

WIPO



PCT/CAL/IV/6

ORIGINAL: English

DATE: December 14, 1990

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

**PCT COMMITTEE
FOR ADMINISTRATIVE AND LEGAL MATTERS**

**Fourth Session, First Part
Geneva, December 10 to 14, 1990**

REPORT
OF THE FIRST PART OF THE FOURTH SESSION

adopted by the Committee*

INTRODUCTION

1. The first part of the fourth session of the PCT Committee for Administrative and Legal Matters (hereinafter referred to as "the Committee") was convened in Geneva from December 10 to 14, 1990.
2. The following members of the Committee were represented at the first part of the session: (i) the following 19 States, members of the International Patent Cooperation Union (PCT Union): Australia, Austria, Canada, Denmark, Finland, France, Germany, Hungary, Italy, Japan, Netherlands, Norway, Republic of Korea, Soviet Union, Spain, Sweden, Switzerland, United Kingdom and United States of America; (ii) the European Patent Office (EPO), in its capacity as International Searching and International Preliminary Examining Authority.
3. Three States, members of the International Union for the Protection of Industrial Property (Paris Union), participated in the first part of the session as observers: Czechoslovakia, Tunisia and Turkey.

* See paragraph 96.

4. The following seven non-governmental organizations were represented by observers: Committee of National Institutes of Patent Agents (CNIPA), Federal Chamber of Patent Attorneys (KPA), Federation of German Industry (BDI), International Federation for the Protection of industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), Japanese Patent Attorneys Association (JPAA) and Union of Industrial and Employers, Confederations of Europe (UNICE).

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

OPENING OF THE SESSION

6. Mr. Bartels (Director, PCT Legal Division, WIPO), opened the Session and welcomed the participants.

ELECTION OF CHAIRMAN

7. The session unanimously elected Mr. U. Schatz (European Patent Office) as Chairman and Mrs. L.D. Østerborg (Denmark) and Mr. S. Takakura (Japan) as Vice-Chairman.

ADOPTION OF THE AGENDA

8. The Committee adopted for, its session the agenda appearing in Annex II to this report.

9. In addition to the documents listed in the agenda referred to above, the following documents containing proposals by several delegations were submitted to the Committee: PCT/CAL/IV/3 to 5.

CONSIDERATION OF PROPOSED AMENDMENTS TO THE REGULATIONS AND MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

10. The Committee considered proposed amendments as appearing in documents PCT/CAL/IV/2 to 5. It confirmed its approval at the third session of the proposed amendments to Rules* 3.1., 3.4, 11.6(a.) and (e), 11.7(b), 15.4(d), 20.3bis, 33.1(c), 38.2(a), 43.1, 43.7, 43.8, 44.2, 44.3(c) and (d), 46.2, 49.5(e) and (k), and 51bis.2(c), as set out in document PCT/CAL/IV/2.

11. The Committee approved unanimously the proposed amendments to the following Rules as appearing in document PCT/CAL/IV/2: Rules 4.1(b)(iv), 4.15, 11.6(f), 11.8(b), 15.1, 15.6, 17.2(c), 17.2(e), 18.3, 18.4(a) and (b), 20.1(a), 29.1(a) and (b), 33.1(b), 43.5(e), 47.1(a), 47.4 and 48.2(a).

* References in this report to “Articles” are to those of the Patent Cooperation Treaty (PCT), to “Rules” to those of the Regulations under the PCT (“the Regulations”) or to Rules as proposed to be amended, and to “Sections” to those of the Administrative Instructions under the PCT (“the Administrative Instructions”) or to Sections as proposed to be modified.

12. Concerning the proposed amendments to the, Rules referred to below, the Secretariat noted various clarifications and drafting changes proposed by members of the Committee and the representatives of the non-governmental organizations. The International Bureau was requested to prepare revised proposals with due regard to the suggestions made. The following paragraphs reflect only selected important points made in interventions. Other details were noted by the Secretariat. Annex III to this report sets out the text of proposed amendments to certain Rules and Sections, other than as set out in document PCT/CAL/IV/2, which were accepted by the Committee. Annex IV to this report sets out the text of proposed amendments to certain Rules and Sections, other than as set out in document PCT/CAL/IV/2, which were generally accepted by the Committee subject to further revision by the International Bureau.

13. Rules 2.2 and 2.2bis. Discussion on these proposals was deferred to, the second part of the fourth session of the Committee, for discussion together with proposed amendments to Rule 90. The Chairman invited delegations to consider, In the meantime, whether inclusion in the Regulations of the Interpretations proposed in Rules 2.2 and 2.2bis was necessary at all.

