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IMPROVED COORDINATION OF  
INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION  
AND THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE:

EXPANDED INTERNATIONAL SEARCH SYSTEM

*Document prepared by the International Bureau*

## BACKGROUND

1. At its first session held in November 2001, the Working Group discussed proposals for an expanded international search report (EISR).<sup>1</sup> This document<sup>2</sup> contains revised proposals. The Working Group's discussions are outlined in paragraphs 7 to 10 of the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) ("first session summary"):

"7. Discussions were based on documents PCT/R/WG/1/2, 3, 3 Add.1, 3 Add.2 and 7, focusing on a proposed system for an expanded international search report (EISR),

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<sup>1</sup> See WIPO's Internet site at [http://www.wipo.int/pct/en/meetings/reform\\_wg/index\\_1.htm](http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm).

<sup>2</sup> This and other working documents for the present session are available on WIPO's Internet site at [http://www.wipo.int/pct/en/meetings/reform\\_wg/reform\\_wg2.htm](http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm).

which would include an opinion of the examiner in addition to the present contents of the ISR proper.

“8. The general concept of the proposed EISR 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 and EOs, 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. While it was recognized that other proposals for reform of the PCT search and examination system might be elaborated, none had been put forward so far, and the EISR proposal was a useful starting point for discussion.

“9. The comments and concerns expressed by various delegations as to the implications of a possible EISR system included the following:

- (i) while the heavy workload faced by some ISAs and IPEAs was an important feature in the background, proposals which merely deferred the problem or shifted workload onto applicants or other Offices were not the most satisfactory;
- (ii) any increase in fees associated with the proposed EISR system compared to the present fees for IS would be a matter for serious concern, particularly for inventors and small enterprises; suggestions made by the larger ISAs as to maintaining the present fees for EISR, or containing any increases, and offsetting any increase by a reduction of the fees for IPE were, however, encouraging;
- (iii) the proposal was seen by certain delegations as a valuable step in the direction of greater mutual recognition of search and examination results and eventually towards the development of a world patent system;
- (iv) while recognizing the efficiencies that would result from search and examination being undertaken by the same examiner at the same time, some delegations would prefer to retain a separated system, at least as an option for applicants and/or Authorities;
- (v) some delegations felt that the EISR system, if adopted, should be optional for applicants, particularly if it would involve payment of higher fees at the time of filing the application; other delegations felt that the EISR system should be mandatory, particularly having regard to the consequences of the Assembly’s adoption of a 30-month time limit under Article 22;
- (vi) it was agreed that the EISR should be produced as part of the IS rather than the IPE procedure;
- (vii) while the examiner’s opinion and the ISR proper should, under an EISR system, be established at the same time by the same examiner, a number of delegations felt that the two components could, and should, then be processed separately;

- (viii) delegations differed as to whether the examiner's opinion should be made public or remain confidential between the ISA, DOs and the applicant; some believed that the opinion would contain little more of substance than the ISR proper, and should therefore be published with it; others believed that public availability of a negative opinion could be unfairly damaging, particularly if the applicant had no chance to rebut it;
- (ix) the interest of DOs in receiving the EISR, particularly smaller DOs, including those in developing countries, was clearly recognized;
- (x) many delegations expressed concern at the suggestion that the EISR might not be available in sufficient time to enable the applicant to withdraw the application before its publication if the EISR was negative; it was also noted, however, that certain ISAs are in any event finding difficulty in meeting the present time limit for producing ISRs;
- (xi) most delegations believed that IPE following the issuance of an EISR should not be mandatory but rather that it should follow only if the applicant so requested;
- (xii) while the maximum advantage from the EISR procedure would accrue if the same examiner carried out both the EISR and any subsequent IPE, it was not necessary to require that the same Authority must conduct both the IS and the IPE; it was already possible for IPEAs to declare themselves prepared to examine only those applications which they have searched as ISA, and certain IPEAs had already exercised that option;
- (xiii) while certain delegations believed that an EISR should be confined to an elaboration of details contained in the ISR, most delegations felt that it should cover similar matters to those dealt with in the present first written opinion in the IPE procedure;
- (xiv) certain delegations emphasized the distinction between, on the one hand, publication of the opinion part of the EISR as part of the published pamphlet, which could be unfairly damaging to applicants, and, on the other, making it available for public inspection like other parts of the application file;
- (xv) concern was expressed that the EISR procedure might add new burdens on the IB to prepare a translation of the opinion during the international phase and on applicants to prepare translations of comments for the purposes of the national phase;
- (xvi) the operation of the EISR procedure should be as simple as possible.

*“Expanded international search (EIS) system: Possible features*

“10. It was agreed that the International Bureau should prepare a revised proposal, along the lines of the system outlined in the following subparagraphs, for consideration by the Working Group at its next session:<sup>3, 4</sup>

(a) For all international applications, the examiner in the ISA would, as part of the IS procedure, prepare a more detailed opinion (ISO) at the same time as preparing the ISR.

(b) The scope and contents of the ISO would be similar to the present first written opinion in the IPE procedure (see Rule 66.2(a)).

(c) The ISR should be published, as at present, with the international application itself (that is, 18 months from the priority date). It was recognized, however, that certain ISAs are facing difficulties in meeting the present deadline for production of ISRs and that that problem may need to be addressed soon, and certain delegations felt that increased flexibility in the time limit for establishing the ISR and ISO would be necessary.

(d) The ISO would be communicated to the applicant with the ISR.

(e) The applicant would have to choose which of the following options to pursue:

(i) request IPE within, say, [two months from the date of the ISO] [25 months from the priority date];

(ii) submit to the IB comments on the ISO (and the ISR) and/or submit Article 19 amendments and an accompanying statement;

(iii) withdraw the application;

(iv) do nothing.

(f) If the applicant requested IPE:

(i) the processing of the application would be governed by Chapter II;

(ii) the ISO would, if the same Office acted in the capacity of ISA and IPEA, be treated as a first written opinion in the IPE procedure; if different Offices carried out the IS and the IPE, the IPEA would be entitled, but would not be obliged, to treat the ISO as the first written opinion in the IPE procedure;

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<sup>3</sup> All references to time limits in the following subparagraphs should be understood as subject to review in the context of paragraph 10(o).

<sup>4</sup> Square brackets indicate that alternatives would be included in the revised proposals.

- (iii) [the ISO would remain confidential as against third parties and DOs and EOs until such time as the IPER was established and the IPE file became available to public inspection (via the EO); if the demand was withdrawn before establishment of the IPER, the application would revert to Chapter I and the ISO would be made available for public inspection accordingly] [the ISO should be available for public inspection at an earlier stage, noting the interest of third parties in having access to it, even when IPE was requested];
  - (iv) any comments responding to the ISO would be treated as being submitted as arguments and/or amendments under Article 34;
  - (v) the IPER would be established and communicated in the usual way.
- (g) If the applicant did not request IPE:
- (i) the processing of the application would be governed by Chapter I;
  - (ii) the ISO, together with any comments, would be sent to DOs;
  - (iii) the ISO, together with any comments, would be made available for public inspection by the IB; when the IB's systems so permitted, this would be done by electronic means;
  - (iv) the ISO and any comments would not be included in the published pamphlet (or its electronic equivalent);
  - (v) the ISO would be made available for public inspection [at the expiry of the time limit for requesting IPE] [after the expiry of the time limit for submitting comments] [at a time corresponding to the time at which the IPER would normally issue (say, 28 months from the priority date)];
  - (vi) any Article 19 amendments and statement would, as at present, be published together with the published pamphlet (or its electronic equivalent) (unless the ISR was not yet available, in which case the amendments and statement would be published later).
- (h) Comments would need to be submitted at an early stage in order to be taken into account during the IPE procedure. If IPE was not requested, they should be submitted before the ISO was made publicly available if they were to be made available with the ISO, but comments submitted later in the international phase could still be made available and taken into consideration during the national phase.
- (i) Possibilities for greater incorporation of the Article 19 procedure into the EIS system should be investigated.
- (j) [If the applicant withdrew the application before its publication, the ISR would not be published and the ISO would not be made available for public inspection.] [If the ISR and ISO did not become available in sufficient time to enable withdrawal of

the application before its publication, the ISO would not be made available for public inspection if the applicant withdrew the application forthwith after receiving them.]

