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

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THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM:

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT;
RELATED PROPOSALS: ELECTIONS; INTERNATIONAL FILING FEE;
“COMMUNICATION ON REQUEST” SYSTEM

Document prepared by the International Bureau

BACKGROUND

1. At its first session, held in Geneva from November 12 to 16, 2001, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals for a new concept and operation of the designation system, based on the proposed new or amended Rules set out in document PCT/R/WG/1/1 and on document PCT/R/WG/1/7.¹
2. Taking into account the comments and concerns expressed by various delegations during the discussions on this matter in the first session of the Working Group, and the areas where agreement has been reached, as summarized in paragraphs 12 to 20 of the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”), this

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

document² sets out revised proposals for amendment of the Regulations³ designed to implement the new concept and operation of the designation system.

3. Similar to the order of the discussions on this matter in the first session of the Working Group, revised proposals for new or amended Rules contained in this document are divided into four parts and contained in the four Annexes to this document:⁴

Annex I: Automatic indication of all designations possible under the PCT;

Annex II: Related proposals: Automatic indication of all designations possible under the PCT;

Annex III: Related proposals: “Flat” international filing fee;

Annex IV: Related proposals: “Communication-on request” system.

Automatic indication of all designations possible under the PCT

4. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

“12. The comments and concerns expressed by various delegations included the following:

- (i) the proposed new approach of Rule 4.9(a) and (b), in so far as it would enable applicants to make an automatic indication of all designations possible under the PCT, was fully supported;
- (ii) noting that the proposed Rule changes would defer to the national phase all decisions and choices by the applicant as to the countries in which protection was sought and as to the kinds of protection sought, certain delegations expressed the view that applicants should have the possibility of excluding designations at the time of filing the international application and/or of withdrawing designations later during the international phase, notwithstanding that this would retain a degree of complexity in the system; certain reasons expressed are noted in items (iii) to (vii), below;

² 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.

³ 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.

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 may be included for ease of reference.

- (iii) it was noted that Article 8(2)(b) expressly contemplated the possibility that an international application may include the designation of only one State; other Articles to be borne in mind in this context included Articles 22, 24 and 37;
- (iv) the applicable national law in certain countries would be incompatible with an automatic designation system which did not allow for exclusions of certain designations; for example, some national laws provided for the automatic withdrawal of an earlier national application if a later international application claimed priority based on that national application and designated the country concerned (“self-designation”); this was a matter of great concern to the Delegations of Germany and Japan, in particular;
- (v) applicants might be under contractual obligations not to seek protection in certain countries, although it was noted that contractual obligations could be expressed differently if the system were changed so as to operate on different principles;
- (vi) it would be necessary in some circumstances to be certain that the designation of a particular country did not have undesirable results arising from the prior art effect of the international application in that country;
- (vii) certain provisions relating to the requirement applicable in certain countries that the inventors be indicated as applicants would be burdensome to comply with in cases where the applicant had no intention of entering the national phase in those countries;
- (viii) it was noted that, where the international application was to be treated as an application for a continuation or continuation-in-part, information concerning the parent application involved was needed at the time of filing the international application;
- (ix) in the context of proposed amended Rule 4.15, most delegations expressed support for yet a further reduction of the requirement for signature of the international application; a review of the present requirements should include a review of provisions concerning the appointment of agents and common representatives;
- (x) Rule 32 should be reviewed to see whether, in the light of the proposed new all-inclusive approach to designations, successor States could not automatically be dealt with by the same kind of approach.

“13. It was agreed that the approach taken in document PCT/R/WG/1/1 in connection with Rules 4, 49*bis* and 90*bis* should be retained, subject to further consideration of the matters mentioned in paragraph 12, above, and to the following:

- (i) a [transitional] reservation provision should be included which would enable applicants to exclude and/or withdraw the designation of any State whose Office had notified the IB, [subject to the timing provisions usual for such

provisions,] that proposed Rule 4.9(a) and (b) were incompatible with the national law applicable in that State;

- (ii) a revised draft should include the following alternatives for consideration: (1) eliminate all signature requirements; (2) require the signature of only one applicant where the international application is filed by several applicants (and similarly in the case of the demand); (3) provide for an RO to waive the need for signature of the international application requirements for papers filed with that Office; (4) provide for an RO to waive the need for a power of attorney where the international application is filed by an agent;
- (iii) where the international application was to be treated as an application for a continuation or continuation-in-part, information concerning the parent application involved should continue to be required in the request;
- (iv) the International Bureau should study the issues mentioned above relating to Articles 8, 22, 24 and 37, prior art effect, the naming of inventors as applicants, and Rule 32, and should provide the results to the Working Group.”

5. Annex I to this document contains revised proposals for new or amended Rules, addressing, in particular, comments and concerns expressed during the first session of the Working Group with regard to the following issues:

(a) *Exclusion of State from being designated.* A transitional reservation provision has been included which would enable applicants to exclude the designation of any State whose Office had notified the International Bureau, subject to the timing provisions usual for such provisions, that the proposed automatic designation of all Contracting States Rule 4.9(a) and (b) were incompatible with the national law applicable in that State (see Rule 4.9(c) as proposed to be amended).

(b) *Withdrawal of individual designations.* So as to address concerns expressed by various delegations (in particular in view of the wording of Article 24(1)(i), see paragraphs 12(ii) and (iii) of the first session summary), it is no longer proposed to delete Rule 90*bis*.2, so that, under the new approach, as at present, the applicant may withdraw individual designations. This would also appear to address the concern with regard to the wording of PCT Article 8(2)(b), as noted in paragraph 12(iii) of the first session summary, since it would continue to be possible that an international application would contain the designation of only one State (in case the applicant withdraws all but one designation).

(c) *Continuation or continuation in part.* It is no longer proposed to delete Rules 4.1(b)(v) and 4.14, so that, under the new approach, as at present, the applicant would be required to indicate, in the request, the parent application concerned if he wishes his application to be treated, in any designated State, as a continuation or continuation in part.

(d) *Rule 32.* This Rule is proposed to be amended so as to bring it in line with the proposed new approach with regard to designations.

(e) *Prior art effect.* Noting that PCT Article 27(5) expressly states that "...any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art...", it would appear impossible to include, in the Regulations, a provision which would provide certainty, as has been suggested in paragraph 12(vi) of the first session summary, "that the designation of a particular country did not have undesirable results arising from the prior art effect of the international application in that country." In other words, in view of the fact that the definition as to what constitutes prior art (other than for the purposes of the international phase) is a matter of the national law of each Contracting State, each Contracting State may wish to review whether its national law may need to be adapted to the new approach with regard to designations. Already at present, the national laws of many Contracting States provide that an international application designating the particular State concerned is considered as comprised in the state of the art not as of the international filing date of the international application but only as of the date on which the applicant has performed the acts for entering the national phase before that Office.

