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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

**PCT COMMITTEE
FOR ADMINISTRATIVE AND LEGAL MATTERS**

**Second Session
Geneva, April 25 to 29, 1983**

REPORT

adopted by the Committee

INTRODUCTION

1 The PCT Committee for Administrative and Legal Matters (hereinafter referred to as "the Committee") held its second session in Geneva from April 25 to 29, 1983.

2. The following members of the Committee were represented at the session: (i) the following 20 States, members of the International Patent Cooperation Union (PCT Union): Australia, Austria, Belgium, Brazil, Congo, Denmark, Finland, France, Germany (Federal Republic of), Hungary, Japan, Luxembourg, Netherlands, Norway, Soviet Union, Sri Lanka, Sweden, Switzerland, United Kingdom and United States of America; (ii) the European Patent Office (EPO), in its capacity as International Searching and Preliminary Examining Authority.

3. The following four States, members of the International Union for the Protection of Industrial Property (Paris Union), participated in the session as observers: Mexico, Spain, Trinidad and Tobago and Turkey.

4. The following seven international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), European Federation of Agents of Industry in Industrial Property (FEMIP), Institute of Professional Representatives Before the

European Patent Office (EPI), International Association for the Protection of Industrial Property (IAPIP), International Federation of Industrial Property Attorneys (FICPI), Union of European Practitioners in Industrial Property (UEPIP) and Union of Industries of the European Community (UNICE).

5. The list of participants is contained in Annex 1 to this report.

OPENING OF THE SESSION; ADOPTION OF THE AGENDA

6. The session was opened by the Chairman of the Committee, Mr. G. Borggard (Sweden). The Committee elected as Vice-Chairman, in view of the absence of Mr. S. N. Afanassiev (Soviet Union), Mr. Y. Gyrzymov (Soviet Union). The other Vice-Chairman, Mr. H. D. Hoinkes (United States of America), was present at the session. Mr. B. Bartels (WIPO) acted as Secretary of the Committee.

7. The Committee adopted the agenda of its session as appearing in document PCT/CAL/II/1.

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

8. After a brief general debate, the Committee considered, chapter by chapter, the amendments proposed in documents PCT/CAL/II/2 to 8. The proposed modifications to the Administrative Instructions were not discussed in detail, on the understanding that further consultations under Rule 89.2(b) would take place before their promulgation.

9. This report reflects mainly the conclusions drawn by the Chairman of the Committee concerning each chapter and the major doubts raised during the discussions. It does not, therefore, reflect all the observations made, including drafting points. It also does not reflect the observations made on the proposed modifications to the Administrative Instructions. However, the discussions were recorded on tape and noted by the Secretariat, which will take them into account when preparing the texts to be submitted to the Assembly of the International Patent Cooperation Union (PCT Union) (hereinafter referred to as "the Assembly"). The Delegation of France made a general reservation on the report and reservations on the amendments referred to in Chapters 6, 23, 25 and 30, as those texts were submitted to the Committee in English only.

Chapter 1

10. The proposed amendments were approved.

Chapter 2

11. The proposed amendments were approved as contained in document PCT/CAL/II/8, after a slight amendment had been made to the English text of Rule 6.4(a), fourth sentence, which consisted of replacing the words "the manner of claiming" by the word "that."

Chapter 3

12. The proposed amendments were approved, subject to reconsideration of the drafting by the International Bureau.

Chapter 4

13. The proposed amendments were approved.

Chapter 5

14. The proposed amendments were approved.

Chapter 6

15. The proposed amendments were approved, after Rule 15.4(b) was amended by adding after the word “application” in the seventh line, the words “if that month expires after the expiration of one year from the priority date” and after Rule 15.4(c) was amended by adding in the third line the words “within one month” after the word “applicable,” by adding in the fourth line the word “not” after the word “shall,” and by adding as a second sentence the following sentence: “The new amount shall, however, apply to any payment of any designation fee made later than one month after the date of receipt of the international application.” The approval of Rule 15.4(c) was reached after a discussion during which some delegations declared that they still preferred the original proposal by the International Bureau. The Delegation of the EPO stressed in that respect that a solution to the problem raised by the interested circles could, in its view, consist of providing for a transitory grace period, without a surcharge, for the payment of the difference between the former and the new amount if the applicant paid the former amount.

Chapter 7

16. The proposed amendments were approved. The Delegation of Japan declared that the receiving Office of its country was now in a position to withdraw its notification under Rule 16bis.3.

Chapter 8

17. The proposed amendments were approved.

18. During the discussion of this Chapter, it was suggested that Rule 4.10(c) should be amended by inserting in the first sentence, after the words “International Bureau,” the words “or to the receiving Office.” The International Bureau was requested to study that suggestion and, where appropriate, to submit a corresponding proposal direct to the Assembly.

chapter 9

19. The proposed amendments to Rules 20.5, 22.1, 22.2 and 23.1(a) were approved as contained in documents PCT/CAL/II/2 and 8.

20. Several delegations were concerned that the proposed Rule 22.3 provided no time limit in cases where the International Bureau did not issue a notification under Rule 22.1(c).

21. However, the proposed amendments to Rule 22.3 were approved, subject to the reservation of the Delegation of the United States of America stated in paragraph 22, below, on the understanding that that Rule would apply without prejudice to the obligation of the applicant to enter the national phase within the time limit applicable under Article 22 or Article 39(1). It was also understood that any designated Office may, if, by the expiration of the said time limit, the International Bureau was not in possession of the record copy, consider the international application withdrawn unless evidence was produced that the international application in question had been filed with the receiving Office on the international filing date and that the necessary national security clearance had been provided.

