible improvements to the Patent Cooperation Treaty (PCT) and submitted to the second session of the PCT Committee for Administrative and Legal Matters.
2. The introduction contained in the first document (PCT/CAL/II/2) applies also to the present document.

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SUBJECT MATTERS OF THE AMENDMENTS PROPOSED IN THIS DOCUMENT

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

(Concerns Rule 42.1)

Proposal approved by the Committee at its first session
(Former Chapter XXXII, see documents PCT/CAL/I/4, pages 40 and 41,
and PCT/CAL/I/9, paragraph 50)

1. Present Rule 42.1 provides for the establishment of international search reports within maximum time limits and that the agreements with the various International Searching Authorities must provide the same time limits for all International Searching Authorities. Since the first agreement concluded with an International Searching Authority has fixed the time limits at the maxima allowed, it is those maxima which had to be and were provided in all the agreements. Naturally, the same time limits would have to be applied also to any agreement with additional International Searching Authorities. Under these circumstances, reference in the Rule to agreements seems superfluous, and it is proposed to convert the maxima provided in the present Rule into fixed time limits.
2. The last sentence of Rule 42.1 contains transitory provisions for the first three years from the entry into force of the PCT. This transitory period is over, and the related text is obsolete. It is therefore proposed to delete the last sentence.

Rule 42

Time Limit for International Search

42.1 Time Limit for International Search

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

*

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

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

(Concerns Rules 46.1 and 46.2)

Revised proposals

(Former Chapter VII, see documents PCT/CAL/I/2, pages 34 to 37,
and PCT/CAL/I/9, paragraph 18)

1. [Ad Rule 46.1](#). The present text of Rule 46.1 provides for a time limit which is two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or, when such transmittal takes place before the expiration of 14 months from the priority date (for the definition of “priority date” see Article 2(xi)), three months from the date of such transmittal. The three-month time limit is applicable in all those cases where the international application has been filed early in the priority year or does not claim the priority of an earlier application. If, for example, the international search report is transmitted to the applicant 10 months after the priority date (which is the international filing date if no priority of an earlier application is claimed), the time limit presently applicable (for filing amendments under Article 19) is 13 months from that date. One does not see, however, why the applicant should not be given more time for filing amendments, since what is important in such a case is that the amendments reach the International Bureau early enough to permit their publication together with the international publication of the international application. If they reach the International Bureau before the expiration of 16 months after the date in question, they will certainly reach the International Bureau in time for including them in the publication of the international application by the International Bureau.
2. Consequently, it is proposed to replace the present time limit (three months from the transmittal of the international search report) by a time limit of 16 months from the priority date. The two-month time limit from the transmittal of the international search report would continue to apply whenever it expires later than 16 months from the priority date (that is, whenever the international search report is transmitted after the expiration of 14 months from the priority date; this is necessarily the case where the international application claims the priority of an earlier application and has been filed at the end of the priority year).
3. Concerning the authority with which any amendments to the claims must be filed under Article 19, the present text of Rule 46 is silent, but it follows from Article 19 that such amendments must be filed with the International Bureau. Since experience shows that sometimes applicants file amendments with the receiving Office or with the International Searching Authority instead, it had been proposed to expressly permit the filing of amendments through the intermediary of the receiving Office or the International Searching Authority (see document PCT/CAL/I/2, page 34, paragraphs 4 and 5). In view of the opinions expressed by the Committee with regard to the compatibility of such a provision with Article 19(1) and to the disadvantages of the rather short 14-day time limit contained in the proposal made to the first session of the Committee, that proposal is not maintained. However, amendments (erroneously) filed with the receiving Office or the International Searching Authority are usually transmitted by that Office or Authority to the International Bureau, so that, eventually, they are filed with the International Bureau, albeit indirectly. The present practice of receiving Offices or International Searching Authorities to transmit amendments filed with them to the International Bureau should not be changed, but no new obligation should be created for Offices or Authorities not following such practice. Furthermore, it appears less complicated to have only one general Rule, namely, that amendments must be received by the International Bureau within the prescribed time limit and that there is no time limit fixed for transmittal by the receiving Office or International Searching Authority—a time limit the observance of which cannot be controlled by the applicant.

Rule 46

Amendment of Claims Before the International Bureau

46.1 Time Limit

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

46.2 Dating of Amendments

[Deleted]

46.3 [See page 11, below]

46.4 [See page 21, below]

46.5 [See document PCT/CAL/II/2, page 49]

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

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

Section 416

Dating of Amendments

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

6. The amendment which had been proposed to Rule 48.2(f) (see document PCT/CAL/I/2, page 36, paragraph 7, and page 37) is no longer required, should the amendments proposed under this Chapter be adopted. It is therefore no longer proposed.

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

(Concerns Rules 12.2, 46.3, 55.2, 66.2, 66.3, 66.8, 66.9, 70.11, 70.16, 70.17 and 92.2)
Proposals approved by the Committee at its first session but revised in the light of observations made at that session and of new considerations (Former Chapter XIII, see documents PCT/CAL/I/3, pages 24 to 29, and PCT/CAL/I/9, paragraph 25)

1. Ad Rules 12.2, 46.3, 66.9 and 70.17(b). Under the present Rule 46.3, amendments to the international application must be made in the language of the international application; however, where the language in which the international application is published is different from the language in which it was filed, amendments must also be made in the language of publication. The languages of publication are, at present, English, French, German, Japanese and Russian. The languages in which international applications may be filed but which are not languages of publication are at present six: Danish, Dutch, Finnish, Icelandic, Norwegian and Swedish. International applications filed in one of these six languages are published, at present, in English translation (see Rule 48.3(b)).
2. The fact that the applicant has to furnish, in the cases referred to above, amendments in two languages (one of the said six languages and English), has been regarded by some applicants as an unnecessary burden since the amendments in the language of the international application would, later on, practically never be used. Naturally, amendments in the language of the international application are useful where that language is the language of a designated Office. This is, however, rather rare, as international applications filed in one of the six languages frequently claim the priority of an earlier application filed in that language. The Office with which such earlier application was filed will usually not be a designated Office and the designated Offices will usually require the use of their own language. (If the language of a designated Office should be the language of the international application, the applicant would need amendments in such language, but this would occur only in very rare cases and at the time of entering the national phase.) Therefore, a general requirement to file amendments in two languages, when the language of the international application and the language of its publication are different, seems, indeed, to be superfluous.
3. It is therefore proposed to amend Rule 46.3 in order to provide that, where the language of publication is different from the language of filing, amendments made under Article 19 must be made only in the language in which the international application is published.
4. For amendments made under Article 34(2)(b), there is, at present, no express provision requiring, for the case that the language of publication is different from the language of filing, that such amendments must be filed in two languages. It follows only indirectly from Rule 70.17(b) that the said amendments must be in the language of filing and in the language of publication since they are to be annexed in these two languages to the international preliminary examination report*. It is proposed to amend the Regulations by deleting Rule 70.17(b) and replacing it by a new Rule 66.9. The latter Rule would provide that, where the language of publication is different from the language of filing, amendments made under Article 34(2)(b) (as well as any letter communicating an amendment consisting of the cancellation of an entire sheet) must be submitted only in the language in

