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COMMITTEE ON REFORM  
OF THE PATENT COOPERATION TREATY (PCT)

Second Session  
Geneva, July 1 to 5, 2002

ENHANCED INTERNATIONAL SEARCH AND  
PRELIMINARY EXAMINATION SYSTEM

*Document prepared by the International Bureau*

## INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.<sup>1</sup>

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<sup>1</sup> Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

*Improved coordination of international search and international preliminary examination and time limit for entering the national phase: expanded international search system*

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT<sup>2</sup> relating, as recommended by the Committee, to an improved coordination of international search and international preliminary examination and time limit for entering the national phase (expanded international search system) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 69).
4. There was wide agreement at the first session of the Working Group on the general approach to be taken (see document PCT/R/WG/1/9, paragraphs 7 to 10). As stated in paragraph 8:

“The general concept of the proposed EISR [expanded international search system] attracted great interest and considerable support, subject to certain comments and concerns mentioned below. As a basic consideration, it was necessary to meet the needs of certain DOs [designated Offices] and EOs [elected Offices], particularly small and medium-sized Offices, including those in developing countries, for examiners’ opinions, especially in view of the recent adoption by the Assembly of a 30-month time limit for entering the national phase under Article 22. ... .”

The Working Group further agreed at its first session (see document PCT/R/WG/1/9, paragraph 10):

“that the International Bureau should prepare a revised proposal, along the lines of the system outlined in the following subparagraphs [subparagraphs 10(a) to (p) of document PCT/R/WG/1/9], for consideration by the Working Group at its next session.”

5. At its second session, the Working Group considered revised proposals for an expanded international search system. The discussion by the Working Group is outlined in the summary of the session (see document PCT/R/WG/2/12, paragraphs 31 to 49):

“31. Discussions were based on documents PCT/R/WG/2/1, 1 Add.1, 9, 9 Corr., 10 and 11, particularly focusing on document PCT/R/WG/2/9, submitted by the United States of America, which proposed a simplified approach.

“32. It was agreed that the proposed amendments of the Regulations set out in the documents should be further revised, taking into account the matters mentioned in the following paragraphs:

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<sup>2</sup> References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO’s Web site at [http://www.wipo.int/pct/en/access/legal\\_text.htm](http://www.wipo.int/pct/en/access/legal_text.htm)). References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Web site at [http://www.wipo.int/eng/document/pt\\_dc/index.htm](http://www.wipo.int/eng/document/pt_dc/index.htm)).

“33. While a more extensive combination of the international search and international preliminary examination procedures would be considered in the context of long-term reform of the PCT, the separate procedures under Chapters I and II of the Treaty would be retained in the context of amending the Regulations to introduce the proposed expanded international search (EIS) system. The international preliminary examination procedure under Chapter II should continue to be initiated by the filing of a demand. The existing possibility for International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) to combine the procedures under Rule 69.1(b) would be retained.

“34. Since all ISAs would be responsible for preparing international search opinions (ISOs) which were analogous in their content to international preliminary examination reports (IPERs), the Regulations should ensure that the qualifications for appointment of an ISA include all of those which apply for appointment of an IPEA.

“35. If the applicant did not file a demand for international preliminary examination, the ISO would be re-issued as a report as part of the Chapter I procedure. The title of the report remained to be decided. Possibilities mentioned (but not agreed) during the session included: “international preliminary examination report” used in such a way as to distinguish the reports under Chapters I and II, “international initial examination report,” “international search examination report,” “international report on patentability” and “international advisory report.” Further suggestions would be welcomed by the Secretariat.

“36. Under the Chapter I procedure, the ISO would remain confidential until the report mentioned in the previous paragraph was communicated to designated Offices by the International Bureau, with the international application, 30 months from the priority date, unless the applicant expressly requested early entry into the national phase under Article 23(2) before a designated Office, in which case the report would be transmitted to that Office. The communication of international applications at the expiration of the applicable time limit under Article 22 to designated Offices of States which had made transitional reservations in connection with the modified time limit under that Article would not include the report, but the report would be sent to such Offices at the same time it was sent to Offices which had not made reservations. Once the report had been communicated, it would also be made publicly available by the International Bureau.

“37. No special provisions would be included in the Regulations for the applicant to comment on the ISO. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent to designated Offices by the International Bureau and made publicly available, as would be the report resulting from the ISO. Designated Offices would be free to require a translation of such comments. Under the Chapter II procedure, any response to the ISO would need to be submitted to the IPEA under Article 34 as part of the international preliminary examination procedure.

“38. It was not necessary to require that the same Office act as both ISA and IPEA, noting that any IPEA could, under the existing system, restrict its competence to applications in respect of which the international search had been carried out by the same Office acting as ISA.

“39. In accordance with the view of the majority of those delegations which expressed views on the matter, the ISO would, for the purposes of the international preliminary examination procedure, be considered to be the first written opinion in that procedure, on the understanding that this did not imply that the IPEA would be bound by the conclusions contained in the ISO. However, any IPEA would be entitled to inform the International Bureau that ISOs which had not been prepared by the same Office in the capacity of ISA would not be considered to be first written opinion in relation to the procedure before that IPEA; such an IPEA would then have to issue a first written opinion after receiving the demand, although that opinion could, of course, incorporate part or all of the content of the ISO.

“40. The time limit for submitting a demand for international preliminary examination would be three months after the issuance of the ISO or 22 months from the priority date, whichever was later, and the time limit for paying the necessary fees would need to be adjusted accordingly. During the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, the demand would have to be filed within 19 months from the priority date if the applicant wished to have 30 months in which to enter the national phase in those countries.

“41. Any arguments and/or amendments in response to the ISO would also have to be submitted within three months after the issuance of the ISO or 22 months from the priority date, whichever was later, if they were to be taken into account by the IPEA, failing which the IPEA would be free to proceed straight to the issuance of the international preliminary examination report, without issuing any further notification to the applicant. That time limit would apply even where the demand had been filed earlier.

“42. Several non-governmental organizations representing users of the PCT system proposed that the applicant should be guaranteed a second written opinion after filing a demand (that is, in addition to the ISO which was considered to be the first written opinion). That proposal did not find support among delegations, but it was noted that the International Preliminary Examination Guidelines, which the IPEAs were obliged to apply and observe, provide for the issuance of a further opinion where the applicant made a serious attempt to respond to a (first) written opinion.

“43. The ISO (or an accompanying form) should outline to the applicant the available options and consequences in terms of filing a demand, particularly if the same Office were not to act as both ISA and IPEA (see paragraph 39, above), time limits, responding to the matters raised in the ISO under Chapter I (by way of submitting informal comments) or Chapter II (by way of filing a demand and Article 34 arguments or amendments), etc.

