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(PCT UNION)**

**PCT COMMITTEE  
FOR ADMINISTRATIVE AND LEGAL MATTERS**

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**PROPOSED AMENDMENTS OF THE PCT REGULATIONS AND  
MODIFICATIONS OF THE PCT ADMINISTRATIVE INSTRUCTIONS,  
RELATING TO THE DRAFT PATENT LAW TREATY**

*prepared by the International Bureau of WIPO*

## INTRODUCTION

1. This document contains proposals for amendments of the Regulations under the PCT and modifications of the Administrative Instructions under the PCT. While the proposals concern directly the processing of international applications under the PCT, they are made with particular regard to the draft Patent Law Treaty (PLT) that has been under development by the WIPO Standing Committee on the Law of Patents (SCP) and will be submitted as the basic proposal to the Diplomatic Conference for the Adoption of the Patent Law Treaty (“PLT Diplomatic Conference”) to be held in Geneva from May 11 to June 2, 2000.<sup>1</sup>
2. The main purpose of the proposals in this document, so far as the PCT procedure is concerned, is to provide the possibility for applicants, when filing an international application, to satisfy in a simplified way a number of requirements of national law which presently have to be met when the application enters the national phase of processing. In particular, applicants would have the possibility of satisfying the requirements set out in Rule 51*bis*, as proposed to be amended, by way of making certain declarations in the request, as provided for in proposed amendments of Rule 4, using standardized wordings.
3. The draft PLT is designed to streamline and harmonize the administrative requirements of national patent Offices for the filing and processing of national patent applications. Those administrative requirements include the form and content of national patent applications, the type of translations of documents which an applicant may be required to provide to an Office in the course of the processing an application, and the evidence which an applicant may be required to provide to an Office in the course of processing an application.
4. Although the draft PLT is applicable primarily to national patent applications, it incorporates by reference the standards prescribed by the PCT as to the form and contents of international applications. The proposals in this document are in line with the goal of the draft PLT to streamline administrative requirements, and the proposals take into account discussions by the SCP of related matters in connection with the draft PLT.
5. It is envisaged that the proposals, revised as necessary in the light of the discussion by the PCT Committee for Administrative and Legal Matters, will be submitted to the PCT Assembly in early 2000 for adoption prior to the PLT Diplomatic Conference.
6. The proposals have undergone revision after consideration by several meetings of an Ad Hoc Advisory Group convened by the Director General. The Offices invited to the AdvisoryGroup meetings, the proceedings of which were informal, were those of all

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<sup>1</sup> References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. References to “draft PLT Articles” and “draft PLT Rules” are, respectively, to those of the draft Patent Law Treaty (PLT) contained in the basic proposal for submission to the PLT Diplomatic Conference (document PT/DC/3) and of the draft Regulations under the Patent Law Treaty (“draft PLT Regulations”) contained in the basic proposal (document PT/DC/4). Any reference to “national” law, “national” applications, “national” Offices, etc., is to be construed as also including a reference to regional law, regional applications, regional Offices, etc.

International Searching Authorities and International Preliminary Examining Authorities, several Offices which handle large numbers of applications, several Offices from developing countries, and regional Offices. Several non-governmental organizations closely interested in PCT matters were also invited to the Advisory Group meetings.

7. The proposed amendments of the Regulations and modifications of the Administrative Instructions are contained, respectively, in Annexes I and II to this document. Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. In a small number of cases, text the need for which, or the precise wording of which, is in doubt is included in square brackets. Parts of affected Rules which are not proposed to be amended are also included where they are particularly relevant to the provisions proposed to be amended; if they are not included, they are replaced by the indication “[...]”. Comments are included, immediately following the text of the provisions concerned, where it seems that they would be helpful. Draft texts for inclusion in the Notes to the request form are also included in order to explain how the declarations should be completed in practice.

8. A more detailed discussion of the proposals is given in the following paragraphs, as follows:

- (i) *documents and evidence which may be required under national law;*
- (ii) *contents of the international application;*
- (iii) *correction and addition of declarations;*
- (iv) *communication and publication of declarations;*
- (v) *certified translations of international applications;*
- (vi) *translations of priority documents;*
- (vii) *opportunity to comply with national requirements;*
- (viii) *indications concerning registered applicants and agents.*

#### DOCUMENTS AND EVIDENCE WHICH MAY BE REQUIRED UNDER NATIONAL LAW

9. Article 27(1) provides: “No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.” Article 27(2)(ii) specifically enables the national law to require, once the processing of the international application has started in the designated Office, the furnishing of “documents not part of the international application but which constitute proof of allegations or statements made in that application.” As to substantive matters, as distinct from matters of form or contents, Article 27(6) provides: “The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.” The relevant provisions of the Regulations for the purposes of Article 27 are found in Rule 51*bis*.

10. Present Rule 51*bis*.1(a) lists a number of matters relating to which the applicant may be required to furnish documents or evidence under the national law applicable by the designated Office. Although that list is not exhaustive, it provides clarity for both applicants and designated Offices that such items may be required to be furnished by the applicant under the national law applicable by the designated Office.

11. It is proposed to amend Rule 51*bis*.1(a) to clarify the items listed, consistently with Article 27 and with national laws. The chapeau in the Rule is proposed to be amended to refer to Article 27 in general. In addition, several items listed in the Rule are proposed to be re-worded, certain items are proposed to be combined, and one item is proposed to be added, in order to provide clarity as to the substance of what an applicant may be required to furnish and to provide consistency with the amendments proposed to Rule 4 (see below). The matters listed in items (i) to (vi) of proposed amended Rule 51*bis*.1(a) relating to which a designated Office may require further evidence or additional documents include: the identity of the inventor; the applicant's entitlement to apply for or be granted a patent; the applicant's entitlement to claim priority where that applicant is different from the applicant who filed the earlier application the priority of which is claimed; non-prejudicial disclosures or exceptions to lack of novelty; (in certain cases) an oath or declaration of inventorship; and (in certain cases) any government license rights in the invention. Only the item relating to government license rights is entirely new (Rule 51*bis*.1(a)(vi)).

