

WIPO



PCT/A/38/6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirty-Eighth (22nd Extraordinary) Session
Geneva, September 22 to 30, 2008**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/45/1): 1, 2, 3, 14, 19, 22, 25 and 26.
2. The report on the said items, with the exception of item 19, is contained in the General Report (document A/45/5).
3. The report on item 19 is contained in the present document.
4. The meeting of the Assembly was presided over by Mrs. Ásta Valdimarsdóttir (Iceland), Chair of the PCT Assembly.

ITEM 19 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

PCT Working Group: Report of the First Session

5. Discussions were based on document PCT/A/38/1.

6. The Assembly:

(i) noted the report of the first session of the PCT Working Group contained in document PCT/WG/1/16 and reproduced in the Annex of document PCT/A/38/1; and

(ii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 31 of document PCT/A/38/1.

Proposed Amendments of the PCT Regulations

7. Discussions were based on documents PCT/A/38/2 and 2 Add.

8. In introducing the documents, the Secretariat proposed two further corrections of a drafting nature to Rule 90*bis* as proposed to be amended, as well as a number of minor corrections of a drafting nature, applicable to the French text only, to various other Rules as proposed to be amended. The corrected texts are set out in Annex I in the English version of this report and Annexes I and II of the French version of this report.

9. The Secretariat further informed the Assembly that, as regards the supplementary search system, it had received confirmation by the Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation), the Swedish Patent and Registration Office and the Nordic Patent Institute in their capacity as International Searching Authorities of their intention to offer the supplementary search service as of January 1, 2009. In addition, the Austrian Patent Office had confirmed its intention to offer that service later in 2009, and both the National Board of Patents and Registration of Finland and the European Patent Office had confirmed their intentions to offer supplementary international searches as of 2010.

10. The Delegation of Finland expressed its support for the proposed amendments of the Regulations.

11. The Assembly:

(i) adopted the amendments of the Regulations under the PCT set out in Annexes I and II to this report;

(ii) decided that the amendments set out in Annex I shall enter into force on January 1, 2009, and shall apply to any international application in respect of which the time limit for making a supplementary search request under new Rule 45*bis*.1(a) expires on or after January 1, 2009;

(iii) decided that the amendments of Rule 29.4 set out in Annex II shall enter into force on July 1, 2009, and shall apply to any international application whose international filing date is on or after July 1, 2009; and

(iv) decided that the amendments of Rules 46.5, 66.8 and 70.16 set out in Annex II shall enter into force on July 1, 2009, and shall apply to any international application in respect of which an amendment under Article 19 or 34 is made on or after July 1, 2009.

Quality Management Systems for PCT International Authorities

12. Discussions were based on document PCT/A/38/3.

13. The Assembly noted the content of document PCT/A/38/3.

Criteria for Any Future Addition of Further Languages of Publication under the PCT

14. Discussions were based on document PCT/A/38/4. The Secretariat proposed a correction to the French text only of the proposed Understanding.

15. The Assembly adopted the Understanding set out in Annex III on criteria for any future addition of further languages of publication under the PCT.

Eligibility Criteria for Reductions in PCT Fees: Proposed Amendments of the Schedule of Fees Annexed to the PCT Regulations

16. Discussions were based on document PCT/A/38/5.

17. The Delegation of Singapore stated that, while the proposal on the eligibility criteria for the reduction of PCT fees for individual applicants from selected States set out in document PCT/A/38/5 reviewed and updated the earlier criteria established in 1997, it had also raised a number of conceptual issues which the Delegation hoped the Secretariat would be able to help clarify. The Delegation stated that, first, the Secretariat's proposal was a departure from the 1997 decision. The proposed criteria, income-based and size-based, were new parameters that had not been discussed amongst Member States. Hence, time should be given for in-depth consideration and discussion to ensure prudent decision-making. Second, the basis of the size-based criteria benchmarks ("not more than 50% above the threshold for establishing the high income category" and "not more than 0.1% of world GDP") was unclear. These benchmarks were based on borrowed concepts and measurements developed in other international organizations for other purposes. Hence, more clarity was needed in terms of the thought process and reasoning behind the proposals to use these borrowed concepts, particularly as regards the determination of the final ceilings under the Secretariat's proposal. In this regard, the Delegation stated that it would be grateful for the Secretariat's clarifications on the rationale, applicability as well as mathematical calculations or formulas in drawing the boundaries at "not more than 50% above the threshold for establishing the high income category" and "not more than 0.1% of world GDP".

