

Patent Cooperation Treaty (PCT) Working Group

**Eleventh Session
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EARLIER START OF PCT CHAPTER II

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SUMMARY

1. The present document contains a proposal aiming at increasing the amount of time available for dialogue between the applicant and the examiner during PCT Chapter II. To this end it is proposed to amend Rule 69.1(a) to allow the International Preliminary Examining Authority to start international preliminary examination when it is in possession of the demand, the relevant fees and either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) and the written opinion established under Rule 43*bis*.1, unless the applicant expressly requests to postpone the start of the international preliminary examination until the expiration of the applicable time limit under Rule 54*bis*.1(a).

BACKGROUND

2. At present, the International Preliminary Examining Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54*bis*.1(a), namely three months from the date of transmittal to the applicant of the international search report or the declaration pursuant to Article 17(2)(a) and the written opinion or 22 months from the priority date, whichever expires later (Rule 69.1(a)). The applicant is entitled to waive this time limit by expressly requesting an earlier start when filling in the demand form (PCT/IPEA/401). However, applicants requesting PCT Chapter II with the European Patent Office as International Preliminary Examining Authority make moderate usage of this waiver.

3. On the other hand, pursuant to Rule 69.2, the time limit for establishing the international preliminary examination report shall be either 28 months from the priority date, six months from the time provided in Rule 69.1 for the start of the international preliminary examination or six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2, whichever expires last.

4. As a result of the interplay between Rules 69.1 and 69.2, the time left for International Preliminary Examining Authorities to establish the first written opinion (Article 34(2)(c)), grant two-months for the applicant to file amendments pursuant to Rule 66 and issue the international preliminary examination report (Rule 70) is often shorter than five months. This time frame becomes even more demanding for International Preliminary Examining Authorities that, following the recommendations contained in paragraph 36 of document PCT/R/2/7, have implemented the policy to issue a second written opinion in the procedure under PCT Chapter II, such as the European Patent Office (EPO Official Journal 2011, 532).

PROPOSAL

5. In light of the relatively short time frame for the steps of the procedure under Chapter II and considering, on the one hand, the encouraging feedback received from European users regarding the introduction of a second written opinion in Chapter II and, on the other, their standing support for increased dialogue during the international preliminary examination, the European Patent Office proposes to amend Rule 69.1(a) to allow the International Preliminary Examining Authority to start international preliminary examination when it is in possession of the demand, the relevant fees and either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) and the written opinion established under Rule 43bis.1, unless the applicant expressly requests to postpone the start of the international preliminary examination until the expiration of the applicable time limit under Rule 54bis.1(a).

6. This proposal would leave unaffected the entitlement of the applicant to submit amendments under Articles 19 or 34 as a basis for the procedure under Chapter II.

7. Therefore, where the international preliminary examination is to take into account amendments under Article 34 but the applicant failed to submit them with the demand, the International Preliminary Examining Authority invites the applicant (Form PCT/IPEA/431) to submit the amendments within a reasonable time limit fixed in the invitation (Rules 53.9(c), 60.1(g) and 69.1(e)). The international preliminary examination shall not start until the International Preliminary Examining Authority has received the amendments or before the time limit fixed in the invitation pursuant to Rule 60.1(g) has expired, whichever occurs first.

8. In the same vein, where the international preliminary examination is to take into account amendments under Article 19 together with the relevant accompanying statements, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.

9. *The Working Group is invited to consider the proposed amendments to the Regulations set out in the Annex to the present document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

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:

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

~~provided that the International Preliminary Examining Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54*bis*.1(a)~~ unless the applicant expressly requests [to postpone the start of the international preliminary examination until the expiration of the applicable time limit under Rule 54*bis*.1\(a\)](#) ~~an earlier start.~~

(b) to (e) *[No change]*

69.2 *[No change]*

[End of Annex and of document]