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WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

First Session

Geneva, November 12 to 16, 2001

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

CONTENTS OF THE INTERNATIONAL APPLICATION;
LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS;
RIGHT OF PRIORITY AND PRIORITY CLAIMS; TIME LIMITS

Document prepared by the International Bureau

BACKGROUND¹

1. At its first session, the Committee on Reform of the PCT (“the Committee”) based its discussions on the matters of conforming PCT filing date and “missing part” type requirements to those of the Patent Law Treaty (PLT), and on other PLT-consistent changes, on document PCT/R/1/2, Annex, pages 4 (items (3) and (4)) and 6 (item 15) as well as comments and proposals made in other documents. The Committee recommended to the Assembly of the International Patent Cooperation Union (PCT Union) that the matters should be referred to the Working Group (see document PCT/R/1/26, paragraphs 72, 73 and 74):²

¹ This and other working documents for the Working Group’s session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

² Document PCT/R/1/2 contains proposals made by the United States of America. Many of the other documents which were before the Committee comment on those proposals or contain other proposals. The documents, as well as the Committee’s report, are available on WIPO’s Internet site at http://www.wipo.int/pct/en/reform/index_1.htm.

“Conform filing date requirements to those in the PLT”

72. Discussions were based on document PCT/R/1/2, Annex, page 4, item (3), as well as comments and proposals made in other documents. The following principles, comments and concerns were expressed by various delegations:

(i) while the proposal was generally supported, certain delegations questioned whether it should extend to certain requirements relating to nationality, residence and language;

(ii) the operation of the proposal in the context of the time limit for international search would need to be looked at carefully.

Conform “missing part”-type requirements to PLT procedure

73. The Committee generally agreed with the proposals made by the United States of America in document PCT/R/1/2, Annex, page 4, item (4).

Other PLT-consistent changes

74. Discussions were based on document PCT/R/1/2, Annex, page 6, item (15), as well as comments and proposals made in other documents. The following principles, comments and concerns were expressed by various delegations:

(i) there is a general need for the PCT to be reviewed to see what changes are necessary or desirable to bring it into line with the letter and spirit of the PLT;

(ii) the examples given in document PCT/R/1/2 and other documents should be reviewed by the working group;

(iii) the use of modern information technology in filing applications makes it easier for applicants to file unnecessarily complex applications which cannot be satisfactorily handled by Offices (for example, applications containing unduly large numbers of pages or claims or with unduly broad claims);

(iv) related matters to be considered in this context should include extensions of time limits and reinstatement of rights;

(v) in the longer term, there could be possibilities for a complete amalgamation of the provisions of the PCT and the PLT.”

2. Subsequent to the session of the Committee, the Assembly agreed with the Committee’s recommendations.³

³ See WIPO’s Internet site at http://www.wipo.int/eng/document/govbody/wo_pct/index_30.htm. The Assembly’s report (document PCT/A/30/7) may not be available in final form at the date of this document but is expected to be available shortly thereafter.

3. The Annexes to this document contain a number of proposed amendments of the PCT Regulations⁴ designed to align PCT requirements with those of the PLT. Annex I contains proposals concerning the *contents of the international application* (see paragraphs 4 to 9, below). Annex II contains proposals concerning the *language of the international application and translations* (see paragraphs 10 and 11, below). Annex III contains proposals concerning the *right of priority and priority claims* (see paragraphs 12 and 13, below). Matters relating to *time limits* are contained in all three Annexes. The Working Group is invited to discuss at its first session as many of the proposals in the Annexes as time permits.

CONTENTS OF THE INTERNATIONAL APPLICATION

4. With regard to the contents of applications, the main differences between the PLT and the PCT concern filing date requirements and filing date related “missing part” requirements.

5. *Filing date requirements* of the PLT are contained in PLT Article 5; details are contained in PLT Rule 2. The filing date requirements of the PCT are contained in PCT Article 11(1); details are contained in PCT Rule 20.4.

6. The main differences between the filing date requirements of the PLT and those of the PCT are as follows:

(i) *claims*: under the PLT, claims are not required for the purposes of the filing date (see PLT Article 5(1)); under the PCT, for the purposes of the international filing date, the international application must contain, at the time of receipt of the application, “a part which on the face of it appears to be a claim or claims” (see PCT Article 11(1)(iii)(e));

(ii) *drawing as description*: under the PLT, a Contracting Party may, for the purposes of the filing date, accept a drawing as the “part which on the face of it appears to be a description” (see PLT Article 5(1)(b)); there is no equivalent provision in the PCT;

(iii) *replacement of description and drawing*: under the PLT, for the purposes of the filing date, the description and any drawings may be replaced by a reference, made upon the filing of the application, in a language accepted by the Office, to a previously filed application (see PLT Article 5(7)); there is no equivalent provision in the PCT;

(iv) *language related requirements* are addressed in paragraphs 10 and 11, below and Annex II;

(v) *time limits*: see paragraph 14, below.

7. “*Missing part*” requirements under the PLT (missing part of the description and missing drawing) are contained in PLT Article 5(5) and (6) and PLT Rule 2(3). “Missing part” requirements under the PCT are contained in PCT Article 14(2) and PCT Rule 20.2.

8. The main difference between the “missing part” requirements of the PLT and those of the PCT is that, under the PLT, the applicant can rectify the omission of a part of the

⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended are included for ease of reference.

description or of a drawing without loss of the filing date if the application claims the priority of an earlier application and the missing part of the description or the missing drawing is completely contained in that earlier application (see PLT Article 5(6) and PLT Rule 2(3) and (4)). Under the PCT, later submission of a missing part of the description or of a missing drawing results in the loss of the originally accorded international filing date (except in the case of an authorized rectification of an obvious error under PCT Rule 91), and in the according of a new international filing date (being the date on which the papers completing the international application were received or the date on which all international filing date requirements were fulfilled, whichever is later) (see PCT Article 14(2) and PCT Rule 20.2).

9. Annex I to this document sets out proposals designed to align the filing date requirements (excluding the language related filing date requirements) and the filing date related “missing part” requirements under the PCT to those under the PLT (see Rules 20 (excluding Rule 20.4(c)), 20*bis*, 26 (excluding Rule 26.3) and 66 (excluding Rule 66.7) as proposed to be amended). In this context, it is also proposed to align certain related requirements under the PCT with those under the PLT (in particular time limits for compliance with non-filing date related requirements; see Rule 26 as proposed to be amended).

