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PCT/CAL/III/3

ORIGINAL: English

DATE: April 11, 1990

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

PCT COMMITTEE FOR ADMINISTRATIVE AND LEGAL MATTERS

Third session*
Geneva, July 2 to 6, 1990

DRAFT
PROPOSED AMENDMENTS TO PART C TO PART F
OF THE REGULATIONS UNDER THE PCT

Memorandum prepared by the International Bureau

INTRODUCTION

Reference is made to the Introduction to document PCT/CAL/III/2. The present document is a continuation of that document and contains further proposals for amendments, relating to parts C to F of the Regulations. Document PCT/CAL/III/2 contains proposals for amendments relating to parts A and B.

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EXPLANATIONS OF THE PROPOSED AMENDMENTS

Ad Rule 53.1(a) and (c)

1. Present situation. Rule 53.1(a), at present, requires the demand to be made on a printed form. It does not permit the use of computer generated forms.
2. Proposed solution. The proposed amendment to Rule 53.1 (a) is, like the amendments proposed to Rules 3.1 and 3.4, intended to prepare the ground for a future filing of demands with the help of word processing equipment. The new second sentence of Rule 53.1(a) replaces Rule 53.1(c), which is proposed to be deleted.

Ad Rule 53.1 (b)

1. Present situation. Present Rule 53.1(b) does not spell out what is the general practice, namely, that applicants may obtain free of charge copies of the printed demand form, not only from the receiving Office, but also from the International Preliminary Examining Authority.
2. Proposed solution. The proposed amendment to Rule 53.1(b) adds a reference to demand forms being available from the International Preliminary Examining Authority.

Ad Rule 53.2(a) (v)

1. Present situation. Present Rule 53.2(a) does not provide for an indication as to which amendments are to be considered for international preliminary examination. Such information is important when the international preliminary examination is to begin as soon as possible after filing of the demand and receipt of the international search report, independently of the expiration of the time limit for submission of amendments under Article 19, as proposed by amended Rule 69.1(b), see below. The present demand form, in Box IV, provides already for a declaration concerning amendments of the claims but without a basis in Rule 53.
2. Proposed solution. It is proposed to add to the mandatory contents of the demand form a declaration of the applicant in which he determines the content of the international application in respect of which the international preliminary examination shall be carried out. For further details, see the explanations concerning the corresponding amendment of Rule 53.9, below.

TEXT OF THE PROPOSED AMENDMENTS

Rule 53

The Demand

53.1 *Form*

(a) The demand shall be made on a printed form or presented as a computer print-out. The particulars of the printed form and of a demand presented as a computer print-out shall be prescribed by the Administrative Instructions.

(b) Copies of printed demand forms shall be furnished free of charge by the receiving Office or by the International Preliminary Examining Authority.

(c) [Deleted]

53.2 *Contents*

(a) The demand shall contain:

(i) to (iii) [No change]

(iv) election of States,

(v) A declaration expressing the wish of the applicant that the international preliminary examination shall relate to the international application as originally filed or as amended.

Ad Rule 53.4

1. Present situation. Rule 53.4, at present, provides that indications concerning the applicant be made, without specifying whether all of the applicants who filed the international application, or only those who are applicants for the elected States listed in the demand, are to be indicated.

2. Proposed solution. In order to provide uniform practice and clear provisions in the Rules, Rule 53.4 is proposed to be amended to state that the demand shall only list the names of the applicants for the States elected in the demand. Applicants, who are applicants only for designated States which are not elected, are not to be listed in the demand and need not sign the demand.

Ad Rule 53.5

1. Present situation. The present Rules refer only to an agent having the right to practice before the receiving Office (Article 49 and Rules 2.2 and 90), but do not refer to an agent having the right to practice before the Office acting as an International Preliminary Examining Authority to be appointed in respect of an international application filed in another Office acting as a receiving Office. Applicants frequently appoint an agent for representation before the International Preliminary Examining Authority which has the right to practice before that Authority but not before the receiving Office.
2. Proposed solution. The proposed amendment to Rule 53.5 spells out what is already contained in the present version of the demand form, namely that an applicant may appoint, in addition to the agent who is representing him already during the international procedure (hereinafter referred to as “principal agent”), another agent specifically for the procedure before the International Preliminary Examining Authority (hereinafter referred to as “additional agent”). In particular, applicants from Japan and the United States of America, if they specify the European Patent Office as competent International Preliminary Examining Authority, often want to be represented before the European Patent Office by a European patent attorney (as additional agent) without revoking the appointment of the agent who filed the international application and is responsible (as principal agent) for its processing in general. The Administrative Instructions, in Section 108, already deal with the consequences of the appointment of an additional agent, in particular, in respect of correspondence from the International Preliminary Examining Authority to the applicant or his agent.

Ad Rule 53.6

1. Present situation. The items which under present Rule 53.6 must be indicated in the demand in order to identify the international application include the name of the receiving Office with which the international application was filed.
2. Proposed solution. The deletion in Rule 53.6 of the requirement to name the receiving Office is proposed because it is superfluous since the international application number permits the identification of the Office with which the application was filed by the two-letter country code which forms part of the international application number.

[Rule 53.2, continued]

(b) [No change]

53.3 [No change]

53.4 *The Applicant*

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply mutatis mutandis. The demand shall only list the names of the applicants for the States elected in the demand.

53.5 *The Agent*

If an agent is designated, Rules 4.4, 4.7 and 4.16 shall apply, and Rule 4.8 shall apply mutatis mutandis. Notwithstanding any earlier appointment of an agent, an additional agent may be designated for the procedure before the International Preliminary Examining Authority as referred to in Rule 90.1(i).

53.6 *Identification of the International Application*

The international application shall be identified by* the name and address of the applicant, the title of the invention, and, where the international filing date and the international application number are known to the applicant, that date and that number.

* The amendment consists in deleting, after the word “by”, the words “the name of the receiving Office with which the international application was filed”.

Ad Rule 53.7

1. Present situation. Rule 53.7 requires, at present, that the name of the State must be indicated for the election of a Contracting State in the demand. It does not provide for referring to regional patents or referring to all eligible designated States, which would simplify the filling in of the demand form.
2. Proposed solution. It is proposed to amend Rule 53.7 and to divide it into two paragraphs. Rule 53.7(a) contains the contents of present Rule 53.7 and includes, consequential to the proposed amendment to Rule 4.9(a), a reference to the indication of a regional Office instead of the name of a State for which a regional patent is desired. If it is sufficient to designate a regional Office, it must be equally sufficient to elect that regional Office for the purposes of Chapter II. New Rule 53.7(b) deals with the manner of electing States in a way which corresponds to the manner of designating States under proposed Rule 4.9(a). It is also proposed to provide a simple way for the joint election of all Contracting States bound by Chapter II which have been designated. This change would give maximum protection to applicants and simplify the filing of a demand for international preliminary examination.

Ad Rule 53.9

1. Present situation. The Regulations do not presently contain a Rule 53.9.
2. Proposed solution. It is proposed to specify in a new Rule 53.9 details relating to the proposed addition to the mandatory contents of the demand of a declaration concerning the basis of international preliminary examination (see the proposed amendments to Rule 53.2(a) (v), above, and also the proposed amendments to Rules 62.2, 66.1 and 69.1, below). The desirability of an early clarification of the basis for international preliminary examination through such a declaration follows from the fact that the time available for international preliminary examination is very limited and the examination should start as early as possible after the filing of the demand. The basis for the start of the international preliminary examination will be clear if the applicant declares already in the demand that he has filed amendments and attaches a copy of the amendments to the demand.
3. The declaration by the applicant in the demand will consist, in practice, in the marking, on the printed demand form, of check-boxes relating to a preprinted text expressing the wish that the international preliminary examination be directed to the international application as filed or as amended. Any amendment which is to be taken into account shall be submitted with the demand. It will thus always be readily available for the international preliminary examination. This means for the applicant, in case of Article 19 amendments, that he has to submit himself a copy to the International Preliminary Examining Authority if he wants these amendments to be the basis for international preliminary examination. This may be considered by some as an additional burden for the applicant but it will at the same time allow an earlier start of the preliminary examination which could be a great advantage compared to the present situation. At present the International Preliminary Examining Authority must wait until it receives from the International Bureau either a copy of the amendments under Article 19, or a notification that no amendments have been filed within the applicable time limits or that the applicant declared that he does not wish to file such amendments (see present Rule 69.1(b)(ii)). For further details, see below Ad Rule 62.
4. The declaration will be binding for the applicant for the start of the international preliminary examination. It must be binding because otherwise the declaration would not clarify the basis for beginning international preliminary examination. Proposed new Rule 66.1(c), however, permits the International Preliminary Examining Authority to take amendments into account which are submitted after the filing of the demand, if such amendments are deemed to be useful and can be considered by the examiner before he has begun to draw up the first written opinion.
5. Demands are usually only submitted after the applicant has evaluated the international search report. Should, exceptionally, the demand be filed before the transmittal of the international search report, the declaration concerning the basis of international preliminary examination will usually refer to the international application as filed, because the results of the international search which may cause amendments are not yet known. If the applicant wishes, later, as a result of the international search report, to amend the international application before the establishment of the first written opinion, it may furnish such amendments to the International Preliminary Examining Authority which may, at its discretion, take them into account (see Ad Rule 66.1(c), below).

53.7 *Election of States*

(a) The applicant shall in the demand name, among the designated States, at least one Contracting State bound by Chapter II of the Treaty as elected State or one regional Office acting for such a State.

(b) The election may be made by naming the State or the regional Office or by indicating the applicable two-letter code as provided in the Administrative Instructions. The election may also be made by an indication that all Contracting States which have been designated in the international application and are bound by Chapter II of the Treaty are elected.

53.8 [No change]

53.9 *Declaration Concerning the Basis of the International Preliminary Examination*

The declaration referred to in Rule 53.2(a) (v) shall specify whether the applicant wishes international preliminary examination to be carried out on the basis of the description, claims and drawings as originally filed or as amended under Article 19(1) or Article 34(1). The declaration is binding for the applicant. A copy of any amendment referred to in the declaration shall be submitted together with the demand.

