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THE INTERNATIONAL BUREAU AS ALTERNATIVE RECEIVING OFFICE:
PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT

Memorandum prepared by the International Bureau

* *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

INTRODUCTION

1. Users of the PCT in different parts of the world often express the wish to have the possibility of filing international applications direct with the International Bureau as an alternative to filing with their national Offices as PCT receiving Offices. The proposals for amendment of the PCT Regulations contained in the present document are designed to provide such an alternative.

2. The text of the amendments to the PCT Regulations which are proposed by the International Bureau, together with explanations, appears below.

SUMMARY

3. The main features and advantages of the proposed new system are summarized in the following six paragraphs.

4. The proposed amendments are intended to give applicants from all PCT Contracting States the option, from January 1, 1994, of filing international applications with the International Bureau as receiving Office, as an alternative to filing with competent national (including regional) Offices as receiving Offices (see the amendments proposed to Rules 19.1(a) and 19.2). Questions of residence or nationality, if in doubt, would be referred by the International Bureau to the national Office of, or acting for, the State concerned, for decision by that Office (Rules 18.1 and 18.2).

5. The competence of International Searching Authorities and International Preliminary Examining Authorities to search and examine an international application would be established as if the international application had been filed with a national (regional) Office as competent receiving Office for that international application (Rules 35.3 and 59.1(b)). Where there are two or more applicants from different countries, they would have a wider choice of International Searching Authority and International Preliminary Examining Authority than at present, since the competence of Authorities would depend on the State of residence or nationality of any of the applicants rather than on the fact that the international application was filed with a particular receiving Office.

6. Admitted languages for filing with the International Bureau as receiving Office would be all seven publication languages under the PCT. In any particular case, the language in which the applicant has to file the international application will depend on the language(s) accepted by the International Searching Authority which is, or Authorities which are, competent to search the international application. Correspondence between the applicant and the International Bureau as receiving Office would be in English or French.

7. National security provisions would apply (Article 27 (8)), and compliance with them would continue to be the applicant's responsibility.

References in this document to Articles and Rules are, respectively, to those of the Patent Cooperation Treaty (PCT) and of the Regulations under the PCT (the Regulations), or to such provisions as proposed to be amended or added, as the case requires.

8. Agents would have the right to represent applicants before the International Bureau as receiving Office as if the international application had been filed with a national (regional) Office as competent receiving Office for that international application (Rules B3.1bis and 90.1(a) and (d) (i)).

9. The proposed amendments are also intended to reduce or eliminate the problems which arise under the present procedure when an international application is filed with a receiving Office which is not competent having regard to the applicant's residence and nationality. Such problems can be avoided by filing with the International Bureau as receiving Office, since that Office would be competent to receive international applications from residents and nationals of any PCT Contracting State (Rules 19.1(a) and 19.2). In addition, it is proposed that an international application filed by an applicant from a PCT Contracting State with a non-competent receiving Office would be transmitted by that Office to the International Bureau as receiving Office and the date of receipt by the non-competent Office would then be considered as the date of receipt by the International Bureau (Rule 19.4).

INTERNATIONAL BUREAU AS RECEIVING OFFICE

10. No amendment to the Regulations appears to be necessary to deal with the general question of the application of the Treaty, Regulations and Administrative Instructions where the International Bureau acts in its capacity as receiving Office. Clearly, references to receiving Office would include the International Bureau when acting in that capacity.

LANGUAGE OF FILING AND CORRESPONDENCE

11. The International Bureau as an alternative receiving Office would prescribe as admitted languages, pursuant to Rule 12.1, those languages that the competent International Searching Authority (or, where two or more are competent, the competent Authority chosen by the applicant) accepts for search and that are languages of publication (that is, Chinese, English, French, German, Japanese, Russian and Spanish). Provision would be made for Chinese and Spanish as filing languages for international applications filed with the International Bureau in the expectation that China will become bound by the PCT on January 1, 1994, and that the Spanish Industrial Property Office will be appointed as an International Searching Authority with effect from January 1, 1994. Accordingly, no change is proposed to Rule 12.1(a).