(k) Provision should be made to enable the demand to be filed, if the applicant so wished, at the same time as the filing of the application; in such a case:

- (i) the IPE would not commence until the necessary fees had been paid; those fees would not need to be paid at the time of filing but would fall due at the expiration of the time limit for requesting IPE;
- (ii) new possibilities for a combination of IS and IPE, such as was presently envisaged in present Rule 69.1(b), should be investigated and improved procedures for such a combined procedure should be developed.

(l) An outer time limit should be fixed for requesting IPE; the IPEA would be entitled to refuse to proceed with the IPE if it was requested after the expiration of that time limit.

(m) A system should also be introduced to enable the IPEA to be made available for public inspection by the IB, on behalf of the EOs.

(n) Appropriate provision should be made to enable applicants to give notice of proposed amendments of the description and drawings (as well as the claims) in comments filed in response to the ISO, and for those proposed amendments to be taken into account by DOs in the event that the applicant did not request IPE.

(o) The fixing of appropriate time limits would require consideration of the following issues:

- (i) special provision should be made for international applications not claiming priority (PCT “first filings”) as, for example, the time limits under present Rule 46;
- (ii) the time limit for submitting comments on an ISO should enable them to be submitted in time to be made available for public inspection together with the ISO;
- (iii) the time limits for filing a demand and for filing amendments under Article 34 should be reviewed so as to ensure optimal coordination of the EIS and IPE procedures;
- (iv) earlier time limits may need to apply in cases where the same Office did not act in the capacity of both ISA and IPEA;
- (v) the need for flexibility for applicants and Authorities in meeting various different requirements would need to be balanced against the need for a system with clear and certain operation.

(p) Further consideration needed to be given to requirements relating to the language and possibly translations of the ISO and any comments submitted on it (noting

that the ISR and IPER are presently translated by the IB into English, and applicants are presently required to furnish translations of the application and annexes to the IPER for the purposes of the national phase).”

## FEATURES OF THE PROPOSED EXPANDED INTERNATIONAL SEARCH SYSTEM

2. Proposed amendments of the Regulations<sup>5</sup> for introducing an expanded international search system, taking into account, to the extent possible, the points mentioned in paragraphs 7 to 10 of the first session summary, are set out in the Annex.<sup>6</sup> The key features of the proposed system are outlined in the following paragraphs.

### *Establishment of ISO*

3. With regard to every international application (IA), the International Searching Authority (ISA) would establish, at the same time that it establishes the international search report (ISR), a non-binding, preliminary “international search opinion” (ISO) (see paragraph 10(a) of the first session summary). The ISO would contain an opinion as to whether the IA 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; (ii) whether the IA complies with the requirements of the Treaty and the Regulations (so far as checked by the ISA); and (iii) any observations corresponding to those referred to in Article 35(2), last sentence. In other words, the scope of the ISO would be similar to the present written opinion in the international preliminary examination (IPE) procedure, except that, unlike the written opinion, the ISO would always be issued even if all of the conditions referred to in Article 34(2)(c) are fulfilled (see paragraph 10(b) of the first session summary). In this latter sense, the ISO would correspond more to the present IPER than to the first written opinion.

4. The time limit for establishing the ISO would be the same as that currently applicable for the ISR (see Rule 42.1), that is, three months from the date of receipt by the ISA of the search copy or 9 months from the priority date, whichever time limit expires later. The presently proposed amendments do not attempt to deal expressly with the possibility of a later time limit for the establishment of the ISR (see paragraph 10(c) of the first session summary and paragraphs 41 and 42, below).

5. The ISO would be established in the language in which the international search report is established. In order to ease the burden on the International Bureau (IB), which would be obliged to translate the ISO, if not in English, into English, and so as to reduce the costs for the International Bureau and keep the fees payable by the applicant to a minimum (see

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<sup>5</sup> References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc.

<sup>6</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

paragraph 10(p) of the first session summary), the Working Group may, however, wish to consider an alternative approach under which the ISO would be established, at the option of the ISA, either in English or in the language in which the international search report is established. In this context, the Working Group may also wish to consider applying the same approach to the establishment of the ISR and the IPER and to allow the Authorities to establish those reports, if so wished, in English. With regard to the language of the comments on the ISO furnished by the applicant, see paragraph 15, below.

#### *Communication of ISO to applicant*

6. The ISO would be communicated by the ISA, together with the ISR, to the applicant and to the IB (see paragraph 10(d) of the first session summary).

#### *Options for the applicant*

7. After having received the ISR and the ISO, the applicant would have the choice of the following options to pursue (see paragraph 10(e) of the first session summary):

- (i) submit to the IB comments on the ISO (see paragraph 8, below); and/or
- (ii) submit to the IB amendments of the claims under Article 19.1 (see paragraph 16, below; and/or
- (iii) request international preliminary examination (IPE) (see paragraphs 25 to 33, below);

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

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

#### *Comments on the ISO*

8. After the receipt of the ISO, the applicant would be entitled to one opportunity to submit to the International Bureau (IB) comments on the ISO.

9. The main purpose of such comments would be to give the applicant an opportunity to rebut any opinion contained in the ISO with which he does not agree, noting that the ISO will be communicated to the designated Offices (DOs) (see paragraphs 19 and 20, below) and will be made available for public inspection (see paragraphs 22 and 23, below). Such opportunity would appear to be of particular importance in cases where no demand for IPE is submitted and thus no opportunity exists (besides any amendment of the claims under Article 19) to amend the international application during the international phase.

10. Furthermore, as had been suggested in paragraphs 10(f)(iv) of the first session summary, it is proposed to provide for the possibility that proposed amendments outlined in the comments on the ISO may be treated as amendments of the application, provided that they are clearly identified as amendments and provided that they would only need to be taken into account by the IB (under Article 19) or, where a demand had been submitted, by the IPEA



(under Article 34) if the requirements under Articles 19 and 34, respectively, and the requirements under the corresponding Rules, were met.

11. As regards the possibility of giving notice of proposed amendments to DOs in the comments on the ISO, it is proposed, as has been suggested in paragraph 10(n) of the first session summary, to provide for the possibility that proposed amendments outlined in the comments on the ISO may be treated as amendments of the application under Article 28. Such amendments would be required to be clearly identified as amendments and would only need to be taken into account by the DO if the requirements under Article 28 and the requirements under corresponding Rule 52 were met.