18. The Delegation further expressed the view that, third, earlier discussions had highlighted that the overarching objective of the reduction in PCT fees for individuals was to spur innovation. The proposal's focus on economic indicators, such as GNI per capita and GDP, were not definitive in measuring or encouraging innovation. For a more complete picture, work should be done towards identifying criteria that would fulfill the objective of encouraging inventive activities. One aspect that should be explored in greater detail was that of an innovation criterion. Quoting from a study by the Organisation for Economic Co-operation and Development (OECD) (Compendium of Patent Statistics 2007, OECD), the Delegation stated that patent-based statistics provided a measure of innovation output as they reflected the inventive performance of countries. Hence, an in-depth statistical analysis of

parameters, such as the level of PCT filings by individuals and patent trends, should be conducted. This approach would ensure that the reduction in PCT fees served to benefit States with lower levels of filings by encouraging innovation, and the increased usage of the PCT system in patent filings. Fourth, the decision for a 90% reduction in PCT fees for eligible countries had been made in March 2008 and had come into force only on 1 July 2008. In the case of Singapore, 11 individual applicants had already benefited from the 90% reduction over the past two months, and the impact on the PCT income was a negligible 0.008%. More time should be given to allow Member States to assess the impact of the 90% reduction on innovation levels. At least a year should be allowed to pass to allow the impact of the decision to work through the PCT system before going back to the drawing board to refine the March 2008 decision. This would permit more rounded assessments. Meanwhile, the Secretariat could explore new criteria, particularly innovation-related criteria which would provide additional and perhaps more relevant perspectives to this issue.

19. In conclusion, the Delegation of Singapore stated that it was of the view that a decision on eligibility criteria for fee reductions should be deferred to a later stage, as more time should be given for Member States to deliberate on the Secretariat's proposal, to better assess the impact of the recent reduction, and to explore new and conceptually robust criteria. To ensure that the reduction achieved the aim of stimulating innovation, the eventual criteria should be based on patent-based statistics and consider independent evidence, rather than borrowing concepts which may not be relevant, in order to fulfill the overarching objective of spurring innovation.

20. The Delegation of Algeria, speaking on behalf of the African Group, stated that the Group had taken careful note of the proposed eligibility criteria for reductions of the PCT fees. The Group supported the extension of the reductions to developing countries of all categories, including the nine States to which the reductions had been extended pending review. Moreover, it was essential that least developed countries (LDCs) should continue to benefit from the fee reductions for as long as they continued to be classified as LDCs according to the United Nations system. Finally, the Group considered that the proposal for biennial review of the lists of eligible States was too frequent and a period of five years was recommended since it could not be expected that a developing country or LDC would make substantial progress in a period as short as two years.

21. The Delegation of the United Arab Emirates expressed its support for the proposal made by Singapore to conduct further studies. It observed that most inventors from the United Arab Emirates were students.

22. The Delegation of Nigeria endorsed the statement of the African Group. The Delegation supported criteria that would be broad enough to offer fee reductions to all developing countries, including the nine which had been recently added. The Delegation considered that it was important to consider carefully and scientifically what each criterion could do in terms of improvement to the system. It was necessary to look at what could be done to ensure that all developing countries enjoyed this fee reduction. The Delegation considered that a combination of both an income and size-based approach as recommended by the Secretariat would go furthest to embracing all these countries and the Delegation endorsed such an approach. The Delegation observed that a decision might be postponed to do further scientific analysis to find the most correct approach but believed that, even if another 10 years was spent on analysis, it would be impossible to do something definite. What was needed was to apply criteria now that could help extend reductions to all countries in the developing world. This did not preclude a careful review of the criteria, but the important thing was to

apply something which was broad. The Delegation reiterated the view expressed by the African Group that two years was too short for a period for review. Five years would be appropriate for this.

23. The Delegation of Oman observed that Oman would benefit from the criteria that came out of this study. Its authorities had not yet had the time to consider the study in detail, in particular because of the language in which the study was published. Language was, of course, a very important factor in enabling delegations to understand the documents that are published by the Organization. In relation to the study, the Delegation referred to the objectives of the fee reduction as stated in paragraph 4, that it “would contribute to increased access to the PCT system” or increase demand, and that would be a tangible benefit. With regard to the choice of criteria, the Delegation considered that those proposed in the document, based on income and size, were not sufficient. There should be different criteria, such as creativity, which was a key factor. Creativity was, of course, key to development, and that was why it was important to look into that matter as one of the eligibility criteria. The Delegation considered that enlarging the number of different criteria would be useful in finding a sustainable long-term solution, rather than a temporary approach under which the criteria would have to be reviewed frequently. The Delegation hoped that the study would help to find a long term sustainable solution which would only need to be reviewed every three or four years. Such a review should take into account the increasing demand and, importantly, development in the beneficiary countries. The Delegation finally reiterated the importance of language. For countries which were just getting to grips with a new system, it was essential to have effective means of communicating in their own languages. If the benefits of treaties and agreements were going to be felt, it was necessary to receive all of the documents for those treaties in a language that enabled the authorities to understand the fine technical niceties of the agreements so that States would be able to have a fruitful dialog.