Ad Rules 54.2 and 54.3

1. Present situation. Under present Rule 54, in accordance with Article 31(2)(a), applicants are entitled to file a demand for international preliminary examination only if they are residents or nationals of a Contracting State bound by Chapter II and if the international application has been filed with the receiving Office of, or acting for, such State. If there are different applicants for different elected States, this requirement must be fulfilled by at least one of the applicants indicated for the purposes of each elected State. This means that, for the purposes of each elected State, at least one applicant must be a national or resident of a Contracting State bound by Chapter II and it means in addition that the international application must have been filed with the receiving Office of, or acting for, the State of which that applicant is a national or resident.
2. This leads to the result that, even if all applicants are nationals or residents of Contracting States bound by Chapter II, not all of them are always entitled to make a demand or elections. The following example is intended to illustrate the problem: if a demand is filed by an applicant who is a national of France for an international application filed with the receiving Office of that country, and if that international application indicates as applicant for the United States of America a national and resident of Australia, the election of the United States of America is not valid, although the applicant for the United States of America is a national and resident of a Contracting State bound by Chapter II (Australia), because the international application has not been filed with the receiving Office of that State, which would be the Office of Australia and not the Office of France. This result is not only unjust but it is also absurd because an international application cannot be filed with two Offices. For the election of the United States of America to be valid, the international application would have had to be filed with the Office of Australia, but, had it been filed with the Office of Australia, the elections made in the name of the national of France would not have been valid. In other words, the present text of Rule 54.3 causes problems for the use of Chapter II whenever different applicants do not have the same nationality or residence.
3. Proposed solution. It is therefore proposed to amend Rule 54 and to provide in Rule 54.2 that it is sufficient for the right to file a demand if at least one of all the applicants fulfills the requirements set out in paragraphs (i) or (ii) of that Rule. This means that the right to file a demand exists if at least one of all the applicants is a national or resident of a Contracting State bound by Chapter II and if the international application has been filed with the receiving Office of such State. In order to have a proper election for each State, it is proposed to no longer require that the international application must have been filed with the receiving Office of the State of which the applicant is actually a national or resident. Since, as is also clarified in an amended title of Rule 54.2, that Rule covers all cases where several applicants file an international application, whether they are the same for all elected States or different for different elected States, Rule 54.3 is no longer needed and is proposed to be deleted.

Rule 54

The Applicant Entitled to Make a Demand

54.1 [No change]

54.2 *Several Applicants: Same for All Elected States or Different for Different Elected States**

If there are several applicants, the right to make a demand under Article 31(2) shall exist if at least one of them is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of a Contracting State bound by Chapter II, or

(ii) [No change]

54.3 [Deleted]

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

Ad Rule 54.4

1. Present situation. The present situation is described above with respect to Rules 54.2 and 54.3.
2. Proposed solution. The proposed amendment is consequential to the amendments in Rule 54.2. It replaces the reference to Article 31(2) by a reference to Rule 54.2 because in case of different applicants for different elected States, the conditions of Article 31(2) must only be complied with by one of them to file the demand.

54.4 Applicant Not Entitled to Make a Demand or an Election

(a) If the applicant does not have the right or, in the case of several applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.

(b) [Deleted]

Ad Rule 56.1(a) and (b)

1. Present situation. Present Rule 56.1 does not indicate to which authority a later election should be directed and does not mention that all such later elections must be submitted prior to the expiration of 19 months from the priority date in order to have the effect of delaying the national procedure under Article 39(1)(a).
2. Proposed solution. It is proposed to amend Rule 56.1 and to divide it into paragraphs (a) and (b). Rule 56.1(a) as proposed adds that later elections should be submitted to the International Bureau. Rule 56.1(b) is entirely new and clarifies that any later election submitted after the expiration of 19 months from the priority date does not have the effect provided under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in the designated Office within the time period applicable under Article 22. As a matter of fact, both amendments repeat what is already said in the Treaty, namely in Article 31(6)(b) and in Article 39(1)(a). However, since most of the details are contained in the Regulations, applicants tend to overlook the relevant provisions of the Treaty itself. The proposed amendment, therefore, serves only to facilitate the better comprehension of the procedural requirements.

Ad Rule 56.1(c)

1. Present situation. According to Article 31(6)(b), later elections must be submitted to the International Bureau. Since the demand must be filed with the International Preliminary Examining Authority and, during the procedure under Chapter II of the PCT, applicants are dealing with that Authority, they often overlook the requirement under Article 31(6)(b) and file later elections with the International Preliminary Examining Authority instead of with the International Bureau. Although that Authority will usually forward the later election to the International Bureau, such later election may reach the International Bureau only after the expiration of 19 months and therefore not have the effect desired by the applicant, namely, to postpone the entry into the national phase from 20 to 30 months after the priority date for the State in question.

2. Proposed solution. Since the provision of Article 31(6)(b) cannot be changed, it is proposed to add a new paragraph (c) to Rule 56.1, which would contribute to making the PCT system simpler and safer for applicants. The proposed new Rule provides that any later election which is submitted by the applicant to the International Preliminary Examining Authority shall be transmitted by that Authority promptly to the International Bureau. The later election would then be considered as if it had been submitted to the International Bureau on the date on which it has been received by the International Preliminary Examining Authority. By recognizing the date of submission with the International Preliminary Examining Authority as the date of submission with the International Bureau, it is guaranteed that an applicant, who submitted the demand by mistake to the wrong addressee, would not lose the effect under Article 39(1)(a): if a later election is filed with the International Preliminary Examining Authority before the expiration of 19 months from the priority date, but is received by the International Bureau after that period, it would be regarded as having been made prior to the expiration of the 19-month period under Article 39(1)(a), i.e., it would result in the postponing of the entry into the national phase from 20 to 30 months.

Rule 56

Later Elections

56.1 *Elections Submitted Later Than the Demand*

(a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice signed and submitted by the applicant to the International Bureau, and shall identify the international application and the demand.

(b) If a later election is submitted after the expiration of 19 months from the priority date, it does not have the effect provided for under Article 39(1)(a), and the acts referred to in Article 22 must be performed in respect of the designated Office within the time limit applicable under Article 22.

(c) If a later election is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the paper containing the later election and transmit it promptly to the International Bureau. The later election shall be considered to have been submitted to the International Bureau on the date marked.

56.2 to 56.3 [No change]

Ad Rule 56.4

1. Present situation. Present Rule 56.4 provides that use of a printed form for making later elections is preferred and that copies of such forms must be furnished free of charge to applicants. The existing later election form is rarely used. Most applicants make later elections by way of a letter, using the preferred wording suggested in Rule 56.4.
2. Proposed solution. It is proposed to amend Rule 56.4 by deleting any reference to a printed form. The reference to the preferred wording would remain. The present form could, however, continue to be used and it is not intended to remove it from the PCT Applicant's Guide.

56.4 *Form of Later Elections*

The later election shall* preferably be worded as follows: “In relation to the international application filed with ... on ... under No. by ... (applicant) (and the demand for international preliminary examination submitted on ... to ...), the undersigned elects the following additional State(s) under Article 31 of the Patent Cooperation Treaty: ... “.

56.5 [No change]

* The amendment consists in deleting, after the words “election shall” the words “preferably be made on a printed form furnished free of charge to applicants. If it is not made on such a form, it shall”.

Ad Rules 57.1 to 57.5

1. Present situation. The present Rule 57 requires the payment of further handling fees (or, in case of a later election, of a supplement to the handling fee) for each language into which the international preliminary examination report must be translated by the International Bureau. Many mistakes have been made by applicants when paying the handling fee because they did not correctly assess the number of languages into which a translation is required.
2. Proposed solution. It is proposed to amend Rule 57.2(a) consequential to the amendment proposed to Rule 72.1, below. Proposed Rule 72.1 provides for a translation of the international preliminary examination report by the International Bureau only if that report is not in English, and it would only be translated into English. In view of the clearly limited number of translations and in view of the fact that any translation would be only into English, it is proposed to further simplify the PCT system, to do away with the multiplications of the handling fee if a translation is required, and to provide for one single amount of the handling fee. This single amount will be payable by all applicants independent of the language in which the international preliminary examination report is established. Such improvement would be achieved by deleting the second sentence of Rule 57.2(a).
3. The proposed amendments have the advantage that applicants will no longer have to check whether any of the elected Offices requires a translation, and that they will need to pay only one handling fee. The proposed amendments will also facilitate the procedure for the International Preliminary Examining Authorities when checking the payment of the fees.
4. It is also proposed to delete Rule 57.1(b), Rule 57.2(b), Rule 57.3(b) and (d) and Rule 57.5. The complications resulting from the need for a translation of the international preliminary examination report due to a later election filed with the International Bureau can be deleted. The proposed single amount of the handling fee renders the so-called “supplement to the handling fee” superfluous. This solves also the confusion and problems which resulted from the fact that the supplement to the handling fee was payable to the International Bureau, whereas the handling fee itself was payable to the International Preliminary Examining Authority.
5. As a consequence of all the amendments proposed above, it is also proposed to simplify the titles of Rules 57.2 and 57.4.

Rule 57

The Handling Fee

57.1 *Requirement to Pay*

- (a) [No change]
- (b) [Deleted]

57.2 *Amount**

- (a) The amount of the handling fee is as set out in the Schedule of Fees**
- (b) [Deleted]
- (c) to (e) [No change]

57.3 *Time and Mode of Payment*

- (a) [No change]
- (b) [Deleted]
- (c) [No change]
- (d) [Deleted]

* The title has been amended to read “Amount” instead of “Amounts of the Handling Fee and the Supplement to the Handling Fee”.

** The amendment consists in deleting the second sentence.

Ad Rule 57.6

1. Present situation. Under the present Rule 57.6, the handling fee is never refunded. It does not, however, appear to be fair to withhold the handling fee from an applicant who withdraws the demand promptly after filing it (e.g., because he has realized that the demand was received by the International Preliminary Examining Authority only after the expiration of 19 months from the priority date and therefore does not have the effect of postponing the entry into the national phase). Likewise, it does not appear to be fair to withhold the handling fee from an applicant who is not entitled to make a demand because he is not a national or resident of a Contracting State bound by Chapter II of the PCT. In both cases there will be no “handling” of the demand by the International Bureau and it appears therefore to be justified to refund any handling fee paid by such an applicant. Furthermore, the Rule refers to the “supplement to the handling fee” which is proposed to be abandoned (see Ad Rules 57.1 to 57.5, above).
2. Proposed solution. The present provision of Rule 57.6 seems to be too strict particularly where the demand is withdrawn before it is sent to the International Bureau for processing. Accordingly, it is proposed to amend Rule 57.6 to provide for a refund of the handling fee where the demand is withdrawn prior to submission to the International Bureau or is considered under Rule 54.4(a) not to have been made. It is also proposed to no longer exclude expressly the refund of the handling fee in other cases. For reasons of equity, it may be justified to refund the handling fee in some exceptional circumstances. It should be left to the International Bureau to decide about the refunds in such exceptional cases.
3. At the same time, it is proposed to make an amendment consequential to the deletion of Rules 57.1(b), 57.2(b), 57.3(b) and (d) and 57.5, proposed above, and to delete, in Rule 57.6, the reference to the supplement to the handling fee. There will no longer be a supplement to the handling fee if the said Rules are amended as proposed above.

57.4 *Failure to Pay**

(a) to (c) [No change]

57.5 [Deleted]

57.6 *Refund*

If the demand is withdrawn before it has been sent by the International Preliminary Examining Authority to the International Bureau or is considered, under Rule 54.4(a), not to have been submitted, the handling fee shall be refunded.

* The amendment consists in deleting, after the words “to Pay”, the words “(Handling Fee)”.