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

10. The main difference between the language related requirements of the PLT and those of the PCT is that, under the PLT, only two elements of the application (“an express or implicit indication to the effect that the elements are intended to be an application” and “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office”) must, for the purposes of the filing date, be in a language accepted by the Office, whereas the “part which on the face of it appears to be a description” may, for the purposes of the filing date, be in any language (see PLT Article 5(2)). Under the PCT, both the “part which on the face of it appears to be a description” and the “part which on the face of it appears to be a claim or claims” must, for the purposes of the international filing date, be in a language accepted by the receiving Office (see PCT Article 11(1)(ii) and PCT Rule 20.4(c)).

11. Annex II to this document sets out a proposal to align the language related filing date requirements under the PCT to those under the PLT (see Rule 20.4(c) as proposed to be amended). This change has far reaching consequences on certain non-filing date related provisions dealing with the language of the international application for receiving Office processing, international search and international publication. Annex II also sets out specific proposals for amendment of certain Rules which deal with those issues (see Rules 12, 19, 23, 26.3, 35 and 48 as proposed to be amended).

RIGHT OF PRIORITY AND PRIORITY CLAIMS

12. Under the PLT, it is possible for the applicant to request the restoration of the right of priority where an application which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired but within a certain time limit (see PLT Article 13(2) and PLT Rule 14(4) and (5)). There is no equivalent provision in the PCT.

13. Annex III to this document sets out specific proposals to include, in the PCT Regulations, provisions relating to the restoration of the right of priority (see Rules 4 and 26*bis* as proposed to be amended). In this context, it is also proposed to amend Rules 17 and 66.7 so as to provide for the possibility, in line with the PLT requirements, that priority documents may be available, in the future, from digital libraries.

TIME LIMITS

14. Under the PLT, the time limits for subsequent compliance with filing date requirements (see PLT Article 5(3) and (4) and PLT Rule 2(1) and (2)) are longer than those provided for under the PCT (see PCT Article 11(2) and PCT Rule 20.6). Provisions designed to align the PCT with the PLT in respect of time limits are contained in each of the Annexes.

GENERAL REMARKS

15. Some of the proposals in relation to language and time limits appear to be difficult to draft without adding to the complexity of the PCT system. Draft provisions are, however, included in the present document with a view to facilitating discussion on how best to proceed.

16. As regards the *language requirements*, the added complexity is mainly due to the fact that the proposals have to accommodate the fact that, under the PCT, several Offices and Authorities (and not just one national Office, as is the case under the PLT) process the application during the international phase, and each PCT Office and Authority is entitled, within certain limits, to decide on its own working languages.

17. As regards the *time limits* for compliance with certain requirements, the added complexity is due to the fact that some (later) time limits are not consistent with the more restrictive time scale under by the PCT within which Offices and Authorities are required to perform certain actions (for example, in relation to the timely establishment of the international search report).

FURTHER PLT CONSISTENT CHANGES

18. The proposals contained in the Annexes to this document do not address all necessary PLT-related changes. For the next session of the Working Group, the International Bureau intends to prepare a further document identifying and addressing the further changes necessary or desirable to bring the PCT in line with the letter and spirit of the PLT.

19. The Working Group is invited to consider the proposals contained in the Annexes to this document.

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

CONTENTS OF THE INTERNATIONAL APPLICATION

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Rule 20

Receipt of the International Application

20.1 [No change]

20.2 [Deleted] *Receipt on Different Days*

~~(a) In cases where all the sheets pertaining to the same purported international application are not received on the same day by the receiving Office, that Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the papers completing the international application were received, provided~~

~~(i) where no invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within 30 days from the date on which sheets were first received;~~

~~(ii) where an invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within the applicable time limit under Rule 20.6;~~

~~(iii) in the case of Article 14(2), the missing drawings are received within 30 days from the date on which the incomplete papers were filed;~~

~~(iv) the absence or later receipt of any sheet containing the abstract or part thereof shall not, in itself, require any correction of the date marked on the request.~~

[Rule 20.2, continued]

~~(b) Any sheet received on a date later than the date on which sheets were first received shall be marked by the receiving Office with the date on which it was received.~~

[COMMENT: It is proposed to delete present Rule 20.2 so as to combine the issue of “receipt on different days” and the issue of “missing parts of the international application” in new Rule 20*bis* (see below). It is further proposed to move the content of the chapeau of present paragraph (a) (“that Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the papers completing the international application were received”) and the content of present paragraph (b) to the Administrative Instructions.]

20.3 ~~[Deleted]~~ *Corrected International Application*

~~In the case referred to in Article 11(2)(b), the receiving Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the last required correction was received.~~

[COMMENT: With regard to the case of subsequent compliance with Article 11(1) requirements (“the case referred to in Article 11(2)(b)”), see proposed new Rule 20.6*bis*, below. It is proposed to move the content of present Rule 20.3 to the Administrative Instructions.]

20.4 *Determination Under Article 11(1)*

(a) [No change]

(a-bis) For the purposes of Article 11(1)(iii)(a), an implicit indication to the effect that the elements are intended to be an international application shall be sufficient.

[COMMENT: See PLT Article 5(1)(i).]

[Rule 20.4, continued]

(b) For the purposes of Article 11(1)(iii)(c), it shall be sufficient to indicate the name of the applicant in a way which allows his identity to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

[COMMENT: No change; included in this document only for ease of reference. It is to be noted that, in view of the option provided under PLT Article 5(1)(c), both this paragraph and Article 11(1)(iii)(c) are compatible with PLT Article 5(1)(a)(ii).]

[\(b-bis\) For the purposes of Article 11\(1\)\(iii\)\(d\), a drawing shall be accepted as the part which appears to be a description.](#)

[COMMENT: See PLT Article 5(1)(b).]

(c) [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, changes proposed to Rule 20.4(c) in Annex II to this document.]

[Rule 20.4, continued]

(d) For the purposes of Article 11(1)(iii)(e), the part which on the face of it appears to be a description shall be considered to contain a part which on the face of it appears to be a claim or claims. ~~If, on October 1, 1997, paragraph (e) is not compatible with the national law applied by the receiving Office, paragraph (e) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.~~

[COMMENT: See PLT Article 5(1). It is proposed to amend paragraph (d) so as to align the PCT filing date requirements with regard to claims with those under the PLT; under paragraph (d) as proposed to be amended, the presence, upon filing, of “a part which on the face of it appears to be a claim or claims” (see Article 11(1)(iii)(e)) would no longer be required. See also Rule 26.3*ter* as proposed to be amended, below.]

(e) For the purposes of Article 11(1)(iii)(d), a reference, made upon filing of the international application, in a language accepted by the receiving Office under Rule 12.1(a), to a previously filed application shall, subject to paragraphs (f) to (i), replace the description and any drawings and, if applicable, the claim or claims.

