

PCT

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PREPARATORY COMMITTEE

First Session

Geneva, February 6 to 10, 1978

PREPARATION OF THE FIRST
SESSION OF THE ASSEMBLY
OF THE PCT UNION

Memorandum prepared by the International Bureau

1. This document deals with some of the questions which will have to be placed before the first session, scheduled for April 10 to 14, 1978, of the Assembly of the PCT Union. In the present document, "PCT" means the Patent Cooperation Treaty and "the Preparatory Committee" means the Preparatory Committee of the PCT Union.

I.

RULES OF PROCEDURE OF THE PCT ASSEMBLY

2. Article 53(12) of the PCT provides that the Assembly of the PCT Union "shall adopt its own rules of procedure." It is proposed that the Preparatory Committee recommend to the Assembly that the latter adopt the draft Rules of Procedure set out in Annex I to the present document. The said draft follows closely the Rules of Procedure of other Unions administered by WIPO.

II.

ADMISSION OF OBSERVERS

3. It is proposed that the Preparatory Committee recommend to the Assembly that the latter decide to admit as special observers or as observers the following

(a) as Special Observers

- (i) the States not members of the PCT Union which contribute to the budget of the PCT Union, that is, at present: Australia, Austria, Belgium, Brazil, Canada, Cuba, Denmark, Egypt, Finland, Hungary, Iran, Ireland, Israel, Japan, Luxembourg, Netherlands, Norway, Philippines, Romania, Spain, Sweden, Yugoslavia (22),

- (ii) the European Patent Office,
 - (iii) the Office of the African Intellectual Property Organization (OAPI)
- (b) as Observers
- (i) all States members of the Paris Union which are not members of the PCT Union and which have no special observer status,
 - (ii) the following intergovernmental organizations
 - United Nations (UN)
 - Council of Mutual Economic Assistance (CMEA)*
 - Commission of the European Communities (CEC)*
 - Interim Secretariat for the Community Patent Convention*
 - (iii) the following international non-governmental organizations:
 - Asian Patent Attorneys Association (APAA)
 - Committee of National Institutes of Patent Agents (CNIPA)
 - Council of European Industrial Federations (CEIF)
 - European Federation of Agents of Industry in Industrial Property (FEMIP)
 - European Industrial Research Management Association (EIRMA)
 - Inter-American Association of Industrial Property (ASIPI)
 - International Association for the Protection of Industrial Property (AIPPI)
 - International Chamber of Commerce (ICC)
 - International Federation of Inventors' Associations (IFIA)
 - International Federation of Pharmaceutical Manufacturers Associations (IFPMA)
 - International Federation of Patent Agents (FICPI)
 - Licensing Executives Society (International) (LES)
 - Pacific Industrial Property Association (PIPA)
 - Union of European Patent Attorneys and Other Representatives Before the European Patent Office (UNEPA)
 - Union of Industries of the European Community (UNICE)

4. It is to be noted that the States and Organizations referred to in the preceding paragraph have been notified that the first session of the Assembly will deal with the question of admission of observers and that they are invited to that session subject to a favorable decision by the Assembly which is expected to be made at the beginning of that session.

III.

DATES FROM WHICH INTERNATIONAL APPLICATIONS MAY BE FILED AND DEMANDS FOR INTERNATIONAL PRELIMINARY EXAMINATION MAY BE SUBMITTED

5. Article 65(2) of the PCT provides that "the Assembly shall fix the dates from which, subject to the provision of paragraph (1) [dealing with the possibility of gradual application], international applications may be filed and demands for international preliminary examination may be submitted. Such dates shall not be later than six months after this Treaty has entered into force according to the provisions of Article 63(1) [that is, January 24, 1978], or after Chapter II has become applicable under Article 63(3) [that is, March 29, 1978], respectively."

* Where the agenda of the session contains one or more specific items which, in the opinion of the Director General, is of special and direct interest to this Organization, the invitation will be extended to it to attend during the discussion of that specific item or those specific items.

6. It is proposed that the Preparatory Committee recommend to the Assembly that the latter fix June 1, 1978, as the date from which international applications may be filed and demands for international preliminary examination may be submitted. The proposed date is not only within the time limit fixed in the PCT but would be identical with the date from which applications under the European Patent Convention may be filed.

IV.

AMENDMENTS OF THE REGULATIONS
UNDER THE PCT

7. It is proposed that the Preparatory Committee recommend to the Assembly that the latter adopt the amendments to the PCT Regulations set out in Annex II.

8. Such amendments arise either from the PCT Interim Committees (the Interim Advisory Committee for Administrative Questions or the Interim Committee for Technical Cooperation) or from the International Bureau's further work on the implementation of the PCT in preparation for the first session of the Assembly.

9. Annex II to this document contains (i) the present text of the Rules of the Regulations proposed to be amended (where applicable) with parts proposed to be deleted shown within square brackets and proposed additional wording shown with underlining, (ii) the draft of the new texts in the form in which they would appear in the Regulations if adopted by the Assembly, (iii) the Background Notes, explaining the proposed texts. For the sake of convenience, the amendments relating to fees have been grouped together and thus do not appear in the numerical sequence.

