

# WIPO



PCT/R/WG/1/1

ORIGINAL: English

DATE: September 7, 2001

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT  
COOPERATION TREATY (PCT)

First Session

Geneva, November 12 to 16, 2001

THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM

*Document prepared by the International Bureau*

## BACKGROUND

1. This document is being made available provisionally, on WIPO's Internet site,<sup>1</sup> in advance of the formal convening of the session of the Working Group. It is provisional in the sense that the establishment of the Working Group, as recommended by the Committee on Reform of the PCT ("the Committee") at its first session held in May 2001, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 30th (13th ordinary) session from September 24 to October 3, 2001, held in conjunction with the 36th series of meetings of the Assemblies of the Member States of WIPO (see document PCT/A/30/2, paragraph 8):<sup>2</sup>

(i) to note the report of the first session of the Committee contained in document PCT/R/1/26 and reproduced in the Annex to document PCT/A/30/2;

---

<sup>1</sup> See WIPO's Internet site at [http://www.wipo.int/pct/en/meetings/reform\\_wg/index\\_1.htm](http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm).

<sup>2</sup> See WIPO's Internet site at [http://www.wipo.int/eng/document/govbody/wo\\_pct/index\\_30.htm](http://www.wipo.int/eng/document/govbody/wo_pct/index_30.htm).

(ii) to approve the Committee's recommendations concerning the establishment of a working group, the matters to be referred to the working group, and the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly, as set out, respectively, in paragraphs 67 and 68, 69 to 75, and 205 of the Committee's report.

2. Subject to the Assembly's approval, the session of the Working Group will be formally convened and this document will then cease to be provisional in nature.

3. In order to facilitate informal discussion prior to the session of the Working Group, the International Bureau is establishing an electronic forum on PCT reform on WIPO's Internet site.<sup>3</sup> The forum site enables comments to be submitted by e-mail and then made available on the site; registered forum participants will be informed by e-mail of any comments made available on the site.

## THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM

4. At its first session, the Committee based its discussions of the concept and operation of the designation system on document PCT/R/1/2 as well as comments and proposals made in other documents. The Committee agreed that the matter of the concept and operation of the designation system should be referred to the Working Group (see document PCT/R/1/26, paragraph 69):<sup>4</sup>

“69. Discussions were based on document PCT/R/1/2, Annex, page 3, item (1), as well as comments and proposals made in other documents. The following principles, comments and concerns were expressed by various delegations:

(i) elimination of the concept of designations (as distinct from eliminating the need for individual designations) would require a review of the concept of entry into the national phase;

(ii) changes should be consistent with the intention to eliminate the designation fee when processing in electronic form is implemented;

(iii) applicants need to be able to exclude one or more States from designation;

(iv) third parties have an interest in being able to find out with certainty the States in which the applicant in respect of an international application intends to enter the national phase or, where applicable, whether, and in which Offices, any given international application is being processed in the national phase; possibilities include the collection by a central source, such as the International Bureau, of information provided by applicants or designated Offices (see Rule 86.1(a)(vi) and documents SCIT/6/5 and SCIT/6/7, paragraphs 27 to 32); the possibility will exist of collecting

---

<sup>3</sup> The electronic forum may be accessed via the URL shown in footnote 1.

<sup>4</sup> Document PCT/R/1/2 contains proposals made by the United States of America. Many of the other documents which were before the Committee comment on those proposals or contain other proposals. The documents, as well as the Committee's report, are available on WIPO's Internet site at [http://www.wipo.int/pct/en/reform/index\\_1.htm](http://www.wipo.int/pct/en/reform/index_1.htm).

such information as a by-product of use by designated Offices of the communication on request (COR) system being developed under WIPO's IMPACT project;

(v) the means of communication of international applications to designated Offices should be reviewed, having regard to possibilities offered by modern information and communications technology (including the COR system);

(vi) appropriate provision should continue to be made for the fact that different types of protection (for example, patents and utility models) may be sought in certain States;

(vii) the system for indication of different applicants for different designated States should be examined in the light of any changes proposed;

(viii) consequential changes to the request form would be needed.”

5. At a broad level, there appear to be two options for reforming the concept and operation of the designation system:

(i) elimination altogether of the concept of designations; or

(ii) retention of the concept of designations while making the operation of the designation system more automatic and seamless.

