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DRAFT
PROPOSED AMENDMENTS TO PART A AND PART B
OF THE REGULATIONS UNDER THE PCT

MEMORANDUM PREPARED BY THE INTERNATIONAL BUREAU

INTRODUCTION

General

1. The Assembly of the International Patent Cooperation Union (PCT Union), when adopting at its eleventh session, in February 1984, modifications to time limits fixed in certain Articles* of the Patent Cooperation Treaty (PCT) and amendments to numerous Rules* of the PCT Regulations, agreed with the views expressed by one delegation that the PCT system should be allowed to rest for a while (see document PCT/A/XI/9, paragraphs 68 and 69). Consequently, no amendments have been adopted and even proposed since then.

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* Unless expressly provided otherwise, any reference in this document to an Article or to a Rule is a reference to an Article of the PCT or to a Rule of the PCT Regulations, as the case may be.

2. During the last five years of practical application of the revised PCT system, further points have come to light which deserve special consideration and which may require further amendments to the Regulations. Furthermore, new technologies (wide use of personal computers and of telecopiers, optical character recognition (OCR) standards, inventions consisting in new nucleotide and/or amino acid sequences) require a “modernization” of the Regulations. Experience gained with the increasingly used procedure under Chapter II of the PCT has also revealed various points where a simplification of the procedure would be desirable. Finally, although the present system is now very safe and simple for the applicant, there remain a few situations where applicants who are not familiar with the details of the PCT procedure overlook certain requirements, which might eventually affect their rights.

3. The International Bureau has collected over the years all points where the PCT Regulations could be further improved. As far as the procedure before the International Searching and Preliminary Examining Authorities is concerned, a meeting of these Authorities in January 1990 in Geneva identified various points, in particular relating to the procedure under Chapter II, where amendments to the PCT Regulations would be desirable.

4. It is therefore believed that the time has come for a further detailed review of the PCT Regulations. First proposals for amendments of those Regulations are submitted to the PCT Committee for Administrative and Legal Matters of the PCT (hereinafter referred to as “the Committee”) in this document and in documents PCT/CAL/III/3 and 4. On the basis of the results of the session of the Committee, revised proposals will be submitted to a further session of the Committee, before being forwarded to the Assembly of the PCT Union for adoption.

[Possible Additional Amendments Resulting from Harmonization](#)

5. The proposed amendments do not include any amendment which would result from the proposed treaty which is at present under consideration by the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions. Proposals for further amendments to the PCT Regulations resulting from that treaty may be made by the International Bureau at a later date.

[General Listing of Topics](#)

6. In order to provide a general idea of the topics covered by the proposed amendments and to permit easy reference to the related Rule, those topics are listed in paragraphs 8 and 9, below, together with an indication of the Rules which are proposed to be amended in connection with each topic. However, the proposals for amendments which appear on the odd-numbered pages of this document and of documents PCT/CAL/III/3 and 4 are presented in the ascending order of the Rules and not grouped according to topics. Where necessary for the understanding of the proposed amendments, the explanatory notes which appear on the even-numbered pages of the said documents contain cross-references to the Rule or Rules which are proposed to be amended in the same context or for the same purpose or reason.

7. The following paragraphs contain a breakdown of the proposed amendments according to three main categories:

- proposed Rule changes primarily of interest to applicants;
- proposed Rule changes primarily of interest to Offices;
- proposed Rule changes primarily of interest to the International Bureau.

8. [Proposed Rule Changes Primarily of Interest to Applicants](#)

- a. Possibility to appoint agents having the right to practice before the International Preliminary Examining Authority for Chapter II processing: Rules 2.2, 53.5, 90.1(i), 90.3(e).
- b. Possibility to generate forms for the request and demand by computer: Rules 3.1, 3.4, 53.1(a).
- c. Simplification of the designation and election system: Rules 4.1(b), 4.9(a), 53.7.
- d. Possibility for designations subject to confirmation: Rules 4.9(b) and (c), 15.1 and 15.5, Schedule of Fees.
- e. Liberalization of correctable obvious errors“: Rules 4.10(b), 91.1(b) and (c).
- f. Liberalization of formal requirements: Rules 11.6(a), (e) and (f), 11.7(b), 11.8(b), 20.3bis .
- g. Liberalization of the refund of fees: Rules 15.6(b), 16.2, 57.6.
- h. Simplification of the system applicable in case of late payment of fees: Rule 16bis .
- i. Liberalization of the applicant requirements (who may file): Rules 18.3, 18.4(a) and (b), 26.5(c), 53.4, 54.2, 54.3, 54.4.
- j. Safeguard of the international filing date in case of filing with a receiving Office which is not competent: Rule 19.4.
- k. Liberalization of the requirements for the international filing date (only description and claims required in prescribed language): Rule 20.4(c).
- l. Liberalization of the consequences if the signature of the applicant is lacking: Rule 26.5(b).
- m. Clarification and simplification of withdrawals; all provisions combined in one Rule; time limit for withdrawals of priority claims extended: Rules 32, 32bis , 48.6(c), 75, 90bis .
- n. Inclusion of additional matter in the international search and the preliminary examination report: Rules 43.6, 70.12 and 70.13.
- o. Clarification in the Regulations that amendments under Article 19 must be filed with the International Bureau: Rule 46.2.

- p. Liberalization of translation requirements: Rules 49.5(c-*bis*), (h) and (k), 76.5.
- q. Possibility to start international preliminary examination earlier: Rules 53.2(a), 53.9, 60.1(e), 62, 66.1(a) to (c), 69.1(b) and (c).
- r. Safeguard if later elections are not filed with the International Bureau and simplification of formalities: Rules 56.1, 56.4.
- s. Simplification of the handling fee system: Rules 57.1(b), 57.2(a) and (b), 57.3(b) and (d), 57.4, 57.5, 72.1(a).
- t. Liberalization of demand correction time: Rule 60.1(a).
- u. Possibility for checking the correctness of elections: Rule 61.3.
- v. Extension of the time limit for amendments before the elected Office: Rule 78.1(a).
- w. Liberalization of possibilities for filing documents with the International Bureau: Rule 80.7(c).
- x. Liberalization of procedures relating to proof of mailing and delivery and related procedures: Rule 82.1.
- y. Possibility to file a power of attorney with the International Preliminary Examining Authority: Rule 90.3(b).
- z. Liberalization of transmittal by telecopier (facsimile): Rule 92.4.
- 9. [Proposed Rule Changes Primarily of Interest to Offices](#)
 - a. Possibility for the applicant to indicate a telecopier (facsimile) number: Rule 4.4(c).
 - b. Introduction of certain requirements concerning nucleotide and amino sequences in machine readable form: Rules 5.2, 39.1(vii), 67.1(vii).
 - c. Postponement of transmittal of the search copy until the search fee paid: Rule 23.1.
 - d. Postponement of the notice of designation and other notices to the designated or elected Offices, as well as of the communication of the international preliminary examination report, until the communication under Article 20: Rules 24.2(a), 29.1, 47.Ka), 47.4, 60.2(c), 73.2.
 - e. Clarification of the provision on relevant prior art for international search: Rule 33.1(c).
 - f. Modification of the minimum requirements for International Searching Authorities: Rule 36.1.
 - g. Simplification of the system for the establishment of the abstract: Rules 38.2, 44.2.
 - h. Modification of the time limit for international search and of matter contained in international search reports: Rules 42.1, 43.5(e), 43.7, 43.9.

- i. Deletion of the name of the receiving Office from correspondence: Rules 43.1, 53.6, 61.2(b), 70.3.
 - j. Replacement of signature requirements on certain forms by an indication of name of an authorized Officer: Rules 43.8, 70.14.
 - k. Notification to the International Preliminary Examining Authority of later elections no longer required: Rule 61.1(c).
 - l. Restriction of international preliminary examination to inventions on which an international search report has been established: Rules 66.1(d), 66.2(a)(vi), 68.1, 68.2, 70.2(d).
 - m. Liberalization of the requirements for free copies of documents: Rule 87.2(b).
 - n. Possibility to require the use of an official language for correspondence: Rule 92.2(a).
 - o. Simplification of the mailing of notifications: Rule 92.3.
10. [Proposed Rule Changes Primarily of Interest to the International Bureau](#)
- a. Deletion from publication in the Gazette of the abstract and of a drawing: Rules 3.3(a)(iii), 86.1(i).
 - b. Making available, after publication, copies of priority documents to third parties: Rule 17.2(b).
 - c. Changing of format and contents of the Gazette and other publication items: Rules 48.2(a)(viii) and (ix), 86.2 (a), 86.3, 86.4.
11. Further amendment proposals relate to Rules which have become obsolete or which are not needed for other reasons (Rules 15.4(d), 44.3(c), 49.5(e), 51*bis* .2(c), 71.2(c), 88.1(ii)). Rules 20.1(a) and 53.1(b) are amended in order to align them with the present practice. Rule 59.1 is amended in order to align it with the Treaty.
12. The detailed proposals relating to Part A and Part B of the Regulations (Rules 1 to 52) are contained in this document. Document PCT/CAL/III/3 contains the detailed proposals relating to Part C to Part F of the Regulations (Rules 53 to 96 and Schedule of Fees), except the proposals relating to Rule 86 (“The Gazette”), which will be contained in document PCT/CAL/III/4. The proposed amendments appear on the odd-numbered pages, whereas the corresponding explanations appear on the opposite even-numbered pages. In the text itself of the Rules proposed to be amended, underlinings indicate what is new as compared to the present text. Deletions of text matter in a given Rule are identified by asterisks.
13. [The Committee is invited to consider and advise the International Bureau on the proposed amendments contained in the present and other preparatory documents.](#)

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EXPLANATIONS OF THE PROPOSED AMENDMENTS

[Ad Rule 2.2](#)

1. [Present situation.](#) The present definition of “agent” under Rule 2.2 refers to Article 49 which means that only persons having the right to practice before the national Office with which the international application was filed are covered by that definition. Applicants from Japan and the United States of America, when filing a demand for international preliminary examination with the European Patent Office (EPO), often appoint a European professional representative for the international preliminary examination procedure before the EPO as International Preliminary Examining Authority. These European representatives are entitled to practice before the EPO but not before the national Offices of Japan or the United States of America, with which the international applications were filed.
2. [Proposed solution.](#) It is proposed to broaden, in a new sentence to be added to Rule 2.2, the definition of “agent” to include also persons having the right to practice before the International Preliminary Examining Authority to which the demand is submitted.
3. What is said here applies equally to the proposed amendments to Rules 53.5 and 90.1(i) (see document PCT/CAL/III/3).

TEXT OF THE PROPOSED AMENDMENTS

Rule 2

Interpretation of Certain Words

2.1 [No change]

2.2 “Agent”

Whenever the word “agent” is used, it shall be construed as meaning any person who has the right to practice before international authorities as defined in Article 49 and, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used, also the common representative referred to in Rule 4.8. For the purposes of the procedure under Chapter II of the Treaty, the word “agent” shall be construed as meaning also any person who has the right to practice before the International Preliminary Examining Authority to which the demand is submitted.

