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COMMITTEE ON REFORM  
OF THE PATENT COOPERATION TREATY (PCT)

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AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT;  
RELATED PROPOSALS: ELECTIONS; INTERNATIONAL FILING FEE;  
“COMMUNICATION ON REQUEST” SYSTEM

*Document prepared by the International Bureau*

## INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.<sup>1</sup>

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<sup>1</sup> Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

*The concept and operation of the designation system*

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT<sup>2</sup> relating, as recommended by the Committee, to the concept and operation of the designation system (see the report of the first session of the Committee, document PCT/R/26, paragraph 69).

4. The Working Group agreed on the general approach to be taken with regard to the new concept and operation of the designation system and generally agreed on the proposals for amendment of the Regulations contained in document PCT/R/WG/2/2, Annexes I to IV, subject to the matters raised in document PCT/R/WG/2/12, paragraphs 5 to 25:

“5. Discussions were based on document PCT/R/WG/2/2.

*“Automatic indication of all designations possible under the PCT*

“6. The International Bureau indicated that paragraph 5(e) of document PCT/R/WG/2/2 was not intended to suggest that Article 27(5) was exhaustive on the question of prior art effect, but rather that it must be read giving proper effect to Articles 11(3) and 64(4).

“7. The proposals contained in document PCT/R/WG/2/2, Annex I, were generally agreed, subject to the matters raised in the following paragraphs.

“8. In connection with proposed amended Rule 4:

(i) provision should be made for the mention in the request of details of a parent application where a patent of addition, etc., is sought, similarly to Rule 4.1(b)(iii) dealing with parents of a continuation or continuation-in-part of an earlier application, on the understanding that the absence of such an indication could be corrected by the applicant in the national phase; Rule 4.13 should also be reviewed in this connection;

(ii) the wording of Rule 4.9(a)(i) should make it expressly clear that it is only possible to designate States which are Contracting States at the filing date of the application;

(iii) the wording of Rule 4.9(a)(ii) and (iii) should be revised to provide that the filing of the request ‘constitute’ the desired effect rather than ‘have the effect of the wish of the applicant’;

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<sup>2</sup> References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO’s Web site at [http://www.wipo.int/pct/en/access/legal\\_text.htm](http://www.wipo.int/pct/en/access/legal_text.htm)). References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Web site at [http://www.wipo.int/eng/document/pt\\_dc/index.htm](http://www.wipo.int/eng/document/pt_dc/index.htm)).

(iv) the terminology used in Rule 4.9(b) ('prior to the time of performing the acts ...' and that used in Rule 49*bis*.1 ('within the time limit applicable ...') should desirably be aligned;

(v) the wording of Rule 4.9(c) should be revised to make it clear what was the nature of the circumstances in which it would operate (that is, in cases of 'self-designation' as explained in document paragraph 12(iv) of PCT/R/WG/1/9), having regard to the provisions of the national laws affected (that is, to those of Germany, Japan and the Republic of Korea), noting that 'incompatibility' did not correctly describe those circumstances;

(vi) the request form should contain a box which would enable applicants to make exclusions of designations under Rule 4.9(c) during the transitional period during which that Rule would operate;

(vii) Rule 4.9(d) should be deleted as being unnecessary having regard to the limited and transitional nature of Rule 4.9(c).

"9. It was agreed that the present requirements in respect of indications and signature under Rules 4.5 and 4.15 should be retained. However, in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide such signature and the indications required under Rule 4.5(a) to (c) in respect of all of two or more applicants, two safeguards for applicants should be added.

"10. The first safeguard would provide that, for the purposes of Article 14(1)(a)(i), it would be sufficient that the request be signed by at least one applicant. The second safeguard would provide that, for the purposes of Article 14(1)(a)(ii), it would be sufficient that indications required under Rule 4.5(a) to (c) be provided in respect of at least one applicant who is entitled according to Rule 19 to file the international application with the receiving Office concerned.

"11. It was also agreed that, consequential to those changes, provision should be made in Rule 51*bis*.1 to permit designated Offices to require, in the national phase, the signature and required indications in respect of all applicants where those had not been provided in the international phase. In addition, to enable the receiving Office to contact a common representative appointed, or considered, under Rule 90.2, such representative should have provided the indications required under Rule 4.5(a) to (c).

"12. It was further agreed that safeguards for applicants corresponding to those provided in relation to the request should be also added in relation to the signature, and to the indications in respect of the applicant, required in the demand.

"13. While most delegations favored the simplicity of an automatic and all-inclusive designation, the Delegation of Germany drew attention to the wording of certain Articles of the Treaty which contemplate the possibility that the applicant may (for example) designate only one Contracting State (see Article 4) or choose only one form of protection (see Article 43). It was agreed that further consideration should be given to the question whether such possibilities needed to be specifically enabled by procedures available under the Regulations. In the event that they did need to be enabled, while recognizing that they might not be of great practical significance, one possibility might be the withdrawal of designations on the same day as the application

was filed and to provide that such a withdrawal be considered as the exclusion of the designations concerned.

“14. It was noted that, when an automatic and all-inclusive designation system had been adopted, future contractual arrangements between applicants and others would need to take that fact into account.

“15. It was noted that further consequential amendments would be needed to Rule 32.2(b) and (c).

“16. In connection with proposed Rule 49*bis*:

(i) in Rule 49*bis*.1(a) and (b), the reference to ‘Article 22(1) and 39(1)(a)’ should be simply to ‘Article 22,’ noting that Rule 76.5 made the provisions applicable to Chapter II;

(ii) in Rule 49*bis*.2, the words ‘a further time which shall be reasonable under the circumstances’ should be replaced by ‘at least two months from [the time of entering the national phase]’ (the wording of the latter to be aligned with that in Rules 4.9(b) and 49*bis*.1; see paragraph 8(iv), above).

“17. It was agreed that Rule 76.6 no longer had any effect and should be deleted, since all transitional reservations made under that provision had since been withdrawn.

*“Automatic indication of all elections possible under the PCT*

“18. The proposals contained in document PCT/R/WG/2/2, Annex II, were generally agreed, subject to the matters raised in the following paragraphs.

“19. Considering that there is no longer a need for a specific regulation for the concept of ‘later election,’ it was agreed that Rule 56 should be deleted. Consequential amendment of other Rules (such as Rule 61.2) would then also be needed.

*“‘Flat’ international filing fee’*

“20. The proposals contained in document PCT/R/WG/2/2, Annex III, were generally agreed, subject to the matters raised in the following paragraphs.

“21. It was agreed that further consideration should be given to the basis for calculation of the late payment fee contemplated in Rule 16*bis*.2(b), depending on the amount which might be fixed for the new flat international filing fee (see Schedule of fees, item 1).

“22. It was agreed that item 1 of the Schedule of Fees should refer to ‘each sheet of the international application.’

*“‘Communication on request’ system*

“23. The proposals contained in document PCT/R/WG/2/2, Annex IV, were generally agreed, subject to the matters raised in the following paragraphs.

“24. It was agreed that Rule 47 as proposed to be amended and proposed new Rule 93bis should be revised to reflect the fact that those Rules would have to operate in relation to every Article 20 communication of a copy of the international application to a designated Office, no matter how that communication was effected, be it on the basis of a standing order for systematic communication of all or a certain class of documents or on the basis of a particular order for the communication of specified documents, be it on paper, in electronic form, by physical means (mailing) or by electronic means. Different considerations applied and could lead to different approaches, noting, in particular, the possibility of effecting communications by electronic means via a central data source (‘intellectual property digital library’ (IPDL)) from which Offices would be able to ‘pull’ documents rather than have them ‘pushed’ to Offices by the International Bureau.

“25. It was agreed that further consideration should be given to the nature of the act of ‘communication,’ the operation of Article 22(1), the safeguard afforded to applicants by the last sentence of present Rule 47.1(c), against the background of the proposed communication on request system, the possibilities available for Offices to make either particular orders for the communication of particular documents or standing orders for the communication of all or a certain class of documents, and the use of the term ‘IPDL’ in the context of communication by electronic means.”