10. No amendment of the Regulations is proposed in relation to one question on which the International Bureau was asked, by the Interim Committee for Technical Cooperation at its seventh (October 1977) session, to consider such amendment. This question and the reasons for not proposing any amendment are set out in Annex III to this document.

V.

PCT COMMITTEE FOR TECHNICAL
ASSISTANCE (PCT/CTA)

11. Article 51(1) of the PCT provides that "the Assembly shall establish a Committee for Technical Assistance (referred to in this Article as "the Committee")"; Article 51(2) (a) provides that "the members of the Committee shall be elected among the Contracting States, with due regard to the representation of developing countries."

12. It is proposed that, at least as long as the number of the member States of the PCT Union is relatively low--say, 30--all member States of the PCT Union be elected as members of the Committee. It is further suggested that once the membership of the PCT Union reaches 30, the question of whether all member States or only some of them should be members of the Committee should be examined by the Assembly. Consequently, it is proposed that the Preparatory Committee recommend to the Assembly that the latter adopt the following decision:

"With reference to PCT, Article 51(1) and (2) (a), the Assembly hereby establishes the PCT Committee for Technical Assistance (PCT/CTA) and elects all States members of the PCT Union as members of the said Committee, it being understood that the election of any State which will become member of the PCT Union in the future shall take effect on the date on which such State becomes member of the PCT Union. Finally, the Assembly decides that once the number of the States members of the PCT Union reaches 30, it will, in its session following such an event, reconsider the question of the composition of the said Committee."

13. It is further proposed that the Preparatory Committee recommend to the PCT Assembly to make the following decision:

"With reference to PCT, Article 51(5), the Assembly decides that it will itself establish and, where necessary in the future, amend the Rules of Procedure of the PCT Committee for Technical Assistance (PCT/CTA)."

14. Finally, it is proposed that the Preparatory Committee recommend to the Assembly to adopt, as the Rules of Procedure of the said Committee, the draft appearing in Annex IV.

15. The said draft provides for special observer status for, inter alia, States not members of the PCT Union but contributing to its budget. It is believed that States not falling into that category should not be given observer status on the Committee.

16. It is to be noted that the said draft Rules of Procedure do not contain any provision on intergovernmental organizations (other than those which have a special observer status) since PCT, Article 51(2)(b) already covers them by providing that "the Director General shall, on his own initiative or at the request of the Committee, invite representatives of intergovernmental organizations concerned with technical assistance to developing countries to participate in the work of the Committee."

17. As to the participation in the meetings, as observers, of international non-governmental organizations, the draft Rules of Procedure contain a similar provision.

18. It is recalled that in their September 1977 sessions, the Executive Committee of the Paris Union and the WIPO Coordination Committee--when adopting a decision establishing the WIPO Permanent Committee on Patent Information (WIPO/PCPI)--agreed, inter alia, that the meetings of PCT/CTA "shall be joint" with those of the WIPO Permanent Committee for Development Cooperation Related to Industrial Property, "it being understood that the activities of the said Committees will be coordinated and it being further understood that, where decisions are made by [PCT/CTA]..., only the members of [PCT/CTA]... shall vote" (AB/VIII/16, Annex B, Decision, paragraph 4). Furthermore, the same decision recommends that the Assembly of the PCT Union "endorse the above measures." Consequently, it is proposed that the Preparatory Committee recommend to the PCT Assembly that it endorse the measures in question. As to the joint sessions, the proposed measures are reflected in Rule 4 of the Draft Rules of Procedure of PCT/CTA (see Annex IV).

VI.

PCT COMMITTEE FOR TECHNICAL COOPERATION (PCT/CTC)

19. Article 56(1) of the PCT provides that "the Assembly [of the PCT Union] shall establish a Committee for Technical Cooperation (referred to in this Article as "the Committee")"; Article 56(2) provides that "the Assembly shall determine the composition of the Committee and appoint its members, with due regard to an equitable representation of developing countries" (subparagraph (a)), that "the International Searching and Preliminary Examining Authorities shall be ex officio members of the Committee" and that "...where such Authority is the national Office of a Contracting State, that State shall not be additionally represented on the Committee" (subparagraph (b)); that "if the number of Contracting States so allows, the total number of members of the Committee shall be more than double the number of ex officio members" (subparagraph (c)). At the end of 1977, it is known that by March 29, 1978, the following 15 States will be members of the PCT Union: Cameroon, Central African Empire, Congo, Chad, France, Gabon, Germany (Federal Republic of), Madagascar, Malawi, Senegal, Soviet Union, Switzerland, Togo, United Kingdom, United States of America. From these, the following three are expected to have their national Offices act as International Searching and/or

Preliminary Examining Authorities: Soviet Union, United Kingdom, United States of America. The European Patent Office is also expected to be an International Searching and Preliminary Examining Authority. Thus, the said four Authorities would be ex officio members of the Committee. It is proposed that the remaining 12 States as well as other States which will become members of the PCT Union, be also members of the Committee. It is further suggested that once the membership of the PCT Union reaches 30, the question of whether all member States or only some of them should be members of the Committee, should be examined by the Assembly. Consequently, it is proposed that the Preparatory Committee recommend to the Assembly that the latter adopt the following decision:

"With reference to PCT, Article 56(1) and (2), the Assembly hereby establishes the PCT Committee for Technical Cooperation (PCT/CTC) and appoints, in addition to the ex officio members according to PCT, Article 56(2)(b), all States, members of the PCT Union, as members of the said Committee, it being understood that the appointment of any State which will become a member of the PCT Union in the future shall take effect on the date on which such State becomes member of the PCT Union. Finally, the Assembly decides that once the number of the States members of the PCT Union reaches 30, it will, in its session following such an event, reconsider the question of the composition of the said Committee."

