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The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith ./ documents PCT/R/WG/7/2, 3, 4, 5, 6, 8 and 9, prepared for the seventh session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva from May 25 to 31, 2005.

The working documents are also available on WIPO's Web site (see <http://www.wipo.int/pct/en/meetings>).

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Enclosures: documents PCT/R/WG/7/2, 3, 4, 5, 6, 8 and 9

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WORKING GROUP ON REFORM OF THE PATENT
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Seventh Session
Geneva, May 25 to 31, 2005

MISSING ELEMENTS AND PARTS OF THE INTERNATIONAL APPLICATION

Document prepared by the International Bureau

SUMMARY

1. This document contains further revised proposals for amendment of the Regulations under the PCT¹ related to the according of the international filing, including proposals concerning the correction of defects under Article 11(1), the later furnishing of parts of the description, claims or drawings, and the incorporation by reference of certain elements or parts.

2. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and the comments received on preliminary draft documents made available since then. The main differences in comparison with the proposals considered at the sixth session concern the following: (i) the proposed wording of the statement of incorporation by references under Rule 4.18; (ii) the proposal that the applicant would have to “confirm” the incorporation by

¹ 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.

reference of certain elements or parts rather than, as in previous drafts, “request,” subsequent to the filing of the international application, that the elements or parts be considered to have been contained in the application as filed; (iii) the proposed structure of Rule 20; (iv) the addition of a reservation provision for designated Offices in relation to the provisions concerning incorporation by reference; and (v) the wording of Rule 82*ter* as proposed to be amended.

BACKGROUND

3. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT), based on document PCT/R/WG/1/5.

4. Among the PLT-related proposals contained in document PCT/R/WG/1/5 were proposals to conform the PCT requirements relating to the later furnishing of parts of the description, claims or drawings to those of the PLT (see document PCT/R/WG/1/5, Annex I). However, due to time constraints, the proposals could not be discussed during the first session of the Working Group.

5. For the second session of the Working Group, the International Bureau prepared a document outlining possible further PLT-related changes to the PCT, suggesting, in general, that those PLT-related proposals contained in document PCT/R/WG/1/5 which had not been discussed during the first session of the Working Group would not need to be addressed as matters of high priority. With regard to the proposal to conform the above mentioned PCT requirements relating to the later furnishing of parts of the description, claims or drawings to those of the PLT, as contained in Annex I to document PCT/R/WG/1/5, it was suggested that “[i]n light of the discussions at the first session of the Working Group, this proposal is considered to have a relatively low priority and will not be resubmitted for consideration by the Working Group until a later date” (see document PCT/R/WG/2/6, paragraph 9; the Working Group at its second session was unable in the time available to consider document PCT/R/WG/2/6 – see document PCT/R/WG/2/12, paragraph 59).

6. At its third session, the Working Group reviewed proposals for reform which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was the proposal to conform the PCT requirements relating to the later furnishing of parts of the description, claims or drawings to those of the PLT, as originally submitted to the Working Group in document PCT/R/WG/1/5. The Working Group agreed that the International Bureau should resubmit the proposals for further consideration by the Working Group (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 35 to 40, in particular, paragraph 38).

7. Further revised proposals relating to the later furnishing of parts of the description, claims or drawings prepared by the International Bureau were considered by the Working Group at its fourth, fifth and sixth session. As had been agreed by the Working Group at its fifth session (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 92), the revised proposals discussed by the Working Group at its sixth session included proposals not only to allow the applicant to “incorporate by reference” certain parts of the description, claims or drawings (similar to the provision under PLT Article 5(6)) without loss of the filing date, but also to allow the applicant to

“incorporate by reference”, for the purposes of the international filing date, the part which on the face of it appears to be a description and the part which on the face of it appears to be a claim or claims (in effect, similar to the “reference filing” provision under PLT Article 5(7) in respect of the description and any drawings) where any such element is not otherwise contained in the international application.

8. The summaries by the Chair of the sessions of the Working Group set out the status of the matters discussed by the Committee and the Working Group, respectively, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken (see documents PCT/R/WG/4/14, paragraphs 45 to 71, PCT/R/WG/5/13, paragraphs 28 to 62, and PCT/R/WG/6/12, paragraphs 58 to 67).

