

International Patent Cooperation Union (PCT Union)

Assembly

**Forty-Second (18th Ordinary) Session
Geneva, September 26 to October 5, 2011**

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

Document prepared by the International Bureau

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 request by the applicant for the retrieval of a priority document from a digital library (proposed amendment of Rule 17.1(b-*bis*));
- (b) the time limit for the furnishing of a correction under Article 11(2) or of a notice confirming the incorporation by reference under Rule 20.6(a) (proposed amendment of Rule 20.7(b));
- (c) the addition of patent documents of the People’s Republic of China to the PCT minimum documentation (proposed amendment of Rule 34); and

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.

(d) the excuse of the delay in meeting certain time limits due to *force majeure* (proposed deletion of Rule 82.2 and proposed addition of new Rule 82*quater*).

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 6 to 13, below, and Annex II. A brief outline of the purpose of each proposed amendment appears in paragraph 5, 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 fourth session, held in June 2011, at which the Working Group agreed on proposed amendments to be submitted to the Assembly for adoption at the present session (see the Summary by the Chair, document PCT/WG/4/16, reproduced in Annex I to document PCT/A/42/1; and the draft report of the session, document PCT/WG/4/17 Prov., reproduced in Annex II to document PCT/A/42/1).

4. The proposed amendments of the PCT Regulations are set out in Annex I to the present document. Where further drafting changes have been included, beyond the text as agreed by the Working Group, attention is drawn to that fact in a footnote. Information concerning the further drafting changes was also posted by the Secretariat on the Working Group’s electronic forum on WIPO’s website² for comments and suggestions by delegations and representatives. All comments received supported the further drafting changes.

5. The purpose of the proposed amendments is outlined briefly in the following subparagraphs. More detailed explanations appear in Annex III.

(a) *Requests by the Applicant for the Retrieval of Priority Document from a Digital Library.* Proposed amendments of Rule 17.1(b-*bis*) are set out in Annex I and explained in Annex III, paragraphs 2 to 7. The proposal is to amend Rule 17.1(b-*bis*) so as to effectively extend the time limit within which the applicant can request the International Bureau to obtain a priority document from a digital library and to remove the (unused) option of requesting that a receiving Office obtain a priority document that way.

(b) *Time limit for the furnishing of a correction under Article 11(2) or of a notice confirming the incorporation by reference under Rule 20.6(a).* Proposed amendments of Rule 20.7(b) are set out in Annex I and explained in Annex III, paragraphs 8 to 10. The proposal is to amend Rule 20.7(b) so as to clarify that this Rule should only apply where *neither* a correction under Article 11(2) *nor* a notice confirming the incorporation by reference under Rule 20.6(a) is received by the receiving Office within the applicable time limit.

(c) *Addition of Patent Documents of the People’s Republic of China to the PCT Minimum Documentation.* Proposed amendments of Rule 34 are set out in Annex I and explained in Annex III, paragraphs 11 and 12. The proposal, made at the request of the Government of the People’s Republic of China, is to amend Rule 34 so as to incorporate patent documents of the People’s Republic of China into the PCT minimum documentation used in carrying out international searches.

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

(d) *Excuse of the Delay in Meeting Certain Time Limits due to Force Majeure.* The proposed deletion of Rule 82.2 and the proposed addition of new Rule 82*quater* are set out in Annex I and explained in Annex III, paragraphs 13 to 19. The proposal is to add to the Regulations a general provision for the excuse of delay in meeting certain PCT time limits due to “*force majeure*” circumstances beyond the control of the applicant.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

6. 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 website³ for comments and suggestions by delegations and representatives. All comments received supported the proposed entry into force and transitional arrangements.

7. Different dates of entry into force are proposed for the amendments set out in Annex I, as set out in the following paragraphs.

8. As regards the proposed amendments of Rule 17.1(b-*bis*) set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2012, and should apply to any international application, irrespective of its international filing date, in respect of which the time limit under amended Rule 17.1(b-*bis*) expires on or after July 1, 2012.

