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DRAFT
PROPOSED AMENDMENTS TO CERTAIN TIME LIMITS IN THE PCT
AND TO THE REGULATIONS UNDER THE PCT

THIRD OF THREE PREPARATORY MEMORANDA OF THE INTERNATIONAL BUREAU

INTRODUCTION

1. The present memorandum is the [third](#) of three documents prepared by the International Bureau within the framework of its study of possible improvements to the Patent Cooperation Treaty (PCT) and submitted to the second session of the PCT Committee for Administrative and Legal Matters.
2. The introduction contained in the first document (PCT/CAL/II/2) applies also to the present document.

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SUBJECT MATTERS OF THE AMENDMENTS PROPOSED IN THIS DOCUMENT

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Chapter 32: Making uniform, and in some cases longer, the time limits
for entering the national phase in designated States

(Concerns Article 22(2) and (3))

Revised proposals

(Former Chapter II, see documents PCT/CAL/I/2, pages 12 to 14,
and PCT/CAL/I/9, paragraph 13)

1. Ad Article 22(2) and (3). It is often—and rightly—said that one of the advantages of the PCT is the fact that the applicant enjoys at least 20 months after the priority date before any national processing of his international application can start (see Articles 22(1) and 23(1)). (Thus, expenses for translations, local agents and national fees are incurred 8 months later than if priority is claimed under the Paris Convention but the PCT is not used.) This 20 month-time limit, however, is subject to an exception which makes the time limit shorter. The exception is provided for in Article 22(2) and applies in the case where the International Searching Authority declares that no international search report will be established. Such cases are rare but when they exist, the exception must be remembered by the applicant. In any case, keeping in mind two different time limits is a complication in itself. There is real danger that the applicant might overlook the requirement under Article 22(2) to enter the national phase within two months from the date of the notification of such declaration sent to the applicant rather than 20 months from the priority date. Furthermore, the short time limit in Article 22(2) also weakens the advantage, flowing from the use of the PCT route, whereby the applicant is given considerable time to reflect upon the desirability of pursuing his application before the designated Offices. Moreover, there seems to be no particularly convincing reason why a shorter time limit in Article 22(2) is necessary. Finally, having the same time limit for the two different situations referred to in paragraphs (1) and (2) of Article 22 could but make it easier for the applicant to remember time limits under the PCT. It is to be noted that the majority of the national Offices, in their capacity of designated Offices, have already made use of the possibility provided under Article 22(3) to extend the time limit under Article 22(2) and have extended it to 20 months from the priority date, thus making it the same as it is under Article 22(1); these are the Offices of Australia, Austria, Democratic People's Republic of Korea, Germany (Federal Republic of), Hungary, Luxembourg, Monaco, Romania, Soviet Union, Switzerland, as well as OAPI. (The Offices of Australia and Hungary have even extended the time limit to 21 months from the priority date.)
2. For all these reasons, it is proposed that the time limit under Article 22(2) should—as in the case of the time limit in Article 22(1)—be 20 months from the priority date. Since there would no longer be any difference between the time limits in paragraphs (1) and (2) of Article 22, it is proposed to delete paragraph (2) and to adapt the wording of paragraph (3) of Article 22 to such deletion.
3. Although these proposals entail amendments in the PCT itself, such amendments may be effected outside a diplomatic conference, namely, by a unanimous decision of the Assembly of the PCT Union or in a vote by correspondence, since Article 47(2) allows “all time limits fixed in Chapters I and II” of the PCT to be modified by such a procedure. Replacing the now existing time limit by another time limit is clearly a modification allowed by Article 47(2). Deleting paragraph (2) and adapting the wording of paragraph (3) to such deletion are consequences of the said modification of a time limit. These amendments can be considered to be a mere change in time limits since the whole paragraph (2) of Article 22 deals with nothing but a time limit.

Article 22

Copy, Translation/and Fee, to designated Offices

- (1) [No change]
- (2) [Deleted]
- (3) Any national law may, for performing the acts referred to in paragraph (1), fix a time limit which expires later than the time limit provided for in that paragraph.

4. [Ad Rules 51.1 and 51.3](#). It is to be noted that the International Bureau no longer proposes that the time limit under Rules 51.1 and 51.3 (for presenting a request initiating any review under Article 25 (of an adverse decision by the receiving Office) and for paying the national fee and furnishing a translation under the same Article) should be the same as the time limit applicable under Article 22. The main reason which prompted the International Bureau, after reconsidering the matter as requested by the Committee, not to maintain such proposal is that the time limit for filing a request under Article 24(2) (to maintain the effect of the international application in cases where such effect is not required to be maintained under Article 25(2)) is the time limit applicable under the national law (see document PCT/CAL/I/9, paragraph 34, last sentence). Since, under most of the national laws which provide for remedies applicable under Article 24(2), the said time limit is the same as that presently provided for in Rules 51.1 and 51.3, it is considered safer for the applicant to have to observe the same time limit where Article 24(2) is applicable or where Article 25 is applicable as the two situations are comparable.

Chapter 33: Making longer the time limit for entering the
national phase in elected States

(Concerns Article 39(1) and Rule 75.1)

Unchanged proposal concerning Article 39(1)

(Former Chapter XVI, see documents PCT/CAL/I/3, pages 38 and 39,
and PCT/CAL/I/9, paragraph 29)

Proposal concerning Rule 75.1

made by the Delegation of the Netherlands

(See document PCT/CAL/I/8)

1. The present text of Article 39(1)(a) provides in effect that the national phase must be entered at the latest at the expiration of 25 months from the priority date. It is proposed to extend this period by five months, so that the time limit becomes 30 months from the priority date. The main reason for this extension would be to allow enough time for the applicant to receive the international preliminary examination report in practically every case before he has to comply with the acts required for the entry into the national phase.
2. If the demand is filed, as is usually the case, during the 19th month from the priority date, the time limit for the establishment of the international preliminary examination report, which is normally 6 months after the start of the international preliminary examination (see present Rule 69.1(a)(i)), expires during the 25th month from the priority date. On the other hand, the applicant must enter the national phase before the elected Office prior to the end of that 25th month. In certain cases, the international preliminary examination report may even be established by as much as two months later (see present Rule 69.1(a)(ii)) that is, after the expiration of the existing 25-month time limit provided for in present Article 39(1)(a). In both cases, the applicant cannot consider the international preliminary examination report before he has to enter the national phase.
3. Even in cases where the demand is filed earlier than the 19th month from the priority date, the existing time limit has, in some cases, proven to be rather tight. Where the priority of an earlier application is claimed in an international application—and this is normally the case—the international search report will be mailed during the 16th month from the priority date. The international preliminary examination usually starts upon receipt by the International Preliminary Examining Authority of amendments under Article 19 or of a notice from the International Bureau that no such amendments have been filed (see Rule 69.1(b)). This occurs usually during the 18th month from the priority date. The time limit for the establishment of the international preliminary examination report expires in such a case during the 24th or 26th month from the priority date—which is too close, or even posterior, to the expiration of the present, 25-month, time limit under Article 39(1)(a).
4. The main purpose of Chapter II of the Treaty is to provide the applicant with an international preliminary examination report before he must incur expenses for translations, local agents and national fees, that is, before entering the national phase. In many cases, the existing time limit of 25 months from the priority date is too short to allow the applicant to benefit from the said report before entering the national phase.
5. It is therefore proposed to extend—as already stated—the time limit under Article 39(1)(a) from 25 months to 30 months from the priority date, which would permit the establishment of the international preliminary examination report in practically all cases some time before the applicant has to enter the national phase.

Article 39

Copy, Translation, and Fee, to Elected Offices

It is proposed that the time limit “25 months from the priority date” in Article 39(1)(a), in fine, be replaced by “30 months from the priority date.”

Rule 75

Withdrawal of the Demand, or of Elections

75.1 Withdrawals

(a) Withdrawal of the demand or all the elections may be effected prior to the expiration of 30 months from the priority date except as to any elected State in which national processing or examination has already started. Withdrawal of the election of any elected State may be effected prior to the date on which examination and processing may start in that State.