“44. No change would be proposed, at least for the time being, to the time limit for the preparation of the international search report (international search report). The Delegation of the United States of America urged consideration of a relaxed time limit for the preparation of the international search report.

“45. The EIS system needed to operate simply and safely during the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, as well as in the future.

“46. Provision would be made for the International Bureau to make reports resulting under Chapter I from the ISO publicly available, together with any informal comments received, and to make IPERs publicly available on behalf of elected Offices which so request.

“47. The scope of the relevant prior art to be considered in the preparation of both the international search report and the ISO, and the basis on which prior art was cited, including the date to which the search should be carried out, would correspond to the international preliminary examination procedure.

“48. If for any reason the applicant filed a demand but the international application or the demand was subsequently withdrawn with the result that an international preliminary examination report was not issued, the report resulting from the ISO would be available to the elected Offices. That is, either an international preliminary examination report or the report resulting from the ISO would always be available to Offices in the national phase.

“49. A number of drafting points were noted by the Secretariat and would be taken into account in the preparation of revised proposals.”

6. Revised proposals for amendment of the Regulations designed to implement an enhanced international search and preliminary examination system are set out in the Annex. They take into account the comments and concerns expressed by various delegations during the discussions on this matter in the first and second sessions of the Working Group, and the areas where agreement has been reached.

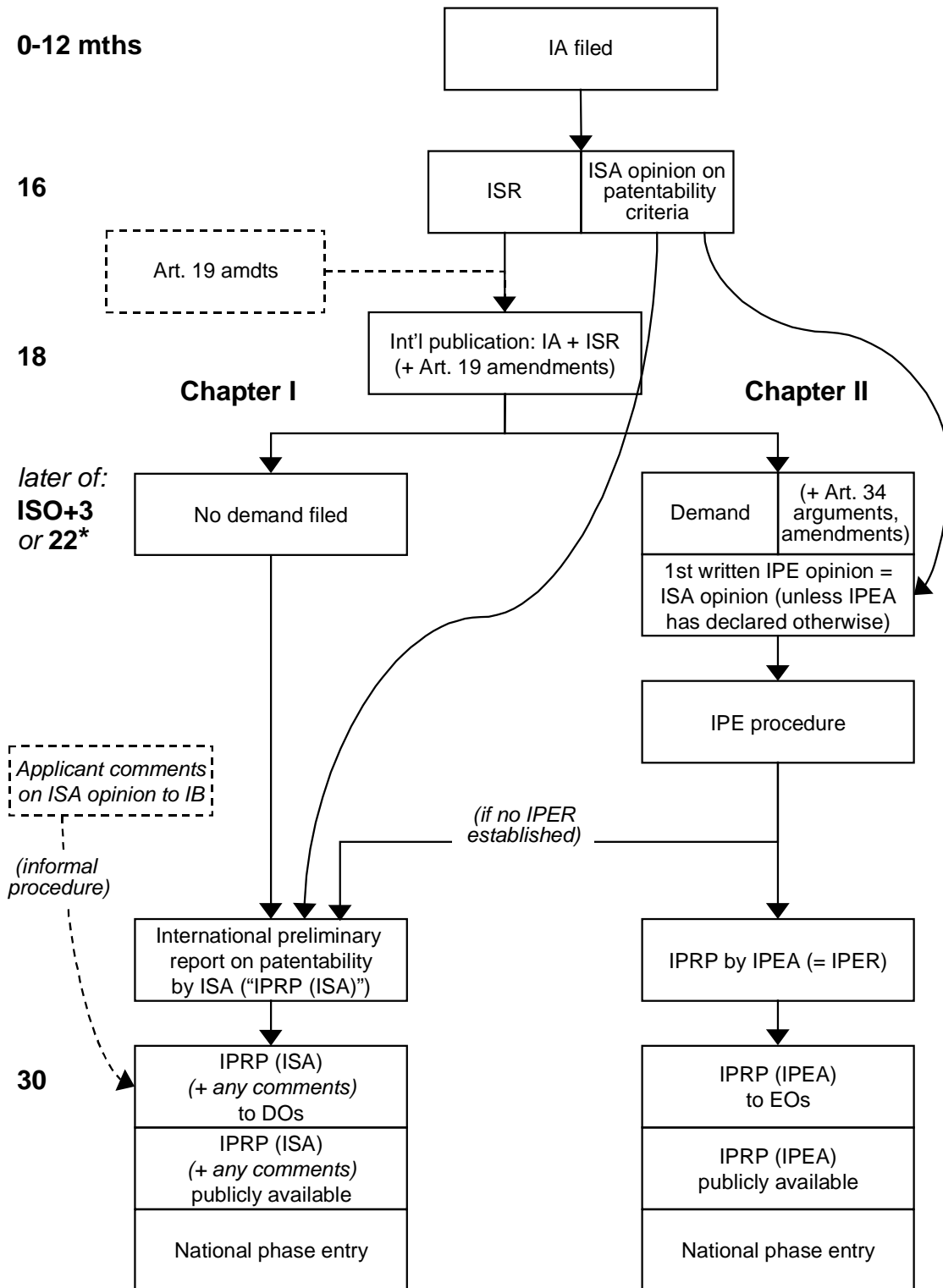
## ENHANCED INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION SYSTEM

### *Overview*

7. The flow chart on the following page illustrates the main features of the proposed enhanced international search and preliminary examination system.

8. During the discussions in the Working Group on how to improve coordination of international search (Chapter I of the Treaty) and international preliminary examination (Chapter II of the Treaty), it has been recognized that a possible merger of the procedures under Chapters I and II would only be considered in the context of long-term reform of the PCT (see document PCT/R/WG/2/12, paragraph 33). While the separate procedures under Chapters I and II would be retained, the proposed enhanced international search and preliminary examination system may be seen as an important first step towards a more extensive rationalization of the international search and international preliminary examination procedures, with a view ultimately to achieving greater convergence of the international and national procedures. The present proposals therefore strive, so far as possible, to bring the procedures under Chapters I and II into line.

## Enhanced International Search and Preliminary Examination System



9. The main feature of the proposed new system is that one of the main elements of the present Chapter II procedure, namely, the establishment of an examiner's opinion, would in effect be advanced and incorporated into the Chapter I procedure. Under the new system, the International Searching Authority (ISA) would be responsible for establishing a preliminary and non-binding written opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. That written opinion of the ISA would be used for the purposes both of Chapter I and, if the applicant files a demand for international preliminary examination, of Chapter II, thus combining the international search and international preliminary examination procedures to a much greater extent than is the case at present.

10. Under Chapter I of the Treaty (that is, if no demand for international preliminary examination is made), the written opinion of the ISA would form the basis for the establishment by the International Bureau, on behalf of the ISA, of an "international preliminary report on patentability" (IPRP) to be communicated to all designated Offices and to be made available for public inspection after the expiration of 30 months from the priority date.