24. The Delegation of Barbados stated that the Member States of WIPO were, in this matter, engaging in a norm setting activity, seeking to establish the modalities on the criteria for eligibility for a PCT fee reduction. In that regard, the Delegation wished to congratulate the International Bureau for its attempt to move away from a “one size fits all” approach with respect to the application of the eligibility criteria, and for attempting to provide an appropriate solution for patent applicants in small States which would either not be eligible or which would soon lose their eligibility for the fee reduction if income were the only criterion. The Delegation considered that Member States were beginning to see the emergence of the effect of the development agenda in the work of the International Bureau.

25. The Delegation of Barbados further stated that, notwithstanding its appreciation for the work of the International Bureau, it had concerns about the appropriateness of the criterion suggested in paragraph 28(b) of document PCT/A/38/5 as it applied to patent applicants from high income, small, vulnerable economies. The Delegation wished to elaborate on why such economies did require special and differential treatment with respect to eligibility for a PCT fee reduction, and why a “one size fits all” approach, based on *per capita* income, was inappropriate. The Delegation expressed the view that, in determining which countries should benefit from a PCT fee reduction, one could not afford simply to look at *per capita* income in isolation; otherwise, one would end up with an inequitable result for patent applicants in high income, small, vulnerable economies, such as Barbados. Rather, one had to look at the various circumstances existing in a given country and the challenges which patent applicants in that country faced in the manufacture of an invention, the sale of that invention in the domestic market as well as the export of that product to the markets of other countries, in order to determine whether there was a need for the applicant to benefit from a fee reduction. One had to look at the full picture. The PCT system was not an end in itself but a means to an

end. It was one of the mechanisms through which intellectual property could make a contribution to the economic development of a country. If one looked only at the *per capita* income, one ended up in the situation whereby patent applicants in certain middle-income countries, where the conditions were more favorable to the manufacture and sale of inventions, were in reality in a far better position than applicants in high income, small, vulnerable economies barred from a PCT fee reduction.

26. The Delegation of Barbados further noted that the *per capita* income of Barbados was high. According to the figures provided by the International Bureau for 2006, Barbados was 175 Swiss francs above the threshold for the high income category. However, while the *per capita* income might be high, the cost of living was also high. The cost of living in Barbados was a factor that ought not to be ignored. In addition, the cost of production was high and, because of the small market, production often suffered from diseconomies of scale. The result was that the level of competitiveness with larger economies was low, which had implications for the export and sale of the manufactured invention to persons in other countries. It was therefore rather difficult for a patent applicant in Barbados to recoup what he had invested in bringing his invention to the stage of patentability. In the view of the Delegation of Barbados, the challenges which patent applicants in Barbados faced with respect to the manufacture and sale of their inventions nullified the benefits of a higher *per capita* income. A patent applicant in Barbados was, in reality, in the same or a worse position than that of patent applicants in certain middle-income countries. The criterion to be suggested for high income, small, vulnerable economies, as well as the duration of that criterion, should therefore not be arbitrary in nature but should reflect reality and exist as long as the special challenges which patent applicants faced remained.

27. The Delegation of Barbados further stated that many small economies were least developed countries, whose needs for special and differential treatment were already addressed in paragraph 28(c) of document PCT/A/38/5. The needs of a number of middle income small economies were addressed under paragraph 28(a) of that document, as their *per capita* income fell below the threshold for the high income category. What needed to be done was to find an appropriate solution for patent applicants in high income, small, vulnerable economies, such as Barbados; otherwise, inequity would result, a fact which had to be underscored. The Delegation of Barbados therefore proposed that, in light of the need to address the challenges faced by patent applicants in high income, small, vulnerable economies, there should be an additional economic criterion in paragraph 28 of document PCT/A/38/5, to read as follows: "... an international application should benefit from the 90% fee reduction if it is filed by an applicant who is a natural person and who is a national of and resides in a State that is classified as a small, vulnerable economy".