14. Rule 3.3(a). The proposal was accepted subject to the replacement of the words “which will show”, in the introductory sentence, by the word “Indicating”. The International, Bureau was asked to consider the possibility of a consequential amendment of Rule 3.3(b) to amend references to “filled in”.

15. Rule 3.4. In accepting the proposal, the text of proposed new Section 102bis was also accepted by the Committee as set out in Annex III to this report.

16. Rule 4.4(c). The proposed amendment was accepted as set out in Annex, III to this report. It was noted that the explanatory notes appearing on the request Form might need to give more details in connection with common representatives.

17. Rule 4.8. Discussion on this proposal was deferred to the second part of the fourth session, for discussion together with proposed amendments to Rule 90.

18. Rule 4.9(a). The proposed amendment was accepted subject to the deletion from item (ii) of the words “intended to be” and to a minor clarification of the drafting of the text in French. The International Bureau was asked to consider whether Section 201 should specifically enable use of two-letter codes to refer to regional patents as well as to the organizations which grant them.

19. Rule 4.9(b). The Committee accepted the proposal as set out in Annex III to this report. It was noted that the Administrative Instructions should provide for the notification of the International Bureau by the receiving Office where designations are confirmed and the corresponding fees paid by the applicant.

20. Rule 4.10(b). The Committee accepted the proposal as set, out in Annex III to this report. It was noted that the Administrative Instructions. should provide for prompt notification of the receiving office by the International Bureau when the latter discovers a discrepancy between the priority claim and the priority document.

21. Rule 5.1. The proposal by the EPO set out in document PCT/CAL/IV/4 was debated at length and received support from several delegations, but a majority of the Committee was not in favor of it. While it was recognized that a provision to omit the title of the invention from the description, and to rely solely on the title given in the request, might be appropriate for the procedure before the EPO, the situation was different for international applications.
22. Several delegations noted that the title was, under their national laws, part of the description, and that the proposed deletion of the title would prevent national offices from being able to obtain the translation of the title upon commencement of the national phase. It was also noted that if the translation of the title was not furnished by the applicant as part of the description, it would then be necessary to require a translation of the request containing the title. This would not be desirable because most designated Offices do not require a translation of the request. Having to provide such a translation would impose an additional burden on the applicant and on the Offices which would be obliged under Rule 49.5(b) to provide request forms in their languages.
23. The discussion further showed that, if the Regulations were to be amended as proposed by the EPO, consequential changes would have to be made in national laws in order to maintain uniformity with PCT requirements. The delegations concerned questioned whether the amendment was warranted. In view of the results of the discussion, the Delegation of the EPO withdrew its proposal.
24. Rule 5.2. The Committee accepted the proposal as set out in Annex III to this report.
25. Rule 11.6(f). In accepting proposed Rule 11.6(f), the Committee also agreed on the proposed modification to Section 108.
26. Rule 12.1(b). When discussing proposed Rule 20.4(c) to (g) (see below), the Committee agreed that Rule 12.1(b) should also be amended along the lines of the proposal as set out in Annex IV to this report.
27. Rule 12.3. This proposal as set out in document PCT/CAL/IV/2 was superseded by a new proposal to amend Rule 20.4 instead (see below).
28. Rule 13. This proposal, set out in document PCT/CAL/IV/5, was submitted jointly by the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office. The Chairman noted that the proposal reflected exactly the results of consideration of the question of unity of invention by the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions. The Committee agreed with the suggestion made by the Chairman that substantive consideration of the matters raised need not be undertaken at present but should be deferred until, after the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned, scheduled for June 1991. The International Bureau could thus prepare a proposal for consideration by the PCT Assembly at its subsequent extraordinary session scheduled for early July 1991, taking into account the outcome of the Conference. The Committee agreed that the PCT should not differ on this matter, from any Treaty which arose from the Conference, and that, in any event, the unanimous opinion of the said Committee of Experts on the question of unity of invention could be expected to find favor with the PCT Assembly.

29. While agreeing with the approach proposed by the Chairman, several representatives of non-governmental organizations foreshadowed that there would not be undivided support for the substance of the proposal.

30. The suggestion was also made that the International Bureau, in preparing the proposal, should consider what might be the most appropriate way of retaining the content of present Rule 13.2 (i.e., whether it should be in the Regulations or, as suggested by the joint proposal, in the PCT Search Guidelines).

31. Rule 13ter. The proposed new Rule was discussed at length and, noting the text, as approved, of Rule 5.2, the Committee accepted the deletion of proposed Rule 13ter.1 and approved the text of Rules 13ter.2 and 13ter.3, renumbered as Rules 13ter.1 and 13ter.2, as set out in Annex III to this report. It was agreed that the International Bureau would study whether a sequence listing could be annexed to the international search report and that the question would be taken up again at the second part of this session of the Committee.