(b) [No change]

75.2 and 75.3 [See document PCT/CAL/II/2, page 71]

75.4 [No change]

6. It is recalled that in Chapter 25 of document PCT/CAL/II/3 it is proposed that 9 months be allowed for the preparation of the international preliminary examination report. Compared to the time usually needed by national Offices for patent examination, even the said period of 9 months may appear to be rather short. If, in addition, the time is taken into consideration which will be saved by the elected Offices for any national examination where the international preliminary examination report has been established and has been considered by the applicant prior to the start of national processing, it becomes evident that the proposed extension of the time limit for starting such processing would not constitute an undue delay.

7. It is firmly believed that the proposed change would contribute to a much wider use of Chapter II for the benefit of the applicants and the elected Offices, since international preliminary examination reports would almost always be available before the national processing may start and thus reduce the number of applications reaching the national phase which are unlikely to become patents.

8. It is to be noted that the time limit in Article 39(1)(a) can be modified by a unanimous decision of the Assembly of the PCT Union or in a vote by correspondence under Article 47(2) as indicated in more detail in Chapter 32, paragraph 3, of this document.

9. [Ad Rule 75.1\(a\)](#). The proposed amendment, which consists of replacing the present time limit of 25 months from the priority date by a time limit of 30 months from such date for withdrawing the demand or all the elections, is equal to, and is consequential on, the proposed extension of the time limit under Article 39(1)(a).

Chapter 34: Making it unnecessary for the applicant to transmit copies
of his international application to the designated Offices

(Concerns Rule 49.1)

Proposal unchanged as to substance

(Former Chapter III, see documents PCT/CAL/I/2, pages 16 to 19,
and PCT/CAL/I/9, paragraph 14)

1. Ad Rule 49.1(a-bis). Article 24(1)(iii) provides that the effect of the international application provided for in Article 11(3) (i.e., the same effect as that of a national (or regional) application) shall cease in any designated State with the same consequence as the withdrawal of a national (or regional) application, if the applicant fails, inter alia, to furnish to the designated Office a copy of the international application within the 20-month time limit, unless a copy of the international application has already reached the designated Office through transmittal (under Article 20 and Rule 47.1(a)) by the International Bureau.
2. In practice, however, the designated Offices rely entirely on the communication of the international application by the International Bureau. Where they are not in possession of a copy of the international application at the expiration of the 20-month time limit, they ask the International Bureau to supply a copy of the international application, or they refer to the copy contained in the complete set of all published international applications received by them under Rule 87.2, and they do not, in fact, consider the international application as an application that has lost its Article 11(3) effect only because no copy transmitted by the applicant reached them in time. In other words, and in practice, lack of compliance by the applicant with his obligation to furnish a copy of the international application under Article 22 does not, in fact, entail any adverse consequences for him.
3. However, the legal possibility of such adverse consequences presently exists, and this is a danger that makes the position of the applicant insecure. It is, therefore, proposed that a new rule—Rule 49.1(a-bis)—provide that where the designated Office does not require the applicant to furnish a copy of the international application, it announce it publicly which would have as a consequence that any applicant could rely on the practice.
4. Ad Rule 49.1(a-ter). There may be Contracting States where, even if the said practice is acceptable, a formal declaration under the proposed new Rule 49.1(a-bis) would not be possible without first making a corresponding amendment of their national laws. It is for such States that Rule -49.1(a-ter) is being proposed. That new Rule would have the same practical effect—security for the applicant—as the proposed Rule 49.1(a-bis) and would rely on Article 24(2) as its legal basis.
5. It is to be noted that the amendments proposed to Rule 76.1—which, for Chapter II, corresponds to Rule 49.1—in document PCT/CAL/I/2 are no longer presented. This is due to the fact that the amendments proposed to Rule 76 in Chapter 35, below, would make unnecessary any amendment to that Rule for the purpose of harmonizing its wording to the proposed new text of Rule 49.1.

Rule 49

Copy, Translation and Fee under Article 22

49.1 Notification

(a) [No change]

(a-bis) Any Contracting State not requiring the furnishing, under Article 22, by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau under Rule 47 has not taken place by the expiration of the time limit applicable under Article 22) shall notify the International Bureau accordingly.

(a-ter) Any Contracting State which, pursuant to Article 24(2), maintains, if it is a designated State, the effect provided for in Article 11(3) even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under Article 22 shall notify the International Bureau accordingly.

(b) Any notification received by the International Bureau under paragraphs (a), (a-bis) or (a-ter) shall be promptly published by the International Bureau in the Gazette.

(c) [No change]

49.2 [No change]

49.3 to 49.7 [See pages 15, 17 and 19, below]

Chapter 35: Making it unnecessary for the applicant to furnish translations of the request; making it clear that certain requirements for entering the national phase or to be complied with during the national phase are not allowed under the PCT; and other improvements favoring the applicant in connection with the translation of claims where amendments to the claims have been filed during the international phase and in connection with any failure to translate statements explaining amendments or to translate certain microbiological indications

(Concerns Rules 11.15, 49.3 to 49.7, 76.1 to 76.3 and 76.5)

Revised proposals

(Former Chapters IV and V, see documents PCT/CAL/I/2, pages 20 to 28, and PCT/CAL/I/9, paragraphs 15 and 16)

1. Ad Rule 49.3. The amendment proposed for Rule 49.3—namely, the inclusion of the words “subject to Rules 49. 6(c) and 49.7”—is a consequence of the proposed inclusion of new Rules 49.6 and 49.7(see paragraphs 16 to 24, below).
2. Ad Rule 49.4. The provisions of Article 22(1) list exhaustively the acts that must be performed as a condition for entering the national phase, as was pointed out by the International Bureau in its document PCT/A/V/6 which it presented to the Assembly of the PCT Union at its fifth session held from June 9 to 16, 1980 (see Part II of the said document, headed “Questions Concerning the National Phase”). That the said listing is exhaustive follows also from Article 24(1)(iii), which cites only the acts referred to in Article 22 as acts whose non-performance within the time limit for entering the national phase may result in the loss of the effect of the international application in the designated States (“may” because Article 24(2) enables the designated Office to maintain the effect notwithstanding such non-performance).
3. The applicant who files an international application is entitled to expect—especially having regard to the provisions of Article 24(1)(iii)—that nothing more is required of him prior to the time limit applicable under Article 22 than to pay the national fee, to provide any necessary translation of his application as well as, in certain cases, a copy of that application, and to furnish certain indications concerning the inventor unless they were contained in the request, and he is entitled to expect that he cannot lose his rights if he complies with these conditions.
4. Besides, Article 27(1) expressly excludes any requirement relating to the form or contents of the international application different from or” additional to those which are laid down in the Treaty and the Regulations, be it during the international phase or once national processing of the international application can start and has started (national phase).
5. The International Bureau has learned—from its discussions with the national Offices in connection with its publication of Volume II of the PCT Applicant’s Guide (which deals with the procedure before them as designated and elected Offices) and from letters it receives from users of the PCT—that some designated Offices ask, for allowing the entering of the national phase or during the national phase, for compliance with conditions additional to those permitted by the PCT and the Regulations.
6. Such possible excess requirements (to the extent that they are known) are of three kinds. The first is the use of a special national form for entering the national phase. Such requirement is contrary to Article 22(1) in the sense that it would oblige the applicant to perform an act—namely, to use a special national form—which is not comprised in the exhaustive listing, set forth by that Article, of the acts to be performed for entering the national phase. Naturally, when the applicant wishes to initiate a certain action during the national phase, he may be required to use a special national form for that purpose, as prescribed by the national law, but such a requirement cannot be imposed upon him in connection with the entry into the national

Rule 11

Physical Requirements of the International Application

11.1 to 11.14 [No change]

11.15 Translations

[Deleted]

Rule 49

Copy, Translation and Fee under Article 22

49.1 [See page 13, above]

49.2 [No change]

49.3 Statements under Article 19; Indications under Rule 13bis.4

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall, subject to Rules 49.6(c) and 49.7, be considered part of the international application.