12. It should be noted that the existing text of Rule 92.2(d) and (e) would require correspondence between the applicant and the International Bureau to be in English or French. Those provisions do not apply to the language of filing of the international application itself (c.f. Rule 12.1). No amendment is proposed to Rule 92.2.

13. The proposals contained in this document are submitted for consideration by the PCT Committee for Administrative and Legal Matters (hereinafter referred to as the Committee) at its fifth session. After any revision based on the conclusions of the Committee, it is intended that proposed amendments to the PCT Regulations will be submitted to the Assembly of the PCT Union for adoption at its ordinary session in September 1993.

14. The text of the proposed amendments appears on the odd-numbered pages following, whereas the corresponding explanations appear on the opposite even-numbered pages. In the text itself of the Rules proposed to be amended, what is new as compared to the present text is indicated by underlining. Deletions of text matter are identified by asterisks and footnotes.

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

EXPLANATION OF THE PROPOSED
AMENDMENTS

Ad Rules 4.1(b)(vi) and 4.14bis

1. The indication of choice of International Searching Authority has, in the past, been made by the applicant in the fee calculation sheet, the use of which is optional. Under proposed Rule 35.3, several International Searching Authorities may be competent in any particular case, especially where there are two or more applicants having different nationalities and/or residences. Proposed new Rules 4.1(b)(vi) and 4.14bis would require the choice of International Searching Authority to be made in a formal way by including an indication in the request itself.

2. Proposed new Rules 4.1(b)(vi) and 4.14bis would apply not only where the International Bureau is the receiving Office but also where a national Office is the receiving Office.

TEXT OF THE PROPOSED AMENDMENTS

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

- (a) [No change]
- (b) The request shall, where applicable, contain:
 - (i) to (iv) [No change]
 - (v) a reference to a parent application or parent patent
 - (vi) an indication of the applicant's choice of competent International Searching Authority.
- (c) to (d) [No change]

4.2 to 4.14 [No change]

4.14bis *Choice of International Searching Authority*

If two or more International Searching Authorities are competent for the searching of the international application, the applicant shall indicate his choice of International Searching Authority in the request.

4.15 to 4.17 [No change]

Ad Rules 18.1 and 18.2

1. Questions concerning residence and nationality are, under existing Rule 18.1, decided by the receiving Office. In case of doubt, the International Bureau as receiving Office would not be in a position to decide such a question. It is therefore proposed that the national Office of, or acting for, the Contracting State concerned would decide the question, in the exceptional cases where a doubt arose, if so requested by the International Bureau (for example, where the residence or nationality indicated by the applicant is of a territory and it is not clear that such residence or nationality constitutes residence or nationality of a Contracting State). The International Bureau would refer the question to the national Office of the Contracting State concerned rather than to the national Office acting for that State (e.g., a question as to residence or nationality of Denmark would be directed to the Danish Patent Office rather than to the European Patent Office), except in the cases where the Contracting State concerned did not maintain its own national Office, but relied on another national Office or a regional Office to act for it. In the latter case, the International Bureau would refer the question to that other national Office or regional Office (for example, to the Swiss Federal Intellectual Property Office in the case of questions concerning Liechtenstein and to OAFI in the case of questions concerning its member States). In ordinary cases, the International

Bureau, like any other receiving Office, would accept what is indicated in the request without looking behind such indications.

2. In order to avoid complex drafting, it is proposed to amalgamate the wording of existing Rules 18.1(a) and 18.2(a) and to add a new paragraph 18.1(c) dealing with the case where the International Bureau is receiving Office. The overriding provisions in existing Rules 18.1(b) and 18.2(b) are proposed to be combined and retained as proposed paragraph (b)(i) and (ii) of Rule 18.1. Consequent on those changes, Rule 18.2 is proposed to be deleted.