2.3 [No change]

Ad Rule 3.1

1. Present situation. At present, the request must always be made on a printed form. Applicants cannot make use of modern computer generated forms to file international applications.
2. Proposed solution. It is proposed to amend Rule 3.1 and to provide for future filing of international applications with the help of word processing equipment or computers and to allow that a request, instead of being prepared on a printed form, be presented in the form of a computer print-out in a similar layout but prepared by the applicant by the use of word processing equipment or computer. It is also proposed to modify the title of Rule 3.1 as a consequence of the possibility for filing a request without using the printed form.
3. A corresponding amendment is proposed to be made to Rule 53.1(a) relating to the use of a printed form for the demand.

Ad Rule 3.3

1. Present situation. The present wording of Rule 3.3 refers only to the filling-in of a printed form. Rule 3.3(a)(iii), in respect of the indication of the figure of the drawings to be published in the abstract, refers to the publication in the Gazette.
2. Proposed solution. It is proposed to amend Rule 3.3(a) and to delete in the first line the word "printed". This is in consequence of the proposed provision in Rule 3.1 which would allow for the possibility to present the request in a manner other than by using a printed form, namely, as a computer print-out. In Rule 3.3(a)(ii), it is proposed to change the words "whether or not" to "where" so that only where an item is accompanying the international application is an indication necessary. Rule 3.3(a)(iii) is proposed to be amended to remove reference to a drawing figure appearing in the Gazette because Rule 86.1(i) is proposed to be amended to delete the abstract and the drawing figure from the Gazette publication of the international application (see document PCT/CAL/III/4).

Rule 3

The Request (Form)

3.1 Form of Request*

The request shall be made on a printed form or be presented as a computer print-out.

3.2 [No change]

3.3 Check List

(a) The request shall contain a list which** will show:

(i) and (ii) [No change]

(iii) the number of that figure of the drawings which the applicant suggests should accompany the abstract when the abstract is published on the front page of the pamphlet***; in exceptional cases, the applicant may suggest more than one figure.

(b) [No change]

* The title has been amended to read "Form of Request" instead of "Printed Form".

** The amendment consists in deleting, after the word "which" the words, ", when filled in,".

*** The amendment consists in deleting, after the word "pamphlet," the words "and in the Gazette".

[Ad Rule 3.4](#)

1. [Present situation](#). The present wording of Rule 3.4 refers only to a printed form.
2. [Proposed solution](#). It is proposed to amend Rule 3.4 and to add to the matter the particulars of which would be prescribed in the Administrative Instructions a reference to a request presented in the form of a computer print-out. The Administrative Instructions will prescribe in particular the layout, in order to have some uniformity of style in computer generated request forms.

3.4 Particulars

Subject to Rule 3.3, particulars of the printed request form and of a request presented as a computer print-out shall be prescribed by the Administrative Instructions.

[Ad Rule 4.1\(b\)\(iv\)](#)

1. [Present situation.](#) Rule 4.1(b) (iv) requires that the request shall contain, for purposes of indicating a regional patent, “the names of” all the designated States. This is often an extended list and may be incomplete because of recent ratifications or accessions.
2. [Proposed solution.](#) It is proposed to delete the requirement in Rule 4.1(b)(iv) to list the individual Contracting States designated for a regional patent by name. This would make it easier to fill in the request. The proposal is also consequential to and consistent with the proposed amendment of Rule 4.9(a) (see below), which provides that it should be possible to designate all Contracting States party to a regional treaty by simply designating the regional Office.

Rule 4

The Request (Contents)

4.1 Mandatory and Optional Contents; Signature

(a) [No change]

(b) (i) to (iii) [No change]

(iv) an indication that the applicant wishes to obtain a regional patent and* the designated States for which he wishes to obtain such a patent

(v) [No change]

(c) and (d) [No change]

4.2 to 4.3 [No change]

4.4 Names and Addresses

(a) and (b) [No change]

* The amendment consists in deleting, after the words “regional patent and”, the words “the names of”.

Ad Rule 4.4(c)

1. Present situation. The provision recommending an indication, in addition to the address, of certain means of communication does not include the telecopier (facsimile machine) and therefore makes use of such equipment for communication difficult. It does, however, recommend to indicate a telegraphic address, which is almost never done. The present Rule also recommends, in the absence of a designation of an agent or common representative, listing of any teleprinter address or telephone number for the applicant first named without regard to whether that applicant is entitled to file an international application with that receiving Office.
2. Proposed solution. It is proposed to amend Rule 4.4(c) and to provide for the inclusion of the telecopier (facsimile) number in the request. This number is of essential importance for rapid communication of copies of documents to the applicant, agent or common representative. The increased worldwide use of this additional means of telecommunication supports the amendment. At the same time it is proposed to delete the recommendation to indicate a telegraphic address. Rule 4.4(c) is also proposed to be amended by adding at the end the requirement that the applicant for which address and telephone number information is given be an applicant who is entitled to file an international application with that receiving Office. Rule 4.8(b) provides that where there is more than one applicant, and no agent or common representative is named in the request, the applicant first named in the request who is entitled to file an international application with the receiving Office with which the international application was filed under Rule 19.1(a) shall be the common representative. It is important that communications be addressed to the common representative because only acts by or in relation to the common representative shall have any effect in the international application under Rule 90.2(b). They would be without effect if they were sent, as the Rule presently provides, to the first named applicant if that applicant was not at the same time the common representative.

[Rule 4.4, continued]

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. It is recommended to indicate any* teleprinter address as well as any telephone and telecopier numbers of the agent or common representative or, in the absence of the designation of an agent or common representative in the request, of the applicant first named in the request who is entitled to file an international application with the receiving Office with which the international application was filed.

(d) [No change]

* The amendment consists in deleting, after the words “indicate any”, the words “telegraphic and”.

Ad Rule 4.9(a)

1. Present situation. At present, the designation of States for the purposes of a patent under a regional patent treaty, such as the European Patent Convention or the Bangui Agreement (OAPI), must be made by an indication of the name of the individual States and, if there is also a national patent available, by an indication that protection under a regional patent treaty is desired for the State indicated. In order to facilitate the designation for a patent under a regional patent treaty, the present request form provides the possibility for a designation “en bloc” for the purposes of a regional patent granted by the European Patent Office (EPO) or by the African Intellectual Property Organization (OAPI) by listing, next to the check box for a European or OAPI patent, all the names of the States which, at the time of printing the form, are party to both the PCT and the regional patent treaty concerned. When, later, a State which is party to the regional patent treaty becomes a PCT Contracting State or, *vice versa*, a PCT Contracting State becomes a party to the regional patent treaty, or a State becomes party to both the PCT and the regional patent treaty, applicants often forget to supplement a designation for a regional patent by the designation of such State not listed on the request form.
2. Proposed solution. It is therefore proposed to amend Rule 4.9 and to provide in a new paragraph (a) for the designation of States for the purposes of a patent under a regional patent treaty by an indication of the regional Office, e.g. the EPO or OAPI, which would automatically include all States eligible at the time of filing the request.
3. The proposed amendment is intended to make the PCT system simpler and safer by providing that any designation for a regional patent is always a designation for all States which are, at the time of filing, party to both the PCT and the regional patent treaty. Where an applicant does not wish to designate all PCT Contracting States which are party to the regional system, then he may still expressly limit such a designation by indicating the individual Contracting States. The latter, however, is possible only in respect of a European patent. The designation for an OAPI patent always has effect in all PCT Contracting States party to the Bangui Agreement and a limitation to individual Contracting States is not possible under that Agreement. It should be noted that only one designation fee is required for the purposes of all States designated under a regional treaty (Rule 15.1(ii)). When the national (regional) phase is entered, applicants may choose certain States before the EPO by paying only the EPO designation fees for those States for which a European patent is desired.
4. It is also proposed to amend the Rule 4.9 to provide for the possibility to indicate only the country code as provided for in Annex B of the Administrative Instructions, instead of having to write the name of the Contracting State in full. The reason for this is that the request form could be reduced in volume. In practice it is already accepted that the nationality or residence of applicants, inventors and agents can be indicated not only by the name of the State in full, but also as an alternative by the country code. The same should apply to designations.

4.5 to 4.8 [No change]

4.9 Designation of States

(a) Contracting States shall be designated in the request individually by their names or the two-letter codes as provided in the Administrative Instructions. If the applicant wishes the grant of a patent under a regional patent treaty, as provided for in Article 45, the Contracting States party to that treaty may be designated for that purpose by the name of the regional Office or by the said two-letter codes. Such a designation of a regional Office is considered to be the designation for the grant of a patent under the regional patent treaty of all Contracting States party to that treaty on the international filing date.

Ad Rule 4.9(b) and (c)

1. Present situation. Problems often result from applicants requesting the correction of errors in designations or requesting that additional designations be added to the request form after the filing date. This is not possible because Article 4(1) (ii) requires all designations to be in the request upon filing.

2. Proposed solution. It is proposed to add a paragraph (b) to Rule 4.9 and to provide that the request may include a text to the effect that, subject to confirmation, in addition to the States designated according to Rule 4.9(a) all other States are designated which are party to the PCT at the time of filing the international application. In the printed request form, this could be done by the inclusion of a check-box in which the marking is already printed. The effect of such a designation subject to confirmation is mainly to help applicants in cases where no State at all was designated, depriving the applicant of a filing date, and in cases where the applicant inadvertently omitted to designate a specific Contracting State for which he had intended to obtain patent protection. Such a designation subject to confirmation would be sufficient for the requirement of according a filing date under Article 11. Further, it would allow the applicant to correct the omission of any designation by paying the fee for the confirmation of that designation together with a specification, provided for in Rule 4.9(a), of the name(s) or the country code(s) of the State(s) or regional patent system(s) where he desires protection and for which the confirmation fee is paid.

3. In addition, it is proposed to provide in a new paragraph (c) to Rule 4.9 that any designation subject to confirmation is automatically considered not to have been made if it has not been confirmed before the expiry of the applicable time limit, i.e. if the applicant did not pay the fee for the confirmation of a designation and failed to specify the State or designated Office for which the confirmation fee is intended (see also the proposed amendment to Rule 15.5, below). This would relieve the receiving Office from making a declaration as to the fate of the designation in accordance with Article 14.

[Rule 4.9, continued]

(b) The request may contain a statement that all Contracting States other than the Contracting States designated under paragraph (a) are designated subject to later confirmation.

(c) Any designation under paragraph (b) shall be considered not to have been made if it is not confirmed through the receipt, by the International Bureau, before the expiration of 16 months from the priority date, of a notice from the applicant stating that he confirms that designation and of the confirmation fee referred to in Rule 15.5. In the notice, designations shall be confirmed in the manner provided for in paragraph (a).