6. With regard to the first option, it is worth noting that the designation system is one of the corner-stones of the PCT system as it was originally established and as it exists today. It is via the designation system that effect is given to some of the fundamental principles of the PCT system, as expressed, for example, in Article 11(3) (effects of the international application in each designated State), Article 23(1) (delaying of national procedure in each designated State) and Article 22(1) (entry into the national phase in each designated State):<sup>5</sup>

Article 11(3): “Subject to Article 64(4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.”

Article 23(1): “No designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22.”

Article 22(1): “The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a

---

<sup>5</sup> References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO's Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc.

translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 20 months from the priority date. ...”

7. In view of the fact that those (and other) fundamental principles of the PCT system are directly linked to the concept of “designation” of Contracting States, it is clear that elimination altogether of that concept (as distinct from reviewing and changing the operation of the current designation system) would require a thorough review of the overall structure of the PCT system and would bring about a much bigger change to the character of the PCT system as a whole than can be achieved in this first stage of PCT reform. The idea should be revisited, of course, when a possible future revision of the Treaty itself is being discussed.

8. Consequently, in the Annex to this document, rather than proposing to eliminate altogether the concept of designations, the International Bureau makes specific proposals for reform of the operation of the designation system, with the aim of making that system more automatic and seamless and of bringing it into line with the way in which most applicants and designated Offices today perceive and use it.

9. The present practice of a large proportion of applicants is to designate all Contracting States (this is true of 76% of the international applications that have reached the International Bureau in the first seven months of 2001), suggesting that applicants today perceive and use the PCT system as a strategic tool to obtain an option for protection in all PCT Contracting States, specific choices being deferred until the time of national phase entry. Most designated Offices have adapted their national procedures accordingly, exemplified by the fact that most have moved from requiring the systematic sending, during the international phase, of documents relating to all international applications in which the Office is designated. Instead, most designated Offices now rely on a “communication on request” system under which they receive such documents from the International Bureau only upon specific request relating to those international applications which have entered the national phase before the Office concerned. Third parties also now attach much greater importance to the question whether or not national phase entry has taken place in a particular designated State than to the fact that a particular State has been designated.

10. In short, today, the emphasis for applicants, designated Offices and third parties is generally more on the practical significance of entry into the national phase than on the legal effect of the application during the international phase (although this in no way diminishes the importance of the fundamental principle established by Article 11(3)), and there appears to be a need to adapt the PCT system accordingly.

11. To do so, proposals for reform of the operation of the designation system are outlined in the Annex to this document; the main general features of those proposals are the following:

(i) by filing an international application, the applicant obtains 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;

(ii) the ability to specify certain kinds of protection sought in particular designated States is deferred until entry into the national phase in the States concerned; if no such specification is made, the international application is to be treated as an application for the grant of a patent (only);

(iii) the concept of designation fees payable in addition to the basic fee is eliminated; instead, a flat “international filing fee” is introduced, irrespective of the number of designations made;

(iv) the same concept as for designations is applied to elections under Chapter II: all eligible States are considered to have been elected, and the concept of “later elections” is eliminated;

(v) the present system of “systematic communication” to designated Offices of all documents relating to a particular international application is replaced by a “communication on request” system under which only documents relating to an international application which has entered the national phase before a particular designated Office are communicated to that Office.

12. As a consequence of the proposed change in the fee structure, a new international filing fee will have to be fixed. The amount of such fee will have to be determined taking into consideration the requested level of the budget resources of WIPO at that time and any related budgetary implications.

13. All proposals for reform of the designation system contained in the Annex to this document are capable of implementation in the short or medium term by amending the Regulations, preparing the way for a subsequent revision of the Articles of the Treaty itself, and recognizing that such a future revision needs to be borne in mind when making present amendments.

*14. The Working Group is invited to consider the proposals contained in the Annex to this document.*

[Annex follows]

## ANNEX

PROPOSED AMENDMENTS OF THE REGULATIONS<sup>1</sup>**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, it is proposed to delete item (iv) from the list of mandatory content of the request. The proposed new wording of Rules 4.9(a) (see below) is necessary to ensure compliance with the requirements of Article 4(1)(ii), first sentence, that the request shall contain "... the designation of ... Contracting States ..." and of Article 11(1)(iii)(b) that the international application must contain "... the designation of at least one Contracting State."]

(iv)~~(v)~~ 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.

