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The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith ./ documents PCT/R/WG/6/1, 2, 3 and 6, prepared for the sixth session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva from May 3 to 7, 2004.

The working documents are also available on WIPO's Web site (see <http://www.wipo.int/pct/en/meetings>).

March 12, 2004

Enclosures: documents PCT/R/WG/6/1, 2, 3 and 6

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

## INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

**Sixth Session**  
**Geneva, May 3 to 7, 2004**

#### RESTORATION OF THE RIGHT OF PRIORITY

*Document prepared by the International Bureau*

#### INTRODUCTION

1. The Committee on Reform of the PCT (“the Committee”), at its first and second sessions, and the Working Group, at its first, second, third, fourth and fifth sessions, considered proposals for amendment of the Regulations under the PCT<sup>1</sup> relating to the restoration of the right of priority. The reports of the sessions of the Committee and the summaries by the Chair of the sessions of the Working Group set out the status of the matters discussed by the Committee and the Working Group, respectively, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken (see documents PCT/R/1/26, paragraphs 72 to 76; PCT/R/2/9, paragraphs 111 to 123 and 125; PCT/R/WG/1/9, paragraphs 22 and 23; PCT/R/WG/2/12, paragraphs 54 to 56; PCT/R/WG/3/5, paragraphs 13 to 27; PCT/R/WG/4/14, paragraphs 35 to 44; PCT/R/WG/5/13, paragraphs 28 to 62).

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<sup>1</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. 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.

2. The Working Group's discussions at its last (fifth) session (see document PCT/R/WG/5/13, paragraphs 28 to 62) are outlined in the following paragraphs:

“28. Discussions were based on document PCT/R/WG/5/7.

“29. Many delegations and representatives of users welcomed the general approach taken in the document, noting that it would further align the provisions of the PCT with those of the PLT. Certain delegations emphasized the need to ensure that the reservation provision in respect of the effect in the national phase for their countries was adequate. While some delegations stated that they would have preferred a simpler approach whereby the same criterion for restoration of the priority right was applied by all Offices, it was recognized that agreement on a single criterion was not achievable at the present time and that the proposed approach was thus a good compromise. Several delegations and representatives of users expressed the hope that a clearer form of drafting could be found to make the numerous possibilities involved easier to understand.

“30. One user representative hoped that a way could be found, possibly by filing with the receiving Office of the International Bureau, to afford applicants the choice of having either the “due care” criterion or the “unintentionality” criterion applied during the international phase. Two delegations confirmed that their national Offices provided such a choice under national law and that they also intended to do so in their capacity as PCT receiving Offices.

“31. Several delegations expressed concern that inclusion of provisions relating to the restoration of the right of priority may conflict with Articles 8(2)(a) and 2(xi) which related the terms “priority claim” and “priority date” to Article 4 of the Paris Convention, which provided for a priority period of 12 months with no provision for restoration where that period was exceeded. Two delegations felt that the introduction of a restoration provision under the PCT would represent such a fundamental change to the system that it ought to be addressed in the Articles of the Treaty itself rather than in the Regulations.

“32. The Working Group noted that Rule 4.10 already allowed applicants to claim the priority, in international applications, of earlier applications filed in countries which were not members of the Paris Convention but were members of the World Trade Organization (WTO). Rule 4.10(d) provided the possibility for transitional reservations as to the application of the provision concerned in order to allow Contracting States as designated States to adapt their national laws in order to conform to the provision when it had been adopted by the Assembly. A similar approach could be provided in relation to the changes now under consideration. One delegation expressed its concern that, if a significant number of States were to take advantage of such a transitional reservation provision, the changes would lose much of their effectiveness. Other delegations requested the inclusion of a further transitional reservation provision for receiving Offices whose applicable national law was not compatible with the proposed amendments.

“33. One delegation suggested that the term “priority period” should be defined for the purposes of the proposed amendments. It was noted that the same term was used in the PLT and that it derived directly from the Paris Convention.

“34. The Working Group noted that, under the proposals, the claimed priority date would be used throughout the international phase for the purpose of calculating time limits (for example, those for international publication and national phase entry), even if restoration of the right of priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office, provided that the international application was filed within two months from the date on which the priority period expired. The Working Group also noted that such retention of a priority claim did not affect the question of relevant prior art for the purposes of the international search under Rule 33, since the relevant date for the purposes of the international search was in any case the international filing date. It was agreed, however, that Rule 33.1(c) should be reviewed with a view to specifically drawing attention, in the international search report, to written disclosures published within 12 to 14 months prior to the international filing date.

“35. The Working Group agreed to refer the question of relevant prior art for the purposes of the written opinion of the International Searching Authority (Rule 43*bis*.1) and the international preliminary examination (Rule 64) to the Meeting of International Authorities under the PCT for consideration via its electronic forum, with a view to the development of a proposal for submission to the next session of the Working Group. It was noted that item (ii) of Rule 64.1(b), relating to cases where the international application “validly” claimed the priority of an earlier application might need to be reviewed in the light of the proposed amendments.

“36. One user representative pointed out that the term of a patent was calculated, in most jurisdictions, from the international filing date, and that allowing priority to be claimed up to 14 months from the filing date of an earlier application would, in effect, enable an extension of term of up to two months. The representative accordingly suggested that restoration be subject to a disclaimer by the applicant of such an extension of term.

“37. In response to a suggestion by one delegation that the terminology be changed to refer to the “restoration of the right to claim priority” rather than “restoration of the right of priority,” the Secretariat recalled that this matter had been discussed extensively at previous sessions of the Working Group and that use of the term “right of priority” had been agreed, noting that it was used in the PLT.

“38. The Working Group agreed that the approach taken in the proposals should be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the matters noted above and the comments and suggestions as to particular provisions noted in the following paragraphs.

#### *Rule 4.10*

“39. The Secretariat explained that the proposal to delete the words “, being a date falling within the period of 12 months preceding the international filing date” in Rule 4.10(a)(i) was intended to reflect the distinction between an invitation to correct a defect in a priority claim and an invitation to request restoration of a right of priority.

However, on further reflection, it was apparent that this proposal would need to be reconsidered in order to ensure that an applicant could be invited to correct a priority claim which erroneously indicated a filing date of the earlier application being later than the international filing date.

*Rule 26bis.2*

“40. One delegation suggested that it would be more appropriate to “notify” the applicant of the possibility of requesting the restoration of the right of priority than to “invite” the applicant to submit a request for such restoration.

“41. One delegation pointed out that no invitation to submit a request for restoration of the right of priority should be needed where the applicant had already submitted such a request or if the time limit for making such a request had expired.

“42. The Working Group agreed that the time limit under Rule 26bis.2(a) should be 14 months from the priority date (or two months from the date on which the priority period expired; see paragraph 45, below) or one month from the date of the invitation, whichever expired later.

“43. One delegation stated that the use of the term “canceled” was not appropriate in Rule 26bis.2(b) to (d).

“44. Several delegations were of the opinion that information concerning a priority claim that has been canceled should be published in all cases under Rule 26bis.2(d), and not only upon request made by the applicant.

*Rule 26bis.3*

“45. There was no support for the suggestion made by one delegation that the period for submitting a request for restoration of a right of priority under Rule 26bis.3(a) should, consistently with the time limit for correcting a priority claim under Rule 26bis.2(b), be increased to 16 months from the priority date. However, it was agreed that the way in which the time limit was expressed in item (i) of Rule 26bis.3(a) (“14 months from the date on which the earlier application was filed”) and in the chapeau of that Rule (“two months from [the date on which the priority period expired]”) should be made consistent, in particular taking into account the possibility that the last day of the priority period might fall on an official holiday or a non-working day.

“46. Several delegations and a representative of users suggested that the International Bureau should review decisions under Rule 26bis.3(a)(iii) with a view to establishing a quality standard applicable to all receiving Offices. They also suggested that, in order to promote uniform standards, the terms “due care” and “unintentional” as used in that Rule should be defined or at least explained in the Regulations or guidelines. The Working Group agreed that the Secretariat should consider this matter further.

“47. Several delegations and representatives of users supported a suggestion by one delegation that, in order to promote consistency of standards, copies of key decisions of Offices concerning requests for restoration based on the “due care” and “unintentionality” criteria should be made available in a central depository for

consultation by Offices, applicants and third parties. One delegation proposed that the said central depository could be supplemented by relevant national legal provisions on the criteria used. The Secretariat agreed that such a facility could be made available on WIPO's Website.

“48. There was no support for the suggestion of one representative of users that the Rules should prescribe a maximum fee for a request for restoration of the right of priority. The Working Group noted that, under Rule 26bis.3(c), an Office which provided for restoration on both the criterion of “unintentionality” and the criterion of “due care” would be free to charge different fees in respect of the two cases.

“49. With regard to the possibility for the receiving Office to require that a declaration or other evidence in support of the statement of reasons be furnished under Rule 26bis.3(d), one delegation favored restoration of the right of priority on the basis of a simple statement by the applicant that the failure to comply with the priority period was unintentional. The delegation suggested that such a statement should also be sufficient for restoration on the “unintentionality” criterion under the PCT procedure and that this be made clear, for example, in the Administrative Instructions. Several delegations indicated that under their legislation a formal declaration and possibly the furnishing of evidence would be required rather than a simple statement, while other delegations observed that they had as yet no practice in this area. After some discussion, it was agreed that the question of what information or evidence each receiving Office was entitled to require in support of a request for restoration of the right of priority should be left to national law and practice.

“50. One delegation suggested that Rule 26bis.3(d) should be worded so as to encourage applicants to file evidence required under Rule 26bis.3(a)(ii) as soon as possible, preferably together with the filing of the application. In addition, the receiving Office should be permitted to combine the giving of an opportunity to make observations on an intended refusal provided for in Rule 26bis.3(e) with an invitation to file evidence under Rule 26bis.3(d).

“51. In reply to a question by a representative of users, the Secretariat confirmed that, under Rule 26bis.3(g), information on the criterion or criteria applied by each Contracting State would be published in the PCT Gazette as well as in the PCT Applicant's Guide and the PCT Newsletter.

#### *Rule 49ter.1*

“52. A suggestion by one delegation and a representative of users that Rule 49ter.1(c) should be deleted to ensure that a restoration of the right of priority by a receiving Office could not be reversed in the national phase was opposed by another delegation. In reply to a query by a representative of users, the International Bureau explained that the reference to “reasonable doubts” was modeled on terminology used in the PLT.

“53. One representative of users suggested that the word “only” should be added before the words “if it has reasonable doubts” in Rule 49ter.1(c). The representative also suggested that wording similar to that used in Rule 51bis.2(b) be considered.

“54. One delegation observed that Rule 49ter.1(c) was directed only to designated Offices whereas other provisions of Rule 49ter were directed, more generally, to designated States. The Secretariat suggested that the wording used throughout Rule 49ter should be reviewed for consistency and to ensure that it was clear what principles would need to be applied under the national law in general.

“55. The Working Group agreed that a designated Office should not be permitted under Rule 49ter.1(c) to review a decision of the receiving Office to restore a right of priority merely because the information or evidence required by that receiving Office was not the same kind of information or evidence as that required by the designated Office under its national law. Instead, a review under that Rule should only be possible where the designated Office had reasonable doubts as to whether the decision of the receiving Office to restore the right of priority based on that information or evidence was correct. The Secretariat noted that the use of the term “reasonable doubts” in this context was modeled on wording used in the PLT.

#### *Rule 49ter.2*

“56. One delegation suggested that a request for restoration of the right of priority which has been refused by the receiving Office under Rule 26bis should automatically be considered to be pending before each designated Office.

“57. One delegation suggested that Rule 49ter.2(b) should be worded so as to encourage applicants to file evidence required under Rule 49ter.2(b)(ii) as soon as possible, preferably together with the filing of the application. In addition, the designated Office should be permitted to combine the giving of an opportunity to make observations on an intended refusal provided for in Rule 49ter.2(c) with an invitation to file evidence under Rule 49ter.2(b)(ii).

“58. One delegation stated that, for consistency with Article 27(4), the word “shall” should be replaced by “may” in Rule 49ter.2(d).

“59. One delegation suggested that consideration should be given as to whether the term “that provision,” which referred to any of the provisions of paragraph (a), was appropriate in Rule 49ter.2(f), having regard to other provisions of Rule 49ter.2, for example, paragraph (e).

“60. There was no support for the suggestion made by one delegation that the time limit under Rule 49ter.2(a)(i) should be the applicable time limit under Article 22 instead of one month from that applicable time limit.

“61. One representative of users pointed out that a Contracting State which did not provide for restoration of the right of priority in respect of national applications could nevertheless provide for such restoration in respect of international applications in accordance with Rule 49ter.2, in which case it would not need to make a reservation under paragraph (f) of that Rule.

“62. In reply to a question by a delegation, the Secretariat confirmed that it was implicit in Rule 49ter.2(a) that the right of priority might be restored by one designated Office but not by others. The International Bureau observed that it was already inherent

from the territorial nature of patents, and the differences in national patent laws, that the scope and validity of a patent granted on a particular international application would not necessarily be the same in all Contracting States.”