5. This document sets out revised proposals for amendment of the Regulations concerning the concept and operation of the designation system, taking into account the comments and concerns expressed by various delegations during the discussions on this matter by the Working Group, and the areas where agreement has been reached. Similar to the order of the discussions on this matter by the Working Group, revised proposals for new or amended Rules contained in this document are divided into four parts and contained in the four Annexes to this document:

Annex I: Automatic indication of all designations possible under the PCT;

Annex II: Automatic indication of all elections possible under the PCT;

Annex III: “Flat” international filing fee;

Annex IV: “Communication-on request” system.

The main general features of those proposals are outlined in the following paragraphs.

*Automatic indication of all designations possible (see Annex I)*

6. *All-inclusive coverage.* By filing an international application, the applicant would obtain an automatic and all-inclusive coverage of all designations available under the Treaty, including all kinds of protection as well as both national and regional patent protection, without needing, at the time of filing the application, to designate individual Contracting States, to choose certain kinds of protection or to indicate expressly whether national or regional protection is sought. Such matters would be left to be dealt with in the national phase.

7. *Limited exclusions under transitional reservation provision.* The request form would include a box enabling applicants to exclude from the automatic and all-inclusive coverage

any Contracting State which had made use of a transitional reservation provision applicable to certain States whose national law provides for the automatic withdrawal of an earlier national application if a later international application claimed priority of that earlier national application and designated the country concerned (“self-designation”).

8. *Kind(s) of protection sought.* The ability to specify certain kinds of protection sought in particular designated States would be deferred until entry into the national phase in the States concerned; if no such specification is made at that stage, the international application would be treated as an application for the grant of a patent (only). Applicants could still mention in the request, for the purposes of international search, details concerning a parent application in case of a continuation or continuation-in-part or concerning a parent application or parent grant in other cases.

9. *Withdrawal of designations.* Under the proposals, the applicant could, as at present, withdraw individual designations. While in practice there would seem to be a negligible number of cases in which applicants might wish not to designate certain States at the time of filing (apart from the possibility referred to in paragraph 7, above), Articles 4(1)(ii) and 11(1)(iii)(b) envisage, and arguably require the provision of the option for, not making all possible designations. It would be therefore be possible, although extremely unlikely in practice, for an applicant to exercise such an option by withdrawing a designation on the same day on which the international application is filed, in which case the designation of the State concerned would be considered not to have been made (see proposed Rule 90bis.6(d)).

10. *Signatures; indications concerning applicants.* The present requirements in respect of signatures and indications in respect of applicants under Rules 4.5 and 4.15 would be maintained. However, in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide such signatures and indications in respect of all applicants (where there are two or more), it would be sufficient that the request be signed by at least one applicant and that indications be provided in respect of at least one applicant who is entitled under Rule 19 to file the international application with the receiving Office concerned. However, designated Offices would be permitted to require, in the national phase, the signature and required indications in respect of any applicants who had not provided them in the international phase.

11. *Powers of attorney.* Where a sole applicant is represented by an agent, or where all co-applicants are represented by a common agent or a common representative, the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the International Bureau would be entitled to waive the requirement that a separate power of attorney be submitted. It would be for the Office, the Authority or the International Bureau, as the case may be, to decide in what circumstances the requirement would be waived. The Office, the Authority or the International Bureau would be permitted to require a separate power of attorney in particular instances even if it had waived the requirement in general. The signature of all applicants would, however, be mandatory in the case of a withdrawal under Rule 90bis or a change in the person of the applicant under Rule 92bis.

*Automatic indication of all elections possible (see Annex II)*

12. *All-inclusive coverage.* The same concept as for designations would be applied to elections under Chapter II; all eligible States would be considered to have been elected. The Rules containing express provisions regulating the procedure for making “later elections”

would be deleted as unnecessary, although the theoretical possibility of making later elections, as envisaged by Article 31(4)(a) and (6)(b), would not be excluded.

13. *Signatures; indications concerning applicants.* Safeguards corresponding to those provided in relation to the request (see paragraph 10, above) would be added in relation to the signature, and to the indications in respect of the applicant, required in relation to the demand.

14. *Withdrawal of elections.* Under the new approach, as at present, the applicant would be able to withdraw any or all elections. As for designations (see paragraph 9, above), and noting that Article 31(4)(a) envisages the possibility that not all eligible States may be elected, an election could theoretically be withdrawn on the same day as the demand is filed, in which case that election would be considered not to have been made (see proposed Rule 90*bis*.6(e)).

*“Flat” international filing fee (see Annex III)*

15. *Elimination of basic fee and designation fees.* The concept of designation fees payable in addition to the basic fee would be eliminated; instead, a flat “international filing fee” would be introduced, irrespective of the number of designations made. As a consequence of the change in the fee structure, a new international filing fee would have to be fixed. The amount of such fee would need to be determined taking into consideration the requested level of the budget resources of WIPO at the time and any related budgetary implications.

*“Communication on request” system (Annex IV)*

16. *Communication of documents.* The present system of “systematic communication” to a designated Office of all documents relating to international applications designating that Office would be replaced by a “communication on request” system, under which documents would be communicated to a designated Office only upon request by the Office and at the time specified by it. While it would still be possible for a designated Office to request the communication of a class or classes of documents, it would be expected that most Offices would request communications only in relation to international applications which have actually entered the national phase before them.

17. *The Committee is invited to consider the proposals contained in Annexes I to IV.*

[Annex I follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>1</sup>

## AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.



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**Rule 4**

**The Request (Contents)**

4.1 *Mandatory and Optional Contents; Signature*

(a) The request shall contain:

(i) to (iii) [No change]

~~(iv) the designation of States,~~

[COMMENT: In line with the proposed new approach of eliminating the need for individual designations of Contracting States (see, in particular, the proposed new wording of Rule 4.9(a), below) it is proposed to delete item (iv) from the list of mandatory content of the request.]

~~(iv)~~<sup>(v)</sup> indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

(b) The request shall, where applicable, contain:

(i) and (ii) [No change]

~~(iii) choices of certain kinds of protection,~~

~~(iv) an indication that the applicant wishes to obtain a regional patent,~~

*[Rule 4.1(b), continued]*

[COMMENT: In line with the proposed elimination of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see Rule 4.9(a)(ii) as proposed to be amended) and of the need to specify whether national and/or regional patents are sought (see Rule 4.9(a)(iii) as proposed to be amended, below), it is proposed to delete present items (iii) and (iv) from the list of mandatory contents (where applicable) of the request and to renumber present items (v) and (vi) accordingly.]

(iii) ~~(v)~~ a reference to a parent application or parent patent,

[COMMENT: As has been suggested by the Working Group (see document PCT/R/WG/2/12, paragraph 8(i), reproduced in paragraph 4 of the Introduction, above), it is proposed to retain the current requirement to include, in the request, a reference to a parent application (where the international application is a continuation or continuation in part of an earlier application) or a reference to a parent application or parent patent, parent inventor's certificate or parent utility certificate (where the applicant wishes the international application to be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition). Inclusion of such references would be for the purposes of international search, for the benefit of the International Searching Authority, and in no way would affect the operation of the designation system itself under Rule 4.9. See also Rule 4.11 as proposed to be amended, below.]

(iv) ~~(vi)~~ an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) No change

4.2 to 4.8 [No change]

4.9 *Designation of States; Kinds of Protection; National and Regional Patents*

(a) The filing of a request shall constitute:

(i) the designation of all Contracting States that are bound by the Treaty on the international filing date;

(ii) an indication that the international application is, in respect of each designated State to which Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State;

(iii) an indication that the international application is, in respect of each designated State to which Article 45(1) applies, for the grant of a regional patent and also, unless Article 45(2) applies, a national patent.

[COMMENT: This is the central provision giving effect to the proposed automatic and all-inclusive designation system outlined in the Introduction, above. Paragraph (a)(i) has been further amended so as to clarify that it is only possible to designate Contracting States that are bound by the Treaty on the international filing date (see document PCT/R/WG/2/12, paragraph 8(ii), reproduced in paragraph 4 of the Introduction, above). Paragraph (a)(ii) and (iii) have been further amended so as to simplify the wording (see document PCT/R/WG/2/12, paragraph 8(iii), reproduced in paragraph 4 of the Introduction, above).]