22. The Delegation of the United States of America reserved its position regarding the proposed amendments to Rule 22.3 because it was of the opinion that Article 12(3) required the prescription of a definite time limit. In any case, the Delegation of the United States of America was prepared, to accept an extension of the time limit for receipt of the record copy by the International Bureau up to the expiration of the time limit applicable under Article 22 or Article 39(1).

23. It was agreed that Rules 22.4, 22.5 and 23.1(c) should be transferred to the Administrative Instructions.

Chapter 10

24. The proposed amendments were approved.

Chapter 11

25. The proposed amendments were approved.

Chapter 12

26. The proposed amendments were approved after the third sentence of Rule 26.2 had been amended to read: "It may be extended by the receiving Office at any time before a decision is taken."

Chapter 13

27. The proposed amendments were approved. The Delegation of the United States of America, however, expressed objections against the proposed Section 112 of the Administrative Instructions, and it was agreed that the International Bureau would reconsider the question of furnishing statistical indications as provided for in that Section.

Chapter 14

28. The proposed amendments were approved as contained in documents PCT/CAL/II/2 and 8, on the understanding that it was possible for an applicant to withdraw his international application on the condition that it would not be published under Article 21. The Delegation

of the United Kingdom expressed doubts on the proposed amendments in view of the additional workload they would impose on receiving offices.

Chapter 15

29. The Delegation of Spain underlined the considerable political and practical importance of the question of inclusion of Spanish-language patent documents in the PCT minimum documentation and of the publication of PCT applications in the Spanish language not only to Spain but to the Spanish-speaking countries of Latin America as well in order to make the Treaty more attractive for those countries. The proposed measures would be beneficial to the PCT system and underline its vocation to universality. Without the proposed modifications, it was very difficult to conceive that the Spanish-speaking countries would be able to join the PCT system. The inclusion of Spanish-language patent documents in the PCT minimum documentation would doubtless increase the quality of the international search report. In order to make the proposals under consideration effective, it would also be necessary for one or more International Searching Authorities to accept Spanish-language international applications for purposes of international search.

30. The Delegation of Mexico, associating itself with the observations made by the Delegation of Spain, stressed in particular the importance of the proposed amendments for the Latin-American region which, on the one hand, was interested in the PCT system in view of the advantages it presented for developing countries but, on the other hand, could not really benefit from it as long as the Spanish language was not admitted in the way proposed.

31. The Delegation of the United Kingdom said that the Heads of Delegation of the Administrative Council of the European Patent Organisation had asked it to make a short statement at this meeting in view of its holding the Chair of the Council. That statement was as follows.

“The adoption of the Spanish language as a PCT language will be discussed at the next meeting of the Administrative Council in June. Obviously, the matter is of considerable significance to the European Patent Organisation, politically and practically, in view of the need, among other things, if Spanish is adopted as a PCT language, for there to be an International Searching Authority for dealing with applications filed in the Spanish language. The Heads of Delegation to the Council have therefore asked the Delegation to say that the position of the Organisation is member States on both the principle of the adoption of Spanish and on the detail of the proposed changes in the Rules is at present reserved.”

The Delegation of the United Kingdom added that it could assure the Committee that the statements made by the Spanish-language Delegations and the report of this session would be put before the Administrative Council of the European Patent Organisation in June 1983.

32. The Delegations of the Soviet Union and Australia supported the proposals concerning the Spanish language. Except for adding Spanish to the languages indicated in Rule 48.3(b), the Delegation of the Soviet Union reserved its position on the modifications contained in that Rule, as this part of the proposal was still being studied in its country. The Delegation of Australia indicated a need to specify in more detail in the Administrative Instructions how the system of choice of languages proposed in Rule 48.3 would operate.

33. The Director General said that he would be grateful to the Administrative Council of the European Patent Organisation if it could take into account, when reconsidering the matter, the considerable political and practical importance of the proposed amendments concerning the Spanish language, both because of the important number of countries using that language and in view of the technical level reached in a number of those countries. There were no practical problems with the proposed inclusion of Spanish-language documents in the PCT minimum documentation, since the number of documents involved was less than 1% of the annual increase of that documentation. There were also no practical grounds against accepting the Spanish language as a language of publication, in particular for Western European countries which had probably less difficulty in accepting Spanish-language publications than they had with publications in certain other languages under the existing system.

34. The Chairman stated that there was no opposition raised against the proposals concerning the Spanish language, but that the reservation of the countries of the European Patent Organisation was noted.

Chapter 16

35. The proposed amendments were approved on the understanding that where, due to the late payment of the search fee, the remaining time of the three month period did not allow the timely establishment of the international search report, the transmittal of that report could be effected exceptionally after the expiration of the three month time limit, but not later than one month after that expiration.

Chapter 17

36. The proposed amendments were approved. It was agreed that the Guidelines for receiving Offices for the processing of international applications under the PCT and the Guidelines for International Search to be Carried out under the PCT should state that, in those cases where amendments under Article 19 would be submitted to the receiving Office or to the International Searching Authority, that Office or Authority should transmit them promptly to the International Bureau.

Chapter 18

37. It was suggested, and approved subject to a more careful study of that suggestion, that Rule 55.1 should be amended by replacing the reference to the language of the translation of the international application under Rule 55.2 by a reference to the language of the international publication (Rule 48.3(b)). The other amendments proposed in this chapter were approved. However, as far as the deletion of the concept of "correction" from Rules 66.2(c), 66.3(a), 66.8(a), 70.11 and 70.16 was concerned, the Delegation of Japan said that it would have preferred that concept to be maintained in those Rules, since, in its view, it resulted from the text of Articles 34(2) (c) (ii) and 3(2) that the International Preliminary Examining Authority should have the possibility to ask for a correction of the request, but it added that it had no intention to prevent a consensus from being reached if the majority of the Committee approved the proposed deletion; no other delegation expressed any doubts or reservations against that deletion.