9. As regards the proposed amendments of Rule 20.7(b) set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2012, and should apply to any international application whose international filing date is on or after July 1, 2012.

10. As regards the proposed amendments of Rule 34 set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2012, and should apply to any international application, irrespective of its international filing date, in respect of which an international search is carried out on or after July 1, 2012.

11. As regards the proposed deletion of Rule 82.2, it is proposed that Rule 82.2 should be deleted with effect from July 1, 2012, provided that Rule 82.2 should continue to apply to any international application whose international filing date is before July 1, 2012, in respect of which the six months time limit for the submission of evidence referred to in Rule 82.1(c) as applicable by virtue of Rule 82.2(b) expires on or after July 1, 2012.

12. As regards the proposed addition of new Rule 82*quater* set out in Annex I, it is proposed that new Rule 82*quater* should enter into force on July 1, 2012, and should apply to any international application, irrespective of its international filing date, in respect of which the six months time limit for the submission of evidence referred to in new Rule 82*quater*:1(a) expires on or after July 1, 2012.

13. Draft decisions of the Assembly concerning dates of entry into force and proposed transitional arrangements are set out in Annex II.

³ <http://www.wipo.int/pct-wg/en/index.html>

14. *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]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS⁴

TABLE OF CONTENTS

Rule 17 The Priority Document	2
17.1 <i>Obligation to Submit Copy of Earlier National or International Application</i>	2
17.2 [No change].....	2
Rule 20 International Filing Date	3
20.1 to 20.6 [No change].....	3
20.7 <i>Time Limit</i>	3
20.8 [No change].....	3
Rule 34 Minimum Documentation	4
34.1 <i>Definition</i>	4
Rule 82 Irregularities in the Mail Service.....	5
82.1 [No change].....	5
82.2 [Deleted] Interruption in the Mail Service	5
Rule 82 ^{quater} Excuse of Delay in Meeting Time Limits.....	6
82 ^{quater} .1 <i>Excuse of Delay in Meeting Time Limits</i>	6

⁴ 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 to 13 of the main body of this document and Annex II.

Rule 17 The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*⁵

(a) and (b) [No change]

(b-*bis*) Where the priority document is, in accordance with the Administrative Instructions, made available ~~to the receiving Office or~~ to the International Bureau from a digital library prior to the date of international publication of the international application, the applicant may, ~~as the case may be,~~ instead of submitting the priority document,⁵:

~~(i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or~~

~~(ii) request the International Bureau, prior to the date of international publication, to obtain the priority document from such digital library.~~

~~Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.~~

(c) and (d) [No change]

17.2 [No change]

⁵ Further drafting changes have been made to Rule 17.1(b-*bis*), beyond the text as agreed by the Working Group; see Annex III, paragraph 5.

Rule 20 International Filing Date

20.1 to 20.6 [No change]

20.7 *Time Limit*

(a) [No change]

(b) Where neither a correction under Article 11(2) ~~nor~~ ~~or~~ a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office prior to ~~after~~ the expiration of the applicable time limit under paragraph (a), any such correction or notice received by that Office after the expiration of that time limit but before it ~~that Office~~ sends a notification to the applicant under Rule 20.4(i), ~~that correction or notice~~ shall be considered to have been received within that time limit.

20.8 [No change]

Rule 34
Minimum Documentation

34.1 *Definition*

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) [no change]

(ii) the patents issued by the Federal Republic of Germany, [the People's Republic of China](#), the Republic of Korea and the Russian Federation,

(iii) to (vi) [no change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not [Chinese](#), Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of [the People's Republic of China](#), Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

Rule 82
Irregularities in the Mail Service

82.1 [No change]

82.2 ~~[Deleted] *Interruption in the Mail Service*~~

~~(a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.~~

~~(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organization that he effected the mailing within five days after the mail service was resumed. The provisions of Rule 82.1(c) shall apply *mutatis mutandis*.~~

Rule 82^{quater}
Excuse of Delay in Meeting Time Limits

82^{quater}.1 Excuse of Delay in Meeting Time Limits⁶

(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.