[Ad Rule 4.10\(b\)](#)

1. [Present situation.](#) Rule 4.10(b) provides that where priority is claimed in an international application and the indication in the request of the country- or date of the earlier application is missing or erroneous or, in case the earlier application is a regional or an international application, the indication of at least one country for which the earlier application was filed, and of the date on which the earlier application was filed, is missing or erroneous, the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made, subject to an exception. The exception applies currently only where the identity or correct identity of the country or date or correct date may be established on the basis of the copy of the earlier application [which reaches the receiving Office before it transmits the record copy to the International Bureau](#). Then the error shall be considered an obvious error. The present time period, limited by the transmittal of the record copy to the International Bureau, is fairly short and restricts correction where the correct data can be easily established at a later date on the basis of a copy of the earlier application.
2. [Proposed solution.](#) It is proposed to amend Rule 4.10(b) by deleting the present limitation of the rectification of an obvious error to cases where the earlier application, which establishes the identity or correct identity of the country or the date or the correct date, is received by the receiving Office before the record copy is transmitted to the International Bureau. The amendment would have the effect that the missing or erroneous indication of the country or date would be subject to the general time limits of receipt provided for in Rule 91, i.e., the receiving Office makes the rectification in time to notify the International Bureau before the expiration of 17 months from the priority date, subject to the special provisions of Rule 91.1(g-bis) to (g-*quater*). The present limitation that rectifications are possible only until the transmittal of the record copy is unnecessary and it would be in the interest of the public that the international application is published with a correct indication of the priority claimed.

4.10 Priority Claim

- (a) [No change]
- (b) If the request does not indicate both
 - (i) [No change]
 - (ii) [No change]

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made except where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous; whenever the identity or correct identity of the said country, or the said date or the correct date, may be established on the basis of the copy of the earlier application*, the error shall be considered as an obvious error,

- (c) to (e) [No change]

4.11 to 4.17 [No change]

*

The amendment consists in deleting, after the word “application,” the words “which reaches the receiving Office before it transmits the record copy to the International Bureau”.

Ad Rule 5.2

1. Present situation. Rule 5 provides general guidance for the content of the description of the invention. It does not, at present, provide for a standardized format for description of nucleotide and amino acid sequence data and its submission in computer readable form which is required to permit proper search and examination of applications containing such data.
2. Proposed solution. It is proposed to add a new Rule 5.2 relating to disclosures of nucleotide and/or amino acid sequences in international applications. Rule 5.2(a)(i) would provide for any such sequences being placed at the end of the description and the use of symbols to be prescribed in the Administrative Instructions. Rule 5.2. (a) (ii) would provide for the furnishing of a copy of the sequence listing in a computer readable form to permit proper search and examination of the international application (see also proposed amendment to Rule 39.1, below). That copy would not form part of the record copy or communication under Article 20. Designated Offices could, however, require the applicant to furnish a copy of the computer readable form of the sequence after national processing has begun. The sequence listings are usually so complex and long that the only satisfactory method of search and examination is to compare the sequence disclosed in an application with the sequences appearing in the existing data bases.
3. Rule 5.2(b) would provide for symbols and a uniform format for sequence listings in the Administrative Instructions so that computerized search and examination would be possible.

Rule 5

The Description

5.1 [No change]

5.2 Nucleotide and/or amino acid sequence disclosure

(a) International applications which contain disclosure of a nucleotide and/or an amino acid sequence shall:

(i) contain at the end of the description, but before the claims, a listing of the sequence using symbols, and

(ii) be accompanied, for the purposes of international search and possible international preliminary examination, by a copy of the sequence listing in computer readable form. That copy shall not form a part of the international application for the purposes of the record copy and communication under Article 20. The designated Office may require the applicant to furnish a copy of the sequence listing in computer readable form once the processing of the international application has started.

(b) The symbols to be used as well as the format of the sequence listing in computer readable form shall be prescribed by the Administrative Instructions.

Ad Rule 11.6 (a)

1. Present situation. At present, Rule 11.6(a) provides for minimum margins for all sheets making up the international application, including the request form. The request form, however, which is currently a printed form, does not itself comply with the minimum margins provided for under this Rule and the printed form has never done so. The purpose of the minimum margins is to guarantee a reasonably uniform international publication of the international application. Since the request form is not published as part of the pamphlet, there is no need to apply the minimum margins requirements to the request.
2. Proposed solution. It is therefore proposed to delete the request from the listing of those sheets which must comply with the minimum margins to avoid conflict of the request form margins with this Rule.

Ad Rule 11.6(e)

1. Present situation. Current Rule 11.6(e) provides that the margins of the international application, when submitted, must be completely blank. This Rule is not compatible with WIPO Standard ST.22, "Recommendation for the presentation of patent applications typed in optical character recognition (OCR) format." Paragraph 7(e) of that Standard provides that "any applicants' or representatives' references should appear in the margin at the top" and that "line numbering, if given, should be ... in the left hand margin area".
2. Proposed solution. In order to make the standard ST.22 and Rule 11.6(e) compatible, it is proposed to amend Rule 11.6(e) by making it subject to Rule 11.6(f) relating to applicant's file reference and subject to Rule 11.8(b) relating to line numbers. The two exceptions are proposed to be provided in the said Rules as explained below relative to those Rules.

Ad Rule 11.6(f)

1. Present situation. Present Rule 11.6(e) requires all margins to be completely blank. This provision prohibits the applicant from placing his applicant's file reference in the margin of sheets of the international application.
2. Proposed solution. The proposed new Rule 11.6(f) provides for an exception to the general Rule laid down in Rule 11.6(e) by allowing expressly that applicants may indicate an applicant's file reference in the top margin. If such an applicant's file reference is indicated within 1.5 cm from the top of the sheet, it will not negatively affect a reasonably uniform international publication of international applications since the reference will not appear in the top margin of the pamphlet.

Rule 11

Physical Requirements
of the International Application

11.1 to 11.5 [No change]

11.6 Margins

(a) The minimum margins of the sheets containing* the description, the claims, and the abstract, shall be as follows:

- top: 2 cm

- left side: 2.5 cm

- right side: 2 cm

- bottom: 2 cm

(b) to (d) [No change]

(e) Subject to paragraph (f) and to Rule 11.8(b), the margins of the international application, when submitted, must be completely blank.

(f) The top margin may contain in the left-hand corner an indication of applicant's file reference not exceeding ten characters, provided that the reference does not appear beneath 1.5 cm from the top of the sheet

* The amendment consists in deleting, after the word “containing” the words “the request.”.

[Ad Rule 11.7\(b\)](#)

1. **Present situation.** The present Rule only allows for the consecutive Arabic numerals numbering the sheets contained in the international application to be placed in the middle at the top of the sheet. Word processing equipment and printers do not always allow for such flexibility as to provide for the numerals indicating the consecutive number of the sheet to be placed at the top of the page, though it normally allows for the number to be centered between the sides of the page.
2. **Proposed solution.** It is proposed to amend the Rule to comply with suggestions made by users that provision be made in the Regulations that the page number should also be able to be placed centered at the bottom of the sheet. The requirement that it shall be in the middle or centered is not changed, also the absolute prohibition of placing the numbers in the margins has not been changed.

[Ad Rule 11.8\(b\)](#)

1. **Present situation.** Present Rule 11.8(b) requires that all line numbers appear on the left side, to the right of the margin. WIPO Standard ST.22, "Recommendation for the presentation of patent applications typed in optical character recognition (OCR) format" provides in paragraph 1.2.1.1) that "... line numbering, if given, should be... in the left-hand margin area... ". Rule 11.8(b) is not compatible with this Standard.
2. **Proposed solution.** The proposed amendment to Rule 11.8(b) provides for an exception to the general Rule to leave the margin blank by giving applicants the option to put the numbering of lines on the left-hand side of the sheet either within or outside the left-hand margin in conformity with WIPO Standard ST.22. This would solve the conflict between the present Rule and WIPO Standard ST.22. Both formats are acceptable with regard to a reasonably uniform international publication of international applications.

11.7 [Numbering of sheets](#)

(a) [No change]

(b) The numbers shall be [centered](#) at the top [or bottom](#) of the sheet,* but [shall](#) not [be placed](#) in the margin.

11.8 [Numbering of Lines](#)

(a) [No change]

(b) The numbers should appear on the left side, [preferably](#) to the right of the margin, [but the numbers may also appear in the left margin](#).

11.9 to 11.14 [No change]

* The amendment consists in deleting, before the word “but”, the words “in the middle.”.

Ad Rules 15.1 and 15.5

1. Present situation. Under the proposed system of Rule 4.9(b) providing for designations subject to confirmation, a special fee for the confirmation of designations is required (see Rule 4.9(b) and (c), above).
2. Proposed solution. It is proposed to provide in Rule 15.5 for the payment of the fee for the confirmation of a designation made under Rule 4.9(b). This fee would consist of the amount fixed under item 2 of the Schedule of Fees annexed to the Regulations augmented by a surcharge of 50%. The surcharge of 50% is proposed to be required in order to prevent an abuse of this designation system and to ensure that such a late payment of fees connected with designations is the exception rather than the rule. It is further proposed that in this special case applicants pay directly and in Swiss currency to the International Bureau in order to avoid any further burden on the receiving Office. When making the payment of the said fee applicants must specify in a notice to the International Bureau the designation of the State or regional Office for which the confirmation fee is intended (see Rule 4.9(b), above).
3. It should be noted that the confirmation fee replaces, for any designation made under Rule 4.9(b) and confirmed under Rule 4.9(c), the designation fee referred to in Rules 15.1 to 15.4 and 15.6. Consequently, the provisions of Rule 16*bis* would not apply to the confirmation fee because any reference in Rule 16*bis* to the designation fee is a reference to the designation fee referred to in Rules 15.1 to 15.4 and 15.6 and not to the proposed new fee for confirmation. However, for the removal of doubt, it is proposed to expressly state in the new Rule that Rule 16*bis* does not apply to the confirmation fee.
4. The amendment to Rule 15.1(ii) is proposed to make it clear that the “designation fee” is the fee payable for a designation made in the request pursuant to Rule 4.9(a) and to distinguish that fee clearly from the new fee for confirmation of designations, under Rule 15.5.

Ad Rule 15.4(d)

1. Present situation. Present Rule 15.4(d) provides for a transition period which appears to be no longer needed.
2. Proposed amendment. In order to remove unnecessary wording and concepts from the Rules, it is proposed that paragraph (d) of Rule 15.4 be deleted.

Rule 15The International Fee15.1 Basic Fee and Designation Fee

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau (“international fee”) to be collected by the receiving Office and consisting of,

(i) a “basic fee,” and

(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a) by the applicant in the international application, except that, where Article 44 applies in respect of a designation, only one designation fee shall be due.

15.2 and 15.3 [No change]

15.4 (a) to (c) [No change]

(d) [Deleted]

15.5 Fee for Confirmation of Designations

The confirmation fee referred to in Rule 4.9(c) shall consist of the amount, specified in item 2 of the Schedule of Fees annexed to these Regulations, for a designation, augmented by a surcharge of 50%. That fee is due irrespective of the number of designation fees due on account of designations made under Rule 4.9(a) and shall be payable in Swiss currency. Rule 1?bis does not apply to that fee.