9. The Working Group’s discussions at its most recent (sixth) session (see document PCT/R/WG/6/12, paragraphs 58 to 67) are outlined in the following paragraphs:

“58. Discussions were based on documents PCT/R/WG/6/4 and 4 Add.1.

“59. The Working Group was generally in favor of the proposals contained in the document and invited the Secretariat to prepare revised proposals, for consideration at the next session, taking into account the comments and suggestions set out in the following paragraphs.

“60. While a number of questions remained to be addressed, the revised drafting of Rules 4.18 and 20 in document PCT/R/WG/6/4 Add.1 was in general preferred to that in document PCT/R/WG/6/4. The references to Rules 4.18 and 20 in the following paragraphs are thus to those Rules as they appear in document PCT/R/WG/6/4 Add.1. *Rules 4.18 and 20*

“61. Some delegations expressed the view that there was no basis in the Treaty itself for the incorporation by reference of a missing element or missing part of an international application and therefore believed that an amendment of the Treaty would be required in order to implement provisions of the kind envisaged.

“62. One delegation expressed the view that, since incorporation by reference of a missing element under Rule 4.18 would be conditional on compliance with the requirements of Rule 20.5(a) and (b), the proposed provision was not compatible with Articles 11(2) and 14(2) since, “at the time of receipt” of the international application, the missing element was not incorporated in the international application. The legal fiction established by Rule 4.18, according to which the missing element would be considered to have been incorporated by reference *ab initio* in the international application only if the requirements of Rule 20.5(a) and (b) were subsequently complied with, would not be sufficient to overcome the delegation’s concerns. In that delegation’s view, it would be necessary for such incorporation by reference to be unconditional so as to comply with those Articles.

“63. One delegation expressed concerns as to compatibility of the proposal with the Articles of the Treaty and noted that the issue of missing parts could be dealt with, so far as a designated State was concerned, by appropriate provisions in the national law. That delegation and others stated that, in the event that the proposals were to proceed by way of amendment of the Regulations, a transitional reservation for designated Offices would therefore be needed in addition to that proposed for receiving Offices.

“64. In response to a query concerning Rule 4.18 as to whether the applicant would need to establish on the face of the application documents that something was missing from them before an incorporation by reference could be effective, two delegations suggested that Rule 4.18 should be interpreted broadly so as to enable the incorporation by reference of any part or element contained in the priority document concerned, without having to satisfy such a test. One delegation pointed to Note 5.21 on PLT Article 5(6)(b) (filing date where missing part of description or drawing is filed), which referred to the question “whether, in a particular case, a missing part of the description or a missing drawing is completely contained in the earlier application.” Another delegation observed that there was no apparent policy reason for applying a strict interpretation of the provisions since the time frame was such that the missing part or element would always be included in the application as published, and there was no possibility of abuse since the relevant subject matter had to be contained in the earlier application.

“65. A suggestion by a representative of users that it should be possible for the incorporation by reference of a missing part or element of an international application to be effected by acts taken in the national phase was opposed by several delegations. The International Bureau confirmed that the Comment on Rule 4.18 was not intended to imply such a possibility and should be modified accordingly.

“66. In reply to a query by a delegation, the International Bureau explained that Rule 4.18 used the wording “The request *may* contain a statement ...” since it did not seem appropriate to require the applicant to include such a statement in all cases. A reference to the statement was required in Rule 4 since only contents listed in that Rule could be included in the request. In practice, however, it was envisaged that the request form would include a pre-printed statement under Rule 4.18.

“67. In response to a query by a delegation, the Secretariat confirmed that, under Rule 20.5(a)(i) as proposed to be amended in document PCT/R/WG/6/4 Add.1, it was intended that, for the purposes of incorporation by reference, the priority claim must have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.”

10. Annex I to the present document contains further revised texts of the proposals related to the according of the international filing date, including proposals related to “incorporation by reference” of certain elements and parts of the international application, contained in the Annexes to documents PCT/R/WG/6/4 and 4 Add.1. The proposals have been further revised so as to take into account the discussions and agreements reached at the sixth session of the Working Group, as summarized in paragraph 9, above, and comments received on preliminary draft documents for the seventh session of the Working Group which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 1 and Paper No. 1 Rev. Noting that the Working Group, at its sixth session, generally preferred the revised drafting of Rules 4.18 and 20 in document PCT/R/WG/6/4 Add.1 to that in document PCT/R/WG/6/4 (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 60, reproduced in paragraph 9, above), the further revised proposals for Rules 4.18 and 20 appearing in Annex I to this document are, by and large, based on those Rules as they appeared in document PCT/R/WG/6/4 Add.1.