Ad Rule 59.1

1. Present situation. The present text of Rule 59.1 provides that each Contracting State bound by the provisions of Chapter II shall inform the International Bureau of the International Preliminary Examining Authority or Authorities which are competent for international preliminary examination of international applications filed with its national Office, or with the national Office of another State or an intergovernmental organization acting for the former Office. In practice, however, and in reliance on Article 32(2) it is the receiving Office acting for a State bound by Chapter II which both specifies the International Preliminary Examining Authority or Authorities and informs the International Bureau.
2. Proposed solution. It is proposed to amend Rule 59.1 to align it to the corresponding Article. Article 32(2) provides that it is the receiving Office which, in accordance with the applicable agreement between the International Preliminary Examining Authority or Authorities and the International Bureau, specifies the International Preliminary Examining Authority or Authorities competent for the preliminary examination.
3. The proposed deletion of some words is consequential to the change from “Contracting State” to “receiving Office”. The added full stop and thus resulting new complete sentence is to increase legibility of the text.

Rule 59

The Competent International Preliminary Examining Authority

59.1 *Demands under Article 31(2)(a)*

For demands made under Article 31(2)(a), each receiving Office acting for a Contracting State bound by the provisions of Chapter II shall, in accordance with the terms of the applicable agreement referred to in Article 32(2) and (3), inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with it*. The International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of Rule 35.2 shall apply *mutatis mutandis*.

59.2 [No change]

* The amendment consists in the deletion of: “its national Office, or, in the case provided for in Rule 19.1(b), with the national Office of another State or an intergovernmental organization acting for the former Office, and”. A fullstop is added and the “t” in “the” has been capitalized.

Ad Rule 60.1(a)

1. Present situation. Rule 60.1(a) in its present form requires the International Preliminary Examining Authority to invite the applicant to correct any defect in the demand within one month from the date of the invitation. No provision is made for longer periods for response or for any extension of the one-month period.

2. Proposed solution. It is proposed that Rule 60.1(a) be amended to be subject to new paragraph (e), discussed below under Ad Rule 60.1(e), and to provide for a time limit reasonable under the circumstances, but never less than one month from the date of the invitation. The proposed Rule would also provide for extending the time limit if a decision has not yet been taken by the International Preliminary Examining Authority about the proper correction of the defect. The wording proposed is similar to that of the present Rule 26.2. Although the proposed amendment may make additional time available to applicants, it should be recognized by applicants that a prompt response is to their advantage because international preliminary examination will normally not start before the correction of any defect in the demand has been received. Thus a late response to the invitation reduces the time available for the International Preliminary Examining Authority to issue written opinions and the international preliminary examination report before the deadline of 28 months after the priority date. However, it is nevertheless felt that additional flexibility in the presently rather rigid time frame for correction would be beneficial.

Rule 60

Certain Defects in the Demand or Elections

60.1 *Defects in the Demand*

(a) Subject to paragraph (e), if the demand does not comply with the requirements specified in Rules 53 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. It shall not be less than one month from the date of the invitation to correct. The time limit may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) to (d) [No change]

Ad Rule 60.1(e)

1. Present practice. Under current Rule 59.1(b), a number of alternative events are listed, one of which must occur before international preliminary examination may start, even though the demand and necessary fees have already been submitted. The time delay which currently results from the requirements of Rule 69.1(b) uses valuable time which could be used for preliminary examination. It is, however, necessary under the present system because the basis for international preliminary examination is clear only after the expiration of the applicable period.

2. Proposed solution. In order to be able to begin international preliminary examination as soon as possible after filing the demand, it is proposed above to add new Rules 53.2(a)(v) and 53.9 to require a declaration as to the content of the international application on which international preliminary examination is to begin. Proposed new Rule 50.1(e) relates to the situation where no declaration under Rule 53.2(a)(v) is filed or where such a declaration is made but the amendment referred to therein is not submitted with the demand. Proposed new Rule 60.1(e) provides that, rather than inviting the applicant to submit a declaration and thereby lose valuable time, the international preliminary examination would begin on the basis of the application as originally filed, with the possibility of later amendments being considered at the discretion of the International Preliminary Examining Authority under proposed Rule 55.1(c). The application of the provision of Rule 50.1Ca) to the declaration concerning the basis of the international preliminary examination does not appear to be justified. It is the applicant's risk if he does not clearly specify what he wants. In any event, the application of the sanction that the demand is considered as if it had not been submitted appears to be too severe. Moreover, the applicant has the possibility, after receipt of the first written opinion, to present any amendment desired, including any earlier amendments which had not been taken into account by the International Preliminary Examining Authority for the first written opinion because the applicant failed to make the appropriate declaration in the demand, or failed to submit the copies of the amendments referred to in a declaration made in the demand.

[Rule 60.1, continued]

(e) Where the demand does not contain a declaration concerning the basis of the international preliminary examination as provided for in Rule 53.2(a)(v), or where such declaration has been made but a copy of any amendment referred to in the declaration is not submitted together with the demand, there shall be no invitation under paragraph (a).

60.2 [No change]

Ad Rule 51.1/c)

1. Present situation. The present Rule requires that the International Preliminary Examining Authority be notified of any later election received by the International Bureau. There appears, however, to be no interest on the side of the International Preliminary Examining Authority in receiving information about possible later elections. The text of the present Rule contains, furthermore, a reference to Rule 57.5(c) relating to the failure to pay a supplement to the handling fee, which is proposed above (see Ad Rules 57.1 to 57.5) to be no longer provided.
2. Proposed solution. It is proposed to amend Rule 51.1Cc) by deleting the reference to the International Preliminary Examining Authority and thus to no longer notify that Authority of later elections. Furthermore, it is proposed, consequential to the deletion of Rule 57.5(c), to delete in Rule 51.1Cc) the reference to Rule 57.5(c).

Rule 61

Notification of the Demand and Elections

61.1 *Notification to the International Bureau, the Applicant, and the International Preliminary Examining Authority*

(a) and (b) [No change]

(c) The International Bureau shall promptly notify* the applicant of the receipt, and the date of receipt, of any later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 60.2(b). Where the later election has been considered under Rule** 60.2(c) as if it had not been submitted, the International Bureau shall notify the applicant accordingly.

Ad Rule 61.2(b)

1. Present situation. Rule 61.2(b), at present, requires that the notification to each elected Office under Article 31(7) about its election includes in addition to the number of the international application the name of the receiving Office. Since the application number already identifies the receiving Office by the two-letter country code, the separate listing of the receiving Office is redundant.

2. Proposed solution. It is proposed to delete from Rule 61.2(b) the requirement of an indication in the notification to the elected Offices of the name of the receiving Office with which the international application has been filed. Reference is made to the proposed amendment to Rule 53.6 where the special indication of the name of the receiving Office in the demand is no longer required.

* The amendment consists in deleting after the word “notify”, the words “the International Preliminary Examining Authority and”.

*

** The amendment consists in deleting the reference to Rule 57.5(c).

Ad Rule 61.2(c)

1. Present situation. Under the present Rule 61.2(c) the elected Offices shall be notified of their election promptly after the expiration of the 18th month from the priority date, or, if the international preliminary examination report is communicated earlier, then, at the same time as the communication of that report.

2. Proposed solution. If the proposed amendments to Rules 24.2 and 47.1(a) (see document PCT/CAL/III/2) are adopted, the national Offices will be notified that they have been designated only together with the communication under Article 20. In order to avoid that an Office is notified of its election prior to the communication under Article 20 it is proposed to amend Rule 62.1(c) and to provide for the notification to the elected Offices of all elections made prior to the communication under Article 20 to be effected together with that communication.

Ad Rule 61.3

1. Present situation. Present Rule 61.3 provides for the International Bureau informing applicants that the elected Offices have been notified of their election under Article 31(7) but does not require the naming of each elected Office which has been so notified. Furthermore, the second sentence of present Rule 61.3 requires the International Bureau to inform the applicant, in respect of each elected State, of any applicable time limit under Article 39(1)(b).

2. Proposed solution. It is proposed to amend Rule 61.3 by deleting the current second sentence relating to informing applicants of time limits and replacing it with a new sentence which provides that applicants will be informed of the elected Offices which have been notified as to their election. This amendment would allow applicants to check the correctness of the elections. It would also remove the requirement of the International Bureau to inform the applicant in each case of the applicable time limit under Article 39(1)(b) in each elected Office. The latter amendment corresponds to the amendment proposed in document PCT/CAL/III/2 concerning Rule 24.2(a) which contains an equivalent provision relating to Chapter I and the time limit under Article 22. The reasons given in respect of Rule 24.2(a) apply also here. The information needed is available to applicants in the WIPO publication “PCT Applicant’s Guide, Volume II”.

61.2 *Notifications to the Elected Offices*

(a) [No change]

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant*, the filing date of the application whose priority is claimed (where priority is claimed), the date of receipt by the International Preliminary Examining Authority of the demand, and in the case of later elections, the date of receipt by the International Bureau of the later election.

(c) The notification shall be sent to the elected Office together with the communication provided for in Article 20. Elections effected after such communication shall be notified promptly after they have been effected.

61.3 *Information for the Applicant*

The International Bureau shall inform the applicant in writing that it has effected the notification referred to in Rule 61.2. Such information shall also contain a list of the elected Offices notified under Article 31(7).

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

Ad Rule 62

1. Present situation. Under Rule 62.2, the International Bureau must, at present, transmit promptly copies of claims which have been amended under Article 19 to the International Preliminary Examining Authority. If such amendments are made after the demand has been filed, the Rule requires the applicant to send copies of the amendments to the International Preliminary Examining Authority at the same time as he files amendments with the International Bureau. This is often overlooked by applicants. Where the applicant declares to the International Bureau that he does not wish to make amendments, the Rule requires the International Bureau to inform the International Preliminary Examining Authority accordingly.
2. The present system under Rule 69.1(b) by which international preliminary examination starts only once it is clear whether amendments under Article 19 have been made has proved to be impracticable. If applicants receive, for example, an international search report within nine months from the priority date, they usually file a demand soon thereafter. International preliminary examination, however, may, under the present rules, only start if the time limit for filing Article 19 amendments of the claims before the International Bureau under Rule 46.1 has expired or if the applicant has declared that he does not have the intention to file amended claims under Article 19. The time limit under Rule 46.1 expires 16 months after the priority date and, if an amendment is received after that time limit but prior to the completion of the technical preparations for international publication, it is considered to have been received by the International Bureau on the last day of the 16-month time limit. Since the applicant has the right to file amendments under Article 19 until the completion of technical preparations for international publication, the International Preliminary Examining Authority must expect that applicants file amendments under Article 19 until that moment and can therefore not start with the international preliminary examination. Thus, valuable time is lost which could have been used for international preliminary examination.
3. Proposed solution. It is proposed to amend the present system to establish a general rule that the applicant determines at the time of filing the demand whether international preliminary examination should initially be directed to the international application as filed or as amended (see the proposed amendment to Rule 53.2, above). Where the applicant wishes that the international preliminary examination be directed to the application as amended, he should so declare in the demand and attach the amendments (see proposed new Rule 53.9). Therefore, there is no longer a need for the provisions of the present Rule 62 and it is proposed to delete that Rule.