[Ad Rule 15.6\(b\)](#)

1. [Present situation](#). Present Rule 15.6(a) provides that the international fee shall be refunded if the international application is not accorded a date of filing under Article 11(1). Further, it is stipulated in Rule 15.6(b) that in no other case shall the international fee be refunded. This severely limits the situations in which international fees may be refunded.
2. Practice under the past 11 years of operation under the PCT has shown that there are certain special cases other than the one covered by Rule 15.6(a) where it would have been justified also to refund the international fee to the applicant. However, it is difficult to find a general formula to cover all the different cases where a refund would be equitable. For example, an international application is filed and the international fee as well as the transmittal fee, if any, and the search fee are paid; due to a misunderstanding, however, the filing did not correspond to the intention of the applicant and within a very short time after filing the international application is withdrawn. At present, the receiving Office can refund the transmittal fee, and the International Searching Authority can refund the search fee in accordance with its agreement with WIPO if the search has not yet started. Only the international fee, which is a substantial one, cannot be refunded under the present rules.
3. [Proposed solution](#). The proposal is to amend Rule 15.6(b) to provide for refund of the international fee if the international application is withdrawn before the transmittal of the record copy to the International Bureau and to no longer exclude expressly the refund of the international fee in other cases. For reasons of equity, it may be justified to refund the international fee in some exceptional circumstances. It should be left to the International Bureau to decide about the refunds in such exceptional cases.

15.6 Refund

(a) [No change]

(b) The international fee shall be refunded to the applicant if the international application is withdrawn before the transmittal of the record copy to the International Bureau.

Ad Rule 16.2

1. Present situation. The search fee is due within one month from the time of filing the international application. The search fee is for the benefit of the International Searching Authority and is collected by the receiving Office. The receiving Office transmits the international search fee to the International Searching Authority.
2. According to the present Rule 16.2, the search fee shall be refunded in full when the international application is not accorded a filing date under Article 11(1). Further, the international search fee is refunded fully or in part in accordance with present Rules 16.3 and 41 as well as with the agreements between the International Searching Authorities and WIPO.
3. The receiving Office collects the search fee for the International Searching Authority. The Rules do not make it clear whether, under certain circumstances, the receiving Office could refund the search fee directly to the applicant or whether the receiving Office has to transmit the fee to the International Searching Authority and let that Authority decide on the refund. This practice is cumbersome for the applicant, the receiving Office and the International Searching Authority. Therefore, an agreement exists between certain receiving Offices and International Searching Authorities, to the effect that if the international application is withdrawn before the search copy has been transmitted to the International Searching Authority, the receiving Office is empowered to refund the search fee to the applicant.
4. Proposed solution. It is proposed to amend Rule 16.2 to the effect that the practice of some Authorities is incorporated in the PCT, making it clear that the search fee shall, in addition to the cases governed by Rule 16.3 and Rule 41.1, be refunded to the applicant in two cases, namely, where the determination under Article 11(1) is negative (the present Rule) and where the international application has been withdrawn and the search copy has not yet been transmitted to the International Searching Authority (a new provision). It is also proposed to amend the text of the Rule so that refunds would be made in both situations by the receiving Office.

Rule 16

The Search Fee

16.1 [No change]

16.2 Refund

The search fee shall be refunded to the applicant by the receiving Office if:

- (i) the determination under Article 11(1) is negative, or
- (ii) if the international application is withdrawn before the transmittal of the search copy to the International Searching Authority.

16.3 [No change]

Ad Rule 16bis

1. Present situation. The present procedure under Rule 16bis which is applicable when the applicant does not pay, within the applicable time limit, the transmittal fee, the basic fee, the designation fees and the search fee, has proved to be an excellent safeguard. However, this procedure is cumbersome for the parties concerned, the receiving Offices, the International Bureau and the applicant. The receiving Office, instead of inviting the applicant to pay any missing amount, charges that amount to the International Bureau in Geneva and notifies that Bureau of the charge made. The International Bureau issues an invitation to the applicant to pay any missing amount to its bank account in Geneva within one month. If this payment is not made, the International Bureau informs the receiving Office, which then declares that the international application is considered withdrawn and notifies the applicant thereof.
2. Proposed solution. The proposed new procedure under Rule 16bis .1 provides that the receiving Office, instead of notifying the International Bureau in Geneva of any lack of fees paid, itself invites the applicant to pay such fees. Thus, the applicant will be informed earlier than under the present procedure that there are still certain fee amounts due in respect of his international application. The applicant would pay fees due directly to his receiving Office in the currency of the receiving Office within the period of grace provided in the invitation. This procedure would provide a simplified and rationalized procedure without putting an additional burden on the receiving Office, on the one hand, but with the effect of improving considerably the situation of the applicant by a caution notice and easier payment to the receiving Office within a period of grace and relieving the receiving Office and the International Bureau from the present costly and cumbersome procedure, on the other hand.
3. The workload for the receiving Office would, compared to the present procedure under Rule 16bis , not increase under the new procedure. However, under the new procedure, the receiving Offices would receive compensation for their work, by earning any amount paid as a surcharge for late payment, which amount is at present paid to and retained by the International Bureau.
4. Under the proposed procedure, applicants will no longer be obliged to make payment to the International Bureau in Geneva, Switzerland in the form of a reimbursement. Thus, payment of any amount due to the receiving Office can be made simpler, cheaper and faster. Furthermore, the problems which exist under the present system if the applicant pays erroneously to the receiving Office instead of to the International Bureau, or if payments are received by the receiving Office after it has notified the International Bureau, would be solved. Moreover, the receiving Office would be in a position to declare an international application withdrawn if the applicant failed to pay the amount specified in the invitation without having to wait for a notification from the International Bureau. The proposed procedure is basically a provision for an extension of the time at which certain fees are due and is therefore fully consistent with the PCT Articles.

Rule 16bisLate Payment of Fees^{*}16bis .1 Invitation by the Receiving Office^{**}

(a) Where, by the time they are due under Rule 14.1(b), Rule 15.4(a) and Rule 16.1(f), the receiving Office finds that in respect of an international application no fees were paid to it by the applicant, or that the amount paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and the search fee, the receiving Office shall invite the applicant to pay the fees, or the missing part thereof, together with a surcharge, within one month from the date of the invitation.

(b) Where, by the time they are due under Rule 15.4(b), the receiving Office finds that in respect of an international application the payment made by the applicant is insufficient to cover the designation fees necessary to cover all the designations, the receiving Office shall invite the applicant to pay the amount required to cover those fees, together with a surcharge, within one month from the date of the notification.

(c) The invitation shall refer to the fees due under both paragraphs (a) and (b) unless the fees under Rule 15.4(b) become due more than one month after the fees under Rule 15.4(a); in the latter case, there shall be two separate invitations.

* The title has been amended to read “Late Payment of Fees” instead of “Advancing Fees by the International Bureau”.

** The title has been amended to read “Invitation by the Receiving Office” instead of “Guarantee by the International Bureau”.

[Ad Rule 16bis , continued]

5. The proposed procedure would help to avoid the situation where the international search starts without the search fee having been paid, in particular where the receiving Office and the International Searching Authority are the same Office, which is the case for the majority of international applications. The receiving Office could withhold forwarding of the search copy to the International Searching Authority until receipt of payment of the search fee (see the proposed amendment to Rule 23.1(a)). This processing would be much quicker than under the present procedure where payment is made to the International Bureau, which then, in turn, informs the receiving Office and the International Searching Authority. It would also allow the International Searching Authority to start the international search earlier and only after the search fee has been paid by the applicant.

6. As to the surcharge it is proposed in Rule 16bis .1(f), in addition to the general Rule of being 50% of the outstanding fees, to determine the minimum and the maximum amount in a general manner which would avoid the need to adjust these amounts later specifically. It is proposed that the minimum payable to each receiving Office would be equivalent to the transmittal fee charged by it and that the maximum would correspond to the basic fee part of the international fee.

7. The provisions of present Rule 16bis .2 are no longer required under the new system, including Rule 16bis.2(a), referring to the surcharge of 50% in the Schedule of Fees (for the latter, see also below “Ad Rule 96, The Schedule of Fees”). The possibility provided in the second sentence of present Rule 16bis .2(a) is now reflected in proposed Rule 16bis .1(c), but with a changed contents. Normally, there shall be one invitation for the fees payable under Rule 15.4(a) and (b). However, if the fees become due at different dates, two separate invitations shall be issued whenever the designation fee becomes due more than one month later than the basic fee. The allocation of monies will continue to be governed by the Administrative Instructions in Section 321, which will be modified if the amendments to Rule 16bis are adopted.

8. However, it is not proposed to delete Rule 16bis .2 but to change its contents. Experience has shown that a few particular applicants have a practice of filing regularly applications without ever paying any fee or of paying by cheques which are not honored. The processing of the international application in such a case, the application of the procedure under Rule 16bis and the sending of notices requesting payment, are a waste of resources. Accordingly, it is proposed to amend Rule 16bis .2 to authorize the receiving Office not to process the international application in such a case, but to require first that all payments be made in a guaranteed payment form such as money order or certified cheque. If such payment is not received by the due dates, referred to in Rule 16bis .1(a) or (b), the receiving Office would be entitled to return all papers received to the applicant. It is expected that the provisions of this Rule would be used only in very exceptional situations.

[Rule 16bis .1, continued]

(d) The allocation of moneys paid to the receiving Office which are not sufficient to cover all the amounts specified in the invitation, including the surcharge, shall be governed by the Administrative Instructions.

(e) If, within the one-month time limit specified in the invitation, the applicant does not pay the amount, including the surcharge, specified in the invitation or pays it only partially, the receiving Office shall make the applicable finding under Article 14(3).

(f) The amount of the surcharge shall be 50% of the amount specified in the invitation. It shall not be less than the transmittal fee and shall not exceed a maximum which is equivalent to the amount of the basic fee part of the international fee referred to under item 1(a) of the Schedule of Fees.

16bis .2 Advance Payment in Special Cases^{*}

Where, based on past experience, it is notorious that a particular applicant has been found to seldom or never pay fees due, the receiving Office may require all payments to be made by money order or certified cheque and may suspend the processing of the international application until the fees due have been so paid. Where, by the time these fees are due under Rule 14.1(b), Rule 15.4 and Rule 16.1(f), payment has not been received, the receiving Office may return all papers submitted by the applicant.

* The title has been amended to read “Advance Payment in Special Cases” instead of “Obligations of the Applicant, Etc.”

Ad Rule 17.2(b)

1. Present situation. The present Rule 17.2(b) prevents the International Bureau from making available priority documents prior to the international publication of the international application. After that publication, the International Bureau receives an increasing number of requests from third parties, asking for copies of priority documents. When this Committee (PCT/CAL), at its first meeting in September 1982, discussed a proposal for an amendment to Rule 17.2(b), it was agreed that the supplying of copies of priority documents should be left to the designated Offices or to the national Office with which the priority application was filed, and the proposal to amend Rule 17.2(b) was withdrawn. The International Bureau has since referred requesting parties to the designated Offices or to the said national Office, but that procedure has proven to be unsatisfactory. Indeed, if the earlier application was withdrawn or rejected before its publication or not yet published or open to public inspection, copies of the priority document cannot be obtained from the said national office. As far as the possibility is concerned to obtain copies from the designated Offices, the majority of them do not receive a copy of the priority document on a regular basis. They request such copy only if, during the national phase, need for the inspection of such documents arises. Only some designated Offices request to be supplied with copies of priority documents for all international applications in which they are designated. Therefore, there are only some designated Offices from which third parties may obtain copies of priority documents after international publication. Third parties do not usually know which of the designated Offices receives regularly copies of priority documents. It is therefore only normal that they address a request for a copy of the priority document to the International Bureau.