11. For information and clarity, the proposals for amendment of Rule 20 are presented both in the form of a marked-up text of Rule 20 as proposed to be amended (contained in Annex I) and in the form of a “clean” text of Rule 20 as it would stand after amendment (contained in Annex II).

12. The main features of the further revised proposals are outlined in the following paragraphs.

INTERNATIONAL FILING DATE; CORRECTION OF DEFECTS UNDER ARTICLE 11(2); LATER FURNISHING OF MISSING PARTS; INCORPORATION BY REFERENCE

Title of Rule 20

13. In the context of aligning the PCT requirements concerning the later furnishing of certain elements or parts of the application to those of the PLT, it is proposed to change the title of Rule 20 to read “International Filing Date” rather than, as at present, “Receipt of the International Application”, so as to more appropriately cover the subject matter of Rule 20, namely, the according of the international filing date under Article 11.

Structure of Rule 20

14. It is proposed to revise the structure of Rule 20 by moving to the Administrative Instructions matters of detail related to the stamping of dates, etc., leaving the Rule to deal only with matters related to the according of the international filing date, including procedures and consequences concerning the correction of defects under Article 11(2), the later furnishing of missing parts, and the incorporation by reference of certain elements or parts.

15. So as to avoid adding further complexity to the system, it is no longer proposed, as in document PCT/R/WG/6/4 Add.1, to deal with the procedures and consequences relating both to the correction of certain defects under Article 11(1)(iii)(d) and (e) (the international application does not contain the element referred to in Article 11(1)(d) or(e)), and to the later furnishing of certain parts of description, claims and drawings, in the same Rule.

16. Furthermore, it is no longer proposed, as in document PCT/R/WG/6/4 Add.1, to deal with the procedures and consequences relating to both the possible incorporation by reference of the elements referred to in Article 11(1)(iii)(d) and (e), and of parts of the description, claims and drawings, in the same Rule.

17. Rather, it is proposed to deal with those issues in separate Rules, as follows:

(a) Rule 20.3 as proposed to be amended deals with the procedures and consequences relating to *all* Article 11(1) defects, and with the consequences where the applicant confirms, in accordance with Rule 20.6 as proposed to be amended (see below), the incorporation by reference of any element referred to in Article 11(1)(iii)(d) or (e).

(b) Rule 20.5 as proposed to be amended deals with the procedures and consequences relating to the later furnishing of certain parts of the description, claims and drawings, and with the consequences where the applicant confirms, in accordance with Rule 20.6 as proposed to be amended (see below), the incorporation by reference of any such part.

(c) Rules 4.18 as proposed to be amended deals with the possible inclusion in the request of a statement of incorporation by reference of both the elements referred to in Article 11(1)(iii)(d) or (e) and of parts of the description, claims or drawings. Rule 20.6 as proposed to be amended deals with the required confirmation of any such statement of incorporation by reference.

18. The proposed amendments would also align the order of the provisions dealing with the according of the international filing date with the (logical) order in which a receiving Office determines whether to accord, and which date to accord, as the international filing date, as follows:

- Rule 20.1 Determination Under Article 11(1)
- Rule 20.2 Positive Determination Under Article 11(1)
- Rule 20.3 Defects Under Article 11(1)
- Rule 20.4 Negative Determination Under Article 11(1)
- Rule 20.5 Missing Parts
- Rule 20.6 Confirmation of Incorporation by Reference of Elements and Parts
- Rule 20.7 Time Limit
- Rule 20.8 Incompatibility With National Laws

Determination under Article 11(1) (Rule 20.1)

19. Rule 20.1 corresponds to present Rule 20.4, except for some minor drafting changes. It deals with general questions related to the determination under Article 11(1).

Positive Determination under Article 11(1) (Rule 20.2)

20. Rule 20.2 as proposed to be amended by and large corresponds to present Rule 20.5, except that paragraphs (a) and (b) are proposed to be amended so as to clarify that this Rule deals with the according of the international filing date where the receiving Office determines that the international application, *at the time of receipt*, fulfills all requirements under Article 11(1).