Chapter 19

38. The proposed amendments were approved.

Chapter 20

39. The proposed amendments to Rule 47.1(b) were approved.

40. It was agreed not to amend the present text of Rule 47.2(c) on the understanding that the International Bureau could ask at any time for a reconsideration of that provision if the exceptions to the general rule that copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20 were to increase to such an extent that they would put a substantial additional burden on the International Bureau.

Chapter 21

41. The proposed amendments were approved.

Chapter 22

42. The proposed amendments were approved.

Chapter 23

43. The proposed amendments were approved after the following modifications were made: the title of Rule 54.4 was changed to read "Applicant Not Entitled to Make a Demand or an Election"; paragraph (c) of Rule 54.4 was deleted; in Rule 61.1(b), the expression "54.4(a)," was added after the word "Rules" in the third line, and the words "or where an election has been considered under Rule 54.4(b) as if it had not been made," were added after the word "submitted," in the fourth line.

Chapter 24

44. The substance of the proposed amendments was approved. However, it was agreed that the contents of the proposed new paragraph (c) of Section 201 of the Administrative Instructions and of the present paragraph (b) of that Section should be included in the Regulations since they involved notifications to applicants.

Chapter 25

45. The amendments to Rule 66.4(b) proposed in Chapter 25 were approved.

46. Subject to the adoption of the 30-month time limit in Article 39 (1) (a) , Rule 69.1(a) was approved as follows:

“(a) The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;

(ii) 9 months after the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.”

Chapter 26

47. The proposed amendments were approved. However, the Delegation of Japan said that, since there was a link between Rule 66.7 and the time limit in Article 39(1)(a), and in view of its position as expressed in connection with Chapter 33, it preferred to add, at least for the time being, in the second sentence of Rule 66.7(a), after the word “Authority,” the words “in time for the international preliminary examination report to be established within the time limit applicable under Rule 69.1(a) or.”

Chapter 27

48. The proposed deletion of Rule 80.6(b) was approved on the understanding that it should not enter into force as long as any receiving office having made a notification under that Rule would not be in a position to withdraw it. The Delegation of Japan declared that the receiving Office of its country was now in a position to withdraw its notification under Rule 80.6(b).

Chapter 27bis

49. The proposed amendments were approved (document PCT/CAL/II/5).

Chapter 28

50. The proposed amendments were approved.

Chapter 29

51. The proposed amendments were approved.

Chapter 30

52. Consideration of the amendments proposed for Rule 4.10(b) and Rule 66.5 was deferred until agreement was reached on the text of Rule 91.1.

53. Paragraphs (a), (b) and (c) of Rule 91.1. The Delegations of Japan and the United States of America stated that they preferred to maintain the existing text of these paragraphs.

54. The Delegation of Belgium said that it preferred the existing text of these paragraphs of Rule 91.1 with the deletion of the words “of transcription.”

55. A number of delegations raised objections against the proposal contained in paragraph (b). The Delegation of the United States of America said that rectification should not lead to presentation of new matter; the error should be demonstrably non-substantive.

56. The Delegations of Sweden and the United Kingdom said that correctable errors must be obvious to anybody and immediately evident from the documents already filed. The producing of further evidence by the applicant must be avoided in the procedure before the receiving office.

57. The Delegations of the EPO and the United Kingdom suggested to insert in line 6 before “nothing else” the words “it is immediately evident that” and retain the rest of the text of (b) in the document under consideration.

58. This proposal was opposed by the Delegations of the United States of America and Japan as, in their view, it would not prevent the applicant from adding new matter.

59. The Delegation of Australia opposed paragraph (b) in document PCT/CAL/II/3 as going too far in allowing rectification. One should amend Rule 91.1 to provide for a notification of the substance of the rectification to any designated or elected office in order to allow re-examination of the rectification made.

60. The Representatives of various non-governmental organizations expressed themselves in favor of paragraphs (a), (b) and (c) in document PCT/CAL/II/3 and stressed in particular the need to allow also the rectification by way of submission of missing sheets in the international application at least in the case where the missing sheets were present in the priority document.

61. The Delegations of the United States of America and Japan said with respect to paragraph (c) that they objected to rectifications by way of inserting missing pages as in such cases the addition of new matter was rather more likely. A principle similar to that of Article 19(2) of the Treaty would have to apply also here.

62. The Delegation of the United States of America referred to the fact that there was no real evidence as to what error was corrected in what form by another receiving office. It therefore expressed itself in favor of a later review procedure by the designated or elected Office in the case a text was adopted which allowed more rectifications than the present text. After an opposition raised against the review procedure by various delegations and representatives of the non-governmental organizations, the Chairman concluded on this point that no review procedure should be foreseen.

63. The Representatives of FICPI and IAPIP said that the users of the PCT had no intention to add new matter by way of rectifications under Rule 91.

64. Paragraphs (d), (e), (f), (g) and (h) of Rule 91.1 and Rule 91.2. No comments were made with respect to those provisions, except to confirm that Section 109 of the Administrative Instructions was proposed to be deleted and its contents transferred to Rule 91.1(f) and except for Rule 91.1(e) (ii) (see below).