49.4 Use of National Form; Number of Copies; Certification of Translation

(a) No applicant shall be required to use a national form in connection with the performance of the acts referred to in Article 22.

phase. In order to clarify the matter, it is proposed to expressly negate such requirement in connection with the entry into the national phase in what would be a new Rule, namely, [Rule 49.4\(a\)](#). That Rule would not prevent any designated Office from issuing a special national form which could be used in connection with the entry into the national phase, provided the use of such form is optional and not mandatory.

7. The second possible excess requirement is the furnishing of the international application or the translation thereof in more than one copy. Article 22(1) is crystal clear: it requires the furnishing of a copy. Asking for more than one copy would be contrary to Article 22(1) and, since the number of copies in which the international application or the translation thereof are required to be furnished is a formal requirement, it would also be contrary to Article 27(1) which admits no requirements relating to the form of the international application different from or additional to those which are laid down in the Treaty. In the first session of this Committee, one of the participants tried to draw an analogy with the requirement prevailing in some receiving Offices asking for three copies of the international application. However, the analogy is not a correct one since the Treaty does not speak of the number of copies in which the international application has to be filed with the receiving Office, whereas it does speak about the number—and fixes it at one—in which the international application (and its translation, where a translation is required) has to reach each designated Office. Besides, even a receiving Office requiring three copies cannot reject the application filed in one copy; on the contrary, it will have to prepare the missing two copies itself (see Rule 21.1(c)). Nevertheless, an exception is proposed to be allowed, namely, it is proposed that two copies might be required where the applicant seeks two kinds of protection under Article 44. The exception would be justified on the ground that, in reality, in such a case, the international application has the effect of two applications. The exception would be covered by the proposed new Rule 51**bis**.1(c)(see the explanations relating thereto in Chapter 36, paragraph 12, below).

8. The third possible excess requirement is the furnishing of a certification of the translation of the international application by a public authority or a sworn translator. Again, such furnishing may not be required, either as a condition for entering the national phase or at any time during the national phase, since it is a formal requirement and, as such, is at variance with Article 27(1).

9. It is proposed to expressly exclude the two excess requirements outlined in the preceding two paragraphs in what would be a new Rule, namely, [Rule 49.4\(b\)](#).

10. [Ad Rule 49.5\(a\) and \(b\)](#). Article 22(1) provides that a translation of the international application, “as prescribed,” may be required. The words “as prescribed,” whenever used in the Treaty, mean as prescribed in the Regulations (c.f. also Article 58(1)(i)). This permits prescribing in the Regulations not only the languages from or into which a translation may be required but also the determination of the scope of the translation. That scope does not necessarily have to coincide with the contents of an international application as specified under Article 3(2), as confirmed by the fact that Rule 49.3—already as adopted at the Washington Diplomatic Conference—includes, for the purposes of Article 22 and Rule 49, any statement made under Article 19(1) in the contents of the international application although such statement is not among the elements listed in Article 3(2). It is proposed that a new Rule—Rule 49.5(a)—specify the parts that have to be translated. Those would be all the parts of the international application [except the request](#). Requiring translation of the request creates difficulties for the applicant, particularly where no version of the request form exists in the language of the translation. Even where such a version exists, it may not be easily at the disposal of the applicant. On the other hand, lack of translation of the request creates no difficulties for the designated Office since the request is already on a printed form (see Rule 3.1), since the printed form has a uniform content and layout in all languages (see Section 201 of the Administrative Instructions) and since the key words (names and addresses) if written in characters other than those of

[Rule 49.4, continued]

(b) No applicant shall be required, when performing the acts referred to in Article 22 or at any time thereafter,

(i) to furnish the international application or the translation thereof in more than one copy, without prejudice to Rule 51bis.1(c);

(ii) to furnish a certification of the translation of the international application by a public authority or a sworn translator.

49.5 Contents of and Physical Requirements for the Translation

(a) For the purposes of Article 22, the translation of the international application shall contain the description, claims, text matter of drawings (if any) and the abstract.

(b) When furnishing the translation of the international application under Article 22, no applicant shall be required to furnish drawings together with that translation, provided that, where any drawing contains text matter, the translation of that text matter may be furnished on a copy of the original drawing by pasting the translation on such copy of the drawing. The expression "Fig." does not require translation into any language.

(c) No designated Office shall require that the translation of the international application furnished to it under Article 22 comply with physical requirements other than those prescribed for the international application as filed.

49.6 Translation of Amendments and Statements Made under Article 19

(a) If the applicant amended any claims under Article 19 but the translation furnished by him under Article 22 contains only the translation of the claims as filed, the designated Office shall take into account only those claims, unless later amendments are made under Article 28.

the Latin alphabet must also be indicated in characters of the Latin alphabet either as a mere transliteration or through translation into English (see Rule 4.16); the first two requirements allow the easy identification of the kind of indications concerned in the request, whereas the third requirement makes familiarity with alphabets other than the Latin alphabet unnecessary. The fact that the title of the invention appearing in the request would not be translated [there](#) would cause no difficulties since it is always translated as part of the description (see Rule 5.1(a)). By the way, several of the national Offices—those of Denmark, Finland, Hungary, Norway, Romania, the Soviet Union and Sweden—already do not require a translation of the request.

11. Practice has shown that the question what the applicant has to furnish in connection with [drawings](#), when he furnishes a translation of the international application under Article 22, requires clarification. The furnishing of a translation of the drawings makes sense only if and to the extent that the drawings contain text matter, but it does not make sense if the drawings do not contain text matter and, where they contain text matter, it does not make sense in relation with the figurative element of the drawings. This first point is clarified in the proposed new Rule 49.5(a).

12. Another question is whether the applicant, when he furnishes a translation of the international application under Article 22, may be required to furnish an additional copy (additional to the copy contained in the international application as filed) of the drawings or to furnish drawings executed anew. It is proposed to state expressly in what would be a new Rule—Rule 49.5(b)—that such requirement is excluded. Such requirement is excluded because it would oblige the applicant to perform an act which is not comprised in the exhaustive listing, set forth in Article 22(1), of the acts to be performed for entering the national phase. Naturally, if the drawings contain text matter, the applicant must furnish a translation of that text matter and the proposed Rule 49.5(b) is also intended to clarify the manner in which the translation of such text matter may be furnished. It is recalled that Rule 11.11 requires that any words used in a drawing must be so placed that, if translated, they may be pasted over without interfering with any lines of the drawing. Consequently, it is proposed that Rule 49.5(b) provide that the translation of any text matter of a drawing may be furnished on a copy of the original drawing by pasting the translation on that copy. Such manner of furnishing the translation of the text matter of the drawings is, however, optional: the applicant may prefer to furnish the translation separately, or he may even be compelled by circumstances to do so if the text is longer in the translation than in the original language so that pasting the translation on a copy of the original drawing is physically impossible.

13. It is to be noted that, if the applicant amends his application during the national phase, it may be necessary to furnish new drawings. This case, however, is completely different from the case under consideration, which deals with what the applicant is required or may not be required to furnish as a condition for entering the national phase.

14. Finally, it is proposed to expressly exclude in new Rule 49.5(b) the requirement that the expression “Fig.” be translated into any language since that expression is commonly used and understood whatever the language of the international application.

15. [Ad Rules 11.15 and 49.5\(c\)](#). Present Rule 11.15 provides that no designated Office may require that the translation of the international application furnished to it under Article 22 comply with requirements—a word which, in the context of Rule 11, means [physical](#) requirements—other than those prescribed for the international application as filed. That Rule would find a more appropriate place in the Regulations if it were included in the provisions relating to the furnishing of the translation of the international application for the purposes of the entry into the national phase. Consequently, it is proposed to transfer the contents of present Rule 11.15 into what would be a new Rule 49.5(c) and to delete Rule 11.15.

