

International Patent Cooperation Union (PCT Union)

Assembly

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PROPOSED AMENDMENTS OF THE PCT REGULATIONS

Document prepared by the International Bureau

CORRECTIONS RELATING TO DOCUMENT PCT/A/41/2

This document reproduces the text of document PCT/A/41/2 with some minor corrections concerning the proposals for entry into force and transitional arrangements in respect of the proposed amendments to Rule 70.16. As indicated in paragraph 5, below, proposals concerning entry into force and transitional arrangements in respect of the proposed amendments had been posted by the Secretariat on the Working Group's electronic forum on WIPO's website for comments and suggestions by delegations and representatives. Unfortunately, due to an administrative oversight, a comment submitted by one delegation within the applicable time limit was not received by the Secretariat in time to be taken into account in document PCT/A/41/2. That comment related to the entry into force and transitional arrangements of Rule 70.16. The delegation suggested that Rule 70.16 as amended should be applicable to all international preliminary examination reports completed on or after July 1, 2011, irrespective of the international filing date of the international application concerned; the original proposal established two procedures to be used concurrently, depending on the international filing date of the international application concerned, which would be confusing and difficult to implement for the International Authority concerned. So as to take that comment into account, the proposed provisions concerning entry into force and transitional arrangements set out in paragraph 6, below, have been modified, a new paragraph 8 has been added, and previous paragraphs 8 and 9 have been renumbered accordingly. The draft decisions of the Assembly set out in Annex II, below, have also been modified accordingly. Editorial changes are not specifically mentioned.

SUMMARY

1. This document contains proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT)¹, as recommended by the PCT Working Group (“the Working Group”). The proposed amendments relate to the following matters:
 - (a) the rectification of obvious mistakes authorized by the International Preliminary Examining Authority;
 - (b) amendments under Articles 19 and 34 and accompanying letters; and
 - (c) annexes to the international preliminary examination report.
2. The texts of the proposed amendments of the PCT Regulations appear in Annex I. For proposed dates of entry into force and transitional arrangements, see paragraphs 5 to 9, below, and Annex II. A brief outline of the purpose of each group of amendments appears in paragraph 4, below, and more detailed explanations are set out in Annex III. A “clean” text of all of the proposed amended provisions (without underlining or striking through) appears in Annex IV.

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

3. Proposals were considered by the Working Group during its third session, held in June 2010, at which the Working Group agreed on proposed amendments to be submitted to the Assembly for adoption at the present session, subject to possible further drafting changes to be made by the Secretariat (document PCT/WG/3/14 Rev., reproduced in the Annex to document PCT/A/41/1 Rev.).
4. The proposed amendments of the PCT Regulations are set out in Annex I to the present document. The purpose of the proposed amendments is outlined briefly in the following subparagraphs. More detailed explanations appear in Annex III.
 - (a) *Rectification of Obvious Mistakes Authorized by the International Preliminary Examining Authority.* Proposed amendments of Rules 48.2(i) and 70.16 are set out in Annex I and explained in Annex III, paragraphs 2 to 8. The proposed amendments concern the rectification of obvious mistakes authorized by the International Preliminary Examining Authority under Rule 91.1(b)(iii).
 - (b) *Amendments under Articles 19 and 34 and Accompanying Letters.* Proposed amendments of Rules 49.5, 53.9, 55.3, 62.1, 62.2, 70.2 and 70.16, and the proposed deletion of Rule 66.9, are set out in Annex I and explained in Annex III, paragraphs 9 to 17. The proposed amendments concern the filing of amendments of the claims under Article 19 and of amendments of the description, claims or drawings under Article 34, and accompanying letters indicating the basis for the amendment in the application as filed.
 - (c) *Annexes to the International Preliminary Examination Report.* Proposed amendments of Rule 70.16 are set out in Annex I and explained in Annex III, paragraph 18. The proposed amendments concern replacement sheets, letters and other documents which are to be annexed to the international preliminary examination report.