32. Proposed new Rule 13ter.4, to be renumbered as Rule 13ter.3, did not meet with the agreement of delegations and it was agreed that it should be further considered by the International Bureau in view of the various suggestions and views expressed, in particular, whether the listing required by the designated Office would have to be the same as that required by the International Searching Authority, and whether, in case no listing was required by the International Searching Authority, the designated Office could still require one. The International Bureau noted that the designated Office should in no case be able to go beyond the standard Prescribed. This question would be taken up again at the second part of this session of the Committee.

33. Rule 15.5. The proposal was accepted subject to the insertion of the words “under this paragraph” at the end of the first sentence, after the words “designation fees paid”. The Delegation of the EPO noted that the PCT Regulations should provide for the receiving Office to acknowledge to the applicant the receipt of the confirmation of a designation and the payment of the corresponding fee.

34. Rule 16.1(a). The Committee considered a proposal to amend Rule 16.1 (see document PCT/CAL/IV/3) submitted by Sweden. The principle of a claims fee was supported by some delegations but it was agreed that the matter required further study by the International Bureau in order to take into account the views expressed by delegations and representatives of the non-governmental organizations, and other possible implications for the PCT procedure., The Delegations of Hungary and the United States of America reserved their positions. The Delegation of Hungary pointed out that Rules 6.1(a) and 13.4 required the number of claims to be reasonable, so that in its view there was already a sufficient basis in the Regulations for dealing with excessive numbers of claims.

35. A number of additional questions were raised by delegations, including: what sanction should be applied for non-payment of the claims fee; whether the claims, fee is part of the search fee and consequently non-payment of the, claims fee is equivalent to non-payment of the search fee; the consequence of non-payment on, the status of any claims introduced under PCT Article 19 or 34; the real value for the, designated Offices of an incomplete search (i.e., a search relating only to the claims for which a claims fee has been paid); and how to discourage applicants from filing applications containing a high number of claims. It was pointed out that the International Searching Authorities could always, increase the search fee,

but that this would indirectly make all applicants pay for those few who file applications with, an excessive number of claims.

36. The question was raised whether the sanction of withdrawing the entire application, if the claims fee was not paid, would not be too harsh. On the other hand, it did not seem that a search carried out only on those claims for which a claims fee had been paid would be in the spirit of the Treaty since it would not serve the needs of designated offices.

37. Representatives of the non-governmental organizations suggested that, if the claims fee were to be introduced only for claims in excess of, for example, 25, that is, a higher number than the present similar requirements under some national laws, the provision would be better understood by users and would be seen less as a disadvantage of using the PCT route but rather as a means of discouraging an excessive number of claims. The repeated payment of Claims fees at other stages (to the International, Preliminary Examining Authority and to designated Offices) would be undesirable. The Delegations, of Sweden and the EPO stated that their Offices had no intention of introducing a claims fee for international preliminary examination..

38. Rule 16.2. The proposed amendment was generally accepted by the Committee. The Delegation of Japan explained, that the provisions of the Japanese national accounting law would not permit a refund under proposed Rule 16.2(ii) in the absence of an express request by the applicant. The Committee felt that it would be possible to deal with the problem faced by the Japanese Patent Office through the inclusion of a pre-printed conditional request for a refund in the request Form or in the fee calculation sheet or, alternatively, by making it clear in the explanations of the proposed amendments that a receiving Office would be able to apply the proposed Rule by inviting the applicant to make a request before the refund was made.

39. Rule 16bis.1. The proposed amendment was generally accepted, subject to replacing the word “notification” in the last line of Rule 16bis.1(b) by the word “invitation”. The title of Rule 16bis should be amended to read “Extension of Time Limits for Payment of Fees”. The Delegation of Japan expressed a reservation based on its view that the time limits which could be prescribed under Article 14(3)(a) were exhaustively stated in Rules 14.1(b), 15.4(a) and 16.1(f), but agreed to reconsider, its position in the, light of, comments by the International Bureau that Rule 16bis.1, as proposed to be amended, would itself constitute an extension of the time limits under those Rules and that they, taken together, prescribe the time limits under Article 14(3)(a.).

40. It was noted that Rule 27.1 may need a consequential amendment to refer to the late payment fee.

41. In connection with Rule 16bis.1, the Committee agreed that proposals to modify Sections 320 and 321 and to delete Section 322 should proceed along the lines, set out in Annex IV to this report. The International Bureau was asked to revise the proposal under Section 321 to deal also with the question of how fees paid should be applied to the late payment fee.