12. Where no demand is submitted, it is proposed to give the applicant the opportunity to submit comments within a time limit of 28 months from the priority date so as to ensure that the comments are available in time for being communicated, together with the ISO, to the DOs and for being made available, together with the ISO, for public inspection (both proposed to take place promptly after the expiration of 30 months from the priority date, see paragraphs 19 and 22, below; see also paragraph 10(h) and (o)(ii) of the first session summary).

13. Where a demand is submitted, it is proposed to give the applicant the opportunity to submit comments only until the time of filing of the demand, noting that, after the filing of the demand, the processing of the application would be governed by Chapter II and that the applicant would have other possibilities of rebutting the ISO, such as by submitting arguments and/or amendments under Article 34.

14. The same time limits for submitting comments would apply to both IAs claiming priority and IAs not claiming priority – no special provision would appear necessary in the case of the latter (as had been suggested in paragraph 10(o)(i) of the first session summary).

15. In order to ease the burden on the applicant (who, upon entry into the national phase, normally would have to translate any comments on the ISO for the purposes of the national phase procedure), it is proposed to give the applicant the option of furnishing the comments on the ISO either in English or in the language of publication and to require all DOs to accept, for the purpose of the national phase, comments in English (see paragraph 10(p) of the first session summary and paragraph 35, below).

#### *Amendments of the claims under Article 19*

16. As at present, after the receipt of the ISR (and the ISO), 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 the national law of DOs. While, in general, such Article 19 amendments would be distinct from, and processed separately and differently from, any comments on the ISO submitted by the applicant, such amendments may be included in any comments on the ISO and, under certain conditions, be taken into account as amendments under Article 19 (see paragraph 10, above). Of course, such amendments under Article 19 could include amendments to the claims filed in response not only to the ISR but also in response to the ISO, without the need for the amendments to be specifically indicated as being filed in response to one or the other (see also paragraph 10(i) of the first session summary).

*International publication*

17. Unless the applicant has withdrawn the IA, the IA would, as at present, be published promptly after the expiration of 18 months from the priority date, together with the ISR and any Article 19 amendments of the claims but without the ISO or any comments thereon furnished by the applicant (see paragraph 10(c) of the first session summary). Both the ISO and any comments thereon would remain confidential until a later date (see paragraphs 18 to 24, below).

*Confidentiality of ISO and of comments thereon*

18. The ISO and any comments thereon furnished by the applicant would remain confidential as against third parties and DOs until such time as, had a demand been filed, the IPER would have been established and the IPE file became available for public inspection (via the EOs) (see paragraph 10(g)(v) of the first session summary, third square-bracketed option). Since this is usually the case only after the expiration of 30 months from the priority date, it is proposed to apply the same time limit to both the communication to DOs of the ISO and any comments thereon (see paragraphs 19 to 21, below) and to the making available for public inspection of those documents (see paragraphs 22 to 24, below). The first square-bracketed option in paragraph 10(g)(v) of the first session summary, namely making the ISO available for public inspection at the expiration of the time limit for requesting IPE, has not been included at this stage. Although, strictly speaking, if no demand had been filed, Article 38 would not be applicable, given the similarity between ISO and written opinion, it would appear preferable to apply, with regard to confidentiality, the same principles to the ISO as are applied to the written opinion (and the IPER). The approach proposed in this document appears to be in line with the second square-bracketed option in paragraph 10(g)(v) of the first session summary, namely, making the ISO and any comments available after the expiration of the time limits for submitting comments (see paragraph 12, above).

*Communication of ISO and of comments thereon to designated Offices*

19. As indicated above, the ISO and any comments thereon furnished by the applicant would be communicated to DOs at 30 months from the priority date, that is, at the same point in time at which, had a demand been filed, the IPER would have been established and the IPE file would have become available for public inspection (via the EOs) (see paragraph 10(g)(v) of the first session summary, third square-bracketed option). As had been suggested in paragraphs 10(h)(i) and (iii) of the first session summary, the ISO and any comments thereon would be communicated only to DOs: where a demand has been submitted and an IPER established, the processing of the application would (continue to) be governed by Chapter II and EOs would rely on the Article 38 procedure to gain access to the ISO and any comments thereon (see paragraph 23, below). In the latter connection, see also other proposals being made to this session of the Working Group whereby all possible elections would automatically be made; if those proposals do not proceed, the question of access by EOs to the ISO may have to be reviewed.

20. The ISO, when communicated to the DOs, if not in English, would, if so requested by the DO, be accompanied by a translation into English, prepared by or under the responsibility of the IB (as is the case for the IPER), which would be required to have it ready in time for communication to interested DOs promptly after the expiration of 30 months from the priority date (see paragraph 19, above; see paragraph 29, below, with regard to the translation of the ISO for the purposes of IPE). As is the case for IPERs, an ISO in English or translated into

English would have to be accepted by all DOs for the purposes of national phase processing, and no DO would be entitled to require the applicant to furnish a translation of the ISO into any other language (see paragraph 10(p) of the first session summary).

21. Where a demand has been submitted and an IPER has been established and thus no communication of the ISO to DOs is to be effected (see paragraph 19, above), no translation of the ISO into English would be prepared (unless a translation is needed for the purpose of IPE, see paragraph 29, below).

*Public inspection of ISO and of comments thereon*

22. As indicated above, the ISO (and any translation into English thereof), together with any comments on the ISO submitted by the applicant, would be made available for public inspection by the IB, but not before the expiration of 30 months from the priority date, that is, not before the point in time at which, had a demand for IPE been filed, the IPER would have been made available, via elected Offices (EOs), to third parties (see paragraph 10(g)(v) of the first session summary, third square-bracketed option).

23. As has been suggested in paragraph 10(f)(iii) of the first session summary, it is proposed not to make the ISO (and any translation thereof and any comments thereon) available for public inspection if a demand for IPE has been filed and an IPER has been established. In such a case, the processing of the application would be governed by Chapter II and the ISO (and any translation thereof and any comments thereon) would remain confidential, with the exception that EOs (and, via the EOs, depending on the applicable national law, third parties) would get access to those documents once the IPER has been established (as is the case today, under Article 38(1), with regard to any other document relating to IPE). If a demand has been submitted but no IPER is established (for example, because the applicant has withdrawn the demand or the demand is considered not to have been submitted), the application would revert to Chapter I and the ISO (and any translation thereof and any comments thereon) would both be communicated to DOs and made available for public inspection (see paragraph 10(f)(iii) of the first session summary).

24. Furthermore, the ISO (and any translation thereof and any comments thereon) would not be made available for public inspection if the applicant withdraws the international application in time to prevent international publication (see paragraph 10(j) of the first session summary). Finally, as suggested in paragraph 10(j) of the first session summary, it is proposed not to make the ISO (and any translation thereof and any comments thereon) available for public inspection if the applicant withdraws the IA within two months after receipt of the ISO (even if the withdrawal of the IA occurs after international publication).

*International preliminary examination*

25. In the context of introducing the ISO, it is necessary to consider changes to the IPE procedure which would make it worthwhile for the applicant to still make use of the international preliminary examination procedure under Chapter II. To do so, it is proposed to fix a time limit for the filing of the demand which, on the one hand, would be later than the one being applied today (in practice, 19 months from the priority date) but which, on the other hand, would leave enough time for the IPEA to provide a “value added” IPE service to the applicant by establishing, in particular cases, in addition to the ISO established by the ISA, a “second” written opinion (see paragraphs 31 and 32, below). In the context of introducing the ISO, it is thus proposed to fix the time limit for filing the demand at two months after the

receipt by the applicant of the ISR and the ISO or 20 months from the priority date, whichever expires later.