[COMMENT: See PLT Article 5(7). It seems appropriate to mention the claims in the context of the PCT, notwithstanding that PLT Article 5(7) is silent as to them. A question remaining to be addressed is what constitutes the record copy, the search copy and the home copy in a case where the description, any drawings and, if applicable, the claim or claims are replaced by a reference to a previously filed application.]

[Rule 20.4, continued]

(f) The reference to the previously filed application referred to in paragraph (e) shall indicate that, for the purposes of the international filing date, the description and any drawings and, if applicable, the claim or claims are replaced by the reference to the previously filed application; the reference shall also indicate the number of that application, the filing date of that application and the Office with which that application was filed.

[COMMENT: See PLT Rule 2(5)(a).]

(g) Where the international application contains a reference to a previously filed application referred to in paragraph (e), the applicant shall, subject to paragraph (i), within one month from the date of receipt of the international application by the receiving Office, furnish to that Office a copy of the previously filed application and, where the previously filed application is not in a language accepted by the receiving Office under Rule 12.1(a), is not in a language accepted by the International Searching Authority that is to carry out the international search or is not in a language of publication, a translation of that previously filed application into a language referred to in Rule 12.3(a).

[COMMENT: See PLT Rule 2(5)(b) and PCT Rule 12.3(a) as proposed to be amended (see above).]

(h) Rules 12.3(c) to (e) shall apply *mutatis mutandis* where the applicant has not, within the time limit under paragraph (g), furnished a copy of the previously filed application or any translation thereof referred to in paragraph (g).

[Rule 20.4, continued]

(i) The applicant shall not be required to furnish a copy of a previously filed application referred to in paragraph (g) where that earlier application was filed with the national Office that is acting as receiving Office or with the International Bureau acting as receiving Office, or where that earlier application is, in accordance with the Administrative Instructions, available to the receiving Office from a digital library.

[COMMENT: See PLT Rules 2(5)(b) and 4(3). The PLT is silent on the question whether, if a copy of the previously filed application is available from a digital library, a translation is required.]

20.5 *Positive Determination Under Article 11(1)*

[COMMENT: Clarification only.]

(a) to (c) [No change]

20.6 *Invitation Under Article 11(2) to Correct*

[COMMENT: Clarification only.]

(a) [No change]

[Rule 20.6, continued]

(b) The receiving Office shall promptly invite ~~mail the invitation to~~ the applicant to furnish the required correction, or to make observations, within two months ~~and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction.~~ ~~The time limit shall not be less than 10 days, and shall not exceed one month,~~ from the date of the invitation. If that ~~such~~ time limit expires after the expiration of one year from the filing date of any application whose priority is claimed, the receiving Office shall ~~may~~ call this circumstance to the attention of the applicant.

[COMMENT: With regard to the proposed new two-month time limit, see PLT Article 5(3) and PLT Rule 2(1). With regard to the requirement to give the applicant the opportunity to make observations, see PLT Article 5(3). In this context, it is proposed to make it mandatory for receiving Offices to draw the applicant's attention to the fact that the time limit for corrections expires after the expiration of the priority period.]

20.6bis Subsequent Compliance with Requirements under Article 11(1)

(a) Where, at the time of receipt of the purported international application, one or more of the requirements under Article 11(1) are not complied with but are subsequently complied with, the international filing date shall, subject to Rules 20bis.2 and 20bis.3, be the date on which all of the requirements under Article 11(1) are subsequently complied with, and the receiving Office shall proceed as provided in Rule 20.5, provided that the said requirements are complied with within the applicable time limit under paragraph (b).

[Rule 20.6bis, continued]

(b) The time limit referred to in paragraph (a) shall be:

(i) where an invitation under Article 11(2)(a) to correct was sent to the applicant, two months from the date of the invitation;

(ii) where no invitation under Article 11(2)(a) to correct was sent to the applicant, two months from the date on which one or more elements referred to in Article 11(1)(iii) were first received.

[COMMENT: See PLT Article 5(4) and (with regard to the applicable time limits) PLT Rule 2(1) and(2), as well as PCT Article 11(2)(b). While the PLT provides for the time limit under item (ii) only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed”, it is proposed to apply that time limit to all cases where no invitation has been sent to the applicant, irrespective of whether or not indications allowing the applicant to be contacted had been filed.]

20.7 *Negative Determination*

(a) If the receiving Office does not, within the applicable ~~prescribed~~ time limit under Rule 20.6bis(b), receive a correction ~~a reply to its invitation to correct~~, or if the correction offered by the applicant still does not fulfill the requirements provided for under Article 11(1), it shall:

[COMMENT: Consequential on the proposed amendment of Rules 20.6 and 20.6bis.]

[Rule 20.7(a), continued]

(i) promptly notify the applicant that the ~~his~~ application is considered not to have been filed ~~is not and will not be treated as an international application~~ and shall indicate the reasons therefor,

[COMMENT: Item (i) is proposed to be amended so as to align the terminology with that used in PLT Article 5(4)(b).]

(ii) to (iv) [No change]

Rule 20bis

Missing Part or Missing Drawing

20bis.1 Notification of Missing Part or Missing Drawing

Where, in determining under Rule 20.4 whether the papers comply with the requirements of Article 11(1), the receiving Office finds that a part of the description appears to be missing from the purported international application (“missing part”) or that the application refers to a drawing which appears to be missing from the purported international application (“missing drawing”), that Office shall promptly notify the applicant accordingly; where the receiving Office sends to the applicant an invitation to correct under Article 11(2)(a), the notification shall be included in that invitation.

[COMMENT: See PLT Article 5(5) and PCT Article 14(2). While PCT Article 14(2) only concerns the case of missing drawings, it is proposed to extend the (applicant friendly) concept of an “early warning” that certain parts appear to be missing from the international application as filed also to other elements of the international application. In line with the Notes on the PLT, it is proposed to amend the Administrative Instructions and the receiving Office Guidelines so as to make it clear that there is no obligation on the receiving Office to carry out a check for a missing part of the description or a missing drawing.]

20bis.2 Receipt of Missing Part or Missing Drawing

(a) Where the receiving Office receives any missing part or missing drawing as referred to in Rule 20bis.1, any such missing part or missing drawing shall be included in the international application and, subject to Rule 20bis.3, the international filing date shall be the date on which the receiving Office has received any such missing part or missing drawing or the date on which all of the requirements of Article 11(1) are complied with, whichever is later, provided that any such missing part or missing drawing is received within the applicable time limit under paragraph (b).

[COMMENT: See PLT Article 5(6) and (with regard to missing drawings), PCT Article 14(2).]

(b) The time limit referred to in paragraph (a) shall be:

(i) where a notification under Rule 20bis.1 and/or an invitation under Article 11(2)(a) to correct was sent to the applicant, two months from the date of the notification or invitation, as the case may be;

(ii) where no notification under Rule 20bis.1 and no invitation under Article 11(2)(a) to correct was sent to the applicant, two months from the date on which one or more elements referred to in Article 11(1) were first received.