12. Draft PLT Article 6(6) provides that a Contracting Party may require that evidence be filed with its Office in the course of processing the application only where that Office may reasonably doubt the veracity of any matter contained in the application. It is similarly proposed to amend Rule 51*bis* to conform to those proposals in the draft PLT regarding the circumstances under which a designated Office may require an applicant to furnish evidence or additional documents regarding statements made in the international application.

13. Consistent with the approach taken in the draft PLT, it is proposed to limit the ability of a designated Office to require evidence from an applicant under the PCT where the applicant has included a declaration under proposed amended Rule 4.17 or proposed new Rule 4.19. Such a limitation would apply regardless of whether the applicant has filed the declaration together with the international application or furnished the declaration under proposed new Rule 26*ter* after the filing of the international application. Such a limitation is also proposed where the applicant has submitted directly to a designated Office a declaration in accordance with proposed amended Rule 4.17 or proposed new Rule 4.19, relating to events which occurred prior to the time national phase processing of the application began. However, where the designated Office has reasonable doubts as to the veracity of the declaration submitted by the applicant, the designated Office may require the applicant to furnish evidence or additional documents.

14. It is similarly proposed to limit the ability of a designated Office to require the applicant to furnish evidence or additional documents regarding the identity of an inventor where indications regarding the inventor have already been furnished in the request in accordance with Rules 4.1(a)(v) and 4.6, unless the designated Office has reasonable doubts as to the veracity of the indications.

15. A designated Office would not be subject to such a limitation for declarations referred to in Rule 4.18 regarding non-prejudicial disclosures or exceptions to lack of novelty, noting that such matters involve substantive conditions of patentability.

16. Since proposed new Rule 51*bis*.1(a-*bis*) may not be compatible with all national laws applicable by designated Offices, it is proposed to provide the ability for Offices to make a reservation regarding the applicability of proposed new Rule 51*bis*.1(a-*bis*), as provided in proposed new Rule 51*bis*.1(a-*ter*).

17. The draft PLT sets forth certain maximum requirements for national patent applications which national patent Offices may require of applicants. In setting those requirements, the draft PLT expressly relies on the requirements which may be imposed the PCT. Specifically, draft PLT Article 6 provides: “No Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to the requirements relating to form or contents compliance with which under the PCT may be required by the Office of, or acting for, any Contracting State of that Treaty once the processing or examination of an international application has started in the national phase of PCT procedure.”

18. The requirements relating to the form or contents of an international application which a designated Office may require under the PCT are thus incorporated by reference under the draft PLT as permissible requirements which national Offices may require in respect of national applications. The requirements concerned include, in particular, those which apply under Rule 51*bis*.

#### CONTENTS OF THE INTERNATIONAL APPLICATION

19. At present, a PCT applicant has the opportunity to satisfy the national requirements which are expressly set forth in Rule 51*bis*.1(a) only upon or after entry of the international application into the national phase of the PCT procedure, that is, when the designated Office begins to process it. The proposals contained in this document are designed to afford applicants the possibility of satisfying those requirements at the time of filing an international application or later during the international phase.

20. It is proposed to permit applicants to include in the request certain declarations corresponding to the matters set out in 51*bis*.1(a)(i) to (iv), relating to which designated Offices may require evidence or additional documents (see paragraph 10, above). In particular, the proposals would provide applicants with the possibility in certain circumstances of making, in the request, declarations using standardized wording as to: the identity of the inventor; the applicant’s entitlement to apply for and be granted a patent; the applicant’s entitlement to claim priority of an earlier application; non-prejudicial disclosures or exceptions to lack of novelty; and an oath or declaration as to inventorship (see proposed Rules 4.17 to 4.19). It is also proposed to provide for applicants to include a statement in the description as to government license rights in the invention (see proposed Rule 5.1(a)(i), corresponding to proposed Rule 51*bis*.1(a)(vi)).

21. The declarations referred to in Rules 4.17 to 4.19 could only be made in cases where the circumstances can be covered by the standardized wording that is prescribed; in other cases, the applicant would not be able to include such declarations and may be required to furnish documentary evidence to designated Offices in the national phase, as provided for by Article 27 and Rule 51*bis*.1. Where a declaration using standardized wording is made, however, no designated Office would be entitled, in the national phase, to require the applicant to furnish further evidence as to the matter covered by the declaration except where there is a reasonable doubt as to the veracity of the declaration (see proposed Rule 51*bis*.1(a-*bis*)). Thus, where the standardized wordings are appropriate to the circumstances, applicants could include the necessary declarations in the request at the time of filing the international application and avoid having to file, when entering the national phase, multiple similar declarations covering the matters concerned in all designated States.

22. It is thus proposed to amend Rule 4.1(c) to provide that the request may contain declarations in accordance with Rules 4.17 to 4.19 as to matters referred to in Rule 51*bis*.1(a). The allowable standardized wordings of such declarations are set out in proposed amended Rule 4.17 and in proposed new Sections 211 and 212 pursuant to proposed new Rules 4.18 and 4.19. An oath or declaration of inventorship made for the purposes of the designation of the United States of America under Rule 4.19 and Section 212 would have to be signed by the person making it if that person did not sign the request.

23. It is also proposed to amend Rule 5.1(a), which deals with the content of the description of the international application, to provide the possibility to include, if so required by the national law of any designated State, a statement regarding any government license rights in the invention and identify any government contract under which the invention was invented.

24. The proposals also address related issues concerning the processing of such declarations, the correction and later filing of such declarations, and the publication of such declarations and/or their communication to designated Offices.

#### CORRECTION AND ADDITION OF DECLARATIONS

25. In general, it is proposed to permit applicants to correct or add any declaration referred to in Rules 4.17 to 4.19 until the expiration of 16 months from the priority date (or even later, provided that the declaration is received by the International Bureau before the technical preparations for international publication have been completed).

26. Pursuant to proposed new Section 212, an oath or declaration of inventorship referred to in Rule 4.19 which is added under Rule 26*ter*.1(a), and any correction of an oath or declaration under Rule 26*ter*.1(a), would have to be signed by the person concerned.