Apparent Defects Under Article 11(1) (Rule 20.3)

21. With regard to the provisions relating to the correction of apparent Article 11(1) defects, the revised proposals contained in Annex I continue to make a distinction between, on the one hand, defects under Article 11(1)(i), (ii) and (iii)(a) to (c) (relating to nationality and residence requirements, language, indication that application is intended as an international application, designations of countries, and name of applicant), and, on the other hand, defects under Article 11(1)(iii)(d) and (e) (relating to a missing description or missing claim or claims; see Rule 20.3(a)(ii) as proposed to be amended), noting that, depending on the applicant's action, the according of the international filing date may or may not be affected.

22. Where the receiving Office finds that any of the requirements of Article 11(1)(i), (ii) and (iii)(a) to (c) is or appear to be not fulfilled, it will invite the applicant to furnish the required correction under Article 11(2). The furnishing by the applicant of the required correction will always affect the according of the international filing date, which will be the date on which the receiving Office receives that correction (see Rule 20.3(a)(i) and 20.3(b)(i) as proposed to be amended), provided that all other requirements of Article 11(1) are complied with.

23. Where the receiving Office finds that any of the requirements of Article 11(1)(iii)(d) and (e) is not or appears not to be fulfilled, it will invite the applicant to either furnish the required correction or confirm that the element concerned referred to in Article 11(1)(iii)(d) or (e) is incorporated by reference under Rule 4.18. Where the applicant furnishes the required correction under Article 11(2), the international filing date will be the date on which the receiving Office receives the required correction (see Rule 20.3(a)(ii) and 20.3(b)(i) as proposed to be amended), provided that all other requirements of Article 11(1) are complied with.

24. However, where the applicant confirms the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) which is completely contained in an earlier application the priority of which is claimed in the international application, that element will be considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, and the international filing date will be the date on which all Article 11(1) requirements are fulfilled (see Rule 20.3(a)(ii) and 20.3(b)(ii) as proposed to be amended) (see paragraphs 30 to 39, below, with regard to the inclusion in the request of the statement of incorporation by reference and the requirement to confirm that statement).

Negative Determination Under Article 11(1) (Rule 20.4)

25. Rule 20.4 as proposed to be amended corresponds to present Rule 20.7 and deals with the “negative determination under Article 11(1),” that is, the refusal by the receiving Office to accord an international filing date. It is proposed to be amended so as to take into account the possibility that the applicant, rather than filing a correction under Article 11(2), may confirm the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e).

Missing Parts (Rule 20.5)

26. As indicated above, it is proposed to deal with the provisions relating to the later furnishing of certain parts of the description, claims or drawings (not including the case where an entire element referred to in Article 11(1)(iii)(d) or (e) is or appears to be missing but including the case where all of the drawings are or appear to be missing) in a separate Rule (Rule 20.5 as proposed to be amended). Similar to the consequences explained above in relation to the applicant’s actions following an invitation to correct a defect under Article 11(1)(iii)(d) and (e) (see paragraph 23 above), depending on the applicant’s action following an invitation to furnish a part of the description, claims or drawings which is or appears to be missing, the according of the international filing date may or may not be affected.

27. Where the applicant furnishes a missing part to the receiving Office on or before the date on which all of the requirements of Article 11(1) are fulfilled but within the applicable time limit under Rule 20.7, that part will be included in the purported international application and the international filing date will be the date on which all of the requirements of Article 11(1) are fulfilled (see Rule 20.5(b) as proposed to be amended).

28. Where the applicant furnishes a missing part to the receiving Office after the date on which all of the requirements of Article 11(1) were fulfilled but within the applicable time limit under Rule 20.7, that part will be included in the international application and the international filing date will be corrected to the date on which the receiving Office received that part (see Rule 20.5(c) as proposed to be amended).

29. Where the applicant confirms, in accordance with Rule 20.6(a), that a part of the description, claims or drawings was incorporated by reference under Rule 4.18 and the receiving Office finds that all the requirements of Rule 4.18 and 20.6(a) are complied with, that part is considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, and the international filing date will be the date on which all of the requirements of Article 11(1) are fulfilled (see Rule 20.5(d) as proposed to be amended).