11. In the designated Offices, following the entry into the national phase of an international application under Chapter I of the Treaty, the proposed IPRP by the ISA would meet the need for an "examiner's opinion," of particular importance for small and medium-sized Offices, including those in developing countries, following the recent adoption by the Assembly of a 30-month time limit for entering the national phase under Article 22. Following the adoption of that changed time limit, there is the expectation that many applicants will not opt to request the international preliminary examination procedure under Chapter II of the PCT, with the result that many international applications will enter the national phase with an international search report but without any examiner's opinion.

12. The proposed IPRP by the ISA would fill that gap. The report would be equivalent to an international preliminary examination report which is established on the basis of a written opinion to which the applicant never responded, noting that, in such a case, it is the practice of International Preliminary Examining Authorities (IPEAs) to simply "convert" the written opinion into an international preliminary examination report. For the purposes of national phase processing, the IPRP by the ISA should carry the same weight as such an international preliminary examination report.

13. Under Chapter II, that is, if a demand for international preliminary examination is made, the written opinion of the ISA would, unless the IPEA specifically opts otherwise, take the place of the first written opinion established, under the present system, by the IPEA during the international preliminary examination procedure. International preliminary examination would be carried out on the basis of the international search report and the written opinion of the ISA, and would be concluded with the international preliminary examination report which, in order to stress the similarities between the report established under Chapter I and that established under Chapter II, is also proposed to bear the title "international preliminary report on patentability."

14. The main distinction between the IPRP by the ISA under Chapter I and the IPRP by the IPEA under Chapter II would be that the former would be established on the basis of the international application as filed whereas the latter would be established following a dialogue between the applicant and the examiner, often on the basis of the international application as

amended, under Article 34, in response to the international search report and the written opinion of the ISA.

15. Further details of the proposed procedure are outlined in the following paragraphs.

*Procedure under Chapter I*

16. *Establishment of written opinion by ISA.* With regard to every international application, the ISA would establish, at the same time that it establishes the international search report, a written opinion as to whether the international application complies with certain requirements, which would correspond directly to the matters referred to in Article 34(2)(c), that is: (i) whether the invention satisfies the criteria of novelty, inventive step and industrial applicability; and (ii) whether the international application complies with the requirements of the Treaty and the Regulations (so far as checked by the ISA). The written opinion of the ISA would also contain any other observations corresponding to those referred to in Article 35(2), last sentence. In other words, the scope of the ISA's written opinion would be similar to the written opinion established by the IPEA during international preliminary examination.

17. The relevant date for determining prior art for the purposes of establishing the written opinion would be the international filing date or, where priority of an earlier application is claimed, the priority date, as is the case for the establishment of the international preliminary examination report. Although the Working Group suggested that "[t]he scope of the relevant prior art to be considered in the preparation of both the international search report and the ISO [international search opinion], and the basis on which prior art was cited, including the date to which the search should be carried out, would correspond to the international preliminary examination procedure" (see document PCT/R/WG/2/12, paragraph 47), it is proposed upon further reflection, for the safeguard of the applicant, that the *international search* should continue to take into account prior art up to the international filing date, even if the international application claims the priority of an earlier application, and to apply the same prior art criteria as for international preliminary examination only to the establishment of the *written opinion* established by the ISA. That approach would put the written opinion of the ISA on equal footing with the written opinion of the IPEA, and should not pose any problems for examiners who are already used to taking different "relevant dates" into account for determining prior art for international search and international preliminary examination purposes.

18. The time limit for the ISA to establish the written opinion would be the same as that currently applicable for the international search report (see Rule 42.1), that is, three months from the date of receipt by the ISA of the search copy or nine months from the priority date, whichever time limit expires later. The written opinion of the ISA would be established in the language in which the international search report is established, and would be communicated, together with the international search report, to the applicant and to the International Bureau.

19. *Options for the applicant.* After having received the international search report and the written opinion of the ISA, the applicant would have a choice of the following options to pursue:

- (i) submit to the International Bureau (informal) comments on the written opinion of the ISA (see paragraphs 20 and 21, below); and/or



- (ii) submit to the International Bureau amendments of the claims under Article 19(1) (see paragraph 22, below); and/or
- (iii) request international preliminary examination (see paragraphs 30 to 39, below);

and, in addition, the applicant would always have the following options:

- (iv) withdraw the international application under Rule 90*bis*.1; or
- (v) not take any action.

20. *Informal comments on the written opinion of the ISA.* No special provisions would be included in the Regulations for the applicant to comment on the written opinion of the ISA. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent by the International Bureau to all designated Offices and made publicly available, as would be the report resulting from the written opinion of the ISA (see paragraph 26, below). Designated Offices would be free to require a translation of such comments. Any formal response to the written opinion of the ISA would need to be submitted to the IPEA under Article 34 as part of the procedure under Chapter II, that is, by requesting international preliminary examination.

21. The main purpose of allowing for informal comments to be submitted would be to give the applicant an opportunity to rebut the written opinion of the ISA in the event that international preliminary examination is not requested, noting that the written opinion of the ISA will be “converted” to an IPRP, communicated to the designated Offices and made available for public inspection (see paragraphs 26 and 29, below).

22. *Amendments of the claims under Article 19.* As at present, after the receipt of the international search report and of the written opinion of the ISA (or the declaration under Article 17.2(a)), the applicant would have the opportunity under Article 19 to amend the claims (only), within the time limit under present Rule 46.1, in particular with a view to international publication (in which the Article 19 amendments are included) and any provisional protection the applicant may enjoy under national law. There would be no reason why such amendments (to the claims only, of course) under Article 19 could not respond to matters raised in the written opinion of the ISA.

23. *International publication.* Unless the applicant withdraws the international application, the international application would, as at present, be published promptly after the expiration of 18 months from the priority date, together with the international search report and any Article 19 amendments of the claims, but without the written opinion of the ISA or any comments thereon furnished informally by the applicant. Both the written opinion of the ISA and any such comments thereon would remain confidential until a later date (see paragraphs 28 and 29, below).

24. *International preliminary report on patentability.* If no demand for international preliminary examination is made (and thus no international preliminary examination report is to be established), the International Bureau would establish, on behalf of the ISA, an IPRP with the same content as the written opinion of the ISA. That procedure would correspond to the present procedure during international preliminary examination under which the IPEA issues a written opinion which, if the applicant does not respond, is “converted” by the IPEA

into an international preliminary examination report. An IPRP by the ISA should thus carry the same weight for national phase purposes as an international preliminary examination report established at present in that way (see paragraph 12, above).

25. The proposed title “international preliminary report on patentability” would not be in conflict with Article 35(2). The report would not “contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable *according to any national law*” (emphasis added); rather, the report would be limited to a statement, in relation to each claim, whether the claimed appears to satisfy the criteria of novelty, inventive step and industrial applicability as defined for the purposes of the international phase under the PCT (see Article 33 and Rules 64 and 65).