65. Paragraph (i) of Rule 91.1. The Delegations of Japan, the United Kingdom, Sweden, Brazil, the United States of America and Belgium opposed the introduction of a system of rectification of omitted designations as it was difficult to distinguish between mere rectification and later designation. The proposal that a rectification in such case would require, under paragraph (e) (ii), the express authorization of the designated or elected Office was not considered to be an appropriate remedy, as certain countries would wish to exclude

the rectification of omitted designations in general without being obliged to deal with each individual case. The Delegation of the United Kingdom suggested an addition to that effect in paragraph (i) which is reproduced as Annex II of this report. The Delegation of the United States of America also pointed to the fact that, under the proposed system, the applicant would have to wait until the national phase in order to see whether his designation was upheld. If the rectification was refused, he would probably then have already lost his rights in the country concerned as his application was in the meantime internationally published.

66. The Delegation of the United States of America proposed to replace paragraph (i) by a text which would limit rectification in the case of designations expressly to cases of improper indication of countries as distinguished from their omission. That proposal is attached as Annex III of this report.

67. Proposals by the Chairman and the Delegation of Sweden on paragraphs (a) to (c) of Rule 91.1. After informal consultations, the Chairman presented a proposal on paragraphs (a), (b) and (c) which is reproduced in Annex IV of this report, and the Delegation of Sweden presented an alternative proposal on the same paragraphs which is reproduced in Annex V of this report.

68. The Delegations of the Netherlands, Switzerland, France and Belgium expressed a preference for the proposal of the Swedish Delegation. The Delegation of the Netherlands stated, however, its preference for the existing text of Rule 91.1 in case neither of the two proposals would find general support by the Committee. The Delegations of Switzerland and France said that they could also go along with the proposal of the Chairman. The Delegation of Switzerland added that the Chairman's proposal had the advantage of treating the request and other papers more liberally than the substantive elements of the international application.

69. The Representative of FEMIPi pointed to the advantage of the proposal of the Chairman that it lead to a more liberal solution for the correction of obvious errors than the present text.

70. The Delegations of Japan and the United States of America, repeating their preference for the existing text, stated that they could not go along with any of the proposals as they were presently drafted. The proposal of the Chairman was too broad as far as rectification of obvious errors in the request or other papers were concerned. The expression "other papers" could cover also documents containing technical information. The Swedish proposal in paragraph (b) was broader than the existing text of that paragraph.

71. The Delegation of the United Kingdom expressed sympathy with the intention of the Chairman's proposal to separate the treatment of rectifications in the request, on the one hand, and in the description, claims and drawings, on the other hand, as the possibilities of rectification for the latter had to remain as restrictive as in the existing text, whereas for the former a somewhat broader solution could be envisaged. That solution would, however, also have to be limited in some form, which was not the case in the Chairman's proposal. In particular the inclusion of "other papers" in paragraph (a) without being qualified in any way by paragraph (b) was too permissive, as among those "other papers" were also papers containing substance. Moreover, it was essential that any individual State should be able to declare that omitted designations of that State could not be rectified in the request. In addition, any solution which might require a receiving office to hear evidence and arguments was not desirable. The Delegation proposed, however, to keep both proposals on the agenda for further consideration.

72. The Delegation of the United States of America said that any solution treating rectification in the request in a way different from the solution of paragraph (b) for the other elements of the international application would have to be limited by restrictive conditions, which was not the case in the Chairman's proposal. In particular the revised version of paragraph (i) on rectification in designations, as contained in the Delegation's proposal referred to above (Annex III), would be necessary in order to fix strict limits for such rectifications, in particular excluding the rectification of omitted designations.

73. The Representative of IAPIP said that, once paragraph (b) would be revised to exclude new matter, he could support either the proposal of the Chairman or that of the Swedish Delegation.

74. The Chairman said in conclusion that all the texts discussed during that session and annexed to the report should be used for a further effort of the International Bureau to produce a new text or new alternative texts, for the session of the Assembly. The new proposals should, to the extent necessary and useful, be the subject of informal consultations, in particular with the authors of the various proposals, and should be distributed in good time before the session of the Assembly to allow thorough preparation. The Chairman added that the Swedish proposal had received a slight preference in the discussions, that there was a strong preference of some Delegations, in particular those of Japan and the United States of America, for the existing text, that it should be further explored whether a solution for a separate treatment of rectifications in the request could be found, that the question of treatment of rectifications in "other papers" needed further study, that paragraph (c) in document PCT/CAL/II/3 should no longer appear in a new proposal and that any such proposal should exclude omitted designations from rectification.

Chapter 31

75. The proposed amendments were approved.

Chapter 32

76. The Delegation of Japan stated that it was still its view that the present time limit in Article 22(2) was not without grounds. Since, however, it realized that it would be advantageous to applicants to have more uniformity in the time limits under the PCT system, it was willing to harmonize its position with that of the other countries in order not to prevent a consensus from being reached. However, in view of the need to amend the Japanese patent law, acceptance of the change of the time limit under Article 22(2) would be possible only if adequate means were found such as a reservation clause or a transitory clause, which would be acceptable to Japan for the adaptation of its national law. The Delegation of Norway also said that the proposed extension of the time limit required a change of its national law. Subject to those statements, the principle of harmonizing the time limit under Article 22(2) with the time limit under Article 22(1) was unanimously approved.

77. Views differed, however, on the question whether the competence to modify time limits given to the Assembly under Article 47 also allowed for the deletion of a whole paragraph, namely, paragraph (2) of Article 22, as proposed by the International Bureau. That solution for the harmonization of the time limit was approved by the majority of the Committee, whereas several delegations expressed their preference for the maintaining of that paragraph

in an amended form, for example by deleting the introductory words “Notwithstanding the provisions of paragraph (1)” and by replacing the words “two months from the date of the notification sent to the applicant of the said declaration” by the words “20 months from the priority date” or by the expression “the same as that provided for in paragraph (1).” The suggestion was also made that, if paragraph (2) of Article 22 were to be changed by a repetition of the time limit under paragraph (1) of Article 22, an appropriate footnote in the brochure containing the text of the PCT could explain why the same time limit appeared both in paragraph (1) and in paragraph (2) of that Article.