[COMMENT: With regard to the applicable time limit under item (i), see PLT Article 5(6) and PLT Rule 2(3)(i), and PLT Article 5(3) and PLT Rule 2(1); with regard to the applicable time limit under item (ii), see PLT Article 5(6) and PLT Rule 2(3)(ii), and PLT Article 5(3) and PLT Rule 2(2). While the PLT provides for the time limit under item (ii) only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed”, it is proposed to apply that time limit to all cases where no invitation has been sent to the applicant, irrespective of whether or not indications allowing the applicant to be contacted had been filed. See also present PCT Rule 20.2(a)(iii) which is proposed to be deleted (see above).]

[Rule 20bis.2, continued]

(c) If the international filing date accorded under paragraph (a) is later than one year from the filing date of any application whose priority is claimed, the receiving Office shall notify the applicant accordingly. The applicant may, in a notice addressed to the receiving Office, within two months from the date of the notification or, where no notification was sent to the applicant, within two months from the date on which one or more elements referred to in Article 11(1) were first received, withdraw any missing part or missing drawing, in which case the international filing date shall be the date on which all of the requirements of Article 11(1) are complied with.

[COMMENT: See PLT Article 5(6)(c).]

20bis.3 Replacing Missing Part or Missing Drawing by Reference to an Earlier Application

Where any missing part or missing drawing as referred to in Rule 20bis.1 is filed under Rules 20bis.2 to rectify its omission from an international application which, at the date on which one or more of the elements referred to in Article 11(1)(iii) were first received by the receiving Office, claims the priority of an earlier application, the filing date shall, upon request of the applicant filed within the applicable time limit under Rule 20bis.2(b), be the date on which all the requirements of Article 11(1) are complied with, provided that:

[COMMENT: See PLT Article 5(6)(b) and Rule 2(4).]

[Rule 20bis.3, continued]

(i) a copy of the earlier application is filed with the receiving Office within the applicable time limit under Rule 20bis.2(b);

[COMMENT: See PLT Rule 2(4)(i).]

(ii) where the earlier application is not in a language accepted by the receiving Office under Rule 12.1(a), or is not in a language accepted by the International Searching Authority that is to carry out the international search, or is not in a language of publication, a translation of that earlier application into a language referred to in Rule 12.3(a) is filed with the receiving Office within the applicable time limit under Rule 20bis.2(b);

[COMMENT: See PLT Rule 2(4)(iii).]

(iii) a copy of the earlier application, and the date of filing of the earlier application, certified as correct by the Office with which the earlier application was filed, is filed, upon invitation of the receiving Office, within a time limit of four months from the date of the invitation or the time limit under Rule 17.1(a), whichever expires earlier;

[COMMENT: See PLT Rule 2(4)(ii).]

(iv) any missing part or drawing is completely contained in the earlier application;

[COMMENT: See PLT Rule 2(4)(iv).]

[Rule 20bis.3, continued]

(v) the international application, at the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, contained an indication that the contents of the earlier application were incorporated by reference in the application;

[COMMENT: See PLT Rule 2(4)(v).]

(vi) an indication is filed within the applicable time limit under Rule 20bis.2(b) as to where, in the earlier application or in the translation referred to in item (iv), any missing part or missing drawing is contained.

[COMMENT: See PLT Rule 2(4)(vi).]

Rule 26

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

26.1 Invitation Under Article 14(1)(b) to Correct ~~Time limit for Check~~

(a) The receiving Office shall, ~~issue the invitation to correct provided for in Article 14(1)(b)~~ as soon as possible, preferably within one month from the receipt of the international application, invite the applicant, under Article 14(1)(b), to furnish the required correction, or to make observations, within the time limit under Rule 26.2.

[COMMENT: The title is proposed to be amended so as to cover the subject matter of paragraph (a). With regard to the requirement to give the applicant the opportunity to make observations, see PLT Article 6(7).]

(b) ~~[Deleted] If the receiving Office issues an invitation to correct the defect referred to in Article 14(1)(a)(iii) or (iv) (missing title or missing abstract), it shall notify the International Searching Authority accordingly.~~

[COMMENT: It is proposed to move the content of present paragraph (b) to the Administrative Instructions.]

26.2 *Time Limit for Correction*

The time limit referred to in Rule 26.2 and Article 14(1)(b) ~~shall be reasonable under the circumstances and~~ shall be two ~~fixed in each case by the receiving Office. It shall not be less than one~~ months from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

[Rule 26.2, continued]

[COMMENT: See PLT Article 6(7) and PLT Rule 6(1).]

26.3 [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, changes proposed to Rule 26.3 in Annex II to this document.]

26.3bis [No change]

26.3ter Invitation to Furnish Claims ~~Invitation to Correct Defects Under Article 3(4)(i)~~

(a) Where the receiving Office finds that the international application does not contain any claim except for any claim which, under Rule 20.4(d), is considered to be contained in the part which on the face of it appears to be a description, it shall invite the applicant to furnish a claim or claims. Rules 26.1(a), 26.2, 26.3, 26.3bis, 26.5 and 29.1 shall apply *mutatis mutandis*. ~~Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office shall, unless~~

~~(i) a translation of the international application is required under Rule 12.3(a), or~~

~~(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published,~~

[Rule 26.3ter(a), continued]

~~invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published. Rules 26.1(a), 26.2, 26.3, 26.3bis, 26.5 and 29.1 shall apply mutatis mutandis.~~

[COMMENT: Since the international filing date will be accorded to an international application based on the legal fiction under Rule 20.4(d) (“the part which on the face of it appears to be a description shall be considered to contain a part which on the face of it appears to be a claim or claims”), the sanction of the failure to furnish, after the filing of the international application, a claim or claims can only be that the international application be considered withdrawn (see Rules 26.5 and 29.1, which apply *mutatis mutandis*). Of course, since an international filing date has been accorded, such withdrawn application could still serve as a basis for claiming priority.]