26. *Communication to designated Offices.* The International Bureau would communicate the IPRP by the ISA and any (informal) comments on the written opinion of the ISA furnished by the applicant to all designated Offices, but not before the expiration of 30 months from the priority date (see paragraphs 28 and 29, below). Where the applicant makes an express request for early national phase entry before a designated Office before the expiration of 30 months from the priority date, the International Bureau would, if the IPRP has not yet been established, communicate a copy of the written opinion by the ISA to that Office (the content of which would, of course be identical to the subsequently produced IPRP).

27. *Translation of IPRP.* As for an international preliminary examination report at present, the IPRP by the ISA, when communicated to the any designated Office, if not in English, would, if requested by that Office, be accompanied by a translation into English prepared by or under the responsibility of the International Bureau. The applicant would have an opportunity to submit observations on the translation. As is the case for international preliminary examination reports, an IPRP in English or translated into English would have to be accepted by all designated Offices for the purposes of national phase processing, and no designated Office would be entitled to require the applicant to furnish a translation of the IPRP into any other language.

28. *Confidentiality of written opinion, IPRP, translation and comments.* As indicated above, the written opinion of the ISA, the IPRP by the ISA, any translation thereof and any comments on the written opinion of the ISA submitted by the applicant would remain confidential as against third parties and designated Offices until 30 months from the priority date, corresponding to the time at which the file of the international preliminary examination presently becomes available for public inspection (via the elected Offices).

29. After the expiration of 30 months from the priority date, the IPRP by the ISA, any translation into English thereof and any comments on the written opinion of the ISA submitted by the applicant would be communicated to all designated Offices. At the same time, the written opinion of the ISA, the IPRP, any translation into English thereof and any comments on the written opinion of the ISA submitted by the applicant would be made available for public inspection by the International Bureau. Public inspection would be possible even where a demand for international preliminary examination has been made, noting that third parties would, in any case, get access to those documents, once the international preliminary examination report has been established, via elected Offices.

*Procedure under Chapter II*

30. *Demand for international preliminary examination.* The international preliminary examination procedure under Chapter II would continue to be initiated by the filing of a demand. The existing possibility for ISAs and IPEAs to combine the procedures under Rule 69.1(b) would be retained.

31. The time limit for making a demand for international preliminary examination would be three months after the issuance of the international search report and the written opinion of the ISA or of the declaration under Article 17.2(a), or 22 months from the priority date, whichever is later. Any demand made after the expiration of the applicable time limit would be considered as if it had not been submitted and the IPEA would so declare. During the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 are still in force, the demand would have to be filed within 19 months from the priority date if the applicant wished to have 30 months in which to enter the national phase in those countries.

32. *International preliminary examination procedure.* As at present, if the applicant files a demand for international preliminary examination, the further processing of the international application would be governed by Chapter II.

33. Upon receipt of a demand or a copy thereof from the IPEA, the International Bureau would transmit to the IPEA copies of the written opinion of the ISA (unless the same Office is acting as both ISA and IPEA). Any comments on the written opinion of the ISA submitted (informally) by the applicant to the International Bureau (see paragraph 20 and 21, above) would not be communicated to the IPEA; rather, any response to the written opinion of the ISA would need to be submitted by the applicant to the IPEA under Article 34 as part of the international preliminary examination procedure.

34. Upon the request of the IPEA, where the written opinion of the ISA is not in English or in a language accepted by the IPEA, a translation into English of the written opinion of the ISA would be prepared by the International Bureau and transmitted to the IPEA within two months following the request for translation. All IPEAs would be required to accept such written opinions established in or translated by the International Bureau into English.

35. *Written opinion of ISA considered to be written opinion for the purposes of international preliminary examination.* In general, the written opinion of the ISA would be considered to be a written opinion for the purposes of international preliminary examination (see paragraph 37, below, with regard to the exception from this general rule). Any arguments and/or amendments in response to the written opinion of the ISA would have to be submitted within the same time limit as the time limit for making the demand, that is, three months after the issuance of the written opinion of the ISA or 22 months from the priority date, whichever was later, if they are to be taken into account by the IPEA, failing which the IPEA would be free to proceed straight to the issuance of the international preliminary examination report without issuing any further notification to the applicant. That time limit would apply even where the demand had been filed earlier. Indications informing the applicant that, if a demand for international preliminary examination is made, the written opinion of the ISA will be considered to be a written opinion of the IPEA (except in the case outlined in paragraph 37, below) and an invitation to submit, within the applicable time limit, a written reply together, where appropriate, with amendments, would be included in the written opinion of the ISA submitted to the applicant.

36. The IPEA would not be obliged to issue a further written opinion, in addition to the written opinion of the ISA, before establishing the international preliminary examination report. However, if the applicant makes a serious attempt to meet the (search) examiner's objections by submitting, within the applicable time limit, arguments and/or amendments in response to the written opinion of the ISA, the International Preliminary Examination Guidelines, which the IPEAs are obliged to apply and observe in corresponding cases at present, require that "if there are still objections that require to be met, the examiner must consider, subject to sufficient time being available having regard to the time limit for the establishment of the international preliminary examination report ... whether they could best be resolved by a further written opinion, a telephone discussion or an interview."

37. *IPEA may decide not to accept written opinions of other ISAs for the purposes of international preliminary examination.* While, in general, the written opinion of the ISA would be considered to be a written opinion for the purposes of international preliminary examination, any IPEA would be entitled to inform the International Bureau that a written opinion of the ISA which had not been prepared by the same Office in its capacity as an ISA would not be considered to be first written opinion in relation to the procedure before that IPEA. Such an IPEA would be obliged to notify the applicant accordingly, and the normal international preliminary examination procedure (as at present) would apply, although the IPEA would in any event be obliged to take the content of the written opinion of the ISA into account. As at present, the applicant would be entitled to receive one written opinion from the IPEA (in addition to the written opinion of the ISA), with the opportunity to submit arguments and/or amendments under Article 34.

38. *International preliminary report on patentability.* In the context of introducing the enhanced international search and preliminary examination system, it is proposed to entitle the international preliminary examination report as an "international preliminary report on patentability" so as to stress the similarities between the report established under Chapter I and that established under Chapter II. As explained in paragraph 25, above, this proposed title would not be in conflict with Article 35(2).

39. *Communication of IPRP to elected Offices.* The IPRP by the IPEA would be established within the applicable time limit under Rule 69 (that is, usually within 28 months from the priority date) and communicated by the IPEA to the applicant and to the International Bureau. As is the case for the communication to all designated Offices of the IPRP by the ISA, the International Bureau would communicate the IPRP by the IPEA to all elected Offices, but not before the expiration of 30 months from the priority date. Where the applicant makes an express request for early national phase entry before an elected Office before the expiration of 30 months from the priority date, the International Bureau would if the international preliminary examination report has not yet been established, communicate a copy of the written opinion by the ISA to that Office.