27. Proposed new Rule 26*ter*.2(a) provides for the receiving Office or the International Bureau to invite the applicant to correct any declaration referred to in Rules 4.17 to 4.19 that is not worded as required by those Rules. The receiving Office and the International Bureau would not, however, have to check such a declaration for its substance or its completeness; such matters would be ones for designated Offices in the national phase. Pursuant to proposed new Rule 26*ter*.2(b), failure to correct a defect, in response to the invitation, within the time limit under proposed new Rule 26*ter*.1(a), would result in the declaration being considered, for the purposes of the international phase of the PCT procedure, not to have been submitted. In such a situation, the applicant would then have to submit any corrected declaration required under the national laws applicable by designated Offices directly to the Offices concerned.

28. Proposed new Rule 26*ter*.3 deals with the processing of declarations. Pursuant to proposed new Rule 26*ter*.3(a), where the International Bureau receives any such declaration referred to in proposed amended Rule 4.17 and proposed new Rules 4.18 and 4.19 before the expiration of the applicable time limit, it shall proceed as provided in proposed new Rules 47.1(a-*ter*) and 48.2(a)(x) and (b)(iv), which concern communication to designated Offices and publication, respectively (see below).

29. Proposed new Rule 26*ter*.3(b) clarifies that any declaration that is received by the International Bureau after the applicable time limit shall be considered not to have been made. In such a case, the International Bureau would notify the applicant that the declaration was

received after the applicable time limit and inform the applicant that the declaration should be submitted by the applicant to the designated Office or Offices concerned.

#### COMMUNICATION AND PUBLICATION OF DECLARATIONS

30. The declarations which are set forth in the proposed amendments to Rule 4 would provide applicants the possibility of satisfying the national law requirements expressly set forth in Rule 51*bis*.1(a). Thus, where a declaration is included in the request, the designated Office or Offices concerned must be informed.

31. In order to inform the designated Office or Offices concerned that a declaration has been included in the request, it is proposed that such declaration be communicated by the International Bureau to the designated Office or Offices concerned and also be mentioned in the published pamphlet (see Rules 47.1(a-*ter*) and 48.2(b)(iv)). However, a declaration regarding non-prejudicial disclosures or exceptions to lack of novelty would be published as part of the pamphlet (see Rule 48.2(a)(x)) and would not be separately communicated. It is also proposed that indications regarding the fact that other declarations that have been included in the request, apart from those regarding non-prejudicial disclosures or exceptions to lack of novelty, be contained in the published pamphlet.

#### CERTIFIED TRANSLATIONS OF INTERNATIONAL APPLICATIONS

32. Draft PLT Article 6(3) provides that a Contracting Party may require a translation of any part of an application that is not in a language accepted by its Office. However, draft PLT Article 6(6) provides that a Contracting Party may require that evidence be filed with its Office in the course of the processing of the application only where that Office may reasonably doubt the accuracy of the translation. Under the draft PLT, such evidence could include a certification of the translation.

33. Draft PLT Article 6(7) also provides that where evidence is required from an applicant, the national Office shall notify the applicant, giving an opportunity to comply with any such requirement, and to make observations, within two months from the date of the notification.

34. At present under the PCT, Rule 51*bis*.2(b) provides that the national law applicable by the designated Office may require that the applicant, upon invitation by the designated Office, furnish a certification of the translation of the international application if the designated Office deems such certification to be necessary, and that the designated Office must give the applicant an opportunity to comply with the requirement which shall be reasonable under the circumstances and shall be fixed in the invitation.

35. Consistent with the approach taken in the draft PLT, it is proposed to limit the ability of a designated Office to require certification of the translation of the international application except where the designated Office reasonably doubts the accuracy of the translation. It is also proposed that if a certification of the translation is required, the designated Office must invite the applicant to provide the certification and the applicant must be given an opportunity to comply with such a requirement within not less than two months from the date of the invitation.

36. Accordingly, it is proposed to amend Rule 51*bis*.2(b) by deleting the present text and to amend Rule 51*bis*.1(d) to provide that no designated Office shall require certification of the

translation of the international application by a public authority or sworn translator except where the designated Office reasonably doubts the accuracy of the translation and, upon an invitation to the applicant, gives an opportunity to comply with any such requirement within not less than two months from the date of the invitation.

#### TRANSLATIONS OF PRIORITY DOCUMENTS

37. Draft PLT Article 6(5) provides that, where the priority of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application, and a translation where the earlier application is not in a language accepted by the Office be filed with the Office in accordance with the Regulations under the draft PLT. Pursuant to draft PLT Rule 4(4), a Contracting Party may require such a translation only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable. Furthermore, pursuant to draft PLT Article 6(7), a Contracting Party may only require such a translation upon invitation by the national Office, within a time limit which shall be not less than two months from the date of the invitation.

38. Consistent with the approach taken under the draft PLT, it is proposed to limit the ability of designated Offices to require that a translation of a priority document be furnished by the applicant to those cases where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

39. Accordingly, proposed new Rule 51*bis*.1(e) provides that the national law applicable by the designated Office may, in accordance with Article 27(6), require that a translation of the priority document be furnished in the language, or in one of the languages of, or a language admitted by, the designated Office only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

40. Since proposed new Rule 51*bis*.1(e) may not be compatible with all national laws applicable by designated Offices, it is proposed to provide the ability to make a reservation regarding the applicability of that proposed new Rule, as provided in proposed new Rule 51*bis*.1(f).

41. It is also proposed to make the procedure before the International Preliminary Examining Authority consistent with the approach taken in the draft PLT with respect to translation requirements. Thus, it is proposed to amend Rule 66.7(b) to restrict the entitlement of an International Preliminary Examining Authority to invite the applicant to furnish a translation of a priority document to cases where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1).

#### OPPORTUNITY TO COMPLY WITH NATIONAL REQUIREMENTS

42. Pursuant to draft PLT Article 6(7), where one or more of the requirements applied by the Contracting Party with respect to the form and contents of an application, translations, and priority documents, or where evidence is required, the national Office shall notify the applicant, giving an opportunity to comply with any such requirement, and to make observations, within the relevant time limit. Pursuant to draft PLT Rule 6(1), the time limit referred to in draft PLT Article 6(7) shall be not less than two months from the date of the notification.