*[Rule 4.9(a), continued]*

~~Contracting States shall be designated in the request:~~

~~(i) in the case of designations for the purpose of obtaining national patents, by an indication of each State concerned;~~

~~(ii) in the case of designations for the purpose of obtaining a regional patent, by an indication that a regional patent is desired either for all Contracting States which are party to the regional patent treaty concerned or only for such Contracting States as are specified.~~

*[Rule 4.9, continued]*

(b) Notwithstanding paragraph (a)(i), if, on [date of adoption of these modifications by the PCT Assembly], the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request may, for as long as that national law continues to so provide, contain an indication that the designation of that State is not made, provided that the designated Office informs the International Bureau by [three months from the date of adoption of these modifications by the PCT Assembly] that this paragraph shall apply in respect of designations of that State. The information received shall be promptly published by the International Bureau in the Gazette.

~~The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:~~

~~(i) at least one Contracting State is designated under paragraph (a), and~~

~~(ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.~~

*[Rule 4.9, continued]*

(e) ~~[Deleted]~~ ~~The confirmation of any designation made under paragraph (b) shall be effected by~~

~~(i) filing with the receiving Office a written notice containing an indication as referred to in paragraph (a)(i) or (ii), and~~

~~(ii) paying to the receiving Office the designation fee and the confirmation fee referred to in Rule 15.5~~

~~within the time limit under paragraph (b)(ii).~~

[COMMENT: In line with the proposed new concept of designations, there is no need to maintain the present precautionary designation and confirmation system as provided in existing paragraphs (b) and (c). Paragraph (b) is proposed to be amended so as to provide, in the form of a transitional reservation provision, for the possibility of excluding the designation of a Contracting State if the national law of that State provides for automatic withdrawal of an earlier application in the case of “self-designation” (see paragraph 7 of the Introduction, above). It is envisaged to include in the request form a box which would enable applicants to make exclusions of designations under paragraph (b) during the transitional period during which that Rule would operate. (See document PCT/R/WG/2/12, paragraphs 8(v) and (vi), reproduced in paragraph 4 of the Introduction, above).]

4.10 [No change]

4.11 *Reference to Earlier Search, Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

- (i) an international or international-type search has been requested on an application under Article 15(5); ~~or if~~
- (ii) the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application;~~;~~
- (iii) the applicant intends to make an indication under Rule 49bis.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
- (iv) the applicant intends to make an indication under Rule 49bis.1(c) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;



*[Rule 4.11(a), continued]*

the request shall so indicate and shall, as the case may be, contain a reference to that fact. ~~Such reference shall either~~ identify the application ~~(or its translation, as the case may be)~~ in respect of which the earlier search was made ~~by indicating country, date and number,~~ or otherwise identify the ~~said~~ search, ~~by indicating, where applicable, date and number of the request for such search~~ or indicate the relevant parent application or parent patent or other parent grant.

(b) The inclusion in the request of an indication under paragraph (a)(iii) or (iv) shall have no effect on the operation of Rule 4.9.

[COMMENT: It is proposed to amend Rule 4.11 so as to require the applicant to include in the request, in accordance with Rule 4.1(b)(iii) and (iv) as proposed to be amended (see above), an indication of the parent application or parent patent concerned where the applicant intends, when entering the national phase (see Rule 49bis), to indicate the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition, or as a continuation or continuation in part of an earlier application. Inclusion of such indications would be for the for the purposes of international search, for the benefit of the International Searching Authority, and would not affect the operation of Rule 4.9. Certain details in the present provision are proposed to be omitted and left to the Administrative Instructions or simply to the wording of the request form. See also Rule 4.1(b)(iii) and (iv) as proposed to be amended, above.]

4.12 [Deleted] ~~*Choice of Certain Kinds of Protection*~~

~~(a) If the applicant wishes his international application to be treated, in any designated State, as an application not for a patent but for the grant of any of the other kinds of protection specified in Article 43, he shall so indicate in the request. For the purposes of this paragraph, Article 2(ii) shall not apply.~~

*[Rule 4.12, continued]*

~~(b) In the case provided for in Article 44, the applicant shall indicate the two kinds of protection sought, or, if one of two kinds of protection is primarily sought, he shall indicate which kind is sought primarily and which kind is sought subsidiarily.~~

4.13 ~~[Deleted]~~ *Identification of Parent Application or Parent Grant*

~~If the applicant wishes his international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, he shall identify the parent application or the parent patent, parent inventor's certificate, or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph, Article 2(ii) shall not apply.~~

4.14 ~~[Deleted]~~ *Continuation or Continuation-in-Part*

~~If the applicant wishes his international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, he shall so indicate in the request and shall identify the parent application involved.~~

[COMMENT: The proposed deletion of Rules 4.12 to 4.14 is consequential on the proposed introduction of an automatic and all-inclusive coverage of all designations available under the Treaty, including all kinds of protection as well as both national and regional patent protection, without needing to designate individual Contracting States, to choose certain kinds of protection or to indicate expressly whether national or regional protection is sought).]

4.14bis to 4.18 [No change]

## Rule 26

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

26.1 and 26.2 [No change]

#### 26.2bis Checking of Requirements Under Article 14(1)(a)(i) and (ii)

(a) For the purposes of Article 14(1)(a)(i), if there is more than one applicant, it shall be sufficient that the request be signed by at least one of them [who is entitled according to Rule 19.1 to file the international application with the receiving Office].

(b) For the purposes of Article 14(1)(a)(ii), if there is more than one applicant, it shall be sufficient that the indications required under Rule 4.5(a) to (c) be provided in respect of at least one of them who is entitled according to Rule 19.1 to file the international application with the receiving Office [and has signed the request].

[COMMENT: As was agreed at the second session of the Working Group (see document PCT/R/WG/2/12, paragraphs 9 to 11, reproduced in paragraph 4 of the Introduction, above), in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide the signatures or the required indications of *all* of the applicants (where there are two or more), it is proposed to add the new safeguards set out in proposed new Rule 26.2bis(a) and (b). The words in square brackets have been included for discussion purposes: Do the signature and the indications provided need to be of the same applicant; do(es) the applicant(s) concerned need to have the right to file with the receiving Office? Consequential to those proposed changes, it is also proposed to permit designated Offices to require, in the national phase, the signature and required indications in respect of all applicants where those had not been provided in the international phase (see Rule 51bis.1(a) as proposed to be amended, below; see also Rule 90.2 as proposed to be amended, below).]

26.3 to 26.6 [No change]

## Rule 32

### Extension of Effects of International Application to Certain Successor States

#### 32.1 *Request for Extension of International Application to Successor State*

(a) The effects of any international application whose international filing date falls in the period defined in paragraph (b) ~~are may, subject to the performance by the applicant of the acts specified in paragraph (c), be~~ extended to a State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting State designated in the international application which subsequently ceased to exist (“the predecessor State”), provided that the successor State has become a Contracting State through the deposit, with the Director General, of a declaration of continuation the effect of which is that the Treaty is applied by the successor State.

[COMMENT: In line with the proposed new approach with regard to designations, it is proposed to amend Rule 32 so as to automatically extend the effects of an international application to a successor State which has deposited a declaration of continuation under Rule 32.1(a).]

(b) [No change]

(c) Information on ~~In respect of~~ any international application whose filing date falls within the applicable period under paragraph (b) and whose effect is extended to the successor State shall be published by; the International Bureau shall in the Gazette. ~~send the applicant a notification informing him that he may make a request for extension by performing, within three months from the date of that notification, the following acts:~~

*[Rule 32.1(c), continued]*

~~(i) filing with the International Bureau the request for extension;~~

~~(ii) paying to the International Bureau an extension fee in Swiss francs, the amount of which shall be the same as the amount of the designation fee referred to in Rule 15.2(a).~~

[COMMENT: It is proposed to stop sending individual notifications to each applicant and instead to publish the relevant information about the extension and the international applications concerned in the Gazette.]