(b) Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.

(c) The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.

[Annex II follows]

⁶ Further drafting changes have been made to Rule 82^{quater}, beyond the text as agreed by the Working Group; see Annex III, paragraph 19.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

1. This Annex sets out proposals, including draft decisions by the Assembly, for dates of entry into force and transitional arrangements in respect of the proposed amendments of the PCT Regulations set out in Annex I (see paragraphs 6 to 13 of the main body of this document).
2. A draft decision that is proposed to be adopted by the Assembly concerning entry into force and transitional arrangements in respect of the amendments appearing in Annex I is set out in paragraph 8, below.

RULE 17.1(B-BIS)

3. As regards the proposed amendments of Rule 17.1(b-bis) set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2012, and should apply to any international application, irrespective of its international filing date, in respect of which the time limit under amended Rule 17.1(b-bis) expires on or after July 1, 2012. Rule 17.1(b-bis) as amended, which in effect extends the time limit within which the applicant can request the International Bureau to obtain a priority document from a digital library, would thus not only apply to any international application filed on or after July 1, 2012, but also to any international application filed before that date in respect of which the (extended) time limit under Rule 17.1(b-bis) as amended has not yet expired.

RULE 20.7(B)

4. As regards the proposed amendments of Rule 20.7(b) set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2012, and should apply to any international application whose international filing date is on or after July 1, 2012. Rule 20.7(b) as amended would thus not apply to any international application whose international filing date is before July 1, 2012.

RULE 34

5. As regards the proposed amendments of Rule 34 set out in Annex I, it is proposed that those amendments should enter into force on July 1, 2012, and should apply to any international application, irrespective of its international filing date, in respect of which an international search is carried out on or after July 1, 2012. Notwithstanding the date of entry into force of the proposed amendments of Rule 34, all International Searching Authorities have expressed their intention to include the relevant documentation in their databases at the earliest possible date and in any event by July 1, 2012.

RULES 82 AND 82QUATER

6. As regards the proposed deletion of Rule 82.2, it is proposed that Rule 82.2 should be deleted with effect from July 1, 2012, provided that Rule 82.2 should continue to apply to any international application whose international filing date is before July 1, 2012, in respect of which the six months time limit for the submission of evidence referred to in Rule 82.1(c) as applicable by virtue of Rule 82.2(b) expires on or after July 1, 2012.

7. As regards the proposed addition of new Rule 82*quater* set out in Annex I, it is proposed new Rule 82*quater* should enter into force on July 1, 2012, and should apply to any international application, irrespective of its international filing date, in respect of which the six months time limit for the submission of evidence referred to in new Rule 82*quater*.1(a) expires on or after July 1, 2012.

PROPOSED DECISIONS

8. 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 Rule 17.1(b-*bis*) set out in Annex I shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which the time limit under amended Rule 17.1(b-*bis*) expires on or after July 1, 2012.
- (b) The amendments of Rule 20.7(b) set out in Annex I, shall enter into force on July 1, 2012, and shall apply to any international application whose international filing date is on or after July 1, 2012.
- (c) The amendments of Rule 34 set out in Annex I, shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which an international search is carried out on or after July 1, 2012.
- (d) Rule 82.2 shall be deleted with effect from July 1, 2012, provided that Rule 82.2 shall continue to apply to any international application whose international filing date is before July 1, 2012, and in respect of which the six months time limit for the submission of evidence referred to in Rule 82.1(c) as applicable by virtue of Rule 82.2(b) expires on or after July 1, 2012.
- (e) New Rule 82*quater* shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which the six months time limit for the submission of evidence referred to in new Rule 82*quater*.1(a) expires on or after July 1, 2012.