[Rule 49.6, continued]

(b) If the applicant amended any claims under Article 19 but the translation furnished by him under Article 22 contains only the translation of the claims as amended, the designated Office shall invite the applicant to furnish a translation of the claims as filed, if it deems such translation to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(c) Where the translation furnished by the applicant under Article 22 does not contain the translation of any statement made under Article 19(1), the designated Office may disregard such statement.

49.7 Translation of Indications under Rule 13bis.4

Where the translation furnished by the applicant under Article 22 does not contain the translation of any indication furnished under Rule 13bis.4, the designated Office shall, if it deems such translation to be necessary, invite the applicant to furnish a translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

Rule 76

Copy, Translation and Fee under Article 39(1):

Translation of Priority Document

76.1 Notification

[Deleted]

76.2 Languages

[Deleted]

16. [Ad Rule 49.6](#). The inclusion in the Regulations of a new Rule 49.6 is proposed to clarify what is to be translated if the applicant has filed with the International Bureau (under Article 19) amendments to the claims (paragraphs (a) and (b)) and a statement explaining them (paragraph (c)). At present, the practice is not uniform. Some designated Offices (e.g., the Patent Offices of Australia, Denmark, Finland, Luxembourg, Sweden and the Soviet Union) require only a translation of the claims as amended whereas other designated Offices require a translation of both the claims appearing in the international application as filed and the claims as amended. In order to simplify the procedure to be observed for entering the national phase and in order to allow the applicant to save the expense of two translations where only one is required (because the designated Office is satisfied with the translation of the claims as amended since the national (or regional) procedure only relates to the international application as amended (and not to the international application as filed)), it is proposed not to oblige the applicant, [as a condition for entering](#) the national phase, to furnish [both](#) translations, but to specify the consequences of a failure to furnish both translations when entering the national phase.

17. Paragraph (a) of the proposed new Rule 49.6 deals with the case where the applicant has filed amendments but failed, when entering the national phase, to furnish a translation of the claims as amended while having furnished a translation of the claims as filed. In such a case, the applicant should not risk losing his rights. The amendments would then simply be disregarded; in that case, amendments of the same kind could be filed under Article 28 once national processing has started.

18. Paragraph (b) deals with the case where the applicant has filed amendments but failed, when entering the national phase, to furnish a translation of the claims as filed while having furnished a translation of the claims as amended. In such a case, the applicant should not automatically lose his rights. He should, if the designated Office considers it necessary to receive a translation of the claims as filed, have an opportunity to furnish that translation [during](#) the national phase, after having been expressly invited to do so. [For entering](#) the national phase, however, it would be enough to furnish only the translation of the claims as amended.

19. Allowing the designated Office to ask for the translation of the claims as filed is provided since such Office may find it useful to have also the translation of the claims to which the international search report relates in order to identify the extent to which the applicant has taken into account any reference cited in the said report.

20. The proposed procedure would be perfectly viable even in those cases where amended claims are not supported by the description and would appear to go beyond the disclosure in the international application as filed but, in fact, do not do so because what seems to go beyond the said disclosure was contained in the claims as filed. Such cases should be very rare since, if the applicant has drafted his international application properly, the complete disclosure is given in the description. In those exceptional cases where that is not the case, the applicant could always spontaneously furnish a translation of the claims as filed, which permits him to prove that the amended claims do not go beyond the disclosure in the international application as filed. Where the applicant does not spontaneously furnish such a translation, any designated Office could indicate to the applicant that it intends to disallow the amended claims. The applicant could then, by presenting a translation of the claims as filed, prove that the amendments do not go beyond the disclosure in the international application as filed. In any case, where the designated Office is of the opinion that it needs a translation of the claims as filed in addition to the translation of the amended claims, it would invite the applicant to furnish such translation, and it is only if the applicant does not furnish the translation in reply to the invitation that he could lose his rights.

76.3 Statements under Article 19; Indications under Rule 13bis.4

[Deleted]

76.4 [No change]

76.5 Application of Rules 49 and 51bis

Rules 49 and 51bis shall apply, provided that:

(i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) any reference in the said Rules to Article 22 or to Article 28 shall be construed as a reference to Article 39(1) or to Article 41, respectively;

(iii) the words “international applications filed” in Rule 49.1(c) shall be replaced by the words “a demand submitted.”

21. As far as the statement explaining the amendments is concerned, the applicant should not be in jeopardy because of being held not to have filed the required translation if he omits to file a translation of the statement. The fact that this minor defect in the translation may lead to the international application ceasing to have the effect provided for in Article 11(3) in the designated State with the same consequences as the withdrawal of a national application (see Article 24(1)(iii)) is out of proportion with the significance of the statement for the designated Office. In practice, it seems that the Offices probably exercise leniency with regard to the statement but the applicant should not be in the position of having to rely on leniency.

22. It is therefore proposed in paragraph (c) of the new Rule 49.6 that the designated Office may disregard any statement if not translated. Consequently, Article 24(1)(iii) would not apply in such a case. The designated Office would not be obliged to disregard the statement if not translated) it could nevertheless take it into account, for instance, if it was drafted in a language which is understood by the examiners of the designated Office. On the other hand, disregarding the statement would be the only possible sanction in case of failure to furnish a translation thereof.

23. [Ad Rule 49.7](#). The inclusion in the Regulations of a new Rule 49.7 is proposed in order to take care of the special case of microbiological inventions under Rule 13**bis**. That Rule provides, *inter alia*, that, where a reference to a deposited microorganism appears in an international application, the applicant must furnish certain indications, in particular, the date of deposit and the accession number of the deposit. Under the present Regulations, failure to furnish a translation of those indications within the time limit applicable under Article 22 would lead to the applicant losing his rights in the designated State concerned, which seems to be an excessive sanction, particularly in view of the fact that some of those indications (e.g., those mentioned above) do not require translation.

24. It is therefore proposed that failure of the applicant to furnish a translation of the indications furnished under Rule 13**bis**.4 should not automatically lead to a loss of rights but that, where the designated Office considers it necessary to have a translation of any such indication, the applicant be given an opportunity to furnish that translation. It is only where he does not comply with the invitation to furnish a translation that he could lose his rights.

25. [Ad Rules 76.1 to 76.3 and 76.5](#): Present Rules 76.1, 76.2 and 76.3 repeat, in connection with Chapter II of the PCT, what is provided in present Rules 49.1, 49.2 and 49.3 in relation to Chapter I, with a few differences which are necessary in order to take account of the applicability of Chapter II. The proposed amendments to Rules 49.3 to 49.7 should also apply to Chapter II. They could be repeated, with a few differences, in Rule 76. However, it is not proposed to do so. In view of the length of the whole Rule 49 as proposed to be amended, such repetition in Rule 76 would be cumbersome and is, in fact, not necessary. It is therefore proposed to state in what would be a new Rule 76.5 that Rule 49 is applicable to cases pertaining to Chapter II, while indicating the few differences which are to be made in order to take into account the applicability of Chapter II, and to delete Rules 76.1, 76.2 and 76.3. On the other hand, Rule 76.4, which corresponds to the last sentence of Rule 17.2(a), would be maintained. (It is to be noted that the proposed new Rule 76.5 would also make Rule 51**bis**—which is a new Rule proposed to be included in the Regulations and explained in Chapter 36, below—applicable to cases pertaining to Chapter II.)