¹ 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 references to regional laws, regional applications, the regional phase, etc.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

5. Proposals concerning entry into force and transitional arrangements in respect of the proposed amendments were posted by the Secretariat on the Working Group's electronic forum on WIPO's website² for comments and suggestions by delegations and representatives. The proposals contained in this document take into account the comments and suggestions received.
6. As regards the proposed amendments of Rules 12.2, 48.2, 53.9, 55.3, 62.1, 62.2, 66.9, 70.2 and 92.2 set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2011, and should apply to international applications whose international filing date is on or after July 1, 2011.
7. As regards the proposed amendments of Rule 49.5 set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2011, and should apply to international applications in respect of which the applicant has performed the acts referred to in Article 22 or Article 39 on or after July 1, 2011, and in respect of which an amendment under Article 19 or Article 34 was filed on or after July 1, 2009.
8. As regards the proposed amendments of Rule 70.16 set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2011, and should apply to any international preliminary examination report which is completed in accordance with Rule 70.4 on or after July 1, 2011, irrespective of the international filing date of the international application concerned.
9. Draft decisions of the Assembly concerning dates of entry into force and proposed transitional arrangements are set out in Annex II.
 10. *The Assembly of the PCT Union is invited:*
 - (i) *to adopt the proposed amendments of the Regulations under the PCT set out in Annex I; and*
 - (ii) *to adopt the proposed decisions set out in Annex II relating to entry into force and transitional arrangements.*

[Annexes follow]

² <http://www.wipo.int/pct-wg/en/index.html>

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS³

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³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. A “clean” copy of the proposed amended provisions (without underlining or striking through) appears in Annex IV. For dates of entry into force and transitional arrangements, see paragraphs 6 and 7 of the main body of this document and Annex II.

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Rule 12
Language of the International Application
and Translations for the Purposes of International Search
and International Publication

12.1 to 12.1~~ter~~ [No change]

12.2 *Language of Changes in the International Application*

(a) Any amendment of the international application shall, subject to Rules 46.3 [and](#) ~~55.3~~
~~and 66.9~~, be in the language in which the application is filed.

(b) and (c) [No change]

12.3 and 12.4 [No change]

Rule 48
International Publication

48.1 [No change]

48.2 *Contents*

(a) to (h) [No change]

(i) If the authorization [by the receiving Office, the International Searching Authority or the International Bureau](#) of a rectification of an obvious mistake in the international application [under ~~referred to in~~](#) Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, and the front page shall be republished.

(j) to (k) [No change]

48.3 to 48.6 [No change]

Rule 49
Copy, Translation and Fee under Article 22

49.1 to 49.4 [No change]

49.5 *Contents of and Physical Requirements for the Translation*

(a) For the purposes of Article 22, the translation of the international application shall contain the description (subject to paragraph (a-bis)), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (c-bis) and (e),

(i) [no change]

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended [\(the claims as amended shall be furnished in the form of a translation of the complete set of claims furnished under Rule 46.5\(a\) in replacement of all the claims originally filed\)](#), and

(iii) [no change]

(a-bis) to (l) [No change]

49.6 [No change]

Rule 53
The Demand

53.1 to 53.8 [No change]

53.9 *Statement Concerning Amendments*

(a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments:

(i) to be taken into account, in which case a copy of the amendments [and of the letter required under Rule 46.5\(b\)](#) shall preferably be submitted with the demand; or

(ii) [no change]

(b) and (c) [No change]

Rule 55
Languages (International Preliminary Examination)

55.1 and 55.2 [No change]

55.3 Language and Translation of Amendments and Letters

(a) Subject to paragraph (b), if the international application has been filed in a language other than the language in which it is published, any amendment under Article 34, as well as any letter referred to in Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c), shall be submitted in the language of publication.