3. As invited by the Working Group, revised proposals relating to the restoration of the right of priority, taking account of the suggestions made by delegations and representatives of users at the fifth session (see document PCT/R/WG/5/13, paragraphs 28 to 62, reproduced in paragraph 2, above) were prepared by the International Bureau accordingly and made available, in the form of a preliminary draft document, for comment by the Working Group and the International Authorities via the PCT reform electronic forum and the MIA (Meeting of International Authorities) electronic form, respectively. The further revised proposals contained in Annex I to this document take into account the comments received on the preliminary draft. Article 13 and Rule 14 of the PLT are reproduced, for ease of reference, in Annex II.

4. The main features of the draft proposals remain as outlined in document PCT/R/WG/5/7, as represented in the flowchart appearing on page 8, below, are outlined in the following paragraphs.

#### RETENTION OF PRIORITY CLAIM; RESTORATION OF RIGHT OF PRIORITY

##### *Automatic Retention of Priority Claim During International Phase*

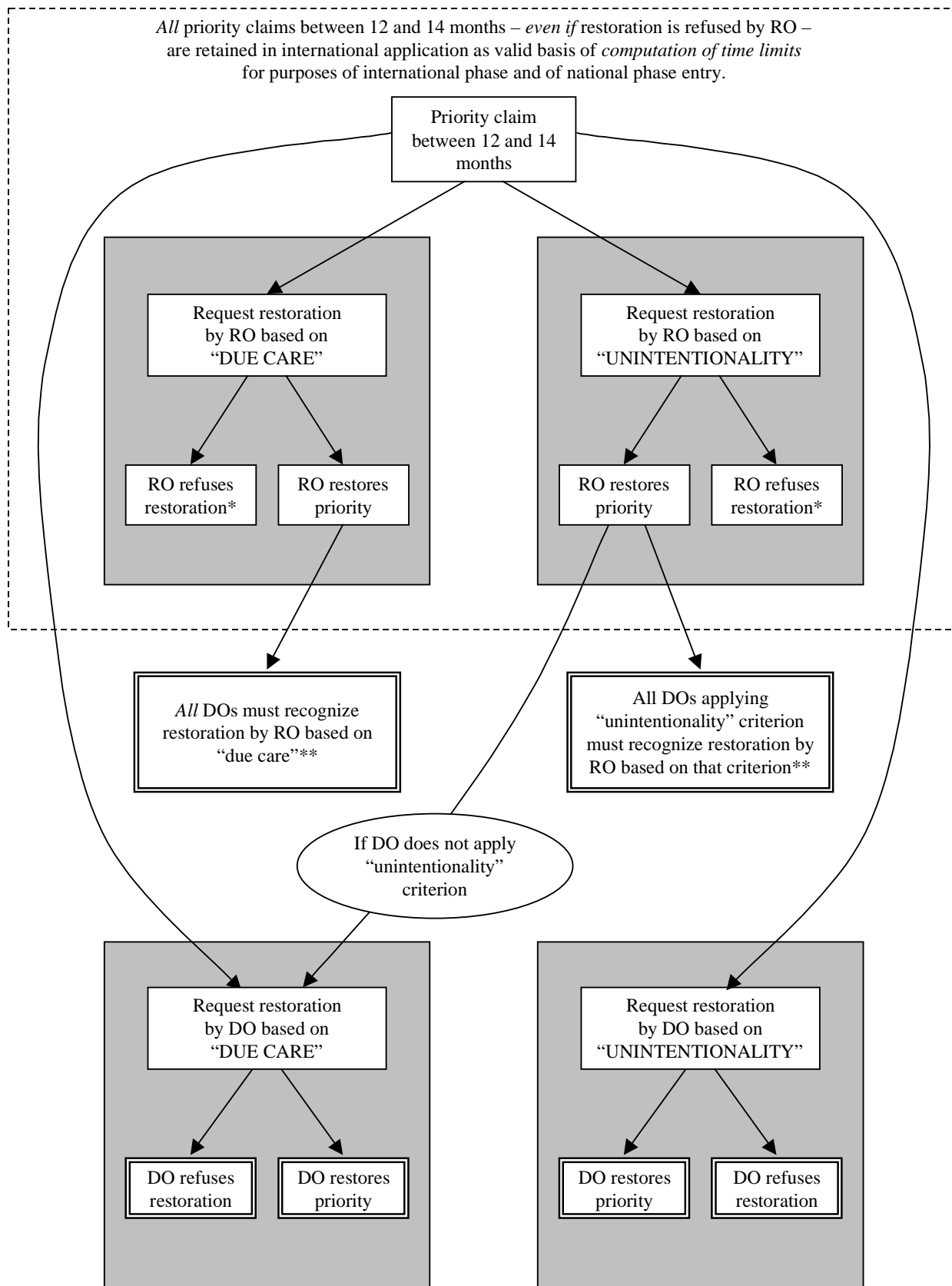
5. It is proposed to provide for the automatic retention, during the international phase, of a priority claim where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. Such a priority claim would be retained irrespective of whether the applicant requests the receiving Office to restore the right of priority and even where such a request is made but refused by the receiving Office. Such a priority claim would therefore be taken into account during the international phase for the purposes of international search and international preliminary examination, and for the computation of time limits, including that for entry into the national phase.

##### *Restoration of the Right of Priority by the Receiving Office during the International Phase*

6. The applicant would have the possibility of requesting the receiving Office to restore the right of priority during the international phase. The receiving Office, when deciding on a request for restoration, would be free to apply either the more strict criterion of “due care” or the less strict criterion of “unintentionality.” Although not expressly stated in the proposed amended provisions, it is to be understood that a receiving Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, receiving Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations.



RESTORATION OF RIGHT OF PRIORITY



\* Refusal by RO does not preclude a subsequent request to DO based on either criterion.

\*\* Restoration by RO is subject to review by DO where reasonable doubt that requirements were met.

7. It would be advantageous for the applicant to obtain a positive finding by the receiving Office on the stricter criterion of “due care” since such a finding would be effective in all designated States, unlike a finding on the less strict “unintentionality” criterion (see paragraph 9, below).

8. Concern has been previously expressed by several delegations that inclusion of provisions relating to the restoration of the right of priority may conflict with Articles 8(2)(a) and 2(xi), relating the terms “priority claim” and “priority date” to Article 4 of the Paris Convention, which provides for a priority period of 12 months with no provision for restoration where that period was exceeded. However, at its fifth session, the Working Group noted that Rule 4.10 already allowed applicants to claim the priority, in international applications, of earlier applications filed in countries which were not members of the Paris Convention but were members of the World Trade Organization (WTO) (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraphs 31 and 32). Accordingly, a precedent already exists in the PCT Regulations for the inclusion in international applications of a priority claim that is not as provided in Article 4 of the Stockholm Act of the Paris Convention.

#### *Effect of Receiving Office Decision on Designated States*

9. A decision by the receiving Office to restore a right of priority based on the criterion of “due care” would be effective in all designated States (subject to a transitional reservation provision). A decision by the receiving Office to restore a right of priority based on the criterion of “unintentionality” would be effective only in those designated States whose applicable national law provided for restoration of the right of priority based on that criterion.

#### *Prior Art for the Purposes of International Search, the Establishment of the Written Opinion by the International Searching Authority and International Preliminary Examination*

10. The Working Group, at its fifth session, noted that, under the proposals, the claimed priority date would be used throughout the international phase for the purpose of calculating time limits (for example, those for international publication and national phase entry), even if restoration of the right of priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office, provided that the international application was filed within two months from the date on which the priority period expired. The Working Group also noted that such retention of a priority claim did not affect the question of relevant prior art for the purposes of the international search under Rule 33, since the relevant date for the purposes of the international search was in any case the international filing date. The Working Group did agree, however, that Rule 33.1(c) should be reviewed with a view to specifically drawing attention, in the international search report, to written disclosures published within 12 to 14 months prior to the international filing date (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 34, at the end).

11. Upon consideration, it would appear that no change to Rule 33.1(c) is needed since that Rule does not deal with the issue of written disclosures published earlier than the international filing date but later than the claimed priority date. Rather, that issue is covered by Section 507(d) of the Administrative Instructions (“Manner of Indicating Certain Special Categories of Documents Cited in the International Search Report”). With regard to international applications claiming the priority of an earlier application filed not within 12 months but within 14 months prior to the international filing date, it would appear that

Section 507 should be modified so as to provide for a special code (say, letter “R” for “Restoration” (of the right of priority)) to identify, in the international search report (in addition to the letter “P” used in accordance with Section 507(d)), any document whose publication date occurred earlier than the international filing date of the international application but later than the priority date claimed in that application where that claimed priority date falls within the 2-month period between 12 months and 14 months prior to the international filing date.

12. At its fifth session, the Working Group also agreed to refer the question of relevant prior art for the purposes of the written opinion of the International Searching Authority (Rule 43*bis*.1) and the international preliminary examination (Rule 64) to the Meeting of International Authorities under the PCT (MIA) for consideration via its electronic forum, with a view to the development of a proposal for submission to the next session of the Working Group (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 35). Following consultation with the International Authorities via the MIA electronic forum, it is proposed to amend Rule 64.1(b) so as to clarify the “relevant date” for the purposes of Rule 64.1(a) where the international application claims the priority of an earlier application but has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. By virtue of Rule 43*bis*.1(b), this date would also be the “relevant date” for the purposes of establishing the written opinion by the International Searching Authority.

*Restoration of the Right of Priority by Designated Office during the National Phase*

13. All designated Offices (including elected Offices) would be obliged to provide for the restoration of the right of priority in the national phase (subject to a transitional reservation provision). As under the PLT and the provisions applicable to the receiving Office mentioned above, the national law applicable by the designated Office would have to provide for the restoration of the right of priority either on the basis of the more strict criterion of “due care” or the less strict criterion of “unintentionality.” Although not expressly stated in the proposed amended provisions, it is to be understood that a designated Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a designated Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations.

14. In practice, of course, restoration of the right of priority by a designated Office during the national phase would only be necessary where the receiving Office had not already restored the right of priority with binding effect for the designated Office concerned.

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

[Annex I follows]

## ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>2</sup>

## RESTORATION OF THE RIGHT OF PRIORITY

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<sup>2</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 4**

**The Request (Contents)**

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No Change]

(iii) declarations as provided in Rule 4.17<sub>a</sub>.

(iv) a request for restoration of the right of priority.

(d) [No change]

4.2 to 4.9 [No change]

#### 4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, ~~being a date falling within the period of 12 months preceding the international filing date;~~

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 39. Upon further consideration, it is proposed to amend item (i) of paragraph (a) so as to require the applicant to only indicate the filing date of the earlier application and to deal with the question of whether the international application has been filed within the Paris Convention priority period (only then the priority claim would be valid) in Rule 26bis.2(a) as proposed to be amended (see below).]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

**Rule 26bis**

**Correction or Addition of Priority Claim**

26bis.1 [No change]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds:

- (i) that the international application has an international filing date which is later than the date on which the priority period expired and a request for restoration of the right of priority under Rule 26bis.3 has not been submitted; or

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 41. Upon further consideration, it is proposed to amend Rule 4.10(a)(i) (see above) and Rule 26bis.2(a) so as to expressly provide that the applicant should be invited to correct the priority claim where the international application has an international filing date which is later than the date on which the priority period expired. As in the PLT (see PLT Article 13(2)), it is not proposed to define the term “priority period” but to rely on the fact that the term “period of priority” is used in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property (see PCT Article 8(2)); however, a definition referring to the Paris Convention could be included in the PCT Regulations if necessary. There appears to be no need for an invitation to correct a priority claim where a request for restoration of that right of priority has been filed by the applicant, showing that the applicant, while being aware of the fact that the filing date of the earlier application as indicated in the request does not fall within the 12 months preceding the international filing date, has no intention to correct that priority date but rather wishes to have the right of priority restored under Rule 26bis.3, below.]

- (ii) that a priority claim does not comply with the requirements of Rule 4.10<sub>5</sub>; or

[Rule 26bis.2(a), continued]

(iii) that any indication in a priority claim is inconsistent with the contents of ~~not~~  
~~the same as~~ the corresponding indication appearing in the priority document;

[COMMENT: Clarification only.]

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim. In the case referred to in item (i), where the international filing date is within two months from the date on which the priority period expired, the receiving Office or the International Bureau, as the case may be, shall also notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 40. A notification of the possibility of submitting a request for the restoration of the right of priority would, of course, only be sent to the applicant where such request had not already been made (“in the case referred to in item (i)” of paragraph (a)).]

(b) If, ~~in response to an invitation under paragraph (a),~~ the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim ~~so as to comply with the requirements of Rule 4.10,~~ that priority claim shall, subject to paragraph (c), for the purposes of the procedure under the Treaty, be considered not to have been made (“considered void”) and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, ~~provided that a~~



*[Rule 26bis.2(b), continued]*

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 43. Upon further consideration, it is proposed to further amend paragraph (b) so as to avoid, in paragraph (c) (see below) the use of a double negative (“shall *not* be considered *not* to have been made”).]