2. Proposed solution. The obligation to keep priority documents confidential ends once an international application has been published. There is no need for the International Bureau to refer third parties to designated Offices where the file is open to public inspection and to refuse the making available of copies of priority documents. It is therefore proposed to provide in Rule 17.2(b) that, after international publication, the International Bureau shall, upon request and subject to the payment of the charges for the service, furnish copies of priority documents to third parties.

Rule 17

The Priority Document

17.1 [No change]

17.2 Availability of Copies

(a) [No change]

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application. After such publication, the International Bureau shall, upon request by any person and subject to payment of a fee covering the cost of preparing and mailing, furnish copies of the priority document.

(c) [No change]

[Ad Rules 18.3 and 18.4](#)

1. [Present situation](#). The present Rule 18.4 requires that, in respect of each designated State, at least one of the applicants indicated for the purpose of that State must be entitled to file an international application according to Article 9. Applicants have encountered difficulties with this provision which may be illustrated by the following example. A corporate applicant may not file an international application designating the United States of America because, for the purpose of that State, only the inventor may be the applicant. Therefore, the inventor must be indicated in such an international application as applicant for the United States of America. If such inventor is not a national or resident of a PCT Contracting State, the United States of America cannot be designated in the international application. This is sometimes overlooked by applicants when filing an international application. Or, if applicants are aware of the problem, it is often a reason not to file a PCT application because, if a separate national application has to be filed in the United States of America, no advantage can be taken of the full benefits of the PCT.
2. [Proposed solution](#). It is proposed to amend Rule 18.3, including its title, by providing that the provisions which apply for several applicants for the purposes of all designated States apply also if they are different applicants for the purposes of different designated States. Thus, it would be sufficient if at least one of several applicants is entitled to file an international application according to Article 9, irrespective of whether the applicants are the same for all designated States or different for different designated States. As a consequence to the proposal to amend Rule 18.3, the provisions in Rule 18.4(a) and (b) would become superfluous. It is suggested that these provisions be deleted and that the title of Rule 18.4 be amended to reflect only the remaining contents of this Rule.

Rule 18

The Applicant

18.1 to 18.2 [No change]

18.3 Several Applicants: Same for all Designated States or Different for Different Designated States**

If there are several applicants, the right to file an international application shall exist if at least one of them is entitled to file an international application according to Article 9.

18.4 Information on Requirements Under National Law as to Applicants **

(a) and (b) [Deleted]

(c) [No change]

* The title has been amended by adding the words “or Different for Different Designated States”.

** The title has been amended to read “Information on Requirements Under National Law as to Applicants” instead of “Several Applicants: Different for Different Designated States”.

Ad Rule 19.4

1. Present situation. In the present world, where nationality and residence of the inventor might not correspond to those of the applicant, it happens not infrequently that the international application is filed with the “wrong” receiving Office. If the receiving Office is not competent, the finding under Article 11 is negative and no filing date is accorded for the international application. This leads to loss of rights, such as the priority right, if the applicant cannot quickly act and refile the international application with the correct receiving Office. However, this is excluded in practice where the international application contains a priority claim and has been filed at the end of the priority year. In such a case the receiving Office, where the international application was incorrectly filed, makes the determination that it is not competent too late to permit a refiling of the international application within the priority year. Sometimes weeks may pass before the applicant is notified that he obviously lacks the right to file at that specific Office under Article 11(1) (i) due to lack of a proper residence or nationality.
2. Proposed solution. To solve the problem, it is proposed to add a new Rule 19.4. The proposed Rule stipulates, in paragraph (a), that the non-competent receiving Office which received the international application must promptly inform the applicant that it is not competent. The applicant may request within 14 days the transmittal of the international application to a receiving Office specified by the applicant in his request for transmittal. Furthermore, it is provided, in paragraph (b) of the Rule, that the date of receipt of the application at the first Office is accepted as the date of receipt by the second Office. This ensures, in case all other requirements of Article 11 are fulfilled, that the latter receiving Office can accord, as the filing date of the international application, the date of actual receipt by the first receiving Office. In other words, it is accepted that the first Office acts as kind of an agent of the second receiving Office.
3. In practice, the first Office would promptly contact the applicant, invite him to make a request to transmit the application to the competent receiving Office and at the same time inform him to pay the appropriate fees at that competent receiving Office. The applicant should be informed that he must indicate the Office to which he wants the application to be transmitted.
4. The receiving Office transmitting the international application would refund under paragraph (c) of the Rule any amount paid to cover the international and the search fee. As far as any amount paid for the transmittal fee is concerned, the non-competent receiving Office would be entitled to keep any transmittal fee paid in order to cover the costs associated with the procedure under this Rule and to discourage applicants from abusing this procedure and from using it as a regular method of filing.

Rule 19

The Competent Receiving Office

19.1 to 19.3 [No change]

19.4 Transmittal to Competent Receiving Office

(a) Where a receiving Office finds that it is not competent under Rule 19.1 (“non-competent receiving Office”), it shall promptly notify the applicant of that fact. The non-competent receiving Office shall promptly transmit the international application to the receiving Office specified by the applicant if it receives a request to that effect from the applicant within 14 days from the date of the notification.

(b) The date on which the international application was actually received by the non-competent receiving Office transmitting it to the receiving Office specified by the applicant shall be considered by the latter receiving Office to be the date of actual receipt by it.

(c) The non-competent receiving Office transmitting the international application to the receiving Office specified by the applicant shall refund any amount paid for the international fee and the search fee. It may keep any amount paid for the transmittal fee.

Ad Rule 20.1

1. Present situation. At present, Rule 20.1(a) consists of two parts. The first deals with the indelible marking of the date of actual receipt by the receiving Office. The second part provides that the receiving Office shall mark the number assigned by the International Bureau on each sheet of each copy received. This Rule does not correspond to the practice as the International Bureau does not, in actual fact, assign any specific numbers to the receiving Offices. The current practice is established in Section 307 of the Administrative Instructions.
2. Proposed solution. It is proposed to amend Rule 20.1(a) and to refer only to the international application number without any further details as to who assigns it.

Ad Rule 20.3bis

1. Present situation. The present Rule has never been implemented. The Administrative Instructions do not prescribe the manner in which corrections required under Article 11(2) (a) shall be presented by the applicant.
2. Proposed solution. It is proposed to delete Rule 20.3bis since experience during past years has shown that there is no need for special provisions in the Administrative Instructions relating to the manner of carrying out corrections of defects under Article 11. It is misleading that the present Rule refers to the Administrative Instructions and these Instructions do not prescribe any details.

Ad Rule 20.4(c)

1. Present situation. An international application must be in the prescribed language, otherwise the receiving Office does not accord an international filing date (Article 11(1)(U)). An international application as provided under Article 3(2) shall contain a request, a description, claims and, where required, drawings. -It happens occasionally that applicants file the request on a printed form which is in a language different from the language of the international application. It also happens that applicants overlook that drawings filed with the international application contain words in a language different from the language used in the description and the claims of the international application. Refusing an international filing date in case of such a minor defect due to an oversight appears to be much too severe a sanction. Receiving Offices have in the past usually allowed a correction of such a defect without affecting the international filing date.
2. Proposed solution. It is proposed here to generalize that practice and to provide expressly that failure to use the prescribed language for parts of the international application other than the description and the claims does not prevent the according of an international filing date, if the defect is corrected subsequently within the time limit fixed by the receiving Office for that purpose in its invitation for correction.

Rule 20

Receipt of the International Application

20.1 Date and Number

(a) Upon receipt of papers purporting to be an international application, the receiving Office shall indelibly mark the date of actual receipt in the space provided for that purpose in the request form of each copy received and the international application number on each sheet of each copy received.

(b) [No change]

20.2 to 20.3 [No change]

20.3bis Manner of Carrying Out Corrections

[Deleted]

20.4 Determination under Article 11(1)

(a) and (b) [No change]

(c) For the purposes of Article 11(1) (ii), it shall be sufficient if the description and the claims are in the prescribed language, provided that the applicant completes the international application in the prescribed language within the time limit fixed by the receiving Office in an invitation to correct the defect.

20.5 to 20.9 [No change]

Ad Rule 23.1

1. Present situation. Current Rule 23.1(a) requires that the search copy be forwarded to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau. It is to everyone's benefit to forward both the record copy and the search copy as early as possible. However, in case of non-payment of the search fee, it would be beneficial to delay forwarding of the search copy. Such delay is not possible under the present rule.
2. Rule 23.1(b) provides for a monitoring system by the International Bureau and transmittal of a copy of the international application to the International Searching Authority. This system is linked to the transmittal of the record copy at the same time as the search copy. It would no longer work where, because of non-payment of the search fee, the forwarding of the search copy is delayed as proposed under amended Rule 23.1(a). Moreover, past experience has shown that this procedure is not necessary because the International Searching Authority is informed by the International Bureau, under Rule 24.2, about the receipt of the record copy. This, together with the notice under Rule 25 of the receipt of the search copy, should ensure follow-up in case forwarding of the search copy is overlooked.
3. Proposed solution. Rule 23.1(a) is proposed to be amended to provide for delayed transmittal of the search copy until payment of the search fee has been received. This would prevent any work being required or performed by the International Searching Authority without payment of a search fee. The Administrative Instructions could provide for informing the International Searching Authority at the time of transmittal of the record copy if the transmittal of the search copy is delayed under the proposed new second sentence of Rule 23.1(a). Rule 23.1(b) is proposed to be deleted because the present procedure would not be compatible with the proposed new system under Rule 23.1(a) under which the search copy is only transmitted when the search fee has been paid. The amendment would also reduce the monitoring burden of the International Bureau since other means of monitoring are already available under the Regulations.

Rule 23

Transmittal of the Search Copy

23.1 Procedure

(a) The search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau unless no search fee has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.