#### *Guidelines for international search and preliminary examination*

40. If the proposed enhanced system is adopted, the PCT International Search Guidelines and PCT International Preliminary Examination Guidelines would have to be modified accordingly, with a view to implementing the amendments of the Regulations proposed in the Annex to this document and to merging both Guidelines into a single set of Guidelines addressed to the International Searching and Preliminary Examining Authorities, which would be responsible, in future, for conducting the international search and international preliminary examination in a more coordinated way than at present.

*National phase processing*

41. *Communication of IPRP to designated and elected Offices.* In general, national phase processing before any designated or elected Office would not change as compared to today's situation. Any designated or elected Office would receive from the International Bureau, promptly after the expiration of 30 months from the priority date, a copy of an IPRP, established by either the ISA or the IPEA, as applicable, together with, if necessary, a translation into English, and a copy of any comments submitted informally to the International Bureau by the applicant on the written opinion of the ISA. The content of the file of the international preliminary examination, which would include the written opinion of the ISA, would be available to any elected Office from the IPEA (see present Rule 94.2).

42. *Public inspection (Chapter I).* A copy of the written opinion of the ISA and of any comments thereon submitted informally by the applicant to the International Bureau, of the IPRP by the ISA and any translation thereof into English, and of any observations on the translation submitted by the applicant, would be made available, after the expiration of 30 months from the priority date, to any person as part of the file held by the International Bureau (see present Rule 94.1).

43. *Public inspection (Chapter II).* As at present, access by third parties to the international preliminary examination report (and other parts of the file of the IPEA) would be available via any elected Office whose national law provides for such access (see present Rule 94.3). In the context of introducing the enhanced international search and preliminary examination system, it is now proposed to amend Rule 94.3 to provide for the International Bureau to make the international preliminary examination report available on behalf of any elected Office which so requests.

*Demand filed at the same time as the filing of the international application*

44. In the context of introducing the enhanced international search and preliminary examination system, it is proposed to enable the applicant to submit the demand at the same time as the filing of the international application or at any time thereafter prior to the expiration of the time limit for filing the demand (see paragraph 30, above). In order to enable the applicant to do so, it is proposed to postpone the due date for the payment of the handling fee and the preliminary examination fee (at present, one month from the date of filing of the demand) and to provide that those fees only fall due within one month from the date of filing of the demand or 22 months from the priority date, whichever expires later (see, however, paragraph 45, below), with the same invitation procedure and further extension of the time limit for payment as applies at present if the fees are not paid (in full). Of course, international preliminary examination procedures would only start if the applicant pays in full, within the applicable time limit, the amount due for the handling fee and the preliminary examination fee, including, where applicable, a late payment fee.

45. As an exception to the general rule that the handling fee and the preliminary examination fee fall due within one month from the date of filing of the demand or 22 months from the priority date, whichever expires later (see paragraph 44, above), it is proposed to set an earlier due date for the payment of those fees where the IPEA is part of the same national Office or intergovernmental organization as the ISA and wishes to start the international preliminary examination at the same time as the international search. In such a case, the IPEA would be required to invite the applicant to pay those fees within one month from the

date of the invitation. Otherwise, no special provision has been included at this stage which would introduce new possibilities for a combination of international search and international preliminary examination, beyond what is envisaged in present Rule 69.1(b); present Rule 69.1(b) appears sufficient to enable an IPEA to start the international preliminary examination at the same time as the international search.

*46. The Committee is invited to consider the proposals contained in the Annex.*

[Annex follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>1</sup>ENHANCED INTERNATIONAL SEARCH AND  
PRELIMINARY EXAMINATION SYSTEM

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**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) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

[COMMENT: Rule 36.1 is proposed to be amended so to ensure that the qualifications for appointment of an ISA (in charge of establishing the written opinion established under Chapter I) include all of those which apply for appointment of an IPEA (see Rule 63.1) (see document PCT/R/WG/2/12, paragraph 34). Rule 63.1 is also proposed to be amended accordingly (see below).]

**Rule 43bis**

**Written Opinion of the International Searching Authority**

43bis.1 Written Opinion

(a) Subject to Rule 69.1(b-bis), the International Searching Authority shall, at the same time as it establishes the international search report, establish a written opinion as to:

(i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;

(ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

[COMMENT: See paragraph 16 in the Introduction to this document. The scope of the written opinion of the ISA would be similar to the present written opinion established as part of the international preliminary examination procedure. Proposed new Rule 43bis.1 has been made subject to proposed new Rule 69.1(b-bis) (see below): where the national Office or intergovernmental organization that acts as ISA is also acting as IPEA and wishes, in accordance with Rule 69.1(b), to carry out international preliminary examination at the same time as international search, and considers that all the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization Author need not, in its capacity as ISA, establish a written opinion under Rule 43bis.1 but may proceed to issue the international search report and the (positive) international preliminary examination report.]

[Rule 43bis.1, continued]

(b) For the purposes of establishing the written opinion, Article 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.2(a), (b) and (c), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

[COMMENT: As regards the relevant date for determining prior art, note that, for the purposes of establishing the written opinion of the ISA, reference is made to Rule 64 rather than to Rule 33 (see paragraph 17 of the Introduction to this document). As regards the list of Articles and Rules to be applied *mutatis mutandis*, while the scope and contents of the written opinion of the ISA would be similar to the present first written opinion in the international preliminary examination procedure, it appears more appropriate to refer to the corresponding provisions concerning the international preliminary examination report rather than to the provisions concerning the written opinion under Chapter II, since the written opinion of the ISA, as a document to be sent to the applicant separate from the international search report, appears to be, from a formal point of view, closer to an international preliminary examination report-style “report” than to a written notification containing certain negative statements as listed in Rule 66.2. This also would appear to reflect the current practice under which the IPEAs send out, as the written opinion, a first draft of the international preliminary examination report which contains more information than is required under Rule 66.2 (for example, not only a negative statement as referred to in Rule 66.2(a)(ii) but a full statement similar to the full international preliminary examination report as referred to in Rule 70.6).]

(c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under Rule 66.1bis(a) but subject to Rule 66.1bis(b), be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a), in which case the applicant is invited to submit to that Authority, with the demand or in any event before the expiration of the time limit under Rule 54bis.1(a), a written reply together, where appropriate, with amendments.

[COMMENT: See paragraphs 35 and 36 of the Introduction to this document. A notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion of the ISA will be considered to be a written opinion of the IPEA (except where the IPEA has made a declaration under Rule 66.1bis(b), see below) and an invitation to submit, within the applicable time limit, a written reply together, where appropriate, with amendments, would be included in the written opinion of the ISA submitted to the applicant.]