Statement of Incorporation by Reference; Confirmation of Such Statement (Rules 4.18 and 20.6)

30. Under proposed new Rule 4.18, where the international application, on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, claims the priority of the earlier application, the applicant would be entitled to include in the request a statement of incorporation by reference that, where any element of the international application referred to in Article 11(1)(iii)(d) or (e) or any part of the description, claims or drawings referred to in Rule 20.5(a) which is not otherwise contained in the international application is completely contained in the earlier application, that element or part is, subject to confirmation under Rule 20.6(a), incorporated by reference in the international application for the purposes of Rule 20.6.

31. It is proposed that the applicant would have to “confirm” the incorporation by reference of any element of the international application referred to in Article 11(1)(iii)(d) or (e) or any part of the description, claims or drawings, rather than, as was proposed in documents PCT/R/WG/6/4 and 4 Add.1, that the applicant must, subsequent to the filing of the international application, “request” that the missing element or part be considered to have been contained in the application as filed, noting that the incorporation by reference itself has already been effected by including the statement under Rule 4.18 in the international application as filed.

32. PLT Rule 2(4) leaves it at the option of the Office of a PLT Contracting Party to require the furnishing by the applicant of a *simple copy* of the earlier application (within the time limit for making the request for incorporation by reference) and/or to invite the applicant to furnish a *certified copy* of the earlier application (within four month from the date of the invitation to furnish a missing part or within the 16-month time limit for furnishing the priority document, whichever expires earlier) in order to determine whether the missing part is completely contained in the earlier application (PLT Rule 5.2(b)(ii) contains a similar provision with regard to “reference filing”).

33. In view of the practical difficulties experienced by applicants in obtaining priority documents from certain Offices, it does not appear realistic to require the applicant to furnish a certified copy of the earlier application (the “priority document”) within a time limit which is shorter than the time limit under present Rule 17.1(a) (noting that the time limit under Rule 17.1(a) is, in effect, the date of international publication of the international application concerned, and that the applicant may, in accordance with Rule 17.1(c), validly furnish the priority document to any designated Office even after national phase entry). On the other hand, it does not appear possible to require the receiving Office to delay making its decision under Rule 20.6(b) on the incorporation by reference until after the expiration of the time limit under Rule 17.1(a).

34. In order to solve the problem, it is proposed to proceed as follows. Generally, under Rule 20.6(a) as proposed to be amended, the applicant would be required, for the purposes of incorporation by reference of a missing element or part under Rule 20.6, to furnish only a simple copy of the earlier application, within the applicable time limit under Rule 20.7 unless, within that time limit, the priority document is available to the receiving Office because the applicant has already complied with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document.

35. Where the priority document was available to the receiving Office within the applicable time limit under Rule 20.7, the receiving Office would base its finding under Rule 20.6(b) on the priority document, and the front page of the published pamphlet would contain, for the benefit of designated and elected Offices, an indication to that effect.

36. Where, however, the priority document was not available to the receiving Office within the applicable time limit under Rule 20.7 because the applicant did not, within that time limit, comply with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document, the receiving Office would base its finding under Rule 20.6(b) on the simple copy of the earlier application furnished by the applicant under Rule 20.6(a). The front page of the published pamphlet would contain an indication to the effect that the applicant, for the purposes of Rule 20.6(a)(ii), relied on a separately submitted (non-certified) copy of the earlier application rather than on compliance with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document.

37. In the latter case, during national phase procedures, where the priority document continues not to be available to the designated or elected Office because the applicant still has not complied with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document, or where the priority document is available to the designated or elected Office but that Office finds that that the element or part concerned is not completely contained in the priority document, that Office would be entitled to treat the application, in the case of a missing element, as if the international filing date had been accorded under Rule 20.3(b)(i) (see paragraph 23, above) or, in the case of a missing part, as if the international filing date had been accorded under either Rule 20.5(b) or (c), as the case may be (see paragraphs 27 and 28, above), provided that the Office would have to first give the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances (see proposed new Rule 82*ter*.1(b)). In order to be able to make a determination under proposed new Rule 82*ter*.1(b), the designated or elected Office would be permitted to require the applicant to furnish a translation of the priority document where that document is not in a language accepted by the Office for the purposes of national processing (see proposed new Rule 51*bis*.1(e)(ii)).