(f) *Naming of applicant as inventor.* The concern expressed by various delegations (see paragraph 12(vii) of the first session summary) that the inventors would always need to be indicated as applicants since the international application would, under the new approach, always contain the designation of the United States (the only PCT Contracting State with such a requirement), resulting in a great burden for applicants who had no intention of entering the national phase in that State, has been addressed in the context of the proposals to simplify and streamline the signature requirements (see paragraph (g), below). It will be proposed in a separate document prepared for consideration by the Working Group that, while there would still be a requirement to indicate inventors as applicants, there would no longer be a requirement that such applicants must to sign the request or a power of attorney.

(g) *Signature requirements.* Given the importance of the provisions relating to signature requirements, proposals to simplify and streamline the present regime as to signature requirements have not been included in this document but will be presented to the Working Group in a separate document (see document PCT/R/WG/2/[...]).

Automatic indication of all designations possible under the PCT

6. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

"16. The comments and concerns expressed by various delegations included the following:

- (i) most delegations expressed support for the proposed new approach of Rules 53 and 56 in so far as it would enable applicants to make an automatic indication of all possible elections;
- (ii) similar considerations applied in the case of elections as in that of designations in relation to the possible need for applicants to be able to exclude and/or withdraw particular elections;

- (iii) it was noted that Article 31(4) expressly mentioned the possibility that Contracting States may be elected later and that Article 37 expressly stated that the applicant may withdraw any election;
- (iv) Rule 61.4 should be further reviewed with a view to aligning its current wording with the new approach with regard to elections.

“17. It was agreed that the approach taken in proposed Rules 53, 56 and 90bis should be retained, subject to further consideration of the matters mentioned in paragraph 16, above.”

7. Annex II to this document contains revised proposals for new or amended Rules, addressing, in particular, comments and concerns expressed during the first session of the Working Group with regard to the following issues:

(a) *Exclusion of State from being elected.* While Rule 4.9(c) as proposed to be amended allows for the exclusion of certain Contracting States from being designated, it appears not necessary to also allow for the exclusion of certain States from being elected (as mentioned in paragraph 13(ii) of the first session summary).

(b) *Withdrawal of individual elections.* So as to address concerns expressed by various delegations (in particular in view of the wording of PCT Article 37(1), see paragraphs 12(iii), 13(ii) and 13(iii) of the first session summary), it is no longer proposed to eliminate the concept of withdrawals of individual elections, so that, under the new approach, as at present, the applicant may withdraw individual elections.

(c) *Later elections.* While, in view of the proposed new concept of elections, there appears to be no real need to maintain, in the Regulations, a formal procedure for making “later elections”, noting the wording of Article 31(4), second sentence (“Additional Contracting States may be elected later”), it is not any longer proposed to eliminate the concept of “later elections”. In practice, since - under the new approach - automatically all designated States would always be elected, a “later election” could only occur where the applicant, after the filing of a demand, withdraws an individual election and later “corrects” this withdrawal by electing that State (again) (by way of a “later election” within the applicable time limit).

(d) *Rule 61.4.* Rule 61.4 has been reviewed, as suggested in paragraph 13(iv) of the first session summary, but no change is proposed to be made to Rule 61.4 in the context of this document. Section 431 of the Administrative Instructions would have to be modified so as to bring it in line with the proposed new concept of eliminating the need for individual elections and the fact that, under the proposed new approach, exclusion of elections would not any longer be possible.

“Flat” international filing fee

8. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

“14. The comments and concerns expressed by various delegations included the following:

- (i) the introduction of a flat international filing fee, replacing the current separate basic fee and designation fee(s), was fully supported;
- (ii) the proposed flat fee would be appropriate even if it were decided that applicants should continue to have the possibility of excluding and/or withdrawing designations;
- (iii) the fixing of the amount of the new fee, which would take place in the context of approving WIPO’s budget, should take into account the general objective of PCT reform to further reduce costs for applicants; certain delegations expressed the view that the new fee should be lower than the total amount of the basic fee and the maximum number of designation fees payable;
- (iv) the representative of IFIA proposed a study of the possibility of granting a fee reduction to all those applicants who are “natural persons”, irrespective of their nationality and residence;
- (v) there was a lack of available information for third parties as to whether and when international applications had entered the national phase; possibilities included: the (hitherto incomplete) provision of such information by DOs under Rule 86.1(a)(vi) and Section 112; a task already being undertaken in the context of WIPO’s Standing Committee on Information Technologies (see documents SCIT/6/5 and 7); and information produced as a by-product of the use by DOs of the communication-on-request (“COR”) system being developed under WIPO’s IMPACT project.

“15. It was agreed that the approach taken in proposed Rules 15, 16*bis*, 27, 29, 32 and 51, and in the Schedule of Fees, should be retained, subject to further consideration of the matters mentioned in paragraph 14, above.”

9. Annex III to this document contains (slightly) revised proposals for new or amended Rules concerning the introduction of a flat “international filing fee.”

“Communication on request” system

10. Document PCT/R/WG/1/9 summarizes the status of discussions on this matter by the Working Group as follows:

“18. The comments and concerns expressed by various delegations included the following:

- (i) the coming introduction of the new “communication on request” (COR) system, replacing the current systematic communication of documents to DOs, was noted with approval;
- (ii) certain delegations representing member States with large Offices indicated that, even under the COR system, they wished to continue to receive, preferably in electronic form, all documents related to international applications in which the Office concerned was designated, irrespective of whether national phase entry had taken place; the COR system would support such systematic communication;
- (iii) the COR system should be extended to include communications to ISAs and IPEAs as well as DOs/EOs;
- (iv) Rule 47.1(c), which contained provisions designed to safeguard applicants’ rights having regard to Article 22 in connection with the communication of international applications to DOs, should be reviewed to ensure that the safeguards would operate satisfactorily in conjunction with the COR system;
- (v) consideration should be given to combining Rules 47.1(b) and 47.4;
- (vi) Rule 61.2 should be reviewed to ensure that it would operate satisfactorily with the COR system, noting that Article 31(7) expressly stated that each EO must be notified of its election.

“19. It was agreed that the approach taken in proposed Rules 24.2, 47, 48, 73, 76.5 and 93*bis* should be retained, subject to further consideration of the matters mentioned in paragraph 18, above.”