---

<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

*[Rule 4.1, continued]*

(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,~~

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

[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, below), 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 items (iii) to (v) from the list of mandatory contents (where applicable) of the request. See also proposed new Rule 49*bis*, below.]

~~(iii)~~<sup>(v)</sup> 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 request shall be considered to contain:

(i) an indication that all designations which are permitted under the Treaty are made;

(ii) an indication that the international application is to be treated, in each designated State in respect of which Article 43 or 44 applies, as an application 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 to be treated, in each designated State in respect of which Article 45 applies, as an application for the grant of both a regional patent and, unless Article 45(2) applies, a national patent.

~~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]

[COMMENT: Rule 4.9(a) as proposed to be amended lies at the heart of the new concept of how and when Contracting States are designated, and how and when to specify which kinds of protection are sought and whether national and/or regional patents are sought in any given designated State. Under the new concept, the applicant would obtain, when filing an international application, an automatic and all-inclusive coverage covering all possible designations, all possible kinds of protection, and all available national and regional patents, without the need to specify details or choices at the time of filing. This would then satisfy, for example, the requirements of Article 11(1)(iii)(b) and Rule 20.4 in relation to the according of a filing date. Rather, the applicant would be required to do so only later, upon national phase entry (see proposed new Rule 49*bis*). In order not to water down this new concept of an automatic and all-inclusive coverage, Rule 4.9(a) does not provide for the possibility of making exclusions relating to designations of particular States, particular kinds of protection or national or regional patents, and Rule 90*bis* as proposed to be amended no longer provides for the possibility of withdrawing individual designations. One consequence would be that all international applications would automatically include the designation of “US,” resulting in the need for any inventor indicated as applicant for the US only to sign the request for each and every application. To avoid this burden for applicants, it is also proposed to amend Rule 4.15(b) (see below) with the result that such an applicant/inventor would in general need to provide a signature only if and when the application enters the national phase in the US.]

(b) The national law applicable by a designated Office shall not require that any express indication referred to in Article 43, 44 or 45 be made prior to the time of performing the acts referred to in Article 22(1). ~~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]

~~(c) 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: The aim of paragraph (b) as proposed to be amended is to ensure that the applicant can indeed rely on the new concept of obtaining an automatic and all-inclusive coverage with regard to all possible kinds of protection without the risk of violating the national law applicable in any designated Office. Furthermore, in line with the 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), which are thus proposed to be deleted.]

4.10 and 4.11 [No change]

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: In line with the proposed new concept of obtaining an automatic and all-inclusive coverage with regard to all possible kinds of protection and deferring the need to choose a certain kind of protection (if so wished) until the time of national phase entry (see proposed new Rule 49*bis*, below), Rules 4.12 to 4.14 are proposed to be deleted.]

4.14bis [No change]

4.15 *Signature*

(a) [No change]

(b) The request need not be signed by any applicant who is indicated as applicant in respect only of a State whose national law requires that national applications be filed by the inventor, provided that it is signed by at least one applicant. ~~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 refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.~~

[COMMENT: As indicated in the Comment to Rule 4.9(a), due to the fact that, under the new concept of designations, all designations permitted under the Treaty are always considered to have been made, all international applications would always include the designation of “US”, resulting in the need for any applicant/inventor for the US to sign the request. To avoid this great additional burden for applicants, it is proposed to amend Rule 4.15(b) so as to ensure that a signature by any applicant/inventor who is applicant for the US only is not needed upon filing of the international application, provided that the request is signed by at least one (other) applicant. An applicant/inventor would, of course, have to sign any declaration of inventorship included in the request under Rule 4.17(iv) or added under Rule 26ter. If such a declaration is not furnished during the national phase, an oath or declaration of inventorship, signed by the inventor, in accordance with Article 27 and Rule 51bis.1(a)(iv), would have to be furnished direct to the USPTO as designated Office, either upon national phase entry or upon invitation thereafter (see Rule 51bis.3).]

4.16 to 4.18 [No change]

## 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 these~~ 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 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.~~

[COMMENT: Proposed amendments of Rules 15. 2 to 15.5 are consequential on the proposed elimination of the designation fee, the basic fee, and the system of confirmation of precautionary designations.]

15.6 [No change]



**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.

[COMMENT: Proposed amendments of Rule 16bis are consequential on the proposed elimination of the designation fee and the basic fee.]