Chapter 33

78. The amendments proposed in Chapter 33 were supported by various Delegations and no opposition on the substance was raised. The Representatives of the non-governmental organizations stressed the importance of the proposed extension of the time limit under Article 39(1) (a) for an increased use of Chapter II of the PCT. The Delegation of the United States of America said that acceptance of Chapter II was under active consideration in its country and that if the interested circles came to a positive recommendation, the government would consider taking the necessary measures for an acceptance of Chapter II; in that perspective, if the proposed extension of the time limit under Article 39(1) (a) would be considered useful by the interested circles of its country, the Delegation would favor such extension.

79. The Delegation of Japan stated that the proposed extension was not unacceptable to Japan. However, in view of the need to amend the Japanese patent law, acceptance of the change of the time limit under Article 39(1)(a). would be possible only if adequate means were found such as a reservation clause or a transitory clause, which would be acceptable to Japan for the adaptation of its national law.

80. The Delegations of Austria, Sweden and Finland stated that they were ready to accept the proposed extension of the time limit under Article 39(1) (a) but that also the laws of their countries had to be changed in order to adapt them to the amendments. An appropriate solution would have to be found to accommodate this situation.

81. The Delegation of Brazil stated that it had similar problems of compatibility of the proposed extension with its national law and therefore had to reserve its position.

82. The Director General suggested that a possible solution to the transitory problem raised by various Delegations should be studied, consisting of the following: the normal time limit would be 30 months from the priority date; where a Contracting State, at the time of entry into force of the change in time limit, was not yet in a position under the national law to apply the new time limit, it notified the International Bureau of that fact; in that case, the present time limit of 25 months would continue to apply between the said Contracting State and the other Contracting States; in other words, nationals of countries applying still the 25 month time limit would, in the other States, only enjoy the benefit of the same time limit.

83. The Committee noted this suggestion with considerable interest and asked the International Bureau to study it, taking into account possible legal problems.

84. The Chairman stated in conclusion that there was unanimous acceptance of the principle of the 30 month period. It was generally felt that the Assembly, when adopting it, should find

a solution, perhaps along the lines stated by the Director General, in order to accommodate the situation of States whose laws were, at the time of entry into force of the amendment, not yet adapted to the amendment; this would induce all Contracting States to take the necessary measures so that their nationals could as soon as possible benefit as well from the 30-month period.

85. The Delegation of Japan said that the solution outlined by the Director General required further study and that it was not in a position at this stage to make any comments relating thereto.

Chapter 34

86. The Delegation of Hungary expressed doubts, in connection with the proposed Rule 49.1(a-*bis*), whether it was possible for a Contracting State to waive an obligation of the applicant which was provided for in Article 22. The Delegation of the United Kingdom assured the Delegation of Hungary that it was not alone in having doubts. One delegation questioned the need for the proposed Rule 49.1(a-*ter*) but others insisted on the need to include that provision. The proposals were approved. The International Bureau agreed to revise paragraph 4 of the explanations in the light of the discussions.

Chapter 35

87. The proposals relating to Rules 11.15, 49.3, 49.6(c), 49.7, 76.1, 76.2, 76.3 and 76.5 were approved.

88. The Delegation of Brazil declared that under its national law the use of a special form was required and therefore it could not accept the proposed Rule 49.4(a). The Delegation of the United Kingdom expressed for the same reason a reservation with respect to that Rule. Subject to those two statements, the proposed Rule 49.4(a) was approved.

89. The Committee agreed that the words “or at any time thereafter” should be deleted from the proposed Rule 49.4(b) and approved that provision in principle with the proviso that its transfer to Rule 51*bis* should be considered.

90. Concerning the proposed Rule 49.5, the Committee agreed that a solution based on the text appearing in Annex VI of this report should be further studied in preparation of a decision to be taken by the Assembly. The Delegation of Japan, however, stated that it could not accept any solution implying that a copy of the drawings, filed as an element of the translation furnished under Article 22, could be furnished after the expiration of the time limit under Article 22 with the same effect as if it had been furnished before that expiration; it explained that, under its national law, such late furnishing did not entail a loss of the application but resulted in the missing drawings being considered non-existent.

91. As far as the proposed Rule 49.6(a) was concerned, the Delegation of the United Kingdom, while expressing its sympathy for the proposal, said that it implied an amendment of its national law. It therefore reserved its position and indicated that an acceptable transitory solution was needed. The Delegation of the United States of America said that the proposed Rule 49.6(a) was not compatible with its present national law but that legislation had been introduced to the US Congress which, if adopted, would make the proposal compatible with its national law; consequently, the Delegation had to make a reservation on the proposal. The

Delegation of Hungary expressed doubts concerning the last part of Rule 49.6(a) (“unless later amendments are made under Article 28”) and it was agreed that that part of the Rule should be reconsidered. Subject to those three statements, the proposed Rule 49.6(a) was approved.

92. The proposed Rule 49.6(b) was approved by the majority of the Committee. However, the Delegations of Japan, the United States of America, the United Kingdom and the Netherlands, supported by the Delegations of Hungary and Brazil, expressed strong objections against the proposal because in their opinion the proposed Rule was not in agreement with the Treaty. Moreover, there were substantial practical objections to the proposal. It was agreed in conclusion that the International Bureau would reconsider that proposal, and submit a revised proposal to the Assembly.