(c) A priority claim shall not be considered void ~~not to have been made~~ only because:

[COMMENT: See the Comment on paragraph (b) as proposed to be amended, above.]

(i) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing; ~~or because~~

(ii) an indication in the priority claim is inconsistent with the contents of ~~not the same as~~ the corresponding indication appearing in the priority document; or

(iii) the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date.

[COMMENT: As noted by the Working Group at its fifth session (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 34), pursuant to item (iii), a priority claim contained in an international application whose international filing date is later than the date on which the priority period expired but within the period of two months from that date would automatically be retained, even if restoration of the right of priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office. Such a priority claim would therefore be used throughout the international phase for the purpose of calculating time limits (for example, those for

*[Rule 26bis.2, continued]*

international publication and national phase entry) as well as for the determination of prior art in the context of establishing the written opinion by the International Searching Authority and the international preliminary examination report by the International Preliminary Examining Authority under Chapter II (see Rule 64.1(b) as proposed to be amended, below).]

(d) (e) Where the receiving Office or the International Bureau has made a declaration under paragraph (b) or where the priority claim has not been considered void because paragraph (c) applies, the International Bureau shall, ~~upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions~~, publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions which was considered not to have been made, together with any information submitted by the applicant concerning such priority claim received by the International Bureau prior to the completion of the technical preparation for international publication. Such information ~~A copy of that request~~ shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 44. Under paragraph (d) as proposed to be amended, information concerning a priority claim which is considered void would be published in all cases and not only upon request made by the applicant. Furthermore, information concerning a priority claim would also be published in all cases where the priority claim, in accordance with Rule 26bis.2(c), was not considered void. The Administrative Instructions would have to be modified accordingly. See also Rule 48.2 as proposed to be amended, below.]

26bis.3 Restoration of Right of Priority by Receiving Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall restore the right of priority if the applicant, within the time limit applicable under paragraph (b):

[COMMENT: See PLT Article 13(2) and PLT Rule 14(4)(a). With regard to the time limit for submitting a request for restoration, see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 42, and proposed new paragraph (b), below.]

(i) submits a request to for restoration to the Office, stating the reasons for the failure to file the international application within the priority period, preferably together with, where applicable, any declaration or other evidence in support of that statement of reasons under paragraph (c):

[COMMENT: See PLT Article 13(2)(i) and (iii). See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 50. See also proposed new paragraph (c), below.]

(ii) where a priority claim in respect of the earlier application is not contained in the international application, submits a notice under Rule 26bis.1(a) adding the priority claim;

[COMMENT: See PLT Article 13(2)(i) and PLT Rule 14(5)(ii).]

*[Rule 26bis.3(a), continued]*

(iii) pays, where applicable, the fee for requesting restoration required under paragraph (d);

[COMMENT: See PLT Article 13(4).]

provided that the Office finds that one of the following criteria is satisfied, that is, that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Office, was unintentional (“criteria for restoration”).

[COMMENT: See PLT Article 13(2)(iv). The receiving Office, when deciding on a request for restoration, would be free to apply either the more strict criterion of “due care” or the less strict criterion of “unintentionality.” Although not expressly stated in the proposed amended provisions, it is to be understood that a receiving Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, receiving Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations. At its fifth session, the Working Group agreed that the International Bureau should consider a suggestion by several delegations and a representative of users that, in order to promote uniform standards, the terms “due care” and “unintentional” as used in Rule 26bis.3 should be defined or at least explained in the Regulations or Guidelines (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 46). Upon consideration, it would appear not feasible to define or explain the terms “due care” and “unintentional” in the Regulations. Rather, it is proposed that, following adoption of the proposed amendments by the Assembly, the International Bureau should consider this matter further, with a view to defining or explaining those terms in the Receiving Office Guidelines, taking into account any standards that are currently applied under the national laws applicable in Contracting States.]

(b) The time limit referred to in paragraph (a) shall be two months from the date on which the priority period expired or, where applicable, one month from the date of the notification under the last sentence of Rule 26bis.2(a), whichever expires later.

[COMMENT: See PLT Article 13(2)(ii) and PLT Rule 14(4)(b). See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 42, and the chapeau of proposed new paragraph (a), above.]

*[Rule 26bis.3, continued]*

(c) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (a)(i) be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau, and the International Bureau shall include in its files, a copy of any such declaration or other evidence filed with the receiving Office.

[COMMENT: See PLT Article 13(5). Note that the Working Group agreed at its fifth session that the question of what information or evidence each receiving Office was entitled to require in support of a request for restoration of the right of priority should be left to national law and practice (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 49).]

(d) The submission of a request under paragraph (a)(i) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration. The amount of that fee, if any, shall be fixed by the receiving Office.

[COMMENT: See PLT Article 13(4). As noted by the Working Group at its fifth session, under Rule 26bis.3(c), an Office which provided for restoration on both the criterion of “unintentionality” and the criterion of “due care” would be free to charge different fees in respect of the two cases (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 48).]

(e) The receiving Office shall not refuse, totally or in part, a request under paragraph (a)(i) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal by the receiving Office may be sent to the applicant together with any invitation to file a declaration or other evidence under paragraph (c).

*[Rule 26bis.3(e), continued]*

[COMMENT: See PLT Article 13(6). See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 50. See also proposed new paragraph (a)(i), above.]

(f) The receiving Office shall promptly:

(i) notify the International Bureau of the receipt of a request under paragraph (a)(i);

(ii) make a decision upon the request;

(iii) notify the applicant and the International Bureau of its decision and which of the criteria for restoration the decision was based upon.

(g) Each receiving Office shall inform the International Bureau as to which of the criteria for restoration it is, in general, prepared to apply. The International Bureau shall promptly publish such information in the Gazette.

(h) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (g) are not compatible with the national law applied by the receiving Office, paragraphs (a) to (g) shall not apply to that receiving 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 [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

*[Rule 26bis.3(f), continued]*

[COMMENT: While it would be preferable, so as to achieve a uniform approach to the question of restoration of the right of priority at least during the international phase, not to provide for a transitional reservation provision in Rule 26bis.3 (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 32, at the end), upon consideration, it would appear that such transitional reservation provisions is needed to give any Contracting State time to adapt its national law, as applied by the receiving Office, where that national law is not compatible with the provisions of Rule 26bis.3. Note, however, that a Contracting State could only take advantage of such transitional reservation provision if its national law contained provisions addressed to its national Office in its capacity as a PCT receiving Office (and not only in its capacity as a national Office) which were not compatible with the proposed amendments of the PCT Regulations.]



## Rule 48

### International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (viii) [No change]

(ix) any information concerning a priority claim [referred to in Rule 26bis.2\(d\)](#)  
~~considered not to have been made under Rule 26bis.2(b), the publication of which is~~  
~~requested under Rule 26bis.2(c),~~

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26ter.1, which was received by the International Bureau before the expiration of the time limit under Rule 26ter.1,

[\(xi\) any information concerning a request under Rule 26bis.3 for restoration of the right of priority and the decision of the receiving Office upon such request, including information as to which of the criteria for restoration the decision was based upon.](#)

*[Rule 48.2, continued]*

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

(i) to (iii) [No change]

(iv) where applicable, an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1.

(v) where applicable, an indication that the pamphlet contains information under Rule 26*bis*.2(c).

(vi) where applicable, an indication that the pamphlet contains information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request.

(vii) where applicable, an indication that the applicant has, under Rule 26*bis*.3(c), furnished copies of any declaration or other evidence to the International Bureau.

(c) to (i) [No change]

*[Rule 48.2, continued]*

(j) If, at the time of completion of the technical preparations for international publication, a request under Rule 26bis.3 for restoration of the right of priority is still pending, the pamphlet shall contain, in place of the decision by the receiving Office upon that request, an indication to the effect that such decision was not available and that the decision (when it becomes available) will be separately published.

48.3 to 48.6 [No change]

**Rule 49ter**

**Effect of Restoration of Priority Right by Receiving Office:**

**Restoration of Right of Priority by Designated Office**

49ter.1 Effect of Restoration of Priority Right by Receiving Office

(a) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken, that restoration shall, subject to paragraph (c), be effective in each designated State.

[COMMENT: See paragraph 9 of the Introduction to this document. As regards a transitional reservation provision, see paragraph (f) and Rule 49ter.2(g), below.]

(b) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to paragraph (c), be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion.

[COMMENT: See paragraph 9 of the Introduction to this document. Restoration by the receiving Office would also be effective in any designated State whose applicable national law provided for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion. A decision by the Assembly may be necessary to ensure that such understanding is agreed upon by all Contracting States. As regards a transitional reservation provision, see paragraph (f) and Rule 49ter.2(g), below.]

*[Rule 49ter.1, continued]*

(c) A decision by the receiving Office to restore a right of priority under Rule 26bis.3 shall not be effective in a designated State where the designated Office, a court or any other competent organ of or acting for that designated State finds that a requirement applied by the receiving Office under that Rule was not complied with, provided that the designated Office shall not review the decision of the receiving Office unless it may reasonably doubt that a requirement applied by the receiving Office under that Rule was complied with. In the latter case, the designated Office shall notify the applicant accordingly, indicating the reasons for those doubts and giving the applicant an opportunity to make observations within a reasonable time limit.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 53. The proposed wording “the designated Office, a court or any other competent organ of or acting for that designated State” is modeled on Article 27(4). Note that the requirement for reasonable doubt applies only to designated Offices in order not to fetter the courts or any other competent organs of or acting for the designated States in the exercise of their discretion under national law. At its fifth session, the Working Group agreed that a designated Office should not be permitted under Rule 49ter.1(c) to review a decision of the receiving Office to restore a right of priority merely because the information or evidence required by that receiving Office was not the same kind of information or evidence as that required by the designated Office under its national law; instead, a review under that Rule should only be possible where the designated Office had reasonable doubts as to whether the decision of the receiving Office to restore the right of priority based on that information or evidence was correct (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 54).]

(d) No designated State shall be bound by a decision of the receiving Office refusing a request under Rule 26bis.3 for restoration of the right of priority.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 54. Upon further consideration, it is proposed to direct paragraph (d) to designated States rather than, as in the previous draft, to designated Offices.]

*[Rule 49ter.1, continued]*

(e) Where the receiving Office has refused a request for the restoration of the right of priority, any designated Office may consider that request to be a request for restoration submitted to that designated Office under Rule 49ter.2(a) within the time limit under that Rule.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 56. Note, however, that, in order for the request to be considered by the designated Office, it must comply with certain requirements (such as the furnishing of reasons, which the request filed during the international phase may not have complied with) and a fee may have to be paid to the designated Office (see Rule 49ter.2(a)(ii), below).]

(f) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (c) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

*[Rule 49ter.1(f), continued]*

[COMMENT: A designated Office whose applicable national law did not provide for the restoration of the right of priority at all or did provide for the restoration of the right of priority based on a more stringent criterion than the “due care” criterion would have to make use of the transitional reservation provision under paragraph (f) and also of the transitional reservation provision under Rule 49ter.2(g).]

49ter.2 Restoration of Right of Priority by Designated Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall restore the right of priority if the applicant, within a time limit of one month from the applicable time limit under Article 22:

(i) submits a request for restoration to the designated Office, stating the reasons for the failure to file the international application within the priority period, preferably together with, where applicable, any declaration or other evidence in support of that statement of reasons under paragraph (b);

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 57.]

(ii) pays, where applicable, the fee for requesting restoration required under paragraph (c);

*[Rule 49ter.2(a), continued]*

provided that the Office finds that one of the following criteria is satisfied, that is, that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Office, was unintentional (“criteria for restoration”).

[COMMENT: Although not expressly stated in the proposed amended provisions, it is to be understood that a designated Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a designated Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations.]

(b) The designated Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (a)(i) be filed with it within a time limit which shall be reasonable under the circumstances.

(c) The submission of a request under paragraph (a)(i) may be subjected by the designated Office to the payment to it, for its own benefit, of a fee for requesting restoration.

(d) The designated Office shall not refuse, totally or in part, a request under paragraph (a)(i) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal may be sent by the designated Office to the applicant together with any invitation to file a declaration or other evidence under paragraph (b).

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 57.]



*[Rule 49ter.2, continued]*

(e) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraph (a), the designated Office may, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under that paragraph.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 58.]

(f) Each designated Office shall inform the International Bureau as to which of the criteria for restoration it is, in general, prepared to apply or, where applicable, of the requirements of the national law applicable in accordance with paragraph (e). The International Bureau shall promptly publish such information in the Gazette.