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

Rule 12

Language of the International Application

12.1 [See document PCT/CAL/II/2, page 19]

12.2 Language of Changes in the International Application

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

Rule 46

Amendment of Claims Before the International Bureau

46.1 and 46.2 [See page 7, above]

46.3 Language of Amendments

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

46.4 [See page 21, below]

46.5 [See document PCT/CAL/II/2, page 49]

which the international application is published. Rule 70.17(b) becomes then obsolete, since the language of the annexes to the international preliminary examination report follows from the general provisions determining in which languages they have to be submitted. Furthermore, it appears more appropriate to deal with the questions of languages for amendments within the framework of Rule 66 concerning the procedure before the International Preliminary Examining Authority than under Rule 70, since the latter Rule contains basically only instructions for the International Preliminary Examining Authority concerning the international preliminary examination report and not provisions addressed (also) to the applicant concerning the procedure before the International Preliminary Examining Authority.

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

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

7. It is therefore proposed to delete Rule 55.2: that Rule provides only for a theoretical case which, as can be seen after several years of operations under the PCT, has never arisen in practice and is not likely to arise in the future. As a consequence of the proposed deletion of Rule 55.2, paragraph (c) of Rule 92.2, which may apply only in cases where Rule 55.2 is applicable, should also be deleted. (The deletion of the reference to paragraph (c) of Rule 99.2 in its paragraph (a) is consequential to the deletion of Rule 99.2(c), whereas the reference to Rule 66.9 is proposed to be added in Rule 92.2(a) as a consequence of the insertion of new Rule 66.9.)

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

Rule 55

Languages (International Preliminary Examination)

55.1 [No change]

55.2 The International Application

[Deleted]

Rule 66

Procedure Before the International Preliminary

Examining Authority

66.1 [No change]

66.2 First Written Opinion of the International Preliminary Examining Authority

(a) and (b) [No change]

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

(d) [No change]

*

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

9. [Ad Rules 70.16 and 70.17\(a\)](#). The terminology used in the present English text of these Rules is not uniform: in some instances, the words “attachment” or “attached” are used (once in the title of Rule 70.16 and twice in the text of that Rule), whereas in other instances the words “annex,” “annexes” or “annexed” are used (twice in the text of Rule 70.16, once in the title of Rule 70.17 and once in the text of the latter Rule), although in all instances they speak of the same thing. The French text of the same Rules uses one and the same expression—namely “[annexe](#)” and its derivatives—in all these instances. From the many questions received by the International Bureau related to the interpretation of these two Rules, it appears to be appropriate to clarify the English text by using—like in the French text—only one expression. It is therefore proposed to use in the English text only the word “annex.” (The other amendments proposed to Rule 70.16 are consequential to the proposals explained in the preceding paragraph and to the proposed deletion of Rule 66.8(b) (see document PCT/CAL/II/2, Chapter 11).)

66.3 [Formal Response to the International Preliminary Examining Authority](#)

(a) The applicant may respond to the invitation referred to in Rule 66.2(c) of the International Preliminary Examining Authority by making amendments^{*} or—if he disagrees with the opinion of that Authority—by submitting arguments, as the case may be, or do both.

(b) [No change]

66.4 [See page 41, below]

66.5 [See page 57, below]

66.6 [No change]

66.7 [See pages 45 and 47, below]

66.8 [Form of** Amendments](#)

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

(b) [See document PCT/CAL/II/2, page 51]

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

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

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

66.9 [Language of Amendments](#)

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

[Rule 70](#)[The International Preliminary Examination Report](#)

70.1 to 70.10 [No change]

70.11 [Mention of Amendments](#)*

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

70.12 to 70.15 [No change]

70.16 [Annexes of the Report](#)

If the claims, the description, or the drawings, were amended** before the International Preliminary Examining Authority, each replacement sheet*** shall be [annexed to the report](#). Replacement sheets superseded by later replacement sheets shall not be [annexed](#). If the amendment is communicated in a letter, a copy of such letter shall also be annexed to the report.

*

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

**

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

The amendment consists of deleting, after the word “sheet,” the words “marked as provided in Rule 66.8(b).” It is consequential to the deletion of that Rule (see document PCT/CAL/II/2, page 51).

70.17 [Languages of the Report and the Annexes](#)

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

(b) [\[Deleted\]](#)

[Rule 92](#)

[Correspondence](#)

92.1 [No change]

92.2 [Languages](#)

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

(b) [No change]

(c) [\[Deleted\]](#)

(d) and (e) [No change]

92.3 and 92.4 [No change]

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

(Concerns Rule 46.4)

Proposal approved by the Committee at its first session
(Former Chapter XI, see documents PCT/CAL/I/3, pages 18 to 20, and
PCT/CAL/I/9, paragraph 23)

