

WIPO



PCT/MIA/VI/5
ORIGINAL: English
DATE: January 10, 1997

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

**Sixth Session
Canberra, February 17 to 21, 1997**

**DEMAND FOR INTERNATIONAL PRELIMINARY EXAMINATION:
LATE FILING; RIGHT TO FILE; FILING WITH NON-COMPETENT AUTHORITY**

Document prepared by the International Bureau

Late filing of demand

1. The PCT Regulations do not provide any possibility for extension of the 19-month time limit under Article 39(1)(a) before which a demand for international preliminary examination must be filed if the national phase entry is to be postponed from 20 to 30 months from the priority date. If the late filing of a demand is not detected immediately by the International Preliminary Examining Authority with the result that the applicant is not informed accordingly forthwith, the applicant is unlikely to have sufficient time to take the necessary steps to enter the national phase before the expiration of 20 months from the priority date. This inflexibility appears to be unnecessarily severe.

2. Proposed new PCT Rule 53bis, as contained in the Annex to this document, would enable the applicant to remedy this situation in certain circumstances. It is envisaged that late filing of the demand or of a later election would be excused for up to two months beyond the 19-month time limit, subject to payment of a fee equal to the handling fee ("additional handling fee"), such fee being for the benefit of the International Preliminary Examining Authority in the case of the demand or the International Bureau in the case of a later election.

Right to make demand for international preliminary examination

3. The right to make a demand for international preliminary examination is provided for, in general, in PCT Article 31(2)(a), which reads as follows:

“Any applicant who is a resident or national, as defined in the Regulations, of a Contracting State bound by Chapter II, and whose international application has been filed with the receiving Office of or acting for such State, may make a demand for international preliminary examination.”

4. At its first session held in 1990, the Meeting accepted “that Article 31(2)(a) should be interpreted in such a way that it permits each applicant who is a national or resident of a Contracting State bound by Chapter II and whose international application was filed with the receiving Office of or acting for a Contracting State bound by Chapter II, to file a demand and to make elections under [the former text of] Rule 54.3(a)(i).” The Meeting agreed that that interpretation would apply even without an amendment of the PCT Regulations, but that appropriate proposals for amending the Regulations should be made. (See documents PCT/MIA/I/6, paragraphs 42 to 48, and PCT/MIA/I/8, paragraph 57.)

5. PCT Rule 54 was subsequently amended, with effect from July 1, 1992, such that PCT Rule 54.2 now expressly covers the situation in the case where there are two or more applicants:

“If there are two or more applicants, the right to make a demand under Article 31(2) shall exist if at least one of the applicants making the demand is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II, or

(ii) a person entitled to make a demand under Article 31(2)(b) and the international application has been filed as provided in the decision of the Assembly.”

6. In amending Rule 54.2, the Assembly agreed that the adopted minimum requirements for filing a demand were consistent with Article 31(2)(a).

7. It is now proposed that PCT Rule 54.2 be further amended, as proposed in the Annex to this document, to cover expressly the case where there is a sole applicant as well as that where there are two or more applicants.

Filing of demand with a “non-competent” International Preliminary Examining Authority

8. The PCT Regulations do not provide for a procedure in case a demand is filed with an International Preliminary Examining Authority which is not, for whatever reason (having regard to the nationality and residence of the applicant, the specification of competent International Preliminary Examining Authorities by the receiving Office, or the language of the international application), competent to perform the international preliminary examination of the international application in question.

9. Under amendments of the PCT Regulations which have come into force in recent years, the filing of an international application with a “non-competent” receiving Office, or the filing of a later election with the International Preliminary Examining Authority rather than the International Bureau, is now capable, at least in some circumstances, of remedy without loss of rights to the applicant (see Rules 19.4 and 56.1(f), respectively).

10. It is now proposed to take a similar approach in cases where the demand is filed with a “non-competent” International Preliminary Examining Authority. Proposed new PCT Rule 59.3, which is set out in the Annex to this document, would require that such a demand be forwarded by that Authority to the International Bureau, which would in turn take the necessary action to transmit the demand to the competent Authority.

11. The proposed new Rule is intended as a safeguard for applicants only in cases where the demand is filed with a “non-competent” International Preliminary Examining Authority. It is not intended to permit applicants to change International Preliminary Examining Authorities where a choice is available; nor would it apply in cases where the demand is filed by mistake directly with the receiving Office or the International Bureau.

12. The Meeting is invited to consider the proposed amendments of the PCT Regulations contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT

Rule 53bis

Election Made After the Expiration of 19 Months from the Priority Date

53bis.1 Effect of Election Made After the Expiration of 19 Months from the Priority Date

(a) If the election of any State is made after the expiration of 19 months from the priority date but before the expiration of 21 months from that date, such election shall, upon request and subject to the payment of a fee in accordance with paragraph (b) (“additional handling fee”), be considered, for the purposes of Article 39(1)(a), as if it had been made before the expiration of 19 months from that date.

(b) The amount of the additional handling fee shall be equal to the handling fee. Where the election concerned is made in the demand, the additional handling fee shall be paid to the International Preliminary Examining Authority for its benefit. Where the election concerned is made in a notice effecting a later election, the additional handling fee shall be paid to the International Bureau for its benefit. The additional handling fee shall be due in respect of any demand or any such notice, as applicable, irrespective of the number of elections effected. The additional handling fee shall be due at the time when the demand or the notice, as applicable, is submitted. Rule 57.4 shall apply *mutatis mutandis*.

Rule 54

The Applicant Entitled to Make a Demand

54.1 [No change]

54.2 Right to Make a Demand ~~Two or More Applicants~~

~~The~~ If there are two or more applicants, the right to make a demand under Article 31(2) shall exist if the applicant making the demand or, if there are two or more such applicants, at least one of them, ~~the applicants making the demand is~~

(i) [No change]

(ii) [No change]

54.3 and 54.4 [No change]

Rule 59

The Competent International Preliminary Examining Authority

59.1 and 59.2 [No change]

Rule 59.3 Transmittal of Demand to the Competent International Preliminary Examining Authority

(a) If the demand is submitted, by an applicant having the right to make a demand, to an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, that Authority shall mark the date of receipt on the demand and transmit it promptly to the International Bureau.

(b) Where a demand is transmitted to the International Bureau under paragraph (a), the International Bureau shall promptly,

(i) if there is only one competent International Preliminary Examining Authority, transmit the demand to that Authority and inform the applicant accordingly, or

(ii) if two or more International Preliminary Examining Authorities are competent, invite the applicant to indicate, within 15 days from the date of the invitation or 21 months from the priority date, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

[Rule 59.3, continued]

(c) Where an indication is furnished as required under paragraph (b)(ii), the International Bureau shall promptly transmit the demand to the competent International Preliminary Examining Authority indicated by the applicant. Where no indication is so furnished, the demand shall be considered not to have been submitted and the applicant shall be notified accordingly.

(d) Where the demand is transmitted to a competent International Preliminary Examining Authority under paragraph (b), it shall be considered to have been submitted to that Authority on the date marked on it under paragraph (a).

[End of Annex and of document]