11. Annex IV to this document contains revised proposals for new or amended Rules, addressing, in particular, comments and concerns expressed during the first session of the Working Group with regard to the following issues:

(a) *Extending the Communication On Request system to ISAs and IPEAs.* Upon further reflection, notwithstanding paragraph 18(iii) of the first session summary, it is proposed not to extend the “communication on request” system to International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs). Other than designated/elected Offices, which actually process only those international applications that enter the national phase before the Office concerned and thus need only the documents which relate to those applications, ISAs and IPEAs process all international applications in respect of which they have been chosen to act as ISA or IPEA and thus need the documents relating to all those applications. Furthermore, there are only a very limited number of provisions in

the PCT Regulations dealing with the communication of information, notifications etc. from the International Bureau to ISAs and IPEAs (see, for example, Rules 24.2(a) and (c), and 62.1), while the vast majority of provisions providing for copies of forms etc. to be sent to those Authorities are to be found in the Administrative Instructions. It thus appears preferable to retain, in principal, the present system under which all communications and notifications are sent to ISAs and IPEAs systematically but to provide, in the Administrative Instructions, specific exceptions with regard to specific communications or notifications the receipt of which ISAs and IPEAs should be able to waive.

(b) *Rules 47.1(c) and 47.4.* These Rules have been reviewed, as suggested in paragraphs 18(iv) and (v) of the first session summary, and amendments are proposed with a view to ensuring that the safeguards of the applicant's rights having regard to Article 22 in connection with the communication of the international application to designated Offices would operate satisfactorily in conjunction with the proposed "communication on request" system.

12. The Working Group is invited to consider the proposals contained in Annexes I to IV to this document.

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT

TABLE OF CONTENTS

| | | |
|---------------------|---|----|
| Rule 4 | The Request (Contents)..... | 2 |
| 4.1 | <i>Mandatory and Optional Contents; Signature</i> | 2 |
| 4.2 to 4.8 | [No change]..... | 3 |
| 4.9 | <i>Designation of States, <u>Kinds of Protection, National and Regional Patents</u></i> | 4 |
| 4.10 and 4.11 | [No change]..... | 7 |
| 4.12 | [Deleted] <i>Choice of Certain Kinds of Protection</i> | 7 |
| 4.13 | [Deleted] <i>Identification of Parent Application or Parent Grant</i> | 8 |
| 4.14 | <i>Continuation or Continuation-in-Part</i> | 8 |
| 4.14bis and 4.15 | [No change]..... | 8 |
| 4.16 to 4.18 | [No change]..... | 8 |
| Rule 32 | Extension of Effects of International Application to Certain Successor States..... | 9 |
| 32.1 | <i>Request for Extension of International Application to Successor State</i> | 9 |
| 32.2 | <i>Effects of Extension to Successor State</i> | 11 |
| Rule 48 | International Publication..... | 12 |
| 48.1 to 48.5 | [No change]..... | 12 |
| 48.6 | <i>Announcing of Certain Facts</i> | 12 |
| <u>Rule 49bis</u> | <u>Indications as to Protection Sought for Purposes of National Processing</u> | 13 |
| <u>49bis.1</u> | <u><i>Choice of Certain Kinds of Protection</i></u> | 13 |
| <u>49bis.2</u> | <u><i>Failure to Furnish Indication or Identification</i></u> | 14 |
| Rule 76 | Copy, Translation and Fee Under Article 39(1); Translation of Priority Document..... | 15 |
| 76.1, 76.2 and 76.3 | <i>[Remain Deleted]</i> | 15 |
| 76.4 | [No change]..... | 15 |
| 76.5 | <i>Application of Rules 22.1(g), 49, <u>49bis</u> and 51bis</i> | 15 |
| 76.6 | [No change]..... | 15 |
| Rule 90bis | Withdrawals..... | 16 |
| 90bis.1 to 90bis.7 | [No change]..... | 16 |

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) The request shall contain:

(i) to (iii) [No change]

~~(iv) the designation of States,~~

[COMMENT: In line with the proposed new approach of eliminating the need for individual designations of Contracting States (see, in particular, the proposed new wording of Rule 4.9(a), below) it is proposed to delete item (iv) from the list of mandatory content of the request.]

(iv)~~(v)~~ indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

(b) The request shall, where applicable, contain:

(i) and (ii) [No change]

~~(iii) choices of certain kinds of protection,~~

[Rule 4.1(b), continued]

~~(iv) an indication that the applicant wishes to obtain a regional patent;~~

~~(iii) (v) in the case referred to in Rule 4.14, a reference to a parent application or parent patent,~~

[COMMENT: In line with the proposed elimination of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see Rule 4.9(a)(ii) as proposed to be amended, and Rules 4.12 and 4.13 as proposed to be deleted, below), and of the need to specify whether national and/or regional patents are sought (see Rule 4.9(a)(iii) as proposed to be amended, below), it is proposed to delete present items (iii) and (iv) from the list of mandatory contents (where applicable) of the request and to amend and renumber present item (v) accordingly. New item (iii) (amended former item (v)) would still give the applicant the possibility to refer to a parent application where the international application is the continuation or continuation in part of such earlier (parent) application; see also Rule 4.14, below. See also proposed new Rule 49bis, below.]

~~(iv)(vi)~~ an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) [No change]

4.2 to 4.8 [No change]

4.9 *Designation of States, Kinds of Protection, National and Regional Patents*

(a) The filing of a request shall:

(i) constitute the designation of all Contracting States;

(ii) have the effect of an indication of the wish of the applicant to treat the international application, in each designated State in respect of which Article 43 or 44 applies, as an application for every kind of protection which is available by way of the designation of that State and to defer the express indication referred to in those Articles to the time of performing the acts referred to in Article 22(1);

(iii) have the effect of an indication of the wish of the applicant to treat the international application, in each designated State in respect of which Article 45 applies, as an application for both a regional patent and, unless Article 45(2) applies, a national patent.

~~Contracting States shall be designated in the request:~~

~~(i) in the case of designations for the purpose of obtaining national patents, by an indication of each State concerned;~~

~~(ii) in the case of designations for the purpose of obtaining a regional patent, by an indication that a regional patent is desired either for all Contracting States which are party to the regional patent treaty concerned or only for such Contracting States as are specified.~~

[COMMENT: Following comments by various delegations, paragraph (a) has been further amended so as to simplify the wording further. See paragraph (c) with regard to the possibility to exclude certain States from being designated.]

[Rule 4.9, continued]

(b) The national law applicable by a designated Office shall not require that any express indication referred to in Article 43, 44 or 45 be made prior to the time of performing the acts referred to in Article 22(1). ~~The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:~~

~~(i) at least one Contracting State is designated under paragraph (a), and~~

~~(ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.~~

[COMMENT: The aim of paragraph (b) as proposed to be amended is to ensure that the applicant can indeed rely on the new concept of obtaining an automatic and all-inclusive coverage with regard to all possible kinds of protection without the risk of violating the national law applicable in any designated Office. Furthermore, in line with the new concept of designations, there is no need to maintain the present precautionary designation and confirmation system as provided in existing paragraphs (b) and (c).]