1. Under Article 19(1), the applicant may amend the claims before the International Bureau and file, at the same time, a brief statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings. Details concerning the statement are provided for in Rule 46.4. The statement is to be distinguished from the letter which is required under Rule 46.5 either in order to explain the differences between the replacement sheets (on which the amendments are submitted) and the replaced sheets or in order to cancel entire sheets. The statement must, under the present Rule 46.4(b), contain no comments on the international search report or the relevance of the citations contained in that report but it may refer to a citation (appearing in the said report) in order to indicate that a specific amendment of a claim is intended to avoid the cited document. The statement will not be published by the International Bureau if the latter finds that it does not comply with the provisions of Rule 46.4(see Rule 48.2(h)).
2. [Ad Rule 46.4\(a\)](#). The International Bureau has encountered difficulties in determining in papers received from the applicant what is meant by him to be a statement under Article 19(1) and what is to be taken as a letter explaining the differences between replaced and replacement sheets or cancelling an entire sheet. Yet the correct determination is important since: (i) the statement is, whereas the explanatory letter is not, to be published and (ii) any statement published and communicated to the designated Offices is considered to be part of the international application (see present Rules 49.3 and 76.3) and must be translated under Article 22(1) or Article 39(1)(a) whereas the contrary is true for any explanatory letter. If the explanatory letter is taken by the International Bureau to be a statement but was not meant as such by the applicant, there is a risk that the applicant will fail to prepare the prescribed translation for the designated Offices and thus furnishes an incomplete translation. On the other hand, it can also happen that what is taken by the International Bureau as an explanatory letter was meant by the applicant to be a statement under Article 19 and therefore would neither be published nor communicated to the designated Offices.
3. It is proposed to eliminate the risk of such a confusion by adding to Rule 46.4(a) an additional sentence that would require that any statement under Article 19(1) must—by the applicant- -be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement. It would follow from this Rule that if a text is not so identified by the applicant, the International Bureau would consider it as an explanatory letter which, because it is a mere letter and not an explanatory statement, is neither published nor communicated to the designated Offices. The applicant would then also know that only what was meant to be a statement and has been identified as such by him through the said heading will have to be included in the translation to be furnished under Article 22(1) or Article 39(1)(a).
4. [Ad Rule 46.4\(b\)](#). The checking of compliance of a statement with the provisions of the existing Rule 46.4(b) is, in practice, sometimes a difficult task: the statement must, on the one hand, contain no comments on the relevance of the citations contained in the international search report but it may, on the other hand, refer to such a citation to indicate that a specific amendment of a claim is intended to avoid the document cited and this reference often contains a kind of explanation that the cited document is not relevant in relation to what is still claimed in the amended claim. The borderline between such an explanation and a comment which is not admitted under the present Rule is not always entirely clear. The applicant has problems when drafting a statement complying with Rule 46.4(b) and the International Bureau when checking the compliance of the statement with that Rule.

Rule 46

Amendment of Claims Before the International Bureau

46.1 and 46.2 [See page 7, above]

46.3 [See page 11, above]

46.4 Statement

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

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

46.5 [See document PCT/CAL/II/2, page 49]

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

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

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

(Concerns Rules 47.1, 47.2 and 48.2)

Revised proposal (drafting only)

(Former Chapter XXXIII, see documents PCT/CAL/I/4, pages 42 to 47,
and PCT/CAL/I/9, paragraphs 51 and 52)

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

Rule 47

Communication to designated Offices

47.1 Procedure

(a) [No change]

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

(c) to (e) [No change]

47.2 Copies

(a) and (b) [No change]

(c) Copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.

47.3 [No change]

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

7. [Ad Rule 47.2\(c\)](#). All designated Offices have accepted that the International Bureau uses copies of the pamphlet under Rule 48 for the purposes of the communication of the international application under Article 20. The advantages of this practice are evident. The use of the pamphlet has also brought about considerable economies for the International Bureau. In order to secure that any future designated Office would follow the general practice of all present designated Offices, it is proposed to delete from the present text of Rule 47.2(c) the words “Except to the extent that any designated Office notifies the International Bureau otherwise.” It should be understood, however, that the special demands made by some designated Offices, in particular the Offices of Japan (to receive a copy of the request in addition to the pamphlet) and the United States of America (to receive the pamphlet in a version printed recto only), will continue to be satisfied on the basis of bilateral arrangements although they constitute a burden for the PCT budget. In other words, such special demands would not be affected by the proposed amendment to Rule 47.2(c).

Rule 48International Publication

48.1 [No change]

48.2 Contents

(a) [No change]

(b) [See document PCT/CAL/II/2, page 17]

(c) to (f) [No change]

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

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

(i) [No change]

48.3 [See document PCT/CAL/II/2, pages 75 and 77, and see page 31, below]

48.4 and 48.5 [No change]

48.6 [See document PCT/CAL/II/2, pages 59 and 69]

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

(Concerns Rule 48.3)

Proposal approved by the Committee at its first session;
new additional proposal explained in paragraph 4

(Former Chapter XXXIV, see documents PCT/CAL/I/4, pages 48 and 49,
and PCT/CAL/I/9, paragraph 53)

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

Rule 48

International Publication

48.1 [No change]

48.2 [See document PCT/CAL/II/2, page 17, and see page 27, above]

48.3 Languages

(a) and (b) [See document PCT/CAL/II/2, pages 75 and 77]

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

48.4 and 48.5 [No change]

48.6 [See document PCT/CAL/II/2, pages 59 and' 69]

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

(Concerns Rules 53.1 and 61.1)

Proposals approved by the Committee (subject to drafting changes)
at its first session

(Former Chapter XII, see documents PCT/CAL/I/3, pages 22 and 23,
and PCT/CAL/I/9, paragraph 24)

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

Rule 53

The Demand

53.1 Form

(a) to (c) [No change]

(d) [Deleted]

53.2 to 53.8 [No change]

Rule 61

Notification of the Demand and Elections

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

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

(b) [See page 37, below]

(c) [No change]

61.2 and 61.3 [No change]

*

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

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

(Concerns Rules 54.3, 54.4, 58.3 and 61.1)

Revised proposals

(Former Chapter XXXV, see documents PCT/CAL/I/4, pages 50 to 53,
and PCT/CAL/I/9, paragraphs 54 and 55)