3. Note that proposed Rule 18.1(c) would apply to the cases where the International Bureau acts as receiving Office under either proposed new Rule 19.1(a)(iii) or existing Rule 19.1(b).

Rule 18

The Applicant

18.1 *Residence and Nationality**

(a) Subject to the provisions of paragraphs (b) and (c), the question whether an applicant is a resident or national of the Contracting State of which he claims to be a resident or national shall depend on the national law of that State and shall be decided by the receiving Office.

(b) In any case,

(i) possession of a real and effective industrial or commercial establishment in a Contracting State shall be considered residence in that State, and

(ii) a legal entity constituted according to the national law of a Contracting State shall be considered a national of that State.

(c) Where the international application is filed with the International Bureau as receiving Office, the national Office of, or acting for, the Contracting State concerned shall, if so requested by the International Bureau, decide the question referred to in paragraph (a).

18.2 [Deleted]

18.3 and 18.4 [No change]

Ad Rule 19.1

1. Proposed new Rule 19.1(a)(iii) would afford applicants who are residents or nationals of any Contracting State (see Article 9) the option of filing the international application with the International Bureau as receiving Office.

2. The right of applicants to file international applications with the International Bureau would not preclude any Contracting State from applying restrictions for reasons of national security, etc., under the provisions of Article 27(8). No express provision needs to be included in this (or any other) Rule, however, since the provisions of Article 27(8) are overriding in nature. Compliance with national security restrictions is the responsibility of applicants and their agents, who are already used to observing these restrictions for foreign filings. The fact that national security restrictions may apply would be indicated in the Applicant's Guide and in the Notes to the Request form. Enforcement would be a matter for Contracting States; it would be unnecessary and impracticable for the International Bureau to have any role in ensuring such compliance (it is to be noted, in this connection, that the European Patent Office does not undertake any examination as to whether national provisions regarding national security have been complied with).

* The title has been amended to read Residence and Nationality instead of Residence.

3. It should be noted that no change is proposed to Rule 19.1(b). It is envisaged that the International Bureau would continue to act as receiving Office instead of the national Office for those Contracting States with which there are agreements to that effect under Rule 19.1(b) (Barbados, OAPI States, Sri Lanka). There would be no change in the languages prescribed by the International Bureau for nationals and residents of those Contracting States.

Rule 19

The Competent Receiving Office

19.1 *Where to File*

(a) Subject to the provisions of paragraph (b), the international application shall be filed, at the option of the applicant,

(i) with the national Office of or acting for the Contracting State of which the applicant is a resident,

(ii) with the national Office of or acting for the Contracting State of which the applicant is a national,

(iii) irrespective of the Contracting State of which the applicant is a resident or national, with the International Bureau.

(b) and (c) [No change]

Ad Rule 19.2

1. Proposed Rule 19.2(ii) would make it clear that, if there are two or more applicants, the international application may be filed with the International Bureau as receiving Office under Rule 19.1(a)(iii) if at least one of the applicants is a resident or national of a Contracting State.

19.2 *Two or More Applicants*

If there are two or more applicants:

(i) the requirements of Rule 19.1(a)(i) or (ii) shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national,

(ii) the international application may be filed with the International Bureau under Rule 19.1(a)(iii) if at least-one of the applicants is a resident or national of a Contracting State.