(b)~~(a)~~ Where a translation of the international application is required under Rule 55.2;⁷

(i) ~~any amendments which are referred to in the statement concerning amendments under Rule 53.9 and which the applicant wishes to be taken into account for the purposes of the international preliminary examination, and any letter referred to in paragraph (a);⁷ and~~

(ii) any amendments under Article 19 which ~~is are~~ to be taken into account under Rule 66.1(c) or (d) and any letter referred to in Rule 46.5(b);⁷

shall be in the language of that translation. Where such amendments or letters have been or are submitted ~~filed~~ in another language, a translation shall also be submitted ~~furnished~~.

(c)~~(b)~~ If an ~~Where the required translation of an~~ amendment or letter is not submitted in a language as required under ~~referred to in~~ paragraph (a) or (b) is not furnished, the International Preliminary Examining Authority shall invite the applicant to submit ~~furnish~~ the amendment or letter in the required language ~~missing translation~~ within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d)~~(c)~~ If the applicant fails to comply, ~~with the invitation~~ within the time limit under paragraph (c) paragraph (b), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

Rule 62
Copy of the Written Opinion by the International Searching Authority and of Amendments
under Article 19 for the International Preliminary Examining Authority

62.1 *Copy of Written Opinion by International Searching Authority and of Amendments Made before the Demand Is Filed*

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

(i) [no change]

(ii) a copy of any amendment under Article 19, and any statement referred to in that Article, [and the letter required under Rule 46.5\(b\)](#), unless that Authority has indicated that it has already received such a copy.

62.2 *Amendments Made after the Demand Is Filed*

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments, ~~and~~ any statement referred to in that Article [and the letter required under Rule 46.5\(b\)](#). In any case, the International Bureau shall promptly transmit a copy of such amendments ~~and~~ statement [and letter](#) to that Authority.

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.8 [No change]

66.9 *[Deleted] Language of Amendments*

~~(a) Subject to paragraphs (b) and (c), if the international application has been filed in a language other than the language in which it is published, any amendment, as well as any letter referred to in Rule 66.8, shall be submitted in the language of publication.~~

~~(b) If the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, any amendment, as well as any letter referred to in paragraph (a), shall be submitted in the language of that translation.~~

~~(c) Subject to Rule 55.3, if an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall, if practicable having regard to the time limit for establishing the international preliminary examination report, invite the applicant to furnish the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances.~~

~~(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.~~

Rule 70
**International Preliminary Report on Patentability by the International Preliminary
Examining Authority (International Preliminary Examination Report)**

70.1 [No change]

70.2 *Basis of the Report*

(a) to (c) [No change]

(c-*bis*) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter indicating the basis for the amendment in the application as filed, as required under Rule 46.5(b)(iii), Rule 46.5(b)(iii) being as applicable by virtue of Rule 66.8(c), or Rule 66.8(a), as applicable, the report may be established as if the amendment had not been made, in which case the report shall so indicate.

(d) and (e) [No change]

70.3 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) The following replacement sheets and letters shall be annexed to the report:

- (i) each replacement sheet under Rule 66.8 containing amendments under Article 34 and each letter under Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c);
- (ii) each replacement sheet under Rule 46.5 containing amendments under Article 19 and each letter under Rule 46.5; and
- (iii) each replacement sheet under Rule 26.4 as applicable by virtue of Rule 91.2 containing a rectification of an obvious mistake authorized by that Authority under Rule 91.1(b)(iii) and each letter under Rule 26.4 as applicable by virtue of Rule 91.2;

unless any such replacement sheet has been superseded or considered reversed by a later replacement sheet or an amendment resulting in the cancellation of an entire sheet under Rule 66.8(b); and

- (iv) where the report contains an indication referred to in Rule 70.2(e), any sheet and letter relating to a rectification of an obvious mistake which is not taken into account pursuant to Rule 66.4*bis*.