1. [Ad Rules 54.3 and 54.4](#). Present Rule 54.3(b) provides that, in the (exceptional) case of different applicants indicated for the purposes of different elected States, the election of a State is considered not to have been made if none of the applicants indicated for the purposes of that State is qualified to make a demand under Article 31(2).
2. Rule 54 does not contain a provision for the (more common) case where the applicant or, in case of several applicants indicated for the purposes of all elected States, none of them is qualified under Article 31(2) to make a demand.
3. Although there are no doubts about the legal consequence in cases where none of the applicants is qualified to make a demand, it is proposed to clarify the situation by adding a new Rule 54.4 to Rule 54. Paragraph (a) would provide that the demand shall be considered not to have been made if the applicant or, in case of several applicants, none of them is entitled to make a demand. Paragraph (b) would be practically identical to the present text of Rule 54.3(b), which is proposed to be transferred to Rule 54.4 in order for that Rule to cover all cases of applicants not qualified to make a demand. Paragraph (c) would provide for the notification by the International Preliminary Examining Authority of the applicant and the International Bureau where the demand is considered, under paragraph (a), not to have been submitted or the election of a State is considered, under paragraph (b), not to have been made. Presently, such notifications are provided in Section 601 of the Administrative Instructions but their correct place is in the Regulations, like similar kinds of notifications (see, for example, Rules 29.1(a)(ii) and 29.1(b)). Consequently, it is proposed to delete Section 601.
4. [Ad Rule 58.3](#). Where the demand is considered not to have been submitted because of non-payment of the handling fee or the preliminary examination fee in spite of an invitation to pay (Rules 57.4(c) and 58.2(c)) or because the applicant did not comply with an invitation to correct a defect in the demand (Rule 60.1(c)), a refund of any amount paid as preliminary examination fee is provided for in present Rule 58.3. It seems to be justified to apply the same Rule to the case where the demand would be considered not to have been made under the proposed new Rule 54.4(a). In addition, there may be other cases where a demand is considered not to have been made, for example, the case where a national of a Contracting State not bound by Chapter II of the PCT makes a demand under Article 31(2) but elects only States which have not declared that they are prepared to be elected by such an applicant (see Article 31(4)(b)). In order to be sure that all such cases are covered by Rule 58.3, it is proposed to amend it by deleting all references to other provisions.
5. [Ad Rule 61.1\(b\)](#). Where the demand is considered not to have been submitted under Rules 57.4(c), 58.2(c) or 60.1(c), the International Preliminary Examining Authority must, under the present text of Rule 61.1(b), notify the applicant but not the International Bureau. On the other hand, where the demand is considered not to have been submitted under the proposed new Rule 54.4(see paragraph 4, above), the International Preliminary Examining Authority must, under the present text of Section 601—which is proposed to be incorporated into new Rule 54.4(see paragraph 3, above)—notify not only the applicant but also the International Bureau. It is proposed to eliminate such discrepancy by providing for a notification to the International Bureau also in Rule 61.1(b). In addition, it is proposed to add a new Section to the Administrative Instructions in order to provide for a notification by the International Bureau to all elected Offices concerned

Rule 54

The Applicant Entitled to Make a Demand

54.1 and 54.2 [No change]

54.3 Several Applicants: Different for Different Elected States

(a) [No change]

(b) [~~Deleted~~]

54.4 Applicant Not Entitled to Make a Demand

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

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

(c) Where paragraph (a) or (b) applies, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

where they have been notified of their elections and the demand is considered not to have been submitted, or the relevant election is considered not to have been made. The text of new Section 418 could read as follows:

Section 418

Notifications to Elected Offices Where the Demand or an Election

is Considered Not to Have Been Submitted or Made

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

Rule 58

The Preliminary Examination Fee

58.1 and 58.2 [No change]

58.3 Refund

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

Rule 61

Notification of the Demand and Elections

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

(a) [See page 33, above]

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

(c) [No change]

61.2 and 61.3 [No change]

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

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

(Concerns Rule 60.3)

Proposal adopted in substance by the Committee at its first session
(Former Chapter XXXVI, see documents PCT/CAL/I/4, pages 54 and 55,
and PCT/CAL/I/9, paragraph 56)

1. Present Rule 60.3 provides that, where the applicant has attempted to elect a State which is not a designated State or which is not bound by Chapter II, the International Bureau must notify the applicant that the attempted election is considered not to have been made. This provision applies irrespective of whether the attempted election was made in the demand (any other defect in a demand must be notified to the applicant by the International Preliminary Examining Authority; see present Rule 60.1(a) and (d)) or in the later election (any other defect in a later election must be notified to the applicant by the International Bureau; see present Rule 60.2(a)).
2. It is proposed to provide that, where the attempted election is in the demand, the International Preliminary Examining Authority—rather than the International Bureau—must notify the applicant that such attempted election is considered not to have been made. This proposal is made because if it is the said Authority that has to make the notification, the applicant will receive it sooner than if it has to be made by the International Bureau (since the demand has to be first notified to the International Bureau; see Rule 61.1(a)).
3. It is furthermore proposed to transfer the contents of Rule 60.3 to the Administrative Instructions and consequently to delete that Rule. This proposal is made in order to harmonize the provisions applicable to “attempted designations” and to “attempted elections.” The Regulations do not contain any provisions applicable to the case of an attempted designation, although such case is much more frequent, in practice, than the case of an attempted election. Attempted designations, however, are dealt with in Section 201(b) of the Administrative Instructions, which provides, in essence, for the cancellation ex officio of any attempted designation. It is proposed to deal with attempted elections in the same way, *mutatis mutandis*, by adding a new paragraph (c) to Section 201. The text of such a modified Section 201 could read as follows:

Section 201

Names of States; Cancellation of Attempted

Designations and Elections

(a) and (b) [No change]

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

Rule 60

Certain Defects in the Demand or Elections

60.1 and 60.2 [No change]

60.3 Attempted Elections

[Deleted]

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

(Concerns Rules 66.4 and 69.1)

Proposal concerning Rule 66.4 unchanged; proposal concerning Rule 69.1 approved by the Committee at its first session subject to the approval of the proposed amendment to Article 39(1)(a) and to a further study of the time limit (Former Chapter XV, see documents PCT/CAL/I/3, pages 34 to 37, PCT/CAL/I/7 and PCT/CAL/I/9, paragraphs 27 and 28)