Chapter 36

93. The Delegation of Japan said that provisions such as those proposed in Chapter 36 should be left to national law and that it could, in particular, not accept the proposed Rule 51*bis*.1(a) (vi) and (b)(i) and the proposed Rule 51*bis*.2. The Delegation of the United States of America reserved its position in respect of Rule 51*bis*.1(a)(iii) and (d) since those provisions were not compatible with its present national law, but the Delegation added that, legislation had been introduced to the US Congress which, if adopted, would make those provisions compatible with its national law; however, Rule 51*bis*.2 would not be compatible with that legislation since it required an invitation procedure whereas the said legislation would provide for a grace period without any invitation procedure. The Delegation of Japan added, in connection with Rule 51*bis*.2, that its national law did not provide for a grace period. The Representative from UNICE proposed that the request form should provide for a special box for the purpose of a statement concerning the non-prejudicial disclosures or exceptions to lack of novelty referred to in Rule 51*bis*.1(a)(vi). It was agreed that the International Bureau should reconsider the contents of Rule 51*bis*.1(c), (d) and (e) in connection with the reconsideration of Chapter 35. The Delegation of the United States of America stated that paragraph (e) should also be reviewed with a view to determining whether, instead of focussing on direct reproduction, the text should not be broadened to include a reference to all physical requirements of Rule 11. Subject to this reconsideration and the above-mentioned statements by the Delegations of Japan and the United States of America, Rule 51*bis*.1 was approved as contained in documents PCT/CAL/II/2 and 8. as far as Rule 51*bis*.2 was concerned, the Delegations of the United States of America and Japan opposed any form of invitation procedure. The Delegation of the United Kingdom also objected to the proposed invitation procedure and suggested, that a possible solution would consist of replacing in the title of that Rule the word “Invitation” by the word “Opportunity,” by replacing in the fifth and sixth lines the words “invite the applicant” by the words “provide the applicant with an opportunity” and to delete at the end of the Rule the words “and shall be fixed in the invitation”, it was agreed that the International Bureau should transmit to the Assembly a revised proposal.

Chapter 37

94. The Delegations of the United Kingdom and of Japan reserved their position on the proposed amendments in view of possible problems in connection with their national laws but added that the matter was under consideration. It was agreed that the last part of Rule 74.1(c) (“unless later amendments are made under Article 41”) should be reconsidered. Subject to

those statements and that agreement, the proposed amendments were approved as appearing in document PCT/CAL/II/8.

Chapter 38

95. The Delegations of the United Kingdom and the United States of America expressed considerable doubts about the proposed Rule 82*bis* in general and found its scope difficult to evaluate. These Delegations did not agree that the Treaty required that applications correctly deemed to have been withdrawn in the international phase due to failure to meet time limits had, obligatorily, to be considered in the national phase.

96. The proposed new Rule 82*bis*.1 was approved. The proposed , new Rule 82*bis*.2 was approved subject to the deletion of the second sentence. it was agreed to delete the proposed new Rule 82*bis*.3. The Delegations of the United Kingdom and of the United States of America reserved their positions on the proposed Rules 82*bis*.1 and 82*bis*.2 as revised, in order to consider their altered scope.

97. The proposed new Rule 82*ter*.1 was approved.

Proposal of the Delegation of Sweden on Rule 25.1 (document PCT/CAL/II/6)

98. After a discussion of the proposal, which showed that the views of the users of the PCT were divided on the usefulness of the notification to the applicant of the receipt of the search copy, it was agreed not to amend Rule 25.1.

Proposal of the Delegation of Sweden on Rule 28.1 (document PCT/CAL/II/7)

99. After a discussion of the proposal, the majority of the Committee agreed that Rule 28.1 should not be changed, subject to a possible deletion of the reference to the International Searching Authority. On the latter point, the Delegations of Sweden and of the EPO and the International Bureau were requested to hold consultations with a view to determining whether such a deletion should be proposed to the Assembly. It was furthermore agreed that the Receiving Office Guidelines for the Processing of International Applications under the PCT should be revised in order to better clarify the formality examination standards, in particular the requirements for reasonably uniform international publication referred to in Rule 26.3, so that the cases of application of Rule 28.1 would decrease in the future.

Questions of Special Interest to Developing Countries

100. After a brief discussion of the questions referred to in paragraphs 9 to 12 of document PCT/CAL/II/2, the Committee decided that, in particular in view of their political nature, they should be dealt with directly by the Assembly.

Statement by the Representative of APAA

101. Speaking on behalf of the Japanese Group of APAA, the Representative of APAA, supported by the Representative of FEMIP, underlined the usefulness of international search reports and stated that only a few national Offices gave a credit for the benefit of receiving the international search report. More frequent use of the PCT route would not only depend on the improvement of the PCT system under consideration by the Committee but also on the improvement of the financial advantages of using the PCT route. The national Offices, in particular the examining offices, should consider the reduction or a partial refund of national filing, search and examination fees, thus making the PCT system more attractive. The International Bureau stressed that this was also the view of the Assembly, which had adopted a Resolution to that effect, and it was hoped that more countries would soon give credit for the economies they were able to make thanks to the PCT system.