Time Limit (Rule 20.7)

38. Rule 20.7 as proposed to be amended provides for the time limits within which the applicant may furnish corrections of Article 11(1) defects (including the furnishing of missing elements), furnish missing parts or confirm the incorporation by reference of elements or parts.

Incompatibility With National Laws (Rule 20.8)

39. As had been suggested during the sixth session of the Working Group (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 63), reservation provisions are included in respect of both receiving Offices and designated Offices whose applicable national law is not compatible with the envisaged amendments of the PCT Regulations concerning the incorporation by reference of elements referred to in Article 11(1)(iii)(d) and (e) and parts of the description, claims or drawings (see Rule 20.8 as proposed to be amended).

Alignment of certain related requirements under the PCT with those under the PLT

40. In the context of “missing element” and “missing part” requirements, it is also proposed to align certain related requirements under the PCT with those under the PLT, in particular time limits for compliance with non-filing date related requirements (see Rule 26 as proposed to be amended).

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

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

MISSING ELEMENTS AND PARTS OF THE INTERNATIONAL APPLICATION

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Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No change]

(iii) declarations as provided in Rule 4.17.

(iv) a statement as provided in Rule 4.18.

[COMMENT: The proposed addition of item (iv) reflects the proposed addition of new Rule 4.18, below.]

(d) [No change]

4.2 to 4.17 [No change]

4.18 *Statement of Incorporation by Reference*

Where the international application, on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, claims the priority of an earlier application, the request may contain a statement that, where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in the international application but is completely contained in the earlier application, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in the international application for the purposes of Rule 20.6.

[COMMENT: See paragraphs 30 and 31 in the main body of this document.]

4.19 ~~4.18~~ *Additional Matter*

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.18 ~~4.17~~, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to 4.18 ~~4.17~~ or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

[COMMENT: The renumbering is consequential on the proposed addition of new Rule 4.18 (see above).]

Rule 12

**Language of the International Application and Translation
for the Purposes of International Search and International Publication**

12.1 [No change]

12.1bis *Language of Elements and Parts Furnished Under Rule 20.3, 20.5 or 20.6*

An element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b) or 20.6(a) and a part of the description, claims or drawings furnished by the applicant under Rule 20.5(b) or 20.6(a) shall be in the language of the international application as filed or, where a translation of the application is required under Rule 12.3(a) or 12.4(a), in both the language of the application as filed and the language of that translation.

[COMMENT: Proposed new Rule 12.1*bis* would have to be further amended should it be agreed to amend the Regulations in relation to “international publication in multiple languages” as proposed in PCT/R/WG/7/4.]

12.2 [No change]

12.3 *Translation for the Purposes of International Search*

(a) and (b) [No change]

[Rule 12.3, continued]

(c) Where, by the time the receiving Office sends to the applicant the notification under Rule [20.2\(c\)](#) ~~20.5(e)~~, the applicant has not furnished a translation required under paragraph (a), the receiving Office shall, preferably together with that notification, invite the applicant:

[COMMENT: The renumbering is consequential on the proposed renumbering of present Rule 20.5, below.]

(i) and (ii) [No change]

(d) and (e) [No change]

12.4 [No change]

Rule 20 [“marked-up” copy]³

International Filing Date Receipt of the International Application

[COMMENT: See paragraph 13 in the main body of this document.]

~~20.1—Date and Number~~

~~(a) Upon receipt of papers purporting to be an international application, the receiving Office shall indelibly mark the date of actual receipt on the request of each copy received and the international application number on each sheet of each copy received.~~

~~(b) The place on each sheet where the date or number shall be marked, and other details, shall be specified in the Administrative Instructions.~~

~~20.2—Receipt on Different Days~~

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

³ A “clean” copy of the text of Rule 20 as it would stand after amendment is contained in Annex II.

[Rule 20, continued]

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

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

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

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

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

~~20.3 *Corrected International Application*~~

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

20.1 ~~20.4~~ *Determination Under Article 11(1)*

(a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers fulfill ~~comply with~~ the requirements of Article 11(1).

[COMMENT: Drafting change only (see the wording of Article 11(1)).]