**Rule 44**

**Transmittal of the International Search Report, Written Opinion, Etc.**

44.1 *Copies of Report or Declaration and Written Opinion*

The International Searching Authority shall, on the same day, transmit one copy of the international search report and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a), to the International Bureau and one copy to the applicant.

[COMMENT: See paragraph 18 of the Introduction to this document.]

44.2 and 44.3 [No change]

**Rule 44bis**

**International Preliminary Report on Patentability by  
the International Searching Authority**

44bis.1 Establishment of Report

(a) Unless an international preliminary examination report has been or is to be established, the International Bureau shall establish a report on behalf of the International Searching Authority (in this Rule referred to as “the report”) as to the matters referred to in Rule 43bis.1(a)(i) to (iii). The report shall have the same contents as the written opinion established under Rule 43bis.1.

(b) The report shall bear the title “international preliminary report on patentability” together with an indication that it is established under this Rule by the International Searching Authority.

[COMMENT: See paragraphs 24 and 25 of the Introduction to this document.]

44bis.2 Communication to Designated Offices

(a) Where a report has been established under Rule 44bis.1, the International Bureau shall communicate it to each designated Office in accordance with Rule 93bis.1 but not before the expiration of 30 months from the priority date.

[COMMENT: See paragraph 26 of the Introduction to this document.]

(b) Where the applicant makes an express request to a designated Office under Article 23(2), the International Bureau shall communicate a copy of the written opinion established by the International Searching Authority under Rule 43bis.1 to that Office promptly upon the request of that Office or of the applicant.

[COMMENT: While, in “normal” cases, the IPRP by the ISA is communicated to any designated Office not before the expiration of 30 months from the priority date, where the applicant makes a request for early national phase entry before a designated Office before the that report is established, it is proposed to communicate to that Office a copy of the written opinion of the ISA (the content of which would be identical to any IPRP by the ISA).]

44bis.3 Translation for Designated Offices

(a) Any designated State may, where the report has been established in a language other than the official language, or one of the official languages, of its national Office, require a translation of the report into English. Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

(b) If a translation is required under paragraph (a), it shall be prepared by or under the responsibility of the International Bureau.

(c) The International Bureau shall transmit a copy of the translation to any interested designated Office and to the applicant at the same time as it communicates the report to that Office.

[COMMENT: See paragraph 27 in the Introduction to this document.]

44bis.4 Observations on the Translation

The applicant may make written observations as to the correctness of the translation referred to in Rule 44bis.3 and shall send a copy of the observations to each of the interested designated Offices and to the International Bureau.

[COMMENT: See paragraph 27 in the Introduction to this document.]

**Rule 44ter**

**Confidential Nature of Written Opinion, Report, Translation and Observations**

44ter.1 Confidential Nature

(a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:

(i) subject to Rules 44bis.2(b), 62.1(i) and 73.2(b), to the written opinion established under Rule 43bis.1;

(ii) if a report is established under Rule 44bis.1, to that report, to any translation of it prepared under Rule 44bis.3(b) or to any written observations on that translation sent by the applicant under Rule 44bis.3(d).

[COMMENT: See paragraphs 28 and 29 in the Introduction to this document. Item (i) of paragraph (a) is subject to Rules 44bis.2(b) and 73.2(b) (communication of the written opinion of the ISA to any designated or elected Office, before the expiration of 30 months from the priority date, in case of early national phase entry under Chapter I and Chapter II, respectively) and subject to Rule 62.1(i) (communication of the written opinion of the ISA to the IPEA, before the expiration of 30 months from the priority date, where a demand for international preliminary examination has been made).]

(b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.

[COMMENT: The wording of paragraph (b) is modeled after Article 30(4).]



**Rule 54bis**

**Time Limit for Making a Demand**

54bis.1 Time Limit for Making a Demand

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a); or

(ii) 22 months from the priority date.

(b) Any demand made after the expiration of the time limit applicable under paragraph (a) shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

[COMMENT: See paragraph 31 in the Introduction to this document.]

**Rule 57**

**The Handling Fee**

57.1 and 57.2 [No change]

57.3 *Time Limit for Payment; Amount Payable*

(a) Subject to paragraphs (b) and (c), the ~~The~~ handling fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later., ~~provided that,~~

[COMMENT: See paragraph 44 of the Introduction to this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

(b) Subject to paragraph (c), where ~~Where~~ the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the handling fee shall be paid within one month from the date of receipt by that Authority or 22 months from the priority date, whichever expires later.

[COMMENT: See paragraph 44 of the Introduction to this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

*[Rule 57.3, continued]*

(c) Where, in accordance with Rule 69.1(b), the International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search, that Authority shall invite the applicant to pay the handling fee within one month from the date of the invitation.

[COMMENT: See paragraph 45 of the Introduction to this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

(d) The amount of the handling fee payable shall be the amount applicable on the date of payment ~~that date of submittal or date of receipt, as the case may be. For the purposes of the preceding two sentences, Rule 59.3(e) shall not apply.~~

[COMMENT: The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

57.4 and 57.5 *[Remain deleted]*

57.6 *Refund*

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

- (i) [No change]
- (ii) if the demand is considered, under Rule 54.4 or 54bis.1(b), not to have been submitted.

**Rule 58bis**

**Extension of Time Limits for Payment of Fees**

*58bis.1 Invitation by the International Preliminary Examining Authority*

(a) Where, ~~by the time they are due under Rules 57.3 and 58.1(b),~~ the International Preliminary Examining Authority finds: ~~that no fees were paid to it, or~~

(i) that the amount paid to it is insufficient to cover the handling fee and the preliminary examination fee; ~~or~~

(ii) ~~by the time they are due under Rules 57.3 and 58.1(b), that no fees were paid to it;~~

the Authority shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 58bis.2, within a time limit of one month from the date of the invitation.

[COMMENT: The proposed change appears necessary for two reasons: (i) to clarify that the finding whether the amount paid is insufficient to cover the handling fee and the preliminary examination fee needs to be done already upon receipt of any amount intended to cover those fees and not only at the time fees are due (which may be as late as 20 months from the priority date); and (ii) to clarify that no invitation to pay fees should be send out to the applicant where the applicant has filed the demand early (say, at the same time as the international application) but where the fees are not yet due (in such a case, they would not be due before the expiration of 20 months from the priority date).]