(b) Any claim furnished after the international filing date shall not go beyond the disclosure in the international application as filed. ~~If, on October 1, 1997, paragraph (a) is not compatible with the national law applied by the receiving Office, paragraph (a) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.~~

[Rule 26.3ter, continued]

(c) If the national law of any designated State permits a claim furnished after the international filing date to go beyond the said disclosure, failure to comply with paragraph (b) shall have no consequence in that State. ~~Where the request does not comply with Rule 12.1(e), the receiving Office shall invite the applicant to file a translation so as to comply with that Rule. Rules 3, 26.1(a), 26.2, 26.5 and 29.1 shall apply *mutatis mutandis*.~~

[COMMENT: Paragraphs (b) and (c) as proposed to be amended adopt the provisions which apply to amendments to the claims filed under PCT Article 19 (see PCT Article 19(2) and (3)): the International Bureau does not check whether Article 19 amendments go beyond the original disclosure and publishes them “as filed”; during Chapter II, however, the International Preliminary Examining Authority checks (under PCT Rule 66.2(a)(iv)) whether such amendments go beyond the original disclosure. It is proposed to apply the same principles to a claim or claims furnished subsequently to the filing of the international application: the receiving Office would not check whether such claims go beyond the original disclosure, and such claims would be taken into account “as filed” for the purposes of the international search and international publication; during Chapter II, however, the International Preliminary Examining Authority would check (under PCT Rule 66.2(a)(iv) as proposed to be amended, see below) whether such claims go beyond the original disclosure.]

(d) ~~[Deleted] If, on October 1, 1997, paragraph (e) is not compatible with the national law applied by the receiving Office, paragraph (e) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.~~

[COMMENT: Proposed deletion of the current text of Rule 26.3ter is consequential on the proposed amendment of Rules 12 and 20.4(c).]

26.4 [No change]

26.5 *Decision of the Receiving Office*

(a) The receiving Office shall decide whether the applicant has submitted the correction within the time limit under [paragraph \(b\) Rule 26.2](#), and, if the correction has been submitted within [the applicable](#) ~~that~~ time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

(b) The time limit referred to in paragraph (a) shall be:

(i) where an invitation under Rule 26.2 was sent to the applicant, two months from the date of the invitation;

(ii) where no invitation under Rule 26.2 was sent to the applicant, three months from the date on which one or more of the elements referred to in Article 11(1)(iii) were first received by the receiving Office.

[COMMENT: See PLT Article 6(7) and PLT Rule 6(1) and (2). While the PLT provides for the limit under item (ii) only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed”, it is proposed to apply that time limit to all cases where no invitation has been sent to the applicant, irrespective of whether or not indications allowing the applicant to be contacted had been filed]

26.6 ~~[Deleted]~~ *Missing Drawings*

~~(a) If, as provided in Article 14(2), the international application refers to drawings which in fact are not included in that application, the receiving Office shall so indicate in the said application.~~

[COMMENT: It is proposed to move the content of paragraph (a) to the Administrative Instructions.]

~~(b) The date on which the applicant receives the notification provided for in Article 14(2) shall have no effect on the time limit fixed under Rule 20.2(a)(iii).~~

[COMMENT: The proposed deletion of present paragraph (b) is consequential on the proposed amendment of Rule 20.2 (see above).]

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 [No change]

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

(a) If the International Preliminary Examining Authority

(i) to (iii) [No change]

(iv) considers that any amendment or any claim furnished after the international filing date goes beyond the disclosure in the international application as filed,

(v) to (vii) [No change]

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

[COMMENT: The proposed amendment of item (iv) of paragraph (a) is consequential on the proposed amendment of Rules 20.4(d) and 26.3*ter* (see above).]

[Rule 66.2, continued]

(b) to (d) [No change]

66.3 to 66.6 [No change]

66.7 [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, Rule 66.7 as proposed to be amended in Annex III to this document.]

66.8 and 66.9 [No change]

Rule 90bis

Withdrawals

90bis.1 to 90bis.5 [No change]

90bis.6 *Effect of Withdrawal*

(a) [No change]

(b) Where the international application is withdrawn under Rule 90bis.1, the international processing of the international application shall, [subject to Article 11\(1\) and Rules 20.5 and 20.7](#), be discontinued.

[COMMENT: See PLT Articles 5(1) and 5(4). Paragraph (b) is proposed to be amended so as to clarify that the receiving Office should, in case of the withdrawal of the international application, if the requirements under Article 11(1) are complied with, proceed with according the international filing date before discontinuing the processing of the international application concerned.]

(c) [No change]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

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Rule 12

Language and Translation of the International Application ~~and Translation for the~~ ~~Purposes of International Search~~

12.1 ~~Languages Accepted for the Filing~~ of the International Applications for the Purposes of
Receiving Office Processing

(a) For the purposes of receiving Office processing, an ~~An~~ international application shall be ~~filed~~ in any language which the receiving Office accepts for that purpose.

(b) For the purposes of paragraph (a), each ~~Each~~ receiving Office shall, ~~for the filing of international applications,~~ accept at least one language which is both:

(i) a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office, and

(ii) a language of publication.

(c) Notwithstanding paragraph (a), the request shall be ~~filed~~ in a language which is both a language accepted by the receiving Office under that paragraph and a language of publication.

[Rule 12.1, continued]

(d) Notwithstanding paragraph (a), any text matter contained in the sequence listing part of the description referred to in Rule 5.2(a) shall be **presented** in accordance with the standard provided for in the Administrative Instructions.

[COMMENT: See PLT Article 6(2). The proposed amendments of Rule 12.1 aim at clarifying that the requirements of Rule 12.1 are not filing date related.]

12.2 Language of Changes in the International Application

[COMMENT: Further changes to Rule 12.2 will be necessary when agreement has been reached on the basic approach to be taken with regard to the language of the international application and translations (see Rule 12.3), with a view to keeping the number of languages in which corrections and rectifications need to be furnished are required to the minimum necessary.]

(a) Any amendment of the international application shall, subject to Rules 46.3, 55.3 and 66.9, be in the language in which the application is filed.

(b) Any rectification under Rule 91.1 of an obvious error in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), ~~48.3(b)~~ or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language of the application and the language of that translation;

[Rule 12.2, continued]

(ii) where a translation of the request is required under Rule 12.3(b-bis) ~~26.3ter(e)~~,
rectifications referred to in Rule 91.1(e)(i) need only be filed in the language of that
translation.

[COMMENT: The proposed amendments of items (i) and (ii) of paragraph (b) are
consequential on the proposed deletion of Rule 48.3(b) and the proposed amendment of
Rule 12.3(b-bis).]

(c) Any correction under Rule 26 of a defect in the international application shall be in
the language in which the international application is filed, provided that:

(i) where a translation of the international application is required under
Rule 12.3(a), any correction shall be filed in the language of that translation; where the
language of that translation is not accepted by the receiving Office under Rule 12.1(a), any
correction shall be in both the language in which the international application is filed and the
language of that translation;

(ii) where a translation of the request is required under Rule 12.3(b-bis), any
correction need only be filed in the language of that translation.

(c-bis) Any correction under Rule 26 of a defect in a translation of the international
application furnished under Rule 12.3(a) or 55.2(a), or in a translation of the request furnished
under Rule 12.3(b-bis) ~~26.3ter(e)~~, shall be in the language of the translation.

