

# WIPO



PCT/R/WG/6/5

ORIGINAL: English

DATE: March 16, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

Sixth Session  
Geneva, May 3 to 7, 2004

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

*Document prepared by the International Bureau*

## PROPOSED AMENDMENTS OF RULES 53.9(b) AND 69.1(d)

1. During its fifth session, the Working Group discussed proposals to delete Rules 53.9(b) and 69.1(d), consequential on the amendments adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10, Annex V). The Working Group's discussions (see document PCT/R/WG/5/13, paragraphs 12 to 14) are outlined in the following paragraphs:<sup>1</sup>

“12. Discussions were based on document PCT/R/WG/5/10.

“13. One delegation questioned whether Rules 53.9(b) and 69.1(d), instead of being deleted, as proposed in document PCT/R/WG/5/10, should rather be amended to limit the application of those Rules to the case where, in accordance with Rule 69.1(b), the national Office or intergovernmental organization that acted as both International

---

<sup>1</sup> References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc.

Searching Authority and International Preliminary Examining Authority wished to start the international preliminary examination at the same time as the international search.

“14. The Working Group agreed that the Secretariat should study the matter further, with a view to submitting a revised proposal, if needed, to the Working Group at its next session.”

2. Upon further consideration, it is proposed not to delete Rules 53.9(b) and 69.1(d), as was proposed in document PCT/R/WG/5/10, but to further amend those Rules, for the reasons outlined in the following paragraphs.

3. Under Rules 53.9(b), 54*bis*.1(a) and 69.1(d) as in force as from January 1, 2004, the time limit for making amendments under Article 19 always (with one exception, mentioned further below) expires before the expiration of the time limit under Rule 69.1(a) for the start of the international preliminary examination. (The time limit for making such amendments is *two* months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later, whereas the time limit for the start of the international preliminary examination is *three* months from the date of transmittal to the applicant of the international search report and the written opinion by the International Searching Authority or of the declaration referred to in Article 17(2)(a), or 22 months from the priority date, whichever time limit expires later). Therefore, in the ordinary course of events, there is no need (and, indeed, no possibility) for the applicant to request postponement of the start of the international preliminary examination under Rule 53.9(b).

4. The only exceptional case is that where the applicant submits the demand and pays the preliminary examination fee prior to the start of the international search (typically, at the same time as the filing of the international application itself) and where the International Preliminary Examining Authority (being the same Authority which acts as the International Searching Authority) wishes to start international preliminary examination at the same time as the international search, as contemplated by Rule 69.1(b).

5. It could thus be argued that, in such an exceptional case as outlined in paragraph 4, above, the applicant, by requesting international preliminary examination at such an early stage, could be taken to have forsaken the possibility of also requesting a postponement of the international preliminary examination under Rule 53.9(b), and that thus Rules 53.9(b) and 69.1(d) should be deleted. This, however, would deprive the applicant of his right to have the international preliminary examination carried out on the basis of the claims as amended under Article 19.

6. It is thus proposed not to delete but to amend Rules 53.9(b) and 69.1(d) so as to limit the request for postponement to the exceptional case that the International Preliminary Examining Authority wishes to start examination at the same time as international search. Note, however, that such a request by the applicant would, in effect, make it impossible for the International Preliminary Examining Authority to start examination at the same time as international search.

AMENDMENTS OF RULE 16BIS.1

7. The Annex to this document also contains proposals to further amend Rule 16bis.1 as amended by the PCT Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10, Annex V). These proposed amendments are in the nature of corrigenda or consequential amendments based on the amendments already adopted. Explanations are set out in the Annex in comments relating to the provisions concerned.

*8. 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:<sup>2</sup>

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

TABLE OF CONTENTS

Rule 16bis	Extension of Time Limits for Payment of Fees .....	2
16bis.1	<i>Invitation by the Receiving Office</i> .....	2
16bis.2	[No change] .....	3
Rule 53	The Demand.....	4
53.1 to 53.8	[No change] .....	4
53.9	<i>Statement Concerning Amendments</i> .....	4
Rule 69	Start of and Time Limit for International Preliminary Examination.....	5
69.1	<i>Start of International Preliminary Examination</i> .....	5
69.2	[No change] .....	5

---

<sup>2</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.

**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 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 fee and the search fee, the receiving Office shall, [subject to paragraph \(d\)](#), 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.

[COMMENT: It is proposed to amend paragraph (a) so as to clarify that the sending of an invitation by the receiving Office under paragraph (a) is subject to paragraph (d) (in the same way as paragraph (c) is subject to paragraph (e); see below). Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) would then be considered to have been received in time, and the receiving Office should not send any invitation under paragraph (a).]

(b) *[Remains deleted]*

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) 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 [\(e\)](#) ~~(d)~~:

[COMMENT: it is proposed to further amend Rule 16bis.1(c) so as to replace the erroneous reference to paragraph (d) with a reference to paragraph (e).]

*[Rule 16bis.1(c), continued]*

(i) and (ii) [No change]

(d) [No change] Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.4 or 16.1(f), as the case may be.

(e) [No change] 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).

16bis.2 [No change]

**Rule 53**

**The Demand**

53.1 to 53.8 [No change]

53.9 *Statement Concerning Amendments*

(a) [No change]

(b) If no amendments under Article 19 have been made and the time limit for filing such amendments has not expired, the statement may indicate that, should the International Preliminary Examining Authority wish to start the international preliminary examination at the same time as the international search in accordance with Rule 69.1(b), the applicant wishes the start of the international preliminary examination to be postponed in accordance with Rule 69.1(d).

[COMMENT: See paragraphs 2 to 6 in the Introduction to this document.]

(c) [No change]

**Rule 69**

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

69.1 *Start of International Preliminary Examination*

(a) to (c) [No change]

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

(i) [No change] it has received a copy of any amendments made under Article 19;

(ii) [No change] it has received a notice from the applicant that he does not wish to make amendments under Article 19; or

(iii) the expiration of the applicable time limit under [Rule 46.1](#) ~~Rule 54bis.1(a)~~.

[COMMENT: See paragraphs 2 to 6 in the Introduction to this document.]

(e) [No change]

69.2 [No change]

[End of Annex and of document]