42. Rule 16bis.2. The Committee unanimously approved the proposal set out in Annex III to this report.

43. Rule 17.2(d). The Committee generally accepted the proposed amendment as set out in Annex III to this report.

44. The Delegations of Denmark and the EPO reserved their positions in relation to the proposed broadening of the Rule which provides that the priority document should not be made available where the international application or a, priority, claim is withdrawn after the completion of technical preparations for international publication but before the date of international publication. The representatives of the non-governmental organizations were strongly of the view that the priority document should remain confidential in such circumstances, and supported the text set out in Annex III to this report.

45. Rules 18.3, and 18.4(a) and (b). The Committee discussed these proposals at length and approved them. The Delegations of Japan and the Netherlands stated that, in view of the discussion, they would no longer maintain their reservations made at the third session of the Committee. There was unanimity amongst the delegations that the proposal was not against the spirit of Article 9.

46. Rule 19.4. Several delegations and all the representatives of the non-governmental organizations supported the aim behind the proposal, believing that it would be desirable to include provisions which avoid loss of rights for the applicant where an international application is filed with a “non-competent” receiving Office. Some delegations did not support the concept of the proposal, believing that the low incidence of cases did not warrant the inclusion of a Rule which raised problems of compatibility with the Treaty itself and/or that this kind of error by applicants or their agents should not be able to be excused.

47. Several delegations expressed concern as to the suitability of the proposed Rule to achieve the objective, notably as to the role of the “transmitting Office” (whether it or the applicant should determine which was the appropriate competent receiving Office, and whether it should have a discretion as to whether to act under the proposed Rule), and as to possible incompatibility of the proposal with the spirit, if not the letter, of Article 11(1)(i). It was noted that applicants may have more than one competent receiving Office and that the choice should be left to the applicant.

48. One of the representatives of the non-governmental organizations suggested that, notwithstanding the exceptional nature of the circumstances dealt with in proposed Rule 19.4, a time limit of four weeks should be provided in Rule 19.4(b).

49. The Chairman concluded that the matter would not be further discussed during the fourth session of the Committee unless the International Bureau could prepare an alternative proposal. He also invited delegations to suggest alternative approaches to the International Bureau before the second part of this session of the Committee.

50. Rule 20.4(c) to (g). The Committee generally agreed that a proposal be included along the lines of proposed Rule 20.4(c) to (g), as set out in Annex IV to this report. This proposal superseded the proposals set out in document PCT/CAL/IV/2 in relation to Rules 12.3, 20.4(c) and 26*bis*.

51. The Committee generally agreed that, in the context of Article 11(1)(ii), “international application” should be interpreted on the basis of the minimum contents of an international, application for according a filing date, as set out in Article 11(1)(iii), rather than on the more

specific enumeration found in Article 3(2). This approach was consistent with the purpose behind Article 11 and was necessary to ensure that Article 11 (notably Article 11(2)) was internally consistent. The requirement of Article 11(1)(ii) that the international application be in the prescribed language thus did not preclude the Regulations from treating the request, drawings and abstract (none of which are mentioned in Article 11(1)(iii) among the necessary minimum elements of an international application) outside the confines of Article 11(2) if they did not comply with language requirements. The Delegation of the Netherlands expressed its hesitation as regards the interpretation of “international application” given above.

52. Some delegations expressed hesitation in relation to certain aspects of the proposal, including: the mandatory nature of Rule 20.4(c)(ii); special problems associated with flow sheets and other drawings containing a substantial amount of text matter (see Rules 7.1 and 11.11); difficulties which might arise, in the event that the applicant’s address in the request could not be identified by the receiving office; the possibility of an extension of the original disclosure by way of an incorrect translation; and whether the use of the concept of “obvious error” was appropriate or necessary to require a faithful translation with no change in the meaning and scope of the disclosure. In connection with the latter two points, it was agreed the filing of a translation should not enable the original disclosure to be extended. It was also noted that the PCT procedure, generally, is based on the requirement that rights accrue in designated Offices from the international filing date, notwithstanding that translations are only required to be filed with designated Offices upon entry into the national phase or that translations are prepared under Rule 48.3(b) under the responsibility of the International Searching Authority. Finally, it was noted that the rectification of an obvious language error in a drawing would require authorization by the International Searching Authority.

53. It was noted that the proposal in relation to Rule 12.1(b) (see above) would liberalize the language requirements for requests, reflected in proposed Rule 20.4(c).

54. The Delegation of Japan expressed a reservation based on the view that the proposal was inconsistent with Article 11.