[COMMENT: The proposed amendments of present paragraph (c) would ensure that all
corrections offered by the applicant under Rule 26, including any claims furnished after the
filing of the international application under Rule 26.3ter(a) as proposed to be amended (see
below), would be in a language in which the receiving Office can process the application, in a
language in which international search can be carried out and in the language of publication.]

12.3 Translation for the Purposes of Receiving Office Processing, International Search or International Publication

(a) Where the language in which the international application is filed is not accepted by the receiving Office under Rule 12.1(a), is not accepted by the International Searching Authority that is to carry out the international search or is not a language of publication, the applicant shall, within one month from the date of receipt of the international application by the receiving Office, furnish to that Office a translation of the international application into a language which is all of the following:

(i) a language accepted by that Authority, unless the international application was filed in such a language; and

(ii) a language of publication;~~;~~ and

(iii) a language accepted by the receiving Office under Rule 12.1(a), unless the international application ~~was~~ is filed in such a language ~~a language of publication~~.

[COMMENT: Rule 12.3(a) is proposed to be amended so as to cover all language-related requirements with regard to receiving Office processing, international search and international publication in the same Rule; see also Rule 48.3(b) which is proposed to be deleted.

Rules 12.3(a) and 35 as proposed to be amended, when read together with the provisions of the Agreements between the International Bureau and the International Searching Authorities, may in certain (rare) cases limit the competency of a particular ISA to carry out international search for a particular international application filed with a particular receiving Office in a particular language. *Example:* an international application is filed in Chinese with the Mexican Institute of Industrial Property as receiving Office (RO/MX); RO/MX has specified the Spanish Patent and Trademark Office (ISA/ES) and the European Patent Office (ISA/EP) as competent ISAs. In order to comply with the language requirements under Rule 12.3(a), the applicant will have to furnish a translation into Spanish, the only language accepted by RO/MX for the processing of international applications; Spanish, however, is not accepted by the ISA/EP for international search, so that ISA/EP, under the applicable agreement between WIPO and ISA/EP and Rule 35 as proposed to be amended, is not competent, and thus cannot be chosen by the applicant, to carry out the international search for this particular international application.

[Rule 12.3(a), Comment, continued]

Possible alternative approaches to that issue which the Working Group may wish to consider include: (i) allow for two translations to be furnished by the applicant (one for the purposes of RO processing, one for the purposes of international search); or (ii) require each receiving Office to accept, under Rule 12.1(a), with regard to each ISA specified by that Office as competent to carry out international searches for international applications filed with it, at least one language which is accepted by that ISA.]

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

(b-bis) Where the request does not comply with Rule 12.1(c), the applicant shall, within the time limit under paragraph (a), furnish to the receiving Office a translation of the request so as to comply with that Rule.

[COMMENT: Proposed new paragraph (b-bis) is based on the wording of present Rule 26.3~~ter~~(c) which is proposed to be deleted (see below) so as to combine all language-related requirements in Rule 12.]

[Rule 12.3, continued]

(c) Where ~~by the time the receiving Office sends to the applicant the notification under Rule 20.5(e)~~, the applicant has not within the time limit under paragraph (a), furnished any a translation required under paragraph (a) or (b-bis), the receiving Office shall, ~~preferably together with that notification~~, invite the applicant: (i) to furnish the required translation within ~~the time limit under paragraph (a)~~; (ii) ~~in the event that the required translation is not furnished within the time limit under paragraph (a), to furnish it and to pay, where applicable, the late furnishing fee referred to in paragraph (e)~~, within two ~~one~~ months from the date of the invitation ~~or two months from the date of receipt of the international application by the receiving Office, whichever expires later~~.

[COMMENT: It is proposed to amend paragraph (c) so as to eliminate the present requirement for receiving Offices to first “remind” the applicant about the obligation to furnish any required translation within one month from the date of receipt of the international application and, at the same time, to eliminate the entitlement of receiving Offices to require the payment of a late furnishing fee. Instead, following the expiration of that one-month time limit, the Office will directly invite the applicant to furnish any missing translation. With regard to the new time limit for the furnishing of any missing translation (two months from the date of the invitation), see PLT Article 6(7) and PLT Rule 6(1). Note that paragraph (c) as proposed to be amended now covers language defects related to both the international application (paragraph (a)) and the request (paragraph (b-bis)).]

[Rule 12.3, continued]

(d) Where ~~the receiving Office has sent to the applicant an invitation under paragraph (c) and~~ the applicant has not, within the applicable time limit under paragraph (e) ~~(c)(ii)~~, furnished any ~~the required~~ translation required under paragraph (a) or (b-bis) ~~and paid any required late furnishing fee~~, the international application shall be considered withdrawn and the receiving Office shall so declare. ~~Any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 15 months from the priority date shall be considered to have been received before the expiration of that time limit.~~

(e) The time limit referred to in paragraph (d) shall be:

- (i) where an invitation under Rule 12(3)(c) was sent to the applicant, the date specified in that invitation;
- (ii) where no invitation under Rule 12(3)(c) was sent to the applicant, three months from the date on which one or more of the elements referred to in Article 11(1)(iii) were first received.

Any translation received by the receiving Office before that Office makes the declaration under paragraph (d) shall be considered to have been received before the expiration of the applicable time limit under this paragraph.

[Rule 12.3, continued]

~~(e) The furnishing of a translation after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to 50% of the basic fee.~~

[COMMENT: With regard to the time limits, see PLT Articles 6(7) and 6(8) and PLT Rules 6(1) and (2). While the PLT provides for the longer three-month time limit only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed,” it is proposed to apply that longer three-month time limit in all cases where no invitation has been sent to the applicant, irrespective of whether or not indications allowing the applicant to be contacted had been filed. With regard to the last sentence of paragraph (e), it is further proposed to retain the text of previous paragraph (d) (slightly amended) so as to make sure that any translation furnished by the applicant after the expiration of the time limit under paragraph (d) is still accepted by the receiving Office as long as that Office has not yet made the declaration that the international application is considered withdrawn. Finally, in the context of revising all language related requirements, it is proposed to eliminate the late furnishing fee (for the benefit of the receiving Office) where the translation of the international application is furnished only upon invitation.]

Rule 19

The Competent Receiving Office

19.1 to 19.3 [No change]

19.4 *Transmittal to the International Bureau as Receiving Office*

(a) Where an international application is filed with a national Office which acts as a receiving Office under the Treaty but

(i) [No change]

(ii) the elements referred to in Article 11(1)(iii)(a) and (c) are ~~that international application is~~ not in a language accepted under Rule 12.1(a) by that national Office but are ~~is~~ in a language accepted under that Rule by the International Bureau as receiving Office, or

(iii) [No change]

that international application shall, subject to paragraph (b), be considered to have been received by that Office on behalf of the International Bureau as receiving Office under Rule 19.1(a)(iii).