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

[COMMENT: Drafting change only.]

(c) [No change] For the purposes of Article 11(1)(ii), it shall be sufficient that the part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims be in a language accepted by the receiving Office under Rule 12.1(a).

[COMMENT: Rule 19.4(a)(ii) would apply where an element referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a)(ii) is considered, under Rule 20.6(b) as proposed to be amended to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office but is not in the same language accepted by the receiving Office as the international application as filed. Such application, containing such element or part incorporated by reference, would be considered to have been received by the receiving Office on behalf of the International Bureau as receiving Office under Rule 19.1(a)(iii), which accepts international applications in any language.]

[Rule 20.1, continued]

(d) [No change] If, on October 1, 1997, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: A decision by the Assembly may be necessary to ensure that transitional reservations that were made under existing Rule 20.4(d) continue to be effective under that provision as renumbered Rule 20.1(d).]

20.2 ~~20.5~~ *Positive Determination* Under Article 11(1)

[COMMENT: Renumbering and clarification only.]

(a) If the receiving Office determines that, at the time of receipt of the papers purporting to be an international application, the requirements of ~~determination under~~ Article 11(1) were fulfilled ~~is positive~~, the receiving Office shall accord as the international filing date the date of receipt of the international application. ~~stamp on the request the name of the receiving Office and the words “PCT International Application,” or “Demande internationale PCT.”~~ ~~If the official language of the receiving Office is neither English nor French, the words “International Application” or “Demande internationale” may be accompanied by a translation of these words in the official language of the receiving Office.~~

[COMMENT: See paragraph 20 in the main body of this document.]

(b) The receiving Office shall stamp the request of the international application which it has accorded an international filing date as prescribed by the Administrative Instructions. The copy whose request has been so stamped shall be the record copy of the international application.

(c) [No change] The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

20.3 Defects Under Article 11(1)

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that any of the requirements of Article 11(1) are not, or appear not to be, fulfilled, it shall promptly invite the applicant, as applicable and at the applicant's option:

(i) to furnish the required correction under Article 11(2); or

(ii) where the requirements concerned are those relating to an element referred to in Article 11(1)(iii)(d) or (e), to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

[COMMENT: See paragraphs 21 to 23 in the main body of this document. See proposed new Rule 4.18, above, and proposed new Rule 20.6, below, concerning the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e). It is also proposed to change the term "one year" (as used in the last sentence of present Rule 20.6) to "12 months" for consistency with Rule 4.10(a)(i) and Article 4C(1) of the Paris Convention.]

[Rule 20.3, continued]

(b) Where, following an invitation under paragraph (a) or otherwise:

(i) the applicant furnishes to the receiving Office the required correction under Article 11(2) after the date of receipt of the purported international application but on a later date falling within the applicable time limit under Rule 20.7, the receiving Office shall accord that later date as the international filing date and proceed as provided in Rule 20.2(b) and (c);

[COMMENT: See paragraphs 22 and 23 in the main body of this document.]

(ii) an element referred to in Article 11(1)(iii)(d) or (e) is, under Rule 20.6(b), considered to have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

[COMMENT: See paragraphs 23 and 24 in the main body of this document.]

(c) ~~20.8~~ If the receiving Office later discovers, or on the basis of the applicant's reply realizes, that it has erred in issuing an invitation under paragraph (a) ~~to correct~~ since the requirements of ~~provided for under~~ Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in Rule 20.2 ~~Rule 20.5~~.

[COMMENT: It is proposed to move the contents of present Rule 20.8 into proposed new paragraph (c) of Rule 20.3.]

20.4 ~~20.7~~ *Negative Determination* Under Article 11(1)

[COMMENT: Renumbering and clarification only.]

(a) If the receiving Office does not ~~;~~ receive, within the applicable time limit under Rule 20.7, a correction or confirmation referred to in Rule 20.3(b), within the prescribed time limit, receive a reply to its invitation to correct, or if a ~~the~~ correction or confirmation has been received ~~offered by the applicant but the application~~ still does not fulfill the requirements of ~~provided for under~~ Article 11(1), the receiving Office ~~it~~ shall:

(i) promptly notify the applicant that the ~~his~~ application is not and will not be treated as an international application and shall indicate the reasons therefor~~;~~

(ii) notify the International Bureau that the number it has marked on the papers will not be used as an international application number~~;~~

(iii) keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1~~;~~ and

(iv) [No change] send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under Article 25(1), the International Bureau needs such a copy and specially asks for it.

