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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

**Sixth Session
Canberra, February 17 to 21, 1997**

**PROPOSED AMENDMENTS OF THE PCT REGULATIONS RELATING TO
INTERNATIONAL PRELIMINARY EXAMINATION: LATE FILING OF DEMAND;
FILING OF DEMAND WITH NON-COMPETENT AUTHORITY;
LATE PAYMENT FEE**

Proposal by the European Patent Office

1. In the context of matters relating to international preliminary examination, and following the proposals by the International Bureau outlined in document PCT/MIA/VI/5 relating to late filing of the demand and filing of the demand with a non-competent International Preliminary Examining Authority, the European Patent Office has made further proposals relating to proposed new PCT Rules 53*bis* and 59.3.
2. In addition, the European Patent Office has made a proposal for amendment of PCT Rules 57 and 58 relating to a late payment fee in case of late payment of the handling fee and the preliminary examination fee.
3. The Annex to this document contains the proposals by the European Patent Office.

[Annex follows]

ANNEX

Mr Philip Thomas
Director
PCT Legal Division
WIPO
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57.8MIA/VI

Dear Mr Thomas,

**Re: I. Late filing of a demand with a wrong IPEA
II. Filing of a demand with a wrong IPEA
III. Late payment fee**

I. The EPO in principle agrees to the proposed new Rule 53^{bis}. However, we would like to propose a few amendments:

From a practical point of view later elections are rather uncommon due to the pre-marked Box V of the demand form. Therefore, it seems unnecessary to include later elections in the new rule.

If "late later elections" were excluded from the new system it is proposed to make clear that it is the demand (including the election of all eligible states) which may be filed later. As to the additional fee it is suggested to have a higher penalty than the proposed second handling fee. The EPO therefore is in favour of asking for 50 % of the IPE fee in order to deter applicants using the new possibility frequently.

As to the proposed time limit of 21 month, only a one month delay should be permitted in order to have sufficient time for the IPER. Furthermore, the reference to Article 39 (1)(a) only concerns the time limit for entry into the national phase; what is needed however, is a reference to Rule 69.2(II) in order to avoid any pressure on the IPEA to complete the IPER within 28 month.

A draft amended Rule 53^{bis} is attached.

II. As to amended Rule 59.3 the EPO agrees with the principle of the proposal. However, the date of receipt marked on the demand should not be decisive with respect to the time limit for establishing the IPER (R. 69.2 (I)) because it might well be that an

IPEA retains the demand for a longer period before sending it to the IB where it takes additional time before it will reach the competent IPEA. Time then could be too short to comply with the said time limit..

Therefore, the EPO proposal is to take the date of receipt at the competent IPEA as the start of the international preliminary examination and make R. 69.2(II) applicable.

III. As distinct from Rule 16^{bis} in relation to Rule 15.4(a) late payment fees are not foreseen with respect to the preliminary examination fee. That is why some applicants abuse the system as it stands by waiting to be invited to pay said fees.

Therefore, it is proposed to introduce a possibility for such sanction by inserting into Rule 57.3 the same time of payment as under Rule 15.4(a), referring to said time under an amended Rule 58.1(b) and amending Rule 58.2 (see draft in the annex).

I would be grateful if you could include these issues for discussion at the forthcoming MIA.

With my best regards



York Busse

Principal Administrator
International Legal Affairs

EPO proposal for amending draft Rule 53.1^{bis}

Rule 53^{bis} Late Filed Demand

53^{bis}.1 Demand Filed after the Expiration of 19 Months from the Priority Date

(a) Where the demand is filed after the expiration of 19 months from the priority date but before the expiration of 20 months from that date, the International Preliminary Examining Authority shall inform the applicant accordingly and shall invite him to pay an additional fee in accordance with paragraph (b) within one month from the date of the invitation. If the additional fee is paid within that time limit, the demand shall be considered, for the purpose of Article 39 (1)(a), as if it had been filed before the expiry of 19 months from the priority date. Rule 69.2(II) shall apply.

(b) The amount of the additional fee shall be 50% of the [handling and the] preliminary examination fee and shall be paid to the International Preliminary Examining Authority for its benefit.

EPO proposal for a late payment fee - R. 57 and R. 58

Rule 57 The Handling Fee

[57.1 to 57.2 no change]

57.3 Time and Mode of Payment

(a) The handling fee shall be ~~due at the time~~ paid within one month from the date of receipt of the demand is submitted.

57.4 Failure to Pay

(a) Where the handling fee is not paid as required, the International Preliminary Examining Authority shall invite the applicant to pay the that fee together with any late payment fee required under paragraph (d) within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the one-month time limit, the handling fee shall be considered as if it had been paid on the due date within the time limit under Rule 57.3(a).

[(c) no change]

(d) The amount of the late payment fee shall be 50% of the handling fee and shall be paid to the International Preliminary Examining Authority for its own benefit.

[57.5 - 6 no change]

Rule 58
The Preliminary Examination Fee

[58.1(a) no change]

(b) The amount and the due date of the preliminary examination fee, if any, shall be fixed by the International Preliminary Examining Authority, provided that the said due date shall not be earlier than the due date of the handling fee. As to the time of payment [of said fee], Rule 57.3(a) shall apply.

[58.1(c) no change]

58.2 Failure to Pay

(a) Where the preliminary examination fee fixed by the International Preliminary Examining Authority under Rule 58.1(b) is not paid as required under that Rule 58.1(b), the International Preliminary Examining Authority shall invite the applicant to pay the fee or the missing part thereof within one month from the date of the invitation together with any late payment fee required under Rule 58.2(d).

(b) If the applicant complies with the invitation within the prescribed one-month time limit, the preliminary examination fee will shall be considered as if it had been paid on the due date within the time limit under Rule 58.1(b).

[58.2 (c) no change]

(d) Where an International Preliminary Examining Authority issues an invitation under Rule 58.2(a) it may require a late payment fee from the applicant, equivalent to 50 % of the amount of the preliminary examination fee as specified in the invitation.

[58.3 no change]