## 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(e).~~

[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/308).]

*[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 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~~(i)~~) 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).]

## 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) 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).]

#### 29.2 *[Remains deleted]*

29.3 and 29.4 [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) and (b) [No change]

(c) In respect of any international application whose filing date falls within the applicable period under paragraph (b), the International Bureau shall send the applicant a notification informing him that he may [file a request for extension with the International Bureau within three months from the date of that notification.](#) ~~make a request for extension by performing, within three months from the date of that notification, the following acts:~~

~~(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: Consequential on the proposal to eliminate the need for the payment of individual designation fees (see Rule 15.1 as proposed to be amended). In this context, it is also proposed to eliminate the “extension fee” for the benefit of the International Bureau.]

(d) [No change]

32.2 [No change]



## Rule 47

### Communication to Designated Offices

#### 47.1 Procedure

(a) [No change]

(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.~~

(a-*ter*) [No change]

(b) The ~~Such~~ communication provided for in Article 20 shall be effected upon request by the designated Office but, subject to Rule 47.4, not prior to ~~promptly after~~ the international publication of the international application ~~and, in any event, by the end of the 19th month after the priority date~~. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

[Rule 47.1, continued]

(c) The International Bureau shall send a notice to the applicant indicating the designated Offices to which the communication has been effected and the date of such communication. Such notice shall be sent on the same day as the communication. ~~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 designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice.

(d) [No change]

(e) No designated Office shall require the applicant to furnish a copy of the international application under Article 22(1) unless it has requested the International Bureau, under paragraph (b), to effect the communication provided for in Article 20 and has been informed by that Bureau that the international application is not in its files. ~~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: Proposed amendments to Rule 47.1 are consequential on the proposed move from a system under which all documents, including copies of international applications, are systematically communicated to all designated Offices, to a system under which such communication would only take place upon request of the designated Office concerned. See proposed new Rule 93*bis*, below.]

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 and 47.4 [No change]

**Rule 48**

48.1 [No change]

48.2 *Contents*

(a) [No change]

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

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

[COMMENT: In line with the proposed new concept of eliminating the need for individual designations, the Administrative Instructions could 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 would be 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.]

(ii) to (iv) [No change]

(c) to (i) [No change]

48.3 to 48.5 [No change]

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: Proposed amendment of paragraph (a) is consequential on the proposed amendment of Rule 29.1 (see above).]

(b) *[Remains deleted]*

(c) If the international application, ~~the designation of any designated State~~ or the priority claim is withdrawn under Rule 90*bis* after the technical preparations for international publication have been completed, notice of the withdrawal shall be published in the Gazette.

[COMMENT: Proposed amendment of paragraph (c) is consequential on the proposal to eliminate the need for individual designations and the possibility to withdraw individual designations (see Rule 90*bis* as proposed to be amended, below).]

**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 any 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 shall so indicate at the time of performing the acts referred to in Article 22(1).

(b) If the applicant wishes the international application to be treated, in any 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 shall so indicate at the time of performing the acts referred to in Article 22(1) and shall also 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 any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, the applicant 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.

*[Rule 49bis.1, continued]*

[COMMENT: See comment to Rule 4.9(a)(ii), above. Under the new concept, the applicant would obtain, when filing an international application, an automatic and all-inclusive coverage with regard to all kind(s) 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. Instead, under proposed new Rule 49bis, the applicant would be required to do so only upon entry into the national phase before the designated Office concerned. Of course, if the applicant does not make any choice of kind of protection, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)).]

49bis.2 Continuation or Continuation-in-Part

If the applicant wishes the international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, the applicant shall so indicate at the time of performing the acts referred to in Article 22(1) and shall identify the parent application involved.

[COMMENT: Same approach as the one proposed under new Rule 49bis.1; see Comment on that Rule, above.]

49bis.3 Failure to Furnish Indication or Identification

Where the applicant fails to furnish any indication or identification referred to in Rules 49bis.1 and 49bis.2 within the same period within which the requirements under Article 22(1) must be complied with, the applicant shall have an opportunity to furnish any such indication or identification after the expiration of that period within a time limit which shall be reasonable under the circumstances and shall, in no case, be less than two months.