[COMMENT: The proposed amendment of item (ii) is consequential on the proposed amendment of Rule 20.4(c) (see below).]

(b) and (c) [No change]

Rule 20

Receipt of the International Application

20.1 to 20.3 [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, changes proposed to Rules 20.2 and 20.3 in Annex I to this document.]

20.4 *Determination Under Article 11(1)*

(a) and (b) [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, proposed addition of new Rules 20.4(a-*bis*) and 20.4(b-*bis*) in Annex I to this document.]

(c) For the purposes of Article 11(1)(ii), it shall be sufficient that the elements referred to in Article 11(1)(iii)(a) and (c) ~~the part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims~~ be in a language accepted by the receiving Office under Rule 12.1(a).

[COMMENT: See PLT Article 5(2). It is proposed to amend paragraph (c) so as to align the PCT language-related filing date requirements with those of the PLT. Under paragraph (c) as proposed to be amended, the international application could be filed, for the purposes of the international filing date, in any language (with the exception of the name of the applicant and the indication that the application is intended as an international application; those elements would have to be filed, for the purposes of the international filing date, in a language accepted by the receiving Office under Rule 12.1(a)).]

[Rule 20.4, continued]

(d) [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, changes proposed to Rule 20.4(d) and proposed addition of new Rules 20.4(e) to (i) in Annex I to this document.]

20.5 to 20.7 [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, changes proposed to Rules 20.5, 20.6 and 20.7, and proposed addition of new Rule 20.6*bis*, in Annex I to this document.]

Rule 23

Transmittal of the Search Copy, Translation and Sequence Listing

23.1 Procedure

(a) Where no furnishing of a claim is required under Rule 26.3ter(a) and no translation of the international application is required under Rule 12.3(a), the search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau unless no search fee has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.

(b) Where

(i) any claim is furnished under Rule 26.3ter(a) or

(ii) a translation of the international application is furnished under Rule 12.3(a),

a copy of any such claim or of any such ~~that~~ translation and of the request, which together shall be considered to be the search copy under Article 12(1), shall be transmitted by the receiving Office to the International Searching Authority, unless no search fee has been paid. In the latter case, a copy of any such claim or any such ~~the said~~ translation and of the request shall be transmitted promptly after payment of the search fee.

[COMMENT: Consequential on the proposed amendment of PCT Rules 20.4(d) (see above) and 26.3ter (see below).]

[Rule 23.1, continued]

(b-bis) Paragraph (b)(ii) shall not apply [and paragraph (a) shall apply] where the language in which the application is filed is accepted by the International Searching Authority that is to carry out the international search.

[COMMENT: It is proposed to add new paragraph (b-bis) so as to ensure that international search can be carried out on the basis of the international application as filed even where the language in which the application was filed is not accepted by the receiving Office under Rule 12.1(a) and/or is not a language of publication. Examples: (i) international application filed in Swedish with RO/SE, international search to be carried out by ISA/SE in Swedish, international publication in the language of the translation required under Rule 12.3(a); (ii) international application filed in English with RO/MX, international search to be carried out by ISA/EP in English, international publication in the language of the translation required under Rule 12.3(a), that is, in Spanish.]

(c) [No change]

Rule 26

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

26.1 and 26.2 [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, changes proposed to Rules 26.1 and 26.2 in Annex I to this document.]

26.3 *Checking of Physical Requirements Under Article 14(1)(a)(v)*

(a) Where no translation of the international application ~~is filed in a language of publication~~ has been furnished under Rule 12.3(a), the receiving Office shall check:

~~(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;~~

~~(ii) any translation furnished under Rule 12.3 for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.~~

[Rule 26.3, continued]

(b) Where a translation of the international application has been furnished under Rule 12.3(a) ~~is filed in a language which is not a language of publication~~, the receiving Office shall check:

(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction;

(ii) any translation furnished under Rule 12.3(a) and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

[COMMENT: Consequential on the proposed amendment of Rule 12.3(a) and the proposed amendment of Rule 48.3(a), (a-bis) and (b).]

26.3bis to 26.6 [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, changes proposed to Rules 26.3ter, 26.5 and 26.6 in Annex I to this document.]

Rule 35

The Competent International Searching Authority

35.1 [No change]

35.2 *When Several International Searching Authorities Are Competent*

(a) Any receiving Office may, in accordance with the terms of the applicable agreement referred to in Article 16(3)(b), specify several International Searching Authorities:

(i) by declaring all of them competent for any international application filed with it, and leaving the choice, [subject to paragraph \(a-bis\)](#), to the applicant, or

(ii) by declaring one or more competent for certain kinds of international applications filed with it, and declaring one or more others competent for other kinds of international applications filed with it, provided that, for those kinds of international applications for which several International Searching Authorities are declared to be competent, the choice shall, [subject to paragraph \(a-bis\)](#), be left to the applicant.

[Rule 35.2, continued]

(a-bis) The choice of the applicant under paragraph (a) shall be limited to those International Searching Authorities which, under the applicable agreement referred to in Article 16(3)(b), accept the international application in the language in which it is filed or into which it has been translated under Rule 12.3(a).

[COMMENT: Although such a provision would not be needed given the wording of the present Agreements between the International Bureau and the national and regional Offices that act as International Searching Authorities, it is proposed to amend paragraph (a) and to add a new paragraph (a-bis) so as to clarify that the competency of a particular International Searching Authority to carry out international search with regard to a particular application also depends, among other things, on the language in which the international application is filed or the language into which the international application is translated under Rule 12.3(a). See also Rule 12.3(a) as proposed to be amended, above.]

(b) [No change]

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

(a) [No change]

(b) Where two or more International Searching Authorities are competent under paragraph (a), the choice shall, subject to Rule 35.2(a-bis), be left to the applicant.

(c) [No change]

Rule 48

International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”) and no translation has been furnished under Rule 12.3(a), that application shall be published in the language in which it was filed.

(a-*bis*) If a translation of the international application ~~is not filed in a language of publication and a translation into a language of publication~~ has been furnished under Rule 12.3(a), that application shall be published in the language of that translation.

[Comment: The proposed amendments of paragraphs (a) and (a-*bis*) are consequential on the proposed amendment of Rule 12. The result of the proposed amendments would be that, different from today’s situation, where an international application is filed in a publication language and a translation is furnished under Rule 12.3(a), that application would be published in the language of that translation and not in the language in which it was filed (as is the case today).]