(b) to (d) [No change]

58bis.2 [No change]

**Rule 59**

**The Competent International Preliminary Examining Authority**

59.1 and 59.2 [No change]

59.3 *Transmittal of Demand to the Competent International Preliminary Examining Authority*

(a) and (b) [No change]

(c) Where the demand is transmitted to the International Bureau under paragraph (a) or submitted to it under paragraph (b), the International Bureau shall promptly:

(i) [No change]

(ii) if two or more International Preliminary Examining Authorities are competent, invite the applicant to indicate, within [the time limit applicable under Rule 54bis.1\(a\) or](#) 15 days from the date of the invitation ~~or 19 months from the priority date~~, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

[COMMENT: Proposed amendment of item (ii) of paragraph (c) is consequential on the introduction of new time limit for the filing of a demand under proposed new Rule 54bis.1(a) (see above).]

(d) to (f) [No change]

## Rule 61

### Notification of the Demand and Elections

61.1 to 61.3 [No change]

[COMMENT: No change is proposed to Rule 61.1 in the context of this document. Note, however, that it is proposed to delete Rule 61.1(c) in the context of document PCT/R/2/6.]

61.4 *Publication in the Gazette*

~~Where a demand has been filed before the expiration of 19 months from the priority date, the~~ The International Bureau shall, promptly after the filing of the demand but not before the international publication of the international application, publish in the Gazette information on the demand and the elected States concerned, as provided in the Administrative Instructions.

[COMMENT: Proposed amendment of Rule 61.4 is consequential on the proposed introduction of new Rule 54bis and the fact that any demand made after the expiration of the applicable time limit under that Rule is considered not to have been made. Even following the recent change of the time limit under Article 22(1) from 20 to 30 months, the Rule still serves a purpose in that it requires the International Bureau to publish information on the fact that a demand for international preliminary examination has been filed, thereby informing the public that an international preliminary examination report will become available in respect of the international application concerned. Section 431 of the Administrative Instructions, providing for the details as to which information on the demand and the elected States is to be published in the Gazette, would also have to be modified.]

**Rule 62**

**Copy of Written Opinion by International Searching Authority and of Amendments  
Under Article 19 for the International Preliminary Examining Authority**

62.1 *Copy of Written Opinion by International Searching Authority and of Amendments  
Made Before the Demand Is Filed*

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

(i) a copy of the written opinion established under Rule 43bis.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and

(ii) a copy of any amendments under Article 19, and any statement referred to in that Article, ~~to that Authority,~~ unless that Authority has indicated that it has already received such a copy.

[COMMENT: See paragraph 33 of the Introduction to this document.]

62.2 [No change]

**Rule 62bis**

**Translation for International Preliminary Examining Authority  
of Written Opinion of International Searching Authority**

*62bis.1 Translation and Observations*

(a) Upon request of the International Preliminary Examining Authority, the written opinion established under Rule 43bis.1 shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau.

(b) The International Bureau shall transmit a copy of the translation to the International Preliminary Examining Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

(c) The applicant may make written observations as to the correctness of the translation and shall send a copy of the observations to the International Preliminary Examining Authority and to the International Bureau. The International Preliminary Examining Authority may take such observations into account.

[COMMENT: See paragraph 34 of the Introduction to this document.]



**Rule 63**

**Minimum Requirements for  
International Preliminary Examining Authorities**

63.1 Definition of Minimum Requirements

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

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iii) that Office or organization must hold an appointment as an International Searching Authority.

[COMMENT: Rule 63.1 is proposed to be amended so to ensure that the qualifications for appointment of an International Preliminary Examining Authority include all of those which apply for appointment of an International Searching Authority (see Rule 36.1) (see document PCT/R/WG/2/12, paragraph 34). Rule 36.1 is also proposed to be amended accordingly (see above).]

**Rule 66**

**Procedure Before the International Preliminary Examining Authority**

66.1 [No change]

66.1bis *Written Opinion of the International Searching Authority*

(a) Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43bis.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

[COMMENT: See paragraphs 35 and 36 of the Introduction to this document.]

(b) An International Preliminary Examination Authority may notify the International Bureau that paragraph (a) shall not apply to the procedure before it in respect of written opinions established under Rule 43bis.1 by the International Searching Authority or Authorities specified in the notification, provided that such a notification shall not apply to cases where the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority. The International Bureau shall promptly publish any such notification in the Gazette.

[COMMENT: See paragraph 37 of the Introduction to this document.]

*[Rule 66.1bis, continued]*

(c) Where the written opinion established by the International Searching Authority under Rule 43bis.1 is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of this paragraph, the International Preliminary Examining Authority shall notify the applicant accordingly in writing.

(d) A written opinion established by the International Searching Authority under Rule 43bis.1 which is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a) shall nevertheless be taken into account by the International Preliminary Examining Authority in proceeding under Rule 66.2(a).

66.2 ~~First~~ *Written Opinion of the International Preliminary Examining Authority*

(a) to (c) [No change]

(d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall not be more than three months after the said date.

(e) The time limit for replying to the notification ~~but~~ may be extended if the applicant so requests before its expiration.

[COMMENT: Paragraph (d) is proposed to be amended and new paragraph (e) proposed to be added so as to clarify that paragraph (e) applies to both the notification under paragraph (d) and the notification under proposed new Rule 43bis.1(c) (see also proposed new Rule 43bis.1(b), which includes a reference to Rule 66.2(e)).]

66.3 to 66.9 [No change]

**Rule 69**

**Start of and Time Limit for International Preliminary Examination**

69.1 *Start of International Preliminary Examination*

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession ~~both~~ of all of the following:

- (i) the demand; ~~and~~
- (ii) the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2; and
- (iii) ~~of~~ either the international search report and the written opinion established under Rule 43bis.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established;

provided that the International Preliminary Examination Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54bis.1(a) unless the applicant expressly requests an earlier start.

[Rule 69.1, continued]

[COMMENT: Paragraph (a) is proposed to be amended so as to clarify that the IPEA must start the international preliminary examination procedure only after having received the demand, the fees due and either the international search report and the written opinion of the ISA or the declaration under Article 17(2)(a), and that it must not start before the expiration of the time limit under Rule 54bis(a), that is, before the expiration of 3 months from the date of transmittal to the applicant of the written opinion or 22 months from the priority date, whichever expires later. The latter provision is intended to ensure that the IPEA, after the filing of a demand does not proceed straight to the issuance of an international preliminary examination report (in particular in cases where the demand has been filed early with regard to Article 22 transitional reservation countries) without giving the applicant sufficient time to respond to the international search report and the written opinion of the ISA.]

(b) If the ~~competent International Preliminary Examining Authority is part of the same~~ national Office or intergovernmental organization that acts as ~~the competent~~ International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization ~~the International Preliminary Examining Authority~~ so wishes and subject to paragraphs (d) and (e), start at the same time as the international search.

(b-bis) Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization need not, in its capacity as International Searching Authority, establish a written opinion under Rule 43bis.1.

[COMMENT: See comment on proposed new Rule 43bis.1, above.]