(c) Notwithstanding paragraph (a)(i), if, on [date], paragraph (a)(i) is not compatible with the national law applied by the designated Office, the request may, for as long as paragraph (a)(i) continues not to be compatible with that law, contain an indication that the designation of the State for which the said Office acts as designated Office is not made, provided that the said Office informs the International Bureau accordingly by [date]. The information received shall be promptly published by the International Bureau in the Gazette.
~~The confirmation of any designation made under paragraph (b) shall be effected by~~

[Rule 4.9(c), continued]

~~(i) filing with the receiving Office a written notice containing an indication as referred to in paragraph (a)(i) or (ii), and~~

~~(ii) paying to the receiving Office the designation fee and the confirmation fee referred to in Rule 15.5~~

~~within the time limit under paragraph (b)(ii).~~

[COMMENT: Paragraph (c) is proposed to be amended so as to provide, in the form of a transitional reservation provision, for the possibility to exclude certain States from being designated if paragraph (a)(i) is not compatible with the national law applied by the designated Office concerned. Note that the possibility to exclude would only apply to the designation of States but not to kinds of protection or the choice between national and regional patents.]

(d) The applicant may correct or withdraw any indication made under paragraph (c) by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

[COMMENT: New paragraph (d) is proposed to be added since there appears to be a need to allow for the correction of mistakes made when excluding certain designations; without the possibility to correct, it would be impossible to get a designation back into the application once it has been (erroneously) excluded from the designations (such correction is possible under today's "confirmation of precautionary designation system"). It is not foreseen to allow the applicant to "add" an indication of exclusion, since this, in effect, would result in the withdrawal of a designation, an action which the applicant can still perform under

[Rule 4.9(d), continued]

existing Rule 90bis.2, which remains unchanged. As to the time limit within which the applicant can correct or withdraw an “indication of exclusion”, it is proposed to give the applicant more time as is presently the case under the “confirmation of precautionary designation system” (to be compared with that system since, in effect, the correction/withdrawal of an “indication of exclusion” is nothing else than an addition of a designation after the filing of the international application).]

4.10 and 4.11 [No change]

4.12 [~~Deleted~~] ~~*Choice of Certain Kinds of Protection*~~

~~(a) If the applicant wishes his international application to be treated, in any designated State, as an application not for a patent but for the grant of any of the other kinds of protection specified in Article 43, he shall so indicate in the request. For the purposes of this paragraph, Article 2(ii) shall not apply.~~

~~(b) In the case provided for in Article 44, the applicant shall indicate the two kinds of protection sought, or, if one of two kinds of protection is primarily sought, he shall indicate which kind is sought primarily and which kind is sought subsidiarily.~~

[COMMENT: Rule 4.12 is proposed to be deleted so as to eliminate of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see also Rule 4.9(a)(ii) as proposed to be amended, above, and Rule 4.13 as proposed to be deleted, below).]

4.13 ~~[Deleted] *Identification of Parent Application or Parent Grant*~~

~~If the applicant wishes his international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, he shall identify the parent application or the parent patent, parent inventor's certificate, or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph, Article 2(ii) shall not apply.~~

[COMMENT: Rule 4.13 is proposed to be deleted so as to eliminate of the need for a choice of certain kind(s) of protection to be made at the time of filing the international application (see also Rule 4.9(a)(ii) as proposed to be amended and Rule 4.12 as proposed to be deleted, above).]

4.14 *Continuation or Continuation-in-Part*

If the applicant wishes his international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, he shall so indicate in the request and shall identify the parent application involved.

[COMMENT: Upon further review, as has been suggested in paragraph 12(viii) of the first session summary, it is no longer proposed to deleted Rule 4.14 (as was proposed in document PCT/R/WG/1/1).]

4.14*bis* and 4.15 [No change]

[COMMENT: No change of Rule 4.15 is proposed in the context of this Annex; see, however, changes proposed in the context of a separate document concerning signature requirements.]

4.16 to 4.18 [No change]

Rule 32

Extension of Effects of International Application to Certain Successor States

32.1 *Request for Extension of International Application to Successor State*

(a) The effects of any international application whose international filing date falls in the period defined in paragraph (b) ~~are may, subject to the performance by the applicant of the acts specified in paragraph (e), be~~ extended to a State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting State designated in the international application which subsequently ceased to exist (“the predecessor State”), provided that the successor State has become a Contracting State through the deposit, with the Director General, of a declaration of continuation the effect of which is that the Treaty is applied by the successor State.

[COMMENT: Upon further review, as has been suggested in paragraph 12(x) of the first session summary, and in line with the proposed new approach with regard to designations, it is now proposed to amend Rule 32 so as to automatically extend the effects of an international application to a successor State which has deposited a declaration of continuation under Rule 32.1(a).]

(b) [No change]

[Rule 32.1, continued]

(c) Information on ~~In respect of~~ any international application whose filing date falls within the applicable period under paragraph (b) and whose effect is extended to the successor State shall be published by; the International Bureau ~~shall in the Gazette. send the applicant a notification informing him that he may make a request for extension by performing, within three months from the date of that notification, the following acts:~~

~~(i) filing with the International Bureau the request for extension;~~

~~(ii) paying to the International Bureau an extension fee in Swiss francs, the amount of which shall be the same as the amount of the designation fee referred to in Rule 15.2(a).~~

[COMMENT: It is proposed to stop sending individual notifications to each applicant and instead to publish the relevant information about the extension and the IAs concerned in the Gazette.]

(d) [Deleted] ~~This Rule shall not apply to the Russian Federation.~~

[COMMENT: Proposed deletion of paragraph (d) would appear consequential on the proposed amendment of paragraph (a).]

32.2 *Effects of Extension to Successor State*

(a) Where the effects of the international application are extended to the successor State
~~a request for extension is made~~ in accordance with Rule 32.1,

(i) the successor State shall be considered as having been designated in the
international application, and

(ii) the applicable time limit under Article 22 or 39(1) in relation to that State shall
be extended until the expiration of at least ~~six~~ three months from the date of the publication of
the information under Rule 32.1(c) ~~request for extension~~.

[COMMENT: It appears justified to extend the time limit for national phase entry to six months from the date of the publication of the information concerning the extension and the IAs concerned since the applicant is no longer notified by the IB by way of an individual notification but has to rely on the information published in the Gazette.]

