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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE FOR ADMINISTRATIVE AND LEGAL
MATTERS

Fourth Session, First Part⁺
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PROPOSED AMENDMENTS TO PART A AND PART B OF THE REGULATIONS
UNDER THE PCT

Memorandum Prepared by the International Bureau

INTRODUCTION

1. Proposals for amendments of the PCT Regulations were submitted to the PCT Committee for Administrative and Legal Matters (hereinafter referred to as “the Committee”) in documents PCT/CAL/III/2, 3 and 4. Additional proposals for amendments were submitted to the Committee by various delegations in documents PCT/CAL/III/6, 7, 8 and 9.
2. The present document contains revised proposals for amendment of the Introductory Rules^{*} and the Rules Concerning Chapter I of the Treaty, taking into account the conclusions of the third session of the Committee, held in Geneva from July 2 to 6, 1990 (first part) and

⁺ *Editor’s Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

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

September 17 to 21, 1990 (second part). The revised proposals are submitted for further consideration by the Committee at its fourth session. Certain proposals which were agreed

unanimously by the Committee during its third session are so indicated in the text of this document; there should be no need for their further consideration by the Committee at its fourth session. After further revision taking into account the conclusions of the fourth session, it is intended that proposed amendments to the PCT Regulations will be submitted to the Assembly of the PCT Union for consideration and, if appropriate, adoption. Revised proposals for amendment of the Rules concerning other Chapters of the Treaty will be prepared for consideration at the second part of the fourth session of the Committee.

3. The proposed amendments appear on the odd-numbered pages, whereas the corresponding explanations appear on the opposite even-numbered pages. In the text itself of the Rules proposed to be amended, underlinings indicate what is new indicate what is new as compared to the present text. Deletions of text matter in a given Rule are identified by asterisks.

4. The Committee is invited to consider and advise the International Bureau on the proposed amendments contained in the present document.

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EXPLANATIONS OF THE PROPOSED AMENDMENTS

Ad Rules 2.2 and 2.2bis

1. Present situation. Rule 2.2 defines “agent” by reference only to persons entitled to practice under Article 49. Moreover, there is overlap between the present definition in Rule 2.2, the definition of the same term in Rule 90.1, and the other provisions of Rules 90.2 and 90.3 in relation to agents.
2. Under the present definition in Rule 2.2, the word “agent” includes the common representative referred to in Rule 4.8, unless the contrary is indicated. In fact, in all instances of the word “agent” in the Regulations, the contrary is indicated by the wording, purpose or content of the provision concerned, so the inclusion of common representative within the definition of “agent” is confusing and unnecessary. There are, however, a number of instances where the words “common representative” appear in the text of the Regulations.
3. Proposed solution. The question of appointment of agents, and who may be appointed as an agent, is governed by Rule 90. Proposed amendments in relation to Rule 90 are also being prepared for consideration at the second part of the fourth session of the Committee. To avoid any overlap and possible inconsistencies, it is proposed to simplify the definition in Rule 2.2 by merely referring to agents appointed under Rule 90.1bis.
4. It is also proposed to include a definition of “common representative” as new Rule 2.2bis, thus distinguishing between agents and common representatives as is already the case throughout the text of the Regulations. Proposed amendments to Rules 4.8 and 90 will leave the question of appointment of common representatives to Rule 90.1bis, and this is reflected in proposed Rule 2.2bis.

TEXT OF THE PROPOSED AMENDMENTS

Rule 2

Interpretation of Certain Words

2.1 [No change]

2.2 “*Agent*”

Whenever the word “agent” is used, it shall be construed as meaning an agent appointed under Rule 90.1bis, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used*.

2.2bis “*Common Representative*”

Whenever the expression “common representative” is used, it shall be construed as meaning an applicant appointed as, or considered to be, the common representative under Rule 90.1bis.

2.3 [No change]

* The amendment consists in deleting the word “also the common representative referred to in Rule 4.8”.

Ad Rule 3.1

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

Ad Rule 3.3(a)

1. Present situation. The present wording of Rule 3.3 refers only to the filling-in of a printed form.
2. Proposed solution. It is proposed to amend Rule 3.3(a) and to delete in the first line the words "printed form". This is in consequence of the proposed provision in Rule 3.1 which would allow for the possibility to present the request in a manner other than by using a printed form, namely, as a computer print-out.
3. After further consideration, it is proposed by the International Bureau not to reword the introductory sentence and subparagraph (ii) of this Rule, as was suggested by the Committee (see paragraph 11 of document PCT/CAL/III/5). The present wording is believed to be satisfactory.
4. Subparagraph (iii) of this Rule is proposed to be amended to remove the reference to where the abstract is published, because this is irrelevant for the purposes of this Rule.

Rule 3

The Request (Form)

3.1 *Form of Request**

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

3.2 [No change]

3.3 *Check List*

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

(i) and (ii) [No change]

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

(b) [No change]

Ad Rule 3.4

1. Present situation. The present wording of Rule 3.4 refers only to a printed form.
2. Proposed solution. It is proposed to amend Rule 3.4 and to add to the matter the particulars of which would be prescribed in the Administrative Instructions a reference to a request presented in the form of a computer print-out. The Administrative Instructions will prescribe in particular the layout, in order to have some uniformity of style in computer generated request forms.
3. This proposed amendment was agreed by the Committee at its third session.

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

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

*** The amendment consists in deleting, after the word "published", the words "on the front page of the pamphlet and in the Gazette".

4. A text for a new Administrative Instruction which would cover both the request and the demand (with regard to the demand, see also explanatory notes for Rule 53.1(a) as proposed in document PCT/CAL/III/3 and to be included in a revised form in a subsequent document to be prepared for the second part of the fourth session of the Committee) could read as follows:

Section 102bis

Request or Demand Presented as a Computer Print-out under

Rule 3.4 or Rule 53.1(a)

(a) The printed Form PCT/RO/101 (Request) or PCT/IPEA/401 (Demand) if presented as a computer print-out shall be prepared according to the particulars listed in Annex G.

(b) Slight variations in layout necessary in view of the printing of such computer print-outs in various languages as well as the use of a variety of computer equipment shall be permitted.

Annex G:

[Remains to be prepared in consultation with computer experts]

3.4 *Particulars*

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

Ad Rule 4.1(b)(iv)

1. Present situation. Rule 4.1(b)(iv) requires that the request shall contain, where the applicant wishes to obtain a regional patent, an indication of that wish as well as the names of all the designated States. This is often an extended list and may be incomplete because of recent ratifications or accessions.

2. Proposed solution. Rule 4.1(b)(iv), as proposed to be amended, maintains the requirement of an indication of the applicant's wish to receive a regional patent, but no longer requires the indication of the names of all of the States designated for the purposes of such patents. Details of how States are to be designated in such a case are found in Rule 4.9(a)(ii) as proposed to be amended, and are no longer needed in Rule 4.1(b)(iv). The request Form will, in any event, contain clear pre-printed boxes for designations designed to avoid mistakes.

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) [No change]

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

(iv) an indication that the applicant wishes to obtain a regional patent,*

(v) [No change]

(c) and (d) [No change]

4.2 to 4.3 [No change]

*

The amendment consists in the deletion of the words “and the names of the designated States for which he wishes to obtain such a patent”.

Ad Rule 4.4(c)

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

4.4 *Names and Addresses*

(a) and (b) [No change]

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

(d) [No change]

4.5 to 4.7 [No change]

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

Ad Rule 4.8

1. Present situation. Rule 4.8(a) requires the request, if there are several applicants and they are not all represented by a common agent, to designate a common representative. Rule 4.8(b) provides where there is no such designation of a common representative, for the applicant first named in the request who is entitled to file an international application with the receiving Office concerned, to be the common representative. However, there are also provisions in Rule 90.3 for appointment of a common representative by a power of attorney.
2. Proposed solution. It is proposed to place all provisions for appointment of common representatives in Rule 90. Proposed amendments to that Rule will be included in a subsequent document to be prepared for the second part of the fourth session. Rule 4.8 would then merely refer, like the remainder of Rule 4, to the contents of the request, requiring that, if a common representative is designated, the request shall so indicate.

Ad Rule 4.9(a)

1. Present situation. At present, the designation of States for the purposes of a patent under a regional patent treaty, such as the European Patent Convention or the Bangui Agreement (OAPI), must be made by an indication of the name of the individual States and, if there is also a national patent available, by an indication that protection under a regional patent treaty is desired for the State indicated. In order to facilitate the designation for a patent under a regional patent treaty, the present request Form provides the possibility for a designation “en bloc” for the purposes of a regional patent granted by the European Patent Office (EPO) or by the African Intellectual Property Organization (OAPI) by listing, next to the check box for a European or OAPI patent, all the names of the States which, at the time of printing the form, are party to both the PCT and the regional patent treaty concerned. When, later, a State which is party to the regional patent treaty becomes a PCT Contracting State or, vice versa, a PCT Contracting State becomes a party to the regional patent treaty, or a State becomes party to both the PCT and the regional patent treaty, applicants often forget to supplement the indication of their wish to obtain the regional patent by the designation of such State not listed on the request Form.
2. Proposed solution. It is therefore proposed to amend Rule 4.9 and to provide, in addition to individual designations (Rule 4.9(a)(i)), for a collective designation of States for the purposes of a regional patent (Rule 4.9(a)(ii)).

3. A collective indication may refer simply to all the States party to a regional patent treaty at the time of filing, or to all those States with specified exceptions, e.g., “European patent for all States party to the European Patent Convention except...” Where an applicant does not wish to designate all PCT Contracting States which are party to the regional patent treaty, he may either make a collective indication with specified exceptions, as described above, or indicate the designated States individually. All this would comply with the provisions of the European Patent Convention which require that designated States be identified. The designation for an OAPI patent, however, always has effect in all PCT Contracting States party to the Bangui Agreement; particular States need not be identified in the case of such a designation, either individually or collectively, because a limitation to individual Contracting States is not possible under that Agreement.

4.8 *Common Representative**

If a common representative is designated, the request shall so indicate.

4.9 *Designation of States*

(a) Contracting States shall be designated in the request

(i) in the case of designations for the purpose of obtaining national patents, by an individual indication of each State concerned:

(ii) in the case of designations for the purpose of obtaining a regional patent, by an indication of the regional patent which is desired, together with, where required by the relevant regional patent treaty, either an individual indication of each State concerned or a collective indication made in such a manner that it is obvious which States are intended to be designated.

* The title has been amended to read “Common Representative” instead of “Representation of Several Applicants Not Having a Common Agent”.

[Ad Rule 4.9(a), continued]

4. It should be noted that only one designation fee is required for the purposes of all States designated under a regional treaty (Rule 15.1(ii)). When the national (regional) phase is entered before the EPO, applicants may choose certain States before the EPO by paying only the EPO designation fees for those States for which a European patent is desired.