43. At present under the PCT, Rule 51bis.2(a) provides that where any of the requirements referred to in Rule 51bis.1, or any other requirement of the national law applicable by the designated Office which that Office may apply under Article 27(1), (2), (6) or (7), is not already fulfilled prior to the beginning of national phase processing, the applicant shall have an opportunity to comply with that requirement once national phase processing has begun. However, under the present Rule, a designated Office is not required to invite the applicant to comply with the national requirement and there is no guaranteed amount of time within which the applicant may have the opportunity to comply with such requirement.

44. Consistent with the approach taken by the draft PLT, it is proposed to amend Rule 51bis.2(b) to require designated Offices to invite the applicant to comply with any national requirement referred to in Rule 51bis.1, or any other national law requirement which an Office may apply under Article 27(1) or (2), which has not already been fulfilled by the beginning of national phase. It is also proposed that applicants be given not less than two months from the date of the invitation to comply with such national requirement. In recognition of the extra administrative burden placed on designated Offices by the proposed invitation requirement, a designated Office would be entitled to charge a fee for its own benefit for inviting the applicant to comply with national requirements.

#### INDICATIONS CONCERNING REGISTERED APPLICANTS AND AGENTS

45. Draft PLT Rule 10(1)(a)(iii) provides that a Contracting Party may require any communication to a national Office to contain, where the applicant, owner or other interested person is registered with the Office, the number or other indication under which he is so registered. Draft PLT Rule 10(1)(b)(iii) makes a similar provision with respect to representatives (agents).

46. Consistent with the draft PLT, it is proposed to add a new Rule 4.5(e) to provide that, where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered. It is also proposed to add a new Rule 4.7(b) to provide that, where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

47. By virtue of Rule 53.5, indications relating to registration of applicants and agents would also be able to be included in a demand for international preliminary examination.

*48. The PCT Committee for Administrative and Legal Matters is invited to advise the International Bureau as to changes which should be made to the proposals in this document with a view to their submission in revised form to the PCT Assembly in early 2000.*

[Annex I follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

**Rule 4**

**The Request (Contents)**

4.1 *Mandatory and Optional Contents; Signature*

(a) The request shall contain:

[...]

(v) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

[...]

(c) The request may contain:

(i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application,

*[Rule 4.1(c), continued]*

(ii) a request to the receiving Office to [prepare and](#) transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office.

*[COMMENT: The proposed amendment would bring the wording of Rule 4.1(c)(ii) into line with that of Rule 17.1(b).]*

[\(iii\) declarations, as provided in Rules 4.17 to 4.19, as to matters referred to in Rule 51bis.1\(a\).](#)

*[COMMENT: Proposed new Rules 4.1(c)(iii) and 4.17 to 4.19, together with proposed new Sections 211 and 212 of the Administrative Instructions, are intended to provide applicants with the possibility of including in the request declarations relating to certain matters about which designated Offices are entitled to require documents or evidence in the national phase of processing of the international application. Those matters are set out in Rule 51bis.1(a), which is also proposed to be amended. For applicants to make use of this possibility, any such declaration in the request must conform to the standard wording set out in proposed new Rule 4.17 and in proposed new Sections 211 and 212 of the Administrative Instructions made under Rules 4.18 and 4.19, respectively. If a declaration as to such a matter is included in the request, designated Offices are limited, by proposed new Rule 51bis.1(a-bis), in their ability to require documents or evidence in the national phase as to that matter to cases where the designated Office has reasonable doubts about the veracity of statements made in the declaration. Such declarations, if not included in the request when the international application is filed, may be added later under proposed new Rule 26ter.1, which also provides for corrections of such declarations. See proposed new Rule 26ter.2 as to checking by the receiving Office. As to the publication or communication to designated Offices of declarations, see proposed new Rules 47.1(a-ter) and 48.2(a)(x) and (b)(iv).]*

*[DRAFT NOTE FOR REQUEST FORM: It is proposed to include text along the following lines in the Notes to the request form: “The various declarations which may be included in the request are set out in Rules 4.17 to 4.19. Only declarations which conform to the*

*[Rule 4.1(c), continued]*

*standardized wordings set out in, or under, those Rules may be included in the request. If the circumstances are such that those standardized wordings are not applicable, the applicant will not be able to make use of the declarations set out in Rules 4.17 to 4.19 but rather will have to comply with the national requirements concerned upon entry into the national phase.”]*

[...]

#### 4.5 *The Applicant*

[...]

(e) Where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered.

*[COMMENT: The proposed amendment reflects draft PLT Rule 10(1)(a)(iii). The same provision would apply mutatis mutandis, by virtue of existing Rule 53.4, to the demand for international preliminary examination in cases where the applicant is registered with the national Office that is acting as International Preliminary Examining Authority.]*

[...]

#### 4.7 *The Agent*

(a) If agents are designated, the request shall so indicate, and shall state their names and addresses.

(b) Where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

*[COMMENT: The proposed amendment reflects draft PLT Rule 10(1)(b)(iii). The same provision would apply mutatis mutandis, by virtue of existing Rule 53.5, to the demand for international preliminary examination in cases where the agent is registered with the national Office that is acting as International Preliminary Examining Authority.]*

[...]

4.17 [Declarations as to Matters Referred to in Rule 51bis.1\(a\)](#)

[\(a\) Any declaration identifying the inventor \(Rule 51bis.1\(a\)\(i\)\) shall be worded as follows:](#)

[“Declaration identifying the inventor \(Rules 4.17\(a\) and 51bis.1\(a\)\(i\)\):](#)

[... \(name\) is the inventor of the subject matter claimed in, and for which protection is sought by way of, this international application.”](#)

*[COMMENT: Proposed new Rule 4.17(a) provides standardized wording for a declaration as to the inventor (see Rules 4.1(c)(iii) and 51bis.1(a)(i)). Such a declaration would commonly be used in cases where the inventor is not indicated as such in the request under Rules 4.1(a)(v) and 4.6 and where the inventor is not also indicated as applicant (in which case Rule 4.17(b) would apply).]*

*[DRAFT NOTE FOR REQUEST FORM: It is proposed to include text along the following lines in the Notes to the request form: “A declaration in accordance with Rule 4.17(a) is not necessary in respect of any inventor who is indicated as such in Box II or III under Rules 4.1(a)(v) and 4.6. Where the inventor is also indicated as applicant, the declaration under Rule 4.17(b) rather than Rule 4.17(a) is applicable. Ellipses and words in parentheses indicate that information is required to be inserted. More than one inventor may be named in a single declaration, or separate declarations may be made. Declarations may be corrected or added under Rule 26ter after the filing of the international application. For details as to national law requirements regarding identification of inventors, see the relevant National Chapters in the PCT Applicant’s Guide, Volume II. For details as to the oath or declaration*