Rule 62

[Deleted]

[Ad Rule 62, continued]

4. The new system would have the advantage that the International Preliminary Examining Authority is immediately in possession of the claims to which the international preliminary examination shall be directed and would not have to wait before starting the preliminary examination for a copy of such amended claims from the International Bureau. The proposed deletion of Rule 62 will render the PCT system simpler and more straightforward. Once a demand has been filed, an applicant, wanting to amend claims for the purposes of international preliminary examination, must himself send amended claims to the International Preliminary Examining Authority. If an applicant wants such amended claims also to be published, he must also send them to the International Bureau pursuant to Article 19. Amendments to the claims which should be taken into account during international preliminary examination must be filed with the International Preliminary Examining Authority within the time limits applicable under Chapter II of the PCT. Amendments under Article 19 must be filed with the International Bureau within the time limits applicable under Rule 46.1. Under the proposed new system, the amendments made before the International Preliminary Examining Authority and those made under Article 19 are independent of each other.

5. Any amendment to the claims which is made after a demand has been submitted will be governed exclusively by Article 34(2)(b). Naturally, filing amendments to the claims under Article 19 before the International Bureau remains still possible within the time limits provided for under Rule 46.1. However, such amendments will have an effect for international preliminary examination only if they are also submitted by the applicant to the International Preliminary Examining Authority either before international preliminary examination starts or thereafter in response to the written opinion of the examiner. Claims amended pursuant to Article 19 before the International Bureau which are also sent by the applicant to the International Preliminary Examining Authority will be treated like amendments under Article 34(2)(b). They may be accepted under the proposed new Rule 66.1(c) (see below) even if they are sent to the International Preliminary Examining Authority after the filing of the demand if, for example, exceptionally, the international search report was established late.

6. The proposed system will not only be beneficial to the applicant and the International Preliminary Examining Authority, but also to the International Bureau, which will be relieved from monitoring, when a demand is transmitted to it by the International Preliminary Examining Authority, whether amendments to the claims under Article 19 have been made and, in the affirmative, from making copies of the amendments and transmitting them to the International Preliminary Examining Authority. The International Bureau will also be relieved from the need to notify the International Preliminary Examining Authority of any declaration by the applicant that he does not wish to make amendments under Article 19.

Ad Rule 66

1. Present situation. The basis of the international preliminary examination is presently, unless the applicant makes amendments under Article 34(2)(b) before the examination starts, the claims as filed or as amended under Article 19. Therefore, international preliminary examination can start only after amendments under Article 19 have been filed or once it is clear that no such amendments will be filed, under the present Rule 62.2. AS already indicated (see above, Ad Rule 53.9 and Ad Rule 62), waiting until the end of the period for filing amendments under Article 19 wastes valuable time which can better be used for international preliminary examination. Further, the present Rule does not indicate how claims to inventions on which no international search report has been established are to be treated before the International Preliminary Examining Authority.
2. Proposed solution. With reference to the explanations concerning the proposal to amend Rule 53.2, to include a new Rule 53.9 and to delete Rule 62, it is proposed to revise Rule 66.1 completely, to divide it into four paragraphs and to add a new item (vi) to Rule 66.2(a).
3. The proposed amended first paragraph, Rule 66.1(a), is directed to the applicant's right to make amendments to his international application according to Article 34(2)(b) and provides that amendments shall be filed at the International Preliminary Examining Authority together with, or at the same time as, the demand. For amendments filed subsequent to the submission of the demand, see below Ad Rule 66.1(c).
4. The amended second paragraph, Rule 66.1(b), provides that the declaration concerning the basis of international preliminary examination made by the applicant is decisive and that international preliminary examination is initially directed to the claims, the description and the drawings indicated by the applicant in such declaration or, if no declaration is made according to Rule 53.2(a)(v) or if the copy referred to in the declaration is not submitted together with the demand, to the international application as filed.
5. The proposed third paragraph, Rule 66.1Cc), provides for a certain discretion of the International Preliminary Examining Authority firstly in case the applicant files amendments under Article 34(2)(b) later than provided for under Rule 66.1(a) (i.e., after the submission of the demand) and secondly in case the applicant submits, also after the submission of the demand, copies of amendments to the claims made under Article 19 before the International Bureau. The International Preliminary Examining Authority need not consider such amendments if the examiner has started to draw up the first written opinion or the international preliminary examination report.
6. Rule 66.1(c) is proposed in order to introduce more flexibility into an otherwise rather rigid system. It permits the International Preliminary Examining Authority to take into account any amendments received after the demand but before it has begun to draw up the first written opinion. This is not only in the interest of the applicant but it may also be in the interest of the International Preliminary Examining Authority insofar as such amendments would usually have to be considered in any case.
7. The proposed amendment does not limit in any way the possibility to amend the international application under Rules 66~3 and 66.4 subsequent to the first written opinion.

Rule 66

Procedure before the International Preliminary Examining Authority

66.1 *Basis of the International Preliminary Examination*

(a) The applicant may make amendments according to Article 34(2)(b) at the time of filing the demand or, subject to paragraph (c), subsequently.

(b) The international preliminary examination shall initially be directed to the claims, the description, and the drawings, as specified by the applicant in the declaration in the demand according to Rule 53.2(a)(v). If such declaration has not been made or if the copy referred to in the declaration is not submitted together with the demand, the international preliminary examination shall initially be directed to the international application as filed.

(c) Any amendment submitted after the filing of the demand need not be taken into account if the International Preliminary Examining Authority has already begun to draw up the first written opinion or, where applicable, the international preliminary examination report.

[Ad Rule 66, continued]

8. Rule 66.1(d) and 66.2(a)(vi) are proposed in order to provide that only claims directed to inventions on which an international search report has been established are subject to international preliminary examination. This provision clarifies that there would be, during the limited time available for international preliminary examination, no further search required by the International Searching Authority and no search required by the International Preliminary Examining Authority. The procedure will result in any claims directed to inventions not searched being not taken into account for consideration by the International Preliminary Examining Authority. This situation may occur because either they are new claims drawn to non-searched inventions or the claims were not searched since the applicant did not pay additional search fees following a holding of lack of unity of invention by the International Searching Authority.

[Rule 66.1, continued]

(d) Claims relating to inventions on which no international search report has been established shall not be subject to international preliminary examination for the purposes of Article 33.

66.2 *First Written Opinion of the International Preliminary Examining Authority*

(a) If the International Preliminary Examining Authority

(i) to (iii) [No change]

(iv) considers that any amendment goes beyond the disclosure in the international application as filed,*

(v) wishes to accompany the international preliminary examination report by observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, or

(vi) considers that a claim relates to an invention on which no international search report has been established and is therefore not subject to international preliminary examination for the purposes of Article 33, the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such a case, it shall notify the applicant accordingly in writing.

(b) to (d) [No change]

66.3 to 66.9 [No change]

Ad Rule 67.1

1. Present situation. Rule 67, which relates to subject matter not required to be examined, does not currently mention 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 examine such pages of symbol without computer assistance.

2. Proposed solution. It is proposed to add another category of subject matter not requiring international preliminary examination, namely, 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. A similar amendment has been proposed to Rule 39, relating to subject matter not requiring search (see document PCT/CAL/III/2). It is noted that amendments to Rule 67 are subject to Rule 88.3(iii).

* The amendment consists in deleting the word "or".

Rule 67

Subject Matter Under Article 34(4)(a)(i)

67.1 *Definition*

No International Preliminary Examining Authority shall be required to carry out an international preliminary examination on 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 Preliminary Examining Authority is not equipped to carry out an international preliminary examination 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 68

1. Present situation. Rule 68 does not presently mention which claims are considered concerning lack of unity of invention before the International Preliminary Examining Authority. Rule 66.2(a)(vi) is proposed to provide that only claims relating to inventions for which an international search report has been established will be subject to international preliminary examination for the purposes of Article 33.
2. Proposed solution. It is proposed to amend Rules 68.1 and 68.2 to provide that the requirement of unity of invention will only be considered as to claims directed to inventions on which an international search report has been established. An international search report may not have been established on some inventions because no additional fees were paid following a holding of lack of unity of invention by the International Searching Authority or because such inventions were not claimed at the time of the international search.

Rule 68

Lack of Unity of Invention (International Preliminary Examination)

68.1 *No Invitation to Restrict or Pay*

When the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with by the claims relating to inventions on which an international search report has been established and chooses not to invite the applicant to restrict the claims or to pay additional fees, it shall establish the international preliminary examination report,* but shall indicate, in the said report, that, in its opinion, the requirement of unity of invention is not fulfilled and shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention.

68.2 *Invitation to Restrict-or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with by the claims relating to inventions on which an international search report has been established and chooses to invite the applicant, at his option, to ‘restrict the claims or pay additional fees, it shall specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement, and shall specify the amount of the additional fees and the reasons for which the international application is not considered as complying with the requirement of unity of invention. It shall, at the same time, fix a time limit, with regard to the circumstances of the case, for complying with the invitation: such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

68.3 to 68.5 [No change]

* The amendment consists in the deletion, after the word “report” (second occurrence), the words “subject to Article 34(4)(b), in respect of the entire international application”.

Ad Rule 69.1(b)

1. Present situation. At present, Rule 69.1(b) lists four different events and stipulates that international preliminary examination shall start only once any of these events occurs. This results in the start of international preliminary examination being unnecessarily delayed.
2. Proposed solution. It is proposed to amend Rule 69.1(b) and to simplify the system in such a way that it guarantees an optimum use of the time available for international preliminary examination. Reference is made to the explanations relating to the amendments of Rules 53.2, 53.9, 62 and 66. In addition to these amendments, it is necessary to provide, through an amendment of Rule 69.1(b), for the commencement of international preliminary examination, as a general rule, at the occurrence of either the receipt of the international search report or the declaration under Article 17(2)(a) that no international search report will be established. If that report has already been established at the time of filing the demand or, if it is received only after filing of a demand, international preliminary examination shall start as soon as possible. International preliminary examination will, in both cases, be based on the declaration made by the applicant in the demand or, if no declaration is made, on the application as last amended and available to the International Preliminary Examining Authority (see the proposal concerning Rule 66, above). This guarantees a maximum of time for international preliminary examination and avoids the present waiting time until the receipt of amendments under Article 19 or of various notices.

Ad Rule 69.1(c)

1. Present situation. The second sentence of Rule 69.1(c) provides, for the case that the International Searching Authority and the International Preliminary Examining Authority are the same Office and wish to start international preliminary examination simultaneously with the international search, for a time limit for the establishment of the international preliminary examination report of six months after the expiration of the time limit under Rule 46 for amending claims under Article 19 before the International Bureau. As has been explained above in relation to the proposed deletion of Rule 62, amendments under Article 19, unless copies are attached to the demand, will no longer be relevant for international preliminary examination.
2. Proposed solution. It is proposed to delete the second sentence of Rule 69.1(c), since there is no longer a need to link the duration of the international preliminary examination procedure to the period during which the applicant is entitled to make amendments to the claims before the International Bureau. Moreover, the 28-month time limit under Rule 69.1(a)(i) for the establishment of the international preliminary examination report fits perfectly in cases where the preliminary examination starts together with the international search. There is no need for a special time limit for the so-called “telescoped” procedure under Rule 69.1(c), first sentence.

Rule 69

Time Limit for International Preliminary Examination

69.1 *Time Limit for International Preliminary Examination*

(a) [No change]

(b) International preliminary examination shall, subject to paragraph (c), start once the International Preliminary Examining Authority is in possession of the international search report or of a notice of the declaration from the International Searching Authority under Article 17(2)(i) that an international search report will not be established.