(b) and (c) [No change]

Rule 48

International Publication

48.1 to 48.5 [No change]

[COMMENT: In line with the proposed new concept of eliminating the need for individual designations, the Administrative Instructions could be modified so as to avoid having to indicate, on each front page of the pamphlet (and in each entry in the Gazette, see Rule 86.1(a)(i) and Annex D of the Administrative Instructions), a list of all names (two-letter country codes) of all States designated in the international application concerned, noting that, in all cases, that list would always contain all States bound by the Treaty on the international filing date of the application concerned. Instead, an entry along the following lines could appear on the front page of the pamphlet: “Designated States: all States bound by the Treaty on the international filing date of this application.” In the electronic version of the PCT Gazette, the list of those States could be seen by clicking on a hyperlink; furthermore, the International Bureau would publish in each PCT Gazette a list of the Contracting States indicating the date on which each of them became bound by the Treaty.]

48.6 *Announcing of Certain Facts*

(a) If any notification under Rule 29.1~~(a)~~(ii) reaches the International Bureau at a time later than that at which it was able to prevent the international publication of the international application, the International Bureau shall promptly publish a notice in the Gazette reproducing the essence of such notification.

[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed amendment of Rule 29.1 (see Annex III, below).]

(b) *[Remains deleted]*

(c) [No change]

Rule 49bis

Indications as to Protection Sought for Purposes of National Processing

49bis.1 Choice of Certain Kinds of Protection

(a) If the applicant wishes the international application to be treated, in any designated State in respect of which Article 43 applies, as an application not for the grant of a patent but for the grant of another kind of protection referred to in that Article, the applicant shall so indicate within the time limit applicable under Article 22(1) or 39(1)(a). For the purposes of this paragraph, Article 2(ii) shall not apply.

(b) If the applicant wishes the international application to be treated, in any designated State in respect of which Article 44 applies, as an application for the grant of more than one kind of protection referred to in Article 43, the applicant shall so indicate within the time limit applicable under Article 22(1) or 39(1)(a) and shall also indicate, if applicable, which kind of protection is sought primarily and which kind is sought subsidiarily.

(c) In the cases referred to in paragraphs (a) and (b), if the applicant wishes the international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, the applicant shall identify the parent application or the parent patent, parent inventor's certificate, or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph, Article 2(ii) shall not apply.

[Rule 49bis.1(c), continued]

[COMMENT: See comment to Rule 4.9(a)(ii), above. Under the new concept, the applicant would obtain, when filing an international application, an automatic and all-inclusive coverage with regard to all kind(s) of protection, without the need to specify, already upon filing, which kind(s) of protection he intends to seek in any of the designated States. Instead, under proposed new Rule 49bis, the applicant would be required to do so only upon entry into the national phase before the designated Office concerned. Of course, if the applicant does not make any choice of kind of protection, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)).]

49bis.2 Failure to Furnish Indication or Identification

Where the applicant fails to furnish any indication or identification referred to in Rule 49bis.1 within the time limit referred to in that Rule, the applicant shall have an opportunity to furnish any such indication or identification within a further time which shall be reasonable under the circumstances.

[COMMENT: New Rule 49bis.2 is proposed to be added so as to give the applicant who has not, upon entry into the national phase, complied with the requirement to make the choice of the kind(s) of protection sought, and/or to identify the parent application or grant, another opportunity to do so within a reasonable time limit. Note that there would be no obligation on the designated Office to invite the applicant to make such choice or to identify the parent application or grant. Where the applicant, after the expiration of the applicable time limit, still has not made any choice, or has not identified the parent application or grant, the international application is to be treated as an application for the grant of a patent (only) (see Article 4(3)); furthermore, provisions under the applicable national law which provide for a conversion of an application for the grant of a patent into an application for the grant of another kind of protection, if any, apply.]

Rule 76

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain Deleted]*

76.4 [No change]

76.5 *Application of Rules 22.1(g), 49, [49bis](#) and 51bis*

Rules 22.1(g), 49, [49bis](#) and 51bis shall apply, provided that:

(i) to (iv) [No change]

76.6 [No change]

[Comment: It is proposed to amend Rule 76.5 so as to ensure that proposed new Rule 49bis is also applied with regard to elected Offices.]

Rule 90bis

Withdrawals

90bis.1 to 90bis.7 [No change]

[COMMENT: Upon further review, as has been suggested in paragraphs 12(ii) and (iii) of the first session summary, and in particular in view of the wording of PCT Articles 24(1)(i) and 37(1), it is no longer proposed to eliminate the possibility to withdraw individual designations or elections. Thus, no change is proposed to be made to Rule 90bis.]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RELATED PROPOSALS:

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT

TABLE OF CONTENTS

| | |
|---|---|
| Rule 53 The Demand..... | 2 |
| 53.1 to 53.6 [No change]..... | 2 |
| 53.7 <i>Election of States</i> | 2 |
| 53.8 and 53.9 [No change]..... | 2 |
| Rule 61 Notification of the Demand and Elections..... | 3 |
| 61.1 to 61.3 [No change]..... | 3 |
| 61.4 <i>Publication in the Gazette</i> | 3 |

Rule 53

The Demand

53.1 to 53.6 [No change]

53.7 *Election of States*

~~(a) The filing of a demand shall constitute the election of all ~~indicate at least one~~ Contracting States, ~~from among those States~~ which are designated and are bound by Chapter II of the Treaty (~~“eligible States”~~), ~~as an elected State.~~~~

~~(b) Election of Contracting States in the demand shall be made:~~

~~(i) by an indication that all eligible States are elected, or,~~

~~(ii) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States that are elected, and, in the case of States which have been designated for the purpose of obtaining a regional patent, by an indication of the regional patent concerned together with either an indication that all eligible States party to the regional patent treaty concerned are elected or an indication of those among the said States that are elected.~~

[COMMENT: Rule 53.7 is proposed to be amended so as to align the concept of election of Contracting States with the proposed new concept of designation. The proposed new wording is necessary to ensure compliance with Article 31(4) which requires that the demand “shall indicate ... the Contracting ... States...in which the applicant intends to use the results of the international preliminary examination.” While Rule 4.9(c) as proposed to be amended allows for the exclusion of certain Contracting States from being designated, it appears not necessary to also allow for the exclusion of certain designated States from being elected.]

53.8 and 53.9 [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 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: Rule 61.4 has been reviewed (as suggested in paragraph 13(iv) of the first session summary) but no change is proposed to be made to Rule 61.4 in the context of this document. However, 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 have to be modified so as to bring it in line with the proposed new concept of eliminating the need for individual elections and the fact that, under the proposed new approach, exclusion of elections would not any longer be possible. Note that Rule 61.4 is proposed to be amended in the context of the proposed introduction of the expanded international search system and that the 19-months time limit under Rule 61.4 has thus been put in square brackets.]