26. Contrary to the suggestion inherent in paragraph 10(l) of the first session summary, if a demand was filed after the expiration of the applicable time limit, it is proposed not to give the IPEA the choice whether or not to carry out IPE. Instead, any demand made after the expiration of that time limit would be considered as if it had not been submitted and the IPEA would so declare. Such a clear “cut-off” date would appear preferable, in particular in view of the changes proposed in paragraphs 38 and 39, below (filing of the demand at the same time as filing of the IA).

27. As at present, if the applicant files a demand for IPE, the further processing of the IA would be governed by Chapter II (see paragraph 10(f)(i) of the first session summary).

28. Upon receipt of a demand or a copy thereof from the IPEA, the IB would transmit to the IPEA copies of the ISO (unless the IPEA has already established the ISO in its capacity as ISA) and any comments on the ISO submitted by the applicant (in the original language, if received prior to the filing of the demand).

29. Upon request of the IPEA, where the ISO is not in English or in a language accepted by the IPEA, a translation into English of the ISO would be prepared by the IB and transmitted to the IPEA within two months following the request for translation (see paragraph 10(p) of the first session summary). All IPEAs would be required to accept ISOs established in or translated by the IB into English.

30. If the comments on the ISO submitted by the applicant are not in English or a language accepted by the IPEA, the applicant would be invited by the IPEA to furnish a translation into the required language. If the applicant did not comply with that invitation, the comments would not need to be taken into account by the IPEA for the purposes of IPE (see paragraph 10(p) of the first session summary).

31. If the same Office acts in the capacity of ISA and IPEA, the ISO would be treated as a first written opinion in the IPE procedure (of course, only in case the ISO states that not all of the conditions referred to in Article 34(2)(c) are fulfilled) (see paragraph 10(f)(ii) of the first session summary).

(a) As at present, the IPEA would be required to take into account any Article 19 amendments made by the applicant and any Article 34 arguments/amendments made together with the demand or later during the IPE procedure. In addition, the IPEA would also be required to take into account any comments on the ISO submitted by the applicant prior to the filing of the demand (unless superseded by any arguments/amendments furnished by the applicant under Articles 19 and 34). In general, those comments would be treated in the same way as arguments submitted under Article 34, while any proposed amendments outlined in the comments would, under certain conditions (see paragraph 10, above), be treated as amendments under Article 34.

(b) Where the applicant files Article 34 amendments within two months from the time of filing the demand or 22 months from the priority date, whichever expires later, or where the applicant had submitted comments on the ISO prior to the filing of the demand, the applicant would be entitled to receive, and the IPEA required to establish, a second written opinion (of course, only where the IPEA still considers that not all of the conditions under

Article 34(2)(c) are fulfilled). As at present, further arguments/amendments would not need to be taken into account by the IPEA if they are received after the IPEA has begun to draw up the second written opinion or the IPER (see paragraph 10(o)(iii) of the first session summary).

(c) Where the applicant does not file any Article 34 arguments/amendments within the applicable time limit referred to in paragraph (b), above, and did not file any comments, the “normal” IPE procedure would apply. The ISO would still be treated as the (first) written opinion but, as at present, the IPEA may, but would not be obliged to, issue a second written opinion; as at present, the applicant would be entitled to submit further arguments/amendments under Article 34, provided that, as at present, such arguments/amendments would not need to be taken into account by the IPEA if they are received after the IPEA has begun to draw up (any second written opinion or) the IPER.

32. If the IS and the IPE are carried out by different Offices, the IPEA would be entitled, but not obliged, to treat the ISO as the first written opinion. If the IPEA is willing to treat the ISO as the first written opinion, the procedure as outlined in paragraph 31, above, would apply. If the IPEA is not willing to treat the ISO as a (first) written opinion (in which case the IPEA would be obliged to notify the applicant accordingly), the “normal” IPE procedure would apply: the applicant would be entitled, as at present, to receive one written opinion, with the opportunity to submit arguments/amendments under Article 34, provided that, as at present, arguments/amendments would not need to be taken into account by the IPEA if they are received after the IPEA has begun to draw up the written opinion or the IPER (see paragraph 10(f)(ii) of the first session summary).

33. As at present, in all cases, the IPER 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 IB (see paragraph 10(f)(v) of the first session summary).

#### *National phase processing before DO*

34. Upon national phase entry before a DO, the applicant would have the opportunity, as at present, under Article 28, to (further) amend the description, the claims and the drawings within the time limit under Rule 52, that is, within one month from the fulfillment of the requirements for national phase entry before the DO concerned (see paragraph 10(n) of the first session summary). As outlined in paragraph 11, above, any proposed amendments outlined in the comments on the ISO may also be treated as amendments of the application under Article 28, provided that they are clearly identified as such and provided that they only need to be taken into account by the DO if the requirements under Article 28 and the requirements under corresponding Rule 52 are met.

35. If the comments on the ISO are not in English or a language accepted by the DO for the purposes of national phase procedure and the applicant wishes the DO to take the comments into account during the national phase, the applicant would be required to furnish to the DO, together with any necessary translation of the IA and any amendments under Article 19, a translation of the comments into a language accepted by the DO for the purposes of the national phase procedure. If the applicant does not do so, the DO may invite the applicant to furnish a translation, failing which the DO would be entitled to disregard any comments (see paragraph 10(p) of the first session summary).

36. Of course, given the preliminary, non-binding character of the ISO, any DO may, but would not be obliged to, take the ISO into account for the purposes of the national phase.

#### *National phase processing before EO*

37. In general, national phase processing before any EO would not change as compared to today's situation. (See paragraph 19, above, as to the question of access by EOs to the ISO.)

#### DEMAND FILED AT THE SAME TIME AS THE FILING OF THE INTERNATIONAL APPLICATION

38. In the context of introducing the expanded international search system, it is proposed to enable the applicant, if he so wishes, 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 25, above), as has been suggested in paragraph 10(k) of the first session summary. 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 20 months from the priority date, whichever expires later (see, however, paragraph 39, below), with the same invitation procedure and further extension of the time limit for payment as applies at present if the fees have not been paid (in full). Of course, IPE procedures would only start if the applicant has paid 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.

39. 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 20 months from the priority date, whichever expires later (see paragraph 38, 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 IPE at the same time as the IS, namely, one month from the date of filing of the demand. Otherwise, no special provision has been included at this stage which would introduce new possibilities for a combination of IS and IPE, beyond what is envisaged in present Rule 69.1(b), as had been suggested in paragraph 10(k)(ii) of the first session summary. Present Rule 69.1(b) appears sufficient to enable an IPEA to start the IPE at the same time as the IS.

#### DOCUMENTS AVAILABLE FOR PUBLIC INSPECTION AT THE INTERNATIONAL BUREAU ON BEHALF OF ELECTED OFFICES

40. In the context of introducing the expanded international search system, it is proposed to amend present Rule 94.3 so as to enable the IB to make available to third parties, on behalf of the EOs, a copy of the international preliminary examination report to which third parties at present only have access via the EOs, as had been suggested in paragraph 10(m) of the first session summary.