28. As to the question of how to determine which country belonged to the group of small, vulnerable economies, the Delegation of Barbados expressed the view that significant progress had been made in the World Trade Organization's Non-Agricultural Market Access (WTO/NAMA) negotiations on this issue. In the United Nations Conference on Trade and Development (UNCTAD), there was a broader category of countries known as the Structurally Weak Vulnerable Small Economies, which included all the least developed countries, as well as some Latin American and Caribbean countries and others, but more work needed to be done on that issue. The Delegation stated that, in WIPO, Member States had to be creative. The International Bureau could propose the additional criteria and report back to Member States at the next PCT Assembly, or Member States could use the WTO/NAMA criteria as set out in paragraph 23 of the study. In NAMA, a small vulnerable economy was defined as one that had a share of less than 0.1% of the World NAMA trade for the reference period of 1999 to 2001; a different reference period could be used. The International Bureau, by referring to the NAMA trade-related criterion in the study, had not gone on to explore this

criterion because, according to paragraph 24 of the document, it would not be possible to classify all States whose applicants could potentially benefit from the PCT fee reduction as some WIPO Member States were not members of the WTO. In that regard, the Delegation of Barbados wished to point out that the figures used by the WTO were, as stated in WTO document TN/MA/S/18, from the United Nations Comtrade database and could be accessed by the International Bureau from that database. The Delegation stated that it would not like this criterion determined by a percentage of world trade to be rejected out of hand simply because some WIPO Member States were not members of the WTO. It encouraged the International Bureau to address the special challenges which individual patent applicants in high income, small, vulnerable economies faced in the manufacture and sale of their inventions both in the domestic market and abroad. These challenges would not necessarily go away should Barbados's *per capita* income reach 50% above the threshold used by the World Bank for establishing the "high income" category. The duration of the criteria that were proposed should be one which was linked to the existence of these challenges.

29. In conclusion, the Delegation of Barbados stated that, while it welcomed the efforts of the International Bureau to take into account not only the concerns of patent applicants in large and medium-sized developing economies but also those of applicants in small economies, it was unable to join any consensus on the criteria as proposed in paragraph 28 of the study. The Delegation expressed the view that what was needed were more appropriate criteria which took into account and addressed the challenges faced by patent applicants in high income, small, vulnerable economies such as Barbados.

30. Following a proposal by the Director General-elect, the Assembly agreed that the issue should be placed on the agenda of the PCT Working Group in 2009.

[Annexes follow]

ANNEX I

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on January 1, 2009)¹

SUPPLEMENTARY INTERNATIONAL SEARCH

TABLE OF CONTENTS²

Rule 45bis	Supplementary International Searches.....	2
45bis.1	[No change].....	2
45bis.2	<i>Supplementary Search Handling Fee</i>	2
45bis.3	<i>Supplementary Search Fee</i>	2
45bis.4 to 45bis.9	[No change].....	2
Rule 90	Agents and Common Representatives	3
90.1	<i>Appointment as Agent</i>	3
90.2 and 90.3	[No change].....	3
90.4	<i>Manner of Appointment of Agent or Common Representative</i>	4
90.5	<i>General Power of Attorney</i>	4
90.6	[No change]	4
Rule 90bis	Withdrawals	5
90bis.1 to 90bis.3	[No change].....	5
90bis.3bis	<i>Withdrawal of Supplementary Search Request</i>	5
90bis.4	[No change].....	5
90bis.5	<i>Signature</i>	5
90bis.6	<i>Effect of Withdrawal</i>	6
90bis.7	[No change].....	6

¹ See paragraph 11 in the main body of this report for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 45bis
Supplementary International Searches

45bis.1 [No change]

45bis.2 *Supplementary Search Handling Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

45bis.3 *Supplementary Search Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

(e) [No change]

45bis.4 to 45bis.9 [No change]

Rule 90
Agents and Common Representatives

90.1 *Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority.

(b) [No change]

(*b-bis*) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) [No change]

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) specifically before the International Searching Authority, any Authority specified for supplementary search or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

90.2 and 90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) [No change]

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (b-*bis*), (c) or (d)(ii), it shall be submitted to the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

(c) [No change]

(d) Subject to paragraph (e), any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches, any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply.

(e) [No change]

90.5 *General Power of Attorney*

(a) [No change]

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (b-*bis*), (c) or (d)(ii), it shall be deposited with the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

(c) Any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 to the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be, a copy of the general power of attorney shall be submitted to that Office or Authority.