(b) [Deleted]

Ad Rule 24.2

1. Present situation. At present, the International Bureau notifies the applicant, the receiving Office, the International Searching Authority and the designated Offices of the receipt of the record copy promptly upon receipt of that copy. This requires each designated Office to systematically file these notices and associate them with any later communication. If the international application is later withdrawn by the applicant or considered withdrawn by the receiving Office, such early notice is of no value to a designated Office and has caused unnecessary work. Any notification sent to the applicant under the present Rule must contain a list of the designated Offices which have been notified of the fact and the date of receipt of the record copy. It must also draw attention to any extended time limits for entering the national phase which apply in respect of a designated Office.
2. Proposed solution. It is proposed to postpone informing the designated Offices about their designations until a date which is later than the date of receipt of the record copy. It is suggested to delete from Rule 24.2 the reference to the notification of the designated Offices and to notify such an Office of its designation only at the time of and together with the communication under Article 20, if the international application and the designation concerned are still pending at that time. The International Bureau would, promptly upon international publication of the international application, send to each designated Office a copy of the international application in the form of a copy of the pamphlet, a notice of designation and the copy of any required priority documents (see the proposed amendment to Rule 47.1, below).
3. The notice sent to the applicant at the time of the communication of the international application would take the place of the present notification under Rule 24.1. It could also contain information about the date of submission of any priority document and, where applicable, about any changes which have been recorded by the International Bureau under Rule 92*bis* relating to the applicant, the agent, the common representative or the inventor. The Administrative Instructions would determine the exact contents of the notice. A single notification from the International Bureau, well in advance of the earliest time limit for entry into the national phase, would rationalize and streamline the administrative work at the designated Offices so that the national file can be easily established, at only one given point in time, on the basis of the communication of the international application from the International Bureau. It would reduce the paper handling burden of the designated Offices since it would not be required that the present notices under Rule 24.2 be received, filed and stored, prior to the Article 20 communication. Where, exceptionally, an applicant requests under Article 23(2) an early start of the national processing, the designated Office would receive from the International Bureau a copy of the international application together with the required information (see also the proposed new Rule 47.4, below).
4. Under the new procedure, the designated Office would be notified of its designation once it has been established that the Office is, in fact, a designated Office in that the applicant has paid the necessary designation fee. It will therefore no longer happen that an Office is informed by the International Bureau of its designation and then, some time later, informed by the International Bureau of the fact that the designation is deemed withdrawn due to non-payment of the designation fee.

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 [remains deleted]

24.2 Notification of Receipt of the Record Copy

(a) Subject to the provisions of paragraph (b), the International Bureau shall promptly notify the applicant, the receiving Office and the International Searching Authority^{*} of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant^{**}, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain [a list of the States designated according to Rule 4.9\(a\)](#).

(b) [No change]

* The amendment consists in the deletion of: “, and all designated Offices,”.

** The amendment consists in the deletion of: “, and the name of the receiving Office”.

[Ad Rule 24.2, continued]

5. It is further proposed to delete in present Rule 24.2(a) the requirement that the notice shall identify also the name of the receiving Office. In accordance with established practice, it is, for all practical purposes, sufficient that the receiving Office is identified by the two-letter code which forms part of the international application number assigned by the receiving Office.

6. Since there is under the proposed new system, at the time of notifying the applicant of the receipt of the record copy, no notification sent to the designated Offices, the notification of the applicant cannot contain, as is prescribed in the present Rule, a list of the designated Offices which have been notified under Rule 24.2(a). It is therefore necessary to further amend the Rule, and it is proposed to provide, instead of the said listing of designated Offices, for the sending to the applicant of a listing of all designated States. Such listing is a very important means for the applicant for checking the designations made under Rule 4.9(a). It may permit the early discovery of errors or omissions in designations made by the applicant when filling in the request and by the International Bureau when recording the designations, so that corrections may be made. Such corrections would become possible if the applicant confirmed a designation under Rule 4.9(b) by specifying the correct designation by an indication of the State or regional Office concerned (see Rule 4.9, above).

7. Finally, it is proposed to delete, in the last sentence, the requirement that the International Bureau include information to the applicant on the relevant national time limits under Article 22(3). With the increasing number of designated Offices and all their different time limits for entering the national phase, the burden of informing in detail is too cumbersome and not necessary. It appears, after more than eleven years of experience, to be more important to include a general reminder to the applicant that he has to perform certain acts before the designated Offices at the expiry of the applicable time limit under Article 22 or 39(1) and to refer, for further details about national requirements and applicable time limits, to the PCT Applicant's Guide, Volume II. The reminder could be provided for in the Administrative Instructions.

Ad Rule 26.5(b)

1. [Present situation](#). At present, an international application must be signed by all applicants, even where it indicates different applicants for different designated States. If the signature of only one applicant, who may be the applicant for one State, is missing, the international application is to be considered withdrawn although all the other applicants for all the other States have signed the international application. A typical case which happens regularly is that the applicants for all designated States except the United States of America have signed the international application but the applicant for the United States of America, the inventor, for one reason or another, did not sign the international application.
2. The lack of the signature of the applicant for a certain State should have no effect, as far as any other designated State is concerned, if the international application has been signed by the applicant(s) for those other designated States. The sanction that the entire international application is considered withdrawn appears not to be justified.
3. [Proposed solution](#). It is therefore proposed to provide in a new paragraph (b) of Rule 26.5 that the receiving Office shall, if an applicant for a certain designated State did not comply with the requirements as to signature, declare the international application considered withdrawn in respect of that designated State only. The proposed amendment will make the system safer for applicants.

Ad Rule 26.5(c)

1. [Present situation](#). The current Regulations make no exception in case of lack of signature. If the international application is not signed, it shall be considered withdrawn (see Article 14(1)).
2. It should be recognized in the Regulations that situations exist where an applicant is not available or not willing to sign the international application. A typical situation is where the United States of America is designated and therefore the inventor must be the applicant as far as that designated State is concerned. In some instances, the inventor refuses to sign the international application because he no longer is an employee of the company which is the applicant for all other designated States. Another situation is where such an inventor has changed his residence and cannot be located.
3. [Proposed solution](#). Proposed Rule 26.5(c) would provide that an absence of signature shall be excused if an accompanying document explains to the satisfaction of the receiving Office that the applicant refuses to join in the application, is unwilling to sign, or cannot be found or reached after diligent effort, provided that at least one other applicant has signed the international application. Where such a document is furnished and satisfies the receiving Office, the international application would be regarded, pursuant to Article 14(1) (a)(i), as signed as provided in the Regulations.

Rule 26

Checking by, and Correcting before, the Receiving Office of Certain Elements of the
International Application

26.1 to 26.4 [No change]

26.5 Decision of the Receiving Office

(a) [Mo change]

(b) Where, after the expiration of the time limit under Rule 26.2, the signature of an applicant for a certain designated State is lacking, the receiving Office shall, subject to paragraph (c), declare the international application considered withdrawn in respect of that State.

(c) The lack of a signature under paragraph (b) shall be excused by the receiving Office if an applicant refuses to join in an international application, is unwilling to sign, or cannot be found or reached after diligent effort, provided that at least one other applicant has signed the international application and that other applicant has furnished a statement explaining to the satisfaction of the receiving Office the efforts which have been made to obtain the signature of the non-signing applicant and the reasons why no signature of the international application has been obtained.

26.6 [No change]

Ad Rule 29.1

1. Present situation. Rule 29.1(a)(ii) and (b) provides that the International Bureau informs the interested national Office if a designation has been considered withdrawn under Article 14. The proposed amendments to Rule 24.2 and Rule 47.1(a) provide for a delaying of the notification to the national Offices of their designation until the communication under Article 20. The sending, according to the present text of Rule 29.1(a) (ii) and to the present last sentence of Rule 29.1(b), of a notice of withdrawal to the designated Office before the communication under Article 20 would not have any value since the designated Offices have, under the proposed new system, not yet been informed that there is an international application pending in which they are designated. On the other hand, the receiving Office declares an international application as considered withdrawn long before the communication under Article 20. Therefore, there will be no need in future to notify the national Offices.

2. Proposed solution. It is proposed to amend Rule 29.1 and to delete in Rule 29.1(a)(ii) and in Rule 29.1(b) the text which requires the International Bureau to notify the interested national Office of the withdrawal of the relevant designation. This would further streamline the procedure and rationalize it for the benefit of both the national Offices and the International Bureau.

Rule 29

International Application or Designations Considered Withdrawn under Article 14(1), (3) or (4)

29.1 Finding by Receiving Office

(a) If the receiving Office declares, under Article 14(1) (b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3) (a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1), that the international application is considered withdrawn:

(i) [No change]

(ii) the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration* ;

(iii) and (iv) [No change]

*

The amendment consists in the deletion, after the word “declaration”, of the words “, and the International Bureau shall in turn notify the interested designated Offices.”

[Rule 29.1, continued]

(b) If the receiving Office declares under Article 14(3) (b) (failure to pay the prescribed designation fee under Rule 27.1(b)) that the designation of any given State is considered withdrawn, the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration.*

29.2 [Remains deleted]

29.3 and 29.4 [No change]

*

The amendment consists in the deletion of the second sentence: “The International Bureau shall in turn notify the interested national Office.”

[Ad Rule 32](#)

1. [Present situation](#). Rule 32 relates to withdrawal of international applications and designations. A new Rule 90*bis* is proposed which would incorporate the content of Rule 32 (see document PCT/CAL/III/3).
2. [Proposed solution](#). If new Rule 90*bis* is adopted, it is proposed- to delete Rule 32 since the subject matter thereof is covered in Rule 90*bis* .

[Ad Rule 32*bis*](#)

1. [Present situation](#). Rule 32*bis* relates to withdrawal of priority claims, It is proposed to add a new Rule 90*bis* which would include the provisions of Rule 32*bis* (see document PCT/CAL/III/3).
2. [Proposed solution](#). If new Rule 90*bis* is adopted, it is proposed to delete Rule 32*bis* since the subject matter thereof is covered in Rule 90*bis* .

Rule 32

[Deleted]

Rule 32bis

[Deleted]

Ad Rule 33.1(c)

1. Present situation. Present Rule 33.1(c) relates to citing by the International Searching Authority of published applications or patents which have a publication date “later”, but a filing or priority date “earlier”, than the filing date of the international application. The Rule does not cover the situation where the publication date and the filing date of the international application are the same.
2. Proposed solution. The proposed amendment would change “later” to “the same as, or later than,” in order to cover the situation where the dates are the same. It is noted that voting on this item is subject to Rule 88.1 and notice requirements are set forth in Rule 88.4.

Rule 33

Relevant Prior Art for the International Search

33.1 Relevant Prior Art for the International Search

(a) and (b) [No change]

(c) Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

33.2 and 33.3 [No change]

Ad Rule 36.1

1. Present situation. Rule 36.1(ii) requires that each International Searching Authority “have in its possession” at least the minimum documentation referred to in Rule 34.
2. In the present time of electronic processing and storage of patent documents and relevant patent information, on computers and on CD-ROM and other optical discs, it appears no longer to be necessary that the International Searching Authority have physical possession at its premises of all the documentation referred to in Rule 34, especially that relating to non-patent literature under Rule 34(b)(iii).
3. Proposed solution. It is proposed to amend item (ii) of Rule 36.1 and to provide that the minimum documentation must be readily accessible to the International Searching Authority in a manner which permits the identification of the relevant documents to be cited in international search reports. This wording would permit more flexibility and allow the International Searching Authorities to adjust their searching tool to modern technical development.

Rule 36

Minimum Requirements for International Searching Authorities

36.1 Definition of Minimum Requirements

The minimum requirements referred to in Article 16(3) (c) shall be the following:

- (i) [No change]
- (ii) that Office or organization must have* at least the minimum documentation referred to in Rule 34 readily accessible in a manner permitting the identification of the documents which are relevant for the purposes of the international search;
- (iii) [No change]

*

The amendment consists in the deletion of the words: “in its possession”.

Ad Rule 38.2

1. Present situation. Rule 38.2 provides that the International Searching Authority, in certain cases, establishes an abstract or establishes an amended abstract where the abstract furnished by the applicant does not comply with Rule 8. Under the present Rule, such established abstract has to be transmitted to the applicant with an invitation to comment, within one month from the date of the invitation, on the abstract established by the International Searching Authority.