20. It is further proposed that the Preparatory Committee recommend to the PCT Assembly to make the following decision:

"With reference to PCT, Article 56(8), the Assembly decides that it will itself establish and, where necessary in the future, amend the Rules of Procedure of the PCT Committee for Technical Cooperation (PCT/CTC)."

21. Finally, it is proposed that the Preparatory Committee recommend to the Assembly to adopt, as the Rules of Procedure of the said Committee, the draft appearing in Annex V.

22. The said draft provides for special observer status for, inter alia, States not members of the PCT Union but contributing to its budget. It is believed that States not falling into that category should not be given observer status on the Committee.

23. It is to be noted that the said draft Rules of Procedure do not contain any provision on observer organizations since PCT, Article 56(2)(d) already covers the subject by providing that "the Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested organizations to participate in discussions of interest to them."

24. It is recalled that in their September 1977 session, the Executive Committee of the Paris Union and the WIPO Coordination Committee adopted a decision establishing the WIPO Permanent Committee on Patent Information (WIPO/PCPI), and agreed, inter alia, that the meetings of PCT/CTC "shall be joint" with those of WIPO/PCPI, "it being understood that the activities of the said Committees will be coordinated and it being further understood that, where decisions are made by [PCT/CTC]..., only the members of [PCT/CTC]...should vote" (AB/VIII/16, Annex B, Decision, paragraph 4). Furthermore, the same decision recommends that the Assembly of the PCT Union "endorse the above measures." Consequently, it is proposed that the Preparatory Committee recommend to the PCT Assembly that it endorse the measures in question. As to the joint sessions, the proposed measures are reflected in Rule 3 of the Draft Rules of Procedure of PCT/CTC (see Annex V).

VII.

OTHER PCT COMMITTEES AND POSSIBLE WORKING GROUPS

25. PCT, Article 53(2)(a) provides that "the Assembly [of the PCT Union] shall... (viii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union...".

26. During the more than seven years which elapsed between the adoption (1970) and the entry into force (1978) of the PCT, a committee, named the Interim Advisory Committee for Administrative Questions held eight sessions and amply proved its usefulness. It is proposed that a Committee roughly with the same tasks but with a different name (in order to distinguish it from the Interim Committee) be established. The name proposed is "PCT Committee for Administrative and Legal Matters (PCT/CAL)." The proposed terms of reference would take into account the changes caused in the tasks by PCT becoming operational. The terms of reference, composition and other matters requiring a decision by the Assembly are contained in the draft Rules of Procedure of what would be PCT/CAL (see Annex VI). In the light of past experience and what has been suggested in connection with the two other Committees, the said draft seems to be self-explanatory. It is proposed that the Preparatory Committee recommend to the Assembly that the latter establish the said Committee and adopt the said draft Rules of Procedure.

27. For the moment, it does not seem to be necessary to ask for the creation, by the PCT Assembly, of other committees or working groups. On the other hand, it may prove to be useful--once again, based on past experience--that PCT/CAL be given the authority to establish, if it deems necessary, working groups for dealing with special subjects which may be more effectively dealt with, in the first instance, by a group with less members than PCT/CAL would have. The giving of such authority is provided for in Rule 6 of the said draft Rules of Procedure.

VIII.

AGENDA OF THE FIRST SESSION OF THE PCT ASSEMBLY

28. A preliminary draft agenda for the first session of the PCT Assembly has been prepared and has or is going to be sent to those invited to that session. It is contained in document PCT/A/I/1, attached to the present document as Annex VII. The Preparatory Committee is invited to indicate any suggestion it may have for amending the said preliminary draft agenda.

[The Annexes follow]

ANNEX I

Draft

RULES OF PROCEDURE OF THE
ASSEMBLY OF THE INTERNATIONAL
PATENT COOPERATION (PCT) UNION

Rule 1: Application of the General Rules of Procedure

The Rules of Procedure of the Assembly of the International Patent Cooperation (PCT) Union shall consist of the General Rules of Procedure of WIPO, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

(1) The following shall be invited as "special observers" to all sessions of the Assembly:

(i) States not members of the PCT Union which contribute to the budget of the PCT Union,

(ii) intergovernmental authorities having the power to grant patents effective in one or more States members of the PCT Union.

(2) Special observers shall have the same rights in the sessions of the Assembly as States members of the Assembly, except the right to vote.

Rule 3: Draft Agenda

The draft agenda of each session shall be prepared by the Director General. In the case of ordinary sessions, such draft shall follow the instructions of the Executive Committee once the Executive Committee is established [see PCT, Articles 53(9) and 54(6)(a)]. In the case of extraordinary sessions, the said draft shall include the item or items mentioned in the request referred to in Article 53(11)(c) of the Patent Cooperation Treaty.