*[Rule 4.17, continued]*

*by the inventor required by the United States of America as a designated State, see the relevant part of these Notes.”]*

[Rule 4.17, continued]

(b) Any declaration that the applicant is entitled to apply for and be granted a patent (Rule 51bis.1(a)(ii)) shall be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (vi) as is necessary to explain the applicant's entitlement:

“Declaration as to the applicant's entitlement to apply for and be granted a patent (Rules 4.17(b) and 51bis.1(a)(ii)):

... (name) is entitled to apply for and be granted a patent by virtue of the following:

(i) ... (name) is (was) entitled as employer of the inventor, ... (inventor's name)

(ii) an agreement between ... (name) and ... (name), dated ...

(iii) an assignment from ... (name) to ... (name), dated ...

(iv) consent from ... (name) in favor of ... (name), dated ...

(v) a court order issued by ... (name of court), effecting a transfer from ... (name) to ... (name), dated ...



[Rule 4.17(b), continued]

(vi) other transfer of entitlement from ... (name) to ... (name) by way of ...  
(specify kind of transfer), dated ...”

*[COMMENT: Proposed new Rule 4.17(b) provides standardized wording for a declaration as to the applicant’s entitlement to apply for and be granted a patent (see Rules 4.1(c)(iii) and 51bis.1(a)(ii)).]*

*[DRAFT NOTE FOR REQUEST FORM: It is proposed to include text along the following lines in the Notes to the request form: “Include only those items which are applicable, omitting item numbers. Ellipses and words in parentheses indicate that information is required to be inserted. In connection with item (vi), other possible kinds of transfer of entitlement include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the inventor, the order in which items are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant’s entitlement. More than one person may be named in a single declaration, or separate declarations may be made. Declarations may be corrected or added under Rule 26ter after the filing of the international application. For details as to national law requirements regarding the applicant’s entitlement to apply for and be granted a patent, see the relevant National Chapters in the PCT Applicant’s Guide, Volume II. For details as to the oath or declaration by the inventor required by the United States of America as a designated State, see the relevant part of these Notes.”]*

[Rule 4.17, continued]

(c) Any declaration that an applicant is entitled to claim priority of an earlier application (Rule 51bis.1(a)(iii)) shall be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (vii) as is necessary to explain the applicant's entitlement:

“Declaration as to the applicant's entitlement to claim priority (Rules 4.17(c) and 51bis.1(a)(iii)):

... (name) is not indicated as an applicant in respect of earlier application No. ... but is entitled to claim priority of that earlier application by virtue of the following:

(i) ... (name) is (was) entitled as employer of the inventor, ... (inventor's name)

(ii) an agreement between ... (name) and ... (name), dated ...

(iii) an assignment from ... (name) to ... (name), dated ...

(iv) consent from ... (name) in favor of ... (name), dated ...

(v) a court order, issued by .... (name of court), effecting a transfer from ... (name) to ... (name), dated ...

[Rule 4.17(c), continued]

(vi) other transfer of entitlement from ... (name) to ... (name) by way of ...

(specify kind of transfer), dated ...

(vii) the applicant's name changed from ... (name) to ... (name) on ... (date)"

*[COMMENT: Proposed new Rule 4.17(c) provides standardized wording for a declaration as to the applicant's entitlement to claim the priority of an earlier application in respect of which the name of the applicant was not the same as in the international application claiming priority (see Rules 4.1(c)(iii) and 51bis.1(a)(iii)).]*

*[DRAFT NOTE FOR REQUEST FORM: It is proposed to include text along the following lines in the Notes to the request form: "Include only those items which are applicable, omitting item numbers. Ellipses and words in parentheses indicate that information is required to be inserted. In connection with item (vi), other possible kinds of transfer of entitlement include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the applicant in respect of the earlier application, the order in which items are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant's entitlement. More than one person may be named in a single declaration, or separate declarations may be made. Declarations may be corrected or added under Rule 26ter after the filing of the international application. For details as to national law requirements regarding the applicant's entitlement to claim priority of an earlier application, see the National Chapters in the PCT Applicant's Guide, Volume II."]*

4.18 *Declarations as to Non-Prejudicial Disclosures or Exceptions to Lack of Novelty*

The request may contain a declaration as to non-prejudicial disclosures or exceptions to lack of novelty (Rule 51bis.1(a)(iv)) which shall be worded as prescribed in the Administrative Instructions.

*[COMMENT: Proposed new Rule 4.18 and proposed new Section 211 of the Administrative Instructions (see Annex II to this document) provide standardized wording for a declaration as to non-prejudicial disclosures or exceptions to lack of novelty (see Rules 4.1(c)(iii) and 51bis.1(a)(iv)).]*

4.19 *Oath or Declaration of Inventorship*

Where the international application designates a State whose national law requires that national applications be filed by the inventor, the request may contain an oath or declaration of inventorship (Rule 51bis.1(a)(v)) which shall be worded and signed as prescribed in the Administrative Instructions.

*[COMMENT: Proposed new Rule 4.19 and proposed new Section 212 of the Administrative Instructions (see Annex II to this document) provide standardized wording for an oath or declaration of inventorship (see Rules 4.1(c)(iii) and 51bis.1(a)(v)) for the purposes of the designation of a State whose national law requires that national applications be filed by the inventor (in practice, the only such State is the United States of America).]*

4.20 *Additional Matter*

(a) The request shall contain no matter other than that specified in Rules 4.1 to ~~4.16~~ 4.19, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to ~~4.16~~ 4.19 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

*[COMMENT: The proposed amendments are consequential on the proposed amendment to Rule 4.17 and the inclusion of proposed new Rules 4.18 and 4.19.]*

**Rule 5**

**The Description**

5.1 *Manner of the Description*

(a) The description shall first state the title of the invention as appearing in the request and shall:

(i) preferably, if so required by the national law applicable by any designated State, indicate any government license rights in the invention and identify any government contract under which the invention was invented;

(ii) specify the technical field to which the invention relates;

~~(ii)~~ (iii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such art;

~~(iii)~~ (iv) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;

~~(iv)~~ (v) briefly describe the figures in the drawings, if any;

*[Rule 5.1(a), continued]*

~~(v)~~ (vi) set forth at least the best mode contemplated by the applicant for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; where the national law of the designated State does not require the description of the best mode but is satisfied with the description of any mode (whether it is the best contemplated or not), failure to describe the best mode contemplated shall have no effect in that State;

~~(vi)~~ (vii) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry and the way in which it can be made and used, or, if it can only be used, the way in which it can be used; the term “industry” is to be understood in its broadest sense as in the Paris Convention for the Protection of Industrial Property.