55. The International Bureau was asked to revise the proposal in the light of the discussion.

56. Rule 23.1. The proposal was generally accepted by the Committee. The Delegation of Japan maintained the reservation made at the third session of the Committee.

57. Rule 24.2(a). The Committee accepted the proposal as set out in Annex III to this report. Proposed Section 428, set out on page 68 of , document PCT/CAL/IV/2, was renumbered as Section 426, but otherwise was accepted subject to the deletion of paragraph (v). Proposed Section 114, as set out on page 70 of that document, was accepted.

58. It was agreed that the International Bureau should publish information in the PCT Gazette setting out those Authorities and Offices which required the sending of notifications under Rule 24.2(a), and that the Administrative Instructions should be modified to include an appropriate provision.

59. Rule 26.5(b). A majority of delegations supported the proposed amendment. The Delegation of Japan, while supporting the amendment proposal, asked the International,

Bureau to indicate in the explanations of the proposed amendments the legal basis on which the international application could be considered withdrawn, not only as a whole but also in respect of a certain designated State. The Delegations of the Netherlands and the United States of America expressed their reservations as to the best way of arriving at a solution, the need for which was unanimously agreed to by the Committee, since they were of the opinion that not meeting the requirements prescribed in Rules 4.5 and 4.15 had to result in the international application being considered withdrawn as outlined in Article 14(1)(b). The Delegation of the United Kingdom, supported by the Delegation of the Soviet Union, asked the International Bureau to consider whether a reference to the furnishing of a satisfactory statement under Rule 4.15(b)(ii) was needed in this Rule.

60. Rule 26bis. This proposal in document PCT/CAL/IV/2 was superseded by proposed Rule 20.4(c) to (g) (see above).

61. Rule 29.1(a) and (b). In accepting this proposal, the Committee noted that an appropriate provision may be needed in the Administrative Instructions requiring the receiving office to notify the International Bureau of designations confirmed under Rule 4.9(b) (see above).

62. Rules 32 and 32bis. Discussion of these proposals was deferred to the second part of the fourth session of the Committee, for discussion together with the proposed Rule 90bis.

63. Rule 36.1. The Delegation of the EPO, supported by the Delegation of Sweden, opposed this proposal since, in its view, the present provision requiring an International Searching Authority to have the minimum documentation "in its possession", "properly arranged for search purposes" already encompassed the holding of documents as a data bank as well as in hard copy form. A number of other delegations, however, noting the agreement of the Committee at its third session to the substance of the proposal, expressed their support for the proposed text, noting that access to a data bank, if adequate for search purposes, should be sufficient for compliance with the requirement in respect of those parts of the minimum documentation which are contained in the data bank without actually having the data base in its possession.

64. The International Bureau advised, in response to a question from the Delegation of the United States of America, that the matter had arisen as a result of an enquiry by the PCT Committee for Technical Cooperation (PCT/CTC), and agreed to canvass this background in revising the Explanations to the Proposed Amendments.

65. The Chairman pointed out that Rule 36.1 governed the actions of the PCT Assembly in appointing International Searching Authorities, and it was thus particularly appropriate for the question raised by the PCT/CTC to be referred to the Assembly for consideration.

66. Rule 38.2(b). The proposed amendment was accepted with the understanding that the abstract would be republished if it were established by the International Searching Authority and not available to the International Bureau before publication of the international application. Such a provision could be included in the Guidelines on Publication under the PCT.