1. Ad Rule 66.4. Under the present text of Rule 66.3, the applicant may reply to a written opinion of the International Preliminary Examining Authority issued under Rule 66.2 by submitting amendments or corrections or—if he disagrees with the opinion of that Authority—by submitting arguments, as the case may be, or do both. The International Preliminary Examining Authority has, under Rule 66.4(a), the possibility to issue one or more additional written opinions and the applicant has the same right to respond as outlined above. When, however, the applicant requests the International Preliminary Examining Authority, without having received an additional written opinion, to give him one or more additional opportunities under Rule 66.4(b), such opportunities are presently limited to the submission of amendments or corrections and do not include the possibility of submitting arguments.
2. Practice has shown that some applicants would like to have, during the international preliminary examination, also the right to request one or more additional opportunities for the submission of arguments in support of the international application.
3. It is therefore proposed to amend Rule 66.4(b) by allowing also a request for one or more additional opportunities to submit arguments. This amendment would contribute to the better acceptance of Chapter II by applicants since it would broaden the possibility for a dialogue between the applicant and the International Preliminary Examining Authority. It is to be noted that the practice of some of the International Preliminary Examining Authorities already allows applicants to present additional arguments and it would be useful to harmonize the practice of all International Preliminary Examining Authorities. Cases where an applicant may want to present additional arguments are, for example, that the applicant had further thoughts giving him better arguments in addition to those already submitted in response to an opinion of the International Preliminary Examining Authority, or that tests made by the applicant in the meantime have resulted in a better knowledge of the invention. In such cases, the applicant should be permitted to present his new arguments or knowledge to the International Preliminary Examining Authority. This would eventually result in an improvement of the international preliminary examination report, which is in the interest of both the applicant and the elected Offices.
4. Since the provision of Rule 66.4(b) uses the word “may,” the International Preliminary Examining Authority would have the possibility to refuse requests to submit additional arguments if the time limit for international preliminary examination is too short to permit to give the applicant a further opportunity to submit such arguments or if it appears to be a hopeless case, namely, where it is clear that additional arguments would not change the opinion of the International Preliminary Examining Authority. The proposed amendment would thus not put a further burden on the International Preliminary Examining Authority nor increase the cost of the establishment of the international preliminary examination report.
5. For the reasons explained in paragraph 8 of Chapter 18, above, it is furthermore proposed to delete all references to corrections in Rule 66.4.

Rule 66

Procedure Before the International Preliminary

Examining Authority

66.1 [No change]

66.2 [See page 13, above]

66.3 [See page 15, above]

66.4 Additional Opportunity for Submitting Amendments or Arguments

(a) [No change]

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

66.5 [See page 57, below]

66.6 [No change]

66.7 [See pages 45 and 47, below]

66.8 [See page 15, above, and document PCT/CAL/II/2, page 51]

66.9 [See page 17, above]

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

7. In the first session of the Committee, it has been proposed by the Delegation of Sweden (see document PCT/CAL/I/7) and accepted by the Committee to provide for a single time limit for international preliminary examination in order to simplify the PCT procedure. The new single time limit should give more time for international preliminary examination. The Committee left open the question whether the time limit should be 8 or 9 months after the start of the international preliminary examination. It is now proposed to fix the time limit at 9 months.

8. The time limit would thus be 3 months or 1 month longer than under present Rule 69.1(a)(i) and (ii), respectively. Such longer time limit is obviously to the advantage of the applicant since it gives him more time for his efforts to convince the International Preliminary Examining Authority of the well-foundedness of his application or his efforts to amend his claims to make them (more) acceptable. Such extended time limit would, in all normal cases, permit the applicant to avail of the international preliminary examination report at least two months before the national phase may start. It would thus allow the applicant to make his decision about the entering into the national phase after the receipt of the international preliminary examination report and before he must incur the major expenses required for the entry into the national phase. The establishment of the international preliminary examination report only two months before the national phase must be entered makes it rather short for the applicant to consider carefully the results of the international preliminary examination report and to prepare for the entry into the national phase. It is to be noted, however, that the proposed time limit is a maximum time limit, which will have to be used by the International Preliminary Examining Authority only in special cases. The majority of international preliminary examination reports can be established—as under the present procedure—in a time which is much shorter than 9 months and thus give the applicant all the time needed for careful consideration of and preparation for the entry into the national phase.

9. It is to be noted that the proposal is linked to, and therefore subject to, the adoption of the proposed extension of the time limit under Article 39(1)(a) to 30 months from the priority date (see document). If the proposed amendment to Article 39(1)(a) were not to be accepted, it would probably be better to keep the present two time limits under Rule 69.1(a)(i) and (ii) and to add, as proposed in document PCT/CAL/I/3, page 37, a third one for the case where the applicant has made a request under Rule 66.4(b) to submit new amendments or arguments.

Rule 69

Time Limit for International Preliminary Examination

69.1 Time Limit for International Preliminary Examination

(a) The time limit for establishing the international preliminary examination report shall be 9 months after the start of the international preliminary examination.

(b) and (c) [No change]

[Chapter 26: Simplifying the procedure where the International Preliminary Examining Authority needs the priority document but the International Bureau has not received it under Rule 17.1](#)

(Concerns Rule 66.7)

Revised proposal

(Former Chapter XXXVII, see documents PCT/CAL/I/4, pages 56 and 57, and PCT/CAL/I/9, paragraph 57)

1. [Ad Rule 66.7\(a\), \(b\) and \(c\)](#). Under the present text of Rule 66.7(a), where the International Preliminary Examining Authority requests the International Bureau to furnish to it a copy of the priority document, and where the International Bureau has not yet received the priority document under Rule 17.1(a), the applicant must furnish a copy of the application whose priority is claimed in the international application.
2. It is proposed to amend Rule 66.7(a) by making reference to Rule 17.1 (rather than Rule 17.1(a)), which will make Rule 66.7(a) applicable also to Rule 17.1(b), namely, to the case where the receiving Office is requested by the applicant to transmit the priority document to the International Bureau.
3. At the same time, it is proposed to more closely link the procedure under Rule 66.7 to the procedure under Rule 17.1. Presently, those two procedures are separated in the (rare) case where the International Bureau has not received the priority document under Rule 17.1 before it is requested by the International Preliminary Examining Authority to furnish a copy thereof to it. In such a case, the applicant must, under the present Rule 66.7(a), furnish a copy of the earlier application to the International Bureau and directly to the International Preliminary Examining Authority. If the applicant failed to comply with the requirements of Rule 17.1 within the applicable time limit—which is normally 16 months after the priority date—the priority claim may be disregarded by the elected Offices under Rule 17.1(c) even if the applicant timely furnishes, under Rule 66.7(a), the requested copies to the International Bureau and to the International Preliminary Examining Authority. The result is that the International Preliminary Examining Authority will take the priority claim into account although such claim may be disregarded by the elected Offices. Such discrepancy is undesirable. Furthermore, present Rule 66.7(a) does not require the copy of the earlier application which the applicant has to furnish to the International Preliminary Examining Authority to be a certified copy. Some doubts may thus be created as to whether the copy received by the International Preliminary Examining Authority is a true copy or not.
4. In order to avoid the inconveniences of the present system, it is proposed to provide for a system whereby the copy of the earlier application which is furnished to the International Preliminary Examining Authority under Rule 66.7 is always a copy of the priority document furnished to the International Bureau under Rule 17.1. If the request of the International Preliminary Examining Authority for such a copy is made before the 16-month time limit of Rule 17.1—which should be exceptional—and the priority document has not yet been received by the International Bureau, that Bureau would remind the applicant of his obligations under Rule 17.1 and warn him at the same time that any delay in complying with those requirements (even before the expiration of the 16-month time limit) will shorten the time available for preliminary examination. It will thus be in the interest of the applicant to quickly react to the reminder of the International Bureau. If, on the other hand, the 16-month time limit has expired and the applicant has not complied with the requirements of Rule 17.1 at the time when the International Preliminary Examining Authority requests a copy of the earlier application, it is better for the examination report to be established without recourse to such a copy and, consequently, without taking into account the priority claim since, in such a situation, the priority claim may be disregarded by the elected Offices. It is to be noted that the international preliminary examination report will indicate, as it already does at present, that it has been established as if no priority had been claimed (see Form PCT/IPEA/409).