102. The Committee unanimously adopted this report on April 29, 1983.

[Annexes follow]

ANNEX I/ANNEXE I

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

I. MEMBERS OF THE COMMITTEE/MEMBRES DU COMITE

AUSTRALIA/AUSTRALIE

Mrs. J. COWCHER, Second Secretary, Permanent Mission, Geneva

AUSTRIA/AUTRICHE

Mr. N. MARTERER, Vice-President, Austrian Patent Office, Vienna

BELGIUM/BELGIQUE

M. P. CEUNINCK, Secrétaire d'administration, Service de la propriété industrielle, Ministère des affaires économiques, Bruxelles

BRAZIL/BRESIL

Miss A.R. de HOLANDA CAVALCANTI, Assistant of the Patent Director for International Affairs, National Institute of Industrial Property, Rio de Janeiro

Mr. C. HANNICKEL, Specialist of the Patent Director for International Affairs, National Institute of Industrial Property, Rio de Janeiro

Mr. E. CORDEIRO, First Secretary, Permanent Mission, Geneva

CONGO

M. D. NGASSAKI, Chef de l'Antenne nationale de la propriété industrielle, Ministère de l'industrie et de la pêche, Brazzaville

M. C. BAYULUKILA, Attaché de Cabinet, Ministère de l'industrie et de la pêche, Brazzaville

DENMARK/DANEMARK

Mr. J. DAM, Head of Section, Patent and Trademark Office, Copenhagen

FINLAND/FINLANDE

Mrs. S.L. LAHTINEN, Acting Deputy Director General, National Board of Patents and Registration, Helsinki

Mrs. E. HXKLI, Head of Section, National Board of Patents and Registration, Helsinki

FRANCE

M. P. GUERIN, Conseiller juridique, Institut national de la propriété industrielle, Paris

Mlle G. RAJOT, Juriste, Institut national de la propriété industrielle, Paris

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. U.C. HALLMANN, Head of Division, German Patent Office, Munich

HUNGARY/HONGRIE

Mrs. E. PARRAGH, Head of Section, National Office of Inventions, Budapest

JAPAN/JAPON

Mr. O. NOZAKI, Director General, First Examination Department, Japanese Patent Office, Tokyo

Mr. H. AOYAMA, Examiner, Fourth Examination Department, Japanese Patent Office, Tokyo

Mr. S. ONO, First Secretary, Permanent Mission, Geneva

Mr. K. ISHIMARU, Director, Japan Trade Center, Dusseldorf

LUXEMBOURG

M. F. SCHLESSER, Inspecteur principal près le Service de la propriété industrielle, Luxembourg

NETHERLANDS/PAYS-BAS

Mr. S. de VRIES, Member of the Patents Council, Netherlands Patent Office, Rijswijk

NORWAY/NORVEGE

Mr. P.T. LOSSIUS, Deputy Director General, Norwegian Patent Office, Oslo

Mr. I. LILLEVIK, Head of Section, Patent Department, Norwegian Patent Office, Oslo

SOVIET UNION/UNION SOVIETIQUE

Mr. Y. GYRDYMOV, Deputy Director, External Relations Department, USSR State Committee for Inventions and Discoveries, Moscow

SRI LANKA

Mr. K. JAYASINGHE, Registrar of Patents and Trade Marks, Colombo

SWEDEN/SUEDE

Mr. G. BORGGÅRD, Director General, Royal Patent and Registration Office, Stockholm

Ms. B. SANDBERG, Head, International Section, Royal Patent and Registration office, Stockholm

Mr. E. TERSMEDEN, Legal Adviser, Ministry of Justice, Stockholm

SWITZERLAND/SUISSE

M. R. KRMP, Chef de Section, Office fédéral de la propriété intellectuelle, Berne

M. M. LEUTHOLD, Chef de la Division administrative, Office fédéral de la propriété intellectuelle, Berne

UNITED KINGDOM/ROYAUME-UNI

Mr. A. SUGDEN, Principal Examiner, Patent Office, London

Mr. J. SHARROCK, Principal Examiner, Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr. H.D. HOINKES, Legislative and International Patent Specialist, United States Patent and Trademark Office, Washington, D.C.

Mr. L.O. MAASSEL, Patent Practice and Procedure Specialist, United States Patent and Trademark office, Washington, D.C.

EUROPEAN PATENT OFFICE (EPO)/OFFICE EUROPEEN DES BREVETS (OEB)

Mme L. GRUSZOW, Administrateur, Affaires internationales, Office européen des brevets, Munich

M. M.S. PARUP, Juriste, Affaires juridiques, Office européen des brevets, Munich

II. OBSERVER STATES/ETATS OBSERVATEURS

MEXICO/MEXIQUE

Sr. F.J. CRUZ GONZALEZ, Consejero, Mision Permanente, Ginebra

Miss M.A. ARCE, Third Secretary, Permanent Mission, Geneva

SPAIN/ESPAGNE

Sr. A. CASADO CERVINO, Jefe del Servicio de Relaciones Internacionales, Registro de la Propiedad Industrial, Madrid

Sr. S. GOZALO DE MERCADO, Jefe de la Seccion de Explotacion y Licencias, Departamento de Patentes y Modelos, Registro de la Propiedad Industrial, Madrid

TRINIDAD AND TOBAGO/TRINITE-ET-TOBAGO

Mr. H. ROBERTSON, First Secretary, Permanent Mission, Geneva

TURKEY/TURQUIE

Mr. E. APAKAN, Counsellor, Permanent Mission, Geneva

III. INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS/
ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES

ASIAN PATENT ATTORNEYS ASSOCIATION (APAA)

Mr. T. YAMAGUCHI, Chairman, PCT Committee, Japanese Group

EUROPEAN FEDERATION OF AGENTS OF INDUSTRY IN INDUSTRIAL
PROPERTY/FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN
PROPRIÉTÉ INDUSTRIELLE (FEMIP)