(g) If, on [date of adoption of these modifications by the PCT Assembly], paragraph (a) is not compatible with the national law applied by the designated Office, paragraph (a) shall not apply to that designated 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 [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

*[Rule 49ter.2(g), continued]*

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 58. Any designated Office whose national law provided for a criterion more stringent than the “due care” criterion or did not provide for restoration of the right of priority at all could make use of the transitional reservation provision under proposed new paragraph (g). Designated Offices whose applicable national law provided for the restoration of the right of priority based on requirements similar but not identical to the requirements under Rule 49ter.2(a) would not need to make use of the transitional reservation provision, provided the requirements under the applicable national law were, from the viewpoint of applicants, at least as favorable as the requirements under Rule 49ter.2(a). A decision by the Assembly may be necessary to ensure that such understanding is agreed upon by all Contracting States.]

## Rule 64

### Prior Art for International Preliminary Examination

#### 64.1 *Prior Art*

(a) [No change]

(b) For the purposes of paragraph (a), the relevant date will be:

(i) subject to items (ii) and (iii), the international filing date of the international application under international preliminary examination;

(ii) where the international application under international preliminary examination ~~validly~~ claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid;

(iii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that, for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired, the priority claim is not valid.

*[Rule 64.1(b), continued]*

[COMMENT: See paragraph 12 of the Introduction to this document.]

64.2 and 64.3 [No change]

## Rule 76

~~Copy, Translation and Fee Under Article 39(1); Translation of Priority Document;~~

### Application of Certain Rules to Procedures Before Elected Offices

[COMMENT: The proposed amendment of the title of this Rule is consequential on the proposed amendment of the subtitle of Rule 76.5 (see below).]

76.1, 76.2 and 76.3 [*Remain deleted*]

76.4 [No change]

76.5 Application of Certain Rules to Procedures Before Elected Offices ~~22.1(g), 47.1, 49, 49bis and 51bis~~

[COMMENT: Clarification and simplification only.]

Rules 22.1(g), 47.1, 49, 49bis, 49ter and 51bis shall apply, provided that:

[COMMENT: The proposed amendment of Rule 76.5 is consequential on the proposed addition of new Rule 49ter.]

(i) to (v) [No change]

[Annex II follows]

ANNEX II

ARTICLE 13 AND RULE 14 OF THE PATENT LAW TREATY (PLT)

*Article 13*

*Correction or Addition of Priority Claim; Restoration of Priority Right*

(1) [*Correction or Addition of Priority Claim*] Except where otherwise prescribed in the Regulations, a Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations; and
- (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(2) [*Delayed Filing of the Subsequent Application*] Taking into consideration Article 15, a Contracting Party shall provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the priority period; and
- (iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) [*Failure to File a Copy of Earlier Application*] A Contracting Party shall provide that, where a copy of an earlier application required under Article 6(5) is not filed with the Office within the time limit prescribed in the Regulations pursuant to Article 6, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit for filing the copy of the earlier application prescribed in the Regulations pursuant to Article 6(5);

(iii) the Office finds that the request for the copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations; and

(iv) a copy of the earlier application is filed within the time limit prescribed in the Regulations.

(4) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).

(5) [*Evidence*] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(6) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

#### *Rule 14*

##### *Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13*

(1) [*Exception Under Article 13(1)*] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.

(2) [*Requirements Under Article 13(1)(i)*] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) [*Time Limit Under Article 13(1)(ii)*] The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) [*Time Limits Under Article 13(2)*] (a) The time limit referred to in Article 13(2), introductory part, shall expire not less than two months from the date on which the priority period expired.

(b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) [*Requirements Under Article 13(2)(i)*] A Contracting Party may require that a request referred to in Article 13(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [*Requirements Under Article 13(3)*] (a) A Contracting Party may require that a request referred to in Article 13(3)(i):

(i) be signed by the applicant; and

(ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request.

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3)(iv) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [*Time Limit Under Article 13(3)(iii)*] The time limit referred to in Article 13(3)(iii) shall expire two months before the expiration of the time limit prescribed in Rule 4(1).

[End of Annex II and of document]



# WIPO



PCT/R/WG/6/2

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

Sixth Session  
Geneva, May 3 to 7, 2004

FURNISHING OF SEQUENCE LISTINGS FOR SEARCH AND EXAMINATION

*Document prepared by the International Bureau*

## INTRODUCTION

1. At its third session, the Working Group considered a proposal that Rule 13<sup>ter</sup> be amended to provide that International Searching Authorities and International Preliminary Examining Authorities would no longer be obliged to issue invitations to furnish sequence listings in computer readable form complying with the prescribed standard or to carry out an international search and international preliminary examination in case where a sequence listing complying with that standard had not been filed (see document PCT/R/WG/3/1, Annex I, item 5).<sup>1</sup>

2. The Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standard should be furnished together with the international application so as not to delay the start of the international search, it was agreed that the International Bureau should prepare a proposal

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<sup>1</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. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc.

which would permit Authorities to require the payment of a late furnishing fee where an invitation had to be issued under Rule 13*ter*.1(a)(ii) or (e) (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57).

3. At its fourth and fifth sessions, the Working Group discussed revised proposals for amendment of the PCT Regulations concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13*ter*.1. The Working Group's discussions at its fourth session are outlined in document PCT/R/WG/4/14, paragraphs 97 to 102. The Working Group's discussions at its fifth session are outlined in document PCT/R/WG/5/13, paragraphs 63 to 73, reproduced in the following paragraphs:

“LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

“63. Discussions were based on document PCT/R/WG/5/1, Annex I.

“64. In introducing the proposals for the introduction of a late furnishing fee for late submission of sequence listings, the Representative of the European Patent Office (EPO) stressed their significance in view of the fact that sequence listings in electronic form for search purposes were furnished late in the case of about 50% of all international applications containing disclosure of sequences. This caused significant difficulties and delays in the international search of these applications. The Representative expressed the view that it was necessary both to cover the additional administrative cost involved and to provide an incentive for applicants to furnish sequence listings complying with the relevant standard at the earliest time possible.

“*Rules 13ter.1(a) and (a-bis)*

“65. There was general support for the concept of allowing the International Searching Authority to require a late furnishing fee where it needed to invite the applicant to furnish a copy of the sequence listing complying with the relevant standard, whether the listing was in electronic or (in rare cases) paper form. The Working Group noted, in the latter context, that a further amendment of Rule 13*ter*.1(a)(i) that had been agreed at its fourth session should also be included, namely, the insertion after the words “furnish to it” of the words “and to pay, where applicable, the late furnishing fee referred to in paragraph (a-bis).” The Working Group also agreed, consequential on that change, that Rule 13*ter*.1(a-bis) should be further amended by inserting “(a)(i) or” before “(a)(ii)” in both instances.

“66. The Working Group agreed that, where sequence listings in both paper and electronic forms were required under Rule 13*ter*.1(a)(i) and (ii), the payment of only one late furnishing fee would be required.

“67. One delegation suggested that the late furnishing fee should be payable in each case where the necessary sequence listing was not provided on the international filing date. A number of other delegations, however, considered that it was not appropriate to require the payment of a late furnishing fee where the listing was received before the International Searching Authority had started the international search, noting that real difficulties in processing would only be caused by late furnished sequence listings where the search had already started.

“68. The Representative of the EPO proposed that a maximum amount of the late furnishing fee be fixed, and that the amount should be 25% of the international search fee. A considerable number of delegations and representatives of users expressed agreement with the proposal to introduce a maximum amount. Certain delegations believed that the fixing of fees associated with the international search should be left to the discretion of the International Searching Authorities. Some delegations supported the proposal that the maximum be 25% of the international search fee. Others considered that the maximum should be 25% of the international filing fee, referring to the need for uniformity amongst Authorities as well as consistency with the maximum amount of the late furnishing fee payable to receiving Offices under Rule 12.3(d) and (e) in the case of late furnishing of a translation needed for the purposes of international search. One delegation suggested that the amount was largely arbitrary, since there had been no study on how the level of the fee related to the degree of burden involved for Authorities.

“*Rule 13ter.1(c)*

“69. The Working Group agreed that, if a sequence listing and any required late furnishing fee were received after the time limit fixed in the invitation but before the International Searching Authority had declared that a meaningful search could not be carried out, the Authority should use that listing. While one representative of users felt that a specific statement to this effect may be useful, the Working Group concluded that the words “shall not be required to search” provided sufficient flexibility to allow the search to be carried out anyway.

“70. The Working Group agreed to further amend Rule 13ter.1(c) as follows:

“(c) If the applicant ~~has~~ does not, within the time limit fixed in the invitation, furnished the required sequence listing and paid any required late furnishing fee ~~comply with an invitation under paragraph (a) within the time limit fixed in the invitation,~~ the International Searching Authority shall only ~~not~~ be required to search the international application to the extent that ~~such non-compliance has the result that a meaningful search can~~ cannot be carried out.”

“*Rule 13ter.1(f)*

“71. The Representative of the EPO proposed the deletion of the words “, subject to Article 34,” from Rule 13ter.1(f), suggesting that the reference to Article 34 was confusing and misleading to applicants, noting that the Rule was intended to cover situations in which sequence listings were filed for the purposes of the international search and not as amendments of the international application. On the other hand, it was noted that applicants had a right under Article 34(2)(b) to file amendments of any part of the application as filed, including the sequence listing part. The Representative noted that it was extremely difficult, if not impossible, for an examiner to ascertain what amendment had been made to a sequence listing and to assess whether the amendment resulted in added matter within the meaning of Article 34(2)(b). It was important, in any event, to make a clear distinction between a sequence listing filed as an amendment of the international application and one filed for the purposes of Rule 13ter.

“72. Several delegations expressed concern, however, that the simple deletion of the reference to Article 34 would have effects beyond the clarification intended. The Secretariat noted that the structure of Rule 13<sup>ter</sup> might be improved by making a clearer distinction between a sequence listing forming part of the description and one provided for the purposes of international search, and suggested that it might be desirable to review the wording of the Rule in that context.

“73. The Working Group agreed that the issues outlined in paragraphs 63 to 72, above, should be further discussed by the International Authorities, using the electronic forum of the Meeting of International Authorities under the PCT, with a view to the submission of a revised draft of proposed amendments of Rule 13<sup>ter</sup> to the Working Group for approval at its next session and subsequent submission to the Assembly for adoption in September 2004.”

4. Revised proposals for amendment of the PCT Regulations concerning the structure of Rule 13<sup>ter</sup> as well as the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13<sup>ter</sup> were prepared by the International Bureau accordingly and made available, in the form of a preliminary draft document, for comment by the Working Group and the International Authorities via the PCT reform electronic forum and the MIA (Meeting of International Authorities) electronic form, respectively. The further revised proposals contained in the Annex to this document take into account the comments received on the preliminary draft.

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

[Annex follows]

## ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>2</sup>

## LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

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<sup>2</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 3**

#### **The Request (Form)**

3.1 and 3.2 [No change]

#### 3.3 *Check List*

(a) The request shall contain a list indicating:

(i) [No change]

(ii) where applicable, that the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a sequence listing in electronic ~~computer~~ ~~readable~~ form, a document relating to the payment of fees, or any other document (to be specified in the check list);

[COMMENT: With regard to the wording “computer readable form,” it is proposed to align that wording with that used in Parts 7 and 8 of the Administrative Instructions and to use, throughout the Regulations, the wording “electronic form” instead. The Administrative Instructions would have to be modified accordingly.]

(iii) [No change]

(b) [No change]

3.4 [No change]

**Rule 5**

**The Description**

5.1 [No change]

5.2 [No change] *Nucleotide and/or Amino Acid Sequence Disclosure*

(a) [No change] Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing complying with the standard provided for in the Administrative Instructions and presented as a separate part of the description in accordance with that standard.

(b) [No change] Where the sequence listing part of the description contains any free text as defined in the standard provided for in the Administrative Instructions, that free text shall also appear in the main part of the description in the language thereof.

**Rule 13ter**

**Nucleotide and/or Amino Acid Sequence Listings**

13ter.1 Procedure Before the International Searching Authority *Sequence Listing for International Authorities*

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, unless such listing in electronic form is already available to it, and to pay to it, where applicable, the late furnishing fee referred to paragraph (c), within a time limit fixed in the invitation.

~~Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:~~

~~(i) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing complying with that standard;~~

~~(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.~~



*[Rule 13ter.1(a), continued]*

[COMMENT: The existing text of paragraph (a) is proposed to be deleted and replaced by the text appearing here. The relevant standard (covering sequence listings in both paper and electronic forms) is set out in Annexes C and C-bis of the Administrative Instructions. Where the international application is in paper form, paragraph (a) would enable the International Searching Authority to invite the furnishing of a sequence listing in electronic form complying with the standard whether or not there is a complying listing in paper form as required by Rule 5.2. Where the international application is filed in fully electronic form (under Part 7 of the Administrative Instructions), or where the international application is filed on paper together with a sequence listing in electronic form (under Part 8 of the Administrative Instructions), paragraph (a) would enable the Authority to invite the furnishing of a further sequence listing complying with the standard only if that already furnished did not comply with the standard. Where a complying sequence listing is furnished in electronic form spontaneously by the applicant before being invited by the Authority, a further listing would obviously not be needed and could not be required by the Authority. The possibility for the International Searching Authority to require a sequence listing in paper form, which seems less likely to arise in practice, is dealt with in paragraph (b), below.]