[Rule 70.16, continued]

~~(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 [paragraph \(a\)](#) ~~paragraphs (a) and (a-bis)~~, each superseded or reversed replacement sheet referred to in [that paragraph](#) ~~these paragraphs and any letter referred to in that paragraph relating to such superseded or reversed sheet~~ shall also be annexed to the report where:

- (i) 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);
- (ii) [the relevant superseding or reversing amendment was not accompanied by a letter indicating the basis for the amendment in the application as filed and the report is established as if the amendment had not been made and contains an indication referred to in Rule 70.2\(c-bis\).](#)

In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

Rule 92 Correspondence

92.1 [No change]

92.2 *Languages*

(a) Subject to Rules 55.1 and ~~55.3~~ 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

(b) [No change]

(c) *[Remains deleted]*

(d) and (e) [No change]

92.3 and 92.4 [No change]

[Annex II follows]

ANNEX II

ENTRY INTO FORCE AND
TRANSITIONAL ARRANGEMENTS

It is proposed that the Assembly adopt the following decisions concerning entry into force and transitional arrangements in respect of the proposed amendments of the Regulations set out in Annex I:

- “(a) The amendments of Rules 12.2, 48.2, 53.9, 55.3, 62.1, 62.2, 66.9, 70.2 and 92.2 set out in Annex I shall enter into force on July 1, 2011, and shall apply to international applications whose international filing date is on or after July 1, 2011.
- “(b) The amendments of Rule 49.5 set out in Annex I shall enter into force on July 1, 2011, and shall apply to international applications in respect of which the applicant has performed the acts referred to in Article 22 or Article 39 on or after July 1, 2011, and in respect of which an amendment under Article 19 or 34 was filed on or after July 1, 2009.
- “(c) The amendments of Rule 70.16 set out in Annex I shall enter into force on July 1, 2011, and shall apply to any international preliminary examination report which is completed in accordance with Rule 70.4 on or after July 1, 2011, irrespective of the international filing date of the international application concerned.”

[Annex III follows]

ANNEX III

EXPLANATORY NOTES

1. This Annex sets out more detailed explanations of the proposed amendments of the PCT Regulations set out in Annex I. Proposed decisions concerning entry into force and transitional arrangements are set out in Annex II.

RECTIFICATION OF OBVIOUS MISTAKES AUTHORIZED BY THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

2. It is recalled that, in 2005, the Assembly adopted the following amendments to Rule 70.16(a) (document PCT/A/34/2 Rev., Annex II, page 37):

“(a) Each replacement sheet under Rule 66.8(a) or (b) ~~and~~ each replacement sheet containing amendments under Article 19 ~~and each replacement sheet containing rectifications of obvious errors authorized under Rule 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.”
3. Upon consideration, the wording of Rule 70.16(a) as so amended with effect from April 1, 2007, and as in force today, meets with some concerns, for the reasons outlined in the following paragraphs.
4. Paragraph 98 of Annex V of document PCT/A/34/2 Rev. gave the following explanation for the need to amend Rule 70.16(a):

“98. In view of the fact that any rectification authorized by the competent authority will be published (either as part of the published international application or, under Rule 48.2(i), in the form of a statement reflecting all rectifications, together with a revised front page), there is no longer any need under Rule 70.16 for annexing rectifications authorized by the International Preliminary Examining Authority to the international preliminary examining report, and a further drafting change has therefore been made to the text of the latter Rule, beyond the text as agreed by the Working Group, by deleting the words “and each replacement sheet containing rectifications of obvious errors authorized under Rule 91.1(e)(iii).”
5. The statement that any rectification, no matter which competent authority has authorized it, will be published either as part of the published international application or, under Rule 48.2(i), separately in the form of a statement reflecting all rectifications is erroneous. Where the International Preliminary Examining Authority is the authority competent to authorize the rectification of obvious mistakes under Rule 91.1(b)(iii), it would appear that

Article 38⁴ prevents the publication under Rule 48.2(i) of a statement reflecting the rectification of an obvious mistake in any document which forms part of the “file of the international preliminary examination” (see Article 38(1)).