67. Rule 39.1. The Committee agreed to, the proposal, subject to, the addition, after the words “available to it” of the words “in such a, form that a meaningful search can be carried, out.”
68. Rule 40.2(e). This proposal, which is set out in document PCT/CAL/IV/4, was submitted by the EPO. Several delegations supported the concept of permitting the International Searching Authorities to charge a fee for examination of a protest under Rule 40.2, but others, including representatives of the non-governmental organizations, expressed Concerns. It was recognized that the EPO faced particular problems in that the, European Patent Convention provided for a rather extensive and costly procedure for reviewing such protests.
69. After discussion, it was agreed that the EPO would reconsider the proposal, consulting the International Bureau, with a view to taking into account the concerns expressed. In particular, it should be considered to provide for an internal review by the International Searching Authority, on the basis of submissions from the applicant, prior to the formal protest procedure and to payment of a fee for a protest. Also, the possibility of a refund of the proposed fee, where a protest was successful on review should be considered, and the possible need for corresponding amendment of other provisions of Rule 40.2. should be studied.
70. Several delegations expressed the view that the proposed fee could be included in another fee, such as the search fee itself, or the additional fee charged under, Rule 40.2 (possibly by charging a different fee depending on whether a protest was filed). The Delegations of Hungary and Japan reserved their positions, based on their view that the proposed fee, must be regarded as part of, the search fee, since the protest procedure was part of the international searching procedure.
71. The representatives of the non-governmental organizations were of the opinion that the additional fee for, searching under Article 17(3)(a) charged by the EPO, which was as high as the international search fee, would compensate the EPO for its additional work since additional searches required less work than the first search.
72. Rule 42.1. The Committee confirmed its approval of the proposal at Its third session, subject to deletion of the words “where Article 17(3)(a) applies” at the end of the second sentence, In order to ensure that the Rule would cover the cases where the search may be delayed due to the late furnishing of a machine readable listing of a nucleotide or amino acid sequence under Rule 13ter.
73. It was noted that proposed Section 501bis should be, amended accordingly and that, in addition, the word “promptly”, in the third line, should be replaced by the words “as soon as possible”.
74. Rule 43.6(c). The proposal set out in Annex III to this report was generally accepted, noting that the indication in the International search report of the name of the data base and/or the search terms used, was optional. The delegation of the EPO made a reservation as to indications of the search terms, since It believed that such indications would invariably be impracticable.
75. Rule 43.9. The proposal was generally accepted by the Committee. The Delegation of Japan, while supporting the principle of the proposal, suggested that the wording might enable

the Administrative Instructions to override the express provisions of the Rules which prescribed matter to be contained in the international search report. The Delegation agreed to give the matter further consideration after having heard the explanation that the Administrative Instructions could merely, specify additional matters which may be included at the International Searching Authority's option; they could not require additional indications. The Delegation of Sweden expressed hesitation as to the proposed Rule.

76. Rule 48.6(c). Discussion of this proposal was deferred to the second part of the fourth session, for discussion together with the proposed Rule 90bis.

77. Rule 49.5(c-bis). A majority of delegations was in favor of the proposal, provided that a transitional provision is, also included in order to accommodate those countries whose present national law requires a translation of the claims both as filed and as amended at the time of entry into the national phase.

78. The Delegations of Japan and the Netherlands questioned the compatibility of the proposal with Articles 22 and 24 and reiterated their opinion that the matter should be left to the national laws.

79. The International Bureau stressed that the proposed provision did not deny the right of the designated Offices to require a translation of the claims both as filed and as amended. Rather, the proposal provided a safeguard for applicants who overlook the requirement of furnishing both translations by giving them the opportunity, upon invitation by the designated Office, to comply with it.

80. The Delegation of the United Kingdom noted, and, the Committee agreed that, were this Rule to be adopted, a consequential amendment would be required in Rule 49.5(a), second sentence, by adding a reference to Rule 49.5(c-bis) to the existing reference to Rule 49.5(b) and (e).

81. The Delegation of the United States of America noted that it could be appropriate to introduce a surcharge for late furnishing of the missing translation of the claims as filed or as amended.

82. It was noted by the Delegation of the United States of America that the proposal as drafted referred only to those designated Offices which require a translation of the claims both as filed and as amended, and did not take account of Offices which require only one translation.

83. The Delegation of the United States of America expressed the view that it would be advisable to introduce in the proposed Rule an outer time limit to ensure that an applicant would not be required to furnish a missing translation even several years after the grant of the patent. The Delegation of the EPO, however, stressed the importance of not preventing an examiner from requiring a translation of the claims during the national examination (e.g., where an amended claim was not fully supported by the description).

84. The representatives of the non-governmental organizations expressed strong support for the proposal, which, in their view, would help to overcome one of the last pitfalls of the PCT system.

85. Rule 49.5(h). There was strong support for the proposed new Rule.
86. The Delegation of the United Kingdom withdrew the reservation which it expressed at the third session-of the, Committee, because it noted that the English translation of the abstract was supplied to the United Kingdom Patent Office as a designated Office by way of the PCT pamphlet, which contains the abstract translated into English by the International Bureau in all cases where the application is published in a language other than English.
87. The Delegation of the United States of America maintained its reservation but Indicated, in view of the comments presented by the Delegation of the United Kingdom, that it will review its position.
88. The Delegations of Japan and the Netherlands maintained their reservations because the matter should be left to national law.
89. Rule 68.3(e). This proposal as set out in document PCT/CAL/IV/4 was not specifically discussed by the Committee, but the discussion of Rule 40.2(e), reflected above, applies equally to this proposal.
90. Rule 91.1(e). The Delegation of the EPO withdrew its proposal, set out in document PCT/CAL/IV/4,,together with the proposal relating to Rule 5.1.