*[COMMENT: Rule 5.1(a) is proposed to be amended to expressly enable applicants to include a statement in the description as to government license rights. Such a statement is required by the national law of the United States of America to be included at the beginning of the description where the invention was invented under a government contract.]*

[...]

**Rule 26ter**

**Correction or Addition of Declarations Referred to in Rules 4.17 to 4.19**

26ter.1 Correction or Addition of Declarations

(a) The applicant may correct or add any declaration referred to in Rules 4.17 to 4.19 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

(b) Any oath or declaration referred to in Rule 4.19 which is added under paragraph (a), and any correction under paragraph (a) of such an oath or declaration, shall be signed as prescribed in the Administrative Instructions.

26ter.2 Invitation to Correct Declarations

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds that a declaration referred to in Rules 4.17 to 4.19 is not worded as required by those Rules and, where applicable, signed as required by Rule 4.19 or 26ter.1(b), the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the declaration.



*[Rule 26ter.2, continued]*

(b) If, in response to an invitation under paragraph (a), the applicant does not, before the expiration of the time limit under Rule 26ter.1(a), submit a notice correcting the declaration, that declaration shall be considered not to have been submitted, and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly.

### 26ter.3 Processing of Declarations

(a) Where the International Bureau receives any declaration referred to in Rules 4.17 to 4.19 before the expiration of the time limit under Rule 26ter.1, the International Bureau shall proceed as provided in Rules 47.1(a-ter) and 48.2(a)(x) and (b)(iv).

(b) Any such declaration that is received by the International Bureau after the expiration of the time limit under Rule 26ter.1 shall be considered not to have been submitted. The International Bureau shall notify the applicant accordingly and shall inform the applicant that the declaration should be submitted by the applicant to the designated Office or Offices concerned.

*[COMMENT: Proposed new Rule 26ter provides procedures for the addition or correction of declarations in the request which are referred to in Rules 4.17 to 4.19 (see also Rules 4.1(c)(iii) and 51bis.1(a)). Proposed Rule 26ter thus also provides the applicant with a simplified way of providing evidence of changes with respect to the applicant which occur during the international phase. The recording by the International Bureau of such changes during the international phase would continue to be done under Rule 92bis. It is envisaged that a single form would be promulgated on which the applicant could both request the recording of a change with respect to the applicant pursuant to present Rule 92bis and also make a declaration pursuant to proposed Rule 26ter.1]*

**Rule 47**

**Communication to Designated Offices**

47.1 *Procedure*

(a) The communication provided for in Article 20 shall be effected by the International Bureau.

(a-bis) The International Bureau shall notify each designated Office, at the time of the communication provided for in Article 20, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. Such notification shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.

(a-ter) The notification under paragraph (a-bis) shall include any declaration referred to in Rule 4.17 or 4.19 which is of a kind that the designated Office has informed the International Bureau is required under the national law applicable by the designated Office.

*[COMMENT: Proposed new Rule 47.1(a-ter) provides procedures for communicating any declaration referred to in Rules 4.17 and 4.19 to designated Offices (see also Rules 4.1(c)(iii) and 51bis.1(a)). Declarations referred to in Rule 4.18 would be included in the published pamphlet as a result of the proposed amendments to Rule 48, below.]*

[...]

**Rule 48**

**International Publication**

[...]

48.2 *Contents*

(a) The pamphlet shall contain:

[...]

(ix) any information concerning a priority claim considered not to have been made under Rule 26bis.2(b), the publication of which is requested under Rule 26bis.2(c),

(x) any declaration referred to in Rule 4.18.

*[COMMENT: Proposed new Rule 48.2(a)(x) provides that the pamphlet shall contain any declaration contained in the request that is referred to in proposed new Rule 4.18, that is, declarations regarding non-prejudicial disclosures or exceptions to lack of novelty (See Rules 4.1(c)(iii) and 51bis.1(a)(iv)).]*

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

[...]

[Rule 48.2(b), continued]

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first,

(iv) an indication that the request contains any declaration referred to in Rule 4.17 or 4.19.

*[COMMENT: Proposed new Rule 48.2(b)(iv) provides that the front page of the pamphlet shall contain indications that the request contains any declaration referred to in proposed amended Rule 4.17 or proposed new Rule 4.19, that is, those declarations which do not concern non-prejudicial disclosures or other exceptions to lack of novelty (see Rules 4.1(c)(iii) and 51bis.1(a)).]*

[...]

**Rule 51bis**

**Certain National Requirements Allowed Under Article 27~~(1), (2), (6) and (7)~~**

51bis.1 *Certain National Requirements Allowed*

(a) ~~The documents referred to in Article 27(2)(ii), or the evidence referred to in Article 27(6), which the applicant may be required to furnish under the national law applicable by the designated Office include~~ Subject to paragraph (a-bis), the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

*[COMMENT: The proposed amendments to Rule 51bis.1(a) clarify that the items set forth below may be required in accordance with Article 27 as a whole.]*

- (i) any document relating to the identity of the inventor,

*[COMMENT: See proposed Rule 4.17(a).]*

(ii) any document relating to ~~any transfer or assignment of the right to the application~~ the applicant's entitlement to apply for or be granted a patent,

*[COMMENT: The proposed amendments to item (ii) clarify that a designated Office may require any document relating to the applicant's entitlement to apply for or be granted a patent. The proposed amendments reflect proposed Rule 4.17(b).]*

[Rule 51bis.1(a), continued]

~~(iii) any document containing an oath or a declaration by the inventor alleging his inventorship,~~

[COMMENT: The substance of present item (iii) is proposed to be covered by proposed item (v), below.]