19.3 [No change]

Ad Rule 19.4

1. Proposed Rule 19.4 would provide that, where a purported international application is filed with a national Office which is a receiving Office under the PCT but which is not competent to receive an international application from the applicant having regard to his residence and nationality (see Rules 19.1(a)(i) and (ii) and 19.2(i) as proposed to be amended), the papers would, unless prescriptions concerning national security prevent the papers from being transmitted (c.f. Rule 22.1(a) in relation to transmission of the record copy by the receiving Office), be transmitted by that national Office to the International Bureau. In those circumstances the papers would be considered to have been received by the International Bureau as receiving Office under Rule 19.1(a)(iii) on the date of actual receipt by the non-competent Office. Provided that the language requirements for filing with the International Bureau were met (as well as other requirements under Article 11), that date of receipt would then be accorded as the international filing date. The only burden involved for the non-competent Office would be to stamp the date of receipt on the papers and transmit them to the International Bureau, without allocating a PCT application number.

19.4 Transmittal to the International Bureau as Receiving Office

Where papers purporting to be an international application are filed with a national Office which acts as a receiving Office under the Treaty by an applicant who is a resident or national of a Contracting State, but that Office is not competent under Rule 19.1 or 19.2 to receive the purported international application,

(i) the national Office with which the papers were filed shall indelibly mark the date of actual receipt on the request of each copy received and, unless prescriptions concerning national security prevent the papers from being transmitted, shall promptly transmit them to the International Bureau,

(ii) the papers so transmitted shall be considered to have been received by the International Bureau under Rule 19.1(a)(iii) on the date of actual receipt by that national Office.

Ad Rule 35.3

1. It is proposed to create a mechanism for establishing which would be the competent International Searching Authorities in respect of international applications filed with the International Bureau as receiving Office under Rule 19.I(a)(iii). Proposed Rule 35.3 would prescribe the competent International Searching Authorities without the need for a declaration by the International Bureau as receiving Office (such a declaration is presently required from all receiving Offices under Rules 35.1 and 35.2).
2. Proposed Rule 35.3 is drafted in such a way as to reflect the present competence of International Searching Authorities in relation to residents and nationals of Contracting States, as specified in the respective agreements under Article 16(3)(b). However, the competence of an International Searching Authority in cases where the international application is filed with the International Bureau as receiving Office would be linked directly to the residence and nationality of the applicant instead of to the particular receiving Office with which the international application is filed. Thus, the International Bureau would, in such cases, be considered to be acting for the Contracting States for which the International Searching Authorities are prepared to act in accordance with the terms of the applicable agreement under Article 16(3)(b), and would be considered to have specified each International Searching Authority as competent for the searching of international applications filed with the International Bureau by residents and nationals of the Contracting States specified in the applicable agreement. Information as to which International Searching Authorities are competent for international applications filed with the International Bureau as receiving Office by residents and nationals of the various Contracting States would be published in the PCT Gazette and in Volume I of the PCT Applicant's Guide.
3. For the cases where the International Bureau acts as receiving Office instead of a national Office of a Contracting State pursuant to an agreement under Rule 19.1(b), the International Bureau would continue, as at present, to specify competent International Searching Authorities under Rules 35.1 and 35.2.

Rule 35

The Competent International Searching Authority

35.1 and 35.2 [No change]

35.3 *When the International Bureau Is Receiving Office Under Rule 19.1(a)(iii)*

(a) The International Bureau in its capacity as receiving Office under Rule 19.1(a)(iii) shall, for the purposes of any agreement referred to in Article 16(3)(b), be considered

(i) to be acting for those Contracting States for which the International Searching Authority is prepared to act in accordance with the terms of the agreement, and

(ii) to have specified the International Searching Authority as competent for the searching of international applications filed by residents and nationals of those States, and the International Bureau shall publish information accordingly.

(b) Where two or more International Searching Authorities are competent under paragraph (a), the choice shall be left to the applicant.

(c) Rules 35.1 and 35.2 shall not apply to the International Bureau as receiving Office under Rule 19.1(a)(iii).