OTHER MATTERS

91. The Delegation of Czechoslovakia informed the Committee that, after important political changes and the introduction of market economy principles in its country, a new patent law had been approved by the Parliament and would enter into force on January 1, 1991. This new law would enable its country to accede to the PCT in the Course of the first half of 1991. The Government of its country had approved the accession to the PCT because of the advantages of the PCT system.
92. The Chairman, on behalf of the Committee, congratulated Czechoslovakia on its achievement and stated that Czechoslovakia would be very welcome as a new Contracting State. The International Bureau, in associating itself with the Chairman's remarks, offered to give further assistance to the Patent Office of Czechoslovakia in the implementation of the PCT.
93. The International Bureau Indicated that the second part of the fourth session of the Committee was scheduled to be held from March 11 to 15, 1991, in Geneva, for consideration of revised proposals for amendment of Rules relating to Parts C to P of the Regulations.
94. The International Bureau further indicated that it was intended, subject to the outcome of the second part of the fourth session of the Committee, to convene an extraordinary session of the PCT Assembly from July 8 to 12, 1991, in Geneva, for decisions about the proposals for amendments to the PCT Regulations prepared by the International Bureau on the basis of advice by the Committee.

95. The Delegation of France, together with the Delegations of Canada and Italy, reserved their positions as regards the adoption of this report, since no French translation of the draft report was available at the conclusion of the first part of this session.

96. This report, in its English version, was adopted by the Committee on December 14, 1990, subject to such changes that the adoption of the French version may entail. The French version will be submitted for adoption to the Committee at the occasion of the second part of its fourth session.

[Annexes I to IV follow]

ANNEXE I/ ANNEX I

LISTE DES PARTICIPANTS/
LIST OF PARTICIPANTS

I. MEMBRES DU COMITÉ/MEMBERS OF THE COMMITTEE

(dans l'ordre alphabétique français des noms des États)
(in the French alphabetical order of the names of the States)

ALLEMAGNE/GERMANY

Sabine JOTZO (Mrs.), Regierungsrätin z.A, German Patent Office, Munich

AUSTRALIE/AUSTRALIA

John Francis BANNOUSH, First Secretary, Permanent Mission, Geneva

AUTRICHE/AUSTRIA

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[L'annexe II suit/Annex II follows]

ANNEX II

AGENDA

adopted by the Committee

1. Opening of the session
2. Election of a Chairman and two Vice-Chairmen
3. Adoption of the agenda (this document)
4. Consideration of proposed amendments to the Regulations under the PCT (document PCT/CAL/IV/2)
5. Other matters
6. Adoption of the report of the session
7. Closing of the session

[Annex III follows]

ANNEX III

This Annex sets out the text of proposals for amendment of certain Rules and Sections as referred to in the report and accepted by the Committee. Some of the proposals replace, and others are in addition to, proposals set out in documents PCT/CAL/IV/2 to 5. Where the proposed amendment relates to only a part of a Rule or Section, this Annex reproduces, under the title, of the Rule or Section, only that relevant part.

Proposed Amendments to the Regulations

Rule 4.4 Names and Addresses

(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 applicant or, where, applicable, the agent or the common representative.

Rule 4.9 Designation of States

(b) The request may contain an indication that all designations which would be permitted under the Treaty, other than those made paragraph (a), are also made, provided that:

(i) at least one Contracting State is designated under paragraph (a), and

(ii) the request also contains a statement declaring that any designation made under this paragraph which is not confirmed in a written notification to the receiving Office before the expiration of a time limit of 15 months from the priority date, accompanied by the fee prescribed under Rule 15.5, is withdrawn with effect from the expiration of that time limit.

Rule 4.10 Priority Claim

(b) If the request does not indicate both

(i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an International application, at least one country for which it was filed, and

(ii) the date on which it was filed,

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

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, in which case the priority claim may be rectified by the receiving Office at the request of the applicant. The error shall be considered as an obvious error whenever the correction of the priority claim is obvious from a copy of the earlier application submitted, in case of a missing date, before the transmittal of the record copy and, in all other cases, before the expiration of the time limit under Rule 17.1(a) computed on the basis of the correct date.

Rule 5.2 Nucleotide and/or Amino Acid Sequence Disclosure

Where the international application contains disclosure of a nucleotide and/or amino acid sequence, the description shall contain a listing of the sequence complying with the standard prescribed by the Administrative Instructions.

Rule 13ter Nucleotide and/or Amino Acid Sequence Listings

Rule 13ter.1 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 standard prescribed in the Administrative Instructions under Rule 5.2, 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 a machine readable form, to pay for the cost of such transcription.

(b) Any copy of a sequence listing furnished under paragraph (a) shall be accompanied by a statement that the copy does not include matter which goes beyond the disclosure in the international application as filed .