(d) ~~[Deleted] This Rule shall not apply to the Russian Federation.~~

[COMMENT: The proposed deletion of paragraph (d) is consequential on the proposed amendment of paragraph (a).]

### 32.2 *Effects of Extension to Successor State*

(a) Where the effects of the international application are extended to the successor State ~~a request for extension is made~~ in accordance with Rule 32.1,

(i) [No change]

(ii) the applicable time limit under Article 22 or 39(1) in relation to that State shall be extended until the expiration of at least six ~~three~~ months from the date of the publication of the information under Rule 32.1(c) ~~request for extension~~.

*[Rule 32.2(a), continued]*

[COMMENT: It appears justified to extend the time limit for national phase entry to six months from the date of the publication of the information concerning the extension and the international applications concerned since the applicant is no longer notified by the International Bureau by way of an individual notification but has to rely on the information published in the Gazette.]

~~(b) [Deleted] Where, in the case of a successor State which is bound by Chapter II of the Treaty, the request for extension was made after, but the demand was made before, the expiration of the 19th month from the priority date, and a later election is made of the successor State within three months from the date of the request for extension, the applicable time limit under paragraph (a)(ii) shall be at least 30 months from the priority date.~~

~~(b)(e)~~ The successor State may fix a time limits which expires later than that ~~those~~ provided in paragraphs (a)(ii) ~~and (b)~~. The International Bureau shall publish information on such time limits in the Gazette.

[COMMENT: The proposed deletion of present paragraph (b) is consequential on the proposed amendment of Rule 32.1(a) and the proposed elimination of the system of later elections (see Annex II). The proposed amendment of present paragraph (c) is consequential on the proposed deletion of present paragraph (b).]

## Rule 48

### International Publication

48.1 to 48.5 [No change]

[COMMENT: In line with the proposed new concept of eliminating the need for individual designations, the Administrative Instructions will have to be modified so as to avoid having to indicate, on each front page of the pamphlet (and in each entry in the Gazette, see Rule 86.1(a)(i) and Annex D of the Administrative Instructions), a list of all names (two-letter country codes) of all States designated in the international application concerned, noting that, in all cases, that list would always contain all States bound by the Treaty on the international filing date of the application concerned. Instead, an entry along the following lines could appear on the front page of the pamphlet: “Designated States: all States bound by the Treaty on the international filing date of this application.” In the electronic version of the PCT Gazette, the list of those States could be seen by clicking on a hyperlink; furthermore, the International Bureau would publish in each PCT Gazette a list of the Contracting States indicating the date on which each of them became bound by the Treaty. Of course, should any Contracting State make use of the transitional reservation provision under Rule 4.9(b), any exclusion of such State from the “all-inclusive” designation must also be indicated.]

#### 48.6 *Announcing of Certain Facts*

(a) If any notification under Rule 29.1~~(a)~~(ii) reaches the International Bureau at a time later than that at which it was able to prevent the international publication of the international application, the International Bureau shall promptly publish a notice in the Gazette reproducing the essence of such notification.

[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed amendment of Rule 29.1 (see Annex III, below).]

(b) *[Remains deleted]*

(c) [No change]

**Rule 49bis**

**Indications as to Protection Sought for Purposes of National Processing**

49bis.1 Choice of Certain Kinds of Protection

(a) If the applicant wishes the international application to be treated, in a designated State in respect of which Article 43 applies, as an application not for the grant of a patent but for the grant of another kind of protection referred to in that Article, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office.

(b) If the applicant wishes the international application to be treated, in a designated State in respect of which Article 44 applies, as an application for the grant of more than one kind of protection referred to in Article 43, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall indicate, if applicable, which kind of protection is sought primarily and which kind is sought subsidiarily.

(c) In the cases referred to in paragraphs (a) and (b), if the applicant wishes the international application to be treated, in a designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition, the applicant, when performing the acts referred to in Article 22, shall indicate the relevant parent application, parent patent or other parent grant.



*[Rule 49bis.1, continued]*

(d) If the applicant wishes the international application to be treated, in a designated State, as an application for a continuation or a continuation-in-part of an earlier application, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall indicate the relevant parent application.

[COMMENT: See Comment on Rule 4.9(a), above. The applicant would obtain, when filing an international application, an automatic and all-inclusive coverage with regard to all kinds of protection, without the need to specify, already upon filing, which kind(s) of protection he intends to seek in any of the designated States (an indication may, however be required at the time of filing for the purposes of the international search; see Rule 4.11, above). Instead, under proposed new Rule 49bis, the applicant would be required to do so only when entering the national phase before the designated Office concerned. If the applicant does not make any choice of kind of protection, the international application will be treated as an application for the grant of a patent (only) (see Article 4(3)).]

49bis.2 Time of Furnishing Indications

(a) No designated Office shall require the applicant, before performing the acts referred to in Article 22, to furnish any indication referred to in Rule 49bis.1 or, where applicable, any indication as to whether the applicant seeks the grant of a national patent or a regional patent.

(b) Where the applicant fails to furnish an indication referred to in paragraph (a) when performing the acts referred to in Article 22, the applicant shall have an opportunity to furnish such indication within a time limit which shall be at least two months after the applicant has performed those acts. In any case, the applicant may, if so permitted by the national law of the designated State concerned, furnish such indication or, if applicable, convert from one kind of protection to another, at any later time.

[COMMENT: New Rule 49bis.2 would ensure that an applicant who does not, upon entry into the national phase, comply with the requirement to choose the kind(s) of protection sought or to identify the parent application or grant, would have another opportunity to do so. Note that there would be no obligation on the designated Office to invite the applicant to make such choice or to identify the parent application or grant. Where the applicant, after the expiration of the applicable time limit, still has not made any choice, or has not identified the parent application or grant, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)). Provisions under the applicable national law which provide for a conversion of an application for the grant of a patent into an application for the grant of another kind of protection, if any, should apply. A two-month time limit is set for furnishing a missing indication after national phase entry (see document PCT/R/WG/2/12, paragraphs 8(iv) and 16(ii), reproduced in paragraph 4 of the Introduction, above).]

**Rule 51bis**

**Certain National Requirements Allowed Under Article 27**

*51bis.1 Certain National Requirements Allowed*

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iv) [No change]

(v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time;

(vi) the confirmation of the international application by the signature of any applicant for the designated State who has not signed the request;

[COMMENT: The designated Office would be free to require the missing signatures on a copy of the request as originally filed or in some other way. The wording derives from that found in Article 27(2)(ii).]

*[Rule 51bis.1(a), continued]*

(vii) any indication required under Rule 4.5(a) to (c), in respect of any applicant who is indicated as applicant for the designated State, which was not included in the request.

[COMMENT: Notwithstanding the fact that, during the international phase, the indications required under Rule 4.5 (a) to (c) and the signature of only one applicant would be sufficient, it is proposed that the national law applicable by the designated Office may require the furnishing, after national phase entry, of any such indications and of the signature of any applicant who has not furnished such indications or has not signed the request (or a power of attorney, if the request was signed by an agent or a common representative) (see document PCT/R/WG/2/12, paragraph 11, reproduced in paragraph 4 of the Introduction, above).]

(b) to (f) [No change]

51bis.2 and 51bis.3 [No change]

**Rule 76**

**Copy, Translation and Fee Under Article 39(1);**

**Translation of Priority Document**

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 *Application of Rules 22.1(g), 49, [49bis](#) and 51bis*

Rules 22.1(g), 49, [49bis](#) and 51bis shall apply, provided that:

[COMMENT: It is proposed to amend Rule 76.5 so as to ensure that proposed new Rule 49bis is also applied with regard to elected Offices. Rule 76.5 is proposed to be further amended in the context of Annex IV (see below).]

(i) to (iv) [No change]

76.6 ~~[Deleted]~~ *Transitional Provision*

~~If, on July 12, 1991, Rule 76.5(iv) is not compatible with the national law applied by the elected Office in respect of claims amended under Article 19, Rule 76.5(iv) shall not apply in that respect to that elected Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.~~

[COMMENT: Rule 76.6 has no longer any effect since all transitional reservations made under this provision have since been withdrawn, and is thus proposed to be deleted (see paragraph 17, reproduced in paragraph 4 of the Introduction, above).]