(c) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes starts at the same time as the international search.*

Ad Rule 70.2

1. Present situation. Rule 70.2, relating to the basis of the international preliminary examination report, does not cover the situation where certain claims cannot be considered for international preliminary examination because they are drawn on inventions on which no international search report has been established and which under proposed Rule 66.2(a)(vi) (see above) are not required to be examined.

2. Proposed solution. A new Rule 70.2(d) is proposed which would clarify that the international preliminary examination report shall indicate if certain claims were not considered for international preliminary examination either because the claims are new and are drawn to inventions not claimed at the time the international search report was established or because the claims are drawn to inventions not searched because lack of unity of invention was found by the International Searching Authority and no additional search fees were paid for such inventions.

* The proposed amendment consists in deleting, in Rule 69.1(c), the last sentence.
*

Ad Rule 70.3

1. Present situation. Present Rule 70.3, relating to the international preliminary examination report, requires both the international application number and the name of the receiving Office to be indicated. The indication of the name of the receiving Office is superfluous because the receiving Office can be identified by the two-letter country code forming part of the international application number.
2. Proposed solution. Reference is made to the explanations relating to the proposed amendments to Rule 53.6 and Rule 61.2(b). The proposed amendment to Rule 70.3, deleting the requirement to indicate the name of the receiving Office, is complementary to the deletion of the requirement under Rule 53.6 to identify in the demand the receiving Office with which the international application was filed.
3. At the same time, it is proposed to make an editorial change and to delete the comma after the word “application”.

Rule 70

The International Preliminary Examination Report

70.1 [No change]

70.2 *Basis of the Report*

(a) to (c) [No change]

(d) If claims relate to inventions for which no international search report has been established and are therefore not subject to international preliminary examination, the report shall so indicate.

70.3 *Identifications*

The report shall identify the International Preliminary Examining 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.

70.4 to 70.11 [No change]

Ad Rule 70.12

1. Present situation. Rule 70.12, relating to the mention of certain defects in the international preliminary examination report, does not provide for the inclusion of any opinions or reasons as to why the International Preliminary Examining Authority considers that, under Article 34(4), the international application relates to subject matter on which it has decided not to carry out preliminary examination or that the international application is so unclear or the claims are so inadequately supported by the description that no meaningful opinion can be made. The relevant provisions, however, exist. They are contained in Article 35(3).

2. Proposed solution. A new paragraph (iii) is proposed to be added to Rule 70.12 which would provide that, if the international application contains any of the defects referred to in Rule 66.2(a)(i) and Article 34(4), the International Preliminary Examining Authority include any opinions and reasons therefore in the international preliminary examination report as is provided in Article 35(3). Thus, together with the amendment to Rule 70.13, proposed below, Rule 70 would list comprehensively all the items which must be included in the report.

* The amendment consists in deleting the comma after the word “application”.

*

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

Ad Rule 70.13

1. Present situation. The present Rule 70.13, relating to remarks concerning unity of invention, provides only for the situation where an invitation to pay additional fees was issued. Where no such invitation was issued despite a clear lack of unity, it is Rule 68.1 which contains the provision relating to remarks concerning unity of invention.
2. Proposed solution. It is proposed to amend Rule 70.13 by adding a cross-reference to Rule 68.1 and thus complete the listing of items which must be included in the report.

70.12 Mention of Certain Defects

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

- (i) [No change]
- (ii) the international application calls for any of the observations referred to in Rule 66.2(a)(v), it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for this opinion.
- (iii) the international application contains any of the defects referred to in Rule 66.2(a)(i), it shall include this opinion and the reasons therefore in the report pursuant to Article 35(3).

70.13 Remarks Concerning Unity of Invention

If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a), or on the main invention only (Article 34(3)(c), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chooses not to invite the applicant to restrict the claims or to pay additional fees.

Ad Rule 70.14

1. Present situation. Present Rule 70.14 requires that a signature appear on the international preliminary examination report. The requirement for signature or signing is an additional step that requires returning the typed examination report, prior to mailing, back to the authorized officer. In particular, when the international preliminary examination report is produced with the help of a central computer, the obtaining of original signatures requires special handling.
2. Proposed solution. In order to simplify processing of the international preliminary examination report, it is proposed to amend Rule 70.14, including its title, and to provide only for an indication of the name of the authorized officer rather than a signature. If an International Preliminary Examining Authority desired signature for internal control purposes, it would be free to do so, but no signature would be required on the final examination report itself.
3. A similar amendment has been proposed concerning the international search report (see Rule 43.8 in document peT/GAL/III/2).

70.14 *Authorized Officer**

The report shall indicate the name of an authorized officer of the International Preliminary Examining Authority.

70.15 to 70.17 [No change]

Ad Rule 71.2

1. Present situation. Rule 71.2(c) currently provides that an International Preliminary Examining Authority may send copies of documents cited in the international preliminary examination report to the International Bureau and that Bureau would then supply copies to the elected Office or to the applicant. No use of this procedure has been made since operations began under Chapter II.
2. Proposed solution. In view of the fact that no use is being made of the procedure under paragraph (c) of Rule 71.2, it is proposed that this paragraph be deleted along with references thereto in paragraph (d). A similar change has been proposed in respect of Rule 44.3, which contains an equivalent provision for the International Searching Authority (see document PCT/CAL/III/2).

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

Rule 71

Transmittal of the International Preliminary Examination Report

71.1 [No change]

71.2 *Copies of Cited Documents*

(a) and (b) [No change]

(c) [Deleted]

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

Ad Rule 72

1. Present situation. Under the present text of Rule 72, any elected State has the right to require from the International Bureau a translation into English, French, German, Japanese, Russian or Spanish of any international preliminary examination report established in a language other than the official language or one of the official languages of the national Office. Each required translation is a burden for the applicant, who has to pay a further handling fee for each language, for the International Preliminary Examining Authority, which has to check whether the handling fees corresponding to the various translations have been paid by the applicant, and for the International Bureau, which has to prepare all those translations.
2. The International Bureau has, therefore, proposed in the past to all national Offices that, translations should be required only if an international preliminary examination report is not in the English language and then the translation should be into English and into no other language. This has been accepted by all elected Offices and the present world-wide practice is to require a translation of the international preliminary examination report only into English.
3. Proposed solution. It is proposed to amend Rule 72.1(a) in order to reflect the present practice, which will also make it binding for all future Contracting States bound by Chapter II. The amendment of this Rule is a condition for the proposed amendments to Rule 57 relating to the handling fee and to the Schedule of Fees. It will make the system simpler because it would permit the charging of one single handling fee irrespective of whether or not the translation into English will have to be made by the International Bureau. It will simplify the work of the International Preliminary Examining Authority in checking the correct payment of the prescribed handling fee. Furthermore, it will take from the International Bureau the burden of translating the sometimes very complicated international preliminary examination reports into various languages. Those translations would be difficult to cope with by the International Bureau in the future in view of the increasing number of demands for international preliminary examination and the increasing number of international applications filed.

Rule 72

Translation of the International Preliminary Examination Report

72.1 *Languages*

(a) Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office be translated into English*.

(b) [No change]

72.2 and 72.3 [No change]

Ad Rule 73.2

1. Present situation. The communication under Article 36(3)(b) by the International Bureau of the international preliminary examination report to the elected Offices shall, at present, be effected as promptly as 'possible. If a demand is filed early, it may happen that the said report issues prior to the communication under Article 20 of a copy of the international application and prior to a national Office being informed of its election, which under proposed amended Rule 61.2(c) is to be sent together with the communication under Article 20.

2. Proposed solution. It is proposed to amend Rule 73.2 and to provide that the communication of the' international preliminary examination report to the elected Offices will not be effected prior to the notification of an election which is' proposed to take place together with the communication under Article 20 (see Ad Rule 61.2(c), above).

* The amendment consists in deleting, after the word "English," the words " , French, German, Japanese, Russian, or Spanish".

Rule 73

Communication of the International Preliminary Examination Report

73.1 [No change]

73.2 *Time Limit for Communication*

The communication provided for in Article 36(3)(a) shall be effected as promptly as possible but not earlier than the communication under Article 20.

Ad Rule 75

1. Present situation. Rule 75 relates to the withdrawal of the demand, or of elections. A new Rule 90bis is proposed below which would incorporate the content of Rule 75.
2. Proposed solution. If Rule 90bis is adopted, it is proposed to delete Rule 75 since the subject matter thereof is covered in new Rule 90bis.

Rule 75

[Deleted]

Ad Rule 76.5

1. Present situation. Rule 76.5 stipulates that certain Rules relating to Chapter I of the PCT apply also under Chapter II, provided that any reference in the said Rules to certain expressions or Articles is to be construed as a reference to the corresponding expressions or Articles under Chapter II. Rule 49.1(a-ter), which is one of the Rules which applies, contains a cross-reference to Article 24(2). The corresponding cross-reference under Chapter II would be a reference to Article 39(3); however, it is not contained in Rule 76.5. The lack of that reference appears to be an unintentional omission.
2. It is not clear, at present, whether the applicant must furnish to the elected Office, under Article 39(1)(a), a translation of any amendment under Article 19. At present, under Rule 70.16, if such amendments have been made before the start of the international preliminary examination, and have been used as a basis of the examination, they would not be annexed to the international preliminary examination report and therefore would not have to be translated under Rule 74.1. Under the new system which is proposed to be implemented under Chapter II (see the proposals relating to Rules 53.2, 53.9, 62, 66 and 69.1), all amendments, including amendments made under Article 19, have to be sent by the applicant to the International Preliminary Examining Authority, and international preliminary examination will be based on such amendments and on no other amendments. Amendments under Article 19 are considered for the purposes of international preliminary examination only if the applicant so declares and attaches copies to the demand, i.e., if the claims are also “amended before the International Preliminary Examining Authority”. Under Rule 70.16, any replacement sheet containing an amendment made before the International Preliminary Examining Authority must be annexed to the report and any annex to the report must be translated under Rule 74.1. It follows from these provisions that, under the said new system, amendments under Article 19 on which the international preliminary examination is based will be annexed to the report and requires translation under Rule 74.1. If amendments under Article 19 are not a basis of the examination, they are irrelevant for the elected Office and need not be translated.
3. Proposed solution. It is proposed, in order to make Rule 49.1(a-ter) also applicable if Chapter II applies, to amend Rule 76.5 by specifying in item (ii) that a reference to Article 24(2) is to be construed as a reference to Article 39(3).
4. A new item (iv) is proposed to be added to Rule 76.5 which would clarify that no translation of any amendment under Article 19 which was submitted only to the International Bureau and not to the International Preliminary Examining Authority need be furnished to the elected Offices.