#### TIME LIMIT FOR INTERNATIONAL SEARCH

41. Under the proposed EIS system, the ISO would be established at the same time as the ISR, that is, within 3 months from the date of receipt by the ISA of the search copy or 9 months from the priority date, whichever expires later (see present Rule 42.1). The Working Group at its first session was informed that certain ISAs are facing difficulties in

meeting the present deadline for production of ISRs and that that problem may need to be addressed soon. However, at this stage, in the context of introducing the expanded international search system, it is not proposed to amend Rule 42.1 to allow for increased flexibility in the time limit for establishing the ISR (and ISO) (see paragraph 10(c) of the first session summary), as was suggested at the session by certain delegations.

42. Should the Working Group wish to introduce additional flexibility in the time limit for the international search, Rule 42 could be amended, for example, so as to permit the Director General, in consultation with the ISA concerned, if an ISA is unable, for reasons of excessive workload, in respect of certain technical fields, to meet the existing time limit for establishing the international search report under Rule 42, to fix a longer time limit for the establishment of international search reports in those technical fields by the ISA concerned, and to fix the period for which that longer time limit would apply. Any such longer time limit would then also automatically apply, under new Rule 45*bis*.1(a), to the establishment of ISOs in those technical fields by the Authority concerned.

*43. The Working Group is invited to consider the proposals contained in the Annex to this document.*

[Annex follows]

## ANNEX

## PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

## EXPANDED INTERNATIONAL SEARCH SYSTEM

## TABLE OF CONTENTS

Rule 32	Extension of Effects of International Application to Certain Successor States .....	3
32.1	[No change].....	3
32.2	<i>Effects of Extension to Successor State</i> .....	3
<u>Rule 43bis</u>	<u>International Search Opinion</u> .....	4
<u>43bis.1</u>	<u>Establishment of International Search Opinion</u> .....	4
<u>43bis.2</u>	<u>Relevant Prior Art; Inventive Step or Non-Obviousness</u> .....	5
<u>43bis.3</u>	<u>International Search Opinion</u> .....	5
<u>43bis.4</u>	<u>Transmittal of International Search Opinion</u> .....	6
<u>43bis.5</u>	<u>Translation of International Search Opinion for Designated Offices</u> .....	7
<u>Rule 43ter</u>	<u>Comments on International Search Opinion</u> .....	8
<u>43ter.1</u>	<u>Opportunity to Comment on International Search Opinion</u> .....	8
<u>43ter.2</u>	<u>Language, Form and Contents of Comments</u> .....	9
<u>Rule 43quater</u>	<u>Communication and Transmittal of International Search Opinion, Translation and Comments</u> .....	10
<u>43quater.1</u>	<u>Communication to Designated Offices</u> .....	10
<u>43quater.2</u>	<u>Transmittal to International Preliminary Examining Authority</u> .....	11
<u>Rule 43quinquies</u>	<u>Confidential Nature of International Search Opinion, Translation and Comments</u> .....	14
<u>43quinquies.1</u>	<u>Confidential Nature</u> .....	14
Rule 49	Copy, Translation and Fee Under Article 22 .....	16
49.1 and 49.2	[No change].....	16
49.3	<i>Statements Under Article 19; Indications Under Rule 13bis.4</i> .....	16
49.4	[No change].....	16
49.5	<i>Contents of and Physical Requirements for the Translation</i> .....	16
<u>Rule 54bis</u>	<u>Time limit for Making a Demand</u> .....	19
<u>54bis.1</u>	<u>Time Limit for Making a Demand</u> .....	19
Rule 55	Languages (International Preliminary Examination).....	20
55.1 to 55.3	[No change].....	20
<u>55.4</u>	<u>Translation of Comments on International Search Opinion</u> .....	20
Rule 56	Later Elections .....	21
56.1	<i>Elections Submitted Later than the Demand</i> .....	21
56.2 to 56.5	[No change].....	21
Rule 57	The Handling Fee.....	22
57.1 and 57.2	[No change].....	22
57.3	<i>Time Limit for Payment; Amount Payable</i> .....	22
57.4 and 57.5	[Remain deleted].....	23
57.6	[No change].....	23
Rule 58bis	Extension of Time Limits for Payment of Fees .....	24



58bis.1	<i>Invitation by the International Preliminary Examining Authority</i> .....	24
58bis.2	[No change] .....	24
Rule 59	The Competent International Preliminary Examining Authority.....	25
59.1 and 59.2	[No change] .....	25
59.3	<i>Transmittal of Demand to the Competent International Preliminary Examining Authority</i> .....	25
Rule 61	Notification of the Demand and Elections .....	26
61.1 to 61.3	[No change].....	26
61.4	<i>Publication in the Gazette</i> .....	26
Rule 66	Procedure Before the International Preliminary Examining Authority .....	27
66.1	<i>Basis of the International Preliminary Examination</i> .....	27
66.2	<i>First Written Opinion of the International Preliminary Examining Authority</i> .....	28
66.4	<i>Additional Opportunity for Submitting Amendments or Arguments</i> .....	31
66.4bis 5 to 66.9	[No change] .....	31
Rule 69	Start of and Time Limit for International Preliminary Examination .....	32
69.1	<i>Start of International Preliminary Examination</i> .....	32
69.2	<i>Time Limit for International Preliminary Examination</i> .....	33
Rule 78	Amendment of the Claims, the Description, and the Drawings, Before Elected Offices .....	34
78.1	<i>Time Limit Where Election Is Effected Prior to Expiration of <u>the Time Limit Applicable Under Rule 54bis.1(a)</u> <del>19 Months from Priority Date</del></i> .....	34
78.2	<i>Time Limit Where Election Is Effected After Expiration of <u>the Time Limit Applicable Under Rule 54bis.1(a)</u> <del>19 Months from Priority Date</del></i> .....	35
Rule 92bis	Recording of Changes in Certain Indications in the Request or the Demand .....	36
92bis.1	<i>Recording of Changes by the International Bureau</i> .....	36
Rule 94	Access to Files .....	37
94.1	<i>Access to the File Held by the International Bureau</i> .....	37

**Rule 32**

**Extension of Effects of International Application to  
Certain Successor States**

32.1 [No change]

32.2 *Effects of Extension to Successor State*

(a) [No change]

(b) Where, in the case of a successor State which is bound by Chapter II of the Treaty, the request for extension was made after, but the demand was made before, the expiration of the [time limit applicable under Rule 54bis.1\(a\)](#) ~~19th month from the priority date~~, and a later election is made of the successor State within three months from the date of the request for extension, the applicable time limit under paragraph (a)(ii) shall be at least 30 months from the priority date.

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed amendment of Rule 56.1(e) (see below).]

(c) [No change]

**Rule 43bis**

**International Search Opinion**

43bis.1 Establishment of International Search Opinion

(a) The International Searching Authority shall, at the same time as it establishes the international search report, establish an international search opinion.

(b) The objective of the international search opinion is to formulate a preliminary and non-binding 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;

(iii) any other matters that these Regulations provide for.

[COMMENT: The matters to be reported on in the ISO correspond to those mentioned in Article 34(2)(c) in relation to the IPE written opinion; see paragraph 10(a) of the first session summary and paragraph 3 in the “Background” section of this document.]