[Annex III follows]

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.

REQUESTS BY THE APPLICANT FOR THE RETRIEVAL OF PRIORITY DOCUMENT FROM A DIGITAL LIBRARY

TIME LIMIT TO REQUEST RETRIEVAL OF PRIORITY DOCUMENT

2. The goal underlying the present Rules governing the requirement to furnish a priority document during the international phase of the PCT procedure (see Rules 17.1(a), (b) and (b-*bis*)) is that the priority document should, in normal circumstances, be available for public inspection from the international publication date so that third parties interested in the likely validity of the international application – and, where applicable, the International Preliminary Examining Authority – are able to assess whether the priority claims are supported.

3. Where the applicant, instead of submitting a priority document, requests under Rule 17.1(b-*bis*) that the priority document be obtained from a digital library, it can be retrieved automatically by the International Bureau from a digital library almost immediately, as long as it has been properly made available without any further work being required by the Office from whose digital library the document is to be retrieved. However, the complexity of the current processes for ensuring that the priority document is available from a digital library means that many of requests to retrieve such documents are rendered invalid because the document is initially found not to be available to the International Bureau from the digital library within the current time limit of 16 months from the priority date and the applicant needs to take some action to correct this.

4. The International Bureau will seek to reduce the complexity of these processes, but this will take time and requires agreement between all of the participating Offices in the WIPO Digital Access Service for Priority Documents (DAS). For the sake of simplicity, and so as to provide further flexibility for the applicant in dealing with errors, it is proposed to extend the time limit for making a request under Rule 17.1(b-*bis*) from the current 16 months time limit to the date of international publication.

5. Further drafting changes have been made to Rule 17.1(b-*bis*), beyond the text as agreed by the Working Group. Commas have been inserted, at the end of the paragraph, following the word “Bureau” and the word “publication” (“request the International Bureau, prior to the date of international publication, to obtain the priority document from such digital library”).

OFFICES WHICH MAY BE REQUESTED TO OBTAIN PRIORITY DOCUMENT FROM DIGITAL LIBRARY

6. Rule 17.1(b-*bis*) permits applicants to request either the receiving Office or the International Bureau to retrieve a priority document from a digital library. However, even though this option is provided for on the request form, no receiving Office presently offers this service. This leads to significant confusion and errors, with applicants ticking boxes to request a service which in reality does not exist. Furthermore, as long as the International Bureau has access to the same range of digital libraries as the receiving Office, there is no benefit in the priority document being obtained by the receiving Office. This would simply involve additional processing by the receiving Office to forward the document to the International Bureau, with consequent possibilities for delays and errors.

7. Consequently, it is proposed to delete the option in Rule 17.1(b-*bis*) allowing a request for the receiving Office to obtain the priority document from a digital library. The International Bureau would then encourage Offices with suitable digital libraries to join DAS so that their applicants' documents can be made available to the PCT system that way. Since the International Bureau does not wish to collect a fee for this service, the reference to permitting a fee could be deleted at the same time.

TIME LIMIT FOR THE FURNISHING OF A CORRECTION UNDER ARTICLE 11(2) OR OF A NOTICE CONFIRMING THE INCORPORATION BY REFERENCE UNDER RULE 20.6(A)

8. There appears to be room for a misinterpretation of the provisions of present Rule 20.7(b), dealing with the incorporation by reference of elements or parts of the international applications, which should be closed by an appropriate amendment to the PCT Regulations.

9. When Rule 20.7(b) was added to the PCT Regulations with effect from April 1, 2007, the intention was clearly that it should only apply in the case that *neither* a correction under Article 11(2) *nor* the confirmation of an incorporation by reference is received within the applicable time limit and where the receiving Office consequently is required to send the notification under Rule 20.4(i) that the application is not and will not be treated as an international application. The intention was that it should *not* apply where the applicant corrected the application under Article 11(2) within the applicable time limit, since in such a situation a filing date is accorded and a notification under Rule 20.4(i) that the application is not and will not be treated as an international application is never sent. If Rule 20.7(b) were to apply in this situation, it would mean that the time limit for the applicant to confirm the incorporation by reference of any missing element would never expire since the act which triggers the expiration of that time limit, namely, the sending by the receiving Office of the notification under Rule 20.4(i), would never occur.