[Rule 48.3, continued]

(b) ~~[Deleted] If the international application is filed in a language which is not a language of publication and no translation into a language of publication is required under Rule 12.3(a), that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the relevant portions of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.~~

[COMMENT: The proposed deletion of paragraph (b) is consequential on the proposed amendment of Rule 12 (see above). The result of the proposed deletion of paragraph (b) and the proposed amendment of Rule 12.3(a) would be that the applicant would be responsible for the preparation of a translation of the international application complying with the requirements under Rule 12.3(a); at present, where the international application is filed in a language which is accepted by the receiving Office and by the International Searching Authority that is to carry out the international search but is not a language of publication, it is the International Searching Authority who is responsible for the establishment of a translation of the international application into a language of publication.]

[Rule 48.3, continued]

(c) [No change]

48.4 to 48.6 [No change]

[Annex III follows]

ANNEX III

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RIGHT OF PRIORITY AND PRIORITY CLAIMS

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Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, [that date](#) being, [subject to Rule 26bis.3](#), a date falling within the period of 12 months preceding the international filing date ([“the priority period”](#));

[COMMENT: The definition of “priority period” has been added for the purposes of proposed new Rule 26bis.3 (see below).]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 17

The-Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed (“the priority document”), shall, unless [that priority document has](#) already [been](#) filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraphs (b) [and \(b-bis\)](#), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

[COMMENT: See proposed new paragraph (b-bis), below.]

(b) [No change]

[Rule 17.1, continued]

(b-bis) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library, the applicant may, instead of submitting the priority document:

(i) request the receiving Office to obtain the priority document from such digital library and to transmit it to the International Bureau; or

(ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

[COMMENT: See PLT Rule 4(3). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the receiving Office or the International Bureau for the purposes of this paragraph.]

(c) If the requirements of ~~none~~ ~~neither~~ of the ~~three~~ ~~two~~ preceding paragraphs are complied with, any designated ~~Office~~ ~~State~~ may, subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

[Rule 17.1, continued]

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with the designated Office in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to the designated Office from a digital library.

[COMMENT: See PLT Rule 4(3). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the designated Office for the purposes of this paragraph.]

17.2 [No change]

Rule 26bis

Correction or Addition of Priority Claim; Restoration of Priority Claim

26bis.1 and 26bis.2 [No change]

26bis.3 Delayed Filing of the International Application; Restoration of Priority Claim

(a) The receiving Office shall, at the request of the applicant and subject to paragraphs (b) and (c), restore a priority claim where international application has an international filing date which is later than the date on which the priority period referred to in Rule 4.10(a)(i) has expired, if:

[COMMENT: See PLT Article 13(2)]

(i) the international application has been accorded an international filing date which is within a time limit of two months from the date on which the priority period expired;

[COMMENT: See PLT Article 13(2) and PLT Rule 14(4)(a).]

(ii) the request for restoration of priority right is submitted to the receiving Office within a time limit of two months from the date on which the priority period expired or before the technical preparations for international publication have been completed, whichever expires earlier;

[COMMENT: See PLT Article 13(2)(ii) and PLT Rule 14(4)(b)]

[Rule 26bis.3(a), continued]

(iii) the receiving Office finds that the failure to file the international application within the priority period was unintentional.

[COMMENT: See PLT Article 13(2)(iv), which leaves it at the option of each PLT Contracting State to decide whether the Office requires the failure to file the subsequent application to have been “unintentional” or that it “occurred in spite of due care required by the circumstances having been taken”. In the context of the PCT, it is proposed to apply the more generous requirement that the failure was “unintentional”].

(b) The request referred to in paragraph (a)(ii) shall:

(i) state the reasons for the failure to comply with the priority period;

[COMMENT: See PLT Article 13(2)(iii).]

(ii) be accompanied, where the international application did not claim the priority of the earlier application, by a notice adding the priority claim so as to comply with the requirements of Rule 4.10.

[COMMENT: See PLT Rule 14(5)(ii).]

[Rule 26bis.3, continued]

(c) The receiving Office:

(i) may require that a fee in respect of a request referred to in paragraph (a)(ii) be paid:

[COMMENT: See PLT Article 13(4).]

(ii) may require that a declaration or other evidence in support of the reasons referred to in paragraph (b)(i) be filed within a time limit which shall be reasonable under the circumstances:

[COMMENT: See PLT Article 13(5).]

(iii) shall not refuse, totally or in part, a request under paragraph (a)(ii) without the applicant being given the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[COMMENT: See PLT Article 13(6).]

[Rule 26bis.3, continued]

(d) Where the restoration of a priority claim under paragraph (a) causes a change in the priority date, Rule 26bis.1(c) shall apply *mutatis mutandis*.

[COMMENT: Proposed new paragraph (d) is needed so as to ensure that, where the restoration of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.]

(e) Where the receiving Office has refused a request under paragraph (a)(ii) or where such request is still pending at the time of completion of the technical preparations for international publication, the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning that request for restoration of priority right. A copy of the request under this paragraph shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: New paragraph (e) is proposed to be added as a safeguard for the applicant where his request for the restoration of a priority claim has been refused or has not been decided upon by the time the international application is to be published so as to enable him to pursue the matter further, after national phase entry, before the designated Offices concerned; see also Rule 26bis.2(c), which has been used as a model for the wording of new paragraph (e). New Sections in the Administrative Instructions, similar to Sections 314 and 402 in respect of the correction and addition of priority claims, would also be required]

[Rule 26bis.3, continued]

(f) Where the receiving Office has restored a priority claim under paragraph (a), no designated Office shall disregard that priority claim only because the international application has an international filing date which is later than the date on which the priority period referred to in Rule 4.10(a)(i) has expired.

[Comment: New paragraph (f) is proposed to be added so to clarify that designated Offices, during the national phase, would have to respect the decision taken by the receiving Office during the international phase.]

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 to 66.6 [No change]

[COMMENT: No change is proposed in the context of this Annex; see, however, Rule 66.2 as proposed to be amended in Annex I to this document.]

66.7 *Copy and Translation of Earlier Application Whose Priority is Claimed* ~~*Document*~~

(a) If the International Preliminary Examining Authority needs a copy of the earlier application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1, and if that earlier application was not filed with that Authority in its capacity as a national Office and the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, the international preliminary examination report may be established as if the priority had not been claimed.

[COMMENT: See PLT Rule 4(3). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the International Preliminary Examining Authority for the purposes of this paragraph.]

[Rule 66.7, continued]

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority [and the validity of the priority claim is relevant to the formulation of an opinion under Article 35\(1\)](#), that Authority may invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

[COMMENT: See PLT Rule 4(4).]

66.8 and 66.9 [No change]

[End of Annex III and of document]