Rule 4: Decisions When a Quorum is Not Reached

In the case referred to in Article 53(5)(b) of the Patent Cooperation Treaty, the Director General shall immediately communicate those decisions which have not yet taken effect to the States members of the Assembly of the PCT Union which were not represented at the session, together with the report of the session and whatever additional explanations may be necessary. The communication shall invite the said States to express in writing their vote or abstention within a period of three months from the date on which the communication was sent. Replies shall be taken into consideration only if they reach the Director General within the period allowed. Replies shall come from the Ministry of Foreign Affairs or the competent authority of the State in question.

Rule 5: Publication of the Report

The report of the work of each session, or a summary drawn up by the International Bureau, shall be published in the Gazette of the PCT Union and in the reviews La Propriété Industrielle and Industrial Property of the World Intellectual Property Organization.

[Annex II follows]

PCT/PREP/I/2

ANNEX II

Draft

AMENDMENTS TO THE REGULATIONS
UNDER THE PCT

Background Notes on Rule 4.10(d)

At its eighth (October 1977) session, the Interim Advisory Committee for Administrative Questions, on the basis of document PCT/AAQ/VIII/9.Rev., prepared by the International Bureau, endorsed the view that the procedure under Rule 4.10(d) should be utilized in the case of a claimed priority date which is manifestly defective because it is later than the international filing date as well as in the case, already covered by that Rule, of a date which is manifestly defective because it precedes the international filing date by more than one year. The Interim Committee decided to recommend to the Assembly of the PCT Union that it amend Rule 4.10(d) so that the Rule as amended would read as it appears in the proposed new wording (see the report of the said session, document PCT/AAQ/VIII/21, paragraph 83).

[Amendments to the Present Text]

Rule 4.10(d) (first sentence)

(d) If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding [precedes] the international filing date [by more than one year], the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated.

[New Text]

Rule 4.10(d) (first sentence)

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

Background Notes on Rule 11.6(a) and (b)

At its eighth (October 1977) session, the Interim Advisory Committee for Administrative Questions decided, on the basis of document PCT/AAQ/VIII/10 prepared by the International Bureau, to recommend to the Assembly of the PCT Union to amend Rule 11.6(a) and (b) so that the Rule, as amended, would read as appears in the proposed new text (see the report of the said session, document PCT/AAQ/VIII/21, paragraph 87).

[Amendments to the Present Text]

[New Text]

Rule 11.6(a) and (b)

Rule 11.6(a) and (b)

11.6 Margins

11.6 Margins

(a) The minimum margins of the sheets containing the request, the description, the claims and the abstract, shall be as follows:

(a) The minimum margins of the sheets containing the request, the description, the claims, and the abstract shall be as follows:

[- top of first sheet, except that of the request: 8 cm]

- top [of other sheets]: 2 cm
- left side: 2.5 cm
- right side: 2 cm
- bottom: 2 cm

- top: 2 cm
- left side: 2.5 cm
- right side: 2 cm
- bottom: 2 cm

(b) The recommended maximum, for the margins provided for in paragraph (a), is as follows:

(b) The recommended maximum, for the margins provided for in paragraph (a), is as follows:

[- top of first sheet, except that of the request: 9 cm]

- top [of other sheets]: 4 cm
- left side: 4 cm
- right side: 3 cm
- bottom: 3 cm

- top: 4 cm
- left side: 4 cm
- right side: 3 cm
- bottom: 3 cm

Background Notes on Rule 11.13(a)

At its eighth (October 1977) session, the Interim Advisory Committee for Administrative Questions decided, on the basis of document PCT/AAQ/VIII/10 prepared by the International Bureau, to recommend to the Assembly of the PCT Union to amend Rule 11.13(a) so that the Rule, as amended, would read as appears in the proposed new text (see the report of the said session, document PCT/AAQ/VIII/21, paragraph 87).

[Amendments to the Present Text]

[New text]

Rule 11.13(a)

Rule 11.13(a)

11.13 Special Requirements for Drawings

11.13 Special Requirements for Drawings

(a) Drawings shall be executed in durable, black [or blue], sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colorings.

(a) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colorings.