10. So as to put the matter beyond doubt, it is proposed to amend Rule 20.7(b) as set out in Annex I to this document.

ADDITION OF PATENT DOCUMENTS OF THE PEOPLE'S REPUBLIC OF CHINA TO THE PCT MINIMUM DOCUMENTATION

11. At the request of the Government of the People's Republic of China, it is proposed to amend Rule 34 so as to include patent documents of the People's Republic of China in the PCT minimum documentation. Document PCT/WG/4/8 sets out the background for the proposal by the People's Republic of China:

"2. The Chinese patent documentation has formed an important component part of the global prior art. Since the first patent application was received on April 1, 1985, the number of patent applications in China has increased rapidly. By December 31, 2010, the accumulated number of patent applications for inventions and utility models in China has, in less than three decades, approached 4.75 million, including 2,330,264 applications for invention patents and 2,417,384 applications for utility models. In 2010, the number of China's invention patent applications reached 390,000, ranking second among all countries and the number of its PCT applications exceeded 12,000, ranking fourth among all countries. According to the statistical data published by WIPO, invention patent applications in China in 1985 accounted for 0.9% of the world total that year, and rose to 18.2% in 2009, showing that the proportion of the Chinese patent documentation in the total of global patent documentation has been experiencing a sharp rise.

“3. The Chinese patent documentation has enriched and broadened the content and scope of global prior art. A large proportion of the Chinese patent applications come from domestic applicants. Since 2003, the number of domestic applications has remarkably exceeded that of foreign ones. For example, in 2010, the proportion of domestic applications for invention patent was nearly 75%. Among the domestic applications, many of them belong to China’s traditional fields of technology, such as traditional Chinese medicine and botanical pesticide, as well as technical areas where China has competitive advantages, for instance, digital communication. According to the statistics published by WIPO, the number of PCT applications from China in the field of digital communication amounted to 20% of the global PCT applications in this area. The technical information contained in most of the Chinese domestic applications can only be obtained by searching the Chinese patent documentation because equivalent applications are not made in other countries, so that the Chinese documentation may be the exclusive source of such technical information. Hence, for PCT International Authorities, searching the Chinese patent documentation will contribute to the improvement of both the quality and completeness of PCT searches.

“4. The quality of Chinese patent documentation data processing has been constantly improved. In recent years, the State Intellectual Property Office of the People’s Republic of China (SIPO) has been devoted to enhancing the quality and efficiency of patent documentation data processing. By establishing a professional data processing team and adopting strict quality control measures, SIPO has produced standardized Chinese patent documentation data in a universal format, which makes reference to the WIPO relevant standards. All of these moves have provided guarantee for the users in timely and efficiently searching and obtaining patent documentation data.

“5. Chinese patent documentation has been digitalized and can be searched and obtained online. Through years of efforts, all Chinese patent documents can now be furnished in electronic form. SIPO has provided English language abstracts of the patent documents of the People’s Republic of China published since 1985 to all other 16 PCT International Authorities, some of which have also already received the full image data of the Chinese patent documents. At present, users worldwide can search and access online to the Chinese patent documents, free of charge, via the official website of SIPO. With online operation of the English Search System for Chinese Patent Documentation and the Chinese-English Machine Translation System for Chinese Patent Documentation, global users have easier and more prompt access to English abstracts and machine-translated specifications of the Chinese patent documents. According to statistics, in 2010, the accumulated total amount of visits to the official website of SIPO by foreign users has reached 77.34 million, in which the visits to the patent search column amounted to 62.21 million. These statistical data show that an increasing number of global users are making use of Chinese patent documents.