Rule 66

Procedure Before the International Preliminary

Examining Authority

66.1 [No change]

66.2 [See page 13, above]

66.3 [See page 15, above]

66.4 [See page 41, above]

66.5 [See page 57, below]

66.6 [No change]

66.7 Priority Document

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

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

Section 417

Invitation to Furnish a Copy of the Priority Document

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

[Rule 66.7, continued]

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

(c) [\[Deleted\]](#)

66.8 [See page 15, above, and document PCT/CAL/II/2, page 51]

66.9 [See page 17, above]

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

(Concerns Rule 80.6)

Unchanged proposal

(Former Chapter XXXVIII, see documents PCT/CAL/I/4, pages 58 and 59, and PCT/CAL/I/9, paragraph 58)

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

Rule 80

Computation of Time Limits

80.1 to 80.5 [No change]

80.6 Date of Documents

(a) [No change]

(b) [Deleted]

80.7 [No change]

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

(Concerns Rules 88.2 and 88.4)

Proposal made by the Delegation of the Netherlands

(See document PCT/CAL/I/8)

1. Ad Rule 88.2. This Rule contains provisions applicable only “during the first 5 years after the entry into force of the Treaty.” Since that period expires on January 24, 1983, the Rule is no longer applicable from that date. Its continued presence in the Regulations would therefore be superfluous. It is suggested that it be deleted.
2. Ad Rule 88.4. The proposed amendment to that Rule, which consists of deleting the reference to Rule 88.2, is consequential to the proposed deletion of that same Rule 88.2.

Rule 88

Amendment of the Regulations

88.1 Requirement of Unanimity

[No change]

88.2 Requirement of Unanimity During a Transitional Period

[Deleted]

88.3 [No change]

88.4 Procedure

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

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

[Chapter 29; Correcting a mistake in Rule 90.3\(c\)](#)

(Concerns Rule 90.3)

Proposal made by the Delegation of the Netherlands

(See document PCT/CAL/I/8)

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

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

[Section 106](#)

[Common Agent for Several Applicants](#)

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

(b) [No change]

*

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

**

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

Rule 90
Representation

90.1 and 90.2 [No change]

90.3 Appointment

(a) and (b) [No change]

(c) If the separate power of attorney is not signed^{*}, or if the required power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered non-existent unless the defect is corrected.

(d) [No change]

90.4 [No change]

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

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

(Concerns Rules 4.10, 66.5, 91.1 and 91.2)

Revised proposal

(Former Chapter XVIII, see documents PCT/CAL/I/3, pages 44 to 51,
and PCT/CAL/I/9, paragraph 32)

1. Ad Rule 91.1(a) to (d). The present provisions allow the rectification of what are referred to as “obvious errors of transcription” in the international application and other papers submitted by the applicant and expressly exclude the possibility of correcting the omission of entire elements or sheets. It is proposed to make those provisions somewhat more liberal in certain cases. Any obvious error—and not only obvious errors “of transcription”—should be rectifiable and in some cases the omission of missing sheets should be rectifiable. As far as the rectification offered is concerned, it would continue to be required that it be obvious in the sense that “nothing else could have been intended” than what is offered as rectification but the realization of such obviousness would no longer be required to be an “immediate” realization by “anyone.” Some erroneous omissions, however, would not be rectifiable: such would be the case if any element referred to in Article 11(1)(iii) has been entirely omitted, for example, the whole description or all the claims. Such omissions should not be rectifiable because any such omitted element is a condition for the according of an international filing date. If, however, in the case of an element consisting of several sheets, a sheet of that element has been omitted, the possibility to rectify such omission should not be excluded. The case of the drawings is a special one: the omission of any drawing referred to in the international application would not be rectifiable with maintaining the filing date since the provisions of Article 14(2) would apply, whereas the omission of any drawing not referred to in the international application would be rectifiable. As far as the addition of a third sentence to Rule 91.1(d) is concerned, see paragraph 13, below.
2. Ad Rule 91.1(e). This paragraph specifies which authority or office is competent to decide to accept or refuse a request for the rectification of an error. The provisions would, with one exception, remain the same as in the present provisions. The exception would relate to the case in which the error consists in omitting an intended designation: in that case, it would be the national Office of (or acting for) the State whose designation was so omitted which would be competent to decide whether to accept the rectification. Rule 91.1(e) would also indicate that the said Office would not authorize the rectification where it would run counter to its national law. Such an indication would mean that any Contracting State could reject its designation effected through the correction of an error even where the error is provable and proven. Details concerning the omission of intended designations are provided in what would be new paragraph (i); that paragraph is commented upon in paragraphs 9 to 12, below.
3. Ad Rules 91.1(f) and (h). At present, paragraph (f) reads as follows: “The date of the authorization [to rectify] shall be recorded in the files of the international application,” whereas paragraph (h) reads as follows: “Any authority, other than the International Bureau, which authorizes any rectification shall promptly inform the International Bureau of such rectification.” It is proposed to transfer the contents of present paragraph (h) to paragraph (f), in view of the fact that the notification of the authorization for rectification to the International Bureau is referred to in the proposed new text of paragraph (g) (see the next paragraph). At the same time, the requirement of “recording” in the files of the international application would be omitted as not sufficiently clear (whose files are meant?) and unnecessary (since the files of the International Bureau would, in any case, show the rectification). On the other hand, in view of its importance to the applicant, it is proposed to transfer to the Regulations (paragraph (f) of Rule 91.1) the notification of the authorization (or the refusal thereof) to the applicant, which is at present only provided for in the Administrative Instructions (see Section 109, the deletion of which is proposed).