Mr. P.A. JENNY, Vice-President, Basel

INSTITUTE OF PROFESSIONAL REPRESENTATIVES BEFORE THE EUROPEAN
PATENT OFFICE/ INSTITUT DES MANDATAIRES AGREES PRES L'OFFICE
EUROPEEN DES BREVETS (EPI)

Mr. P.A. JENNY, Patentabteilung, CIBA-GEIGY AG, Basle

INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY (IAPIP)/ ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE
LA PROPRIÉTÉ INDUSTRIELLE (AIPPI)

M. G.R. CLARK, Membre d'honneur, Chicago

INTERNATIONAL FEDERATION OF INDUSTRIAL PROPERTY
ATTORNEYS/FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ
INDUSTRIELLE (FICPI)

M. H. BARDERLE, Président, Munich

Mr. P.F. HERITIER, General Treasurer, Basel

Mr. T. RITSCHER, Member of Patent Commission, Zurich

UNION OF EUROPEAN PRACTITIONERS IN INDUSTRIAL PROPERTY
(UEPIP)/UNION DES PRATICIENS EUROPEENS EN PROPRIÉTÉ INDUSTRIELLE
(UPEPI)

M. G.E. KIRKER, Ingénieur-conseil en propriété industrielle, Genève

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES
INDUSTRIES DE LA COMMUNAUTE EUROPEENNE (UNICE)

Mr. R. KOCKLAUNER, Hoechst AG, Frankfurt am Main

IV. OFFICERS/BUREAU

Chairman/Président : Mr. G. BORGGARD (Sweden/Suède)
Vice-Chairmen/Vice-présidents : Mr. H.D. HOINKES (United States of America/
Etats-Unis d'Amérique)
Mr. Y. GYRDYMOV (Soviet Union/
Union soviétique)
Secretary/Secrétaire : Mr. B. BARTELS (WIPO/OMPI)

V. INTERNATIONAL BUREAU OF WIPO/BUREAU INTERNATIONAL DE L'OMPI

Dr. A. BOGSCH, Director General

Mr. K. PFANNER, Deputy Director General

M. F. CURCHOD, Directeur, Division du PCT

Mr. J. FRANKLIN, Deputy Head, PCT Division

Mr. B. BARTELS, Head, PCT Legal Section

Mr. N. SCHERRER, Head, PCT Publications, Fees and Statistics Section

Mr. Y. PLOTNIKOV, Senior Counsellor, PCT Legal Section

Mr. T. HIRAI, Examination Procedures Officer, PCT Examination Section

[Annex II follows/L'annexe II suit]

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ANNEX II

Chapter 30

Rule 91.1(i)

Suggestion for an additional text to Rule 91.1(i)
by the Delegation of the United Kingdom

The International Bureau shall not include an omitted designation, in respect of which a request for rectification has been filed, in the record copy or in the international publication of the international application, of any State which has made a notification to the International Bureau that it does not agree that, under any circumstances, an omitted designation of that State can be rectified. The International Bureau shall inform the applicant that the request for such rectification is not allowable.

[Annex III follows]

PCT/CAL/II/9

ANNEX III

Chapter 30

Rule 91.1(i)

Proposal by the Delegation of the United States of America

(i) Where the applicant alleges that it is due to an obvious error that a State was improperly indicated in the request in a way that the designation of no other State could have been intended, his request for rectification shall be accepted.

[Annex IV follows]

ANNEX IV

Chapter 30

Rule 91.1

Proposal presented by the Chairman

(a) Subject to paragraphs (d) to (i) , obvious errors in the request or other papers submitted by the applicant may be rectified.

(b) Subject to paragraphs (c) to (i) , obvious errors in the description, claims and drawings may be rectified if the error was due to the fact that something other than what was obviously intended was written in the international application, provided it is immediately evident to anyone that nothing else could have been intended than what is offered as rectification.

(c) [No change]*

[Annex V follows]

*

A new Rule could be considered which would provide that the request for a rectification which was not authorized, could, upon applicant's request addressed to the International Bureau, be published on a separate sheet together with the international application. The applicant could then request authorization of the rectification in the national phase by the designated or elected Office.

Chapter 30

Rule 91.1

Proposal by the Delegation of Sweden

- (a) [As proposed in document PCT/CAL/II/3, page 59]
- (b) In order to be rectifiable, the obvious error must be such that it is immediately realized by anyone that nothing else could have been intended than what is offered as rectification.
- (c) [No change]*

[Annex VI follows]

*

A new Rule could be considered which would provide that the request for a rectification which was not authorized, could, upon applicant's request addressed to the International Bureau, be published on a separate sheet together with the international application. The applicant could then request authorization of the rectification in the national phase by the designated or elected Office.

ANNEX V

Chapter 35

Rule 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. If required by the designated Office, the translation shall also contain, subject to paragraph (b), the request and, subject to paragraph (d), a copy of the drawings.

(b) Any designated Office requiring the furnishing of a translation of the request shall furnish copies of the request form in the language of the translation free of charge to the applicants. The form and contents of the request form in the language of the translation shall not be different from or additional to those of the request under Rule 4. The use of the request form in the language of the translation shall be optional.

(c) If 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 or by furnishing a drawing executed anew.

(d) If any original drawing does not contain any text matter, any designated Office requiring under paragraph (a) the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under Article 22, invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(e) The expression "Fig." does not require translation into any language.

(f) Where any copy of the drawings or any drawing executed anew which has been furnished under paragraph (c) or (d) does not comply with the physical requirements referred to in Rule 11, the designated Office may invite the applicant to correct the defect within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(g) Any requirement under the second sentence of paragraph (a) shall be published by the International Bureau in the Gazette.

(h) 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.

[End of Annex VI and of document]