“6. The amount, types and format of those patent documents SIPO can provide are as follows:

<i>ST.16 Code</i>	<i>Type</i>	<i>Coverage</i>	<i>Amount</i>	<i>Format</i>
A	Published Patent Applications	1985 - 2011.03.31	1,992,000	TIFF (specification) TXT (bibliographic data)
B	Approved Patent Applications	1985 - 1992	19,000	
C	Granted Patents	1993 - 2010	578,000	
B	Granted Patents	2010 - 2011.03.31	139,000	
	English abstracts	1985 - 2011.01.31	1,954,189	XML

“7. At its eighteenth session in March 2011, the Meeting of International Authorities under the PCT expressed its strong welcome for the proposal to add the Chinese patent documentation to the PCT minimum documentation. It encouraged SIPO to present a proposal to the PCT Working Group including proposals as to the appropriate amendments to the PCT Regulations and to conduct bilateral discussions with the other Authorities to ensure that they had all the necessary information in time to recommend an appropriate date of entry into force as part of a proposal to the PCT Assembly. A proposal needs to be submitted by July in order for it to be discussed at the September/October 2011 session of the Assembly (see paragraphs 84 and 85 of document PCT/MIA/18/16).

“8. SIPO is actively consulting with other International Authorities bilaterally on timely access to and use of the Chinese patent documentation. SIPO is willing to provide necessary support to the International Authorities if they meet any problems in utilizing the Chinese patent documentation.”

12. Annex I contains draft amendments to PCT Rule 34, which would incorporate the patent documents published by SIPO into the PCT minimum documentation. The said documents would include patents and published applications for patents since 1985 as well as the English abstracts thereof, but not utility models.

EXCUSE OF DELAY IN MEETING CERTAIN TIME LIMITS DUE TO *FORCE MAJEURE*

13. In response to the recent series of disasters in Japan, a number of IP offices have announced measures to attempt to assist applicants in meeting their obligations, in particular as they relate to relevant time limits within which to file or react to invitations, etc. These laudable efforts have resulted in the reflection by the International Bureau that the PCT is quite limited in what it can do to help PCT applicants who find themselves in such difficult circumstances; the existing PCT legal framework does not include significant flexibility as regards being able to excuse delay in complying with PCT time limits generally.

14. While the PCT does contain a number of provisions which directly or indirectly provide for excuse of delay in meeting certain time limits in certain circumstances or before certain authorities, none of the present PCT provisions provides a basis for a general excuse of delay in meeting PCT time limits before all relevant authorities such as would be necessary to adequately protect PCT applicants who had suffered something akin to the series of natural disasters in Japan in March.

15. Prompted by recent emergency situations, it is proposed to amend the PCT Regulations in order to provide the receiving Offices, International Authorities and the International Bureau with enhanced flexibility to respond to the effects of emergency situations on PCT applicants.

16. It is proposed to add a new Rule (Rule 82*quater*) containing a general provision which would offer protection to applicants by excusing delays in meeting PCT time limits when that delay resulted from *force majeure* circumstances. The draft new Rule (see Annex I) contemplates a case by case evaluation of applicability by the receiving Office, the International Authorities or the International Bureau. It would not apply to the 12 month period in the Paris Convention (since the priority period is not set by the Regulations but by Article 8 of the PCT and Article 4C of the Paris Convention) nor to the national phase entry time limits (since the minimum time limits are not set by the Regulations but by PCT Articles 22(1) and 39(1)).