## Rule 90

### Agents and Common Representatives

90.1 [No change]

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9[, who has signed the request and] in respect of whom all indications required under Rule 4.5(a) to (c) have been provided may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office[, who has signed the request and] in respect of whom all indications required under Rule 4.5(a) to (c) have been provided shall be considered to be the common representative of all the applicants.

[COMMENT: Rule 90.2 is proposed to be amended to require an appointed or “deemed” common representative to provide the indications required under Rule 4.5(a) to (c) so as to enable receiving Offices to contact such common representative (see document PCT/R/WG/2/12, paragraph 11, reproduced in paragraph 4 of the Introduction, above). As to the text in square brackets, see the Comment on Rule 26.2*bis*, above.]

90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a)and (b) [No change]

(c) [No change] If the separate power of attorney is not signed, or if the required separate 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) Subject to paragraph (e), any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply.

(e) Where the agent or the common representative submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 or any request for the recording of a change in the person of the applicant referred to in Rule 92bis.1(a)(i), the requirement under paragraph (b) for a separate power of attorney shall not be waived under paragraph (d).

[COMMENT: Rule 90.4 is proposed to be amended to provide that any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement provided in Rule 90.4(b) that a separate power of attorney be submitted to it (see document PCT/R/WG/2/12, paragraphs 57 and 58, reproduced in paragraph 4 of the Introduction, above). It would be for the Office, the Authority or the International Bureau, as the case may be, to decide in what circumstances the requirement would be waived (for example, in cases where the agent concerned was the subject of an indication under Rule 4.7(b), or where the agent is registered to practice before the Office and subject to professional code of conduct). The Office, the Authority or the International Bureau would be permitted to require a separate power of attorney in particular instances even if it had waived the requirement in general. The signature of the applicant or of all applicants would be mandatory in the case of a withdrawal under Rule 90bis (see Rule 90bis.5 as proposed to be amended, below) or a change in the person of the applicant under Rule 92bis (see proposed new Rule 92bis.1(a-bis), below).]

**Rule 90bis**

**Withdrawals**

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

(a) Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, subject to paragraph (b), be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who ~~Where one of the applicants~~ is considered to be the common representative under Rule 90.2(b) shall not be entitled to sign such a notice on behalf of the other applicants, ~~such notice shall, subject to paragraph (b), require the signature of all the applicants.~~

[COMMENT: See Comment on Rule 90.4, above. The second sentence of paragraph (a) is proposed to be amended for clarification purposes only.]

(b) [See Annex II]

[COMMENT: Paragraph (b) (see the proposed amendment thereof in Annex II) excuses signature in certain cases by applicants indicated as applicant/inventor for the United States of America. The Committee may wish to consider whether the operation of that paragraph should be extended to any applicant.]



90bis.6 Effect of Withdrawal

(a) to (c) [No change]

(d) Where a designation is withdrawn under Rule 90bis.2 on the same day as the international filing date, that designation shall be considered not to have been made.

(e) [See Annex II]

[COMMENT: See document PCT/R/WG/2/12, paragraph 13, reproduced in paragraph 4 of the Introduction, and paragraph 9 of the Introduction, above. See also proposed Rule 90bis.6(e) in respect of elections, in Annex II, below.]

90bis.7 [No change]

**Rule 92bis**

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

92bis.1 *Recording of Changes by the International Bureau*

(a) [No change]

(a-bis) Rule 90bis.5 shall apply *mutatis mutandis* to any request for the recording of a change in the person of the applicant.

[COMMENT: See Comment on Rule 90.4, above.]

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.‡

~~(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.~~

*[Rule 92bis.1(b), continued]*

[COMMENT: In the context of the proposed introduction of a new concept and operation of the designation system, it is also proposed to amend Rule 92bis. The existing time limits for the recording of a change under Rule 92bis is either 20 or 30 months from the priority date, depending on whether it is the time limit under Article 22(1) or 39(1)(a) which is applicable. That distinction has become meaningless since, following the recent modification of the time limit under Article 22(1), the time limits under Articles 22(1) and 39(1)(a) are both 30 months. Section 422 of the Administrative Instructions, providing for the details as to notifications concerning changes recorded under Rule 92bis, would also have to be modified accordingly.]

[Annex II follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>1</sup>

## AUTOMATIC INDICATION OF ALL ELECTIONS POSSIBLE UNDER THE PCT

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

**Rule 53**

**The Demand**

53.1 to 53.3 [No change]

53.4 *The Applicant*

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*. ~~Only applicants for the elected States are required to be indicated in the demand.~~

[COMMENT: The proposed amendment of Rule 53.4 is consequential on the proposed introduction of the new concept of automatic election of all designated Contracting States under Rule 53.7 (see below).]

53.5 and 53.6 [No change]

53.7 *Election of States*

(a) The filing of a demand shall constitute the election of all ~~indicate at least one~~ Contracting States, ~~from among those States~~ which are designated and are bound by Chapter II of the Treaty (~~“eligible States”~~), ~~as an elected State~~.

~~(b) Election of Contracting States in the demand shall be made:~~

~~(i) by an indication that all eligible States are elected, or,~~

~~(ii) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States that are elected, and, in the case of States which have been designated for the purpose of obtaining a regional patent, by an indication of the regional patent concerned together with either an indication that all eligible States party to the regional patent treaty concerned are elected or an indication of those among the said States that are elected.~~

[COMMENT: Rule 53.7 is proposed to be amended so as to align the concept of election of Contracting States with the proposed new concept of designation. The proposed new wording is necessary to ensure compliance with Article 31(4) which requires that the demand “shall indicate ... the Contracting ... States ... in which the applicant intends to use the results of the international preliminary examination.” As to the possibility of withdrawing elections on the same day as the demand is received, see paragraph 14 of the Introduction, above, and proposed Rule 90bis.6(e), below.]

53.8 and 53.9 [No change]

**Rule 56**

**[Deleted] Later Elections**

~~56.1—Elections Submitted Later than the Demand~~

~~(a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice submitted to the International Bureau. The notice shall identify the international application and the demand, and shall include an indication as referred to in Rule 53.7(b)(ii).~~

~~(b) Subject to paragraph (c), the notice referred to in paragraph (a) shall be signed by the applicant for the elected States concerned or, if there is more than one applicant for those States, by all of them.~~

~~(c) Where two or more applicants file a notice effecting a later election of a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the notice or could not be found or reached after diligent effort, the notice need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and~~

~~(i) a statement is furnished explaining, to the satisfaction of the International Bureau, the lack of signature of the applicant concerned, or~~

*[Rule 56.1(c), continued]*

~~(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or did not sign the demand but the requirements of Rule 53.8(b) were complied with.~~

~~(d) An applicant for a State elected by a later election need not have been indicated as an applicant in the demand.~~

~~(e) If a notice effecting a later election is submitted after the expiration of 19 months from the priority date, the International Bureau shall notify the applicant that the election does not have the effect provided for under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in respect of the elected Office concerned within the time limit applicable under Article 22.~~

~~(f) If, notwithstanding paragraph (a), a notice effecting a later election is submitted by the applicant to the International Preliminary Examining Authority rather than the International Bureau, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.~~



~~56.2—Identification of the International Application~~

~~The international application shall be identified as provided in Rule 53.6.~~

~~56.3—Identification of the Demand~~

~~The demand shall be identified by the date on which it was submitted and by the name of the International Preliminary Examining Authority to which it was submitted.~~

~~56.4—Form of Later Elections~~

~~The notice effecting the later election shall preferably be worded as follows: “In relation to the international application filed with ... on ... under No. ... by ... (applicant) (and the demand for international preliminary examination submitted on ... to ...), the undersigned elects the following additional State(s) under Article 31 of the Patent Cooperation Treaty: ...”~~

~~56.5—Language of Later Elections~~

~~The later election shall be in the language of the demand.~~

[COMMENT: Rule 56 is proposed to be deleted since there is no longer a need to regulate the procedure for making later elections (see document PCT/WG/R/2/12, paragraph 19, reproduced in paragraph 4 of the Introduction, and paragraph 12 of the Introduction, above).]