2. In practice, there are not many cases in which the International Searching Authority actually establishes an abstract and invites the applicant to comment. However, it is felt that the requirement of inviting comments often gives applicants the impression that they should comment although they could basically agree with the abstract established by the International Searching Authority. The evaluation of the comments is burdensome for the International Searching Authority. The time limit for comments delays the establishment of the final text of the abstract. As a result, the international application is published in some cases with the abstract as established by the International Searching Authority before the expiration of the time limit for any possible comments. Moreover, where comments are made, they frequently do not lead to a modification of the abstract.

3. Proposed solution. It is proposed to amend Rule 38.2 and to delete in paragraph (a) the requirement to invite comments. However, it is not proposed to deprive the applicant of his right to comment. Therefore, it is also proposed to amend paragraph (b) and to provide for the opportunity to submit comments within one month from the date of the international search report where the applicant so wishes. The difference to the present system would be that there is no invitation to submit comments. Certain International Searching Authorities have a similar practice for applications filed under national law.

Rule 38

Missing Abstract

38.1 [No change]

38.2 Establishment of Abstract

(a) If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract (in the language in which the international application is published)*.

(b) The applicant may, within one month from the date of the international search report, submit comments on the abstract established by the International Searching Authority. The definitive contents of the abstract shall be determined by that Authority, and the applicant shall be informed accordingly. Where the Authority amends the abstract established by it, it shall notify the amendment to the International Bureau.

*

The amendment consists in the deletion of the last sentence: “In the latter case, it shall invite the applicant to comment on the abstract established by it within one month from the date of the invitation.”

Ad Rule 39.1

1. Present situation. Rule 39, which relates to subject matters not required to be searched, does not currently speak of nucleotide and/or amino acid sequences which are usually presented in the form of long lists, often several pages, of letter symbols. In practice, it is almost impossible to search such pages of symbols without computer assistance.
2. Proposed solution. It is proposed to add, as another category of subject matter not requiring international search, nucleotide and/or amino acid sequences to the extent that no computer readable form of the sequences listed in the description and claims is provided. Attention is also directed to the amendment to Rule 5.2 on the same subject matter. It is noted that voting on this item is subject to Rule 88.1 and notice requirements are set forth in Rule 88.4.

Rule 39

Subject Matter under Article 17(2) (a) (i)

39.1 Definition

No International Searching Authority shall be required to search an international application if, and to the extent to which, its subject matter is any of the following:

(i) to (v) [No change]

(vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs,

(vii) nucleotide and/or amino acid sequences to the extent that the applicant does not provide a listing of such sequences in computer readable form.

Ad Rule 42.1

1. Present situation. Present Rule 42.1 establishes an inflexible time limit for establishing the international search report. The time limit is three months from the receipt of the search copy by the International Searching Authority or nine months from the priority date, whichever is later. No provision is made for delays caused by fee payment procedure under Rule 16*bis*, or by the lack of unity procedure under Rule 40. Due to these circumstances, International Searching Authorities are sometimes not in a position to comply with the time limits fixed in Rule 42.1.
2. Proposed solution. In order to provide some flexibility for delays in establishing the international search report, it is proposed to amend Rule 42.1 by adding an additional sentence under which additional time may be permitted under the Administrative Instructions in case of lack of unity of invention. The amendments proposed to Rule 16*bis* and to Rule 23.1(a) (to the effect that the receiving Office shall invite the applicant to pay any missing search fee and shall not transmit the search copy unless the search fee has been paid) will, if adopted, remedy the problems resulting from the procedure under the present Rule 16Ms. Should, however, that amendment not be adopted, the words “or Rule 16*bis*” would have to be added after the words “Article 17(3) (a)” in the proposed amendment to Rule 42.1.
3. The Administrative Instructions could be modified by adding to Part 5 a new Section which could read:

“Where the completion of the international search is delayed due to an invitation under Article 17(3) (a) to pay additional search fees, the international search shall start and shall be completed promptly after the conclusion of the said procedures, and the international search report shall, whenever possible, be established not later than 17 months from the earliest priority date. “

Rule 42

Time Limit for International Search

42.1 Time Limit for International Search

The time limit for establishing the international search report or the declaration referred to in Article 17(2) (a) shall be three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later. The Administrative Instructions may permit an extension of the applicable time limit where Article 17(3) (a) applies.

Ad Rule 43.1

1. Present situation. The present wording of Rule 43.1 requires that the “name of the receiving Office” be indicated in addition to “the international number”. Since the international number identifies the receiving Office as part of the number, the indication of the receiving Office in addition to the application number is a duplication of information.
2. Proposed solution. To remove the necessity of supplying duplicative information, it is proposed to delete from Rule 43.1 the requirement to indicate “the name of the receiving Office.”

Ad Rule 43.5(e)

1. Present situation. Rule 43.5(e) as currently worded only requires that particularly relevant passages of a cited document in an international search report be identified in respect of documents of which only certain passages are relevant. Comments have been received indicating that it would be beneficial to also identify particularly relevant passages of a document cited in an international search report in cases where the citation relates to the entire document.
2. Proposed solution. In order to provide maximum information in international search reports, it is proposed to add a text to Rule 43.5(e) requiring that passages of particular relevance be cited for all cited documents.

Rule 43

The International Search Report

43.1 Identifications

The international search report shall identify the International Searching Authority which established it by indicating the name of such Authority, and the international application by indicating the international application number, the name of the applicant^{*}, and the international filing date.

43.2 to 43.4 [No change]

43.5 Citations

(a) to (d) [No change]

(e) If only certain passages of the cited document are relevant or particularly relevant, they shall be identified, for example, by indicating the page, the column, or the lines, where the passage appears. Even if a document is considered relevant as a whole, the passages of particular relevance shall be identified.

*

The amendment consists in deleting, after the words “the name of the applicant,” the words “the name of the receiving Office.”

Ad Rule 43.6(c)

1. Present situation. Present Rule 43.6, relating to indicating, on international search reports, fields searched, requires, in paragraph (a), the indication of the classification used and, in paragraph (b), if patent documents are searched outside of the minimum documentation as defined in Rule 34, when practicable, the identification of the kinds of documents, the States, the periods and the languages searched. No provision is made as to if or how searches on electronic data bases should be indicated. Such an indication is important, especially in view of the proposed amendment to Rule 36.1(ii) which provides for the possibility to use minimum documentation material in the form of an electronic data base.

2. Proposed solution. In order to provide a basis for indicating searches made on electronic data bases, it is proposed to add a new paragraph (c) to Rule 43.6. That paragraph requires the indication of the name of the data base and the search terms used when the search extends to such a data base.

Ad Rule 43.7

1. Present situation. Rule 43.7 relates to indicating remarks in the international search report concerning unity of invention. The present wording is somewhat confusing because the second sentence of the Rule provides that where the international search was made on the main invention only, the search report shall indicate which parts were and which parts were not searched. In the case of certain international applications some additional fees, but not all, are paid. This results in claims to more than the main invention, but not all the claims, being searched. The Rule does not provide clearly for the identification of the searched and unsearched parts in such a situation.

2. Proposed solution. It is proposed to amend Rule 43.7 to provide for an indication, where more than the main invention but less than all claims were searched, of which parts of an international application were searched and which parts were not searched due to lack of unity of invention.

Ad Rule 43.8

1. Present situation. Present Rule 43.8 requires that a signature appear on the international search report. The requirement for signing the report involves an additional step in its handling because it requires returning the typed search report, prior to mailing, back to the authorized officer. In particular, when the international search report is produced with the help of a central computer, the obtaining of an original signature requires special handling.

2. Proposed solution. In order to simplify processing of the international search report, it is proposed to amend Rule 43.8, including its title, and to provide only for an indication of the name of the authorized officer rather than a signature. If an International Searching Authority desired signature for internal control purposes, it would be free to do so, but no signature would be required on the final search report itself. A similar amendment is proposed concerning the international preliminary examination report (see Rule 70.14 in document PCT/CAL/III/3).

43.6 Fields Searched

(a) and (b) [No change]

(c) If the international search extended to any electronic data basis, the international search report shall indicate the name of the data base and the search terms used.

43.7 Remarks Concerning Unity of Invention

If the applicant paid additional fees for the international search, the international search report shall so indicate. Furthermore, where the international search was made on the main invention only or on less than all the inventions (Article 17(3) (a)), the international search report shall indicate what parts of the international application were and what parts were not searched.

43.8 Authorized Officer*

The international search report shall indicate the name of an authorized officer of the International Searching Authority* .

* The title has been amended to read “Authorized Officer” instead of “Signature”.

Ad Rule 43.9

1. Present situation. Rule 43.9 lists those items which may appear on the international search report and stipulates that no other matter may be included. This is too restrictive to take care of all situations which may arise, for example because of advances in technology relating to electronic data bases.
2. Proposed solution. In order to provide an ability to make adjustments in the content of the international search report in the future without further Rule changes, it is proposed to amend Rule 43.9 and its title, to the effect that the Administrative Instructions would permit inclusion of any additional matter. The wording is similar to that now existing in Rule 4.17(a) in respect of the request form.

43.9 [Additional Matter](#)*

The international search report shall contain no matter other than that enumerated in Rules 33.1(b) and (c), 43.1, 2, 3, 5, 6, 7 and 8, and 44.2(a) and (b), and the indication referred to in Article 17(2) (b), [provided that the Administrative Instructions may permit the inclusion in the search report of any additional matter specified in the Administrative Instructions](#). In particular, it shall contain no expression of opinion, reasoning, argument, or explanation.

43.10 [No change]

* The title has been amended to read “additional matter” instead of “no other matter”.

[Ad Rule 44.2](#)

1. [Present situation](#). The present Rule 44.2, in paragraphs (b) and (c), provides for a procedure for the case where the International Searching Authority invites the applicant to comment on an abstract established by it. It has been proposed above to amend Rule 38.2(a) and to delete the requirement that the International Searching Authority invite the applicant to comment on the abstract.
2. [Proposed solution](#). Consequential to the proposed amendment to Rule 38.2(a), paragraphs (b) and (c) of Rule 44.2 are not applicable any longer as no time limit will exist for the applicant in which to submit comments on the abstract established by the International Searching Authority. It is therefore proposed to delete paragraphs (b) and (c) of Rule 44.2 and to amend its paragraph (a) by deleting in that paragraph the reference to the deleted paragraphs (b) and (c).

[Ad Rule 44.3](#)

1. [Present situation](#). Rule 44.3(c) currently provides that an International Searching Authority may send copies of documents cited to the International Bureau and that Bureau then supplies copies to the designated Office or to the applicant. No use has been made of this procedure by designated Offices or applicants since the entry into force of the PCT in 1978.
2. [Proposed solution](#). In view of the fact that no use is being made of the procedure under Rule 44.3(c), it is proposed that paragraph (c) be deleted along with references thereto in paragraph (d).

Rule 44

Transmittal of the International Search Report, Etc.

44.1 [No change]

44.2 Title or Abstract

(a) *The international search report shall either state that the International Searching Authority approves the title and the abstract as submitted by the applicant or be accompanied by the text of the title and/or abstract as established by the International Searching Authority under Rules 37 and 38.