Background Notes on Rule 32bis

1. At its eighth (October 1977) session, the Interim Advisory Committee for Administrative Questions considered, on the basis of document PCT/AAQ/VIII/9.Rev. prepared by the International Bureau, a proposed new Rule 32bis dealing with the withdrawal of a priority claim contained in an international application. The Interim Committee endorsed the view expressed by the International Bureau in the said document that the applicant has an inherent right to withdraw a priority claim contained in his international application.
2. The Interim Committee decided to recommend to the Assembly that the right to withdraw the priority claim should be recognized, but that withdrawal should not be allowed after publication of the international application. Furthermore, in the course of the discussion, the view was expressed that the withdrawal of a priority claim should have no effect on time limits which had already expired.
3. The text considered by the Interim Committee has been revised to take into account the above-mentioned points.
4. The Interim Committee asked the International Bureau to present to the Assembly a study on the legal effects of the system of withdrawal of the priority claim now proposed. That study is contained in the following paragraphs.
5. The major effect of the withdrawal of the priority claim before publication of the international application would seem to be that such withdrawal would retard the "priority date" within the sense of Article 2(xi) for a period up to one year. This has the consequence that various obligations of the applicant with respect to the national phase, particularly the payment of national fees and the furnishing of copies of the international application and of translations of this application, would be retarded by the same period of time. Various obligations in the procedure of the international phase would be similarly retarded. As an example, reference is made to the time limit for the transmittal of the record copy under Rule 22 in cases where the withdrawal of the priority claim takes place before such transmittal. Another example would be the delay of the expiration of the time limit for the payment of the designation fee ensuing from the withdrawal of the priority claim. The publication of the international application, which normally takes place 18 months after the priority date, would be delayed as well.
6. For the applicant, such a delay would seem to have only positive consequences except that he might take the risk that for events that have occurred between the filing date of his priority application and the international filing date, the invention may be found to have lost novelty or inventive step. However, whenever he sees a possible negative consequence, he will not withdraw the priority claim.
7. For the general public or the applicant's competitors, such withdrawal would not seem to have a negative effect. It is, of course, true that the public would have access to the technical information contained in the application at a somewhat later date but this is anormal situation under present national procedures for the grant of patents in the case of withdrawal of a priority claim before early publication.
8. For International Searching Authorities, the withdrawal of the priority claim may have the positive effect of allowing them more time for search. Even where the search report is already established, the results of the search will not be disturbed by a change in the "priority date" since the search covers, in any case, disclosures that have occurred up to the international filing date.
9. As far as the International Preliminary Examining Authorities are concerned, they would normally not be affected at all. Where, exceptionally, a demand has been made before the withdrawal of the priority claim has taken place, the withdrawal would neither have a negative nor a positive effect on the procedure before the International Preliminary Examining Authority except that the relevant date for prior art purposes for the international preliminary examination may have changed, which would influence the examination work in exceptional cases where it has already started at that time.
10. For designated and elected Offices, there would normally be no consequences of the withdrawal of the priority claim other than a further delay of national processing or examination. The question of the effect of the withdrawal of the priority claim in cases where national processing or examination has, exceptionally, already started before the priority claim was withdrawn, will be dealt with separately below.

"Rule 32bis

"Withdrawal of the Priority Claim

"32bis.1 Withdrawal

"(a) The applicant may, until international publication of the international application, withdraw the priority claim in the international application except as to any designated State in which national processing or examination has already started.

"(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one, several, or all of them.

"(c) Where the withdrawal of the priority claim or any of several priority claims causes a change in the priority date of the international application, any time limit computed from the priority date which has not already expired, shall be computed from the changed priority date. In the case of Article 21(2)(a), such computation from the changed priority date shall not be made after technical preparations for publication have been completed.

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

[Background Notes on Rule 32bis, continued]

11. For the procedure before the International Bureau, the withdrawal of the priority claim would normally have no consequences other than a delay of the international publication. In cases, however, where preparations for international publication have already started at the time of withdrawal, the work to prepare international publication must be interrupted and taken up again at a later stage. This might occasionally cause some additional work. The cases of withdrawal of the priority claim at that stage of the procedure will, however, not be very numerous and the effect on the workload of the International Bureau consequently negligible.

12. In the following paragraphs, the principles and legal consequences of the provisions proposed in new Rule 32bis are indicated in summarized form.

Ad paragraph (a)

13. That provision states the principle that the applicant may withdraw the priority claim but limits that possibility to the time until the international publication of the international application. While withdrawal of the priority claim, under that provision, is legally possible until the date of international publication, the consequence of the second sentence of paragraph (c) is that any withdrawal of the priority claim after technical preparations for publication have been completed will, while being valid, no longer change the date of publication.

14. There is, however, one exception to the principle of acceptability of the withdrawal up to the date of publication. In cases where, in any designated or elected State, national processing or examination has started earlier and before withdrawal was made, the withdrawal has no legal effect in that State. The conditions for, and the effect of, the withdrawal of a priority claim in the national phase, i.e., after the processing of the application before the designated or elected Office has started, are a matter to be determined by national law.

15. In the exceptional situation where there is no international publication of the international application in the case described in Article 64(3), withdrawal of the priority claim would, of course, be possible until the date on which national processing or examination starts in the designated or elected States.

Ad paragraph (b)

16. This paragraph clarifies that in cases where the priority of more than one earlier application is claimed, the withdrawal may cover one or several or all priority claims. If only one or some of the priority claims are withdrawn, the consequence is, of course, that the earliest remaining priority date will become the "priority date" of the international application. The computing of time limits is, of course, only affected in cases where the earliest of several priority claims is withdrawn.

Ad paragraph (c)

17. Except in the case mentioned in the preceding paragraph, where one of several priority claims which is not the earliest is withdrawn, the withdrawal of one or several or all priority claims will always cause a change in the priority date of the international application. The change of the priority date will have the consequence that that date will be delayed.

18. Paragraph (c) provides that all time limits computed from the priority date which have not already expired will, from now on, be computed no longer from the previous but from the new priority date. This means that a withdrawal of a priority claim which is made after the expiration of a certain time limit will no longer have the consequence of reopening that time limit on the basis of a computation from the new priority date. This would seem to be a necessary limitation in view of the general principle that phases of the procedure which are already definitively concluded and the termination of which has led to certain legal consequences, can no longer be reopened by a later procedural act.