**Rule 60**

**Certain Defects in the Demand or Elections**

60.1 *Defects in the Demand*

(a) Subject to paragraph (a-bis), if ~~if~~ the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(a-bis) For the purposes of paragraph (a), if there are two or more applicants, it shall be sufficient that:

(i) the demand be signed by at least one applicant [who has the right according to Rule 54.2 to make a demand].

(ii) the indications referred to in Rule 4.5(a) to (c) as required under Rule 53.4 be provided in respect of at least one applicant who [has signed the demand and] has the right according to Rule 54.2 to make a demand.

[COMMENT: Proposed new paragraph (a-bis) would provide for safeguards for the applicants corresponding to those provided in relation to the request in proposed new Rule 26.2bis (see Annex I, above) in relation to the signature, and to the indications in respect of the applicant, required in the demand (see document PCT/R/WG/2/12, paragraph 12, reproduced in paragraph 4 of the Introduction, and paragraphs 10 and 13 of the Introduction, above). As to the text in square brackets, similar considerations apply to those mentioned in the Comment on Rule 26.2bis in Annex I, above.]

(b) to (g) [No change]

60.2 ~~[Deleted]~~ *Defects in Later Elections*

~~(a) If the notice effecting a later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Bureau at any time before a decision is taken.~~

~~(b) If the applicant complies with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had been received on the actual filing date, provided that the notice as submitted contained at least one election and permitted the international application to be identified; otherwise, the notice shall be considered as if it had been received on the date on which the International Bureau receives the correction.~~

~~(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted and the International Bureau shall so declare.~~

~~(d) Where, in respect of an applicant for a certain elected State, the signature required under Rule 56.1(b) and (c) or the name or address is lacking after the expiration of the time limit under paragraph (a), the later election of that State shall be considered as if it had not been made.~~

[COMMENT: The proposed deletion of Rule 60.2 is consequential on the proposed deletion of Rule 56 (see above).]

**Rule 61**

**Notification of the Demand and Elections**

61.1 *Notification to the International Bureau and the Applicant*

(a) and (b) [No change]

(c) ~~[Deleted] The International Bureau shall promptly notify the applicant of the receipt, and the date of receipt, of any notice effecting a later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b). Where the notice has been considered under Rule 60.2(c) as if it had not been submitted or where a later election has been considered under Rule 60.2(d) as if it had not been made, the International Bureau shall notify the applicant accordingly.~~

[COMMENT: The proposed deletion of paragraph (c) is consequential on the proposed deletion of Rule 56 (see above).]

61.2 *Notification to the Elected Offices*

(a) [No change]

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed) [and](#); the date of receipt by the International Preliminary Examining Authority of the demand, ~~and in the case of a later election the date of receipt of the notice effecting the later election. The latter date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b).~~

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed deletion of Rule 56 (see above).]

(c) [No change]

(d) [See Annex IV]

61.3 [No change]

61.4 [See document PCT/R/2/7]

[COMMENT: No change is proposed to be made to Rule 61.4 in the context of this document. See, however, changes proposed to be made to Rule 61.4 in the context of the introduction of the enhanced international search and preliminary examination system (document PCT/R/2/7). Section 431 of the Administrative Instructions, providing for the details as to which information on the demand and the elected States is to be published in the Gazette, would have to be modified so as to bring it in line with the proposed new concept of eliminating the need for individual elections and the fact that, under the proposed new approach, exclusion of elections would not any longer be possible.]

**Rule 90bis**

**Withdrawals**

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

(a) [See Annex I]

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

(i) and (ii)

(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with, ~~or did not sign the later election concerned but the requirements of Rule 56.1(c) were complied with.~~

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed deletion of Rule 56 (see above). The Committee may wish to consider whether the operation of that paragraph, which excuses signature in certain cases by applicants indicated as applicant/inventor for the United States of America, should be extended to any applicant.]

90bis.6 *Effect of Withdrawal*

(a) to (c) [No change]

(d) [See Annex I]

(e) Where an election is withdrawn under Rule 90bis.4 on the same day as that on which the demand is received, that election shall be considered not to have been made.

[COMMENT: See document PCT/R/WG/2/12, paragraph 13, reproduced in paragraph 4 of the Introduction, and paragraph 14 of the Introduction, above. See also proposed Rule 90bis.6(d) in respect of designations, in Annex I, above.]

90bis.7 [No change]

[Annex III follows]



PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>1</sup>

## “FLAT” INTERNATIONAL FILING FEE

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

## Rule 15

### The International Filing Fee

#### 15.1 *The International Filing ~~Basic Fee and Designation~~ Fee*

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau (“international filing fee”) to be collected by the receiving Office. That fee includes the fee referred to in Article 4(2). ~~and consisting of,~~

~~(i) a “basic fee,” and~~

~~(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a), except that, where Article 44 applies in respect of a designation, only one designation fee shall be due for that designation, and that the Schedule of Fees may indicate a maximum number of designation fees payable.~~

[COMMENT: In line with the new concept of eliminating the need for individual designations, it is proposed to also eliminate the need for the payment of individual designation fees and to replace both the current basic fee and the current designation fee(s) with just one flat “international filing fee,” irrespective of the number of designations made. See also Rule 27 as proposed to be amended.]

#### 15.2 *Amounts*

(a) The amount ~~amounts~~ of the international filing ~~basic fee and of the designation~~ fee is ~~are~~ as set out in the Schedule of Fees.

*[Rule 15.2, continued]*

(b) The international filing ~~basic fee and the designation~~ fee shall be payable in the currency or one of the currencies prescribed by the receiving Office (“prescribed currency”), it being understood that, when transferred by the receiving Office to the International Bureau, ~~it they~~ shall be freely convertible into Swiss currency. The amount ~~amounts~~ of the international filing ~~basic fee and of the designation~~ fee shall be established, for each receiving Office which prescribes the payment of ~~that those~~ fees in any currency other than Swiss currency, by the Director General after consultation with the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as the prescribed currency. The ~~amounts~~ so established shall be the ~~equivalents~~, in round figures, of the ~~amounts~~ in Swiss currency set out in the Schedule of Fees. ~~It They~~ shall be notified by the International Bureau to each receiving Office prescribing payment in that prescribed currency and shall be published in the Gazette.

(c) Where the amount ~~amounts~~ of the international filing fee ~~fees~~ set out in the Schedule of Fees ~~is are~~ changed, the corresponding ~~amounts~~ in the prescribed currencies shall be applied from the same date as the ~~amounts~~ set out in the amended Schedule of Fees.

(d) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new ~~amounts~~ in the prescribed currency according to directives given by the Assembly. The newly established ~~amounts~~ shall become applicable two months after the date of its ~~their~~ publication in the Gazette, provided that the receiving Office referred to in the second sentence of paragraph (b) and the Director General may agree on a date falling during the said two-month period, in which case the said ~~amounts~~ shall become applicable from that date.

15.3 *[Remains deleted]*

15.4 *Time Limit for Payment; Amount Payable*

(a) The international filing basic fee shall be paid within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

~~(b) The designation fee shall be paid within a time limit of:~~

~~(i) — one year from the priority date, or~~

~~(ii) — one month from the date of receipt of the international application if that one-month period expires later than one year from the priority date.~~

~~(c) Where the designation fee is paid before the expiration of one month from the date of receipt of the international application, the amount payable shall be the amount applicable on that date of receipt. Where the time limit under paragraph (b)(i) applies and the designation fee is paid before the expiration of that time limit but later than one month from the date of receipt of the international application, the amount payable shall be the amount applicable on the date of payment.~~

15.5 ~~[Deleted] *Fees Under Rule 4.9(c)*~~

~~(a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(c) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office) equal to 50% of the sum of the designation fees payable under this paragraph. Such fees shall be payable in respect of each designation so confirmed, even if the maximum number of designation fees referred to in item 2(a) of the Schedule of Fees is already payable or if a designation fee is already payable in respect of the designation under Rule 4.9(a) of the same State for a different purpose.~~

~~(b) Where moneys paid by the applicant within the time limit under Rule 4.9(b)(ii) are not sufficient to cover the fees due under paragraph (a), the receiving Office shall allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.~~

15.6 *Refund*

The receiving Office shall refund the international [filing](#) fee to the applicant:

- (i) to (iii) [No change]

[COMMENT: The proposed amendments of Rules 15. 2 to 15.6 are consequential on the proposed elimination of the designation fee, the basic fee, and the system of confirmation of precautionary designations.]