*[Rule 49bis.3, continued]*

[COMMENT: New Rule 49bis.3 is proposed to be added so as to give the applicant who has not, upon entry into the national phase, complied with the requirement to make the choice of the kind(s) of protection sought, and/or to identify the parent application or grant, another opportunity to do so within two months after he has validly entered the national phase. The national law may, of course, provide for longer time limits to comply with the requirement to make the choice of the kind(s) of protection sought. Where the applicant, after the expiration of the applicable time limit, still has not made any choice, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)); furthermore, 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, apply.]



## 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), 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 (see above).]

51.2 and 51.3 [No change]

## Rule 53

### The Demand

53.1 to 53.6 [No change]

#### 53.7 *Election of States*

~~(a)~~ The demand shall be considered to contain an indication that all ~~indicate at least one~~ Contracting States ~~from among those States~~ which are designated and are bound by Chapter II of the Treaty are elected (~~“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.”]

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. Notwithstanding the wording of Article 31(4), second sentence (“Additional Contracting States may be elected later”), in view of the proposed new concept of elections (see Rule 53.7 as proposed to be amended, above), there appears to be no need to maintain, in the Regulations, a formal procedure for making “later elections”.]

**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 upon request by the elected Office ~~as promptly as possible~~ but not earlier than the communication under Article 20.

[COMMENT: Proposed amendments to Rule 73.2 are 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 93*bis*, 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\(e\)](#), 49 and 51bis*

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

(i) to (iv) [No change]

[COMMENT: Proposed amendment to Rule 76.5 is consequential on the proposed amendment to Rule 47.1.]

76.6 [No change]

**Rule 90bis**

**Withdrawals**

90bis.1 [No change]

90bis.2 [[Deleted](#)] *Withdrawal of Designations*

~~(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies in respect of that State, prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90bis.4.~~

~~(b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.~~

~~(c) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90bis.1.~~

~~(d) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.~~



*[Rule 90bis.2, continued]*

~~(e) No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.~~

90bis.3 [No change]

90bis.4 *Withdrawal of the Demand, ~~or of Elections~~*

(a) The applicant may withdraw the demand ~~or any or all elections~~ at any time prior to the expiration of 30 months from the priority date.

(b) and (c) [No change]

90bis.5 [No change]

90bis.6 *Effect of Withdrawal*

(a) Withdrawal under Rule 90bis of the international application, ~~any designation~~, any priority claim, ~~or~~ the demand ~~or any election~~ shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).

*[Rule 90bis.6 continued]*

(b) [No change]

(c) Where the demand ~~or all elections~~ are withdrawn under Rule 90bis.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

90bis.7 [No change]

[COMMENT: In line with the proposed new concept of eliminating the need for individual designations and elections, there appears to be no need to allow for the withdrawal of individual designations and elections. It is thus proposed to amend Rule 90bis accordingly.]

**Rule 93bis**

**Communication, Notification and Transmittal on Request**

93bis.1 Communication, Notification and Transmittal on Request

Where the Treaty, these Regulations or the Administrative Instructions provide for documents, notifications, communications or correspondence to be communicated, notified or transmitted by the International Bureau to any designated or elected Office, such communication, notification or transmittal shall be effected only upon request by the Office.

[COMMENT: In line with the proposed new concept of designations, it is proposed to move from the current communication system under which all documents, including copies of international applications and international preliminary examination reports, 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. Without such new approach as to communication, since all Contracting States would always be (considered to be) designated in all international applications, and elected in each demand, 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. Consideration should also be given to whether it would be appropriate to extend Rule 93bis to cover communications, etc, with International Searching Authorities and International Preliminary Examining Authorities.]

## SCHEDULE OF FEES

Fees	Amounts
1. <u>International Filing</u> <del>Basic</del> Fee: (Rule 15.2(a))	[...] <u>650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets</u>
<del>(a) if the international application contains not more than 30 sheets</del>	<del>650 Swiss francs</del>
<del>(b) if the international application contains more than 30 sheets</del>	<del>650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets</del>
2. <del>Designation Fee:</del> (Rule 15.2(a))	
<del>(a) for designations made under Rule 4.9(a)</del>	<del>140 Swiss francs per designation provided that any designation made under Rule 4.9(a) in excess of 6 shall not require the payment of a designation fee</del>
<del>(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)*</del>	<del>140 Swiss francs per designation</del>
<u>3</u> 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 (see paragraph 12 in the main body of this document).]

[End of Annex and of document]

---

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