Rule 76

Copy, Translation and Fee under Article 39(1); Translation of Priority Document

76.1 to 76.3 [Remain deleted]

76.4 [No change]

76.5 *Application of Rules 22.1(g), 49 and 51bis*

Rule 22.1(g), 49 and 51bis shall apply, provided that:

- (i) [No change]
- (ii) any reference in the said Rules to Article 22 or Article 24(2) shall be construed as a reference to Article 39(1) or to Article 39(3), respectively;
- (iii) the words “international applications filed” in Rule 49.1(c) shall be replaced by the words “a demand submitted”;
- (iv) no applicant shall be required to furnish a translation of any amendment made under Article 19 unless such amendment is annexed to the international preliminary examination report.

Ad Rule 78.1

1. Present situation. Under the present text of Rule 78.1(a), which fixes the time limit for submitting amendments to the international application before the elected Offices, any amendment must have been made upon entering the national phase before the elected Offices, at the latest before the expiration of the time limit applicable under Article 39. Rule 52.1(a) contains an equivalent provision fixing a time limit for amendments upon entering the national phase before the designated Offices. The time limit under Rule 52.1(a), however, is one month from the fulfillment of the requirements for entering the national phase or, if the international application has not yet been communicated by the expiration of the time limit applicable under Article 22, amendments must be made not later than four months after the expiration of that time limit.

2. Proposed solution. It is proposed to amend Rule 78.1(a) and to provide in that Rule a time limit which corresponds to the time limit under Rule 52.1Ca). The International Bureau does not see a particular reason why the time limits for amending the international application are different in the two Rules. Furthermore, it would be simpler for applicants to remember that they have always at least one month from the fulfillment of the requirements for entering the national phase under Article 39(1)(a) and that, should, exceptionally, the international, preliminary examination report not have been established under Rule 69.1(a)(i) before the expiration of 28 months from the priority date, they have the right to amend the claims within at least four months after the expiration of the time limit applicable under Article 39. Thus, both Rule 52.1(a) and Rule 78.1(a) would provide for equivalent time limits for amendments to the application before the designated and before the elected Offices, respectively.

Rule 78

Amendment of the Claims, the Description, and the Drawings, before Elected Offices

78.1 *Time Limit Where Election is effected prior to Expiration of 19 Months from Priority Date*

(a) Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the applicant shall, if he so wishes, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfillment of the requirements under Article 39(1)(a), provided that, if the transmittal of the international preliminary examination report under Article 36(1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any other time if so permitted by the national law of the said State.

(b) [No change]

78.2 and 78.3 [No change]

Ad Rule 80.7(c)

1. Present situation. Rule 80.7(c) provides that the International Bureau shall be open for business until 6 p.m. In practice, the International Bureau is open for receipt of documents filed by hand or through the post until 6 p.m. on all working days which are not holidays. The International Bureau publishes in the PCT Gazette the holidays on which it is closed for receipt of documents filed by hand or through the post. For receipt of documents by teleprinter or telecopier, the International Bureau's machines operate 24 hours a day, seven days a week, i.e. a document received by the International Bureau before midnight is considered to have been received that day despite the fact that the International Bureau is closed for business after 6 p.m.

2. Proposed solution. It is proposed to delete Rule 80.7(c). It is sufficient that the Regulations provide that a period expiring on a given day shall expire at the moment the national office or intergovernmental organization with which the document must be filed or to which the fee must be paid closes for business on that day. There is no necessity to provide in the Regulations for the hours on which the International Bureau is open for business. The opening hours could be fixed in the Administrative Instructions and, even more important, could be published, together with the list of non-working days, once a year in the PCT Gazette. Rule 80.7(b) allows departure from 'that principle, in the sense that documents may be filed up to midnight. In particular, for documents sent by telecopier (facsimile machine) there is no reason why they should' not be accepted if they are received by the International Bureau after closing for business.

Rule 80

Computation of Time Limits

80.1 to 80.6 [No change]

80.7 *End of Working Day*

(a) and (b) [No change]

(c) [Deleted]

Ad Rule 82

1. Present situation. The procedural safeguard contained in Rule 82 has proven to be of importance to prevent losses of rights. Applicants can provide evidence of mailing of documents if the sending was effected five days prior to the expiration of a time limit and the document or letter was received after expiry of the time limit.
2. In many instances conscientious applicants make use of the very reliable express mail services offered by the postal authorities or by private enterprises (e.g., DHL). However, Rule 82 permits evidence only if the mailing was by mail registered by the postal authorities. When a private over-night delivery service is used and a letter or document is registered by them, the document or letter is not registered by a postal authority. Sending of documents through private delivery services is more and more frequently done. Therefore, the right to present evidence on the timely mailing has shown itself in practice to be too limited.
3. Proposed solution. In order to liberalize the right to provide evidence in cases of delayed or lost documents or letters, it is proposed to amend Rule 82.1(a) and to cover other delivery services which provide receipts to the sender. It is also proposed to delete the reference to “mail” in the title of the Rule and to replace the word “mailing” in paragraphs (b) and (c) by the word “sending” as a consequential amendment. On the other hand, it is not proposed to change any reference to “mail service” or “postal services” in Rule 82.2. It appears not to be appropriate to broaden the scope of the latter Rule.
4. At the same time, it is proposed to simplify the wording of Rule 82.1(a) in view of the fact that, nowadays, practically all mail or delivery over a certain distance is effected automatically by airmail. It appears to be sufficient for the purposes of this Rule to require, in general terms, sending in a manner by which a document would normally be delivered at its destination within five days of sending.

Rule 82

Irregularities in the Delivery of Documents *

82.1 *Delay or Loss* **,”

(a) Any interested party may offer evidence that document or letter was sent five days prior to the expiration of the time limit in a manner by which it would normally be delivered at its destination within five days of sending. In any case, evidence may be offered only in the form of a receipt issued by the service responsible for the delivery.

(b) If such sending is proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, or, if the document or letter is lost, *** substitution for it of a new copy shall be permitted, provided that the interested party proves to the satisfaction of the said Office or organization that the document or letter offered in substitution is identical with the document or letter lost.

(c) In the cases provided for in paragraph (b), evidence of sending within the prescribed time limit, and, where the document or letter was lost, the substitute document or letter as well as the evidence concerning its identity with the document or letter lost shall be submitted within one month after the date on which the interested party noticed--or with due diligence should have noticed--the delay or the loss, and in no case later than six months after the expiration of the time limit applicable in the given case.

82.2 [No change]

* The title has been amended to read “Irregularities in the Delivery of Documents” instead of “Irregularities in the Mail Service”.

** The title has been amended to read “Delay or Loss” instead of “Delay or Loss in Mail”.

*** The amendment consists in deleting, after the word “lost,” the words “in the mail”.

Ad Rule 87.2

1. Present situation. Rule 87.2(b) provides that any national Office desiring to receive copies of certain PCT publications must make a request by November 30 for the publications desired during the following calendar year and specify which language of publication is desired.
2. Proposed solution. Rule 87.2(b) is proposed to be amended to provide only that -the national Offices must make a request for copies of publications, without any requirement for an annual renewal of such request. Rule 87.2(b), as proposed to be amended, would also provide for copies of publications being obtained in more than one language.

Rule 87

Copies of Publications

87.1 [No change]

87.2 *National Offices*

(a) [No change]

(b) The publications referred to in paragraph (a) shall be sent on special request*. If any publication is available in more than one language, the request shall specify the language or languages in which it is desired.

Ad Rule 88

1. Present situation. Rule 88.1(ii) still refers to the alternative procedure for transmittal of the record copy to the International Bureau under Rule 22.2 which was deleted in 19S4.

2. Proposed solution. It is proposed that Rule 88.1 {ii} be deleted because Rule 22.2, to which it refers, has already been deleted. It is noted that voting on this item is subject to Rule 88.1 and notice requirements are set forth in Rule 88.4.

* The amendment consists in deleting, after the words “special request”, the following: “which shall be made, in respect of each year, by November 30 of the preceding year”.

*

Rule 88

Amendment of the Regulations

88.1 *Requirement of Unanimity*

Amendment of the following provisions of these Regulations shall require that no State having the right to vote in the Assembly vote against the proposed amendment:

- (i) [No change]
- (ii) [Deleted]
- (iii) to (vii) [No change]

88.2 to 88.4 [No change]

Ad Rule 90.1(i)

1. Present situation. Rule 90.1(i) provides for recognition as agents of those persons only which are referred to in Article 49.
2. Proposed solution. The amendment of Rule 90.1(i) is proposed for the reasons outlined in document PCT/CAL/III/2 in connection with the proposed amendment of Rule 2.2. The revised Rule 90.1(i) would permit persons having the right to practice before the International Preliminary Examining Authority to be recognized, as agents, for Chapter II procedures.

Ad Rule 90.3(b)

1. Present situation. At present, under Rule 90.3(b), a separate power of attorney may be submitted only to the receiving Office or to the International Bureau.
2. The filing of a power of attorney with the International Preliminary Examining Authority is not provided for. If the applicant appoints an agent for his representation before the International Preliminary Examining Authority, he must at present furnish the power of attorney to the receiving Office or to the International Bureau. If he furnishes it to the receiving Office, that Office is usually not aware of the fact that a demand has been filed and therefore cannot, although it should under the present Rule 90.3(b), inform the International Preliminary Examining Authority.
3. Proposed solution. It is proposed to amend Rule 90.3(b) and to provide that the applicant may file the power of attorney also with the International Preliminary Examining Authority. Where an applicant appoints an (additional) agent for the purposes of Chapter II proceedings, it is in the first place the International Preliminary Examining Authority which needs to be informed of the appointment and which needs the power of attorney if the appointment is not made in the demand.
4. At the same time, it is proposed to delete the second sentence of the present Rule 90.3(b), according to which the recipient of the power of attorney should immediately notify the interested International Searching Authority and the interested International Preliminary Examining Authority. Sections 328 and 425 of the Administrative Instructions provide for a notification relating to appointments of agents by the receiving Office or the International Bureau to all parties concerned. There is no need to burden the Regulations with these administrative details which are of no direct interest to applicants and which, in case of the receiving Office, can often not be complied with in respect to the notification of the International Preliminary Examining Authority.

Rule 90

Representation

90.1 *Definitions*

For the purposes of Rule 90.2 and Rule 90.3:

(i) “agent” means any of the persons referred to in Article 49 or, for the purposes of the procedure under Chapter II of the Treaty, any person who has the right to practice before the International Preliminary Examining Authority to which the demand is submitted;

(ii) [No change]

90.2 [No change]

90.3 *Appointment*

(a) [No change]

(b) The power of attorney may be submitted to the receiving Office, the International Bureau or the International Preliminary Examining Authority.

(c) and (d) [No change]

Ad Rule 90.3(e)

1. Present situation. Applicants from Japan and the United States of America frequently appoint a European patent attorney as representative before the European Patent Office for the purposes of international preliminary examination. Such appointment is often made by the agent who filed the international application. In particular, where such agent has been appointed in the request, it is not clear whether he is entitled to appoint himself an additional agent.

2. Proposed solution. It is proposed to add a new Rule 90.3(e) which would stipulate that, unless excluded, the appointment of an agent includes the power to appoint an additional agent. Such a provision is desirable in order to avoid cumbersome correspondence for the clarification of the question whether an agent who has been appointed in the request has the right to appoint an additional agent or not.