19. With respect to the exception contained in the second sentence of paragraph (c), according to which the time limit for the international publication itself will remain unchanged where the withdrawal is made after technical preparations for publication have been completed, see paragraph 13 above. The major reason for that exception is that, at that stage, the publication of the international application in the Gazette can no longer be prevented and, in all likelihood, the

[Background Notes on Rule 32bis, continued]

pamphlet will already be printed. Since the notice on the international publication in the Gazette cannot be prevented, the pamphlet must be distributed as well at this time. Consequently, the date of the international publication should remain unaltered at this stage, as computed from the previous priority date. In such cases, the fact of the withdrawal of the priority claim which, at this stage, can no longer be indicated either in the notice in the Gazette on the international publication or the pamphlet itself, will have to be published in a later separate notice in the Gazette. In case it is felt that such separate notice would require an amendment to the Regulations, such amendment could be proposed and could consist of an appropriate provision in Rule 48.6.

Ad paragraph (d)

20. This paragraph has the effect that the provisions for the form of the withdrawal of the international application contained in Rule 32.1(c) and the provisions relating to the further processing of such withdrawal by the International Bureau contained in Rule 32.1(d) are made applicable also for withdrawals of priority claims.

Background Notes on Rules 48.2(a)(v) and 48.3(c)

The Interim Advisory Committee for Administrative Questions at its eighth (October 1977) session, on the basis of document PCT/AAQ/VIII/5 prepared by the International Bureau, agreed to accept the amended version of the International Search Report Form which was adopted for use for the transmittal of the international search report by the International Searching Authority to the applicant and the International Bureau, and for publication purposes. The Interim Committee, noting that the amendments to Rules 48.2(a)(v) and 48.3(c) proposed by the International Bureau were required to give effect to the decision of the Interim Committee in relation to the form of publication of the international search report, agreed unanimously to recommend to the PCT Assembly that the said Rules be amended accordingly (see document PCT/AAQ/VIII/21, paragraphs 58 and 88).

[Amendments to the Present Text]

[New Text]

Rules 48.2(a) (v) and 48.3(c)

Rules 48.2(a) (v) and 48.3(c)

Rule 48.2 Contents

Rule 48.2 Contents

(a) ...

(a) ...

(v) subject to paragraph (g), the international search report or the declaration under Article 17(2) (a) [,] ; the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet,

(v) subject to paragraph (g), the international search report or the declaration under Article 17(2) (a); the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet,

...

...

Rule 48.3 Language

Rule 48.3 Language

...

...

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

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

Background Notes on Rules 15.2 and 57.2

At its eighth (October 1977) session, the Interim Advisory Committee for Administrative Questions decided, after considering document PCT/AAQ/VIII/7 prepared by the International Bureau, to recommend to the Assembly of the PCT Union the fixing of increased fees, and the amendment of Rules 15.2 and 57.2, so that the Rules, as amended, would read as appears in the proposed new text (see the report of the said session, document PCT/AAQ/VIII/21, paragraph 109).

[Amendments to the Present Text]

15.2 Amounts

(a) The amount of the basic fee shall be:

(i) if the international application contains not more than 30 sheets:
[US \$45.00 or 194] 500 Swiss francs,

(ii) if the international application contains more than 30 sheets:
[US \$45.00 or 194] 500 Swiss francs plus
[US \$1.00 or 4.30] 10 Swiss francs per sheet in excess of 30 sheets.

(b) The amount of the designation fee shall be:

(i) for each designated State or each group of designated States for which the same regional patent is sought which does not require the furnishing of a copy under Article 13: [US \$12.00 or 52] 135 Swiss francs,

(ii) for each designated State or each group of designated States for which the same regional patent is sought which requires the furnishing of a copy under Article 13: [US \$14.00 or 60] 160 Swiss francs.

...

57.2 Amount

(a) The amount of the handling fee shall be [US \$14.00 or 60] 160 Swiss francs augmented by as many times the same amount as the number of languages into which the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau.

[New Text]

15.2 Amounts

(a) The amount of the basic fee shall be:

(i) if the international application contains not more than 30 sheets: 500 Swiss francs,

(ii) if the international application contains more than 30 sheets: 500 Swiss francs plus 10 Swiss francs per sheet in excess of 30 sheets.

(b) The amount of the designation fee shall be:

(i) for each designated State or each group of designated States for which the same regional patent is sought which does not require the furnishing of a copy under Article 13: 135 Swiss francs,

(ii) for each designated State or each group of designated States for which the same regional patent is sought which requires the furnishing of a copy under Article 13: 160 Swiss francs.

...

57.2 Amount

(a) The amount of the handling fee shall be 160 Swiss francs augmented by as many times the same amount as the number of languages into which the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau.

[Amendment to the Present Text]

[Rule 57.2, continued]

(b) Where, because of a later election or elections, the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau into one or more additional languages, a supplement to the handling fee shall be payable and shall amount to [US \$14.00 or 60] 160 Swiss francs for each additional language.

[New Text]

[Rule 57.2, continued]

(b) Where, because of a later election or elections, the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau into one or more additional languages, a supplement to the handling fee shall be payable and shall amount to 160 Swiss francs for each additional language.