(b) ~~[Deleted]~~ Where the entire international application is filed on paper and the International Searching Authority finds that the description does not comply with Rule 5.2(a), it may invite the applicant to furnish, for the purposes of the international search, a sequence listing in paper form complying with the standard provided for in the Administrative Instructions, unless such listing in paper form is already available to it, whether or not the furnishing of a sequence listing in electronic form is invited under paragraph (a).

[COMMENT: A sequence listing in paper form cannot be required where the international application is filed in fully electronic form (under Part 7 of the Administrative Instructions), or where the international application is filed on paper together with a sequence listing in electronic form (under Part 8 of the Administrative Instructions). It is expected that a sequence listing in paper form would be required only in exceptional circumstances. The Authority would of course be free to print out a listing from the electronic version. Since non-compliance with Rule 5.2(a) is not in the nature of a formal defect, it cannot be addressed by way of a “correction.” However, defects under Rule 5.2(b) may be corrected under Rule 13ter.1(f), below.]

*[Rule 13ter.1, continued]*

(c) The furnishing of a sequence listing in response to an invitation under paragraph (a) or (b) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 25% of the [search fee] [international filing fee].

[COMMENT: See the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 65, 66 and 68. Following comments received on the preliminary draft made available for comments via the PCT reform electronic forum and the MIA electronic forum, it is no longer proposed, as was in the preliminary draft, to fix the maximum amount of the late furnishing fee at 25% of the international filing fee. Rather, noting the clear division of opinion in the fifth session of the Working Group, the Working Group may again wish to consider whether the maximum amount should be fixed by a reference to the search fee or the international filing fee.]

(d) (e) If the applicant does not, ~~comply with an invitation under paragraph (a)~~ within the time limit fixed in the invitation under paragraph (a) or (b), furnish the required sequence listing and pay any required late furnishing fee, the International Searching Authority shall only not be required to search the international application to the extent that ~~such non-compliance has the result that~~ a meaningful search can cannot be carried out without the sequence listing.

[COMMENT: It is proposed to further amend present paragraph (c) (proposed new paragraph (d)) by adding, at the end, the words “without the sequence listing” so as to avoid a possible argument by the applicant that a meaningful search could be carried out where the required sequence listing was furnished but the required late furnishing fee not paid. Otherwise, the proposed amendment of paragraph (e) was approved by the Working Group at its fifth session (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 70). In approving this proposed amendment, the Working Group concluded that, if a sequence listing and any required late furnishing fee were received after the time limit fixed in the invitation but before the International Searching Authority had declared that a meaningful search could not be carried out, the words “shall not be required to search” provided sufficient flexibility to allow the search to be carried out anyway (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 69).]

[Rule 13ter.1, continued]

(e) ~~(f)~~ Any sequence listing not contained in the international application as filed, whether furnished in response to an invitation under paragraph (a) or (b) or otherwise, shall not, ~~subject to Article 34,~~ form part of the international application, but this paragraph shall not prevent the applicant from amending the description in relation to a sequence listing pursuant to Article 34(2)(b). ~~Paragraphs (a) and (e) shall apply mutatis mutandis to the procedure before the International Preliminary Examining Authority.~~

[COMMENT: It is proposed to amend present paragraph (f) (proposed new paragraph (e)) so as to clarify that a sequence listing (either in paper form or in electronic form) furnished by the applicant only for the purposes of the international search would not form part of the international application, and so as to clarify that this would not preclude the possibility that an applicant, under Chapter II, may amend the sequence listing part of the description under Article 34 (see proposed new Rule 13ter.2, below; see also the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 71 and 72). As regards present paragraph (e), it is proposed to move its contents (further amended) to Rule 13ter.2 as proposed to be amended (see below).

(f) ~~(d)~~ Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to submit ~~file~~ the required correction. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

[COMMENT: Drafting change only.]

13ter.2 ~~13ter.1(e)~~ *Procedure Before the International Preliminary Examining Authority*

Rule 13ter.1 ~~Paragraphs (a) and (e)~~ shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority[, provided that any reference to the search fee shall be construed as a reference to the international preliminary examination fee].

[COMMENT: The proposed amendments to present Rule 13ter.1(e) (proposed new Rule 13ter.2) are consequential on the proposed amendments to Rule 13ter.1. The text presented in square brackets would only need to be included should the Working Group decide to fix the maximum amount of the late furnishing fee by a reference to the search fee (see Rule 13ter.1(c), above).]

13ter.3 ~~13ter.2~~ *Sequence Listing for Designated Office*

~~Once the processing of the international application has started before a designated Office, Rule 13ter.1(a) shall apply *mutatis mutandis* to the procedure before that Office.~~ No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

[COMMENT: It is proposed to delete the first sentence of present Rule 13ter.2 (proposed new Rule 13ter.3), consequential on the proposed amendments to Rule 13ter.1(a), and to leave the procedure with regard to sequence listings before designated Offices to the applicable national law of the designated Office concerned, except that no such Office would be permitted to require the applicant to furnish a sequence listing (be it in paper form or in electronic form) other than a listing complying with the standard provided for in the Administrative Instructions.]

**Rule 23**

**Transmittal of the Search Copy, Translation and Sequence Listing**

23.1 *Procedure*

(a) and (b) [No change]

(c) Any sequence listing ~~in computer readable form~~ which is furnished to the receiving Office shall be transmitted by that Office to the International Searching Authority.

[COMMENT: It is proposed to broaden the scope of the Rule so as to ensure that any sequence listing furnished to the receiving Office for the purposes of international search, be it on paper or in electronic form, is transmitted to the International Searching Authority.]

**Rule 76**

**~~Copy, Translation and Fee Under Article 39(1); Translation of Priority Document;~~**

**Application of Certain Rules to Procedures Before Elected Offices**

[COMMENT: The proposed amendment of the title of this Rule is consequential on the proposed amendment of the subtitle of Rule 76.5 (see below).]

76.1, 76.2 and 76.3 [*Remain deleted*]

76.4 [No change]

76.5 Application of Certain Rules to Procedures Before Elected Offices ~~22.1(g), 47.1, 49, 49bis and 51bis~~

[COMMENT: Clarification and simplification only.]

Rules 13ter.3, 22.1(g), 47.1, 49, 49bis and 51bis shall apply, provided that:

[COMMENT: It is proposed to amend Rule 76.5 so as to ensure that Rule 13ter.3 is also applied in respect of elected Offices.]

(i) to (v) [No change]

[End of Annex and of document]

# WIPO



PCT/R/WG/6/3

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

Sixth Session  
Geneva, May 3 to 7, 2004

RECTIFICATION OF OBVIOUS MISTAKES

*Document prepared by the International Bureau*

## INTRODUCTION

1. At its first session, held on November 12 to 16, 2001, the Working Group discussed a proposal by the United States of America that Rule 91<sup>1</sup> be amended to limit the rectification of obvious errors to errors occurring in the request and to eliminate the rectification of obvious errors in the description, claims, drawings, and abstract of international applications (see document PCT/R/WG/1/4, paragraphs 8 to 12). Those discussions are summarized in document PCT/R/WG/1/9, as follows:

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<sup>1</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. 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.

“Proposal to amend Rule 91 (see document PCT/R/WG/1/4)

“34. The comments and concerns expressed by various delegations included the following:

(i) while some delegations expressed support for the approach taken in the proposal, others felt that the correction of obvious errors should not be limited to errors occurring in the request but should continue to be possible also with regard to such errors in the description, claims and drawings; any such requests for correction should be dealt with as early as possible during the international phase rather than by individual [designated Offices] in the national phase;

(ii) noting the workload of Offices in dealing with requests under present Rule 91, it was recognized that a balanced solution would have to be found which would continue to give applicants the flexibility needed to correct obvious errors without putting too heavy a burden on Offices dealing with requests for rectifications;

(iii) noting ongoing discussions in the context of the draft [Substantive Patent Law Treaty], some delegations expressed their desire for a review of the present definition of “obvious error” under Rule 91.1(b).

“35. It was agreed that the proposal to amend Rule 91 should not be included in revised drafts to be prepared by the International Bureau, although delegations may wish to further consider the matter in the light of the discussion.”

2. For the second session of the Working Group, the International Bureau prepared a paper (document PCT/WG/2/6) outlining possible further PLT-related changes to the PCT. In relation to the correction of mistakes under PLT Rule 18, paragraph 14 of that document explained:

“Correction of mistakes

“14. The PLT sets out the requirements that a Contracting Party is permitted to apply as regards requests for correction by the Office of mistakes in respect of an application (see PLT Rule 18). In particular, it sets out the contents of the request that an Office may require; it also obliges the Office to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. However, it does not regulate what mistakes may be corrected. PCT Rule 91.1 provides for rectification of obvious errors in the international application or other papers. However, it does not set out any requirements as to the contents of the request for rectification. It also does not require the receiving Office, International Searching Authority or International Preliminary Examining Authority or International Bureau, as the case may be, to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements.”



3. However, it was suggested “that any proposals to align the PCT with PLT Rule 18 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority” (see document PCT/WG/2/6, paragraph 15; the Working Group at its second session was unable in the time available to consider document PCT/WG/2/6 (see document PCT/WG/2/12, paragraph 59)).
4. During its third session, the Working Group reviewed a proposal by the Representative of the European Patent Office (EPO) that Rule 91.1(b) be amended so as to refer to a “person skilled in the art” rather than “anyone” when determining whether a rectification offered by the applicant was “obvious” under Rule 91.1(b). Several delegations supported the proposal and also expressed the view that, in general, Rule 91 was unnecessarily strict. It was agreed that the EPO and the International Bureau should work together to review Rule 91 and to submit a written proposal for consideration by the Working Group (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 64).
5. A written proposal was submitted to the fourth session of the Working Group (see document PCT/R/WG/4/4 Add.2). However, having regard to the time available, discussions on that document were deferred until the next session (see the summary of by the Chair, document PCT/R/WG/4/14, paragraph 104).
6. The written proposal was accordingly re-submitted to the last (fifth) session of the Working Group (see document PCT/R/WG/5/2). The Working Group’s discussions (see document PCT/R/WG/5/13, paragraphs 106 to 111) are outlined in the following paragraphs:
  - “106. Discussions were based on document PCT/R/WG/5/2.
  - “107. Several delegations and representatives of users expressed support in principle for the amendments proposed in the document. The Secretariat noted that, in general, the criteria for rectification of obvious errors under existing Rule 91 were very strict and not always easy to interpret. There was often great difficulty in deciding how to apply the requirement that a rectification be obvious in the sense that “anyone” would “immediately” realize nothing else could have been intended than what was offered as rectification. Read literally, this would suggest that a rectification might not be authorized if there was one person who would not immediately recognize that the rectification was obvious. The result was a range of different practices applied by the various Offices and Authorities.
  - “108. One delegation expressed its concern that the proposals did not streamline or simplify the procedures for rectification but rather introduced new standards and added complexity to the system; in their current form, the proposals would not be acceptable to the delegation. The delegation suggested that rectification of mistakes should be restricted to mistakes of a minor nature, such as clerical and typographical errors, so as to keep the system simple and transparent.
  - “109. After some discussion in which differing views were expressed, the Chair concluded that there was at present a wide variation in the interpretation of, and practice under, Rule 91, highlighting the need for an overhaul of the system so as to achieve more harmonized practices. The Working Group invited the International Bureau to further study the different practices and approaches, focusing, in particular, on the issues raised in the discussion. These included:

“(a) the definition of “mistakes” which should be rectifiable;

“(b) the question whether, in the light of such definition of “mistakes”, it was necessary to provide expressly that the omission of “an entire element or sheet of the international application” shall not be rectifiable; if so, what was meant by an “entire element” having regard to the term “elements” in Article 11(1)(iii), and whether it was necessary to explain that no change of meaning was intended by the proposed deletion of the words “even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets;”

“(c) the authorities (receiving Office, International Searching Authority, International Preliminary Examining Authority, International Bureau) which should be responsible for the rectification of mistakes appearing in different elements of the international application (request; description, claims and drawings; corrections and amendments; other documents) and the responsibility of different authorities in different stages of the international phase (Chapter I and Chapter II);

“(d) the basis on which the relevant authority should make the finding whether an alleged mistake is a rectifiable mistake, that is:

“(i) the notional person who should understand what was intended (for example, a person skilled in the art, or a person in the relevant authority);

“(ii) the question of what should be the “applicable date” to be used in determining the allowability of a rectification of a mistake, depending on the element of the international application (request; description, claims and drawings; corrections and amendments) or other document in question;

“(iii) the circumstances (if any) in which account should be taken of the contents of extrinsic documents, including the question as to which documents should be considered to be extrinsic (for example, a cover-letter or other document of record contained in the files of the receiving Office on the international filing date; an earlier application the priority of which was claimed; instructions from the applicant to the attorney);

“(e) the question whether, in accordance with the principle of *lex specialis*, rectification of a mistake should be permitted under Rule 91 if a specific remedy existed elsewhere in the Treaty or Regulations, for example, in respect of correction of priority claims under Rules 26*bis*;

“(f) the time limit for submitting a request for rectification, including:

“(i) the question whether a request for rectification of a mistake in the international application should be submitted before international publication; and

“(ii) the question whether rectification of mistakes in the description, claims or drawings of an international application should be permitted after the start of the international preliminary examination procedure or whether any mistake should be “correctable” at that stage only by way of an amendment;

“(g) the need to provide that a rectification under Rule 91 should have no effect in any designated or elected Office where the processing or examination of the international application has already started (in the case of early entry into the national phase);

“(i) the question whether the request for rectification should, in all cases, contain a brief explanation of the mistake and the proposed rectification;

“(j) what, if any, further action is necessary where a mistake in the description, claims or drawings, or a mistake in the correction of a priority claim, is rectified after the international search report and the written opinion of the International Searching Authority have been established.