43bis.2 Relevant Prior Art; Inventive Step or Non-Obviousness

For the purposes of establishing the international search opinion, Article 33(2) to (6) and Rules 64 and 65 shall apply *mutatis mutandis* and the relevant date referred to in those Rules shall be the international filing date.

[COMMENT: Proposed new Rule 43bis.2 appears necessary so as to clarify that, as is the case for the international search report, the relevant date for determining prior art is the international filing date and not, as may be the case for international preliminary examination, the priority date. Accordingly, as at present, the ISA would not be required to verify any claimed priority date (see PCT International Search Guidelines, paragraph VI-4.1).]

43bis.3 International Search Opinion

(a) The international search opinion shall be based on the international application as filed. Rule 66.1(f) shall apply *mutatis mutandis*.

[COMMENT: Proposed new paragraph (a) appears necessary so as to clarify that the ISA would not need to establish the ISO with regard to claims which have not been searched. Reference is made to Rule 66.1(f) instead of present Rule 66.1(e) only because Rule 66.1(e) has been renumbered (see below) but remains unchanged otherwise.]

(b) Articles 35.2 and 35.3, and Rules 67, 70.2(d), 70.3, 70.4(ii), 70.6 to 70.9 and 70.12 shall apply *mutatis mutandis*.

[COMMENT: While, in paragraph 10(b) of the first session summary, it is suggested that the scope and contents of the ISO would be similar to the present first written opinion in the IPE procedure, and reference is made to Rule 66.2(a), it appears more appropriate to refer to the corresponding provisions in Article 35(2) and 35(3) and Rule 70 since the ISO, as a document to be sent to the applicant separate from the ISR, appears to be, from a formal point of view, closer to an IPER-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

*[Rule 43bis.3(b), continued]*

which the IPEAs send out, as the written opinion, a first draft of the IPER 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 IPER as referred to in Rule 70.6). Rule 70.12(iii) corresponds to Rule 66.2(a)(i), Rule 70.6 corresponds to Rule 66.2(a)(ii), Rule 70.12(i) corresponds to Rule 66.2(a)(iii), Rule 66.2(a)(iv) is not applicable in the context of the ISO, Rule 70.12(ii) corresponds to Rule 66.2(a)(v), Rule 70.2(d) corresponds to Rule 66.2(a)(vi), and Rule 70.12(iv) corresponds to Rule 66.2(a)(vii).]

(c) Every international search opinion shall be in the language in which the international search report is established.

[COMMENT: See paragraph 10(p) of the first session summary and paragraph 5 in the “Background” section of this document.]

43bis.4 Transmittal of International Search Opinion

The International Searching Authority shall, together with the international search report, transmit one copy of the international search opinion to the International Bureau and one copy to the applicant.

[COMMENT: See paragraph 10(d) of the first session summary.]

43bis.5 Translation of International Search Opinion for Designated Offices

(a) Any designated State may require that the international search opinion, established in any language other than the official language, or one of the official languages, of its national Office, be accompanied, when communicated to it under Rule 43quater.1, by a translation into English.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

(c) Any translation referred to in paragraph (a) of the international search opinion shall be prepared by or under the responsibility of the International Bureau.

(d) The International Bureau shall transmit a copy of the translation referred to in paragraph (a) of the international search opinion to the applicant at the same time as it communicates such translation to the interested designated Office or Offices. The applicant may make written observations, in English or the language of the international search opinion, on what, in his opinion, are errors of translation in the translation of the international search opinion and shall send a copy of any such observations to each of the interested designated Offices and a copy to the International Bureau.

[COMMENT: See paragraph 10(p) of the first session summary and proposed new Rule 43bis.3(c), above. See also paragraph 20 in the “Background” section of this document. While, if a demand has been submitted, no translation of the ISO would be established for any DOs, a translation of the ISO may nevertheless be prepared, for the purposes of international preliminary examination, if so requested by the IPEA (see Rule 43quater.2(b), below); in such a case, the applicant would also have the opportunity to comment on that translation, and to submit a copy of any such comments to the IPEA (see Rule 43quater.2(c), below). The wording of Rule 43bis.5 corresponds largely to that of present Rule 72 concerning translations of the IPER.]

**Rule 43ter**

**Comments on International Search Opinion**

43ter.1 Opportunity to Comment on International Search Opinion

(a) The applicant shall be entitled to one opportunity to submit, within 28 months from the priority date, written comments on the international search opinion, provided that, if a demand is submitted, such comments shall be submitted before or together with the demand.

[COMMENT: See paragraphs 10(h) and 10(o)(ii) of the first session summary and paragraphs 12 and 13 in the “Background” section of this document.]

(b) Any comments referred to in paragraph (a) shall be submitted directly to the International Bureau.

[COMMENT: See paragraph 10(e)(ii) of the first session summary.]

43ter.2 Language, Form and Contents of Comments

(a) Any comments submitted under Rule 43ter.1 shall, at the option of the applicant, be in English or in the language in which the international application is to be published. They shall be identified as such by a heading, preferably by using the words “Comments on the International Search Opinion” or their equivalent in the language of the comments.

[COMMENT: See paragraph 10(p) of the first session summary and paragraph 15 in the “Background” section of this document.]

(b) The comments shall contain no disparaging comments on the international search opinion or the international search report. They may contain arguments but shall preferably not contain any proposed amendments of the international application. Where any such proposed amendment is contained in the comments, it shall be considered to be:

(i) an amendment under Article 19 only if clearly identified as such and only if the requirements of Rule 46 are met;

(ii) an amendment under Article 34 only if clearly identified as such and only if the requirements of Rules 66.4bis, 66.5, 66.8 and 66.9 are met;

(iii) an amendment under Article 28 only if clearly identified as such and only if the requirements of Rule 52 are met.

[COMMENT: See paragraph 10(f)(iv) of the first session summary and paragraphs 9 to 11 in the “Background” section of this document.]



**Rule 43<sup>quater</sup>**

**Communication and Transmittal of International Search Opinion,**

**Translation and Comments**

43<sup>quater</sup>.1 Communication to Designated Offices

(a) Subject to paragraph (c), the international search opinion, together with any comments thereon (in the original language) submitted by the applicant under Rule 43<sup>ter</sup>.1, shall be communicated by the International Bureau to each designated Office promptly after the expiration of 30 months from the priority date, unless communication at an earlier time is requested or authorized by the applicant.

[COMMENT: See paragraph 10(o)(ii) of the first session summary and paragraphs 19 and 20 in the “Background” section of this document.]

(b) Subject to paragraph (c), the International Bureau shall transmit a copy of the translation of the international search opinion referred to in Rule 43<sup>bis</sup>.5(a) to any interested designated Office at the same time as it communicates to that Office the documents referred to in paragraph (a).

[COMMENT: See paragraph 10(o)(ii) of the first session summary and paragraphs 19 and 20 in the “Background” section of this document. The copy of the translation of the ISO would only be communicated to “interested” designated Offices, that is, designated Offices which, under Rule 34<sup>bis</sup>.5(a), have requested to receive such translation.]

*[Rule 43quater.1, continued]*

(c) Paragraphs (a) and (b) shall not apply if a demand has been submitted and an international preliminary examination report has been established.

[COMMENT: See paragraph 10(f)(iii) of the first session summary and paragraph 19 in the “Background” section of this document.]