Explanatory Notes to Rules 86.3 and 86.4

The weekly publication of the Gazette will not be justified until a sufficient number of international applications are being published. The new texts proposed will provide the necessary flexibility for an appropriate publication frequency and price policy to be instituted by the Director General, having regard to developments in respect of the numbers of international applications being filed and their prospective dates of publication.

[Amendments to the Present Text]

[New Text]

Rule 86.3

Rule 86.3

Frequency

Frequency

(a) Subject to paragraph (b), [T]
the Gazette shall be published once a week.

(a) Subject to paragraph (b), the
Gazette shall be published once a week.

(b) For a transitional period after
the entry into force of the Treaty termi-
nating upon a date fixed by the Assembly,
the Gazette may be published at such times
as the Director General considers appro-
prate having regard to the numbers of
international applications and the
amount of other material required to be
published.

(b) For a transitional period after
the entry into force of the Treaty termi-
nating upon a date fixed by the Assembly,
the Gazette may be published at such times
as the Director General considers appro-
prate having regard to the numbers of
international applications and the amount
of other material required to be published.

Rule 86.4

Rule 86.4

Sale

Sale

(a) Subject to paragraph (b) [T]
the subscription and other sale prices of
the Gazette shall be fixed in the
Administrative Instructions.

(a) Subject to paragraph (b), the
subscription and other sale prices of the
Gazette shall be fixed in the Administrative
Instructions.

(b) For a transitional period after
the entry into force of the Treaty
terminating upon a date fixed by the
Assembly, the Gazette may be distributed
on such terms as the Director General
considers appropriate having due regard
to the number of international applica-
tions and the amount of other material
published therein.

(b) For a transitional period after
the entry into force of the Treaty
terminating upon a date fixed by the
Assembly, the Gazette may be distributed
on such terms as the Director General
considers appropriate having due regard
to the number of international applica-
tions and the amount of other material
published therein.

[Annex III follows]

ANNEX III

DraftOBSERVATIONS ON THE QUESTION REFERRED TO
IN PARAGRAPH 10 OF THE PRESENT DOCUMENT

1. At its seventh (October 1977) session, the Interim Committee for Technical Cooperation considered the obligation to carry out international preliminary examination of an international application (or part of such application) not covered by the international search report (see the report of the said session, document PCT/TCO/VII/14, paragraphs 115 to 123). Having regard to the International Bureau's indication that it reserved its position on the questions under consideration with a view to raising the matter at a later stage before the Assembly, the Interim Committee asked the International Bureau to take into account also any necessary amendments to the Regulations.
2. It is not proposed to raise the matter discussed by the Interim Committee at the first session of the Assembly. Nevertheless, it should be stated here that further study by the International Bureau has confirmed to it the position taken at the last session of the Interim Committee. According to that position, the obligation to carry out international preliminary examination is independent of the question whether or not the examination can be carried out on the basis of the international search report and no principle to the contrary can be deduced from the PCT.
3. The view expressed to the Interim Committee had regard to the fact that the Articles contained in Chapter II of the PCT provide for international preliminary examination of the international application by the International Preliminary Examining Authority upon submission to it of a demand without any limitation related to the international search of the application; provide for such examination to be carried out on the basis of the application as amended by the applicant; provide, without exception, for an international preliminary examination report to be established; specify quite separately from similar provisions in Chapter I the procedure and the fixing of additional fees in the case of lack of unity of invention; and indicate, specifically and quite independently from comparable provisions in Chapter I relating to international search, the circumstances in which the said Authority is not required to go into the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable.
4. A clear demonstration of the lack of any general principle linking international preliminary examination to a prior international search is to be found in the provisions of Rule 69.1(b)(iv) to the effect that international preliminary examination shall start upon receipt by the International Preliminary Examining Authority of "a notice of the declaration by the International Searching Authority that no international search report will be established (Article 17(2)(a))." It is to be noted, in connection with Article 33(6) that the obligation imposed is that of taking into consideration the documents cited in the international search report but is not limited to a consideration only of the relevant prior art cited in that search report. The relevant prior art for the purposes of international preliminary examination is specified in Rule 64 and relates to the provisions of Article 33(2) and (3). The provisions relating to the fixing of the preliminary examination fee (Rule 58.1) and the additional fee in the case of lack of unity of invention (Rule 68.3) are sufficiently flexible to permit the fixing of fees which will cover the work and other expenses which may devolve upon the work of the International Preliminary Examining Authority.
5. Thus no amendment of the Regulations is considered necessary. The International Bureau is, of course, at the disposal of the International Preliminary Examining Authorities with regard to proposing arrangements to resolve questions that may exist on a practical level.

[Annex IV follows]

ANNEX IV

Draft

RULES OF PROCEDURE OF THE PCT COMMITTEE
FOR TECHNICAL ASSISTANCE (PCT/CTA)

Rule 1: Application of the General Rules of Procedure

The PCT Committee for Technical Assistance (PCT/CTA; hereinafter referred to as "the Committee"), being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, as supplemented and amended by the provisions set forth hereafter.

Rule 2: Special Observers

(1) States which are not members of the Committee which have the status of special observer in the PCT Assembly, as well as intergovernmental authorities which have such a status, shall be invited as "special observers" to all sessions of the Committee.