6. There is no clear definition as to which documents form the “file of the international preliminary examination”. Thus, the question arises whether the file includes, for example, the description, claims and drawings as filed, or just other documents specifically related to the Chapter II procedure, such as, for example, the demand for international preliminary examination or amendments under Article 34.
7. So as to avoid any doubt as to compliance of Rule 48.2(i) with Article 38, it is proposed to amend Rule 48.2(i) by clarifying that this provision does not apply where the rectification of an obvious mistake is authorized by the International Preliminary Examining Authority under Rule 91.1(b)(iii).
8. In addition, so as to ensure that rectifications authorized by the International Preliminary Examining Authority are made available to elected Offices and (by virtue of Rule 94.1(c)) to the general public, it is proposed to amend Rule 70.16 to in effect undo the amendments to that Rule adopted in 2005 and to “reinstate” words to the effect that all rectifications of obvious mistakes authorized by the International Preliminary Examining Authority under Rule 91.1(b)(iii) shall be annexed to the international preliminary examination report.

AMENDMENTS UNDER ARTICLES 19 AND 34 AND ACCOMPANYING LETTERS

9. It is recalled that the Assembly, during its thirty-eighth session held in 2008, adopted amendments of Rules 46.5, 66.8 and 70.16, with effect from July 1, 2009, requiring applicants, in the case of amendments of the claims under Articles 19 and 34, to submit replacement sheets containing a complete set of claims rather than, as under the Regulations in force up to June 30, 2009, replacement sheets only for those sheets of claims which, on account of an amendment, differed from sheets previously filed.
10. It is further recalled that the Assembly, during its thirty-ninth session held in 2009, adopted further amendments of Rules 46.5, 66.8 and 70.16, with effect from July 1, 2010, requiring applicants, in the case of amendments of the claims under Article 19 and in the case of amendments of the claims, the description or the drawings under Article 34, to submit a letter which, *inter alia*, indicates the basis for the amendment in the application as filed. Under those amendments, if the applicant fails to submit such a letter, the International Preliminary Examining Authority may establish the international preliminary report on patentability as if the amendment had not been made.

⁴ “Article 38: Confidential Nature of the International Preliminary Examination”

“(1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4) to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

“(2) Subject to the provisions of paragraph (1) and Articles 36(1) and (3) and 37(3)(b), neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, give information on the issuance or nonissuance of an international preliminary examination report and on the withdrawal or nonwithdrawal of the demand or of any election.”

11. Upon consideration, it would appear that further consequential amendments to the Regulations are required, as outlined in the following paragraphs.
12. It is proposed to amend Rule 49.5(a) so as to clarify that, if the claims have been amended under Article 19, the translation to be furnished by the applicant upon entry into the national phase is to be furnished in the form of a translation of the complete set of claims furnished under Rule 46.5(a) in replacement of all the claims originally filed. By virtue of present Rules 66.8(c), 74.1 and 76.4, the same requirement would apply to any amendment of the claims made under Article 34.
13. It is proposed to amend Rules 53.9, 62.1 and 62.2 so as to ensure that the International Preliminary Examining Authority receives a copy of any letter furnished under Rule 46.5(b) (which, *inter alia*, indicates the basis for any amendment in the application as filed) either directly from the applicant (together with the demand, see Rule 53.9 as proposed to be amended) or from the International Bureau (see Rules 62.1 and 66.2 as proposed to be amended) where the applicant wishes that the Article 19 amendments are to be taken into account for the purposes of the international preliminary examination.
14. In order to ensure that the International Preliminary Examining Authority receives a copy of any letter required under Rule 46.5(b) in a language which is accepted by it for the purposes of international preliminary examination, it is also proposed to amend Rule 55.3 to require the applicant to furnish a translation of the letter into a language accepted by that Authority where it is not in such a language (see Rule 55.3(b), (c) and (d) as proposed to be amended).
15. It is proposed to further amend Rule 70.2(c-*bis*) so as to put it beyond doubt that this Rule also applies in the case of amendments to the claims under Article 19 where the applicant fails to submit the letter indicating the basis for the amendment in the application as filed, as required under Rule 46.5(b)(iii) as applicable by virtue of Rule 66.8(c) (see Rule 70.2(c-*bis*) as proposed to be amended).
16. Finally, it is proposed to amend Rule 70.16 so as to require the International Preliminary Examining Authority to annex the letter under Rule 46.5(b) as applicable by virtue of Rule 66.8(c) to the international preliminary examination report where the Article 19 amendments have been taken into account for the purposes of the international preliminary examination (see Rule 70.16(a) and (b) as proposed to be amended). See also paragraph 18, below.
17. In the context of proposed amendments to Rule 55.3 (see paragraph 14, above), noting the current overlap of contents between present Rules 55.3 and 66.9 (both deal with language requirements for amendments under Article 19 and 34 which are to be taken into account for the purposes of international preliminary examination; the difference appears to be that Rule 55.3 deals with amendments filed together with the demand, whereas Rule 66.9 deals with amendments made after the demand has been filed), it is proposed to in effect merge the contents of both Rules into just one Rule by deleting Rule 66.9 and amending Rule 55.3 so as to include matters which at present are contained in Rule 66.9 but which are not covered by present Rule 55.3. Consequential changes are also proposed to Rules 12.2 (deletion of reference to Rule 66.9) and 92.2 (replacement of reference to Rule 66.9 by reference to Rule 55.3).