[Annex III follows]

ANNEX III

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RELATED PROPOSALS:
“FLAT” INTERNATIONAL FILING FEE

TABLE OF CONTENTS

| | | |
|------------------|---|----|
| Rule 15 | The International <u>Filing</u> Fee..... | 2 |
| 15.1 | <i>The International <u>Filing</u> Basic Fee and Designation Fee</i> | 2 |
| 15.2 | <i>Amounts</i> | 2 |
| 15.3 | <i>[Remains deleted]</i> | 4 |
| 15.4 | <i>Time Limit for Payment; Amount Payable</i> | 4 |
| 15.5 | <i>[Deleted] Fees Under Rule 4.9(e)</i> | 5 |
| 15.6 | <i>Refund</i> | 5 |
| Rule 16bis | Extension of Time Limits for Payment of Fees | 6 |
| 16bis.1 | <i>Invitation by the Receiving Office</i> | 6 |
| 16bis.2 | <i>Late Payment Fee</i> | 8 |
| Rule 27 | Lack of Payment of Fees..... | 9 |
| 27.1 | <i>Fees</i> | 9 |
| Rule 29 | International Applications or Designations Considered Withdrawn | 10 |
| 29.1 | <i>Finding by Receiving Office</i> | 10 |
| 29.2 | <i>[Remains deleted]</i> | 10 |
| Rule 51 | Review by Designated Offices..... | 11 |
| 51.1 | <i>Time Limit for Presenting the Request to Send Copies</i> | 11 |
| 51.2 and 51.3 | <i>[No change]</i> | 11 |
| SCHEDULE OF FEES | | 12 |

Rule 15

The International Filing Fee

15.1 *The International Filing ~~Basic Fee and Designation~~ Fee*

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau (“international filing fee”) to be collected by the receiving Office. That fee includes the fee referred to in Article 4(2). ~~and consisting of,~~

~~(i) a “basic fee,” and~~

~~(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a), except that, where Article 44 applies in respect of a designation, only one designation fee shall be due for that designation, and that the Schedule of Fees may indicate a maximum number of designation fees payable.~~

[COMMENT: In line with the new concept of eliminating the need for individual designations, it is proposed to also eliminate the need for the payment of individual designation fees and to replace both the current basic fee and the current designation fee(s) with just one flat “international filing fee,” irrespective of the number of designations made. See also Rule 27 as proposed to be amended.]

15.2 *Amounts*

(a) The amount ~~amounts~~ of the international filing ~~basic fee and of the designation~~ fee is ~~are~~ as set out in the Schedule of Fees.

[Rule 15.2, continued]

(b) The international filing ~~basic fee and the designation~~ fee shall be payable in the currency or one of the currencies prescribed by the receiving Office (“prescribed currency”), it being understood that, when transferred by the receiving Office to the International Bureau, ~~it they~~ shall be freely convertible into Swiss currency. The amount ~~amounts~~ of the international filing ~~basic fee and of the designation~~ fee shall be established, for each receiving Office which prescribes the payment of ~~that those~~ fees in any currency other than Swiss currency, by the Director General after consultation with the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as the prescribed currency. The ~~amounts~~ so established shall be the ~~equivalents~~, in round figures, of the ~~amounts~~ in Swiss currency set out in the Schedule of Fees. ~~It They~~ shall be notified by the International Bureau to each receiving Office prescribing payment in that prescribed currency and shall be published in the Gazette.

(c) Where the amount ~~amounts~~ of the international filing fee ~~fees~~ set out in the Schedule of Fees ~~is are~~ changed, the corresponding ~~amounts~~ in the prescribed currencies shall be applied from the same date as the ~~amounts~~ set out in the amended Schedule of Fees.

(d) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new ~~amounts~~ in the prescribed currency according to directives given by the Assembly. The newly established ~~amounts~~ shall become applicable two months after the date of its ~~their~~ publication in the Gazette, provided that the receiving Office referred to in the second sentence of paragraph (b) and the Director General may agree on a date falling during the said two-month period, in which case the said ~~amounts~~ shall become applicable from that date.

15.3 *[Remains deleted]*

15.4 *Time Limit for Payment; Amount Payable*

(a) The international filing basic fee shall be paid within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

~~(b) The designation fee shall be paid within a time limit of:~~

~~(i) — one year from the priority date, or~~

~~(ii) — one month from the date of receipt of the international application if that one-month period expires later than one year from the priority date.~~

~~(c) Where the designation fee is paid before the expiration of one month from the date of receipt of the international application, the amount payable shall be the amount applicable on that date of receipt. Where the time limit under paragraph (b)(i) applies and the designation fee is paid before the expiration of that time limit but later than one month from the date of receipt of the international application, the amount payable shall be the amount applicable on the date of payment.~~

15.5 ~~[Deleted] *Fees Under Rule 4.9(c)*~~

~~(a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(c) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office) equal to 50% of the sum of the designation fees payable under this paragraph. Such fees shall be payable in respect of each designation so confirmed, even if the maximum number of designation fees referred to in item 2(a) of the Schedule of Fees is already payable or if a designation fee is already payable in respect of the designation under Rule 4.9(a) of the same State for a different purpose.~~

~~(b) Where moneys paid by the applicant within the time limit under Rule 4.9(b)(ii) are not sufficient to cover the fees due under paragraph (a), the receiving Office shall allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.~~

15.6 *Refund*

The receiving Office shall refund the international [filing](#) fee to the applicant:

- (i) to (iii) [No change]

[COMMENT: Proposed amendments of Rules 15. 2 to 15.6 are consequential on the proposed elimination of the designation fee, the basic fee, and the system of confirmation of precautionary designations.]

Rule 16bis

Extension of Time Limits for Payment of Fees

16bis.1 Invitation by the Receiving Office

(a) Where, by the time they are due under Rules 14.1(c), 15.4(a) and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the [international filing basic](#) fee and the search fee, the receiving Office 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 16bis.2, within a time limit of one month from the date of the invitation.

(b) ~~[Deleted] Where, by the time they are due under Rule 15.4(b), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Office 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 16bis.2, within a time limit of one month from the date of the invitation. The amount payable in respect of any designation fee shall be the amount applicable on the last day of the one year period from the priority date if the time limit under Rule 15.4(b)(i) applies or the amount applicable on the date of receipt of the international application if the time limit under Rule 15.4(b)(ii) applies.~~

[Rule 16bis.1, continued]

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) ~~or (b)~~ and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall, subject to paragraph (d):

(i) [Deleted] ~~allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions,~~

(ii) make the applicable declaration under Article 14(3), and

(iii) proceed as provided in Rule 29.