Chapter 36: Making it clear that certain requirements to be complied with during the national phase must be complied with by the applicant only after entering the national phase and after being invited to comply

(Concerns new Rules 51**bis**.1 and 51**bis**.2)

Revised proposals

(Former Chapter VI, see documents PCT/CAL/I/2, pages 30 to 33, and PCT/CAL/I/9, paragraph 17)

1. The preceding Chapter (Chapter 35) deals with requirements which cannot be imposed on the applicant by the national law of the designated Office as a condition for entering the national phase or at any time during the national phase, because they are contrary either to Article 22(1) or Article 27(1). The present Chapter (Chapter 36) deals with requirements which can be imposed by the national law of the designated Office on the applicant once the national phase has started, because they are in conformity with Article 27(1), (2), (6) or (7), but which cannot be imposed as a condition for entering the national phase, either because Article 27 so provides or because they are contrary to Article 22(1), or for both reasons.
2. Proposed Rule 51**bis**.1 lists all the allowed requirements the International Bureau could think of. If any national Office can think of further requirements, it is invited to make them known so that their inclusion could be considered by the Committee. However, in order to cover also possible cases of which neither the International Bureau nor any national Office can think at the present time, the cases listed are introduced by the words “in particular.” Any such additional cases would also be governed by Rule 51**bis**.2. The essence of Rule 51**bis**.2 is that, whenever an allowed requirement exists, it cannot be imposed as a condition for entering the national phase: if the applicant, when entering the national phase, failed to comply with an allowed requirement, he cannot lose his rights before having been invited by the designated Office to comply with the requirement within a certain time limit. The time limit must be reasonable under the circumstances and must be fixed in the invitation; its duration, however, is governed by the national law. It is only if the applicant failed to comply with the invitation that he can lose his rights. In other words, compliance with any of those allowed requirements may be required, but only after the entry into the national phase and the applicant should, in case of failure to comply with such allowed requirements when entering the national phase, be given an opportunity to comply before the non-compliance may result in a loss of rights.
3. In practice, as can be seen in Volume II of the PCT Applicant’s Guide (which deals with the procedure before the designated and elected Offices), all national Offices—except those of Australia, Japan, the United Kingdom and the United States of America—already apply what is proposed under the new Rule 51**bis**.
4. It is to be noted that, under the new Rule 76.5, which is proposed in Chapter 35 (see paragraph 25, in fine, of the explanations relating to that Chapter), Rule 51**bis** as proposed in the present Chapter would also apply to cases pertaining to Chapter II of the PCT. Consequently, whenever the expressions “designated Office” and “Article 22” are used in the present Chapter, they must be understood as covering also, where appropriate, elected Offices and Article 39.
5. Rule 51**bis**.1(a) lists certain requirements which are allowed under Article 27(2)(ii) or Article 27(6). As can be seen from the words “in particular” which appear just before the listing starts, that listing is not necessarily exhaustive.

Rule 51bis (New)

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 are, in particular:

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

(ii) any document relating to any transfer or assignment of the right to file the application,

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

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

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

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

6. The requirements referred to in [items \(i\) to \(iv\)](#) of Rule 51**bis**.1(a) mention documents relating to the identity of the inventor, his inventorship and the right to file the application.
7. The documents referred to in [item \(v\)](#) of Rule 51**bis**.1(a), namely, those which contain any proof of the right of the applicant to claim priority where he is different from the applicant having filed the earlier application the priority of which is claimed, include any document relating to the identity of the applicant having filed that earlier application.
8. [Item \(vi\)](#) of Rule 51**bis**.1(a) deals with evidence concerning non-pre judicial disclosures or exceptions to lack of novelty. What is meant to be covered here are, for example, the provisions of the European Patent Convention and of the national laws of several European countries under which, for the purposes of evaluating the novelty of the invention, a disclosure of the invention is not taken into consideration if it occurred within six months before the filing date of the application and was due to, or in consequence of, an evident abuse in relation to the applicant or his legal predecessor, or the fact that the applicant or his legal predecessor has displayed the invention at certain exhibitions. Also meant to be covered are provisions such as those of the national law of Japan, under which a disclosure of the invention by the person having the right to obtain a patent does not affect the patentability of the invention if such person files a patent application within six months from the said disclosure. Under those two kinds of provisions, the applicant wishing to avail himself of them must, at least in most cases, furnish a statement to that effect at the time of filing the patent application and, later on, evidence of the veracity of the statement. That evidence would be covered by the proposed new Rule 51**bis**. In other words, the applicant would not lose the possibility to take advantage of the provisions in question if he did not furnish the evidence before or at the time of entering into the national phase. On the other hand, the statement itself would not be covered by the proposed new Rule 51**bis**. It is proposed that the statement, if not contained in the description, should be required to be furnished in the request. This could be achieved by adding a new optional box to the request form or by adding the case of non-prejudicial disclosures among the cases in which the supplemental box may be used, as would be possible with the proposed new text of Rule 4.17(a) (see document PCT/CAL/II/2, page 9). Thus, the evidence would fall under Article 27(2)(ii) as a document constituting proof of a statement made in the international application.
9. [Rule 51**bis**.1\(b\)](#), read in combination with Rule 51**bis**.2, specifies that, if the national law of the designated Office requires the applicant to be represented by an agent having the right to represent applicants before that Office and/or have an address for Service in the designated State, or requires the applicant to duly appoint his agent, such requirements may be imposed upon the applicant only after the entry into the national phase. An applicant entering the national phase without complying with such requirements should not lose his rights before having been invited to comply with them and having failed to so comply. This proposal is made in accordance with Article 27(7), under which the national law of the designated Office may be applied in connection with this issue only “once the processing of the international application has started in the designated Office.” It does not introduce a new principle, but is a mere clarification of the meaning and the consequences of Article 27(7). Likewise, it does not mean that it would not be desirable for the applicant to be represented before the designated Office for the entry into the national phase, even where he is not required to be so represented.
10. As stated in the proposed new Rule 49.4(b)(i), the applicant may not be, as a general rule, obliged to furnish the international application or the translation thereof in more than one copy to the designated Office. However, an exception to that general Rule is proposed to be made in the new [Rule 51**bis**.1\(c\)](#) for the case where the applicant is seeking at the same time in his international application, pursuant to Article 44, two kinds of protection. In such case, the furnishing to the designated Office of one copy of the international application, of the translation thereof or of any document relating thereto may be required for each of the two kinds of protection (see the explanations relating to Chapter 35, paragraph 7, above). If such requirement exists, it may be imposed only during the national phase, however, and not as a condition for entering the national phase.

[Rule 51bis.1, continued]

(b) The national law applicable by the designated Office may, in accordance with Article 27(7), require that

(i) the applicant be represented by an agent having the right to represent applicants before that Office and/or have an address in the designated State for the purpose of receiving notifications,

(ii) the agent, if any, representing the applicant be duly appointed by the applicant.

(c) Notwithstanding Rule 49.4(b)(i), the national law applicable by the designated Office may, in accordance with Article 27(1), require that the international application, the translation thereof or any document relating thereto be furnished in more than one copy if the applicant is seeking two kinds of protection under Article 44.

(d) Notwithstanding Rule 49.4(b)(ii), 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 translation is complete and faithful.

(e) Notwithstanding Rule 49.5(b), the designated Office may, in accordance with Article 27(1), require the applicant to furnish new copies of drawings or to furnish drawings executed anew if the copies of the drawings communicated to it under Article 20 or furnished to it under Article 22 do not admit of direct reproduction by photography, electrostatic processes, photo offset, and microfilming, in any number of copies.

11. [Rule 51bis.1\(d\)](#) deals with the verification of the translation of the international application furnished under Article 22. Verification of a translation means a statement by the applicant or by the translator that, to the best of his knowledge, the translation is complete and faithful. The verification of a translation, as distinguished from the certification of a translation by a public authority or a sworn translator, may be considered as proof under Article 27(2)(ii) of the faithfulness and completeness of the translation, whereas a certification would constitute an additional formal requirement not permitted under Article 27(1) and therefore excluded under Rule 49.4(b)(ii). Again, if the requirement for verification exists, it may be imposed only during the national phase and not as a condition for entering the national phase, since the furnishing of the statement constituting the verification is not included in the exhaustive listing of Article 22(1).