Ad Rule 54.1

1. The changes to Rule 54.1 are proposed in the light of the changes proposed to Rules 18.1 and 18.2. In case of doubt as to a question of residence or nationality of the applicant, neither the International Preliminary Examining Authority nor, where the international application was filed with the International Bureau as receiving Office, the International Bureau would be in a position to decide such a question. It is therefore proposed that the national Office of, or acting for, the Contracting State concerned would decide the question, in the exceptional case where a doubt arises, if so requested by the International Preliminary Examining Authority (see proposed Rule 54.1(b)). In ordinary cases, the International Preliminary Examining Authority would accept what is indicated in the demand without looking behind such indications.

2. It should be noted that proposed Rule 54.1(b) would apply in the cases both where the International Bureau acts as receiving Office under Rule 19.1(a)(iii) and where it acts under Rule 19.1(b).

Ad Rule 54.3

1. The provision proposed as Rule 54.3 would be necessary in order to ensure that it is possible to satisfy the requirements of Article 31(2)(a) in cases where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii). Article 31(2)(a) requires, inter alia, that an applicant may make a demand for international preliminary examination only if the international application has been filed with the receiving Office of or acting for a Contracting State bound by Chapter II of the PCT. Proposed Rule 54.3 would provide that, where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), the International Bureau shall, for the purposes of Article 31(2)(a), be considered to be acting for the Contracting State of which the applicant is a resident or national.

Rule 54

The Applicant Entitled to Make a Demand

54.1 *Residence and Nationality*

(a) Subject to the provisions of paragraph (b), the residence or nationality of the applicant shall, for the purposes of Article 31(2), be determined according to Rule 18.1(a) and (b).

(b) The receiving Office or, where the international application was filed with the International Bureau as receiving Office, the national Office of, or acting for, the Contracting State concerned shall, if so requested by the International Preliminary Examining Authority, decide the question whether the applicant is a resident or national of the Contracting State of which he claims to be a resident or national.

54.2 [No change]

54.3 *International Applications Filed with the International Bureau as Receiving Office*

Where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), the International Bureau shall, for the purposes of Article 31(2)(a), be considered to be acting for the Contracting State of which the applicant is a resident or national.

54.4 [No change]

Ad Rule 59.1(b)

1. There would need to be a mechanism for establishing which are the competent International Preliminary Examining Authorities in cases where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii). Proposed Rule 59.1(b) would establish a mechanism similar to that proposed in relation to International Searching Authorities under proposed Rule 35.3, as explained in the notes relating to that proposed Rule. Thus, competence of an International Preliminary Examining Authority, in cases where the international application is filed with the International Bureau as receiving Office, would reflect the present competence of International Preliminary Examining Authorities in relation to residents and nationals of Contracting States, as specified in the respective agreements under Article 32(3). However, competence in such cases would be linked directly to the residence and nationality of the applicant instead of to the receiving Office with which the international application is filed. Information as to which International Preliminary Examining Authorities are competent for international applications filed with the International Bureau as receiving Office by residents and nationals of the various Contracting States would be published in the PCT Gazette and in Volume I of the PCT Applicant's Guide.

2. For the cases where the International Bureau acts as receiving Office instead of the national Office of a Contracting State pursuant to an agreement under Rule 19.1(b), the International Bureau would continue, as at present, to specify competent International Preliminary Examining Authorities under Rule 59.1(a).

Rule 59

The Competent International Preliminary Examining Authority

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

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

(b) Where the international application was filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), Rule 35.3(a) and (b) shall apply *mutatis mutandis*. Paragraph (a) of this Rule shall not apply to the International Bureau as receiving Office under Rule 19.1(a)(iii).