17. The draft new Rule requires the applicant to take the relevant action “as soon as reasonably possible” and, in any case, not later than six months after the expiration of the time limit applicable in the given case. Whether the applicant has taken the relevant action “as soon as reasonably possible” is something which should be judged by the relevant Office on the facts of the case. Commonly, this would mean within a short period of the cause of the delay ceasing to apply. For example, in cases where a strike prevented an agent from reaching his Office, it would be expected that the action should in most cases be taken either the next working day or shortly thereafter, depending on how much preparatory work had been disrupted. On the other hand, where a disaster had resulted in the complete destruction of an agent’s files, it would naturally be expected to take longer to reassemble all the necessary documents and systems to allow the necessary action to be taken. The proposed Rule does not specifically refer to the action being taken “as soon as reasonably possible after the removal of the cause of the delay”, because an applicant should still be expected to take reasonable steps to overcome problems in cases where it can be seen that the relevant emergency situation will continue for a considerable period and the applicant is not himself prevented by the emergency from taking remedial action.

18. As a consequence of the addition of new Rule 82*quater*, it is proposed to delete Rule 82.2, which would appear to become unnecessary.

19. Further drafting changes have been made to Rule 82*quater*, beyond the text as agreed by the Working Group. The words “for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau” have been added in paragraph (a) so as to clarify that the Rule is directed only to Offices in their international phase capacities (as a receiving Office and, where applicable, International Authority) and not as designated Offices (where the requirements must be set by the national law). The last sentence of paragraph (a) (“Any such evidence shall be submitted not later than six months after the expiration of the time limit applicable in the given case”) has been moved to paragraph (b) and, consequential on the changes made to paragraph (a), the words “Any such evidence shall be submitted ...” have been replaced with the words “Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be ...”. Furthermore, in paragraph (b), the words “If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee ...” have been replaced with the words “If such circumstances are proven to the satisfaction of the addressee ...”. Finally, the proviso at the end of paragraph (b) (“provided that any such excuse shall have no effect in any designated or elected Office where the processing or examination of the international application has already started”) has been moved into a new paragraph (c), further amended to read: “The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.”

[Annex IV follows]

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.

TABLE OF CONTENTS

Rule 17	The Priority Document	2
17.1	<i>Obligation to Submit Copy of Earlier National or International Application</i>	2
17.2	[No change].....	2
Rule 20	International Filing Date	3
20.1 to 20.6	[No change].....	3
20.7	<i>Time Limit</i>	3
20.8	[No change].....	3
Rule 34	Minimum Documentation	4
34.1	<i>Definition</i>	4
Rule 82	Irregularities in the Mail Service.....	5
82.1	[No change].....	5
82.2	<i>[Deleted]</i>	5
Rule 82 ^{quater}	Excuse of Delay in Meeting Time Limits.....	6
82 ^{quater} .1	<i>Excuse of Delay in Meeting Time Limits</i>	6

Rule 17
The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) and (b) [No change]

(b-*bis*) Where the priority document is, in accordance with the Administrative Instructions, made available to the International Bureau from a digital library prior to the date of international publication of the international application, the applicant may, instead of submitting the priority document, request the International Bureau, prior to the date of international publication, to obtain the priority document from such digital library.

(c) and (d) [No change]

17.2 [No change]

Rule 20
International Filing Date

20.1 to 20.6 [No change]

20.7 *Time Limit*

(a) [No change]

(b) Where neither a correction under Article 11(2) nor a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office prior to the expiration of the applicable time limit under paragraph (a), any such correction or notice received by that Office after the expiration of that time limit but before it sends a notification to the applicant under Rule 20.4(i) shall be considered to have been received within that time limit.

20.8 [No change]

Rule 34
Minimum Documentation

34.1 *Definition*

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) [no change]

(ii) the patents issued by the Federal Republic of Germany, the People’s Republic of China, the Republic of Korea and the Russian Federation,

(iii) to (vi) [no change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Chinese, Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of the People’s Republic of China, Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

Rule 82
Irregularities in the Mail Service

82.1 [No change]

82.2 *[Deleted]*

Rule 82^{quater}
Excuse of Delay in Meeting Time Limits

82^{quater}.1 Excuse of Delay in Meeting Time Limits

(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.

(b) Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.

(c) The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.

[End of Annex IV and of document]