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PROPOSED AMENDMENT OF RULES 29.1, 48.2(c) AND 90*bis*.1

Document prepared by the Secretariat

1. The Annex to this document contains proposals to amend Rules 29.1, 48.2(c) and 90*bis*.1. Explanations are set out in the Annex in Comments relating to the provisions concerned.

2. *The Working Group is invited to consider the proposals contained in the Annex.*

[Annex follows]

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ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

PROPOSED AMENDMENT OF RULES 29.1, 48.2(c) and 90bis.1

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¹ 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Rule 29**International Applications Considered Withdrawn***29.1 Finding by Receiving Office*

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) or 12.4(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under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn: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) [No change] the receiving Office shall transmit the record copy (unless already transmitted), and any correction offered by the applicant, to the International Bureau;

(ii) [No change] the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall in turn notify each designated Office which has already been notified of its designation;

(iii) [No change] the receiving Office shall not transmit the search copy as provided in Rule 23, or, if such copy has already been transmitted, it shall notify the International Searching Authority of the said declaration;

(iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy;

[Rule 29.1, continued]

(v) no international publication of the international application shall be effected if the notification of the said declaration transmitted by the receiving Office reaches the International Bureau before the technical preparations for international publication have been completed.

[COMMENT: In the past, there have been a substantial number of cases where applicants, rather than expressly withdrawing the international application under Rule 90*bis*.1 prior to publication, relied on Rule 29.1 to have the international application “considered withdrawn” by the receiving Office for failure to pay the required fees, disregarding the substantial risk that, where the declaration by the receiving Office that the application is considered withdrawn reaches the International Bureau only after completion of technical preparations for international publication, the international application will be published, despite the fact that it is considered withdrawn. It is proposed to amend Rule 29.1, along the lines of Rule 90*bis*.1(c) (applicable in the case of an express withdrawal of the international application), to highlight this risk and to remind applicants that international publication can only be reliably prevented by way of an express withdrawal under Rule 90*bis*.1 received by the International Bureau prior to completion of technical preparations for international publication.]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

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

(i) [No change]

(ii) [No change] a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies;

(iii) [No change] the abstract; if the abstract is both in English and in another language, the English text shall appear first;

(iv) to (viii) [No change]

(c) Where a declaration under Article 17(2)(a) has issued, the front page shall ~~conspicuously~~ refer to that fact and ~~need~~ include any figure or figures suggested by the applicant under Rule 3.3(a)(iii) neither a drawing and, if contained in the international application, the ~~nor an~~ abstract.

[COMMENT: Where the International Searching Authority has declared, under Article 17(2)(a), that no international search report will be established (for one of the reasons outlined in Article 17(2)(a)(i) or (ii)), practice of the International Bureau so far has been, in accordance with present Rule 48.2(c), not to include, on the front page of the published international application, any drawing or the abstract. So as to facilitate access to the technical information contained in such a published international application, it is proposed to change the current practice and to include any figure or figures suggested by the applicant under Rule 3.3(a)(iii) and the abstract (if contained in the international application) on the front page of such international application.]

[Rule 48.2, continued]

(d) to (k) [No change]

48.3 to 48.6 [No change]

Rule 90bis

Withdrawals

90bis.1 Withdrawal of the International Application

(a) [No change] The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.

(b) 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.~~

(c) No international publication of the international application 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.

[COMMENT: In the past, there have been a substantial number of cases where applicants, wishing (often at the “last minute”) to withdraw their international application prior to international publication and with the clear intention to prevent publication, relied on Rule 90bis.1(b) and addressed the notice of withdrawal of the international application to the receiving Office (instead of the International Bureau). In such a case, international publication is only prevented if the notice of withdrawal transmitted by the receiving Office to the International Bureau is received by that Bureau before the technical preparations for international publication have been completed (see Rule 90bis.1(c)). If received after completion of those technical preparations, the international application is published by the International Bureau, despite the fact that it has been validly withdrawn by the applicant. In other words, in particular in cases of “last minute” withdrawals, applicants run a considerable risk that such withdrawals addressed to the receiving Office, although effective, will not prevent international publication of the application concerned. Against this background, the Working Group may wish to consider whether Rule 90bis.1 should be amended so as to require the applicant to address a notice of withdrawal of the international application to the International Bureau only and to no longer allow the applicant to address such notice, at the

[Rule 90bis.1, continued]

applicant's option, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority. While such an amendment would most likely not result in all withdrawals of applications being received by the International Bureau in time to prevent international publication, it may increase, over time, the applicants' awareness of the issue and thus result in fewer international applications being published despite the fact that they had been withdrawn by the applicant.]

90bis.2 to 90bis.7 [No change]

[End of Annex and of document]