ANNEXES TO THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

18. In the context of proposed amendments to Rule 70.16 (see paragraph 16, above), it is also proposed to redraft Rule 70.16(a) completely so as to deal in just one paragraph with all replacement sheets and letters which are to be annexed to the report by the International Preliminary Examining Authority, and to require the authority to annex certain documents which to date are not annexed to the report, for the benefit notably of elected Offices, namely: (i) the letter under Rule 66.8(a) (relating to amendments of the description and drawings); (ii) the letter under Rule 46.5(b) as applicable by virtue of Rule 66.8(c) (relating to amendment of claims; see paragraph 16, above); (iii) replacement sheets containing rectifications of obvious mistakes authorized by the authority as a competent authority under Rule 91.1(b)(iii), and the letter relating to such rectifications (see paragraph 8, above); and (iv) replacement sheets containing rectifications of obvious mistakes which could not be taken into account by the authority (because they were received too late) where the report contains an indication to that effect under Rule 70.2(e).

[Annex IV follows]

ANNEX IV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

(CLEAN TEXT)

Proposed amendments of the PCT Regulations are set out in Annex I, in which additions and deletions are shown, respectively, by underlining and striking-through of the text concerned. This Annex contains, for convenient reference, a “clean” text of the relevant provisions as they would stand after amendment and modification, respectively.

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Rule 12
Language of the International Application
and Translations for the Purposes of International Search
and International Publication

12.1 to 12.1~~ter~~ [No change]

12.2 *Language of Changes in the International Application*

(a) Any amendment of the international application shall, subject to Rules 46.3 and 55.3, be in the language in which the application is filed.

(b) and (c) [No change]

12.3 and 12.4 [No change]

Rule 48
International Publication

48.1 [No change]

48.2 *Contents*

(a) to (h) [No change]

(i) If the authorization by the receiving Office, the International Searching Authority or the International Bureau of a rectification of an obvious mistake in the international application under Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, and the front page shall be republished.

(j) and (k) [No change]

48.3 to 48.6 [No change]

Rule 49
Copy, Translation and Fee under Article 22

49.1 to 49.4 [No change]

49.5 *Contents of and Physical Requirements for the Translation*

(a) For the purposes of Article 22, the translation of the international application shall contain the description (subject to paragraph (a-bis)), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (c-bis) and (e),

(i) [no change]

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended (the claims as amended shall be furnished in the form of a translation of the complete set of claims furnished under Rule 46.5(a) in replacement of all the claims originally filed), and

(iii) [no change]

(a-bis) to (l) [No change]

49.6 [No change]