(2) Special observers shall have the same rights in the sessions of the Committee as member of the Committee, except the right to vote.

Rule 3: Observers

The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested international non-governmental organizations to attend the sessions of the Committee in an observer capacity.

Rule 4: Joint Meetings with the WIPO Permanent Committee for Development Cooperation Related to Industrial Property

The meetings of the Committee shall be joint with those of the WIPO Permanent ~~Committee~~ for Development Cooperation Related to Industrial Property, it being understood that the activities of the two Committees shall be coordinated and that, where decisions are made by the Committee, only the members of the Committee shall vote.

[Annex V follows]

ANNEX V

Draft

RULES OF PROCEDURE OF THE PCT COMMITTEE FOR
TECHNICAL COOPERATION (PCT/CTC)

Rule 1: Application of the General Rules of Procedure

The PCT Committee for Technical Cooperation (PCT/CTC; hereinafter referred to as "the Committee"), being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, as supplemented and amended by the provisions set forth hereafter.

Rule 2: Special Observers

(1) States and intergovernmental authorities which are not members of the Committee which have the status of special observer in the PCT Assembly shall be invited as "special observers" to all sessions of the Committee.

(2) Special observers shall have the same rights in the sessions of the Committee as members of the Committee, except the right to vote.

Rule 3: Joint Meetings with the WIPO Permanent Committee on Patent Information

The meetings of the Committee shall be joint with those of the WIPO Permanent Committee on Patent Information, it being understood that the activities of the two Committees shall be coordinated and that, where decisions are made by the Committee, only the members of the Committee shall vote.

[Annex VI follows]

ANNEX VI

DraftRULES OF PROCEDURE OF THE PCT COMMITTEE
FOR ADMINISTRATIVE AND LEGAL MATTERS (PCT/CAL)Rule 1: Composition

The PCT Committee for Administrative and Legal Matters (PCT/CAL; hereinafter referred to as "the Committee") shall have as members the States members of the PCT Union and the International Searching and Preliminary Examining Authorities, it being understood that where any such Authority is the national Office of a State member of the PCT Union, that State shall not be additionally represented on the Committee.

Rule 2: Terms of Reference

The Committee shall deal with matters concerning

(i) the relationship between the International Bureau on the one hand and the applicants, the receiving Offices, the designated Offices, the International Searching Authorities and the International Preliminary Examination Authorities on the other hand,

(ii) the relationship between the applicants on the one hand and the receiving Offices and the designated Offices on the other hand,

(iii) the relationship between the receiving and the designated Offices on the one hand and the International Searching Authorities and the International Preliminary Examination Authorities on the other hand,

(iv) fees, forms, procedures and publications under the PCT,

(v) other administrative and legal questions concerning the application of the PCT.

Rule 3: Application of the General Rules of Procedure

The Committee, being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, as supplemented and amended by the provisions set forth below.

Rule 4: Special Observers

(1) States which are not members of the Committee which have the status of special observer in the PCT Assembly, as well as intergovernmental authorities which have such a status and which are not members of the Committee, shall be invited as "special observers" to all sessions of the Committee.

(2) Special observers shall have the same rights in the sessions of the Committee as members of the Committee, except the right to vote.

Rule 5: Observers

The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested intergovernmental and non-governmental organizations to attend the sessions of the Committee in an observer capacity.

Rule 6: Working Groups

The Committee may set up working groups for the purposes of dealing with specific questions. It shall decide their composition, terms of reference, duration and rules of procedure.

[Annex VII follows]

ANNEX VII

PRELIMINARY DRAFT AGENDA

Prepared by the Director General

1. Opening of the session by the Director General
2. Adoption of the rules of procedure of the Assembly (see PCT, Article 53(12))
3. Election of a Chairman and of two Vice-Chairmen (see WIPO General Rules of Procedure, Rule 9)
4. Adoption of the agenda (see the present document)
5. Admission of observers (see PCT, Article 53(2)(ix))
6. Appointment of International Searching Authorities and International Preliminary Examining Authorities and approval of the agreements between those Authorities and the International Bureau (see PCT, Articles 16(3) and 32(3))
7. Fixing of the date from which international applications may be filed and of the date from which demands for international preliminary examination may be submitted (see PCT, Article 65(2))
8. Amendment of the PCT Regulations (see PCT, Article 58(2))
9. Consideration of matters concerning the relations between the International Bureau and prospective receiving and designated Offices (see PCT, Article 53(2)(a)(i))
10. Establishment of the Committee for Technical Cooperation; appointment of its members; adoption of its rules of procedure (see PCT, Article 56(1), (2)(a) and (c), (8))
11. Establishment of the Committee for Technical Assistance; election of its members; adoption of its rules of procedure (see PCT, Article 51(1), (2)(a), (5))
12. Decision concerning the implementation of Article 50 ("Patent Information Services") of the Patent Cooperation Treaty (see PCT, Article 50(6))
13. Establishment of Committees and Working Groups (see PCT, Article 53(2)(a)(viii))
14. Recommendations concerning the copyright protection of certain PCT publications (see PCT, Article 53(2)(a)(i))
15. Adoption of the report of the session
16. Closing of the session by the Chairman

[End of the Annexes and
End of the document]