(c) [No change]

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:

(i) it has received a copy of any amendments made under Article 19~~;~~

(ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19~~;~~ or

(iii) the expiration of the applicable time limit under Rule 54bis.1(a). ~~20 months from the priority date,~~

~~whichever occurs first.~~

[COMMENT: Proposed amendment of paragraph (d)(iii) is consequential on proposed new Rule 54bis.1(a); the first sentence of paragraph (d) is proposed to be amended for clarification purposes only.]

(e) [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

- (i) 28 months from the priority date;~~;~~ or
- (ii) six ~~eight~~ months from the time provided under Rule 69.1 for the start of the international preliminary examination; ~~date of payment of the fees referred to in Rules 57.1 and 58.1(a);~~ or
- (iii) six ~~eight~~ months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2~~;~~

~~whichever expires last.~~

[COMMENT: Proposed amendment of items (i) to (iii) of Rule 69.2 is consequential on the introduction of a new time limit for filing the demand under Rule 54*bis*.1(a); the first sentence of Rule 69.2 is proposed to be amended for clarification purposes only.]



**Rule 70**

**International Preliminary Report on Patentability by  
the International Preliminary Examining Authority**  
**~~The~~ (International Preliminary Examination Report)**

70.1 to 70.14 [No change]

70.15 *Form; Title*

(a) The physical requirements as to the form of the report shall be prescribed by the Administrative Instructions.

(b) The report shall bear the title “international preliminary report on patentability” together with an indication that it is the international preliminary examination report established by the International Preliminary Examining Authority.

[COMMENT: See paragraphs 25 and 38 of the Introduction to this document.]

70.16 and 70.17 [No change]

**Rule 72**

**Translation of the International Preliminary Examination Report**

72.1 and 72.3 [No change]

*72.3 Observations on the Translation*

The applicant may make written observations as to the correctness of ~~on what, in his opinion, are errors of translation in~~ the translation of the international preliminary examination report and shall send a copy of the ~~any such~~ observations to each of the interested elected Offices and ~~a copy~~ to the International Bureau.

[COMMENT: Rule 72.3 is proposed to be amended for clarification purposes only an so as to align the wording used in Rule 72.3 with the wording used in proposed new Rule 44bis.4 (see above).]

**Rule 73**

**Communication of the International Preliminary Examination Report  
or the Written Opinion of International Searching Authority**

73.1 [No change]

73.2 ~~Time Limit for~~ Communication to Elected Offices

(a) The International Bureau shall effect the communication provided for in Article 36(3)(a) to each elected Office in accordance with Rule 93bis.1 but not before the expiration of 30 months from the priority date. ~~The communication provided for in Article 36(3)(a) shall be effected as promptly as possible but not earlier than the communication under Article 20.~~

[COMMENT: Rule 73.2 is proposed to be amended so as to align, in proposed new paragraph (a), the time limit before the expiration of which the IPRP by the IPEA may be communicated to elected Offices with the time limit before the expiration of which the IPRP by the ISA may be communicated to designated Offices (see proposed new Rule 44bis.2, above).]

(b) Where the applicant makes an express request to an elected Office under Article 40(2), the International Bureau shall, upon the request of that Office or of the applicant,

(i) if the international preliminary examination report has already been transmitted to the International Bureau under Rule 71.1, promptly effect the communication provided for in Article 36(3)(a) to that Office;

*[Rule 73.2(b), continued]*

(ii) if the international preliminary examination report has not been transmitted to the International Bureau under Rule 71.1, promptly communicate a copy of the written opinion established by the International Searching Authority under Rule 43bis.1 to that Office.

[COMMENT: New paragraph (b) is proposed to be added so as to ensure that, where the applicant makes an express request for early national phase entry, the elected Office concerned would get either a copy of the written opinion of the ISA or, if already available, a copy of the IPRP by the IPEA.]

(c) Where the applicant has withdrawn the demand or any or all elections, the communication provided for in Article 36(3)(a) shall nevertheless be effected, if the International Bureau has received the international preliminary examination report, to the elected Office or Offices affected by the withdrawal.

[COMMENT: New paragraph (c) is proposed to be added so as to ensure that any national Office would either, as a designated Office, receive the IPRP by the ISA or, as an elected Office, receive the IPRP by the IPEA. Without such provision, the applicant could, by withdrawing the demand or any or all elections after the international preliminary report on patentability has been established by the IPEA, prevent any Office from receiving either the report established by the ISA or the report established by the IPEA: the former would not be available to any designated Office if an international preliminary examination report is established or is to be established (see proposed new Rule 44bis.1(a), above), and the latter, without the addition of proposed new paragraph (c), would not be available to any elected Office affected by the withdrawal.]

**Rule 78**

**Amendment of the Claims, the Description, and the Drawings,  
Before Elected Offices**

78.1 *Time Limit* ~~Where Election Is Effected Prior to Expiration of 19 Months from Priority Date~~

(a) ~~Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the~~ The applicant shall, if he so wishes, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfillment of the requirements under Article 39(1)(a), provided that, if the transmittal of the international preliminary examination report under Article 36(1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any later ~~other~~ time if so permitted by the national law of the said State.

(b) In any elected State in which the national law provides that examination starts only on special request, the national law may provide that the time limit within or the time at which the applicant may exercise the right under Article 41 shall, ~~where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date,~~ be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit ~~applicable~~ under paragraph (a).

~~78.2 [Deleted] *Time Limit Where Election Is Effected After Expiration of 19 Months from Priority Date*~~

~~Where the election of any Contracting State has been effected after the expiration of the 19th month from the priority date and the applicant wishes to make amendments under Article 41, the time limit for making amendments under Article 28 shall apply.~~

[COMMENT: The proposed amendment of Rule 78.1 and proposed deletion of Rule 78.2 are consequential on the introduction of proposed new Rule 54bis.1(b).]

**Rule 92bis**

**Recording of Changes in Certain Indications  
in the Request or the Demand**

*92bis.1 Recording of Changes by the International Bureau*

(a) [No change]

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.:

~~(i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;~~

~~(ii) of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.~~

[COMMENT: In the context of the proposed introduction of the expanded international search system, it is also proposed to amend Rule 92bis. The existing time limits for the recording of a change under Rule 92bis is either 20 or 30 months from the priority date, depending on whether it is the time limit under Article 22(1) or 39(1)(a) which is applicable. That distinction has become meaningless since, following the recent modification of the time limit under Article 22(1), the time limits under Articles 22(1) and 39(1)(a) are both 30 months. Section 422 of the Administrative Instructions, providing for the details as to notifications concerning changes recorded under Rule 92bis, would also have to be modified accordingly.]

**Rule 94**

**Access to Files**

94.1 *Access to the File Held by the International Bureau*

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 [and Rule 44ter.1](#), furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

[\(c\) The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph \(b\) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.](#)

[COMMENT: See paragraph 43 of the Introduction to this document.]

94.2 and 94.3 [No change]

[End of Annex and of document]