3. It is also proposed to provide in the new Rule that only a person who has the right to practice before the receiving Office or before the Office acting as International Preliminary Examining Authority may be appointed as an additional agent.

[Rule 90.3, continued]

(e) A duly appointed agent or common representative shall be considered to be authorized to appoint an additional agent for the procedure before the receiving Office, the International Searching Authority or the International Preliminary Examining Authority, unless such authorization is expressly excluded. The additionally appointed agent is required to have the right to practice before the national Office with which the international application was filed or before the national Office acting as the International Preliminary Examining Authority in accordance with Rule 90.1(i).

90.4 [No change]

Ad Rule 90bis [New]

1. Present situation. At present, the different possibilities to withdraw the international application, designations, the demand, elections, as well as priority claims, are provided for in Rules 32, 32bis and 75 as well as in Article 37. Users of the system have difficulties to find the applicable provisions in the Treaty and the Regulations.

2. The present Regulations allow a withdrawal under Rule 32 of the international application or of designations until the expiration of 20 months from the priority date. Where the 30-month time limit under Article 39(1)(a) applies, the Regulations do not provide for a withdrawal of the international application after 20 months from the priority date. Furthermore, the effect of a withdrawal in a designated or elected State in which national processing or examination has already started is not clear. Should the international search or preliminary examination continue only for the State where the national phase has already started?

3. The effect of a withdrawal in a designated or elected State depends on the interpretation of the words hereafter underlined in present Rule 32.1(a): “The applicant may withdraw the international application prior to the expiration of 20 months from the priority date except as to any designated State in which national processing or examination had already started” and of the words hereafter underlined in present Rule 75.1(a): “Withdrawal of the demand or all the elections may be effected prior to the expiration of 30 months from the priority date except as to any elected State in which national processing or examination has already started.”

4. These words mean, in the view of the International Bureau, that the start of national processing or examination puts an end to the international phase with respect to that State. Once the national phase has started in a given State, a withdrawal under Rule 32.1 or Rule 75.1 does not affect the application in that State and any withdrawal must be sent by the applicant to the national Office of, or acting for, such State. The general rule applies that the international phase is over when the national processing or examination has already started. After the beginning of the national phase, it is the national law and no longer the PCT which applies in respect of a withdrawal, and it is for this reason that Rules 32.1 and 75.1 contain the said exception. There is no evidence that the said exception could mean that the international phase continues in respect of the State in which the national processing or examination has already started and that, for example, the international search or the international preliminary examination, if not yet completed, would have to continue for the purposes of just that State.

[The text of new Rule 90bis appears on page 87].

[Ad Rule 90bis, continued]

5. This interpretation is supported by the present practice. For example, Section 419 of the Administrative Instructions provides for a notification of the International Preliminary Examining Authority, by the International Bureau, of the withdrawal of the demand. Upon receipt of such a notification, the international preliminary examination is stopped. Should the international preliminary examination continue in respect of the elected Office where the national phase has already started, the PCT would have to provide for the notification of the International Preliminary Examining Authority, by the International Bureau, of the fact that the withdrawal of the demand or of an election is without effect with respect to a certain State because the national phase has already started in that State. But this is not foreseen by the PCT. Moreover, such notification cannot be made because the elected Office does not notify the International Bureau of an early beginning of the national phase and, consequently, the International Bureau is not aware of that fact and cannot notify the International Preliminary Examining Authority thereof.
6. As far as the withdrawal of a priority claim is concerned, it may, under the present Regulations, be effected until international publication. The Regulations do not provide for a withdrawal after that event, although it would be of great interest to applicants because it would further postpone the beginning of the national phase.
7. Proposed solution. To streamline the system and to clarify the questions outlined above in connection with withdrawals, it is proposed to combine, in one new Rule, Rule 90bis, all provisions relating to withdrawals and to cover all possible situations in which applicants can make a withdrawal. At the same time, it is proposed to clarify certain points of ambiguity. Further, it is proposed that the new Rule include related matters such as where the withdrawal should be sent and the question of the prevention of international publication of the international application.
8. The new Rule 90bis.1 provides the general legal basis for the withdrawal of the international application as such. The proposed Rule corresponds basically to the present Rule 32 which is proposed to be deleted (see document PCT/CAL/III/2). However, it clarifies that a withdrawal of the international application is possible also if it is made after the expiration of 20 months from the priority date in all cases where Chapter II applies. The withdrawal must, in such cases, be made prior to the expiration of 30 months from the priority date and has the consequence that all international processing, including international preliminary examination, is terminated (see new Rule 90bis.5(b)).
9. As far as the effect of a withdrawal in respect of a designated Office is concerned where the national processing or examination has already started, see below the proposed new Rules 90bis.5 and 90bis.6.

Rule 90bis [New]

Withdrawals

90bis.1 Withdrawal of the International Application

(a) The applicant may withdraw the international application at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date.

(b) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau or to the receiving Officer. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

(c) There shall be no international publication of the international application if the notice effecting withdrawal or a notification from the receiving Office that the international application has been withdrawn reaches the International Bureau prior to 15 days before the international publication.

[Ad Rule 90bis, continued]

10. New Rule 90bis.2 provides for the withdrawal of designations. The text corresponds to the present Rule 32 which is proposed to be deleted (see document PCT/CAL/III/2). However, it provides in addition for the withdrawal of a designation, where Chapter II applies in respect of the State concerned, until the expiration of 30 months from the priority date. This Rule complies with the practice of applicants which withdraw a designation rather than the corresponding election because they do not understand the present system correctly. It appears clearer to expressly allow and provide for the possibility to withdraw a designation throughout the international phase even where a designated State has been elected. However, where the latter is the case, the withdrawal of a designation would have the effect of withdrawal of the corresponding election.

[Rule 90bis, continued]

90bis.2 Withdrawal of Designations

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies in respect of that State, prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall be considered to be a withdrawal of that election under Rule 90bis.4.

(b) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90bis.1.

(c) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau or to the receiving Office. In the case of Rule 4.8 (b), the notice shall require the signature of all applicants.

(d) There shall be no international publication of the designation if the notice effecting withdrawal or a notification from the receiving Office that the designation has been withdrawn reaches the International Bureau prior to 15 days before the international publication.

[Ad Rule 90bis, continued]

11. New Rule 90bis.3 relates to notices of withdrawal of priority claims. Such withdrawals are at present governed by Rule 32bis which is proposed to be deleted if this Rule is adopted (see document PCT/CAL/III/2). The possibility of withdrawing the priority claim, which is presently open only until international publication, has been used so far primarily to delay international publication of the international application where the applicant was uncertain as to whether he wanted to retain his invention as a secret or to have it published later without the benefit of the priority date.
12. It appears to be to the applicant's advantage to go a step further and to allow the applicant also to postpone, by withdrawing later on the priority claim, the entry into the national phase. This may be desired because an applicant does not have sufficient funds to cover the cost to begin the procedures before the designated or elected Offices within the time periods under Articles 22(1) or 39(1)(a), calculated from the filing date of the earlier application. Such a delayed entry into the national phase is justified because the applicant could have initially filed the international application without benefit of the priority claim. Therefore, no undue advantage is given to the applicant. Similarly, applicants could withdraw a priority claim to delay the date for filing a demand, while still obtaining the delay to enter the national phase before the elected States under Article 39(1)(a).
13. Consequently, it is proposed to provide in a new Rule 90bis.3(a) and (b) that, in effect, a priority claim may be withdrawn until the expiration of 20. months from the priority date, which corresponds to the time limit under Article 42(1), or, if a demand has been filed prior to the expiration of the 19th month from the priority date, until the expiration of 30 months from the priority" date, whichcorresp6tids to the time limit under Article 39 (1) (a)."
14. Proposed Rule 90bis.3(c) corresponds to Rule 32bis.1(c) under which only time periods which have not yet expired will be recomputed from the effective priority date resulting from the, withdrawal of the priority claim.
15. Paragraph (d) of new Rule 90bis. 3 provides that international publication may still occur if the notice effecting withdrawal of a priority claim is received by the International Bureau during the period of 15 days preceding: international publication.

[Rule 90bis.3, continued]

90bis.3 Withdrawal of the Priority Claim

(a) The applicant may withdraw the priority claim made in the international application under Article 8(1) at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date.

(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one or more or all of the priority claims.

(c) Where the withdrawal of the, priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (d), be computed from the priority date resulting from that change.

(d) In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice effecting withdrawal or a notification from the receiving Office that the priority claim has been withdrawn reaches the International Bureau during the period of 15 days preceding the expiration of that time limit.

(e) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau or the receiving Office. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

[Ad Rule 90bis, continued]

16. New Rule 90bis.4 relates to withdrawal of the demand or of elections. It provides that the demand or any or all elections may be withdrawn until the expiration of 30 months from the priority date. This corresponds to the present Rule 75 which is proposed to be deleted (see Ad Rule 75, above) if this Rule is adopted.

17. As far as the, effect of a withdrawal in respect of an elected Office is concerned where the national processing or examination has already started, see below the proposed new Rules 90bis.5 and 90bis.6.

18. New Rule 90bis.5 clarifies the effects of withdrawals and makes it clear that withdrawals under Rule 90bis do not affect the international application in any designated or elected Office where the national processing has already started. In respect of such an Office it is the national law which applies, and where the applicant wants a withdrawal to have effect in the said Office he must address the withdrawal to that Office (see Rule 90bis.6, below).

90bis.4 Withdrawal of the Demand, or of Elections

(a) The applicant may withdraw the demand or any or all the elections at any time prior to the expiration of 30 months from the priority date;

(b) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

90bis.5 Effect of Withdrawal

(a) The withdrawal of the international application, of a designation, of a priority claim, of the demand or of an election, effected under Rules *90bis.1*, *90bis.2*, *90bis.3* or *90bis.4*, as the case may be, shall have no effect in any designated or elected Office where the processing or examination of the international application has already started.

(b) Where the international application is withdrawn under Rule *90bis.1*, all international processing shall be terminated.

(c) Where the demand or all elections are withdrawn under Rule *90bis.4*, all processing by the International Preliminary Examining Authority shall be terminated.

[Ad Rule 90bis, continued]

19. New Rule 90bis.6 clarifies that notices of withdrawal must be addressed to the designated or elected Office if they are sent after certain time periods have expired.

20. New Rule 90bis.7 is the same as present Rule 75.4 which is proposed to be deleted if the proposed new Rule 90bis is adopted.

90bis.6 Withdrawal after Expiration of Time Limit

Any withdrawal of the international application, of a designation, of a priority claim, of the demand or of an election, effected after the period specified in Rules 90bis.1(a), 90bis.2(a), 90bis.3(a) or 90bis.4(a), as the case may be, or after the processing or examination has started in a designated or elected Office, shall be addressed to each designated Office or elected Office concerned.

90bis.7 Faculty under Article 37(4)(b)

(a) Any Contracting State wishing to take advantage of the Faculty provided for in Article 37(4)(b) shall notify the International Bureau in writing.

(b) The notification under paragraph (a) shall be promptly published by the International Bureau in the Gazette, and shall have effect in respect of international applications filed more than one month after the publication date of the relevant issue of the Gazette.