Rule 53
The Demand

53.1 to 53.8 [No change]

53.9 *Statement Concerning Amendments*

(a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments:

(i) to be taken into account, in which case a copy of the amendments and of the letter required under Rule 46.5(b) shall preferably be submitted with the demand; or

(ii) [no change]

(b) and (c) [No change]

Rule 55
Languages (International Preliminary Examination)

55.1 and 55.2 [No change]

55.3 Language and Translation of Amendments and Letters

(a) Subject to paragraph (b), if the international application has been filed in a language other than the language in which it is published, any amendment under Article 34, as well as any letter referred to in Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c), shall be submitted in the language of publication.

(b) Where a translation of the international application is required under Rule 55.2:

- (i) any amendment and any letter referred to in paragraph (a); and
- (ii) any amendment under Article 19 which is to be taken into account under Rule 66.1(c) or (d) and any letter referred to in Rule 46.5(b);

shall be in the language of that translation. Where such amendments or letters have been or are submitted in another language, a translation shall also be submitted.

(c) If an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall invite the applicant to submit the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

Rule 62

Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority

62.1 Copy of Written Opinion by International Searching Authority and of Amendments Made before the Demand Is Filed

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

- (i) a copy of the written opinion established under Rule 43*bis*.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and
- (ii) a copy of any amendment under Article 19, any statement referred to in that Article, and the letter required under Rule 46.5(b), unless that Authority has indicated that it has already received such a copy.

62.2 Amendments Made after the Demand Is Filed

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments, any statement referred to in that Article and the letter required under Rule 46.5(b). In any case, the International Bureau shall promptly transmit a copy of such amendments, statement and letter to that Authority.

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.8 [No change]

66.9 *[Deleted]*

Rule 70
**International Preliminary Report on Patentability by the International Preliminary
Examining Authority (International Preliminary Examination Report)**

70.1 [No change]

70.2 *Basis of the Report*

(a) to (c) [No change]

(c-*bis*) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter indicating the basis for the amendment in the application as filed, as required under Rule 46.5(b)(iii), Rule 46.5(b)(iii) being applicable by virtue of Rule 66.8(c), or Rule 66.8(a), as applicable, the report may be established as if the amendment had not been made, in which case the report shall so indicate.

(d) and (e) [No change]

70.3 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) The following replacement sheets and letters shall be annexed to the report:

- (i) each replacement sheet under Rule 66.8 containing amendments under Article 34 and each letter under Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c);
- (ii) each replacement sheet under Rule 46.5 containing amendments under Article 19 and each letter under Rule 46.5; and
- (iii) each replacement sheet under Rule 26.4 as applicable by virtue of Rule 91.2 containing a rectification of an obvious mistake authorized by that Authority under Rule 91.1(b)(iii) and each letter under Rule 26.4 as applicable by virtue of Rule 91.2;

unless any such replacement sheet has been superseded or considered reversed by a later replacement sheet or an amendment resulting in the cancellation of an entire sheet under Rule 66.8(b); and

- (iv) where the report contains an indication referred to in Rule 70.2(e), any sheet and letter relating to a rectification of an obvious mistake which is not taken into account pursuant to Rule 66.4*bis*.

[Rule 70.16, continued]

(b) Notwithstanding paragraph (a), each superseded or reversed replacement sheet referred to in that paragraph and any letter referred to in that paragraph relating to such superseded or reversed sheet shall also be annexed to the report where:

- (i) 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);
- (ii) the relevant superseding or reversing amendment was not accompanied by a letter indicating the basis for the amendment in the application as filed and the report is established as if the amendment had not been made and contains an indication referred to in Rule 70.2(c-bis).

In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

Rule 92
Correspondence

92.1 [No change]

92.2 *Languages*

(a) Subject to Rules 55.1 and 55.3 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

(b) [No change]

(c) *[Remains deleted]*

(d) and (e) [No change]

92.3 and 92.4 [No change]

[End of Annex IV and of document]