59.2 [No change]

Ad Rule 83.1bis

1. Proposed Rule 83.1bis(a) would accord the right to practice as agents before the International Bureau as receiving Office under Rule 19.1(a)(iii) to persons having the right to practice before the national Office of, or acting for, a Contracting State of which the applicant (or, if there are two or more applicants, any of the applicants) is a resident or national--that is, in effect, to persons who would have been entitled to represent the applicant if the international application had been filed with that national Office as a competent receiving Office. It should be noted that it is envisaged that the International Bureau, for the cases where it acts as receiving Office instead of the national Office of a Contracting State pursuant to an agreement under Rule 19.1(b), would continue, as at present, to specify who may be appointed as agent before it in relation to international applications filed with it in that capacity.
2. Proposed Rule 83.1bis(b) parallels Article 49. It would ensure that any person having the right to practice before the International Bureau when acting as receiving Office (under either Rule 19.1(a)(iii) or Rule 19.1(b)) can also represent the applicant before the International Searching Authority and the International Preliminary Examining Authority. Such a provision is necessary because Article 49 does not cover the case where the international application is filed with the International Bureau as receiving Office, since the International Bureau does not fall within the meaning of national Office as defined in Article 2(xii).
3. Although the International Bureau as receiving Office would not check systematically whether a person designated as agent in fact has the right to practice before a national Office, it would, in those exceptional cases where there is a doubt as to a person's right to practice, be able under the existing wording of Rule 83.2 to request the national Office concerned to inform it whether the person concerned has the right to practice.

Rule 83

Right to Practice before International Authorities

83.1 [No change]

83.1bis *Where the International Bureau Is the Receiving Office*

(a) Any person who has the right to practice before the national Office of, or acting for, a Contracting State of which the applicant or, if there are two or more applicants, any of the applicants is a resident or national shall be entitled to practice in respect of the international application before the International Bureau in its capacity as receiving Office under Rule 19.1(a)(iii).

(b) Any person having the right to practice before the International Bureau in its capacity as receiving Office in respect of an international application shall be entitled to practice before the International Bureau in any other capacity and before the competent International Searching Authority and competent International Preliminary Examining Authority in respect of that application.

83.2 [No change]

Ad Rule 90.1

1. The amendments proposed to Rule 90.1(a) and (d)(i) would enable the appointment as agents, in cases where the international application is filed with the International Bureau in its capacity as receiving Office (under either Rule 19.1(a)(iii) or Rule 19.1(b), of persons having the right to practice before the International Bureau in that capacity (see proposed Rule B3.1bis and the explanation in relation to that Rule).

Rule 90

Agents and Common Representatives

90.1 *Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before* the receiving Office, before the International Bureau and before the International Searching Authority and the International Preliminary Examining Authority.

(b) and (c) [No change]

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) [No change]

90.2 to 90.6 [No change]

* The amendment consists in deleting, before the words “the receiving Office”, the words “that Office acting as”.

Ad Rule 92.4(i)

1. In cases where international applications are filed by facsimile transmission with the International Bureau as receiving Office, they could receive different international filing dates simply by virtue of the fact that they are sent from different time zones from that prevailing in the place where the International Bureau is located (Geneva). Proposed Rule 92.4(i) would, in effect, enable an international application filed with the International Bureau as receiving Office by facsimile transmission to be accorded an international filing date as if it had been sent by facsimile transmission to the applicant's local receiving Office.

2. Proposed Rule 92.4(i) would provide for a document transmitted to the International Bureau by facsimile machine to be considered to have been received by the International Bureau on the date prevailing in the locality from which the document is transmitted if that date is earlier than the date prevailing in the locality of the International Bureau. The proposed Rule would cover the filing of the international application itself, since it is envisaged that the International Bureau would make the necessary notification under Rule 92.4 as to the filing by facsimile transmission of all kinds of documents covered by the Rule.

Rule 92 Correspondence

92.1 and 92.2 [No change]

92.3 [No change]

92.4 *Use of Telegraph, Teleprinter, Facsimile Machine, Etc.*

(a) to (h) [No change]

(i) Where a document is, pursuant to paragraph (a), transmitted by the applicant to the International Bureau by facsimile machine, the document shall be considered to have been received by the International Bureau on the date prevailing in the locality from which the document was transmitted if that date is earlier than the date prevailing in the locality of the International Bureau.

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