(d) Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) ~~or (b)~~ shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.4(a) ~~or (b)~~ or 16.1(f), as the case may be.

(e) Any payment received by the receiving Office before that Office makes the applicable declaration under Article 14(3) shall be considered to have been received before the expiration of the time limit referred to in paragraph (a) ~~or (b)~~.

16bis.2 *Late Payment Fee*

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) ~~or (b)~~ may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of 50% of the international filing ~~basic~~ fee referred to in item 1 ~~(a)~~ of the Schedule of Fees.

[COMMENT: The proposed amendments of Rule 16bis are consequential on the proposed elimination of the designation fee and the basic fee.]

Rule 27

Lack of Payment of Fees

27.1 *Fees*

(a) For the purposes of Article 14(3)(a), “fees prescribed under Article 3(4)(iv)” means: the transmittal fee (Rule 14), the ~~basic fee part of the~~ international [filing](#) fee (Rule 15.1~~(i)~~), the search fee (Rule 16), and, where required, the late payment fee (Rule 16*bis*.2).

(b) For the purposes of Article 14(3)(a) and (b), “the fee prescribed under Article 4(2)” means the ~~designation fee part of the~~ international [filing](#) fee (Rule 15.1~~(ii)~~) and, where required, the late payment fee (Rule 16*bis*.2).

[COMMENT: Consequential on the proposal to eliminate the need for the payment of individual designation fees (see Rule 15.1 as proposed to be amended).]

Rule 29

International Applications ~~or Designations~~ Considered Withdrawn

29.1 *Finding by Receiving Office*

~~(a)~~ If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iv) [No change]

~~(b) If the receiving Office declares under Article 14(3)(b) (failure to pay the prescribed designation fee under Rule 27.1(b)) that the designation of any given State is considered withdrawn, the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration. The International Bureau shall in turn notify each designated Office which has already been notified of its designation.~~

[COMMENT: Consequential on the proposal to eliminate the need for the payment of individual designation fees (see Rule 15.1 as proposed to be amended).]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 51

Review by Designated Offices

51.1 *Time Limit for Presenting the Request to Send Copies*

The time limit referred to in Article 25(1)(c) shall be two months computed from the date of the notification sent to the applicant under Rules 20.7(i), 24.2(c); [or](#) 29.1~~(a)~~(ii); ~~or 29.1(b)~~.

[COMMENT: The proposed amendment of Rule 51.1 is consequential on the proposed amendment of Rule 29.1 (see above).]

51.2 and 51.3 [No change]

SCHEDULE OF FEES

| Fees | Amounts |
|---|--|
| 1. <u>International Filing</u> Basic Fee: (Rule 15.2(a)) | [...] <u>650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets</u> |
| (a) if the international application contains not more than 30 sheets | 650 Swiss francs |
| (b) if the international application contains more than 30 sheets | 650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets |
| 2. Designation Fee: (Rule 15.2(a)) | |
| (a) for designations made under Rule 4.9(a) | 140 Swiss francs per designation provided that any designation made under Rule 4.9(a) in excess of 6 shall not require the payment of a designation fee |
| (b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)* | 140 Swiss francs per designation |
| <u>3</u> 3. Handling Fee: (Rule 57.2(a)) | 233 Swiss francs |

Reductions

3 4. The international filing fee ~~total amount of the fees payable under items 1 and 2(a)~~ is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.

4 5. All fees payable (where applicable, as reduced under item 3 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[COMMENT: The amount of the international filing fee remains to be determined in the context of WIPO's budget.]

[Annex IV follows]

* ~~Editor's Note: See Rule 15.5(a) for the confirmation fee, which is also payable.~~

ANNEX IV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RELATED PROPOSALS:
“COMMUNICATION ON REQUEST” SYSTEM

TABLE OF CONTENTS

| | | |
|---------------------|--|----|
| Rule 24 | Receipt of the Record Copy by the International Bureau | 2 |
| 24.1 | <i>[Remains deleted]</i> | 2 |
| 24.2 | <i>Notification of Receipt of the Record Copy</i> | 2 |
| Rule 47 | Communication to Designated Offices | 4 |
| 47.1 | <i>Procedure</i> | 4 |
| 47.2 | <i>Copies</i> | 6 |
| 47.3 | [No change]..... | 7 |
| 47.4 | <i>Express Request Under Article 23(2) <u>Prior to International Publication</u></i> | 7 |
| Rule 61 | Notification of the Demand and Elections | 8 |
| 61.1 | [No change]..... | 8 |
| 61.2 | <i>Notification to the Elected Offices</i> | 8 |
| 61.3 and 61.4 | [No change] | 8 |
| Rule 73 | Communication of the International Preliminary Examination Report | 9 |
| 73.1 | [No change]..... | 9 |
| 73.2 | <i>Time Limit for</i> <i>Communication</i> | 9 |
| Rule 76 | Copy, Translation and Fee Under Article 39(1); Translation of Priority Document | 10 |
| 76.1, 76.2 and 76.3 | <i>[Remain deleted]</i> | 10 |
| 76.5 | <i>Application of Rules 22.1(g), <u>47.1(e)</u>, 49 and 51bis</i> | 10 |
| 76.6 | [No change]..... | 10 |
| <u>Rule 93bis</u> | <u>Communication, Notification and Transmittal on Request</u> | 11 |
| <u>93bis.1</u> | <u>Communication, Notification and Transmittal on Request</u> | 11 |

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 *[Remains deleted]*

24.2 *Notification of Receipt of the Record Copy*

(a) The International Bureau shall promptly notify:

(i) to (iii) [No change]

of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the ~~States~~ designated Offices under Rule 4.9(a) and, in the case of a designated Office which is responsible for granting regional patents, of the Contracting States designated for such regional patent ~~where applicable, of those States whose designations have been confirmed under Rule 4.9(c).~~

[COMMENT: Rule 24.2(a) is proposed to be amended so as to bring it in line with the current practice of the International Bureau when informing the applicant about the designations made (Form PCT/IB/301).]

[Rule 24.2, continued]

(b) ~~[Deleted] Each designated Office which has informed the International Bureau that it wishes to receive the notification under paragraph (a) prior to the communication under Rule 47.1 shall be so notified by the International Bureau:~~

~~(i) if the designation concerned was made under Rule 4.9(a), promptly after the receipt of the record copy;~~

~~(ii) if the designation concerned was made under Rule 4.9(b), promptly after the International Bureau has been informed by the receiving Office of the confirmation of that designation.~~

[COMMENT: In line with the new concept of eliminating the need for individual designations and the replacement of the systematic communication of documents to designated Offices by a “communication on request” system (see proposed new Rule 93bis, below), it is proposed to delete paragraph (b).]