5. It should be noted that an individual indication of a State may be effected by using its full name or an accepted short title or two-letter code. It is proposed to amend Section 201(a) of the Administrative Instructions, to clarify this matter, as follows:

Section 201

Indications of States, Territories and Intergovernmental Organizations

(a) A State, territory or intergovernmental organization referred to in the request shall be indicated either by its full name, by a generally accepted short title which, if the indications are in English or French, shall be as appears in Annex A, or by the two-letter code as appears in Annexes A and B.

Ad Rule 4.9(b)

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

2. Proposed solution. It is proposed to add a paragraph (b) to Rule 4.9 and to provide that the request may include a text to the effect that in addition to the States designated according to Rule 4.9(a) and provided that at least one State is designated under Rule 4.9(a), all other States are designated which are party to the PCT at the time of filing the international application. In the printed request Form, this could be done by the inclusion of a check-box in which the marking is already printed (see paragraph 4, below, for proposed text). The requirement of according a filing date under Article 11 would be fulfilled because there must be at least one individual or collective designation under Rule 4.9(a). The effect of such a designation under Rule 4.9(b) is mainly of a precautionary nature intended to help an applicant who inadvertently omitted to designate a specific Contracting State for which he had intended to obtain patent protection. Further, it would allow the applicant to correct mistakes in designations by paying the necessary designation fee(s) and specifying the State(s) or regional patent system(s) concerned (by making individual or collective indications, as would be the case under Rule 4.9(a)).

3. In addition, it is proposed to provide that the applicant must declare that any designation under Rule 4.9(b), if the fee referred to in Rule 15.5 is not paid to the receiving Office before the expiration of 15 months from the priority date and if the applicant does not specify the designated State for which such fee is intended (see also the proposed amendment to Rule 15.5, below), is to be considered not to have been made. This would relieve the receiving Office from making a declaration as to the fate of the designation in accordance with Article

14. A designation considered not to have been made under Rule 4.9(b) need not be notified to the applicant or the Offices whose designations are thus considered not to have been made.

4. Proposed text to be added to Box V of the request Form.

Box V: Designation of groups of States or States

At the bottom of Box V, add the following:

Applicant hereby designates all Contracting States which have not been designated above and declares that any such designations in respect of which the receiving Office has not, before the expiration of 15 months from the priority date, received the prescribed fees together with an indication specifying the designated States for which such fees are paid, are to be considered not to have been made.⁽⁴⁾

In the notes at the very bottom of Box V, add the following:

(4) Such designations are possible only if at least one designation has been made above.

[Rule 4.9, continued]

(b) The request may contain an indication that all Contracting States other than those designated under paragraph (a) are also designated, provided that at least one Contracting State is designated under paragraph (a) and that the request also contains a statement that any designation made under this paragraph which is not confirmed in a written notification to the receiving Office before the expiration of 15 months from the priority date, accompanied by the fee prescribed under Rule 15.5, is to be considered not to have been made.

Ad Rule 4.10(b)

1. Present situation. Rule 4.10(b) provides that, where priority is claimed in an international application and the indication in the request of the country or date of the earlier application is missing or erroneous, or, in case the earlier application is a regional or an international application, the indication of at least one country for which the earlier application was filed, and of the date on which the earlier application was filed, is missing or erroneous, the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made, subject to an exception. The exception applies currently only where the identity or correct identity of the country, or the date or correct date, may be established on the basis of the copy of the earlier application which reaches the receiving Office before it transmits the record to the International Bureau. Then the error shall be considered an obvious error. The present time period, limited by the transmittal of the record copy to the International Bureau, is fairly short and restricts correction where the correct data can be easily established at a later date on the basis of a copy of the earlier application.
2. Proposed solution. It is proposed to amend Rule 4.10(b) by changing the present limitation of the rectification of an obvious error to cases where the earlier application, which establishes the identity or correct identity of the country, or the date or correct date, is received by the receiving Office before the record copy is transmitted to the International Bureau. The amendment would have the effect that correction of the missing or erroneous indication of the country or date would be subject to the submission of a copy of the priority document within the time limit provided for in Rule 17.1(a).
3. This proposal varies from that previously agreed by the Committee. The variation is proposed in order to clarify the time limit for making such a correction and to link it clearly to the provisions of Rule 17.1(a) relating to submission of the priority document on the basis of which the correction is to be made.

4.10 *Priority Claim*

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

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made except where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous: whenever the identity or correct identity of the said country, or the said date or * correct date, is established on the basis of the copy of the earlier application submitted before the expiration of the time limit under Rule 17.1(a) computed on the basis of the correct date, the error shall be considered as an obvious error.

(c) to (e) [No change]

4.11 to 4.14 [No change]

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

Ad Rule 4.15

1. Present situation. Article 14(1)(a)(i) provides that it is a defect in an international application if “it is not signed as provided in the Regulations”. Present Rule 4.15 provides: “The request shall be signed by the applicant” and makes no exception. If the international application is not signed by all applicants, and the defect is not corrected within the prescribed time limit, the application shall be considered withdrawn (see Article 14(1)(b)).
2. If the applicant whose signature is missing is an applicant only for the purpose of the designation of the United States of America (i.e., if that applicant is an inventor), it should be recognized in the Regulations that situations where that applicant is unwilling to sign or cannot be found or reached exist and consequently that such situations can be remedied provided some conditions are fulfilled. One such situation is where the applicant/inventor refuses to sign the international application because he no longer is an employee of the company to which he has assigned his rights to the application and which is the applicant for all other designated States. Another situation is where such an applicant/inventor has changed his residence and cannot be located.
3. Proposed solution. Rule 4.15(a) as proposed to be amended makes it clear that exceptions are possible to the principle that the request must be signed by all applicants.
4. Proposed new Rule 4.15(b) provides that, if the signature of an applicant for the purposes of the designation of a State for which that applicant must be the inventor (i.e., at present for the United States of America) is lacking, and if the other applicant or applicants (for the same or for different designated States) have signed the request, it shall be sufficient if a statement is provided by the other applicant or applicants explaining to the satisfaction of the receiving Office that the former applicant is unwilling to sign, or cannot be found or reached after diligent effort. Where such a statement is furnished and satisfies the receiving Office, the international application would be regarded, pursuant to Article 14(1)(a)(i), as signed as provided in the Regulations. Where such a statement is not furnished or does not satisfy the receiving Office, the receiving Office must issue an invitation under Rule 26.1(a). Upon expiration of the time limit fixed in the invitation, the receiving Office then proceeds as provided in Rule 26.5(a).

4.15 *Signature*

(a) Subject to paragraph (b), the request shall be signed by the applicant or, if there is more than one applicant, by all of them.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant, provided that:

- (i) the request has been signed by the other applicant or applicants indicated in the request, and
- (ii) the applicant or applicants who have signed the request have furnished a statement explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.

4.16 and 4.17 [No change]

Ad Rule 5.2

1. Present situation. Rule 5 provides general guidance for the content of the description of the invention. It does not, at present, provide for a standardized format for description of nucleotide and amino acid sequence data. More and more applications containing disclosure of such sequences are filed and it is in the interest of the applicant as well as the international authorities that provisions in this regard be found in the Regulations.

2. Proposed solution. It is proposed to add a new Rule 5.2 relating to disclosures of nucleotide and/or amino acid sequences in international applications which would require any such sequences to be placed within or at the end of the description and to use standardized format and symbols (these would be the subject of a proposed Administrative Instruction set out in the explanatory notes to Rule 13ter). For the submission of such sequences in machine readable form, which are required to permit proper search and examination of applications containing such data, see also proposed new Rule 13ter and the proposed amendment to Rule 39.1 (below).

Rule 5

The Description

5.1 [No change]

5.2 *Nucleotide and/or Amino Acid Sequence Disclosure*

An international application which contains disclosure of a nucleotide and/or amino acid sequence shall contain within, or at the end of, the description, but before the claims, a listing of the sequence in a format, and using symbols, prescribed under Rule 13ter.1.

Ad Rule 11.6(a)

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

Ad Rule 11.6(e)

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

Rule 11

Physical Requirements of the International Application

11.1 to 11.5 [No change]

11.6 Margins

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

-top: 2 cm

-left side: 2.5 cm

-right side: 2 cm

-bottom: 2 cm

(b) to (d) [No change]

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

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

Ad Rule 11.6(f)

1. Present situation. Present Rule 11.6(e) requires all margins to be completely blank. This provision prohibits the applicant from placing his applicant's file reference in the margin of sheets of the international application.
2. Proposed solution. The proposed new Rule 11.6(f) provides for an exception to the general rule laid down in Rule 11.6(e) by allowing expressly that applicants may indicate an applicant's file reference in the top margin. If such an applicant's file reference is indicated within 1.5 cm from the top of the sheet, it will not negatively affect a reasonably uniform international publication of international applications since the reference will not appear in the top margin of the pamphlet.
3. In addition, it is proposed to include in new Rule 11.6(f) an indication that there is a maximum number of characters allowed for the applicant's file reference, and that such number is to be found in the Administrative Instructions (i.e. Section 108(b)). The maximum number is presently 10. Since the applicant will want to see his own file reference being used on correspondence received from the various international authorities, it is in his interest to know that there is a maximum number of characters allowed for such reference and proposed new Rule 11.6(f) makes it clear. On the other hand, and in order to take into account foreseeable changes in the near or more distant future, it seems advisable to indicate such maximum in the Administrative Instructions and consequently modify it, when necessary, without amending the Rule. It should be noted that some national Offices are already allowing, or will very shortly allow, a maximum of 12 or 15 characters for the applicant's file reference of national applications. Therefore, it is proposed to allow a maximum of twelve characters.
4. Section 108 of the Administrative Instructions is proposed to be modified as follows:

Section 108

Correspondence Intended for the Applicant

- (a) [No change]
- (b) Any correspondence from an International Authority to the applicant or his agent shall be marked with the, file reference, composed either of letters or numbers, or both, of the applicant or the agent if so indicated on the request Form, provided this reference does not exceed twelve characters.

[Rule 11.6, continued]

(f) The top margin may contain in the left-hand corner an indication of the applicant's file reference, provided that the reference does not appear beneath 1.5 cm from the top of the sheet. The number of characters in the applicant's file reference shall not exceed the maximum fixed by the Administrative Instructions.

Ad Rule 11.7(b)

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

Ad Rule 11.8(b)

1. Present situation. Present Rule 11.8(b) requires that all line numbers appear on the left side, to the right of the margin. WIPO Standard ST.22, "Recommendation for the presentation of patent applications typed in optical character recognition (OCR) format" provides in paragraph 7(e) that "line numbering, if given, should be in the left-hand margin area" "Rule 11.8(b) is not compatible with this Standard.
2. Proposed solution. The proposed amendment to Rule 11.8(b) provides for an exception to the general rule to leave the margin blank by giving applicants the option to put the numbering of lines on the left-hand side of the sheet either within or outside the left-hand margin in conformity with WIPO Standard ST.22. This would solve the conflict between the present Rule and WIPO Standard ST.22. Both formats are acceptable with regard to a reasonably uniform international publication of international applications.