43quater.2 Transmittal to International Preliminary Examining Authority

(a) Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority a copy of the international search opinion and of any comments thereon (in the original language) submitted by the applicant under Rule 43ter.1, except that the copy of the international search opinion need not be transmitted to the International Preliminary Examining Authority where that Authority is the Office or intergovernmental organization that established the international search opinion in its capacity as International Searching Authority.

(b) Upon request of the International Preliminary Examining Authority, the international search opinion shall, when not in English or in a language accepted by that Authority, be translated into English. The translation shall be prepared by or under the responsibility of the International Bureau and shall be transmitted to the International Preliminary Examining Authority within two months from the date of receipt by the International Bureau of the request for translation.

*[Rule 43quater.2, continued]*

(c) The International Bureau shall transmit a copy of the translation referred to in paragraph (b) to the applicant at the same time as it communicates such translation to the International Preliminary Examining Authority. The applicant may make written observations on the accuracy of the translation of the international search opinion and shall send a copy of any such observations to the International Preliminary Examining Authority and a copy to the International Bureau.

(d) Any international search opinion established in or translated into English shall be accepted by all International Preliminary Examining Authorities for the purposes of international preliminary examination. The International Preliminary Examining Authority may take into account any written observations on the translation of the international search opinion sent to it by the applicant under paragraph (c).

[COMMENT: In view of the fact that, if a demand for IPE has been submitted, no translation into English of the ISO is prepared for the benefit of the designated Offices under proposed new Rule 43bis.5, it is proposed to add new paragraphs (b) to (d) so as to allow the IPEA to request a translation of the ISO into English where such translation is needed for the purposes of IPE and so as to clarify that an ISO in English or translated into English must be accepted by all IPEAs for the purposes of IPE (as is the case for the ISR).]

(e) Notwithstanding Rule 43ter.1(a), if, at the time when the International Bureau receives any comments made by the applicant under Rule 43ter.1, a demand has already been submitted, the International Bureau shall, promptly after the receipt of any comments, transmit a copy of such comments (in the original language) to the International Preliminary Examining Authority, except if a copy of the international preliminary examination report has already been received by the International Bureau.

*[Rule 43quater.2(e), continued]*

[COMMENT: As is the case for amendments under Article 34 (see present Rule 66.4*bis*; see also proposed new Rule 66.1(e), below), any comments submitted by the applicant after the filing of the demand and late in the IPE procedure need, of course, not be taken into account if the IPEA has already begun to draw up the written opinion or the IPER.]

**Rule 43quinquies**

**Confidential Nature of International Search Opinion, Translation and Comments**

43quinquies.1 Confidential Nature

(a) Subject to Rule 43quater.2, neither the International Bureau nor the International Searching Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4), to the international search opinion, to any translation thereof, to any written observations on that translation sent by the applicant under Rule 43quater.2(c), or to any comments on the international search opinion submitted by the applicant under Rule 43ter.1, before the expiration of 30 months from the priority date. In any event, no such access shall, unless requested or authorized by the applicant, be allowed where

(i) no international publication of the international application is effected;

[COMMENT: See paragraph 10(j) of the first session summary, first square-bracketed option.]

(ii) the applicant withdraws the international application under Rule 90bis.1 within two months after the receipt by the applicant of the international search opinion;

[COMMENT: See paragraph 10(j) of the first session summary, second square-bracketed option.]

*[Rule 43quinquies.1(a), continued]*

(iii) a demand has been submitted and an international preliminary examination report has been established.

[COMMENT: See paragraph 10(f)(iii) of the first session summary and paragraphs 22 and 23 in the “Background” section of this document.]

(b) The International Preliminary Examining Authority shall not, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4), to the international search opinion, to any translation thereof, to any written observations on that translation sent by the applicant under Rule 43quater.2(c), or to any comments on the international search opinion submitted by the applicant under Rule 43ter.1, by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

[COMMENT: See paragraph 10(f)(iii) of the first session summary and paragraphs 22 and 23 in the “Background” section of this document. Modeled after Article 38(1).]

**Rule 49**

**Copy, Translation and Fee Under Article 22**

49.1 and 49.2 [No change]

49.3 *Statements Under Article 19; Indications Under Rule 13bis.4*

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1), ~~and~~ any indication furnished under Rule 13bis.4 [and any comments submitted under Rule 43bis.1\(a\)](#) shall, subject to Rule 49.5(c), ~~(c-ter)~~ and (h), be considered part of the international application.

[COMMENT: Rule 49.3 is proposed to be amended so as to clarify that, for the purposes of Article 22 and Rule 49 (in particular the translation requirements under Rule 49.5, below), any comments submitted by the applicant under proposed new Rule 43bis.1 are considered part of the international application and thus, depending on the requirements of the designated Office (see Rule 49.5 as proposed to be amended, below), may have to be translated upon entry into the national phase.]

49.4 [No change]

49.5 *Contents of and Physical Requirements for the Translation*

(a) For the purposes of Article 22, the translation of the international application shall contain the description (subject to paragraph (a-bis)), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs [\(a-ter\)](#), (b), (c-bis) and (e),

*[Rule 49.5(a), continued]*

(i) [No change]

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended, ~~and~~

(iii) if comments on the international search opinion have been submitted under Rule 43ter.1, contain those comments, and

(iv) be accompanied by a copy of the drawings.

(a-bis) [No change]

(a-ter) No designated Office shall require the applicant to furnish to it a translation of any comments on the international search opinion submitted under Rule 43ter.1 if such comments are in English.

[COMMENT: See paragraph 10(p) of the first session summary and paragraph 15 in the “Background” section of this document.]

(b) to (c-bis) [No change]



*[Rule 49.5, continued]*

(c-ter) Any designated Office requiring under paragraph (a) the furnishing of a translation of any comments submitted under Rule 43ter.1 shall, where the applicant failed to furnish such translation within the time limit applicable under Article 22, invite the applicant to furnish such translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the translation is not furnished within the time limit fixed in the invitation, the designated Office may disregard such comments.

[COMMENT: Modeled after Rule 49.5(c-bis).]

(d) to (l) [No change]

(k) No designated Office shall require the applicant to furnish to it a translation of the international search opinion.

[COMMENT: New paragraph (k) is proposed to be added so as to clarify that any necessary translation of the ISO into English could never be requested from the applicant, noting that the provision of such a translation is the responsibility of the International Bureau under Rule 43bis.5(c) and (d).]

**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 two months from the date on which the international search report was transmitted to the applicant under Rule 45bis.2 or 20 months from the priority date, whichever expires later.

[COMMENT: See paragraph 10(1) of the first session summary and paragraph 25 in the “Background” section of this document.]

(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 10(1) of the first session summary and paragraph 26 in the “Background” section of this document.]

## Rule 55

### Languages (International Preliminary Examination)

55.1 to 55.3 [No change]

#### 55.4 Translation of Comments on International Search Opinion

(a) If the language in which the comments on the international search opinion have been submitted under Rule 43ter.1 is not English or a language accepted by the International Preliminary Examining Authority, that Authority shall, if practicable having regard to the time limit for establishing the international preliminary examination report, invite the applicant to furnish the comments in the required language within a time limit which shall be reasonable under the circumstances.