~~(iv) any document containing a declaration by the applicant designating the inventor or alleging the right to the application,~~

[COMMENT: Present item (iv) is proposed to be deleted since the subject matter covered appears to be adequately dealt with in present item (i) and proposed amended item (ii), above.]

~~(v) (iii)~~ any document containing any proof ~~of the right of the~~ that the applicant is entitled to claim priority of an earlier application where ~~he~~ that applicant is different from the applicant ~~having~~ who filed the earlier application ~~the priority of which is claimed,~~

[COMMENT: The proposed amendments to present item (v) provide for re-numbering of the item and clarify that a designated Office may require any document containing any proof of an applicant's right to claim priority of an earlier application. The proposed amendments reflect proposed Rule 4.17(c).]

*[Rule 51bis.1(a), continued]*

~~(vi)~~ (iv) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

*[COMMENT: The proposed re-numbered item (vi) reflects proposed Rule 4.18.]*

(v) where the international application designates a State whose national law requires that national applications be filed by the inventor, any document containing an oath or declaration of inventorship.

*[COMMENT: Proposed new item (v) contains the substance of present (iii) and clarifies that a designated Office may require any document containing an oath or declaration of inventorship. The proposed amendments reflect proposed Rule 4.19.]*

(vi) where the invention was invented as part of the work performed under a contract with the government of the designated State, any document containing a statement indicating any government license rights in the invention and identifying the government contract.

*[COMMENT: Proposed new item (vi) clarifies that a designated Office may require any document containing a statement indicating any government license rights in the invention and identification of the government contract. The proposed amendments reflect proposed new Rule 5.1(a)(i).]*

[Rule 51bis.1, continued]

(a-bis) No designated Office shall require a document or evidence relating to:

(i) any matter referred to in Rule 51bis.1(a)(i), where indications regarding the inventor are contained in the request in accordance with Rules 4.1(a)(v) and 4.6, unless the designated Office has reasonable doubts as to the veracity of the indications;

(ii) any matter referred to in Rule 51bis.1(a)(i) to (iii) or (v), where the request contains a declaration relating to such matter in accordance with Rule 4.17 or 4.19, unless the designated Office has reasonable doubts as to the veracity of the declaration;

(iii) any matter referred to in Rule 51bis.1(a)(i) to (iii) or (v), where the applicant submits directly to the designated Office a declaration relating to such matter in accordance with Rule 4.17 or 4.19 and concerning events which occurred prior to the date on which processing or examination of the international application may start under Article 23 or 40, unless the designated Office has reasonable doubts as to the veracity of the declaration.

*[COMMENT: Proposed new Rule 51bis.1(a-bis) addresses three different situations in which designated Offices are limited in their ability to require documents or evidence from applicants in the national phase. First, proposed item (i) has the effect that if the request already contains indications concerning the inventor, designated Offices may not require documents or evidence regarding the identity of the inventor unless the designated Office has reasonable doubts as to the veracity of the indications contained in the request. Second, proposed item (ii) has the effect that if the request already contains any of the declarations referred to in Rules 4.17 and 4.19, designated Offices may not require documents or evidence regarding matters as to which the declarations were made unless the designated Office has reasonable doubts as to the veracity of the declarations. (Proposed item (ii) thus differs from proposed item (i) in that it concerns the declarations referred to in Rules 4.17 and 4.19 rather than indications regarding the inventor made under Rules 4.1(a)(v) and 4.6.) Third, proposed item (iii) has the effect that, if the applicant has submitted directly to the designated*



*[Rule 51bis.1(a-bis), continued]*

*Office any of the declarations referred to in Rules 4.17 or 4.19 concerning events which occurred prior to the national phase, that designated Office may not require documents or evidence regarding matters as to which declarations were made unless the designated Office has reasonable doubts as to the veracity of the declarations. (Proposed item (iii) thus differs from proposed item (ii) in that it covers situations where the applicant submits the declarations directly to the designated Office rather than where the applicant has included the declaration as part of the request.) Proposed new Rule 51bis.1(a-bis) does not apply to declarations regarding non-prejudicial disclosures or exceptions to lack of novelty referred to in Rule 4.18.]*

(a-ter) If on [date], paragraph (a-bis) is not compatible with the national law applied by the designated Office in so far as that paragraph relates to any matter referred to in Rule 51bis.1(a)(i) to (iii) or (v), that paragraph shall not apply to that Office in relation to that matter for as long as that paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau, specifying the matter or matters concerned, by [date]. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: Proposed new Rule 51bis.1(a-ter) would enable designated Offices to make a reservation regarding the applicability of any matter referred to in Rule 51bis.1(a)(i) to (iii), (v) or (vi).]*

[...]

(d) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the translation of the international application furnished by the applicant under Article 22 be verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the

*[Rule 51bis.1(d), continued]*

translation is complete and faithful. No designated Office shall require certification of the translation of the international application by a public authority or sworn translator except where the designated Office reasonably doubts the accuracy of the translation and, upon an invitation to the applicant, gives an opportunity to comply with any such requirement within a time limit which shall be not less than two months from the date of the invitation.

*[COMMENT: The proposed amendment to Rule 51bis.1(d) would preclude designated Offices from requiring certified translations except where there are reasonable doubts about the accuracy of a translation and only upon an invitation and within a minimum two-month time limit to comply with the requirement to provide such a translation. The invitation and two-month time limit to comply are consistent with draft PLT Article 6(7) and draft PLT Rule 6(1). The proposal addresses the substance of present Rule 51bis.2(b) which, consequently, is proposed to be deleted. See also comments on Rule 51bis.2(b).]*

(e) The national law applicable by the designated Office may, in accordance with Article 27(6), require that a translation of the priority document be furnished in the language, or in one of the languages of, or a language admitted by, the designated Office only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

*[COMMENT: Proposed Rule 51bis.1(e) provides that Offices may require translations of priority documents where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable. This proposed amendment is consistent with draft PLT Rule 4(4). See also the proposed amendments to Rule 66.7 below with respect to translations required by International Preliminary Examining Authorities.]*

*[Rule 51bis.1, continued]*

(f) If on [date], paragraph (e) is not compatible with the national law applied by the designated Office, that paragraph shall not apply to that Office for as long as that paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau by [date]. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: Proposed new Rule 51bis.1(f) would enable designated Offices to make a reservation regarding the applicability of proposed new Rule 51bis.1(e).]*

#### 51bis.2 Opportunity to Comply with National Requirements

(a) Where any ~~of the requirements referred to in Rule 51bis.1, or any other~~ requirement of the national law applicable by the designated Office which that Office may apply under Article ~~27(1), (2),~~ 27(6) or (7) is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.