**Rule 16bis**

**Extension of Time Limits for Payment of Fees**

*16bis.1 Invitation by the Receiving Office*

(a) Where, by the time they are due under Rules 14.1(c), 15.4(a) and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the [international filing basic](#) fee and the search fee, the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

(b) ~~[Deleted] Where, by the time they are due under Rule 15.4(b), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation. The amount payable in respect of any designation fee shall be the amount applicable on the last day of the one year period from the priority date if the time limit under Rule 15.4(b)(i) applies or the amount applicable on the date of receipt of the international application if the time limit under Rule 15.4(b)(ii) applies.~~

*[Rule 16bis.1, continued]*

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) ~~or (b)~~ and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall, subject to paragraph (d):

(i) [Deleted] ~~allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions,~~

(ii) make the applicable declaration under Article 14(3), and

(iii) proceed as provided in Rule 29.

(d) Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) ~~or (b)~~ shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.4(a) ~~or (b)~~ or 16.1(f), as the case may be.

(e) Any payment received by the receiving Office before that Office makes the applicable declaration under Article 14(3) shall be considered to have been received before the expiration of the time limit referred to in paragraph (a) ~~or (b)~~.

16bis.2 *Late Payment Fee*

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) ~~or (b)~~ may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of [50%] of the international filing basic fee referred to in item 1 ~~(a)~~ of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

[COMMENT: The proposed amendments of Rule 16bis are consequential on the proposed elimination of the designation fee and the basic fee. The exact amount of the late payment fee (that is, the exact percentage of the international fee) will need to be determined in the context of fixing the amount of the international fee in item 1 of the Schedule of Fees, below (see document PCT/R/WG/2/12, paragraph 21, reproduced in paragraph 4 of the Introduction, above).]



**Rule 27**

**Lack of Payment of Fees**

27.1 *Fees*

(a) For the purposes of Article 14(3)(a), “fees prescribed under Article 3(4)(iv)” means: the transmittal fee (Rule 14), the ~~basic fee part of the~~ international [filing](#) fee (Rule 15.1~~(i)~~), the search fee (Rule 16), and, where required, the late payment fee (Rule 16*bis*.2).

(b) For the purposes of Article 14(3)(a) and (b), “the fee prescribed under Article 4(2)” means the ~~designation fee part of the~~ international [filing](#) fee (Rule 15.1~~(ii)~~) and, where required, the late payment fee (Rule 16*bis*.2).

[COMMENT: Consequential on the proposal to eliminate the need for the payment of individual designation fees (see Rule 15.1 as proposed to be amended, above).]

**Rule 29**

**International Applications ~~or Designations~~ Considered Withdrawn**

29.1 *Finding by Receiving Office*

~~(a)~~ If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iv) [No change]

~~(b) [Deleted] If the receiving Office declares under Article 14(3)(b) (failure to pay the prescribed designation fee under Rule 27.1(b)) that the designation of any given State is considered withdrawn, the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration. The International Bureau shall in turn notify each designated Office which has already been notified of its designation.~~

[COMMENT: Consequential on the proposal to eliminate the need for the payment of individual designation fees (see Rule 15.1 as proposed to be amended, above).]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

**Rule 51**

**Review by Designated Offices**

*51.1 Time Limit for Presenting the Request to Send Copies*

The time limit referred to in Article 25(1)(c) shall be two months computed from the date of the notification sent to the applicant under Rules 20.7(i), 24.2(c); [or](#) 29.1~~(a)~~(ii); ~~or 29.1(b)~~.

[COMMENT: The proposed amendment of Rule 51.1 is consequential on the proposed amendment of Rule 29.1, above.]

51.2 and 51.3 [No change]

SCHEDULE OF FEES

Fees	Amounts
1. <u>International Filing</u> <del>Basic</del> Fee: (Rule 15.2(a))	[...] <del>650</del> <u>Swiss francs plus 15 Swiss francs</u> <u>for each sheet of the international</u> <u>application in excess of 30 sheets</u>
<del>(a) if the international application</del> <del>contains not more than 30</del> <del>sheets</del>	<del>650 Swiss francs</del>
<del>(b) if the international application</del> <del>contains more than 30 sheets</del>	<del>650 Swiss francs plus 15 Swiss francs for</del> <del>each sheet in excess of 30 sheets</del>
2. <del>Designation Fee:</del> ( <del>Rule 15.2(a)</del> )	
<del>(a) for designations made under</del> <del>Rule 4.9(a)</del>	<del>140 Swiss francs per designation provided</del> <del>that any designation made under</del> <del>Rule 4.9(a) in excess of 6 shall not</del> <del>require the payment of a designation fee</del>
<del>(b) for designations made under</del> <del>Rule 4.9(b) and confirmed</del> <del>under Rule 4.9(c)*</del>	<del>140 Swiss francs per designation</del>
<del>3</del> 3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

~~3~~ 4. The international filing fee ~~total amount of the fees payable under items 1 and 2(a)~~ is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.

~~4~~ 5. All fees payable (where applicable, as reduced under item ~~3~~ 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[COMMENT: The amount of the international filing fee remains to be determined in the context of WIPO's budget. The exact amount of the late payment fee under Rule 16bis.2(b) (that is, the exact percentage of the international fee) will also need to be determined once the amount of the international fee has been fixed (see document PCT/R/WG/2/12, paragraphs 21 and 22, reproduced in paragraph 4 of the Introduction, above).]

[Annex IV follows]

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\* ~~Editor's Note: See Rule 15.5(a) for the confirmation fee, which is also payable.~~

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>1</sup>

## “COMMUNICATION ON REQUEST” SYSTEM

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

**Rule 24**

**Receipt of the Record Copy by the International Bureau**

24.1 *[Remains deleted]*

24.2 *Notification of Receipt of the Record Copy*

(a) The International Bureau shall promptly notify:

(i) to (iii) [No change]

of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the ~~States~~ designated Offices under ~~Rule 4.9(a)~~ and, in the case of a designated Office which is responsible for granting regional patents, of the Contracting States designated for such regional patent ~~where applicable, of those States whose designations have been confirmed under Rule 4.9(c).~~

[COMMENT: Rule 24.2(a) is proposed to be amended so as to bring it in line with the current practice of the International Bureau when informing the applicant about the designations made (Form PCT/IB/301).]

*[Rule 24.2, continued]*

(b) ~~[Deleted] Each designated Office which has informed the International Bureau that it wishes to receive the notification under paragraph (a) prior to the communication under Rule 47.1 shall be so notified by the International Bureau:~~

~~(i) if the designation concerned was made under Rule 4.9(a), promptly after the receipt of the record copy;~~

~~(ii) if the designation concerned was made under Rule 4.9(b), promptly after the International Bureau has been informed by the receiving Office of the confirmation of that designation.~~

[COMMENT: In line with the new concept of eliminating the need for individual designations and the replacement of the systematic communication of documents to designated Offices by a “communication on request” system (see proposed new Rule 93*bis*, below), it is proposed to delete paragraph (b).]

(c) [No change]

**Rule 47**

**Communication to Designated Offices**

47.1 *Procedure*

(a) The communication provided for in Article 20 shall be effected by the International Bureau to each designated Office in accordance with Rule 93bis.1 but, subject to Rule 47.4, not prior to the international publication of the international application.