Ad Rule 91.1

1. Present situation. Rule 91 relates to rectification of obvious errors in the international application and other documents. Rule 91.1(b) defines an obvious error as something other than what was obviously intended. Allowable rectifications are only those which are obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification. It has been argued that these provisions are too restrictive. Furthermore, an editorial change appears to be desirable to clarify paragraph (c) of Rule 91.1.

2. Proposed solution. An additional sentence is proposed to be added to Rule 91.1(b) which would clarify that rectification is also permitted if the error is obvious from a comparison of the originally filed international application with any other papers which may have been filed by the applicant by the international filing date. For example, the Fee Calculation Sheet contains a listing of all designated States for which the payment of the designation fees is intended. If this listing does not correspond to the designations made in the request and the designation fees have been fully paid as indicated in the Fee Calculation Sheet, it is obvious that there exists an error, and the applicant should be allowed to rectify such error.

3. Rule 91.1(c) is proposed to be amended by deleting the words “elements or” since confusion has arisen as to the definition of “element”. There appears to be no need to provide, in addition to the omission of entire sheets for the omission of entire elements. If such element is the description, the claims or the drawings, it will be contained on one or more omitted sheets and is thus covered by the amended Rule. It should be noted that the omission of an entire sheet can be remedied if the later filed sheet is received by the receiving Office within the applicable time limit under Rule 20.2 but, in such a case, the international filing date would have to be changed.

Rule 91

Obvious Errors in Documents

91.1 *Rectification*

(a) [No change]

(b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification. Rectification of an international application shall also be admitted if the error is obvious from a comparison of the international application with any other paper relating to the international application which had been filed by the applicant by the international filing date.

(c) Omissions of entire* sheets of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

(d) and (e) [No change]

Ad Rule 92.2

1. Present situation. Rule 92.2(a) requires, in general, that any letter or document submitted to the Authorities be in the language of the international application to which it relates. There is no provision which would permit the use of the language of any translation made under Rule 12.1(c), i.e., a translation of the international application prepared under the responsibility of the receiving Office for the purposes of international search.

2. Proposed solution. It is proposed to add a new sentence to Rule 92.2(a) which provides that, where the international application has been translated under Rule 12.1(c), the language of the translation must be used in any letter or document submitted by applicant to the Authorities. The International Searching Authority requires a translation under Rule 12.1(c) because the international application was filed in a language which is not an official language of the International Searching Authority. The International Searching Authority should be permitted to impose its official language(s) in such a case.

* The amendment consists in deleting, after the word “entire,” the words “elements or”.

Ad Rule 92.3

1. Present situation. Rule 92.3 provides that any document or letter mailed by a national Office or an intergovernmental organization setting a time limit running from the mailing date shall be sent by registered air mail. Such mailing is quite expensive and cumbersome for both the sender and the recipient, and does not seem to serve any really useful purpose.
2. Proposed solution. Rule 92.3 is proposed to be amended by deleting the word “registered” so that the use of registered mail is no longer required by the Rule.

Rule 92

Correspondence

92.1 [No change]

92.2 *Languages*

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. Where the international application has been translated under Rule 12.1(c), the language of such translation shall be used.

(b) to (e) [No change]

92.3 *Mailings by National Offices and Intergovernmental Organizations*

Any document or letter emanating from or transmitted by a national Office or an intergovernmental organization and constituting an event from the date of which any time limit under the Treaty or these Regulations commences to run shall be sent by* air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within two days from mailing or where air mail service is not available.

* The amendment consists in deleting, before the words "air mail" (first instance), the word "registered".

Ad Rule 92.4

1. Present situation. Present Rule 92.4 concerns the sending of documents subsequent to the international application by various telecommunication means. The filing of an international application by such means is, at present, not covered. The present Rule provides that a document sent by telecommunication means is considered to have been submitted only if it is furnished within 14 days in a form complying with Rules 11.14 and 92.1(a). If the applicant fails to repeat the sending in the proper form within 14 days, the communication of that document is considered not to have been made. There appears to be no need to require such a confirmation within 14 days in all cases.

2. Proposed solution. It is proposed to make two amendments to this Rule. The first amendment expressly allows the possibility of filing an international application by any of the telecommunication means referred to in Rule 92.4(a). The second amendment concerns the need to confirm a document within 14 days in the proper form.

3. As far as the express permission for filing an international application by a telecommunication means is concerned, it is to be noted that the PCT Assembly, during its twelfth session in September 1984,

“agreed that an international application which is received by telecopier by the receiving Office, is to be accorded an international filing date if all the requirements listed in items (i) to (iii) of Article 11(1) are complied with and that any formal defect, such as the lack of signature or of fitness for reproduction, may be corrected upon invitation issued by the receiving Office under Article 14(1). It was understood, however, that no receiving Office would be obliged to make telecopier facilities available to applicants.” (See document PCT/A/XII/4, paragraph 18)

The proposed amendment, therefore, implements in the Regulations what has been agreed as an admissible practice already years ago.

4. The second amendment consists in the deletion of the second sentence of present Rule 92.4(a), providing for the automatic confirmation within 14 days of all papers sent by telecommunication means. It is replaced, as far as the filing of an international application is concerned, by the new paragraph (d) of Rule 94.2 and, as far as documents subsequent to the international application are concerned, by the new paragraph (e) of Rule 92.4 (for both new paragraphs, see below).

5. The content of proposed new Rule 92.4(c) is consequential to the amendments proposed to paragraph (a) of Rule 92.4. The Rule provides for any transmittal by electronic means of the international application to be followed up promptly by the submission of the original which is needed to guarantee a good quality copy for the international publication. The Rule provides further that electronic transmittal shall be accompanied by a sheet which identifies the transmitted document and contains a statement that the original document is being submitted immediately. The Rule provides finally that the original document when submitted must be accompanied by a letter identifying the earlier electronic transmitted document and the date of transmittal.

92.4 *Use of Telegraph, Teleprinter, Telecopier, Etc.**

(a) Notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraphs (b) to (f), the international application or any subsequent documents relating thereto may be transmitted by telegraph, teleprinter, telecopier (facsimile) Or other like means of communication producing a printed or written document.**

(b) [No change]

(c) The transmittal of any document making up the international application (including any replacement sheet and any sheet containing amendments) by any of the means referred to in paragraph (a) shall be followed up immediately by a submission of the original document in a form complying with these Regulations. The transmittal shall be accompanied by a transmittal sheet containing the identification of the transmitted document and a statement that the original of the transmitted document is being submitted immediately by mail or by other means of delivery. The original document shall be submitted with a letter which identifies the earlier transmitted document, the means of communication used and the date of transmittal.

* The title has been amended to read “Use of Telegraph, Teleprinter, Telecopier, Etc.” instead of “Use of Telegraph, Teleprinter, Etc.”

** The amendment consists in deleting the second sentence of Rule 92.4(a),

[Ad Rule 92.4, continued]

6. In a new Rule 92.4(d), it is proposed to provide for a special procedure for all transmittals of international applications and sheets referred to in paragraph (c) by telecommunication means: ,the transmittal of such papers needs to be followed up automatically by sending the original within 14 days. If the said transmittal contains a statement that the original follows, the national Office or intergovernmental organization receiving the international application by telecommunication means will wait 14 days from the date of transmittal for the original copy. If the original copy is not received within 14 days, then the receiving Office shall issue pursuant to Rule 26.1 the invitation provided for in Article 14(1)(b), fixing a time limit for submission of the document complying with the requirements of Rule 11 and duly signed by the applicant. If no statement concerning the following up by sending the original was sent with the transmittal by telecommunication means, the said invitation will be sent without waiting for 14 days.

7. In respect of documents sent by telecommunication which are not part of, or a replacement sheet relating to, the international application, it is proposed to no longer require automatic confirmation. Therefore, it is proposed to provide in a new Rule 92.4(e) that, the original copy of such a document should be retained in applicant's files. The sending by telecommunication should be followed up by forwarding the original only if the applicant is invited to do so.

8. Sending by means of telecommunication means nowadays, to an increasing extent, the sending of a facsimile by a telecopier. A telecopy contains normally an indication of the telephone number from which it was sent and it shows whether the original of the document so sent has been signed. Such a signature received by telecopier shall be accepted, under proposed Rule 92.4(f), as duly signed unless the original is required under Rule 92.4(c) to (e). The original of such document with the original signature will be in the file of the applicant who sends the paper and, should proof of its authenticity be required, then, upon invitation, such an original would have to be submitted by the applicant. Proof of the authenticity may always be required by the Office or Authority receiving a facsimile by a telecopier if it considers it necessary.

[Rule 92.4 continued]

(d) If the transmittal of a document making up the international application does not contain a statement that the original document is being submitted immediately, or if the said original document is not received by the national Office or intergovernmental organization within 14 days of the date of transmittal by the means referred to in paragraph (a), an invitation to correct under Rule 26.1 shall be issued and, if the applicant does not comply with the invitation within the time limit under Rule 26.2, the international application shall be considered withdrawn under Article 14(1) (b) .

(e) If the transmitted document is a kind of document other than the kinds of documents referred to in paragraph (c), the original document shall be submitted only upon invitation, within a time limit which shall be reasonable under the circumstances. If the applicant does not comply with the invitation within the time limit fixed in the invitation, the document shall be considered as not having been submitted.

(f) A document which is transmitted by telecopier (facsimile) and bears a signature shall be regarded as duly signed under these Regulations except where the submission of the original document is required under paragraphs (c) to (e).

Ad Rule 96

1. Present situation. Present item 4 of the Schedule of Fees provides for a “Supplement to the Handling Fee” which is no longer required under the proposed amended Rule 57. Likewise, item 5, on surcharges is no longer required because it is included in the proposed amended Rule 16*bis*.
2. Proposed solution. It is proposed to delete item 4 “Supplement to the Handling Fee” from the Schedule of Fees as a consequential amendment to the amendments proposed to Rule 57, since there will be no longer a supplement to the handling fee.
3. It is furthermore proposed to delete item 5 “Surcharge for late payment” because these surcharges will be paid to the receiving Office under proposed Rule 16*bis* and the amounts of the surcharges are proposed to be provided for in proposed Rule 16*bis*.1(f).
4. In addition it is proposed to amend item 2 by adding a reference to Rule 4.9(a) which would make it clear that a designation subject to confirmation made under Rule 4.9Cb) is not covered by the maximum amount of the designation fee. The designation fee with the surcharge as proposed under Rule 15.5 is payable in all cases in which a designation made under Rule 4.9(b) is confirmed by the applicant.
5. Finally it is proposed to label the two parts under item 1; Basic Fee, by adding the letters (a) and (b), respectively. This amendment would facilitate references to either of the two parts.

Rule 96

The Schedule of Fees

96.1 [No change]

SCHEDULE OF FEES

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	706 Swiss francs
(b) if the international application contains more than 30 sheets	706 Swiss francs plus 14 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	171 Swiss francs per designation for which the fee is due, with a maximum of 1,710 Swiss francs, any such designation, made pursuant to Rule 4.9(a), in excess of 10 being free of charge
3. Handling Fee: (Rule 57.2(a))	216 Swiss francs
4. and 5. [Deleted]	

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