(b) [Deleted]

(c) [Deleted]

44.3 Copies of Cited Documents

(a) and (b) [Mo change]

(c) [Deleted]

(d) Any International Searching Authority may perform the obligations referred to in (a) and (b) through another agency responsible to it.

* The amendment consists in the deletion of the words: “subject to paragraphs (b) and (c),”.

Ad Rule 46.2

1. Present situation. When applicants file international applications or corrections thereto and pay fees, they correspond with the receiving Office, usually in their own country. When it comes time to filing amendments under Article 19, many applicants also forward them to the receiving Office or to the International Searching Authority. Both are the wrong address because, according to Article 19, amendments to the claims must be filed with the International Bureau. Although the receiving Offices and International Searching Authorities usually forward Article 19 amendments to the International Bureau, it results in additional delay in the amendments reaching the International Bureau. Sometimes amendments reach that Bureau only after the expiration of the time limit for filing them.

2. Proposed solution. Since the provisions of Article 19 are often overlooked, it is proposed to add a new Rule which would clearly state that amendments made under Article 19 shall be filed directly with the International Bureau. Although this would repeat what is said in Article 19, it would provide the information as to where to send amendments under Article 19 in the same Rule in which other information concerning such amendments can be found. It is proposed to number this Rule 46.2, a number which is not used at present because the text of that Rule was deleted earlier.

Rule 46

Amendment of Claims Before the International Bureau

46.1 [No change]

46.2 Where to File

Amendments made under Article 19 shall be filed directly with the International Bureau.

46.3 to 46.5 [No change]

[Ad Rule 47.1\(a\)](#)

1. [Present situation](#). Reference is made to the explanation concerning the proposed amendment to Rule 24.2. The notification under Rule 24.2 about the receipt of the record copy and the notification about the date of receipt of the priority document are made, at present, separately and independent of each other, and usually prior to the communication of the international application under Article 20. It is proposed above to amend Rule 24.2 and to provide that the designated Offices would no longer be informed of their designation in a separate notification at the time the applicant is notified of the receipt of the record copy by the International Bureau. The notification by the International Bureau to the designated Offices should be effected together with the communication under Article 20. The same should be done with the notification about the date of receipt of the priority document.

2. [Proposed solution](#). Consequential to the amendment of Rule 24.2 it is proposed to amend Rule 47.1(a) and to provide for the notice of designation to be included in the communication under Article 20. It is also proposed to include in the same notification all other information of interest to the designated Offices which are not clear from the pamphlet, namely indications concerning the fact and the date of receipt of the record copy.

[Ad Rule 47.4](#)

1. [Present situation](#). Where the applicant makes use of the possibility to expressly request under Article 23(2) the designated Office to start the processing or examination of the international application early, the designated Office will not have received a copy of the international application before the communication under Article 20 has occurred. If Rule 24.2 and Rule 47.1 are amended as proposed above, the designated Office will also not have been informed of its designation by the International Bureau since it is proposed to send the notice of designation to the designated Office only upon international publication of the international application.

2. [Proposed solution](#). It is proposed to add a new Rule 47.4 providing that, for the case of an express request by the applicant for an early start of the national phase, the applicant or the designated Office concerned may request the International Bureau for an advanced communication under Article 20 of a copy of the international application to the designated Office. The communication would include the notification of the designation concerned.

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) The communication provided for in Article 20 shall be effected by the International Bureau. It shall include a copy of the international application, a notice about the fact and the date of receipt of the record copy, and a notice about the fact and the date of receipt of any priority document.

(b) to (e) [No change]

47.2 and 47.3 [No change]

47.4 Express Request Under Article 23(2)

Where the applicant makes an express request to the designated Office under Article 23(2) before the communication provided for in Article 20 has taken place, the International Bureau shall, upon request of the applicant or of the designated Office, promptly effect communication to the designated Office concerned.

Ad Rule 48.2(a)

1. Present situation. Rule 48.2 (a) lists the various items to be contained in the pamphlet when the international application is published. However, the list appears to be incomplete because it does not provide for the inclusion of separately furnished references to deposited microorganisms.
2. Proposed solution. It is proposed to complete the list of items which are to be contained in the pamphlet publishing the international application by adding an additional item. References to deposited microorganisms are permitted under Rule 13*bis* but it is not clear whether such references are to be published with the international application in the pamphlet; it is proposed to clarify that point by expressly providing that such references are to be published in the pamphlet.

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) The pamphlet shall contain:

(i) to (vi) [No change]

(vii) any request for rectification referred to in the third sentence of Rule 91.1(f1),

(viii) any reference to a deposited microorganism furnished under Rule 13bis , to the extent that it is not contained in the description.

(b) to (i) [No change]

48.3 to 48.5 [No change]

[Ad Rule 48.6 \(c\)](#)

1. [Present situation](#). Present Rule 48.6(c) provides that where withdrawals of the international application, designations or priority claims are made after the technical preparations for international publication have been completed, that fact shall be published in the Gazette. A new Rule 90*bis* is proposed in document PCT/CAL/III/3 in which all provisions relevant to withdrawals will be concentrated.
2. [Proposed solution](#). If new Rule 90*bis* is adopted, Rule 32 and Rule 32*bis* will be deleted and it is proposed to amend Rule 48.6(c) so as to align it with these amendments.

48.6 Announcing of Certain Facts

(a) [Mo change]

(b) [Remains deleted]

(c) If the international application, the designation of any designated State or the priority claim is withdrawn under [Rule 90bis](#) after the technical preparations for international publication have been completed, [the withdrawal](#) shall be published in the Gazette.

Ad Rule 49.5(c-bis)

1. [Present situation](#). Rule 49.5(a) currently provides that the designated Office may require the furnishing of a translation of the claims as filed or, if the claims have been amended, as amended. A designated Office may also require a translation of both the claims as originally filed and the claims as amended. There is a complete lack of uniformity of the requirements of the designated Offices. This has resulted in some international applications losing their effect in a designated State because the translation furnished to the designated Office was not complete since it did not include, e.g., in addition to the translation of the claims as amended a translation of the claims as filed. In order to avoid such a severe sanction the national laws or practice applied by a number of designated Offices already provide that if an amendment under Article 19 is not translated, the amendment shall be regarded as cancelled or not having been made. Others give the applicant an opportunity for later furnishing of the missing translation.

2. [Proposed solution](#). It is not proposed to amend Rule 49.5(a) because a designated Office should remain free to require the translation it needs. However, it is proposed to add a new paragraph (c-bis) to Rule 49.5 for the case where a designated Office requires under Rule 49.5(a)(ii) a translation of both the claims as filed and the claims as amended under Article 19. In such a case the Office should have the choice to simply disregard the claims which have not been translated or to invite the applicant to furnish the missing translation. The sanction that the international application be considered withdrawn is proposed to become applicable only where the missing translation is not furnished within the time limit fixed in the invitation. In other words, an applicant who furnishes a translation of the claims as amended should not lose the application for failure to furnish a translation of the claims as filed without having been given the opportunity to comply with the requirement to furnish a translation of the claims as filed. The same should apply in the case where the applicant furnished a translation of the claims as filed but failed to translate the claims as amended under Article 19. It is also proposed that the sanction for the failure to furnish the required translation does not apply automatically. It should be at the discretion of the designated Office whether, in such a case, it wants to disregard the claims or consider the international application withdrawn because the applicant did not furnish a translation of a claim which, for example, was deleted when the claims were amended under Article 19. For those reasons, the last sentence of Rule 49.5(c-bis) uses the word “may” and not the word “shall”.

[Ad Rule 49.5\(e\)](#)

1. [Present situation](#). Present Rule 49.5(e) contains an item (ii) which provides for a transition period with regard to issuing an invitation to furnish a copy of the drawings. The transition period has existed for a number of years. It appears to be no longer necessary.

2. [Proposed solution](#). It is proposed that item (ii) of Rule 49.5(e) be deleted and that item (i) be included in the body of Rule 49.5(e).

Rule 49

Copy,. Translation and Fee Under Article 22

49.1 to 49.4 [No change]

49.5 Contents of and Physical Requirements for the Translation

(a) to (c) [No change]

(c-bis) Where the applicant furnishes, to a designated Office which requires under paragraph (a)(ii) a translation of both the claims as filed and the claims as amended, only one of the required two translations, the designated Office may disregard the claims which have not been translated or invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the missing translation is not furnished within the time limit fixed in the invitation, the international application may be considered withdrawn.

(d) [No change]

(e) 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* .

*

The amendment consists in including the text of item (i) in the body of paragraph (e) and in deleting “; or “ at the end of item (i) and the entire item (ii).

Ad Rule 49.5(h)

1. Present situation. In the case where the translation of the abstract is missing the Regulations do not provide for an invitation to the applicant to furnish the missing translation. The lack of a translation of the abstract, however, is considered to be a matter which should be subjected to invitation and correction and not be fatal for entering the national phase before a designated Office.
2. Proposed solution. Rule 49.5(h) is proposed to be amended to include a reference to the abstract and thus provide that the applicant shall be invited to furnish a translation of the abstract if he failed to include it with the translation of the international application. Ad Rule 49.5(k)
1. Present situation. No provision presently exists in the Rules as to whether the title, as originally presented by the applicant in the international application, or the title as it may have been established by the International Searching Authority under Rule 37.2 because the original title did not comply with Rule 4.3, is to be translated under Article 22(1) for the designated Offices. The practice in the designated Offices differs. At least one designated Office requires the translation of the original title and not of the title as corrected by the International Searching Authority.
2. Proposed solution. A new Rule 49.5(k) is proposed to be added which would provide that the title to be translated under Article 22(1) is the title established by the International Searching Authority. This would remove any doubt as to the content of a required translation as far as the title is concerned. It is the corrected title established by the International Searching Authority which is published by the International Bureau and communicated under Article 20 to the designated Offices. It appears to be logical that the designated Offices should receive a translation of that title and not of any earlier defective title.

[Rule 49.5, continued]

(f) and (g) [No change]

(h) Where the applicant did not furnish a translation [of the abstract](#) or of any indication furnished under Rule 13*bis*.4, the designated Office shall invite the applicant to furnish such translation, if it deems it to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(i) and (j) [No change]

[\(k\) Where a title has been established by the International Searching Authority pursuant to Rule 37.2, the translation shall contain the title as established by that Authority.](#)

[Ad Rule 51bis .2\(c\)](#)

1. [Present situation](#). This Rule contains a transitory provision until the national law applied by designated Offices is compatible with the requirements referred to in Rule 51bis .1(a) (iii) and (iv), (b)(i) and (d).
2. [Proposed solution](#). It appears that, in the meantime, compatibility of the national laws applied by all designated Offices with the said requirements has been achieved since Rule 51bis was adopted on February 3, 1984. Therefore, Rule 51bis .2(c) has become obsolete and is proposed to be deleted.

Rule 5Ibis

Certain National Requirements Allowed under Article 27(1), (2), (6) and (7)

5Ibis .1 [No change]

5Ibis .2 Opportunity to Comply with National Requirements

(a) and (b) No change

(c) [Deleted]

[End of document]