11.7 *Numbering of Sheets*

(a) [No change]

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

11.8 *Numbering of Lines*

(a) [No change]

(b) The numbers should appear on the left side, in or preferably to the right of the margin.

11.9 to 11.14 [No change]

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

Ad Rule 12.3

1. Present situation. An international application must be in the prescribed language, otherwise the receiving Office does not accord an international filing date (Article 11(1)(ii)). An international application as provided under Article 3(2) shall contain a request, a description, claims and, where required, drawings. It happens occasionally that an applicant files the request on a printed form which is in a language different from the language of the international application. It also happens that applicants overlook that drawings filed with the international application contain words in a language different from the language used in the description and the claims of the international application. Refusing an international filing date in case of such a minor defect due to an oversight appears to be much too severe a sanction. Receiving Offices have in the past usually allowed a correction of such a defect without affecting the international filing date.
2. Proposed solution. It is proposed that a very liberal approach be taken to requests and drawings not filed in a language admitted under Rule 12.1, noting that such cases are likely to be extremely rare and to be accidental rather than deliberate abuses. Proposed new Rule 12.3 thus would permit requests and drawings to be filed in any language: that is, requests and drawings, for the purposes of Article 11(1)(ii), would always be filed in a “prescribed language” as required by that Article. Requests and drawings filed in a language or languages other than a language admitted under Rule 12.1 will, however, be subject to later correction pursuant to the procedure set out in proposed Rule 26bis (see below). Naturally, it will also be necessary for the address to which communications concerning the application are to be sent to be identifiable by the receiving Office.
3. The problem in relation to the language of abstracts is addressed in proposed Rule 20.4(c) (see below).

Rule 12

Language of the International Publication

12.1 and 12.2 [No change]

12.3 *Request and Drawings*

The request, or the drawings so far as they contain text matter, or both, may be filed in a language or languages other than a language admitted under Rule 12.1, provided that the address to which communications concerning the international application are to be sent can be identified by the receiving Office and that a translation into the language of the description and the claims is filed before the expiration of the time limit fixed by the receiving Office under Rule 26bis.

Ad Rule 13ter

1. Present situation. As discussed in the explanatory notes to proposed new Rule 5.2, the submission of a listing of a nucleotide and/or amino acid sequence is not covered by the Regulations. The sequence listings are often so complex and long that the only satisfactory method of search and examination is a computerized search and examination which compares the sequence disclosed in an international application with the sequences appearing in the existing data bases. It is at the time when the international search has to be carried out that the question of the format of the sequence listing, and whether or not it is machine readable, is most crucial.
2. It should be noted that the furnishing of a copy of a sequence listing in machine readable form is already, or will be, required under the national law applicable in several national Offices.
3. Proposed solution. Proposed new Rule 13ter.1 would provide for the use of symbols and a uniform format for sequence listings to be prescribed in the Administrative Instructions so that computerized search and examination would be possible. A new Section in the Administrative Instructions could read as follows:

Section 209bis

Symbols and Machine Readable Format for Listings of Nucleotide
and/or Amino Acid Sequences

The symbols to be used for listings of nucleotide and/or amino acid sequences as well as the format of such listings shall comply with WIPO Standard ST ... [under preparation by the PCIPI].

4. Proposed new Rule 13ter.2(a) provides for the International Searching Authority, where it finds that the sequence listing does not comply with the prescribed standard, or is not in a machine readable form acceptable to that Authority, to invite the applicant to furnish a copy complying with the prescribed standard, or to furnish a copy in machine readable form or pay the cost of transcription of the sequence listing into machine readable form by the International Searching Authority (where the latter is prepared to make such a transcription).
5. Each International Searching Authority will, subject to generally applicable provisions, determine its own requirements for sequence listings to be in machine readable form. Such requirements would especially concern the maximum length of a sequence listing for which a machine readable copy of the sequence listing will not be necessary and, depending on its technical facilities, determine how the data must be furnished so that they can be read by machine. Such requirements would be notified by the International Searching Authorities to the International Bureau for publication in the Gazette. Applicants will usually be familiar with the requirements of the national Office which acts as International Searching Authority

and will be able to submit a copy of the sequence listing in machine readable form according to those requirements. The International Searching Authorities will also determine the fee to be paid in case the applicant chooses the option, if it is available, of having the International Searching Authority transcribe the sequence in machine readable form for him. These various provisions could be included in the Annexes, concerning fees and charges, to the Agreements between the various International Searching Authorities and the International Bureau.

Rule 13ter [New]

Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Format and Symbols for Sequence Listings

The format and the symbols to be used for a sequence listing referred to in Rule 5.2 shall comply with a standard to be prescribed by the Administrative Instructions.

13ter.2 Sequence Listing Not as Prescribed or Not in Machine Readable Form

(a) If the International Searching Authority finds that a sequence listing does not comply with the prescribed standard or is not in a machine readable form acceptable to that Authority, it may invite the applicant, within a time limit fixed in the invitation, as the case may be:

(i) to furnish to it a copy of the sequence listing complying with the prescribed standard, or

(ii) to furnish to it a copy of the sequence listing in a machine readable form acceptable to that Authority or, if that Authority is prepared to transcribe the sequence listing into machine readable form, to pay for the cost of such transcription.

(b) If the applicant does not comply with the invitation within the time limit fixed in the invitation, the International Searching Authority may make the declaration referred to in Article 17(2)(a).

[Ad Rule 13ter, continued]

6. Proposed new Rule 13ter.2(b) enables the International Searching Authority to make the declaration referred to in Article 17(2), and notify the applicant and the International Bureau accordingly, when the applicant does not comply with the invitation under Rule 13ter.2(a). It should be noted that proposed new Rule 39.1(vii) (see below) makes it clear that the International Searching Authority is not required to search an international application whose subject matter includes nucleotide and/or amino acid sequences to the extent that listings of those sequences required by the International Searching Authority under Rule 13ter are not available to it.

7. Under proposed new Rule 13ter.2(c), if the International Searching Authority transcribes the sequence into machine readable form, it would send a copy of the transcription to the applicant. If international preliminary examination is requested, proposed new Rule 13ter.2(d) provides for a copy of a sequence listing furnished or transcribed under Rule 13ter.2(a) to be made available, on request, to the International Preliminary Examination Authority.

8. Proposed new Rule 13ter.3 ensures that the separately furnished or transcribed copy of a sequence listing, as distinct from a listing appropriately contained in the description as provided in Rule 5.2, would not form part of the international application. It will therefore not be communicated to the designated Offices. However, designated Offices might need a copy of a sequence listing in machine readable form for their own purposes. Proposed new Rule 13ter.4 therefore permits a designated Office to require the applicant to furnish a copy of any sequence listing in a machine readable form acceptable to it.

[Rule 13ter.2, continued]

(c) The International Searching Authority shall send to the applicant a copy of any transcription of a sequence listing made by it under paragraph (a)(ii).

(d) The International Searching Authority shall, upon request, make available to the International Preliminary Examination Authority a copy of a sequence listing furnished or transcribed under paragraph (a).

13ter.3 Copy of Sequence Listing Not Part of International Application

A copy of a sequence listing furnished or transcribed under Rule 13ter.2(a) shall not form part of the international application.

13ter.4 Requirement of Designated Office

Once the processing of the international application has started before a designated Office that Office may require the applicant to furnish to it a copy of any sequence listing in a machine readable form acceptable to it.

Ad Rules 15.1 and 15.5

1. Present situation. The new system proposed for inclusion in Rule 4.9(b) provides for designations which are withdrawn with effect from the expiration of 15 months from the priority date unless a special fee for designations is paid within that period (see Rule 4.9(b), above).
2. Proposed solution. An amendment to Rule 15.1(ii) is proposed to make it clear that the “designation fee” is the fee payable for a designation made in the request pursuant to Rule 4.9(a) and to distinguish that fee clearly from the new fee payable for designations made under Rule 4.9(b).
3. It is proposed to provide in Rule 15.5 for the payment of a fee for the confirmation of a designation made under Rule 4.9(b), comprising the designation fee (fixed under item 2 of the Schedule of Fees annexed to the Regulations) together with a confirmation fee of 50% of the designation fees payable. The confirmation fee is proposed in order to discourage abuses of this designation system and to ensure that such a late payment of fees connected with designations is the exception rather than the rule. The designation fee would be paid for the benefit of the International Bureau and the confirmation fee for the benefit of the receiving Office.
4. It should be noted that Rule 16bis does not apply to the payment of fees under proposed new Rule 15.5.

Ad Rule 15.4(d)

1. Present situation. Present Rule 15.4(d) provides for a transition period which appears to be no longer needed.
2. Proposed solution. In order to remove unnecessary wording and concepts from the Regulations, it is proposed that paragraph (d) of Rule 15.4 be deleted.
3. This proposed amendment was agreed by the Committee at its third session.

Rule 15

The International Fee

15.1 *Basic Fee and Designation Fee*

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

(i) [No change]

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

15.2 and 15.3 [No change]

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

(d) [Deleted]

15.5 *Fee for Confirmation of Designations under Rule 4.9(b)*

The confirmation of a designation or designations under Rule 4.9(b) is subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office) equal to 50\ of the sum of the designation fees paid. The maximum referred to in item 2 of the Schedule of Fees does not apply to designation fees paid under this paragraph.

Ad Rule 15.6

1. Present situation. Present Rule 15.6(a) provides that the international fee shall be refunded if the international application is not accorded a date of filing under Article 11(1). Further, it is stipulated in Rule 15.6(b) that in no other case shall the international fee be refunded. This severely limits the situations in which international fees may be refunded.

2. Practice under the past 11 years of operation under the PCT has shown that there are certain special cases other than the one covered by Rule 15.6(a) where it would have been justified also to refund the international fee to the applicant. However, it is difficult to find a general formula to cover all the different cases where a refund would be equitable. For example, an international application is filed and the international fee as well as the transmittal fee, if any, and the search fee are paid; due to a misunderstanding, however, the filing did not correspond to the intention of the applicant and, within a very short time after filing, the international application is withdrawn. At present, the receiving Office can refund the transmittal fee, and the International Searching Authority can refund the search fee in accordance with its agreement with WIPO if the search has not yet started. Only the international fee, which is a substantial one, cannot be refunded under the present Rule.

3. Proposed solution. It is proposed to amend Rule 15.6 to provide for refund of the international fee if the international application is withdrawn or considered withdrawn before the transmittal of the record copy to the International Bureau and to no longer exclude expressly the refund of the international fee in other cases. For reasons of equity, provision is also made for refunds in other special circumstances.