(b) If the applicant fails to comply, within the time limit under paragraph (a), with the invitation to furnish the comments in the required language, or if it is not practicable to issue such invitation having regard to the time limit for establishing the international preliminary examination report, the comments need not be taken into account for the purposes of the international preliminary examination.

[COMMENT: See first session summary, paragraph 10(p). Modeled in part after Rule 66.9(c) and (d).]

## Rule 56

### Later Elections

#### 56.1 *Elections Submitted Later than the Demand*

(a) to (d) [No change]

(e) Any ~~If a~~ notice effecting a later election ~~is~~ submitted after the expiration of the time limit applicable under Rule 54bis.1(a) ~~19 months from the priority date~~ shall be considered as if it had not been submitted and, the International Bureau shall so declare ~~notify the applicant that the election does not have the effect provided for under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in respect of the elected Office concerned within the time limit applicable under Article 22.~~

[COMMENT: It is proposed to amend paragraph (e) so as align the time limit for the submission of a notice of later election to the time limit for filing of a demand under proposed new Rule 54bis.1(a) (see above). In view of the recent modification of the time limit under Article 22(1), one could, alternatively, consider to allow for a longer time limit for the submission of later elections, say, until the establishment of the IPER (usually, 28 months from the priority date) (Rule 78.2, see below, would also have to be amended accordingly.)]

(f) [No change]

56.2 to 56.5 [No change]

## 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 20 months from the priority date, whichever expires later., ~~provided that,~~

(b) 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 20 months from the priority date, whichever expires later.

[COMMENT: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document. The same approach would apply to the preliminary examination fee (see present Rule 58.1(b)).]

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

*[Rule 57.3(c), continued]*

[COMMENT: See paragraph 10(k)(ii) of the first session summary and paragraph 39 in the “Background” section of 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: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document. 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 [No change]

**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), 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: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document. 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]

61.4 *Publication in the Gazette*

Where a demand has been filed before the expiration [the time limit applicable under Rule 54bis.1\(a\)](#) ~~of 19 months from the priority date~~, 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. 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 66

### Procedure Before the International Preliminary Examining Authority

#### 66.1 *Basis of the International Preliminary Examination*

(a) Subject to paragraphs (b) to [\(e\)](#) ~~(d)~~, the international preliminary examination shall be based on the international application as filed.

(b) [No change]

[COMMENT: After review, it is not proposed to introduce a shorter time limit for submitting Article 34 amendments, as was suggested in paragraph 10(o)(iii) of the first session summary, and to leave the present time limit unchanged.]

(c) and (d) [No change]

[\(e\) Any comments on the international search opinion submitted by the applicant under Rule 43ter.1 shall, subject to Rules 43ter.2\(b\)\(ii\) and 66.4bis, be taken into account for the purposes of the international preliminary examination in the same manner as arguments or amendments submitted under Article 34, unless superseded, or considered as reversed, by an amendment under Article 19 or 34.](#)

[COMMENT: See paragraph 10(f)(iv) of the first session summary and paragraph 10 in the “Background” section of this document.]

[\(f\)](#) ~~(e)~~ Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

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

(a) Subject to paragraphs (e) and (f), if ~~if~~ the International Preliminary Examining Authority

(i) 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.

(b) to (d) [No change]

*[Rule 66.2, continued]*

(e) If the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority and the international search opinion:

(i) states that the claimed invention does not appear to be novel, to involve an inventive step (to be non-obvious) or to be industrially applicable; or

(ii) states that the international application does not comply with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority; or

(iii) contains any other observations provided for in these Regulations;

the international search opinion shall be considered to be the first written opinion and the International Preliminary Examination Authority shall notify the applicant accordingly.  
Rules 66.2(c) and (d) and 66.3 shall apply *mutatis mutandis*.

[COMMENT: See paragraph 10(f)(ii) of the first session summary and paragraph 31 in the “Background” section of this document.]

*[Rule 66.2, continued]*

(f) If the International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the International Searching Authority and the international search opinion contains any statement or observation as referred to in paragraph (e)(i) to (iii) of this Rule, the International Preliminary Examining Authority, at its option:

(i) may decide to consider the international search opinion to be the first written opinion, in which case it shall, promptly after the receipt of the demand, notify the applicant accordingly; Rules 66.2(c) and (d) and 66.3 shall apply *mutatis mutandis*; or

(ii) may decide not to consider the international search opinion to be the first written opinion, in which case it shall, promptly after the receipt of the demand, notify the applicant accordingly and proceed as provided in paragraph (a); it may, however, take the international search opinion into account for the purposes of international preliminary examination.

[COMMENT: See paragraph 10(f)(ii) of the first session summary and paragraph 32 in the “Background” section of this document.]

66.3 [No change]

66.4 *Additional Opportunity for Submitting Amendments or Arguments*

(a) Subject to paragraph (a-bis), if ~~If~~ the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and Rules 66.2 and 66.3 shall apply.

(a-bis) If, under Rule 66.2(e) or (f)(i), the International Preliminary Examining Authority treats the international search opinion as the first written opinion and the applicant responds to that written opinion within two months from the date on which the demand was submitted or 22 months from the priority date, whichever expires later, by making amendments or by submitting arguments under Article 34(2), the Authority shall, if it still considers that not all of the conditions referred to in Article 34(2)(c) are fulfilled, issue an additional written opinion, and Rules 66.2 and 66.3 shall apply.

[COMMENT: See paragraph 10(f)(ii) of the first session summary and paragraphs 25 and 31 in the “Background” section of this document.]

(b) [No change]

66.4bis 5 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 of all of the following ~~both of:~~

(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 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established.

[COMMENT: See paragraph 10(k)(i) of the first session summary and paragraph 38 in the “Background” section of this document.]

(b) to (e) [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be:

- (i) 28 months from the priority date, or
- (ii) 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) 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: See paragraph 10(k) of the first session summary and paragraph 38 in the “Background” section of this document.]



## 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 the Time Limit Applicable Under Rule 54bis.1(a) ~~19 Months from Priority Date~~*

(a) Where the election of any Contracting State is effected prior to the expiration of the time limit applicable under Rule 54bis.1(a) ~~19th month from the priority date~~, 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 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 time limit applicable under Rule 54bis.1(a) ~~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).

*[Rule 78.1, continued]*

[COMMENT: Proposed amendment of Rule 78.1 is consequential on the introduction of new time limit for the filing of a demand under proposed new Rule 54bis.1(a) (see above) and the recent modification of the time limit under Article 22(1).]

78.2 *Time Limit Where Election Is Effected After Expiration of the Time Limit Applicable*

*Under Rule 54bis.1(a)* ~~*19 Months from Priority Date*~~

Where the election of any Contracting State has been effected after the expiration of the time limit applicable under Rule 54bis.1(a) ~~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: Proposed amendment of Rule 78.2 is consequential on the proposed amendment of Rule 56.1(e) (see above). See also the Comment on Rule 56.1(e), above.]

**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 43quinquies](#), furnish, subject to the reimbursement of the cost of the service, [a copy](#) ~~copies~~ of any document contained in its file, [including a copy of the international preliminary examination report where an elected Office has requested the International Bureau to provide access to that report on behalf of that Office.](#)

[COMMENT: See paragraphs 10(g)(iii) and (m) of the first session summary and paragraph 40 in the “Background” section of this document.]

94.2 and 94.3 [No change]

[End of Annex and of document]