(c) [No change]

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) [No change]

(a-bis) The International Bureau shall notify each designated Office, at the time when ~~of~~ the communication provided for in Article 20 is effected, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. ~~Such notification shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.~~

(a-ter) [No change]

(b) The ~~Such~~ communication provided for in Article 20 shall be effected upon request by the designated Office but, subject to Rule 47.4, not prior to ~~promptly after~~ the international publication of the international application ~~and, in any event, by the end of the 19th month after the priority date~~. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

[Rule 47.1, continued]

(c) The International Bureau shall send a notice to the applicant indicating the designated Offices to which the communication has been effected and the date of such communication. Such notice shall be sent on the same day as the communication. ~~Each designated Office shall be informed, separately from the communication, about the sending and the date of mailing of the notice. The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice.~~

[COMMENT: Upon further review, as has been suggested in paragraph 18(iv) of the first session summary, it appears that, in view of paragraph (e) as proposed to be amended (see below), there is no longer a need for an additional safeguard for the applicant and that paragraph (c) can be amended accordingly. Under paragraph (c) as proposed to be amended, the IB would have to send out a notification to the applicant, informing him about the fact that a particular DO has requested the communication under Article 20 to take place, no matter whether such request was made at the time of publication (“systematic communication”), or later, for example, after national phase entry (“communication on request”).]

(d) [No change]

(e) No designated Office shall require the applicant to furnish a copy of the international application under Article 22(1) unless it has requested the International Bureau, under paragraph (b), to effect the communication and has been informed by the International Bureau that the international application is not in its files. ~~Where any designated Office has waived the requirement provided under Article 20, the copies of the documents which otherwise would have been sent to that Office shall, at the request of that Office or the applicant, be sent to the applicant at the time of the notice referred to in paragraph (c).~~

[Rule 47.1(e), continued]

[COMMENT: Proposed amendments to Rule 47.1(e) would give the applicant the assurance that he could always rely on the fact that a designated Office would not require the applicant to furnish a copy of the international application under Article 22(1) (before or after expiration of the time limit under Article 22(1)) unless it has first requested the International Bureau to effect the communication (“on request) and has been informed by the International Bureau that the international application is not in its files.]

47.2 *Copies*

(a) The copies required for communication shall be prepared by the International Bureau. [Further details concerning the copies required for communication may be provided for in the Administrative Instructions.](#)

(b) ~~[Deleted] They shall be on sheets of A4 size.~~

(c) ~~[Deleted] Except to the extent that any designated Office notifies the International Bureau otherwise, copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.~~

[COMMENT: In the context of the proposed move from a “systematic communication system” to a “communication on request system” (see proposed new Rule 93*bis*, below), it is proposed to delete both paragraph (b) and (c) and to provide in the Administrative Instructions for the details concerning the way in which copies of international applications are communicated to designated Offices (on paper or in electronic form, by mail or by electronic means).]

47.3 [No change]

47.4 *Express Request Under Article 23(2)* *Prior to International Publication*

Where the applicant makes an express request to a designated Office under Article 23(2) prior to the international publication of the international application ~~before the communication provided for in Article 20 has taken place~~, the International Bureau shall, upon request of the applicant or the designated Office, promptly effect the ~~that~~ communication provided for in Article 20 to that Office.

[COMMENT: Notwithstanding paragraph 18(v) of the first session summary, it is not proposed to combine Rule 47.4 with Rule 47.1(b). Rather, Rule 47.4 is proposed to be amended so as to bring it in line with the new approach taken under Rule 47.1(b) (communication of the pamphlet on request only). Rule 47.1(b) deals with the “usual” case where communication of the pamphlet to a DO will only take place upon request by the DO concerned and only after international publication of the IA; Rule 47.4, on the other hand, deals with the “exceptional” case where the applicant has entered the national phase early before international publication has taken place; in that case, the communication of the international application may take place, upon request of the applicant or the DO concerned, already before international publication.]

Rule 61

Notification of the Demand and Elections

61.1 [No change]

61.2 *Notification to the Elected Offices*

(a) to (c) [No change]

[COMMENT: No change to paragraphs (a), (b) and (c) is proposed in the context of this Annex. See, however, the proposed amendment of paragraphs (b) and (c) in Annex II, above.]

(d) Where the applicant makes an express request to an elected Office under Article 40(2) prior to the international publication of the international application ~~before the communication provided for in Article 20 has taken place~~, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect the ~~that~~ communication provided for in Article 20 to that Office.

[COMMENT: Proposed amendment of paragraph (d) is consequential on the proposed move from a “systematic communication system” to a “communication on request system”. See also Rule Rule 47.4 as proposed to be amended, above.]

61.3 and 61.4 [No change]

Rule 73

**Communication of the
International Preliminary Examination Report**

73.1 [No change]

73.2 *Time Limit for Communication*

The communication provided for in Article 36(3)(a) shall be effected upon request by the elected Office ~~as promptly as possible~~ but not earlier than the communication under Article 20.

[COMMENT: Proposed amendment of Rule 73.2 is consequential on the proposed move from a system under which all documents, including copies of international preliminary examination reports, are systematically communicated to all elected Offices, to a system under which such communication would only take place upon request of the designated/elected Office concerned. See proposed new Rule 93bis, below.]

Rule 76

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 *Application of Rules 22.1(g), [47.1\(e\)](#), 49 and 51bis*

Rules 22.1(g), [47.1\(e\)](#), 49 and 51bis shall apply, provided that:

(i) to (iv) [No change]

[COMMENT: Proposed amendment of Rule 76.5 is consequential on the proposed amendment to Rule 47.1.]

76.6 [No change]

Rule 93bis

Communication, Notification and Transmittal on Request

93bis.1 Communication, Notification and Transmittal on Request

Where the Treaty, these Regulations or the Administrative Instructions provide for documents, notifications, communications or correspondence to be communicated, notified or transmitted by the International Bureau to any designated or elected Office, such communication, notification or transmittal shall be effected only upon request by the Office concerned.

[COMMENT: With regard to the suggestion to extend the communication on request system also to ISAs and IPEAs, see paragraph [11(a)] in the "Background" section of this document. In line with the proposed new concept of designations, it is proposed to move from the current communication system under which documents relating to international applications are systematically communicated to all designated/elected Offices to a system under which such communication would only be effected upon request of the designated/elected Office concerned. Without such new approach as to communication, since all Contracting States would always be (considered to be) designated in all international applications, and elected in each demand, each designated/elected Office would be flooded with a vast amount of documents related to international applications which may never enter the national phase before the Office concerned. Of course, any Office which wishes to do so would be entitled to continue to request to receive all documents on a systematic basis.]

[End of Annex and of document]