[COMMENT: Paragraph (a) is proposed to be amended so as to clarify the operation of that Rule in view of the proposed introduction of new Rule 93bis. See also Rule 76.5 as proposed to be amended, below.]

(a-bis) The International Bureau shall notify each designated Office, at the time when ~~of~~ the communication provided for in Article 20 is effected, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. ~~Such notification shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.~~

[COMMENT: The proposed deletion of the second sentence is consequential on the proposed introduction of new Rule 93bis. Clarification only in the first sentence.]

(a-ter) [No change]



*[Rule 47.1, continued]*

(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 [provided for in Article 20](#) shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

[COMMENT: The proposed deletion of the first sentence is consequential on the proposed introduction of new Rule 93bis. Clarification only in the second sentence.]

(c) The International Bureau shall send a notice to the applicant indicating [any the](#) designated Offices to which the communication [provided for in Article 20](#) has been effected [in accordance with Rule 93bis.1](#) and the date of such communication. Such notice shall be sent on the ~~same~~ day [on which](#) as the communication [has been effected](#). ~~Each designated Office shall be informed, separately from the communication, about the sending and the date of mailing of the notice.~~ The notice shall be accepted by [all the](#) designated Offices as conclusive evidence that the communication has [been effected](#) ~~duly taken place~~ on the date specified in the notice.

[COMMENT: See Comment on paragraph (e) as proposed to be amended, below.]

(d) [No change]

[Rule 47.1, continued]

(e) Where any designated Office has not, before the expiration of the applicable time limit under Article 22, requested the International Bureau, in accordance with Rule 93bis.1, to effect the communication provided for in Article 20, the Contracting State for which that Office acts as designated Office shall be considered to have notified the International Bureau, under Rule 49.1(a-bis), that it does not require the furnishing, under Article 22, by the applicant of a copy of the international application. ~~Where any designated Office has waived the requirement provided under Article 20, the copies of the documents which otherwise would have been sent to that Office shall, at the request of that Office or the applicant, be sent to the applicant at the time of the notice referred to in paragraph (e).~~

[COMMENT: Paragraphs (c) and (e) are proposed to be amended so as to clarify the operation of those paragraphs, notably the safeguard afforded to applicants by the last sentence of present paragraph (c), under the new “communication on request” system, noting that, under proposed new Rule 93bis and Rule 89bis.3 as proposed to be amended, designated Offices can choose among the following options with regard to Article 20 communication: (i) request Article 20 communication to be effected, at the time of publication, on the basis of a “standing order” for systematic communication of pamphlets relating to all international applications in which the Office is designated; (ii) request Article 20 communication to be effected, (usually) after national phase entry, on the basis of a “particular order” for the communication of pamphlets relating to *specified* international applications in which the Office concerned is designated and which have entered the national phase before the Office; (iii) request Article 20 communication under both (i) or (ii) to be effected on paper, in electronic form or by making them available via a central data source (“intellectual property digital library” (IPDL)) from which designated Offices would be able to “pull” the pamphlets rather than have them “pushed” by the International Bureau.]

47.2 *Copies*

(a) The copies required for communication shall be prepared by the International Bureau. [Further details concerning the copies required for communication may be provided for in the Administrative Instructions.](#)

(b) ~~[Deleted] They shall be on sheets of A4 size.~~

(c) ~~[Deleted] Except to the extent that any designated Office notifies the International Bureau otherwise, copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.~~

[COMMENT: In the context of the proposed move from a “systematic communication system” to a “communication on request system” (see proposed new Rule 93*bis*, below), it is proposed to delete both paragraph (b) and (c) and to provide in the Administrative Instructions for the details concerning the way in which copies of international applications are communicated to designated Offices (on paper or in electronic form, by mail or by electronic means).]

47.3 [No change]

47.4 *Express Request Under Article 23(2)* *Prior to International Publication*

Where the applicant makes an express request to a designated Office under Article 23(2) prior to the international publication of the international application ~~before the communication provided for in Article 20 has taken place~~, the International Bureau shall, upon request of the applicant or the designated Office, promptly effect ~~the~~ that communication provided for in Article 20 to that Office.

[COMMENT: The proposed amendment of Rule 47.4 is consequential on the proposed amendment of Rule 47.1(a). See also Rule 61.2 as proposed to be amended, below.]

**Rule 61**

**Notification of the Demand and Elections**

61.1 [No change]

61.2 *Notification to the Elected Offices*

(a) [No change]

(b) [See Annex I]

(c) [No change]

(d) Where the applicant makes an express request to an elected Office under Article 40(2) prior to the international publication of the international application ~~before the communication provided for in Article 20 has taken place~~, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect the ~~that~~ communication provided for in Article 20 to that Office.

[COMMENT: The proposed amendment of Rule 61.2(d) is consequential on the proposed amendment of Rule 47.1(a). See also Rule 47.4 as proposed to be amended, above.]

61.3 and 61.4 [No change]

**Rule 73**

**Communication of the  
International Preliminary Examination Report**

73.1 [No change]

73.2 *Time Limit for Communication*

The communication provided for in Article 36(3)(a) shall be effected to each elected Office in accordance with Rule 93bis.1 ~~as promptly as possible~~ but not earlier than the communication under Article 20.

[COMMENT: The proposed amendment of Rule 73.2 is consequential on the proposed move from a system under which all documents, including copies of international preliminary examination reports, are systematically communicated to all elected Offices, to a system under which such communication would only take place upon request of the designated/elected Office concerned. See proposed new Rule 93bis, below.]

**Rule 76**

**Copy, Translation and Fee Under Article 39(1);**

**Translation of Priority Document**

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 *Application of Rules 22.1(g), [47.1\(a\) and \(e\)](#), 49 and 51bis*

Rules 22.1(g), [47.1\(a\) and \(e\)](#), 49 and 51bis shall apply, provided that:

(i) to (iii) [No change]

(iv) for the purposes of Article 39(1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report;

[\(v\) the reference in Rule 47.4 to Rule 47.1\(a\) shall be construed as a reference to Rule 61.2\(d\).](#)

[COMMENT: The proposed amendment of Rule 76.5 is consequential on the proposed amendment to Rule 47.1. Note that Rule 76.5 is proposed to be further amended in the context of Annex I (see above).]

76.6 [No change]

**Rule 89bis**

**Filing, Processing and Communication ~~Transmission~~ of International Applications and  
Other Documents in Electronic Form or by Electronic Means**

89bis.1 and 89bis.2 [No change]

89bis.3 Communication ~~Transmittal~~ *Between Offices*

Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, documents, notifications, communication,~~s or~~ correspondence or other document ~~to be transmitted~~ by one national Office or intergovernmental organization to another, such communication ~~transmittal~~ may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

[COMMENT: The title of Rule 89bis and the title and text of Rule 89bis.3 are proposed to be amended so as to align the terminology with that used in proposed new Rule 93bis, below.]



**Rule 93bis**

**Manner of Communication of Documents**

93bis.1 Communication on Request; Communication via Repository

(a) Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, notification, communication, correspondence or other document (“document”) by the International Bureau to any designated or elected Office, such communication shall be effected only upon request by the Office concerned and at the time specified by that Office. Such request may be made in relation to individually specified documents or a specified class or classes of documents.

(b) A communication under paragraph (a) shall, where so agreed by the International Bureau and the designated or elected Office concerned, be considered to be effected at the time when the International Bureau takes action to make the document available to that Office in electronic form in a digital library [or other repository] from which that Office is entitled to retrieve that document.

[COMMENT: In line with the proposed new concept of designations, it is proposed to move from the current communication system under which documents relating to international applications are systematically communicated to all designated/elected Offices to a system under which such communication would only be effected upon request of the designated/elected Office concerned. Since all Contracting States would always be (considered to be) designated in all international applications, and elected in all demands, each designated/elected Office would be flooded with a vast amount of documents related to international applications which may never enter the national phase before the Office concerned. Any Office which wishes to do so would be entitled to continue to request to receive all, or specified classes of, documents on a systematic basis. As to the words “or other repository” (presently in square brackets), see document PCT/R/WG/2/12, paragraph 25.]

[End of Annex IV and of document]