15.6 *Refund*

- (a) The receiving Office shall refund the international fee to the applicant:
 - (i) if the determination under Article 11(1) is negative, or
 - (ii) if, before the transmittal of the record copy to the International Bureau, the international application is withdrawn or considered withdrawn.
- (b) If there are special circumstances which justify a refund, the International Bureau may refund the international fee to the applicant.

Ad Rule 16.2

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

Rule 16

The Search Fee

16.1 [No change]

16.2 *Refund*

The receiving Office shall refund the search fee to the applicant:

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

16.3 [No change]

Ad Rule 16bis

1. Present situation. The present procedure under Rule 16bis which is applicable when the applicant does not pay, within the applicable time limit, the transmittal fee, the basic fee, the designation fees and the search fee, has proved to be an excellent safeguard. However, this procedure is cumbersome for the parties concerned, the receiving Offices, the International Bureau and the applicant. The receiving Office, instead of inviting the applicant to pay any missing amount, charges that amount to the International Bureau in Geneva and notifies that Bureau of the charge made. The International Bureau issues an invitation to the applicant to pay any missing amount to its bank account in Geneva within one month. If this payment is not made, the International Bureau informs the receiving Office, which then declares that the international application is considered withdrawn and notifies the applicant thereof.
2. Proposed solution. The proposed new procedure under Rule 16bis.1 provides that the receiving Office, instead of notifying the International Bureau in Geneva of any lack of fees paid, itself invites the applicant to pay such fees. Thus, the applicant will be informed earlier than under the present procedure that there are still certain fee amounts due in respect of his international application. The applicant would, under the proposed procedure, pay fees due directly to his receiving Office in the currency of the receiving Office within the period of grace provided in the invitation. This procedure would provide a simplified and rationalized procedure without putting an additional burden on the receiving Office, on the one hand, but with the effect of improving considerably the situation of the applicant by a caution notice and easier payment to the receiving Office within a period of grace and relieving the receiving Office and the International Bureau from the present costly and cumbersome procedure, on the other hand.
3. The workload for the receiving Office would, compared to the present procedure under Rule 16bis, not increase under the new procedure. However, under the new procedure, the receiving Offices would receive compensation for their work, by earning any amount paid as a late payment fee, which amount is at present paid to and retained by the International Bureau.
4. Under the proposed procedure, applicants will no longer be obliged to make payment to the International Bureau in Geneva, Switzerland, in the form of a reimbursement. Thus, payment of any amount due to the receiving Office can be made simpler, cheaper and faster. Furthermore, the problems which exist under the present system if the applicant pays erroneously to the receiving Office instead of to the International Bureau, or if payments are received by the receiving Office after it has notified the International Bureau, would be solved. Moreover, the receiving Office would be in a position to declare an international application withdrawn if the applicant failed to pay the amount specified in the invitation without having to wait for a notification from the International Bureau. The proposed procedure is basically a provision for an extension of the time at which certain fees are due and is therefore fully consistent with the Treaty. The time limits prescribed under Article 14(3) are thus constituted by the times specified in Rules 14.1(b), 15.4(a) and 16.1(f) read, as they must be, subject to the possibility of the extension procedure set out in proposed Rule 16bis. Any payment made within the time limit fixed by the receiving Office in the invitation under Rules 16bis.1(a) or (b), is thus made within the “prescribed time limit(s)” under Article 14(3).

Rule 16bis

Late Payment of Fees*

*16bis.l Invitation by the Receiving Office***

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

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

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

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

[Ad Rule 16bis, continued]

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

6. As to the amount of the late payment fee, it is proposed, in an amended Rule 16bis.2, in addition to the general rule of being 50% of the outstanding fees, to determine the minimum and the maximum amount in a general manner which would avoid the need to adjust these amounts later specifically. It is proposed that the minimum payable to each receiving Office would be equivalent to the transmittal fee charged by it and that the maximum would correspond to the basic fee part of the international fee. While the maximum fee payable is thus substantial, it should be remembered that the applicant will already have had one month in which to remedy an underpayment (see Rules 15.4(a) and 16.1(f)).

7. The terminology of “late payment fee” is used rather than “surcharge” as in present Rule 16bis, in order to distinguish the new procedure clearly from the present procedure, to make it plain that this is simply another prescribed fee (for which authority is provided by Article 3(4)(iv)), and to avoid any suggestion that a “surcharge” is in some way part of the fee which has been unpaid or underpaid. Moreover, proposed Rule 16bis.2 adopts a simpler method of calculation than at present, but with the same end result.

8. The charging of the late payment fee is optional for the receiving Office. Each receiving Office should be free to decide whether it wants to charge the applicant with a late payment fee for the work connected with the invitation in case of late payment. If a receiving Office is prepared to issue an invitation under Rule 16bis without requiring a late payment fee, it should be allowed to do so.

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

[Rule 16bis.1, continued]

(c) Where the receiving Office has sent the applicant an invitation under paragraph (a) or (b) and the applicant has not, within the time limit specified in that paragraph, paid in full the amount due, including, where applicable, the late payment fee, the receiving Office shall allocate any moneys paid as prescribed in the Administrative Instructions, make the applicable declaration under Article 14(3), and proceed as provided in Rule 29.

16bis.2 Late Payment Fee

The late payment of fees in response to an invitation under Rule 16bis.1(a) or (b) may be subjected by the receiving Office to the payment to it of a late payment fee of:

- (i) 50% of the amount of unpaid fees which is specified in the invitation, or,
- (ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee, or,
- (iii) if the amount calculated under item (i) is more than the basic fee, an amount equal to the basic fee.

Ad Rule 17.2

1. Present situation. Rule 17.2(b) prevents the International Bureau from making priority documents available prior to the international publication of the international application. After that publication, the International Bureau receives an increasing number of requests from third parties, asking for copies of priority documents. When this Committee (PCT/CAL), at its first meeting in September 1982, discussed a proposal for an amendment to Rule 17.2(b), it was agreed that the supplying of copies of priority documents should be left to the designated Offices or to the national Office with which the priority application was filed, and the proposal to amend Rule 17.2(b) was withdrawn. The International Bureau has since referred requesting parties to the designated Offices or to the said national Office, but that procedure has proven to be unsatisfactory for the following reasons:

(a) The earlier application may have been withdrawn or rejected before being published or laid open to public inspection, in which case the national Office concerned will be prevented from supplying copies of it; and

(b) Many designated Offices do not now require (or, hence, possess) copies of all priority documents from the International Bureau.

Third parties therefore often request copies of priority documents direct from the International Bureau.

2. Present Rule 17.2(b) does not expressly recognize the cases where, before the technical preparations for international publication have been completed, the priority claim has been withdrawn (Rule 32bis), or considered not to have been made or cancelled (Rule 4.10). In such cases, copies of the priority document should not be made publicly available even after international publication of the international application.

3. Proposed solution. The obligation to keep priority documents confidential should, in general, end once the international application has been published. There is no need for the International Bureau to refer third parties to designated Offices where the file is open to public inspection and to refuse the making available of copies of priority documents.

4. It is therefore proposed to provide expressly in new paragraph (c) of Rule 17.2 that, after international publication, the International Bureau shall, upon request and subject to the payment of the charges for the service, furnish copies of the priority document to third parties. It is also proposed to add a new paragraph (d) to Rule 17.2 to include an express provision to prevent priority documents from being made publicly available where, before the technical preparations for publication have been completed, the relevant priority claim is withdrawn or considered not to have been made or the relevant declaration under Article 8(1) is cancelled.

5. Present paragraph (c) is proposed to become new paragraph (e). It is further proposed to be amended consequential on the addition of paragraphs (c) and (d), and also to ensure that copies of earlier international applications which are indicated as priority documents, if they have been published under Article 21, continue to be available. Paragraph (d) would, of course, not prevent copies of a published earlier international application from being made available to the public as PCT pamphlets (and not as priority documents), like any published national patent in a similar situation.

Rule 17

The Priority Document

17.1 [No change]

17.2 *Availability of Copies*

(a) and (b) [No change]

(c) Where an international application has been published under Article 21, the International Bureau shall, subject to paragraph (d), upon request and subject to reimbursement of the cost, furnish a copy of the priority document to any person.

(d) Notwithstanding the fact that the international application has been published under Article 21, the International Bureau shall not make copies of the priority document available to the public if, before the technical preparations for international publication have been completed, the relevant priority claim is withdrawn or considered not to have been made or the relevant declaration under Article 8(1) is cancelled.

(e) Paragraphs (a) to (d) shall apply also to any earlier international application whose priority is claimed in the subsequent international application.

Ad Rules 18.3 and 18.4

1. Present situation. The present Rule 18.4 requires that, in respect of each designated State, at least one of the applicants indicated for the purpose of that State must be entitled to file an international application according to Article 9. Applicants have encountered difficulties with this provision which may be illustrated by the following example. A corporate applicant may not file an international application designating the United States of America because, for the purpose of that State, only the inventor may be the applicant. Therefore, the inventor must be indicated in such an international application as applicant for the United States of America. If such inventor is not a national or resident of a PCT Contracting State, the United States of America cannot be designated in the international application. This is sometimes overlooked by applicants when filing an international application. Or, if applicants are aware of the problem, it is often a reason not to file a PCT application because, if a separate national application has to be filed in the United States of America, no advantage can be taken of the full benefits of the PCT.

2. Proposed solution. It is proposed to amend Rule 18.3, including its title, by providing that the provisions which apply for several applicants for the purposes of all designated States apply also if they are different applicants for the purposes of different designated States. Thus, it would be sufficient if at least one of two or more applicants is entitled to file an international application according to Article 9, irrespective of whether the applicants are the same for all designated States or different for different designated States. This Rule is made under Article 9(3) which enables the Regulations to define the application of the concepts of residence and nationality in cases where there are several applicants.

3. As a consequence of the proposal to amend Rule 18.3, the provisions in Rule 18.4(a) and (b) would become superfluous. It is suggested that these provisions be deleted and that the title of Rule 18.4 be amended to reflect only the remaining contents of this Rule.

Rule 18

The Applicant

18.1 to 18.2 [No change]

18.3 *Two or More Applicants: Same for all Designated States or Different for Different Designated States**

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

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

(a) and (b) [Deleted]

(c) [No change]

* The title has been amended to read "Two or More Applicants: Same for all Designated States or Different for Different Designated States" instead of "Several Applicants: Same for All Designated States".