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 Priority Claim

(a) [No change]

(b) If the request does not indicate both

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

(ii) the date on which it was filed,

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

(c) [No change]

(d) [See document PCT/CAL/II/2, page 7]

(e) [No change]

*

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

4. [Ad Rule 91.1\(g\)](#). Both the present paragraph (g) and paragraph (g) as proposed to be amended deal with the time limit or event until which a rectification can be made. The proposed changes would essentially be clarifications and would make the situation of the applicant more secure since the events and dates would be more precise. Thus, where the rectification is authorized by the receiving Office or the International Searching Authority, it would have to reach the International Bureau by the expiration of 17 months from the priority date, which should be ample and would secure that the international publication would take into account the rectification; where the rectification is authorized by the International Bureau, it would have to be effected by the expiration of the same time limit (which would have the same advantages). There is no change proposed in respect to rectifications authorized by the International Preliminary Examining Authority. It is to be noted that for the rectification of the omission of a designation, no time limit is provided for for the granting of the authorization since it is a matter which affects only the (intended) designated State; on the other hand, as will be seen, paragraph (i) does provide a time limit for making a request for such a rectification. Finally, it is to be noted that the provisions of paragraph (g) would be subject to three qualifications, which are dealt with in proposed paragraphs (g-[bis](#)), (g-[ter](#)) and (g-[quater](#)).
5. [Ad Rule 91.1\(g-bis\)](#). The first qualification is contained in paragraph (g-[bis](#)). It would allow to accept rectifications even beyond the 17-month time limit in the cases covered by paragraph (g)(i) and (iii): where the rectification authorized by the receiving Office or the International Searching Authority reaches the International Bureau after the expiration of that time limit but at a moment when it can still be taken into account in the international publication, the rectification will be effective. In practice, this could mean one or two weeks beyond the 17-month time limit; in other words, the possibility to rectify could go up to two or three weeks before the actual publication (to be effected promptly after the expiration of the 18-month time limit) of the international application. Similar flexibility would apply in the case of rectifications authorized by the International Bureau.
6. [Ad Rule 91.1\(g-ter\)](#). The second qualification to paragraph (g) is contained in proposed paragraph- (g-[ter](#)). It applies where the applicant asked for early publication. The time limits in paragraph (g) are based on the assumption that international publication occurs promptly after the end of the 18th month from the priority date. Where international publication occurs earlier—because the applicant asked for an early publication—the time limits concerning rectifications must expire earlier, otherwise the rectifications could not be taken into account in the international publication. It is proposed that the time limit should be the date on which the request for early publication reaches the International Bureau. Thus, the International Bureau will be able to take into account the rectification in the early publication of the international application.
7. [Ad Rule 91.1\(g-quater\)](#). The third qualification to paragraph (g) is contained in paragraph (g-[quater](#)). It applies where the international application is not published (because none of the designated States requires publication). In that case, obviously, the 18-month publication date is of no influence on setting a time limit. But the date of communication under Article 20 is of such influence, since the communication should take into account any rectification. This is why the proposed limit is the time of communication under Article 20. In fact, this means that the time limit will be between 18 and 19 months from the priority date which, in turn, means an additional ½ to 2 months for rectifications. Such longer time limit is naturally an added advantage for the applicant.
8. [Ad Rule 91.1\(h\)](#). See the observations under paragraph 3, above.

4.11 to 4.16 [No change]

4.17 [See document PCT/CAL/II/2, page 9]

Rule 66

Procedure Before the International Preliminary

Examining Authority

66.1 [No change]

66.2 [See page 13, above]

66.3 [See page 15, above]

66.4 [See page 41, above]

66.5 Amendment

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

66.6 [No change]

66.7 [See pages 45 and 47, above]

66.8 [See page 15, above, and document PCT/CAL/II/2, page 51]

66.9 [See page 17, above]

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

9. [Ad Rule 91.1\(i\)](#). This new paragraph would deal with the case where the applicant asks for a rectification alleging that he intended to designate a State but, through an error, failed to do so in the request part of the international application. The request for rectification would have to be filed with the receiving Office and would have to be accompanied by the designation fee (unless more designation fees were originally paid than required in view of the number of designations effected in the request part of the international application). The time limit for requesting such a rectification would be 15 months from the priority date. Such a time limit would be enough since it would give the applicant a minimum of three months after the filing of the international application to discover the omission. It would, at the same time, give several weeks to the applicant after he receives the notification of the International Bureau under Rule 24.2(a); that notification contains the list of the designated offices and, by reading that list, the applicant can discover the omission made by him.

10. The receiving Office would communicate the request for rectification to the International Bureau. Thus, the International Bureau could take it into account in the international publication of the international application. But since the decision on the request for rectification is—as will be seen later—reserved for the (intended) designated Office and since at the time of the international publication of the international application that decision is not yet taken, the international publication would have to, and would, indicate that the designation is [subject to](#) the said decision. Thus, the uncertainty of the effect of such designation would be flagged.

11. The (intended) designated Office would receive the request for rectification together with the international application communicated to it under Article 20. Once the national processing of the international application starts before the (intended) designated Office, and only then, will the decision be taken, by that Office, whether the rectification is accepted. Naturally, the (intended) designated Office may reject the request for rectification if it finds that the error is not proved.