12. It may happen that the quality of the copies of the drawings received by the designated Office under Article 20 or under Article 22 is not sufficient for the purposes of reproduction. This should normally not happen since the quality of the drawings has been checked by the receiving Office and also, when preparing the international publication of the international application, by the International Bureau. For the exceptional case in which the quality of the drawings would not be sufficient, the proposed new [Rule 51bis.1\(e\)](#), which was drafted with due regard to the wording of Rule 11.2(a), allows the designated Office to require the applicant to furnish new copies of the drawings or drawings executed anew. Such situation has nothing to do with the cases covered by the new Rule 49.5(b) proposed in Chapter 35, which defines what the applicant has to furnish in connection with drawings when he furnishes a translation of the international application for the purposes of the entry into the national phase (see the explanations relating to Chapter 35, paragraphs 11 to 14, above).

51bis.2 Invitation to Comply with National Requirements

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 during the same period within which the requirements under Article 22 must be complied with, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

Chapter 37: Making it possible for the applicant to submit the translation of any annex to the international preliminary examination report later than under the present Rules and specifying the consequences of any failure to submit such translation

(Concerns Rule 74.1)

Revised proposal

(Former Chapter XIV, see documents PCT/CAL/I/3, pages 30 to 32, and PCT/CAL/I/9, paragraph 26)

1. The present text of Rule 74.1 consists of one very long sentence covering various alternatives with different time limits applying to the furnishing of translations of any replacement sheet referred to in Rule 70.16, or of translations of any amendment referred to in the last sentence of that Rule, namely, an amendment communicated in a letter which is to be annexed to the international preliminary examination report. The translation must, where Article 39 applies, be furnished together with the translation of the international application within the time limit applicable under Article 39(1) or, if the said replacement sheet or letter has been filed with the International Preliminary Examining Authority less than one month before or even after the furnishing of the translation of the international application, the translation must be furnished within one month after the filing of the replacement sheet or letter with the International Preliminary Examining Authority. Where Article 22 applies for the furnishing of the translation of the international application to an elected Office—and this is the case only in respect of the Japanese Patent Office since Japan is the only Contracting State which has made a declaration under Article 64(2)(a)(i)—a translation of the replacement sheet or letter must be furnished together with the translation of the international application or, if the replacement sheet or letter has been filed with the International Preliminary Examining Authority less than one month before or even after the furnishing of the translation of the international application, the translation must be furnished within one month after the filing of the replacement sheet or letter with the International Preliminary Examining Authority. The Japanese national law, however, requires the furnishing of a translation of the replacement sheet or letter only prior to the expiration of the 25-month time limit fixed at present in Article 39(1)(a)(see Volume II of the PCT Applicant's Guide, paragraph JP.17(iv)).

2. It is proposed to completely revise the text of this Rule to make it more readily understandable. The proposed new text of Rule 74.1 is divided into three paragraphs, the main features of which would be as follows: paragraph (a) deals with the normal case, namely where the furnishing of a translation of the international application is governed by Article 39(1). Paragraph (b) deals with the exception, namely where the furnishing of the translation of the international application is governed by Article 22 (rather than by Article 39(1)) because the elected State has made a declaration under Article 64(2)(a)(i). Paragraph (c) provides that the elected Office must invite the applicant to furnish a translation of the annexes of the international preliminary examination report where he failed to do so within the time limit fixed in paragraphs (a) and (b) •, this would be a new advantage for the applicant.

3. Ad Rule 74.1(a). The proposed new text of Rule 74.1(a) requires the “translation of any annex, referred to in Rule 70.16, of the international preliminary examination report” and no longer a translation of “any replacement sheet referred to in Rule 70.16, or any amendment referred to in the last sentence of that Rule.” The proposed amendment does not involve any change in substance; it only harmonizes the wording of Rule 74.1 with the proposed amendment to the English text of Rule 70.16 (see document PCT/CAL/II/3, Chapter 18, pages 14 and 17) which, as it reads in the proposed amended form, speaks only of “annexes” and defines the content of the annexes. It becomes, therefore, unnecessary to repeat in Rule 74.1 what the annexes to the international preliminary examination report may consist of.

Rule 74

Translations of Annexes of
the International Preliminary Examination Report

74.1 Time Limit

(a) Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), furnish a translation of any annex, referred to in Rule 70.16, of the international preliminary examination report. However, where such report was transmitted to the applicant less than 1 month before, or any time after, the expiration of the said time limit, the applicant shall furnish the translation of any annex within 1 month from the transmittal of the said report.

(b) The time limits fixed in paragraph (a) shall apply also where the furnishing of a translation of the international application to an elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

(c) Where no translation of the annexes referred to in Rule 70.16 was furnished to the elected Office within the applicable time limit fixed in paragraphs (a) and (b), that Office, if it deems such translation to be necessary, may invite the applicant to furnish the required translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. If no translation has been furnished within that time limit, the elected Office shall take into account only the translation of the international application furnished under Article 39(1), unless later amendments are made under Article 41.

4. At the same time, it is proposed to change the time limit for the furnishing of a translation of the said annexes. The present Rule 74.1 requires, in principle, the furnishing of the translation of the said annexes together with the furnishing, under Article 39, of the translation of the international application. This principle remains unchanged. The proposed change concerns the present one-month time limit for the later furnishing of the translation of the annexes. The present one-month time limit starts on the date of filing the amendments with the International Preliminary Examining Authority and it expires in some cases even before the international preliminary examination report has been established or received by the applicant and the elected Office. However, the furnishing of a translation of the annexes to the said report makes sense only if the report itself has been established, as is clear from the wording of Article 36(3)(b) (which provides for the transmittal of the translation of the [annexes](#) to the report rather than of the amendments filed with the International Preliminary Examining Authority). Moreover, the applicant having to furnish the translation of the annexes should be aware of what, in fact, has been annexed by the International Preliminary Examining Authority before such furnishing. It is therefore proposed to amend the existing one-month time limit under Rule 74.1 by changing the starting date from the date of filing of the amendments to the date of transmittal of the report.

5. [Ad Rule 74.1\(b\)](#). As already stated in paragraph 2, above, this Rule concerns the cases where a declaration has been made by a Contracting State under Article 64(2)(a)(i), that is, at present, Japan. It is proposed to apply the same time limits for the furnishing of translations [of the annexes](#) of the international preliminary examination report as under Rule 74.1(a)*. The reasons are the same as those given in connection with the proposed new Rule 74.1(a): the applicant should know what has been annexed by the International Preliminary Examining Authority to its report before he is required to furnish a translation thereof.

6. [Ad Rule 74.1\(c\)](#). The furnishing of a translation of the [annexes](#) to the international preliminary examination report is not governed by Article 39(1). That Article applies only to the furnishing of a translation of the international application as filed or, where amended under Article 19(1), as amended. The translation of the annexes to the international preliminary examination report must be furnished pursuant to Article 36(3)(b). The sanction provided for the non-furnishing of a translation of the international application in Article 39(2) does not apply to the failure to furnish a translation of the annexes to the international preliminary examination report.

7. To give effect to the provision of Article 36(3)(b), for which the present text does not provide for any sanction, it is proposed that the applicant should be invited to furnish the translation if he failed to do so within the applicable time limit fixed in Rule 74.1(a) and (b) and that, if the applicant fails to comply with the invitation, the elected Office may disregard the changes made to the international application before the International Preliminary Examining Authority and, unless the applicant presents further amendments under Article 41, take into account only the translation of the international application furnished under Article 39(1).

8. In the proposed new Rule, the language into which a translation must be furnished has not been expressly prescribed, since it is believed that it goes without saying that the language must be the same as the language notified under Rule 76.1(a)(i), although this Rule refers only to Article 39(1) and not to Article 36(3)(b).

*

As far as Japan is concerned, the proposed amendment would only cause a minimal change, since Japan already admits that the Japanese translation of the annexes to the international preliminary examination report be furnished by the expiration of 25 months from the priority date, which, in most cases, will coincide with the proposed time limit. Naturally, the obligation of the applicant to furnish a Japanese translation of the [international application](#) by the expiration of 20 months from the priority date would not be affected by the proposed amendment.