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

Ad Rule 19.4

1. Present situation. In the present world, where nationality and residence of the inventor might not correspond to those of the applicant, it happens not infrequently that the international application is filed with the “wrong” receiving Office. If the receiving Office is not competent, the finding under Article 11 is negative and no filing date is accorded for the international application. This leads to loss of rights, such as the priority right, if the applicant cannot quickly act and refile the international application with the correct receiving Office. However, this is not possible in practice where the international application contains a priority claim and has been filed at the end of the priority year. In such a case the receiving Office, where the international application was incorrectly filed, makes the determination that it is not competent too late to permit a refiling of the international application within the priority year. Sometimes weeks may pass before the applicant is notified that he obviously lacks the right to file at that specific Office under Article 11(1)(i) due to lack of a proper residence or nationality.
2. Proposed solution. To solve this problem, it is proposed to add a new Rule 19.4 to ensure that all national Offices (other than those which have delegated their receiving functions by an agreement under Rule 19.1(b)) may act on behalf of a competent receiving Office in so far as the act of receipt of an international application is concerned, and to establish a procedure for handling applications in such circumstances.
3. Proposed new Rule 19.4(a) gives the national Office of or acting for a Contracting State (in this Rule referred to as the “transmitting Office”) the power to receive international applications on behalf of competent receiving Offices. National Offices which have delegated their receiving functions under Rule 19.1(b) will not, however, be able to act as transmitting Offices.
4. A national Office which is itself a competent receiving Office will have the option of receiving an application on behalf of another competent receiving Office in a case where the language requirement in Article 11(1)(ii) would not be met if the first mentioned Office were to act as competent receiving Office. This will enable the application, in such a case, to be transmitted to a competent receiving Office for which the language of the application is a prescribed language.
5. Paragraph (b) of proposed new Rule 19.4 provides that the transmitting Office is to promptly notify the applicant and invite the applicant to request transmittal to another receiving Office within 14 days from the date of the notification.
6. Paragraph (c) provides for the transmittal of the international application by the transmitting Office to the receiving Office specified by the applicant promptly upon receipt by the transmitting Office of the applicant’s request and of the transmittal fee, if any (see the note on paragraph (e), below), within the time limit fixed in paragraph (b). It further provides for the international application to be considered as having been received by the specified receiving Office on the date of receipt by the transmitting Office.

Rule 19

The Competent Receiving Office

19.1 to 19.3 [No change]

19.4 *Receipt on behalf of Competent Receiving Office*

(a) Except where it has delegated its duties to receive international applications in an agreement under Rule 19.1(b), any national Office of 6r acting for a Contracting State may receive an international application on behalf of a competent receiving Office.

(b) Where a national Office (in this Rule referred to as the “transmitting Office”) receives an international application which it believes, having regard to the provisions of Article 11(1)(i) or (ii), it should treat as having been received on behalf of another national Office as competent receiving Office, it shall promptly notify the applicant of that fact, and invite the applicant to request, within 14 days after the date of the notification, transmittal of the application to the receiving Office specified by the applicant.

(c) Upon receipt, within the time limit referred to in paragraph (b), of a request by the applicant and of any transmittal fee required under paragraph (e), the transmitting Office shall promptly transmit the international application to the receiving Office specified by the applicant in the request. The transmitted international application shall then be considered as having been received by the specified receiving Office on the date of receipt of the application by the transmitting Office on behalf of that receiving Office.

[Ad Rule 19.4, continued]

7. Paragraph (d) enables the Office with which the application was filed to proceed to a negative determination pursuant to Rule 20.7 if the applicant does not request the transmittal of the international application within the time limit fixed under paragraph (b).

8. Paragraph (e) provides for the transmitting Office to refund the international fee and search fee to the applicant. The transmitting Office would, however, be able to keep the transmittal fee in order to cover the costs associated with the procedure under this Rule and to discourage applicants from abusing this procedure and from using it as a regular method of filing.

9. Paragraph (f) makes it clear that further processing after transmittal will proceed as if the application has been filed directly with the receiving Office to which the international application has been transmitted.

10. It should be noted that the proposed amendment is consistent with Articles 10 and 11, since the act of receipt of the international application will always be either by or on behalf of a competent receiving Office. An international application filed with a national Office which receives it on behalf of the competent receiving Office will, consistently with the operation of ordinary agency principles, be considered under the proposal to have been filed with the competent receiving Office.

11. It is further proposed to amend the Receiving Office Guidelines so that the processing of an international application by a transmitting Office will be covered in more detail in the most appropriate location.

[Rule 19.4, continued]

(d) If the transmitting Office does not receive from the applicant, within the time limit referred to in paragraph (b), a request to transmit the international application to a receiving Office specified by him, the transmitting Office shall proceed as provided in Rule 20.7.

(e) The transmitting Office may subject the transmittal of the international application to the payment by the applicant of the transmittal fee fixed by it under Rule 14. Any other fees paid to the transmitting Office shall be refunded by that Office to the applicant.

(f) Further processing of an international application transmitted under paragraph (c), and payment of all fees, including a further transmittal fee, shall take place as if the international application had been filed directly with the receiving Office to which the international application has been transmitted. The one-month time limit referred to in Rule 15.4 shall be computed from the date on which the transmitting Office received the request under paragraph (c).

Ad Rule 20.1(a)

1. Present situation. At present, Rule 20.1(a) consists of two parts. The first deals with the indelible marking of the date of actual receipt by the receiving Office. The second provides that the receiving Office shall mark the number assigned by the International Bureau on each sheet of each copy received. This Rule does not correspond to the practice as the International Bureau does not, in fact, assign any specific numbers to the receiving Offices. The current practice is established in Section 307 of the Administrative Instructions.
2. Proposed solution. It is proposed to amend Rule 20.1(a) and to refer only to the international application number without any further details as to who assigns it. The present reference in Rule 20.1(a) to marking the date of actual receipt “in the space provided for that purpose in” the request Form is amended to refer to marking that date simply “on” the request Form. This change will facilitate the use of requests in the form of a computer print-out (see proposed amendments to Rules 3.1, 3.3, and 3.4, above) which will require more flexibility with regard to the marking of the date of receipt.
3. Consequential to the proposed amendment to Rule 19, it is also proposed to modify Section 307 of the Administrative Instructions in order to add a specific reference to the procedure under Rule 19.4 so that the existing procedure with regard to numbering international applications will also apply
4. The following modified text of Section 307 is proposed:

Section 307

System of Numbering International Applications

(a) Papers purporting to be an international application under Rule 20.1 shall be marked with the international application number, consisting of the letters “PCT”, a slant, the two-letter code, as in Annex B, indicating the receiving Office, a two-digit indication of the last two numbers of the year in which such papers were first received, a slant and a five-digit number, allotted in sequential order corresponding to the order in which the international applications are received (e.g., “PCT/SU78/00001”). Where the International Bureau acts, pursuant to Rule 19.1(b), as receiving Office for a national Office, the two-letter code indicating the national Office for which the International Bureau acts as receiving Office shall be used. Where an international application is transmitted to a receiving Office under Rule 19.4, the transmitting Office shall delete the letters “PCT” and the receiving Office shall mark the application with a new number under this Section.

(b) If a negative determination is made under Rule 20.7 or a declaration is made under Article 14(4), the letters “PCT” shall be deleted by the receiving Office from the indication of the international application number on any papers marked previously with that number, and the said number shall be used without such letters in any future correspondence relating to the purported international application.

Rule 20

Receipt of the International Application

20.1 *Date and Number*

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

(b) [No change]

20.2 to 20.3 [No change]

Ad Rule 20.3bis

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

Ad Rule 20.4(c)

1. Present situation. Reference is made to the outline of the present situation and existing problems in relation to the filing of requests and drawings in non-prescribed languages in connection with the proposal to amend Rule 12.3. The problem is similar for abstracts.
2. Proposed solution. Proposed new Rule 20.4(c) deals with the problem in relation to abstracts. An abstract in a non-prescribed language will be treated as not having been filed, noting that the complete absence of an abstract can be corrected under Article 14 without loss of filing date. The abstract is not an essential element of the international application for the purposes of according an international filing date under Article 11.

20.3bis *Manner of Carrying Out Corrections*

[Deleted]

20.4 *Determination under Article 11(1)*

(a) and (b) [No change]

(c) For the purposes of Article 11(1)(ii), an abstract filed in a language other than the prescribed language shall be treated as if it had not been filed.

20.5 to 20.9 [No change]

Ad Rule 23.1

1. Present situation. Current Rule 23.1(a) requires that the search copy be forwarded to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau. It is to everyone's benefit to forward both the record copy and the search copy as early as possible. However, in case of non-payment of the search fee, it would be beneficial to delay forwarding of the search copy. Such delay is not possible under the present Rule.
2. Rule 23.1(b) provides for a monitoring system by the International Bureau and transmittal of a copy of the international application to the International Searching Authority.
3. Proposed solution. Rule 23.1(a) is proposed to be amended to provide for delayed transmittal of the search copy until payment of the search fee has been received. This would prevent any work being required or performed by the International Searching Authority without payment of a search fee. An appropriate amendment to paragraph 35 of the Receiving Office Guidelines, reflecting the proposed change to Rule 23.1, will also need to be made.
4. It is not proposed that the receiving Office notify the International Bureau or the International Searching Authority of the fact that the search copy has not been sent or of the reason why. If a change to this arrangement proves to be necessary in the light of experience, an appropriate instruction can be included at that stage in the Receiving Office Guidelines.
5. Rule 23.1(b) is proposed to be deleted because the present procedure would not be compatible with the proposed new system under Rule 23.1(a) under which the search copy is only transmitted when the search fee has been paid. The amendment would also reduce the monitoring burden of the International Bureau since other means of monitoring are already available under the Regulations.

Rule 23

Transmittal of the Search Copy

23.1 *Procedure*

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

(b) [Deleted]

Ad Rule 24.2(a)

1. Present situation. At present, the International Bureau notifies the applicant, the receiving Office, the International Searching Authority and the designated Offices of the receipt of the record copy promptly upon receipt of that copy. This requires each designated Office to systematically file these notices and associate them with any later communication. If the international application is later withdrawn by the applicant or considered withdrawn by the receiving Office, such early notice is of no value to a designated Office and has caused unnecessary work. Any notification sent to the applicant under the present Rule must contain a list of the designated Offices which have been notified of the fact and the date of receipt of the record copy. It must also draw attention to any extended time limits for entering the national phase which apply in respect of a designated Office.
2. Proposed solution. It is proposed to amend Rule 24.2(a) so that a designated Office will be notified of its designation under Rule 4.9(a) upon receipt of the record copy only if it has informed the International Bureau that it wishes to be so notified. The notification will be sufficient to enable designated Offices to publish the information referred to in Article 30(2)(b) and to plan forward workloads. It is envisaged that the information will be provided in the form of a list of the data to be specified in the Administrative Instructions (see paragraph 8, below).
3. In all other cases, a designated Office will be notified of its designation under either Rule 4.9(a) or, where the fee under Rule 15.5 for the confirmation has been paid, Rule 4.9(b), only at the time of, and together with, the communication under Article 20, if the international application and the designation concerned are still pending at the time when the communication is due. The International Bureau would, promptly upon international publication of the international application, send to each designated Office a copy of the international application in the form of a copy of the pamphlet, a notice of designation and the copy of any required priority documents (see the proposed amendment to Rule 47.1, below).
4. A single notification from the International Bureau, well in advance of the earliest time limit for entry into the national phase, would rationalize and streamline the administrative work at the designated Offices so that the national file can be easily established, at only one given point in time, on the basis of the communication of the international application from the International Bureau. It would reduce the paper handling burden of the designated Offices since it would not be required that the present notices under Rule 24.2 be received, filed and stored, prior to the Article 20 communication. Where, exceptionally, an applicant requests under Article 23(2) an early start of the national processing, the designated Office would receive from the International Bureau a copy of the international application together with the required information (see also proposed new Rule 47.4, below).
5. It is further proposed to delete from present Rule 24.2(a) the requirement that the notice shall identify also the name of the receiving Office. In accordance with established practice, it is, for all practical purposes, sufficient that the receiving Office is identified by the two-letter code, which forms part of the international application number assigned by the receiving Office.