(c) 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).

(d) 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).

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

Rule 13ter.2 Copy of Sequence Listing Not Part of International Application

A copy of a sequence listing furnished or transcribed under Rule 13ter.1(a) shall not form part of the international application.

Rule 16bis.2 Late Payment, Fee

(a) The late payment of fees in response to an invitation under (a) .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.

(b) The amount of the late, payment fee shall not, however exceed the amount of, the basic fee.

Rule 17.2 Availability of copies

(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, prior to International publication:

(i) the International application is withdrawn, or

(ii) the relevant priority claim is withdrawn or considered not to have been made,
or

(iii) the relevant declaration under Article 8(1) is cancelled.

Rule 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 (unless it has informed the International Bureau that it wishes not to be notified), and each designated, Office in respect of a designation made under Rule 4.9(a), or confirmed under Rule 4.9(b), 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) and, where applicable, those whose designation has been confirmed under Rule 4.9(b).

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

Rule 43.6 Fields, Searched

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

Proposed Modifications of the Administrative Instructions

Section 102*bis* Request or Demand Presented as a Computer Print-out under Rule 3.1 or Rule 53.1(a)

(a) If the request or the demand is presented as a computer print-out, such 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 are permitted.

Annex G:

[Remains to be prepared in consultation with computer experts]

[Annex IV follows]

ANNEX IV

This Annex sets out the text of proposals for amendment of certain Rules and Sections, as referred to, in the report, which were generally accepted by the Committee subject to further revision by the International Bureau. Some of the proposals replace, and others are in addition, to proposals set out in documents PCT/CAL/IV/2 to 5. Where the proposed amendment relates to only a part of a Rule or Section, this Annex reproduces, under the title of the Rule or Section, only that relevant part.

Proposed Amendments, to the Regulations

Rule 12.1 Admitted Languages

(b) The request may, notwithstanding paragraph (a), be filed in the language of publication or in a language specified by the receiving Office under paragraph (a).

Rule 20.4 Determination under Article 11(1)

(c) Subject to paragraph (d), where the request is not in a language admitted under Rule 12.1(b):

(i) the use of a non-admitted language in the request shall be treated as being an obvious error in relation to the language used and that error shall not be taken to be a defect under Article 11(1); and

(ii) the receiving Office shall promptly invite the applicant to make a request for rectification under Rule 91.1.

(d) Notwithstanding any time limit specified, in Rule 91.1, where rectification of the error in the language of the request has not been authorized under that Rule before the expiration of three months from the International filing date, the failure to use the correct language shall thereupon cease, to be treated as an obvious error and the receiving Office shall proceed under Article 14(4) before the expiration of the time limit under Rule 30.1.

(e) Where the text contained in any drawing is not in the same language as the description and claims, paragraphs (c)(i) and (ii) shall apply *mutatis mutandis*.

(f) Notwithstanding any time limit specified in Rule 91.1, where rectification of the error in the language of the text contained in a drawing has not been authorized under that Rule before the expiration of three months from the international filing date, the failure to use the correct language shall thereupon cease to be treated as an obvious error and the text concerned shall be disregarded.

(g) Where an abstract is not in the same language as the description and claims, it shall be treated as if it had not been filed and the receiving Office shall proceed under Rule 26.1.

Proposed Modifications of the Administrative Instructions

Section 320 Invitation to Pay Under Rule 16bis.1(a) and (b)

Where the receiving Office finds that fees referred to in Rule 16bis.1(a) and (b), or any part thereof, have not been paid, it may issue a single invitation relating to all such unpaid fees.

Section 321 Application of Moneys Received by the Receiving Office in Certain Cases

(a) and (b) (No change]

(c) Where, pursuant to paragraph (b), the receiving Office applies moneys in payment of the designation fees, it shall apply them to those fees in an order which shall be established as follows

(i) where the applicant indicates to which designation or designations the amount is to be applied it shall be applied accordingly but, if the amount received is insufficient to cover the designations indicated, it shall be applied to as many designations as are covered by it in the order chosen by the applicant in indicating the designations;

(ii) to the extent that the applicant has not given the indications under item (1), the amount or the balance thereof shall be applied to the designations in the order in which they appear in the international application;

(iii) where the designation of a State is for the purposes of a regional patent and provided that the required designation fee is under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.

The receiving Office shall declare any designation not covered by the amount paid withdrawn under Article 14(3)(b) and the receiving Office and the International Bureau shall proceed as provided in Rule 29.

(d) and (e) [Deleted]

Section 322 [Deleted]

[End of Annex and of document]