90.6 [No change]

Rule 90bis
Withdrawals

90bis.1 to 90bis.3 [No change]

90bis.3bis Withdrawal of Supplementary Search Request

(a) The applicant may withdraw a supplementary search request at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45bis.8(a), of the supplementary international search report or the declaration that no such report will be established.

(b) Withdrawal shall be effective on receipt, within the time limit under paragraph (a), of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in paragraph (a), the communication of that report or declaration under Article 20(1), as applicable by virtue of Rule 45bis.8(b), shall nevertheless be effected.

90bis.4 [No change]

90bis.5 Signature

(a) [No change]

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

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau, the Authority carrying out the supplementary international search 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), 90bis.3(c) or 90bis.3bis(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) [No change]

90bis.6 Effect of Withdrawal

(a) and (b) [No change]

(b-*bis*) Where a supplementary search request is withdrawn under Rule 90*bis.3bis*, the supplementary international search by the Authority concerned shall be discontinued.

(c) [No change]

90bis.7 [No change]

[Annex II follows]

ANNEX II

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on July 1, 2009)¹

PROCESSING OF THE INTERNATIONAL APPLICATION UNDER ARTICLE 14(4);
AMENDMENT OF CLAIMS

TABLE OF CONTENTS²

Rule 29	International Applications Considered Withdrawn	2
29.1 to 29.3	[No change]	2
29.4	<i>Notification of Intent to Make Declaration under Article 14(4)</i>	2
Rule 46	Amendment of Claims before the International Bureau.....	3
46.1 to 46.4	[No change]	3
46.5	<i>Form of Amendments</i>	3
Rule 66	Procedure before the International Preliminary Examining Authority.....	4
66.1 to 66.7	[No change]	4
66.8	<i>Form of Amendments</i>	4
66.9	[No change]	4
Rule 70	International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report).....	5
70.1 to 70.15	[No change]	5
70.16	<i>Annexes to the Report</i>	5
70.17	[No change]	5

¹ See paragraph 11 in the main body of this report for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 29
International Applications Considered Withdrawn

29.1 to 29.3 [No change]

29.4 *Notification of Intent to Make Declaration under Article 14(4)*

(a) Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefor. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within two months from the date of the notification.

(b) Where the receiving Office intends to issue a declaration under Article 14(4) in respect of an element mentioned in Article 11(1)(iii)(d) or (e), the receiving Office shall, in the notification referred to in paragraph (a) of this Rule, invite the applicant to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18. For the purposes of Rule 20.7(a)(i), the invitation sent to the applicant under this paragraph shall be considered to be an invitation under Rule 20.3(a)(ii).

(c) Paragraph (b) shall not apply where the receiving Office has informed the International Bureau in accordance with Rule 20.8(a) of the incompatibility of Rules 20.3(a)(ii) and (b)(ii) and 20.6 with the national law applied by that Office.

Rule 46
Amendment of Claims before the International Bureau

46.1 to 46.4 [No change]

46.5 *Form of Amendments*

(a) The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed.

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled.

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 *Form of Amendments*

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) [No change]

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

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) shall, unless superseded by later replacement sheets under Rule 66.8(a) or (b) or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report.

(a-*bis*) Replacement sheets under Rule 46.5(a) shall, unless superseded or considered as reversed by replacement sheets under Rule 66.8(c), be annexed to the report. Replacement sheets under Rule 66.8(c) shall, unless superseded by later replacement sheets under Rule 66.8(c), be annexed to the report. Letters under Rule 46.5(b) or Rule 66.8(a) or (c) shall not be annexed to the report.

(b) Notwithstanding paragraphs (a) and (a-*bis*), each superseded or reversed replacement sheet referred to in those paragraphs shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c). In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

70.17 [No change]

[Annex III follows]

ANNEX III

UNDERSTANDING CONCERNING CRITERIA FOR ANY FUTURE ADDITION
OF FURTHER LANGUAGES OF PUBLICATION UNDER THE PCT

A new language of publication under PCT Rule 48.3 should only be added if all of the following criteria are met:

- (i) the language is accepted for processing by at least one International Searching Authority;
- (ii) the combined number of applications which are first filed in that language (that is, without claiming priority from another application, whether in that language or another) in all Offices which accept that language (including under the PCT) represent at least 2.5% of total first filings worldwide in the most recent year for which statistics are available;
- (iii) adequate machine translation tools are publicly available for translation from that language into at least English, which can be integrated into at least one public database providing free access to international applications freely or at acceptable cost to the database supplier.

[End of Annex III and of document]