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 [Remains deleted]

24.2 *Notification of Receipt of the Record Copy*

(a) Subject to the provisions of paragraph (b), the International Bureau shall promptly notify the applicant, the receiving Office, the International Searching Authority, and each designated Office in respect of a designation under Rule 4.9(a) which has informed the International Bureau that it wishes to be so notified, of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant*, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the States designated under Rule 4.9(a).

(b) [No change]

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

[Ad Rule 24.2(a), continued]

6. Since under the proposed new system, at the time of notifying the applicant of the receipt of the record copy, notifications will not have been sent to all of the designated Offices, the notification of the applicant cannot contain, as is prescribed in the present Rule, a list of the designated Offices which have been notified under Rule 24.2(a). It is therefore necessary to further amend the Rule, and it is proposed to provide, instead of the said listing of designated Offices, for the sending to the applicant of a listing of all designations of states made under Rule 4.9(a). Such listing is a very important means for the applicant for checking such designations. It may permit the early discovery of errors or omissions in designations made by the applicant when filling in the request and by the International Bureau when recording the designations, so that corrections may be made. Such corrections would become possible if, under proposed new Rule 4.9(b) (see above), the applicant makes a collective designation and confirms it by specifying the correct designation and by paying the corresponding designation fee.

7. It is also proposed to delete, in the last sentence, the requirement that the International Bureau include information to the applicant on the relevant national time limits under Article 22(3). With the increasing number of designated Offices and all their different time limits for entering the national phase, the burden of informing in detail is too cumbersome and not necessary. It appears, after more than eleven years of experience, to be more important to include a general reminder to the applicant that he must enter the national phase before each designated Office within the time limit applicable under Article 22 or 39(1). This is already done at present with Form PCT/IB/3DI.

8. The Administrative Instructions should also be modified to provide for the provision of information to designated Offices which requested to be informed about their designations upon receipt by the International Bureau of the record copy. For this purpose, a new Section 428 is proposed as follows:

Section 428

Notice of Designations to Designated Offices

Each designated Office wishing to be notified under Rule 24.2(a) shall receive each month a listing of the international applications in respect of which it has been designated under Rule 4.9(a) or its designation has been confirmed under Rule 4.9(b). Such listing shall contain:

- (i) the number of the application;
- (ii) the international filing date;
- (iii) the name of the applicant;
- (iv) the filing date and identification of any earlier application whose priority is claimed;
- (v) an indication whether the designation was made under Rule 4.9(a) or confirmed under Rule 4.9(b).

[Ad Rule 24.2(a), continued]

9. Notices sent by the International Bureau to national Offices or international authorities under this Section should be able, with the agreement of the Office or authority concerned, to be sent electronically. For this purpose, a new Section 114 is proposed for inclusion in the Administrative Instructions as follows. The new Section would operate generally, however, and not just in relation to Rule 24. It would read as follows:

Section 114

Electronic Transmission of Notices

Where the Treaty, the Regulations or these Administrative Instructions provide for a notice or other communication to be transmitted by one national Office or international authority to another, that notice or communication, except where otherwise provided, may, where so agreed by both the sender and the receiver, be transmitted by electronic means or in electronic form.

Ad Rule 26.5(b)

1. Present situation. At present, an international application must be signed by all applicants, even where it indicates different applicants for different designated States. If the signature of only one applicant, who may be the applicant for one State, is missing, the international application is to be considered withdrawn although all the other applicants for all the other States have signed the international application. A typical case which happens regularly is that the applicants for all designated States except the United States of America have signed the international application but the applicant for the United States of America, the inventor, for one reason or another, did not sign the international application.
2. The lack of the signature of the applicant for a certain designated State should have no effect, as far as any other designated State is concerned, if the international application has been signed by the applicant(s) for those other designated States. The sanction that the entire international application is considered withdrawn appears not to be justified.
3. The same applies in the case of the lack of any of the indications (prescribed in Rule 4) relating to the applicant for a certain designated State.
4. Proposed solution. It is therefore proposed to provide in a new paragraph (b) of Rule 26.5 that the receiving Office shall, if an applicant for a certain designated State did not comply with the requirements as to signature under Article 14(1)(a)(i) (note also the proposed amendments to Rule 4.15, above), or as to the indications prescribed under Article 14(1)(a)(ii), declare the international application considered withdrawn in respect of that designated State. Article 25 would then apply to that designated State. The proposed amendment will make the system safer for applicants.

Rule 26

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

26.1 to 26.4 [No change]

26.5 *Decision of the Receiving Office*

(a) [No change]

(b) Where, after the expiration of the time limit fixed under Rule 26.2 for the correction of a defect under Article 14(1)(a)(i) or (ii) (lack of signature or of a prescribed indication concerning the applicant), that signature or indication is lacking in respect of an applicant for a certain designated state, the receiving Office shall declare the international application considered withdrawn in respect of that State.

26.6 [No change]

Ad Rule 26bis

1. Present situation. The present situation and the problem of requests and drawings filed in a language other than a language admitted under Rule 12.1 are set out in relation to proposed new Rule 12.3.
2. Proposed solution. Under proposed new Rule 12.3, requests and drawings may be filed in any language, so that an international application will not fail to be accorded an international filing date because of non-compliance of the request or drawings with Rule 12.1. In such a case, however, the request or drawings will need to be corrected. A suitable procedure is specified in proposed Rule 26bis. The procedure is similar to that which applies under Rule 26 in relation to correction of other defects.

Rule 26bis [New]

Correction of Request or Drawings Not in Admitted Languages

26bis.1 Request Not in Admitted Language

(a) Where the request does not comply with Rule 12.1 the receiving Office shall invite the applicant to file the request in the same language as the description and claims.

(b) Rule 26.2 shall apply mutatis mutandis to the invitation under paragraph (a).

26bis.2 Language in Request Not Corrected

If the receiving Office finds that, within the prescribed time limit, the request has not been filed in the language specified in the invitation, the international application shall be considered withdrawn and the receiving Office shall so declare.

26bis.3 Drawing Containing Text Not in Admitted Language

Where any drawing containing text matter does not comply with Rule 12.1, Rules 26bis.1 and 26bis.2 shall apply mutatis mutandis.

Ad Rule 29.1

1. Present situation. Rule 29.1(a)(ii) and (b) provides that the International Bureau informs the interested national Office if a designation has been considered withdrawn under Article 14. The proposed amendments to Rule 24.2 and Rule 47.1(a) provide for a delaying of the notification to the national Offices of their designation until the communication under Article 20, except where that notification is specifically requested by designated Offices to be sent to them at the time of the receipt of the record copy by the International Bureau. The sending, according to the present text of Rule 29.1(a)(ii) and to the present last sentence of Rule 29.1(b), of a notice of withdrawal to the designated Office before the communication under Article 20 would not, in general, have any value since the designated Offices have, under the proposed new system, not yet been informed that there is an international application pending in which they are designated. Similarly, the fact that the receiving Office has declared an international application as considered withdrawn will not need in future to be notified to the national Offices (except where they have requested and therefore received notification under Rule 24.2) since that declaration is made long before the communication under Article 20.
2. Proposed solution. It is proposed to delete in Rule 29.1(a)(ii) and in Rule 29.1(b) the text which requires the International Bureau to notify the interested national office of the withdrawal of the relevant designation. This would further streamline the procedure and rationalize it for the benefit of both the national Offices and the International Bureau.
3. Designated Offices which have been sent a notification under Rule 24.2 will, however, be informed of applications or designations considered withdrawn under Article 14(1), (3) or (4). A suitable amendment for this purpose to Section 415 of the Administrative Instructions will be proposed in a subsequent document in connection with the proposal for new Rule 90bis.

Rule 29

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

29.1 Finding by Receiving Office

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

(i) [No change]

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

(iii) and (iv) [No change]

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

29.2 [Remains deleted]

29.3 and 29.4 [No change]

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

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

Ad Rule 32

1. Present situation. Rule 32 relates to withdrawal of international applications and designations. A new Rule 90bis, which would incorporate the content of Rule 32, was proposed in document PCT/CAL/III/3 and will be included in' revised form in a subsequent document to be prepared for the second part of the fourth session of the Committee.
2. Proposed solution. If new Rule 90bis is adopted, it is proposed to delete Rule 32 since the subject matter thereof is covered in Rule 90bis.
3. This proposed amendment was agreed by the Committee at its third session.

Ad Rule 32bis

1. Present situation. Rule 32bis relates to withdrawal of priority claims. A new Rule 90bis, which would incorporate the content of Rule 32bis, was proposed in document PCT/CAL/III/3 and will be included in revised form in a subsequent document to be prepared for the second part of the fourth session of the Committee.
2. Proposed solution. If new Rule 90bis is adopted, it is proposed to delete Rule 32bis since the subject matter thereof is covered in Rule 90bis.
3. This proposed amendment was agreed by the Committee at its third session.

Rule 32

[Deleted]

Rule 32bis

[Deleted]

Ad Rule 33.1(b)

1. Present situation. During the discussion at the third session of the Committee on the proposed amendment to Rule 33.1(c), it was agreed that a similar amendment should be made to Rule 33.1(b), which relates to citing by the International Searching Authority of written disclosures relating to an oral disclosure, use or exhibition which occurred before the international filing date. Such written disclosure shall be separately mentioned in the international search report if it has been made available to the public on a date “posterior to the international filing date”. The provision does not cover the situation where the date on which the written disclosure is made available to the public and the filing date of the international application are the same.

2. Proposed solution. The proposed amendment would change the words “posterior to” to “which is the same as, or later than,” in order to cover also the situation where the dates are the same. It is to be noted that voting on this item is subject to Rule 88~1 and notice requirements are set forth in Rule 88.4.