Chapter 38: Making it clear in which cases Contracting States must
excuse delays in meeting time limits or rectify an error
made by an international authority

(Concerns new Rules 82**bis**.1, 82**bis**.2, 82**bis**.3 and 82ter.1)

Revised proposals

(Former Chapter XVII, see documents PCT/CAL/I/3, pages 40 to 43,
and PCT/CAL/I/9, paragraphs 30 and 31))

1. Ad Rule 82**bis**.1. Article 48 deals with excusing the missing of time limits. Paragraph (1) of that Article speaks about “any time limits fixed in this Treaty [that is, the PCT] or the Regulations [that is, the PCT Regulations],” whereas paragraph (2) speaks—in both of its two ((a) and (b)) subparagraphs—of “any time limit.” Practical experience has shown that there is some uncertainty about the meaning of the expression “any time limit” used in paragraph (2) and that, in particular, some interpret the latter expression as if it were also qualified by the words “fixed in this Treaty or the Regulations.” But since that qualification does not appear in paragraph (2), the meaning of “any time limit” is obviously broader in paragraph (2) than in paragraph (1) and, if correctly interpreted, “any time limit” appearing in paragraph (2) cannot but mean all the time limits relevant in a procedure covering an international application and not only time limits fixed in the PCT or the Regulations.
2. The proposed new Rule 82**bis**.1 is intended to make all this clear by referring to the various kinds of time limits falling within the realm of Article 48(2). There are three kinds of such time limits and they are referred to in subparagraphs (i), (?) and (iii) of the proposed Rule.
3. The first kind are the time limits fixed in the Treaty or the Regulations. They comprise in particular the time limits:
 - for entering the national phase (Articles 22 and 39(1))
 - for electing a Contracting State in order to obtain the delaying effect of Chapter II of the PCT (Articles 39(1)(a) and 40(1))
 - for furnishing the application number of the earlier application the priority of which is claimed (Rule 4.10 (c))
 - for complying with the invitation of the receiving Office to ask for the cancellation of the declaration of priority or for the correction of the filing date of the earlier application (Rule 4.10 (d))
 - for furnishing certain indications in connection with microbiological inventions (Rule 13**bis**.4)
 - for paying the basic fee, the designation fee and the search fee (Rules 15.4 and 16.1)
 - for paying any amount charged to the International Bureau (Rule 16**bis**3.2(a))
 - for submitting the priority document or requesting the receiving Office to transmit it (Rule 17.1)
 - for furnishing papers completing the international application (Rule 20.2(a)(i))
 - for furnishing missing drawings (Rule 20.2(a)(iii))
 - for the record copy to be received by the International Bureau (Rule 22.3)
 - for submitting arguments when the receiving Office intends to make a declaration under Article 14(4)(Rule 29.4)
 - for withdrawing the international application, designations or the priority claim during the international phase (Rules 32.1(a) and 32**bis**.1(a))

Rule 82bis (New)

Excuse by the Designated or Elected State of Delays
in Meeting Certain Time Limits

82bis.1 Meaning of “Time Limit” in Article 48(2)

The reference to “any time limit” in Article 48(2) shall be construed as comprising a reference;

(i) to any time limit fixed in the Treaty or these Regulations;

(ii) to any time limit fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau or applicable by the receiving Office under its national law;

(iii) to any time limit fixed by, or in the national law applicable by, the designated or elected Office, for the performance of any act by the applicant before that Office.

82bis.2 Provisions to which Article 48(2) Applies

The provisions of the national law which is referred to in Article 48(2) concerning the excusing of any delay in meeting any time limit are those provisions which provide for reinstatement of rights, restoration, restitutio in integrum or further processing in spite of non-compliance with a time limit, and any other provision providing for the extension of time limits or for excusing delays in meeting time limits. Any reference in the national law to the performance of an act before the national Office shall be construed as comprising a reference to the performance of an act before any other national Office, or before any intergovernmental authority, competent under the Treaty.

- for commenting on the abstract established by the International Searching Authority (Rule 38.2(a))
- for requesting copies of documents cited in the international search report (Rule 44.3(a))
- for amending claims during the international phase (Rule 46.1)
- for requesting the sending of documents in the file (Rule 51.1)
- for paying the national fee and furnishing the appropriate translation (Rule 51.3)
- for amending the international application before the designated Office (Rule 52.1(a) and (b))
- for submitting a translation of the international application to the International Preliminary Examining Authority (present Rule 55.2(b) and (d))
- for paying the handling fee and the supplement to the handling fee (Rules 57.3, 57.4 and 57.5)
- for correcting defects in the demand or in later elections (Rules 60.1 and 60.2)
- for submitting a copy of the priority document and a translation thereof to the International Preliminary Examining Authority (present Rule 66.7(c))
- for requesting copies of documents cited in the international preliminary examination report (Rule 71.2(a))
- for furnishing a translation of the annexes to the international preliminary examination report (Rule 74.1)
- for withdrawing the demand or elections (Rule 75.1(a))
- for amending the international application before the elected Office (Rules 78.1(a) and 78.2)
- for submitting evidence of mailing and a substitute document or” letter (Rule 82.1(c))
- for requesting rectification of the request in case of an omitted designation (proposed Rule 91.1(i))
- for furnishing the contents of a document sent by certain means of communication (Rule 92.4(a))
- for requesting certain changes (proposed Rule 92bis.2(b)).

4. The second kind of time limits covered by Article 48(2) would comprise the time limits fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, or applicable by the receiving Office under its national law, namely, the time limits:

- for paying the transmittal fee (Rule 14.1(b))
- for making a late payment of the basic fee, the designation fee and the search fee (Rules 15.4 and 16.1)
- for correcting defects under Article 11(Rule 20. 6(b))
- for correcting defects under Article 14(Rule 26.2)
- for paying additional fees to the International Searching Authority (Rule 40.3)

82bis.3 Excuse of Delays Where They Can be Traced to an Error of an International Authority

If the applicant proves to the satisfaction of any designated or elected Office that any delay in meeting the time limit applicable under Article 22 or Article 39(1) is due to an error made by the receiving Office, by the International Searching Authority, by the International Preliminary Examining Authority or by the International Bureau, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would excuse the delay under the national law or national practice, the said Office shall excuse the delay and maintain the effect of the international application provided for in Article 11(3).

- for commenting on the translation made by the International Searching Authority (Rule 48.3(b))
- for paying the “preliminary examination fee to the International Preliminary Examining Authority (Rules 58.1 and 58.2)
- for replying to a written opinion of the International Preliminary Examining Authority (Rule 66.2(d))
- for restricting the claims or paying additional fees to the International Preliminary Examining Authority (Rule 68.2)
- for submitting a letter accompanying a paper to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau (Rule 92.1(b)).

5. The third kind of time limits covered by Article 48(2) would comprise the time limits fixed by the designated or elected Office, or fixed in the national law applicable by that Office, for the performance of any act by the applicant before the said Office, in particular, the time limits:

- for adapting the international application to the requirements of the national law concerning utility models (Rules 6.5, 13.5 and 78.3)
- for furnishing drawings not necessary for the understanding of the invention (Rule 7.2)
- for furnishing certain indications in connection with microbiological inventions (Rules 13**bis**.4 and 13**bis**.7(a))
- for furnishing a certified translation of the priority document, possibly together with a copy of the priority document (Rules 17.2(a) and 76.4)
- for furnishing the translation of certain elements of the international application (proposed Rules 49.6(b) and 49.7)
- for complying with certain requirements allowed under Article 27(1), (2), (6) and (7)(proposed Rule 51**bis**).

6. The question arises during which procedural phase the excusing of the delay in meeting a time limit may take place. Article 48(2) says that any Contracting State shall (subparagraph (a)) or may (subparagraph (b)), as far as that State is concerned, excuse the delay, which indicates clearly that it is during the national phase only that the excusing may take place. In other words, independent of whether the delay to be excused concerns a time limit pertaining to the international phase or a time limit pertaining to the national phase, the excuse procedure applies only during the national phase (and not during the international phase). The procedure would take place before the designated or elected Office (or before a court or other competent body of the designated or elected State). Whenever that Office (or court or other competent body) finds that the delay is to be excused, the consequence of the delay will be eliminated: for instance, if the time limit which was not met was the time limit within which the applicant had to correct a defect under Article 14 before the receiving Office and, as a consequence of the delay, the international application was considered withdrawn, the designated Office will maintain the effect of national application of the international application under Article 24(2) > if the time limit which was not met was the time limit for entering the national phase, the international application will be processed in the designated State as if the time limit had been met.