“110. The Working Group also invited the International Bureau to study suggestions that Rule 82<sup>ter</sup> be amended:

“(a) to require designated and elected Offices to rectify certain decisions taken by the receiving Office or the International Bureau during the international phase if that Office or the International Bureau accepted that the decision taken was erroneous;

“(b) to avoid designated and elected Offices having to decide disputes between the applicant and the receiving Office or the International Bureau as to whether certain decisions taken by the receiving Office or the International Bureau during the international phase were erroneous.

“111. One representative of users stressed the importance of present Rule 82<sup>ter</sup> as the only provision in the PCT which would guarantee applicants a review by designated and elected Offices of certain decisions taken during the international phase by the receiving Office and the International Bureau, noting that, in particular, certain receiving Offices did not, under their national laws and practices, offer any review procedure with regard to decisions taken by them during the international phase.”

7. The Annex to this document contains proposals to amend Rule 91 accordingly, and proposals for consequential amendments of Rules 11, 12, 26<sup>bis</sup>, 48, 66, 70 and 82<sup>ter</sup>. For information and clarity, the proposals for amendment of Rule 91 are presented both in the form of a “clean” text of the Rule 91 as it would stand after amendment and in the form of a marked-up text of Rule 91 as proposed to be amended. The main features of the proposals are outlined in the following paragraphs.

## RECTIFICATION OF OBVIOUS MISTAKES

*Rectification of “Obvious Mistakes”*

8. *Obviousness.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(a). Upon further consideration, it is proposed to continue to use, as at present, the term “obvious” mistake rather than (as was proposed in document PCT/R/WG/5/2) “clear” mistake, noting that the term “obvious” appears to better define and more clearly describe the kind of mistake that should be rectifiable under Rule 91.

9. *Definition.* It is proposed to consider a mistake as being “obvious” and thus rectifiable if the competent authority finds:

- (a) that something else was intended than what appears in the document concerned;  
and
- (b) that nothing else could have been intended than the proposed rectification.

10. As is presently the case (see the final draft of the PCT International Search and Preliminary Examination Guidelines as applied to international applications filed on or after January 1, 2004, document PCT/GL/ISPE/1 Prov.2, Chapter 8, paragraph 8.02 ), the PCT International Search and Preliminary Examination Guidelines should continue to provide that, where the alleged mistake is in any part of the international application other than the request, or in any correction or amendment thereof, the proposed rectification could only be considered obvious where what is proposed as rectification would not go beyond the disclosure in the international application as filed.

11. *Rectification.* Although the draft SPLT uses the term “correction” instead of “rectification” (see draft SPLT Article 7(3) and draft SPLT Rule 7(2)), it is proposed, as was proposed in document PCT/R/WG/5/2, to continue to use the term “rectification” so as to maintain the distinction, in the context of the PCT, between “amendments” of the description, claims or drawings (under Articles 19 and 34) and “corrections” of formal defects (under Article 14 and Rule 26).

*Responsibility for Authorization of Rectification*

12. *Competent authorities.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(c). It is proposed to make a clear distinction between the “competent authorities” responsible for authorizing the rectification of obvious mistakes appearing in the different elements of the international application and in related documents, and the responsibility of the different competent authorities in the different stages of the international phase. Under the proposals, the finding whether an alleged mistake is obvious and thus rectifiable would be made:

- (a) in the case of a mistake in the request part of the international application, or in any correction thereof—by the receiving Office;
- (b) unless the International Preliminary Examining Authority is competent under paragraph (c), below, in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19—by the International Searching Authority;

(c) on or after the date on which international preliminary examination shall start in accordance with Rule 69.1, and provided that the demand for international preliminary examination has not been withdrawn, in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19 or 34—by the International Preliminary Examining Authority;

(d) in the case of a mistake in any other document submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau—by that Office, Authority or Bureau, as the case may be.

*Basis for the Finding by the Competent Authority*

13. *Notional person.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(d)(i). As was the case in document PCT/R/WG/5/2, if the alleged mistake is in any part of the international application other than the request, or in any correction or amendment thereof (that is, in cases where either the International Searching Authority or the International Preliminary Examining Authority is the competent authority), it is proposed to refer to a “person skilled in the art” as the notional person who should understand what was intended by the applicant and who should make the finding whether the alleged mistake is obvious. Otherwise, that is, where the mistake is in the request or in any other document submitted to either the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, no specific attributes need to be ascribed to the person making the finding whether an alleged mistake is “obvious” and thus rectifiable.

14. *Applicable date.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(d)(ii). As was already proposed in document PCT/R/WG/5/2, it is proposed that the applicable date to be used in determining the allowability of a rectification of a mistake should be:

(a) the international filing date where the alleged mistake is in any part of the international application;

(b) the date on which the document containing the alleged mistake was received where the alleged mistake is in any other document, including an amendment or a correction of any part of the international application (noting that, where the mistake is an amendment or a correction of any part of the international application, such mistake could only be considered to be obvious and thus rectifiable where what is proposed as rectification would not go beyond the disclosure in the international application as filed (see paragraph 10, above).

15. *Extrinsic documents.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(d)(iii). Noting that only *obvious* mistakes should be rectifiable under Rule 91, and so as to not to add further complexity to the system (for example, procedures allowing the applicant to furnish evidence, showing his real intention, such as instructions to the agent etc.), it is proposed that the competent authority, when making the finding whether an alleged mistake is “obvious” and thus rectifiable, should only

take into account the document containing the mistake, any other document filed with that document, any other document contained in the authority's file as the applicable date referred to in paragraph 14, above, and the priority document.

#### *Mistakes not Rectifiable Under Rule 91*

16. *Omission of entire sheets etc.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(b). It is proposed to maintain the existing provision that the omission of an entire element or sheet shall not be rectifiable under Rule 91. In view of the proposal to provide expressly for the furnishing of missing parts of the description, claims or drawings (see document PCT/R/WG/6/...), it would not seem appropriate to change the existing provisions of Rule 91 in this respect. Furthermore, it is proposed to clarify what is meant by an "entire element" by referring expressly to the elements of the international application listed in Article 3(2) (request, description, claims, drawings and the abstract).

17. *Mistakes in priority claims and corrections and additions thereof.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(e). Upon consideration, it is proposed that a mistake in a priority claim or in a notice correcting or adding a priority claim (submitted under Rule 26bis) should not be rectifiable under Rule 91 where the rectification of such mistake would cause a change in the priority date of the international application. So as not to add further complexity to the system with regard to the computation of time limits calculated on the basis of the priority date, such mistake should only be correctable by way of submitting a (further) notice of correction or addition under Rule 26bis of the priority claim in question, within the applicable time limit under that Rule.

#### *Request for Rectification*

18. *Time limit; effect of authorization on written opinions and reports.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(f)(i). Upon consideration, it would generally appear not to be necessary to require that any rectification of an obvious mistake in any part of the international application be submitted before the International Searching Authority has begun to draw up the international search report or the written opinion, or (under Chapter II) before the International Preliminary Examination Authority has begun to draw up the written opinion or the international preliminary examination report. Noting that a mistake could only be considered to be obvious and thus rectifiable where what is proposed as rectification would not go beyond the disclosure in the international application as filed, it would appear that the rectification of an obvious mistake in any part of the international application should not effect the substance of any written opinion or report. It is thus proposed to set a uniform time limit of 28 months from the priority date for submitting a request for rectification, irrespective of which is the competent authority for the rectification of the alleged mistake, and irrespective of whether the Authority had indeed begun to draw up a written opinion or report.

19. On the other hand, it is proposed to expressly provide that any rectification authorized after the International Searching Authority or the International Preliminary Examining Authority has begun to draw up a written opinion or a report would not need to be taken into account by that Authority for the purposes of establishing the opinion or the report in question, and to require the International Searching Authority or the International Preliminary Examining Authority, as the case may be, to include in any authorization of the rectification of an obvious mistake information as to whether or not the rectification has been taken into

account for the purposes of preparing the written opinion or report. Such information would then be published together with the rectification (either as part of the pamphlet or together with the statement reflecting all rectifications).

20. *“Correction” of mistakes by way of amendments under Article 34.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(f)(ii). Upon consideration, it is not proposed to allow for the “correction” of mistakes, after the start of the international preliminary examination procedure, only by way of an amendment of the international application under Article 34, as was suggested at the fifth session of the Working Group. Rather, it is proposed to maintain, as under many national and regional laws, a clear legal distinction between, on the one hand, amendments of the description, claims or drawings, and rectifications (or corrections) of mistakes (or errors) in the description, claims or drawings, on the other hand, noting that the rectification of an obvious mistake in the international application would be effective from the international filing date.

21. *Explanation.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(h). Upon consideration, it would appear not to be appropriate to include a mandatory requirement for the applicant to furnish a brief explanation of the mistake and the proposed rectification, as was suggested at the fifth session of the Working Group, noting that such explanation cannot be required under PLT Rule 18(1).

#### *Authorization of Rectification*

22. *Effect on written opinions and reports.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(i). With regard to the question of what, if any, further action would be necessary where a mistake in the international application, other than the request, is rectified after the International Searching Authority or the International Preliminary Examining Authority has begun to draw up the written opinion or any report, see paragraph 18, above.

23. *Effect on designated/elected Offices where national processing has started.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(g). It is proposed to expressly provide that the rectification of an obvious mistake shall have no effect in any designated or elected Office in which processing or examination of the international application has already started prior to the date on which the competent authority authorized the rectification.

#### RECTIFICATION BY DESIGNATED OR ELECTED OFFICES OF ERRORS MADE BY THE RECEIVING OFFICE OR BY THE INTERNATIONAL BUREAU

24. At its fifth session, the Working Group invited the International Bureau to study suggestions that Rule 82*ter* be amended to require designated and elected Offices to rectify certain decisions taken by the receiving Office or the International Bureau during the international phase if that Office or the International Bureau accepted that the decision taken was in error (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraphs 110(a)). A proposal to amend Rule 82*ter* accordingly is contained in the Annex to this document. Note that, while the requirement under proposed new Rule 82*ter*.2, namely, that the receiving Office or the International Bureau accepts that the decision which it took was in error, is stricter than the requirement under present Rule 82*ter*.1 (which does not necessitate such acceptance), it would not be required that the error must be such that, had it been made by the designated or elected Office itself, that Office would rectify it under its

national law or practice, as is required under present Rule 82*ter*.1. Note further that proposed new Rule 82*ter*.2 is not limited to the rectification of errors by the receiving Office or the International Bureau concerning the international filing date or a priority claim, as is the case under present Rule 82*ter*.1.

25. At its fifth session, the Working Group also invited the International Bureau to study suggestions that Rule 82*ter* be amended to avoid designated and elected Offices having to decide disputes between the applicant and the receiving Office or the International Bureau as to whether certain decisions taken by the receiving Office or the International Bureau during the international phase were erroneous (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraphs 110(b)). However, since the Rule 82*ter* at present expressly provides only for rectification if the error was rectifiable under the national law or practice of the designated or elected Office concerned, it does not appear possible to avoid referring to an error by the receiving Office or International Bureau within the context of existing Rule 82*ter*.1. As explained in paragraph 24, above, as an alternative approach, it is proposed to amend Rule 82*ter* so as to provide, in addition to the rectifications under present Rule 82*ter*.1, for the rectification of errors if the receiving Office or the International Bureau accepts that the decision which it took was in error (in which case the designated or elected Office would not have to intervene in or decide disputes between the applicant and the receiving Office or the International Bureau).

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

[Annex follows]



## ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>2</sup>  
RECTIFICATION OF OBVIOUS MISTAKES (OBVIOUS ERRORS)

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<sup>2</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 11

### Physical Requirements of the International Application

11.1 to 11.13 [No change]

11.14 *Later Documents*

Rules 10, and 11.1 to 11.13, also apply to any document—for example, [replacement sheets](#) ~~corrected pages~~, amended claims, translations—submitted after the filing of the international application.