Ad Rule 33.1(c)

1. Present situation. Present Rule 33.1(c) relates to citing by the International Searching Authority of published applications or patents which have a publication date “later”, but a filing or priority date “earlier”, than the filing date of the international application. The Rule does not cover the situation where the publication date and the filing date of the international application are the same.

2. Proposed solution. The proposed amendment would change “later” to “the same as, or later than,” in order to cover the situation where the dates are the same. It is noted that voting on this item is subject to Rule 88.1 and notice requirements are set forth in Rule 88.4.

3. This proposed amendment was agreed by the Committee at its third session.

Rule 33

Relevant Prior Art for* International Search

33.1 *Relevant Prior Art for* International Search*

(a) [No change]

(b) When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

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

3.2 and 33.3 [No change]

* The amendment consists in the deletion of the word “the”.

* The amendment consists in the deletion of the word “the”.

Ad Rule 36.1

1. Present situation. Rule 36.1(ii) requires that each International Searching Authority “have in its possession” at least the minimum documentation referred to in Rule 34, whereas Article 15(4) refers more generally to the “facilities of the International Searching Authority.
2. Since today’s facilities include electronic processing and storage of patent documents and relevant patent information, on computers and on CD-ROM and other optical discs, it appears to be no longer necessary that the International Searching Authority have physical possession at its premises of all the documentation referred to in Rule 34, especially that relating to non-patent literature under Rule 34.1(b)(iii).
3. Proposed solution. It is proposed to amend Rule 36.1(ii) and to provide that the International Searching Authority must be technically able to access the documents of the minimum documentation in a manner which allows it to carry out searches. This wording would permit more flexibility and allow the International Searching Authorities to adjust their searching tool to modern technical development. The International Bureau proposes a modified wording compared to the text as discussed at the third session of the Committee to achieve greater consistency with Article 15.4 (see paragraph 55 of document PCT/C/L/III/5) and Rule 36.1(i).

Rule 36

Minimum Requirements for International Searching Authorities

36.1 *Definition of Minimum Requirements*

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

- (i) [No change]
- (ii) that Office or organization must have the necessary means to access at least the minimum documentation referred to in Rule 34 in a way which allows it to carry out searches:
- (iii) [No change]

Ad Rule 38.2

1. Present situation. Rule 38.2 provides that the International Searching Authority, in certain cases, establishes an abstract or an amended abstract where the abstract furnished by the applicant does not comply with Rule 8. Under the present Rule, such established abstract has to be transmitted to the applicant with an invitation to comment, within one month from the date of the invitation, on the abstract established by the International Searching Authority.
2. In practice, there are not many cases in which the International Searching Authority actually establishes an abstract and invites the applicant to comment. However, it is felt that the requirement of inviting comments often gives applicants the impression that they should comment although they could basically agree with the abstract established by the International Searching Authority. The evaluation of the comments is burdensome for the International Searching Authority. The time limit for comments delays the establishment of the final text of the abstract. As a result, the international application is published in some cases with the abstract as established by the International Searching Authority before the expiration of the time limit for any possible comments. Moreover, where comments are made, they frequently do not lead to a modification of the abstract.
3. Proposed solution. It is proposed to amend Rule 38.2 and to delete in paragraph (a) the requirement to invite comments. However, it is not proposed to deprive the applicant of his right to comment. Therefore, it is also proposed to amend paragraph (b) completely and to provide simply for the opportunity to submit comments within one month from the date of mailing of the international search report where the applicant so wishes. The difference from the present system would be that there is no invitation to submit comments and consequently no need to await the expiration of the time limit for comments. Since the abstract would be established under paragraph (a), there would no longer be a need for a provision stating that the definitive contents of the abstract shall be determined by the International Searching Authority. If considered appropriate, the International Searching Authority, as a result of comments received from the applicant, would amend the abstract, the text of which would then become final. Certain national Offices have a similar practice for applications filed under national law.

Rule 38

Missing Abstract

38.1 [No change]

38.2 *Establishment of Abstract*

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

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

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

Ad Rule 39.1

1. Present situation. Rule 39, which relates to subject matters not required to be searched, does not currently speak of nucleotide and/or amino acid sequences which are usually presented in the form of long lists, often several pages, of letter symbols. In practice, it is almost impossible to search such pages of symbols without computer assistance.

2. Proposed solution. It is proposed to add, as another category of subject matter not requiring international search, nucleotide and/or amino' acid sequences to the extent that listings of the sequences have not been made available to the International Searching Authority as required under proposed new Rule 13ter (see also the proposed amendment to Rule 5.2). It is noted that voting on this item is subject to Rule 88.3 and notice requirements are set forth in Rule 88.4.

Rule 39

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

39.1 *Definition*

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

(i) to (v) [No change]

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

(vii) nucleotide and/or amino acid sequences to the extent that listings of those sequences required by the International Searching Authority under Rule 13ter are not available to it.

Ad Rule 42.1

1. Present situation. Present Rule 42.1 sets an inflexible time limit for establishing the international search report. The time limit is three months from the receipt of the search copy by the International Searching Authority or nine months from the priority date, whichever is later. No provision is made for delays caused by the lack of unity procedure under Rule 40. Due to this procedure, International Searching Authorities are sometimes not in a position to comply with the time limits fixed in Rule 42.1.
2. Proposed solution. In order to provide some flexibility for delays in establishing the international search report, it is proposed to amend Rule 42.1 by adding a sentence under which additional time may be permitted under the Administrative Instructions in case of lack of unity of invention.
3. The proposed amendment to Rule 42.1 was agreed by the Committee at its third session, subject to the addition to Part 5 of the Administrative Instructions of an appropriate provision, for which the new Section 501bis is proposed as follows:

Section 501bis

Time Limit for International Search

Where the completion of the international search is delayed due to an invitation under Article 17(3)(a) to pay additional search fees, the international search report shall be established promptly after the conclusion of the procedures under Rule 40.

Rule 42

Time Limit for International Search

42.1 *Time Limit for International Search*

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later. The Administrative Instructions may permit an extension of the applicable time limit where Article 17(9)(a) applies.

Ad Rule 43.1

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

Ad Rule 43.5(e)

1. Present situation. Rule 43.5(e) as currently worded only requires that particularly relevant passages of a cited document in an international search report be identified in respect of documents of which only certain passages are relevant. Comments have been received indicating that it would be beneficial to also identify particularly relevant passages of a document cited in an international search report in cases where the citation relates to the ~ entire document.
2. Proposed solution. In order to provide maximum information in international search reports, it is proposed to add a sentence to Rule 43.S(e) requiring identification of passages of particular relevance of a cited document which is considered relevant as a whole, unless such identification is not practicable. The proposed text added to Rule 43.5(e) does not make such indication mandatory in all cases since there might be cases in which the entire document was considered to be relevant without any particular passages thereof being considered of particular relevance.

Rule 43

The International Search Report

43.1 Identifications

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

43.2 to 43.4 [No change)

43.5 Citations

(a) to (d) [No change]

(e) If only certain passages of the cited document are relevant or particularly relevant, they shall be identified, for example, by indicating the page, the column, or the lines, where the passage appears. If a document is considered relevant as a whole, the passages of particular relevance, if any, shall be identified unless such identification is not practicable.

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

Ad Rule 43.6(c)

1. Present situation. Present Rule 43.6, relating to indicating, on international search reports, fields searched, requires, in paragraph (a), the indication of the classification used and, in paragraph (b), if patent documents are searched outside of the minimum documentation as defined in Rule 34, when practicable, the identification of the kinds of documents, the States, the periods and the languages searched. No provision is made as to if or how searches on electronic data bases should be indicated. Such an indication is important, especially in view of the proposed amendment to Rule 36.1(ii) which provides for the possibility to use minimum documentation material in the form of an electronic data base.
2. Proposed solution. In order to provide a basis for indicating searches made on electronic data bases, it is proposed to add a new paragraph (c) to Rule 43.6. When the search is based on, or is extended to, such a data base, the indication of the name of the data base would be mandatory, and the search terms used could be indicated where considered useful.

43.6 *Fields Searched*

(a) and (b) [No change]

(c) If the international search is based on, or is extended to, any electronic data base, the international search report shall indicate the name of the data base and may, where considered useful, indicate the search terms

Ad Rule 43.7

1. Present situation. Rule 43.7 relates to indicating remarks in the international search report concerning unity of invention. The present wording is somewhat confusing because the second sentence of the Rule provides that where the international search was made on the main invention only, the search report shall indicate which parts were and which parts were not searched. In the case of certain international applications some additional fees, but not all, are paid. This results in claims to more than the main invention, but not all the claims, being searched. The Rule does not provide clearly for the identification of the searched and unsearched parts in such a situation.
2. Proposed solution. It is proposed to amend Rule 43.7 to provide for an indication, where more than the main invention but less than all claims were searched, of which parts of an international application were searched and which parts were not searched due to non-payment of additional search fees in cases of lack of unity of invention.
3. This proposed amendment was agreed by the Committee at its third session.

Ad Rule 43.8

1. Present situation. Present Rule 43.8 requires that a signature appear on the international search report. The requirement for signing the report involves an additional step in its handling because it requires returning the typed search report, prior to mailing, back to the authorized officer. In particular, when the international search report is produced with the help of a central computer, the obtaining of an original signature requires special handling.
2. Proposed solution. In order to simplify processing of the international search report, it is proposed to amend Rule 43.8, including its title, and to provide only for an indication of the name of the authorized officer rather than a signature. It is to be understood that the name may be indicated by writing, typing, printing or use of a seal. If an International Searching Authority desired a signature for internal control purposes, it would be free to do so, but no signature would be required on the final search report itself. A similar amendment is proposed concerning the international preliminary examination report (see amendment to Rule 70.14 as proposed in document PCT/CAL/III/3 and to be included in a revised form in a subsequent document to be prepared for the second part of the fourth session of the Committee).
3. This proposed amendment was agreed by the Committee at its third session.

43.7 Remarks Concerning Unity of Invention

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

*43.8 Authorized Officer**

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

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

Ad Rule 43.9

1. Present situation. Rule 43.9 lists those items which may appear on the international search report and stipulates that no other matter may be included. This is too restrictive to take into account all situations which may arise, for example because of advances in technology relating to electronic data bases.
2. Proposed solution. In order to provide an ability to make adjustments in the content of the international search report in the future without further Rule changes, it is proposed to amend Rule 43.9 and its title, to the effect that the Administrative Instructions would permit inclusion of any additional matter. The wording is similar to that now existing in Rule 4.17(a) in respect of the request Form.
3. Furthermore, minor drafting changes relating to the enumeration of some Rules are proposed for consistency with the language used in the Regulations in general.
4. Finally, it is proposed to delete the reference to Rule 44.2(b) in Rule 43.9 consequential to the proposed deletion of Rule 44.2(b) which was accepted by the Committee at its third session.