Rule 82ter (New)

Rectification of Errors Made by the Receiving Office
or by the International Bureau

82ter.1 Errors Concerning the International Filing Date and the Priority Claim

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the declaration made under Article 8(1) has been erroneously cancelled or corrected by the receiving Office or the International Bureau, and if the error is an error such that, had it been made by the designated or elected Office itself that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the declaration under Article 8(1) had not been cancelled or corrected, as the case may be.

7. The [reasons](#) for which delays must be excused under subparagraph (a) are not the same as the [reasons](#) for which delays may be excused under subparagraph (b) of Article 48(2): in the first case, the reasons are reasons admitted [in the national law](#) of the Contracting State whose organs (its national Office [qua](#) designated or elected Office and its courts or other competent body) are asked to excuse the delay, whereas, in the second case, the reasons are reasons [other](#) than reasons admitted in the national law. What these other reasons are is not specified-, consequently, it may be any reason, including mistakes by others than the applicant (see the proposed new Rule 82**bis**.3, below).
8. [Ad Rule 82bis.2](#). The first sentence of the proposed new Rule 82**bis**.2 is intended to enumerate the more common remedies that result in excusing delays in meeting time limits, namely, reinstatement of rights, restoration, [restitutio in integrum](#) and “further processing [of the international application] in spite of non-compliance with a time limit.” It is, furthermore, intended to make it clear that the said listing of certain remedies is not exhaustive: this is why the proposed draft speaks of “any other provisions.”
9. It should be understood that, for the purposes of Article 48(2), the provisions referred to in the first sentence of Rule 82**bis**.2 may be applied under the conditions set forth by the national law. If, for example, the remedy provided for by the national law is only available before the expiration of a certain time limit, the applicant will have to initiate the necessary proceedings within that time limit, as would be the case for a national application filed outside the PCT. However, since the provisions of the national law which deal with the excusing of delays in meeting time limits do not, in most cases, make reference to acts to be performed before an [international](#) authority under the PCT—such as the receiving Office, for example—but make reference to acts to be performed before the [national](#) Office, the second sentence of Rule 82**bis**.2 specifies that the provisions in question should be applied to an international application as if the international authority before which the act was not performed in due time were the national Office. This follows from the effect of an international application provided for under Article 11(3). That effect of a regular national application in each designated State as of the international filing date makes it possible to apply national provisions to international applications as of the international filing date since international applications are equal to national applications as of that date. If the national provision is worded in such a way that it is limited to the procedure before the national Office which acts as a designated Office, the provision must be applied [mutatis mutandis](#), which follows from Article 48(2)(a). The purpose of Article 48(2)(a) is to oblige the Contracting States to extend the benefit of [all](#) excuse provisions existing under national law for the benefit of national applications to international applications in order to assure an equal treatment of applicants, be they national applicants or PCT applicants. If, for example, the applicant fails to pay a filing fee or to correct a defect within a certain time limit and if such failure can be excused for national applications, it must, likewise, be excused for international applications.
10. [Ad Rule 82bis.3](#). The proposed new Rule 82**bis**.3 is intended to keep free the applicant from the consequences of any delay in meeting the time limit for entering the national phase where the delay was caused by an error made by [certain Authorities](#). In the case of a national application, where the only Authority is the Patent Office, it is only natural that, if the delay in meeting a time limit is caused by an error [of](#) the Patent Office, that Patent Office will excuse the delay since it caused itself that delay. What is intended here is to extend this principle—natural and equitable—to international applications and to make it mandatory for each national Office, [qua](#) designated or elected Office, to apply it, to the extent that it would apply it in connection with a national application (either under the national law or under the national practice), to the time limit for entering the national phase. The legal basis for such an extension is in Article 48(2)(b) which allows excusing delays for reasons other than those admitted by national laws. Here, the reasons are—at least formally—outside the national law

since, as far as known, no national law deals with the excuse of delays caused by errors of PCT authorities; but should a national law deal with it, Article 48(2)(a) (rather than Article 48(2)(b)) will apply, and the result for the applicant will presumably be the same. Article 48(2)(b) gives a faculty to excuse; the proposed new Rule, if adopted, would mean that all Contracting States which recognize the principle in question in connection with national applications would make use of this faculty in a particular case, namely, that of an error of a PCT Authority leading to a delay in meeting the time limit for entering the national phase. If the delay is so excused, the effect of the international application provided for in Article 11(3) will be maintained under Article 24(2).

11. The scope of the proposed new Rule 82**bis**.3 has been limited to what is considered to be really necessary, namely, the case where the time limit which is not met is the time limit for entering the national phase. Rule 82**bis**.3 would apply, for instance, in the following case (provided, naturally, that delays caused by errors of the national Office are excused under the national law or practice): the International Preliminary Examining Authority erroneously informed the applicant under Rule 61.1(b) that the demand had been received by it on a date which is prior to the expiration of 19 months from the priority date whereas, in fact, the demand was received on a date which is after the expiration of the said 19 months and the elected Offices have been notified of that actual date, so that the applicant entered the national phase too late because he thought, on the basis of the date indicated by the International Preliminary Examining Authority, that the time limit under Article 39(1) would apply, whereas the time limit under Article 22 was, in fact, applicable.

12. In any case, and as is obvious, the intent is that the applicant, in the situations covered by the proposed new Rule 82**bis**.3, should not suffer where he is—so to say—misled by an “official” error. Such an advantage given to the applicant would, as already stated, be a mere extension to the PCT of what is already a generally accepted principle on the national level.

13. The obligation to excuse would only apply where the applicant “proves” that the delay was “due to” an official error. Any excuse allowed would, naturally, be effective only in the Office that granted it; this follows from the words “as far as that State is concerned” of Article 48(2).

14. Ad Rule 82**ter**.1. Experience has shown that errors made by the receiving Office; or by the International Bureau but which do not lead to a delay in meeting a time limit may have adverse consequences for the applicant without any possibility under the Treaty and the Regulations to rectify such error in the national phase.

15. The first case may be illustrated by following example: The receiving Office considers erroneously a replacement sheet as a later submitted sheet under Rule 20.2 and accords as international filing date the date of receipt of the replacement sheets or errs otherwise in the date which is accorded as the international filing date. Such date, if later than the date which should have been accorded as international filing date, might have negative consequences for a priority claimed if the erroneous date is later than 12 months from the priority date, or it might otherwise affect the novelty of the invention. The purpose of the proposed new Rule 82**ter**.1 is to provide a mechanism for rectification of such errors by the receiving Office.

16. The second case which might have consequences similar to those referred to in the preceding paragraph is an error made by the receiving Office or the International Bureau in cancelling or correcting a priority claim under Rule 4.10(d). If the applicant can prove that the filing date of an earlier application is different from what has been decided by the receiving Office or the International Bureau to be the priority date, or that the declaration claiming priority has been erroneously cancelled, the designated or elected Office should rectify the error and proceed on the basis of the rectification. Rule 82^{ter}.1 will apply only in very few cases, but these cases may be very important for the applicant and he should not have to bear the negative consequences of an error made by the receiving Office or the International Bureau.

17. In any case, it would be advisable for an applicant facing one of the two situations covered by the proposed new Rule 82^{ter}.1 to first try to obtain, during the international phase, the correction of what he considers to be an error of a PCT Authority. For that purpose, he should address himself to the Authority which took the allegedly erroneous decision in order to obtain the requested rectification, and should have recourse to any remedy available under the national law applicable to that Authority. Thus, it is only in the case where he would not succeed in obtaining the rectification during the international phase that the remedy proposed in Rule 82^{ter}.1 would become necessary.

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