[COMMENT: It is proposed to amend Rule 11.14 so as to align the terminology (“replacement sheets” instead of “corrected pages”) with that used in Rule 26.4, which applies *mutatis mutandis* under Rule 91.2(b) as proposed to be amended (see below).]

**Rule 12**

**Language of the International Application and Translation  
for the Purposes of International Search and International Publication**

12.1 [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

(b) Any rectification under Rule 91.1 of an obvious mistake ~~error~~ in the international application shall be in the language in which the application is filed, provided that:

[COMMENT: Consequential on the proposed amendment of Rule 91 (see below).]

(i) and (ii) [No change]

(c) [No change]

12.3 and 12.4 [No change]

**Rule 26bis**

**Correction or Addition of Priority Claim**

*26bis.1 Correction or Addition of Priority Claim*

(a) The applicant may correct or add [to the request](#) a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

[COMMENT: It is proposed to amend Rule 26bis.1(a) so as clarify that any correction or addition of a priority claim would be made “to the request,” as is the case also for any correction or addition of declarations under present Rule 26ter.1(a). In the context of “obvious mistakes, ” the proposed amendment would also clarify that the receiving Office would be the competent authority to authorized the rectification of an obvious mistake made in a notice correcting or adding a priority claim (provided that such correction or addition would not cause a change in the priority date, in which case a rectification under Rule 91.1 would not be possible (see Rule 91.1(d)(ii) as proposed to be amended, below).]

(b) and (c) [No change]

*26bis.2* [No change]

**Rule 48**

**International Publication**

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (vi) [No change]

(vii) any request for rectification of an obvious mistake, any reasons and any comments referred to in Rule 91.3(e) where the request for publication under Rule 91.3(e) was received by the International Bureau before the completion of the technical preparations for international publication ~~referred to in the third sentence of Rule 91.1(f),~~

(viii) to (ix) [No change]

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

(xi) any information concerning the authorization of the rectification of an obvious mistake referred to in Rule 91.3(b), second sentence.

*[Rule 48.2, continued]*

(b) to (h) [No change]

(h-bis) If the authorization for rectification of an obvious mistake in the international application referred to in Rule 91.1 is received or given by the International Bureau after completion of the technical preparations for international publication, either the pamphlet (containing the international application as rectified and any information referred to in paragraph (a)(xi)) shall be republished or a statement reflecting all the rectifications (containing any information referred to in paragraph (a)(xi)), shall be published. In the latter case, at least the front page shall be republished and the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2(b), as the case may be, and any information referred to in paragraph (a)(xi), shall be published.

(i) The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g), ~~and~~ (h) and (h-bis) shall apply. Such determination shall depend on the volume and complexity of the amendments or rectifications and/or the volume of the international application and the cost factors.

(j) If the request for publication under Rule 91.3(e) was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in Rule 91.3(e) shall be promptly published after the receipt of the request for publication, and the front page shall be republished.

*[Rule 48.2(j), continued]*

[COMMENT: The proposed amendments of Rule 48.2 are consequential on the proposed change of approach with regard to the time limit within which a request for rectification of a mistake may be made; see proposed new Rule 91.2(a), below.]

48.3 to 49.6 [No change]



**Rule 66**

**Procedure Before the International Preliminary Examining Authority**

66.1 to 66.5 [No change]

66.5 *Amendment*

Any change, other than the rectification of an obvious mistake errors, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

[COMMENT: Consequential on the proposed amendment of Rule 91 (see below).]

66.6 to 66.9 [No change]

**Rule 70**

**International Preliminary Report on Patentability by  
the International Preliminary Examining Authority  
(International Preliminary Examination Report)**

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and, [subject to Rule 91.3\(b\)](#), each replacement sheet containing [the](#) rectifications of [an](#) obvious [mistake](#) ~~errors~~ authorized under Rule [91.1\(b\)\(iii\)](#) ~~91.1(e)(iii)~~ shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Replacement sheets containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

(b) [No change]

70.17 [No change]

**Rule 82ter**

**Rectification of Errors Made**

**by the Receiving Office or by the International Bureau**

82ter.1 [No change] *Errors Concerning the International Filing Date and the Priority Claim*

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered by the receiving Office or the International Bureau not to have been made, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered not to have been made.

82ter.2 *Errors in Decisions*

If the receiving Office or International Bureau accepts that a decision taken by the receiving Office or the International Bureau, as the case may be, was in error, the designated or elected Office shall rectify the error and shall treat the international application as if that error had not been made.

[COMMENT: See paragraphs 24 and 25 of the Introduction to this document.]

**Rule 91 [“clean” copy]<sup>3</sup>**

**Rectification of Obvious Mistakes in  
the International Application and Other Documents**

91.1 Rectification of Obvious Mistakes

(a) An obvious mistake in the international application or other document submitted by the applicant shall be rectifiable, on the request of the applicant, subject to and in accordance with paragraphs (b) to (e) and Rules 91.2 and 91.3.

(b) A rectification under this Rule shall be made only if it is authorized by “the competent authority,” that is:

(i) in the case of a mistake in the request part of the international application, or in any correction thereof—by the receiving Office;

(ii) unless the International Preliminary Examining Authority is competent under item (iii), in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19—by the International Searching Authority;

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<sup>3</sup> Comments on particular provisions appear only in the “marked-up” copy following.

*[Rule .91.1(b), continued]*

(iii) on or after the date on which international preliminary examination shall start in accordance with Rule 69.1, and provided that the demand for international preliminary examination has not been withdrawn, in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19 or 34—by the International Preliminary Examining Authority;

(iv) in the case of a mistake in any other document submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau—by that Office, Authority or Bureau, as the case may be.

(c) For the purposes of this Rule:

(i) a mistake shall be considered to be obvious only if the competent authority finds that something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification;

(ii) the competent authority shall take into account the document containing the mistake, any other document filed with that document, any other document contained in the authority's file at the applicable date under item (iv), and the priority document;

*[Rule 91.1(c), continued]*

(iii) in the case of a mistake in any part of the international application other than the request or in any amendment or correction thereof, the competent authority shall make its finding on the basis of what would have been understood by a person skilled in the [relevant] art;

(iv) a finding as to whether a mistake is obvious shall be made, in the case of a mistake in any part of the international application, as at the international filing date, and in the case of a mistake in any other document, including an amendment or a correction of the international application, as at the date on which that document was submitted.

(d) The following shall not be rectifiable under this Rule:

(i) the omission of one or more entire elements of the international application as referred to in Article 3(2) or of one or more entire sheets of the international application;

(ii) an obvious mistake in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that nothing in this paragraph shall prevent the inclusion of a missing part containing an entire element or an entire sheet, or the correction of a mistake in a priority claim, under another provision of these Regulations.

*[Rule 91.1, continued]*

(e) Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or other document, it may invite the applicant to request rectification under this Rule.

#### 91.2 Requests for Rectification

(a) A request for rectification of an obvious mistake shall be submitted to the competent authority within 28 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation.

(b) Rule 26.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

#### 91.3 Authorization and Effect of Rectifications

(a) The competent authority shall promptly decide whether to authorize or refuse to authorize the rectification of an obvious mistake under Rule 91.1 and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. The International Bureau shall proceed as provided for in the Administrative Instructions.

*[Rule 91.3, continued]*

(b) The rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search report or the written opinion by that Authority, or by the International Preliminary Examining Authority for the purposes of a written opinion by that Authority or the international preliminary examination report, if that Authority gives, or is informed of, the authorization after it has begun to draw up the written opinion or report concerned. Where that Authority has authorized the rectification of an obvious mistake in the international application or in any correction or amendment thereof, the notification under paragraph (a) shall include information as to whether the rectification has been or will be taken into account in the written opinion or report concerned.

(c) Where rectification of an obvious mistake has been authorized under Rule 91.1, it shall be made in the document concerned as provided in the Administrative Instructions.

(d) Where the rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application, from the international filing date;

(ii) in the case of a mistake in another document, including an amendment or a correction of the international application, from the date on which that document was submitted.



*[Rule 91.3, continued]*

(e) Where the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall, upon request submitted to it by the applicant within two months from the date of the refusal, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of that request, of those reasons and of those comments (if any) shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

(f) The rectification of an obvious mistake need not be taken into account by any designated or elected Office in which the processing or examination of the international application has already started prior to the date of the authorization of the rectification by the competent authority.

**Rule 91 [“marked-up” copy]**

**Rectification of Obvious Mistakes Errors in the  
International Application and Other Documents**

91.1 *Rectification of Obvious Mistakes*

(a) An obvious mistake ~~Subject to paragraphs (b) to (g-quarter), obvious errors~~ in the international application or other document papers submitted by the applicant shall be rectifiable, on the request of the applicant, subject to and in accordance with paragraphs (b) to (e) and Rules 91.2 and 91.3 ~~may be rectified.~~

[COMMENT: See paragraphs 8 and 11 of the Introduction to this document.]

(b) ~~(e)~~ A No rectification under this Rule shall be made only if it is authorized by “the competent authority,” that is ~~except with the express authorization:~~

(i) in the case of ~~the receiving Office if the~~ a mistake error is in the request part of the international application, or any correction thereof—by the receiving Office;

(ii) unless the International Preliminary Examining Authority is competent under item (iii), in the case of ~~the International Searching Authority if the~~ a mistake error is in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19—by the International Searching Authority ; ~~or in any document paper submitted to that Authority;~~

*[Rule 91.1(b), continued]*

(iii) on or after the date on which international preliminary examination shall start in accordance with Rule 69.1, and provided that the demand for international preliminary examination has not been withdrawn, in the case of the International Preliminary Examining Authority if the a mistake error is in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19 or 34—by the International Preliminary Examining Authority; ~~or in any document paper submitted to that Authority,~~

(iv) in the case of a mistake in any other document submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or of the International Bureau—by that Office, Authority or Bureau, as the case may be if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

[COMMENT: See paragraph 12 of the Introduction to this document.]

(c) ~~(b)~~ For the purposes of this Rule:

(i) a mistake shall be considered to be obvious only if the competent authority finds that something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification.

[COMMENT: See paragraphs 9 and 10 of the Introduction to this document.]

*[Rule 91.1(c), continued]*

(ii) the competent authority shall take into account the document containing the mistake, any other document filed with that document, any other document contained in the authority's file at the applicable date under item (iv), and the priority document;

[COMMENT: See paragraph 15 of the Introduction to this document.]

(iii) in the case of a mistake in any part of the international application other than the request or in any amendment or correction thereof, the competent authority shall make its finding on the basis of what would have been understood by a person skilled in the [relevant] art;

[COMMENT: See paragraph 13 of the Introduction to this document.]

(iv) a finding as to whether a mistake is obvious shall be made, in the case of a mistake in any part of the international application, as at the international filing date, and in the case of a mistake in any other document, including an amendment or a correction of the international application, as at the date on which that document was submitted.

[COMMENT: See paragraph 14 of the Introduction to this document.]

*[Rule 91.1(c), continued]*

~~Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.~~

~~(d)~~ (e) The following shall not be rectifiable under this Rule:

- (i) the omission ~~Omissions~~ of one or more entire elements of the international application referred to in Article 3(2) or one or more entire sheets of the international application; ~~even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable~~
- (ii) an obvious mistake in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that nothing in this paragraph shall prevent the inclusion of a missing part containing an entire element or an entire sheet, or the correction of a mistake in a priority claim, under another provision of these Regulations.

[COMMENT: See paragraphs 16 and 17 of the Introduction to this document.]

[Rule 91.1, continued]

(e) ~~(d)~~ Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers  
~~Rectification may be made on the request of the applicant. The authority having discovered~~  
what appears to be a rectifiable obvious mistake in the international application or other  
document, it ~~an obvious error~~ may invite the applicant to ~~present a~~ request ~~for~~ rectification ~~as~~  
~~provided in paragraphs (e) to (g-*quater*) in accordance with this Rule. Rule 26.4 shall apply~~  
~~mutatis mutandis to the manner in which rectifications shall be requested.~~

[COMMENT: Clarification only. It is proposed to move the last sentence of present paragraph (d) to proposed new Rule 91.2(b) (see below).]

## 91.2 Requests for Rectification

(a) A request for rectification of an obvious mistake shall be submitted to the  
competent authority within 28 months from the priority date. It shall specify the mistake to  
be rectified and the proposed rectification, and may at the option of the applicant, contain a  
brief explanation.

[COMMENT: See paragraphs 18 and 19, and paragraph 21 of the Introduction to this document. See also PLT Rule 18(1)(a)(i), (iii) and (iv). The indication under PLT Rule 18.1(a)(ii) (the number of the application or patent concerned) is not included here since the request for rectification must be in the form of, or accompanied by, a letter identifying the international application to which it relates (see PCT Rule 92.1(a)). The indication under PLT Rule 18.1(a)(v) (the name and address of the requesting party) is not included since rectification may be made only on the request of the applicant (see paragraph (d), above).]