12. The rectification of the omission of a designation is to be distinguished from a “later” designation, which is a designation made after the filing of the international application and which was not intended to be made by the applicant when he filed the application. “Later” designations are, and would continue to be, [not](#) permitted, since Contracting States must be designated in [the request](#) (see Rule 4.9), and this means, naturally, at the time of filing. The rectification of the request, under Rule 91.1, with respect to a designation, however, relates to a designation which was intended at the time of filing but was erroneously omitted because, for example, the applicant checked by mistake, in Box V of the request form, a check box above or below the check box which the applicant intended to check. The rectification of such an error would [not](#) be a “later” designation but simply the correction of a clerical mistake. Such mistake should, subject to the conditions laid down in Rule 91.1(a) to (c), be rectifiable like any other clerical mistake, except where such rectification would, as outlined in paragraph 2, above, run counter to the national law.

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

Rule 91Obvious Errors in Documents91.1 Rectification

(a) Subject to paragraphs (b) to (i), obvious errors* in the international application or other papers submitted by the applicant may be rectified.

(b) An error which is due to the fact that something other than what was obviously intended by the applicant was written, or that something that was obviously intended by the applicant to be included was omitted, in the international application or other paper submitted by the applicant, shall be regarded as an obvious error. The rectification itself must, in order to be authorized, be obvious in the sense that** nothing else could have been intended by the applicant, at the time he filed the international application or other paper containing the obvious error, than what he offers as rectification.

(c) The omission of any element referred to in Article 11(1)(iii) or of any drawing which is referred to in the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

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

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

** The amendment consists of deleting, after the word "that," the words "anyone would immediately realize that."

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

Section 320

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

(a) and (b) [See document PCT/CAL/II/2, page 48]

(c) Paragraphs (a) and (b) shall apply *mutatis mutandis* to rectifications under Rule 91.1.

Section 401bis

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

(a) [See document PCT/CAL/II/2, page 50]

(b) Paragraph (a) shall apply *mutatis mutandis* to rectifications under Rule 91.1.

Section 501bis

Rectifications under Rule 91.1

Where the International Searching Authority authorizes a rectification under Rule 91.1, Section 320 shall apply *mutatis mutandis*.

[Rule 91.1, continued]

(e) No rectification shall be made except with the express authorization:

(i) of the receiving Office if the error is in the request, except in the case provided for in paragraph (i), below,

(ii) of the national Office concerned, in the case provided for in paragraph (i), below, it being understood that the said Office shall not authorize any rectification where such authorization would be contrary to its national law,

(iii) of the International Searching Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority,

(iv) of the International Preliminary Examining Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority, and

(v) of the International Bureau if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

(f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly.

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

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

Section 602bis

Rectifications under Rule 91.1

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

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

[Rule 91.1(g), continued]

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

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

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

(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be made by, the International Bureau, in order to be effective, latest at the time when the request for early publication reaches the International Bureau.

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

(h) [Deleted]

[Rule 91.1, continued]

(i) Where the applicant alleges that it is due to an obvious error that the designation of a State has been omitted in the request, his request for rectification shall be filed, and accompanied by the corresponding designation fee, with the receiving Office before the expiration of 15 months from the priority date. The receiving Office shall promptly communicate the request for rectification to the International Bureau. The International Bureau shall include the omitted designation in the record copy and in the international publication of the international application with an indication that the designation is subject to authorization by the national Office of or acting for the State whose designation is requested, and shall transmit the request for rectification to that Office together with the international application communicated under Article 20.

91.2 Manner of Carrying Out Rectifications

[Deleted]

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

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

Revised proposal

(Former Chapter XXXIX, see documents PCT/CAL/I/4, pages 60 and 61
and PCT/CAL/I/9, paragraph 59)

1. Ad Rule 92*bis*.1. Under Rule 92*bis*.1, certain indications made in the request part of the international application or in the demand may be changed on the request of the applicant or the receiving Office, and the International Bureau must record the change.
2. However, the said Rule does not provide for a time limit after the expiration of which the recording of changes may no longer be requested. It makes no sense to allow recordings of such changes by the International Bureau once the time limit for delaying national procedure has expired since, from the expiration of that time limit, the international application is entirely under the control of the national Offices.
3. Consequently, it is proposed that a new paragraph (paragraph (b)) in Rule 92*bis*.1 provide that the International Bureau would not record the said changes if the request for changes is received by it after the expiration of a certain time limit. If Article 39(1) is applicable with respect to at least one Contracting State (that is, if there is at least one elected State), that time limit would be the time limit referred to in Article 39(1)(a), that is, 25 months (or, if the proposal contained in Chapter 33 (see document) is accepted, 30 months) from the priority date. If Article 39(1) is not applicable with respect to any Contracting State, the time limit in question would be the time limit referred to in Article 22(1), that is, 20 months from the priority date. If the requested change is not recorded due to the expiration of the applicable time limit, the International Bureau would notify the applicant and, if the change was requested by the receiving Office, that Office accordingly (see proposed Rule 92*bis*.1(c)). The notification sent in such a case to the applicant could explain that the request to record the change should be sent by the applicant to each designated or elected Office.
4. During its first session, the Committee approved the proposal with the proviso that the International Bureau should study whether it would be appropriate to give the possibility to record a requested change up to the time at which the international preliminary examination report is established even where, at that time, the time limit under Article 39(1)(a) has already expired. After studying the matter, the International Bureau proposes not to extend the period for the recording of changes in such cases beyond the date after which national processing may start in the elected Offices. Any change under Rule 92*bis* can have effect for the international application—and should therefore be recorded—only during the international phase. Once the national phase has started, any change is subject to the applicable national provisions. Changes received later should therefore not be recorded by the International Bureau. Should, however, the procedure before the International Preliminary Examining Authority still continue at such a date, the International Bureau would, naturally, inform the International Preliminary Examining Authority of the requested changes and notify the applicant that he has to request the change before each elected Office, but it does not seem necessary to provide for such procedure in the Regulations.
5. Ad Rule 92*bis*.2. Three changes are proposed to be made in connection with Rule 92*bis*.2. First, it is proposed to transfer the contents of that Rule, which deals with the notification of changes recorded under Rule 92*bis*.1, to the Administrative Instructions.

Rule 92bis

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

92bis.1 Recording of Changes by the International Bureau

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

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

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

(i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;

(ii) of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.

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

92bis.2 Notifications

[Deleted]

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

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

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

Section 419

Notifications of Changes Recorded under Rule 92*bis*.1

(a) The International Bureau shall give notifications concerning changes recorded by it:

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

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

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

[Section 419(a), continued]

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

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

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

[End of document]