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SUGGESTIONS CONCERNING RULES 53.7, 53.7**bis**, 54.2, 59,  
63 AND 67

Received from the Australian Patent Office

The present document contains suggestions received from the Australian Patent Office concerning the proposed amendments of certain Rules.

**E**

The following text is suggested:

53.7bis *Indications for the Purposes of the Election of States*

(a) An election may be made by naming a State or a designated Office which grants regional patents or by indicating for the State or Office a two letter code as provided in the Administrative Instructions. The naming or indicating of a designated Office which grants regional patents shall be considered as an election, for the purposes of that regional patent, of all the Contracting States bound by Chapter II for which it was the designated Office.

(b) Where, pursuant to Article 4(i)(ii), the request contains, for a designated State for which a regional patent is available, an indication that the applicant wishes to obtain such a patent and the request also contains the designation of that State without such an indication (the said State not being a State to which Article 45(2) applies), elections may be made in the same manner. An election concerning the designated State shall be considered to be for the purposes of a regional patent where an indication to that effect is given; otherwise an election shall be considered to be for the purposes of a national patent. An indication that an election is for the purposes of a regional patent shall be considered to be made so long as it is apparent that this is intended and, in any event, shall be considered to be made if the indication of the State includes a reference to a patent other than a national patent or the Office or organization entrusted with granting a regional patent (for example, the inclusion of an indication such as 'regional', 'European', or 'EP', in conjunction with the indication of the State).

(c) An indication that all designated States bound by Chapter II are elected shall be considered an election of all such States. Where the circumstance dealt with in paragraph (b) applies, the election of a State designated for the purposes of a regional patent as well as a national patent shall likewise be considered as separate elections of that State for the purposes of a regional as well as a national patent.

Ad Rule 54.2

While what is proposed in relation to Rule 54.2 is generally acceptable having regard to what is provided in Article 31(2)(a), it would be useful to study whether the result of Article 31(2)(a) and this Rule provides sufficient flexibility to applicants who may wish to do business freely in a global economy. Consequently the International Bureau should study (e.g. invite comments on) the use of Article 31(2)(b) and Rule 54.2(2)(i). In doing so, it would have to take into account the provisions of Article 31(4)(b).

Simple reliance on what is proposed may result, in the case of different applicants for different contracting States, in a single applicant for an elected State being a person is not connected with a Contracting State bound by Chapter II (or indeed any Contracting State); this is barely consistent with Article 31(2)(a). The best chance of a remedy lies in Article 31(2)(b).

ATTACHMENT TO LETTER DATED 24 AUGUST 1990  
TO DIRECTOR GENERAL OF WORLD INTELLECTUAL PROPERTY ORGANIZATION

Ad Rule 53.7

The text in the present Regulations sets out the minimum requirement for a demand i.e. that it shall indicate at least one Contracting State bound by Chapter II. (If this is not done, the defect will be the subject of the procedure under Rule 60.1).

Proposed new paragraph 53.7(b) is concerned with a different issue, namely, how to make indications of elections (of Contracting States) in the demand.

It is suggested that what is proposed under new paragraph 53.7(b) be dealt with in a separate Rule 53.7bis which would also resolve some other issues or problems (mentioned below) which exist in relation to Article 31. Rule 53.7 would deal only with the minimum requirement.

To achieve the specification of a minimum requirement in Rule 53.7 the following changes are suggested.

(a) Change the heading to 'Minimum Requirement for Election of States'.

(b) In the text of the present Regulation, change the word 'name' to the word 'indicate'.

Article 31(4)(a) specifies that the demand shall 'indicate' the Contracting State(s) elected in the demand.

Since the purpose is to specify the minimum requirement (not how it is to be achieved), there is no need to refer to regional Offices. The indication may, in fact, be effected by naming a regional Office but that would follow from what would be said in Rule 53.7bis.

Ad Rule 53.7bis

It is suggested that this Rule deal with the following issues:

(a) How to indicate Contracting States in the demand (i.e. the matters dealt with under Rule 53.7(b) in document PCT/CAL/III/3).

(b) How to indicate Contracting States when the request of the international application, as originally filed, contained designations of a Contracting State both for the purposes of a national patent and for the purposes of a regional (European) patent. Article 31(4)(a) does not help in this regard. The sensible solution would seem to be to repeat in the demand the kinds of indications that were made in the request (or, where a regional patent is sought, an indication of the name of the regional Office). A basis for this could be provided in the suggested Rule 53.7bis.

The proposed heading of the Rule does not seem appropriate since it does not deal with the situation 'Same for all Elected States or Different for Different Elected States'. It only deals with 'Several Applicants'.

Ad Rule 59

Having regard to the terminology to be found in Article 31(2)(a) ('receiving Office of or acting for such a State', i.e. Contracting State bound by Chapter II), it would seem preferable to insert the words 'of or' after the words 'receiving Office' in the first line of the amended text.

Ad Rule 63

Consistently with the changes agreed to at the July meeting, it is suggested that this Rule be amended to read as follows.

**RULE 63**

**Minimum Requirements for International Preliminary Examining Authorities**

**63.1 *Definition of Minimum Requirements***

The minimum requirements referred to in Article 32(3) shall be the following:

(i) [No change]

(ii) that Office or organization must have available to it adequate means to access for international preliminary examination at least the minimum documentation referred to in Rule 34;

(iii) [No change]

Ad Rule 67

The chapeau of this Rule purports to contain prescriptions as to the obligations of the International Preliminary Examining Authorities. However, the obligations of those Authorities are as set out in Article 34(4)(a)(i). They are only partially reflected in Rule 67. In particular, Rule 67 does not reflect the fact that the IPEA has to make a decision in the particular case.

The confusion has been added to by agreements between the IPEAs and the International Bureau which purport to regulate the question of the subject matter that the IPEAs will or will not examine.

With the intention of eliminating the present inconsistencies and reinforcing the Treaty provisions of Article 34(4)(a)(i), the following text is suggested.

**RULE 67**

**Subject Matter under Article 34(4)(a)(i)**

**67.1 *Definition***

The subject matter under Article 34(4)(a)(i) on which an International Preliminary Examining Authority is not required to carry out international preliminary examination, and in a particular case may decide not to carry out such examination, comprises the following:

(i) to (vi) [As in document PCT/CAL/III/3, page 45]