[Rule 91.2(a), continued]

~~[91.1(g)] The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g-bis), (g-ter) and (g-quater), be effective:~~

~~(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;~~

~~(ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;~~

~~(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.~~

(b) Rule 26.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

### 91.3 Authorization and Effect of Rectifications

(a) ~~[91.1](f)~~ The competent authority shall promptly decide whether to authorize or refuse to authorize the rectification of an obvious mistake under Rule 91.1 and Any authority which authorizes or refuses any rectification shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons

*[Rule 91.3(a), continued]*

therefor. The International Bureau shall proceed as provided for in the Administrative Instructions. ~~The authority which authorizes a rectification shall promptly notify the International Bureau accordingly.~~

[COMMENT: The proposed amendments would align the wording with that used elsewhere in the amended Rule. The Administrative Instructions would have to be modified so as to require the International Bureau to promptly notify the receiving Office, the International Searching Authority and/or the International Preliminary Examining Authority accordingly, if needed.]

(b) The rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search report or the written opinion by that Authority, or by the International Preliminary Examining Authority for the purposes of a written opinion by that Authority or the international preliminary examination report, if that Authority gives, or is informed of, the authorization after it has begun to draw up the written opinion or report concerned. Where that Authority has authorized the rectification of an obvious mistake in the international application or in any correction or amendment thereof, the notification under paragraph (a) shall include information as to whether the rectification has been or will be taken into account in the written opinion or report concerned.

[COMMENT: See paragraph 19 of the Introduction to this document.]



*[Rule 91.3, continued]*

(c) Where the rectification of an obvious mistake has been authorized under Rule 91.1, it shall be made in the document concerned as provided in the Administrative Instructions.

[COMMENT: Sections 325, 413, 511 and 607 of the Administrative Instructions would have to be modified.]

(d) Where a rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application, from the international filing date:

(ii) in the case of a mistake in another document, including an amendment or a correction of the international application, from the date on which that document was submitted.

[COMMENT: Proposed new paragraph (d) would clearly spell out the effective date of a rectification once authorized.]

(e) ~~[91.1](f)~~ Where the competent authority refuses to authorize a rectification under Rule 91.1 ~~authorization of the rectification was refused~~, the International Bureau shall, upon request ~~submitted to it made~~ by the applicant within two months from the date of the refusal, prior to the time relevant under paragraph (g-bis), (g-ter) or (g-quater) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions,

*[Rule 91.3(e), continued]*

publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of ~~that~~ the request, of those reasons and of those comments (if any) for rectification shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: Under paragraph (e) as proposed to be amended, upon request of the applicant, the International Bureau would also publish information with regard to a request for rectification which was refused by the International Preliminary Examining Authority, even if the request for publication is received after international publication. This would fill a gap which exists under the present Regulations: under present Rule 91.1(f), any request for publication of information with regard to a refused request for rectification has to be received by the International Bureau prior to completion of technical preparations for international publication. In practice, this means that information concerning a request for rectification which has been refused by the International Preliminary Examining Authority after international publication is neither published nor mentioned in the international preliminary examination report: only authorized rectifications are annexed to that report (see present Rule 70.16; see also Rule 70.16 as proposed to be amended, above).]

(f) The rectification of an obvious mistake need not be taken into account by any designated or elected Office in which the processing or examination of the international application has already started prior to the date of the authorization of the rectification by the competent authority.

[COMMENT: See paragraph 23 in the Introduction to this document.]

*[Rule 91.3(f), continued]*

~~{91.1}(g-bis) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.~~

~~{91.1}(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.~~

~~{91.1}(g-quater) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.~~

[End of Annex and of document]

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION

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## INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

**Sixth Session**  
**Geneva, May 3 to 7, 2004**

#### SIGNATURE REQUIREMENTS

*Document prepared by the International Bureau*

#### BACKGROUND

1. On October 1, 2002, with effect from January 1, 2004, the PCT Assembly adopted amendments to the Regulations relating to the concept and operation of the designation system (see document PCT/A/31/10, Annex V). Among the amendments adopted by the Assembly were amendments concerning signature requirements in respect of the request and the demand (see Rules 26.2*bis*(a) and 60.1(a-*ter*)). Under those Rules as amended, it is sufficient that the request and the demand, respectively, be signed by at least one applicant.<sup>1</sup>
2. The amendments outlined above have resulted in differing signature requirements for different acts performed by the applicant during the course of the international procedure. While, as of January 1, 2004, if there are several applicants, the signature of the request and the demand by just one applicant is sufficient for the purposes of Article 14(1)(a)(i),

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<sup>1</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. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc.

(i) any correspondence by the applicant in the course of the international procedure, other than the international application, still requires the signature of all applicants (or of a common agent, or of an appointed or a deemed common representative, representing all applicants) (see Rule 92.1);

(ii) any withdrawal of the international application, designations, priority claims, or of the demand or elections, still requires the signature of all applicants (or of a common agent, or of an appointed common representative, representing all applicants; the deemed common representative is not entitled to sign a notice of withdrawal on behalf of all other applicants) (see Rule 92*bis*).

3. In general, it would appear that differing signature requirements for the request and the demand, on the one hand, and for later acts by the applicant in the course of the international procedure, on the other hand, will likely lead to confusion among applicants and add unnecessary complexity to the system and should thus be avoided.

4. In particular, the fact that the signature of all applicants (or of the common agent, or the appointed or deemed common representative) is still required for such acts such as the submission of a correction or addition of a priority claim (see Rules 26*bis* and 92.1) or the recording of changes in certain indications concerning the applicant, agent, common representative or inventor (see Rules 92*bis* and 92.1) appears to defeat the purpose of the amendments to Rules 26.2*bis*(a) and 60.1(a-*ter*)) as adopted by the Assembly on October 1, 2002, namely, to avoid the need for signatures of all of two or more applicants, in particular in cases where certain applicants are indicated as applicants/inventors for the purposes of the United States of America only and where the applicants have no intention to proceed with the international application into the national phase in that State (but which, due to the new all-inclusive designation system, is automatically designated in the international application).

5. Moreover, the fact that the signature of all applicants is still required in the case of any withdrawal (of the international application, designations, priority claims, demands and elections; see Rule 90*bis*.5) could form a trap for applicants who, relying on the fact that one signature is sufficient for the filing of the international application, wish to withdraw, say, the international application shortly prior to international publication by submitting a notice of withdrawal with the signature of just one applicant, only to be informed that such notice of withdrawal is not effective unless signed by all applicants (or signed by a common agent or an appointed common representative, representing all applicants; note that a deemed common representative is not entitled to sign any notice of withdrawal on behalf of all applicants; see Rule 90.3(c)).

6. The Annex to this document contains proposals for amendment of the Regulations so as to align, at least partially, the signature requirements in respect of correspondence submitted by the applicant in the course of the international procedure and in respect of withdrawals with the signature requirements in respect the request and the demand, as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004.

#### SIGNATURE REQUIREMENTS FOR CORRESPONDENCE

7. It is proposed to amend Rules 92.1 so as to provide that, where there are two or more applicants, the signature of each applicant who, or whose predecessor in title, has signed the request or the demand is sufficient for any correspondence submitted by the applicant(s) in

the course of the international procedure, other than the international application itself. Note that, as at present, the signature of the common agent, the appointed common representative or the deemed common representative would, of course, also be sufficient.

#### SIGNATURE REQUIREMENTS FOR WITHDRAWALS

8. Furthermore, it is proposed to amend Rules 90*bis*.5 so as to provide that, where there are two or more applicants, the signature of each applicant who, or whose predecessor in title, has signed the request or the demand, as the case may be, is sufficient for any notice of withdrawal of the international application, designations or of priority claims, or of the demand or elections. Note that, as at present, the signature of the common agent and the appointed common representative would, of course, also be sufficient, whereas the deemed common representative, as at present, merely by virtue of that fact could not sign any notice of withdrawal on behalf of all applicants.

9. In order to provide a safeguard for those applicants who did not sign a notice of withdrawal, it is proposed to require the recipient of the notice of withdrawal (the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be) to promptly notify the receipt of a notice of withdrawal to all applicants whose addresses have been furnished in compliance with Rule 4.5(a)(ii) (in the request) or Rule 53.4 (in the demand) of the withdrawal; should an applicant who did not sign the notice of withdrawal object to the withdrawal within a time limit of one month following the notification, the notice of withdrawal would be considered not to have been submitted.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>2</sup>

SIGNATURE REQUIREMENTS

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<sup>2</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 90**

**Agents and Common Representatives**

90.1 [No change]

90.2 [No change] *Common Representative*

(a) [No change] 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 may be appointed by the other applicants as their common representative.

(b) [No change] 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 shall be considered to be the common representative of all the applicants.

90.3 *Effects of Acts by or in Relation to Agents and Common Representatives*

(a) [No change] Any act by or in relation to an agent shall have the effect of an act by or in relation to the applicant or applicants concerned.



*[Rule 90.3, continued]*

(b) [No change] If there are two or more agents representing the same applicant or applicants, any act by or in relation to any of those agents shall have the effect of an act by or in relation to the said applicant or applicants.

(c) [No change] Subject to Rule 90*bis*.5(a), second sentence, any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

90.4 to 90.6 [No change]

**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, subject to paragraphs (b) and (c), by each applicant who, or whose predecessor in title, has signed, in the case of a withdrawal referred to in Rule 90bis.1 to 90bis.3, the request or, in the case of a withdrawal referred to in Rule 90bis.4, the demand ~~all of them~~. An applicant who is considered to be the common representative under Rule 90.2(b) shall, ~~subject to paragraph (b)~~, not be entitled, merely by virtue of that fact, to sign such a notice on behalf of the other applicants.

[COMMENT: See paragraphs 7 and 8 in the Introduction to this document. As at present, a deemed common representative could not sign a notice of withdrawal on behalf of all the other applicants (see also Rule 90.3(c), which is not proposed to be amended, above). Rather, the signature of each applicant who, or whose predecessor in title, has signed the request or the demand, as the case may be, would be required. Of course, if the deemed common representative was the only applicant who signed the request, he can sign a notice of withdrawal (see the first sentence of paragraph (a) as proposed to be amended), but such notice of withdrawal would, under paragraph (c), be open to an objection by any applicant who did not sign the notice of withdrawal, in which case the notice would be considered not to have been submitted. The Receiving Office Guidelines would have to be modified so as to clarify that an applicant who signed the request or the demand, as the case may be, but who, following the recordal of a change under Rule 92bis, is no longer an applicant and has no successor in title, would not have to sign any notice of withdrawal.]

*[Rule 90bis.5, continued]*

(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 and has signed the request or the demand, as the case may be, 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 whose signature is required under paragraph (a) and

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned: ~~or~~

~~(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d) or 90bis.3(e), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or~~

~~(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.~~

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

*[Rule 90bis.5, continued]*

(c) Where there are two or more applicants and a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 has been signed in accordance with paragraph (a) but has not been signed by all of the applicants, the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, shall promptly notify the receipt of the notice of withdrawal to all applicants whose addresses have been furnished in accordance with Rule 4.5(a)(ii) or Rule 53.4. If any applicant who did not sign the notice of withdrawal objects to the withdrawal within a time limit of one month from the date of the notification, the notice of withdrawal shall be considered not to have been submitted and the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, shall so inform all applicants whose addresses have been furnished in accordance with Rule 4.5(a)(ii) or Rule 53.4.

[COMMENT: See paragraphs 7 and 8 in the Introduction to this document. Of course, paragraph (c) would not apply where the notice of withdrawal is signed by a common agent or an appointed common representative, representing all applicants, since the signature of the common agent or the appointed common representative would be on behalf of all applicants.]

90bis.6 and 90bis.7 [No change]

## Rule 92

### Correspondence

#### 92.1 *Need for Letter and for Signature*

(a) Any paper submitted by the applicant in the course of the international procedure provided for in the Treaty and these Regulations, other than the international application itself, shall, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates. The letter shall be signed by the applicant or, where there are two or more applicants, subject to paragraph (a-bis), by each applicant who, or whose predecessor in title, has signed the request or the demand.

[COMMENT: See paragraph 7 in the Introduction to this document. It would, of course, be sufficient for the letter to be signed by the common agent or the appointed common representative. It would also be sufficient for the letter to be signed by the deemed common representative, even if he had not signed the request or the demand, since, pursuant to Rule 90.3(c), the signature of the deemed common representative has the effect of an act by or in relation to all the applicants, including those who had signed the request or the demand.]

(a-bis) Rule 90bis.5(b) shall apply *mutatis mutandis*.

[COMMENT: It is proposed to add new paragraph (a-bis) so as to clarify that the signature of an applicant/inventor for the designation of the United States of America who had signed the request (or the demand) is not needed where that applicant could not be found or reached after diligent effort, provided that at least one other applicant who has signed the request or the demand signs the correspondence.]

(b) and (c) [No change]

92.2 to 92.4 [No change]

[End of Annex and of document]