*[COMMENT: The proposed amendment to Rule 51bis.2(a) deletes the reference to Articles 27(1) and 27(2) from the Rule. Matters which fall under Articles 27(1) and 27(2) are addressed below in the proposed amendments to Rule 51bis.2(b).]*

(b) ~~The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the applicant, upon invitation by the designated Office, furnish a certification of the translation of the international application by a public authority or a sworn translator, if the designated Office deems such certification to be necessary under the~~

*[Rule 51bis.2(b), continued]*

~~circumstances, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.~~ Where any requirement of the national law applicable by the designated Office which that Office may apply under Article 27(1) or (2) is not already fulfilled during the same period within which the requirements under Article 22, or where applicable, under Article 39, must be complied with, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for its own benefit for complying with national requirements in response to the invitation.

*[COMMENT: The text of present Rule 51bis.2(b) is proposed to be deleted since the possibility to require a certified translation of the international application is now included in proposed Rule 51bis.1(d). The proposed text of Rule 51bis.2(b) provides that designated Offices shall invite the applicant to comply with those requirements of national law which may apply under Articles 27(1) and 27(2) which have not already been fulfilled. The proposal also provides for a minimum two-month time limit to comply with such requirements consistent with draft PLT Articles 6(3), 6(6), and 6(7). The proposal provides that the correction procedure may be subject to the payment of a fee to the designated Office.]*

**Rule 66**

**Procedure Before the  
International Preliminary Examining Authority**

[...]

*66.7 Priority Document*

[...]

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may, [where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33\(1\)](#), invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

*[COMMENT: The proposed amendment to Rule 66.7 provides that the International Preliminary Examining Authority may invite the application to furnish a translation of the priority document where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1).]*

[...]

[Annex II follows]

ANNEX II

PROPOSED MODIFICATIONS OF THE  
ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

**Section 211**

**Declarations as to Non-Prejudicial Disclosures**

**or Exceptions to Lack of Novelty**

Any declaration as to non-prejudicial disclosures or exceptions to lack of novelty referred to in Rule 4.18 shall be worded as follows:

“Declaration concerning non-prejudicial disclosures or exceptions to lack of novelty (Rules 4.18 and 51bis.1(a)(iv)):

“... (name) declares that an invention that is the subject of this international application was disclosed as follows:

Nature of disclosure: ...

Date of disclosure: ...

Title of disclosure (if applicable): ...

Place of disclosure (if applicable): ...”

*[Section 211, continued]*

*[COMMENT: Proposed Section 211 provides standardized wording for a declaration as to non-prejudicial disclosures or exceptions to lack of novelty (see Rules 4.18 and 51bis.1(a)(iv)).]*

*[DRAFT NOTE FOR REQUEST FORM: It is proposed to include text along the following lines in the Notes to the request form: “More than one applicant may be named in a single declaration, or separate declarations may be made. The nature of the disclosure may relate to an international exhibition, publication, abuse of a claimed invention or other types of disclosures provided for under applicable national or regional law. For details on national law requirements regarding non-prejudicial disclosures or exceptions to lack of novelty, see the relevant National Chapters in the PCT Applicant’s Guide, Volume II.”]*

**Section 212**

**Oath or Declaration of Inventorship**

An oath or declaration of inventorship (Rule 51bis.1(a)(v)) referred to in Rule 4.19 that is furnished for the purposes of the designation of the United States of America shall be worded as follows:

“Oath or declaration of inventorship (Rules 4.19 and 51bis.1(a)(v)):

I hereby declare that I am the original, first and sole (if only one inventor is listed) or joint (if more than one inventor is listed) inventor of the subject matter which is claimed and for which a patent is sought.

This declaration is directed to the international application of which it forms a part (if filing declaration with application).

This declaration is directed to international application No. PCT/... (if furnishing declaration pursuant to Rule 26ter).

I hereby state that I have reviewed and understand the contents of the description, claims and drawings of said application. I have identified in the request of said application any claim to foreign priority, and I have identified below, under the heading “Prior patents,” any application for a patent or inventor’s certificate filed in a country other than the United States of America



*[Section 212, continued]*

and having a filing date prior to the filing date of the earliest filed application in the request or prior to the international filing date.

I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56.

Further, if this international application is a continuation-in-part application of a prior United States application for patent, I acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the international filing date of the present application. (This paragraph may be omitted if the international application is not a continuation-in-part application of a prior United States application.)

I hereby declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Name: ...

Address of residence (including city, US state (if applicable), and country): ...

Citizenship: ...

[Section 212, continued]

Prior patents: ...

Signature: ... (if not contained in the request, or if oath or declaration is corrected or added under Rule 26ter after the filing of the international application)

Date: ... (of signature which is not contained in the request, or of the oath or declaration that is corrected or added under Rule 26ter after the filing of the international application)”

*[COMMENT: Proposed Section 212 provides standardized wording for an oath or declaration of inventorship (Rules 4.19 and 51bis.1(a)(v)) for the purposes of the designation of a State whose national law requires that national applications be filed by the inventor (in practice, the only such State is the United States of America.)*

*[DRAFT NOTE FOR REQUEST FORM: It is proposed to include text along the following lines in the Notes to the request form: “Words in parentheses indicate instructions to the inventor, and ellipses indicate information which is required to be inserted. All inventors should be named in a single declaration, and bibliographic data, such as address of residence and citizenship, must be included for each inventor. Such a declaration may be added pursuant to Rule 26ter after the filing of an international application. For an oath or declaration filed with the international application, the inventor need not sign and date the oath or declaration if he has signed the request. However, for an oath or declaration corrected or added after the filing of an international application, the inventor must sign the oath or declaration.”]*

[End of Annex and of document]