43.9 *Additional Matter**

The international search report shall contain no matter other than that specified in Rules 33.1(b) and (c), 43.1 to 43.3, 43.5 to 43.8 and 44.2(a)** and the indication referred to in Article 17(2)(b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. In particular, it shall contain no expressions of opinion, reasoning, arguments, or explanations.

43.10 [No change]

* The title “has been amended to read “Additional Matter” instead of “No Other Matter”.

** The amendment consists in deleting the words “and (b)” after “44.2(a)”.

Ad Rule 44.2

1. Present situation. Paragraphs (b) and (c) of present Rule 44.2 provide for a procedure for the case where the International Searching Authority invites the applicant to comment on an abstract established by it. It has been proposed above to amend Rule 38.2(a) and to delete the requirement that the International Searching Authority invite the applicant to comment on the abstract.
2. Proposed solution. Consequential to the proposed amendment to Rule 38.2(a), paragraphs (b) and (c) of Rule 44.2 would not be applicable any longer as no time limit will exist for the applicant in which to submit comments on the abstract established by the International Searching Authority. It is therefore proposed to delete paragraphs (b) and (c) of Rule 44.2 and to amend its paragraph (a) by deleting in that paragraph the reference to the deleted paragraphs (b) and (c).
3. This proposed amendment was agreed by the Committee at its third session.

Ad Rule 44.3

1. Present situation. Rule 44.3(c) currently provides that an International Searching Authority may send copies of documents cited to the International Bureau and that that Bureau then supplies copies to the designated Offices or to the applicant. No use has been made of this procedure by designated Offices or applicants since the entry into force of the PCT in 1978.
2. Proposed solution. In view of the fact that no use is being made of the procedure under Rule 44.3(c), it is proposed that paragraph (c) be deleted along with the reference thereto in paragraph (d).
3. This proposed amendment was agreed by the Committee at its third session. However, a further drafting change is proposed by the International Bureau, namely, the insertion of the word “paragraphs” before “(a)”.

Rule 44

Transmittal of the International Search Report, Etc.

44.1 [No change]

44.2 *Title or Abstract*

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

(b) [Deleted]

(c) [Deleted]

44.3 *Copies of Cited Documents*

(a) and (b) [No change]

(c) [Deleted]

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

* The amendment consists in the deletion of the words: "Subject to paragraphs (b) and (c)".

Ad Rule 46.2

1. Present situation. When applicants file international applications or corrections thereto and pay fees, they correspond with the receiving Office, usually in their own country. When it comes time to filing amendments under Article 19, many applicants also forward them to the receiving Office or to the International Searching Authority. Both are the wrong address because according to Article 19, amendments to the claims must be filed with the International Bureau. Although the receiving Offices and International Searching Authorities usually forward Article 19 amendments to the International Bureau, it results in additional delay in the amendments reaching the International Bureau. Sometimes amendments reach that Bureau only after the expiration of the time limit for filing them.
2. Proposed solution. Since the provisions of Article 19 are often overlooked, it is proposed to add a new Rule which would clearly state that amendments made under Article 19 shall be filed directly with the International Bureau. Although this would repeat what is said in Article 19, it would provide the information as to where to send amendments under Article 19 in the same Rule in which other information concerning such amendments can be found. It is proposed to number this Rule 46.2, a number which is not used at present because the text of that Rule was deleted earlier.
3. This proposed amendment was agreed by the Committee at its third session.

Rule 46

Amendment of Claims before the International Bureau

46.1 [No change]

46.2 *Where to File*

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

46.3 to 46.5 [No change]

Ad Rule 47.1(a)

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

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

Ad Rule 47.4

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

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

Rule 47

Communication to Designated Offices

47.1 *Procedure*

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

(b) to (e) [No change]

47.2 and 47.3 [No change]

47.4 *Express Request under Article 23(2)*

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

Ad Rule 48.2(a)

1. Present situation. Rule 48.2(a) lists the various items to be contained in the pamphlet when the international application is published. However, the list appears to be incomplete because it does not provide for the inclusion of separately furnished indications relating to deposited microorganisms.

2. Proposed solution. It is proposed to complete the list of items which are to be contained in the pamphlet publishing the international application by adding an additional item. Indications contained in references to deposited microorganisms are permitted under Rule 13bis to be furnished separately from the international application but it is not clear whether such indications are to be published with the international application in the pamphlet; it is proposed to clarify that point by expressly providing that such indications are to be published in the pamphlet.

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (vi) [No change]

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

(viii) any indications in relation to a deposited microorganism furnished under Rule 13bis separately from the description.

(b) to (i) [No change]

48.3 to 48.5 [No change]

Ad Rule 48.6(c)

1. Present situation. Present Rule 48.6(c) provides that where withdrawals of the international application, designations or priority claims are made after the technical preparations for international publication have been completed, that fact shall be published in the Gazette. A new Rule 90bis, in which all provisions relevant to withdrawals will be concentrated, was proposed in document PCT/CAL/III/3 and will be included in revised form in a subsequent document to be prepared for the second part of the fourth session of the Committee.
2. Proposed solution. If new Rule 90bis is adopted, Rule 32 and Rule 32bis will be deleted and it is proposed to amend Rule 48.6(c) so as to align it with these proposed amendments.
3. This proposed amendment was agreed by the Committee at its third session.

48.6 *Announcing of Certain Facts*

(a) [No change]

(b) [Remains deleted]

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

Ad Rule 49.5(c-bis)

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

2. The interest of the applicant should also be taken into account in a more favorable way in a number of situations, some of which are illustrated here. One such situation is where the application as filed contains a large number of claims (e.g., 50) and where the amendment under Article 19 consists of cancelling most of them (e.g., 40). The sanction that the entire application be considered withdrawn, merely because claims which are of no interest to the applicant anymore have not been translated upon entry into the national phase, is harsh and out of proportion to the nature of the non-compliance by the applicant. In addition, it should not be forgotten that translation costs represent a large part of the filing costs and in this regard the PCT route would place the applicant in a less favorable situation than the national route. Another situation is where the examiner will not need a translation of the claims as filed in order to understand the international search report. Why then not require from the applicant a translation of the claims as filed only upon the examiner's request?

3. Proposed solution. The proposed amendment outlined in the following paragraphs is in line with the general philosophy of other proposed amendments for the benefit of applicants in its attempt to add to the safeguards of the PCT system. It would avoid the draconian sanction whereby the international application is automatically considered withdrawn without first giving the applicant the opportunity to supply the missing translation(s). The proposal in no way limits the ability of a designated Office, however, to require those translations which it needs. Rather, it ensures that the applicant will first be given time in which to comply with national requirements relating to translations before the sanction of the international application being considered withdrawn is applied. On the other hand, a designated Office would also be free under the proposed amendment not to require a translation of claims which are not needed for the purposes of the national phase or to disregard the claims of which a translation has not been furnished.

4. It is proposed to provide for the case where a designated Office requires under Rule 49.5(a)(ii) a translation of both the claims as filed and the claims as amended under Article 19 in a new paragraph (c-bis) to Rule 49.5. In such a case that Office will first have the option either of disregarding the claims of which a translation has not been furnished or of inviting the applicant to furnish the missing translation within a reasonable time limit. Where such an invitation is sent and the applicant does not furnish the

Rule 49

Copy, Translation and Fee under Article 22

49.1 to 49.4 [No change]

49.5 *Contents of and Physical Requirements for the Translation*

(a) to (c) [No change]

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

[Ad Rule 49.5(c-bis), continued]

missing translation within the time limit specified in the invitation, the Office will then have the option of disregarding the claims of which a translation has not been furnished or of considering the international application withdrawn. In other words, the sanction that the international application be considered withdrawn will in no case be applied before the applicant has been invited to furnish the missing translation.

5. Transitional provisions could be added to Rule 49.5 (in a new paragraph (c-ter), for example) for the Contracting States whose national laws would not be in compliance with Rule 49.5(c-bis) at the time of its adoption. Such a provision could read as follows:

“If, on [date of adoption by the PCT Assembly], paragraph (c-bis) is not compatible with the national law applied by the designated Office, paragraph (c-bis) shall not apply to that designated Office for as long as it continues not to be compatible with that law.”

Ad Rule 49.5(e)

1. Present situation. Present Rule 49.5(e) contains an item (ii) which provides for a transition period with regard to issuing an invitation to furnish a copy of the drawings. The transition period has existed for a number of years. It appears to be no longer necessary.
2. Proposed solution. It is proposed that item (ii) of Rule 49.5(e) be deleted and that item (i) be included in the body of Rule 49.5(e).
3. This proposed amendment was agreed by the Committee at its third session.

Ad Rule 49.5(h)

1. Present situation. In the case where the translation of the abstract is missing, the Regulations do not provide for an invitation to the applicant to furnish the missing translation. The lack of a translation of the abstract, however, is considered to be a matter which should be subjected to invitation and correction and not be automatically fatal for entering the national phase before a designated Office.
2. Proposed solution. Rule 49.5(h) is proposed to be amended to include a reference to the abstract and thus provide that the applicant shall be invited to furnish a translation of the abstract if he failed to include it with the translation of the international application.
3. In addition, since the national laws of Contracting States do not all give the same importance to the abstract, it is proposed to provide as a possible sanction (by using the verb “may” and not “shall”) that the designated Office consider the application withdrawn if the translation of the abstract is not furnished in response to the invitation.

[Rule 49.5, continued]

(d) [No change]

(e) Any designated Office requiring under paragraph (a) the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under Article 22,* invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.*

(f) and (g) [No change]

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

(i) and (j) [No change]

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

Ad Rule 49.5(k)

1. Present situation. No provision presently exists in the Regulations as to whether the title, as originally presented by the applicant in the international application, or the title as it may have been established by the International Searching Authority under Rule 37.2, because the original title did not comply with Rule 4.3, is to be translated under Article 22(1) for the designated Offices. The practice in the designated Offices differs. At least one designated Office requires the translation of the original title and not of the title as corrected by the International Searching Authority.
2. Proposed solution. A new Rule 49.5(k) is proposed to be added which would provide that the title to be translated under Article 22(1) is the title established by the International Searching Authority. This would remove any doubt as to the content of a required translation as far as the title is concerned. It is the corrected title established by the International Searching Authority which is published by the International Bureau and communicated under Article 20 to the designated Offices. It appears to be logical that the designated Offices should receive a translation of that title and not of any earlier defective title.
3. This proposed amendment was agreed by the Committee at its third session.

[Rule 49.5, continued]

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

Ad Rule 51bis.2(c)

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

Rule 51bis

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

51bis.1 [No change]

51bis.2 *Opportunity to Comply with National Requirements*

(a) and (b) No change

(c) [Deleted]

[End of document]