[COMMENT: See paragraph 25 in the main body of this document.]

20.5 Missing Parts

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that a part of the description, claims or drawings is or appears to be missing, including the case where all of the drawings are or appear to be missing but not including the case where an entire element referred to in Article 11(1)(iii)(d) or (e) is or appears to be missing, it shall promptly invite the applicant, as applicable and at the applicant's option:

(i) to complete the purported international application by furnishing the missing part;

(ii) to confirm, in accordance with Rule 20.6(a), that the part was incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

[COMMENT: See paragraph 26 in the main body of this document.]

[Rule 20.5, continued]

(b) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, on or before the date on which all of the requirements of Article 11(1) are fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application and the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

[COMMENT: See paragraph 27 in the main body of this document.]

(c) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, after the date on which all of the requirements of Article 11(1) were fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application, and the receiving Office shall correct the international filing date to the date on which the receiving Office received that part and proceed as provided for in the Administrative Instructions.

[COMMENT: See paragraph 28 in the main body of this document. The Administrative Instructions would have to be modified so as to prescribe the procedure to be followed by the receiving Office with regard to notifications to be sent to the International Bureau and the International Searching Authority, in particular in the case where the record and search copies have not yet been transmitted by the time when the missing part is included and the filing date corrected.]

[Rule 20.5, continued]

(d) Where, following an invitation under paragraph (a) or otherwise, a part referred to in paragraph (a) is, under Rule 20.6(b), considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

[COMMENT: See paragraph 29 in the main body of this document.]

(e) Where the international filing date has been corrected under paragraph (c), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (c), request that the missing part concerned be disregarded, in which case the missing part shall be considered not to have been furnished and the correction of the international filing date under that paragraph shall be considered not to have been made, and the receiving Office shall proceed as provided for in the Administrative Instructions.

[COMMENT: See PLT Article 5(6)(c). The proposed wording (“request to disregard”) differs from that used in the PLT (“withdraw”) so as to avoid confusion with withdrawals under Rule 90*bis*. The Administrative Instructions would have to be modified so as to prescribe the procedure to be followed by the receiving Office with regard to notifications to be sent to the International Bureau and the International Searching Authority, in particular in the case where the record and search copies have not yet been transmitted by the time a notification by the applicant under paragraph (e) is received by the receiving Office.]

20.6 Confirmation of Incorporation by Reference of Elements and Parts

(a) The applicant may submit to the receiving Office, within the applicable time limit under Rule 20.7, a written notice confirming that an element or part is incorporated by reference in the international application under Rule 4.18, accompanied by:

[COMMENT: See paragraphs 30 and 31 in the main body of this document.]

(i) a sheet or sheets embodying the element or part concerned;

(ii) where the applicant has not already complied with Rule 17.1(a), (b) or (b-bis) in relation to the priority document, a copy of the earlier application as filed;

[COMMENT: See paragraphs 32 to 37 and in the main body of this document.]

(iii) where the earlier application is not in the language in which the international application is filed, a translation of the earlier application into that language or, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), a translation of the earlier application into both the language in which the international application is filed and the language of that translation; and

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

[Rule 20.6(a), continued]

(iv) in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the earlier application.

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

(b) Where the receiving Office finds that the requirements of Rule 4.18 and paragraph (a) have been complied with and that the element or part referred to in paragraph (a) is completely contained in the earlier application concerned, that element or part shall be considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.

[COMMENT: It is proposed that the effectiveness of a confirmation of incorporation by reference under Rule 4.18 be subject to a finding by the receiving Office rather than operating automatically. This appears to be necessary if designated Offices and third parties are to be able to rely on the procedure followed with a reasonable degree of certainty. Furthermore, it is envisaged that the Administrative Instructions would be modified so as to provide for the receiving Office to stamp sheets incorporated under Rule 20.6 with words such as “INCORPORATED BY REFERENCE—RULE 20.6”, and to provide that a notification by the receiving Office to the International Bureau that a missing element or part has been incorporated by reference would include an indication as to whether the applicant, for the purposes of Rule 20.6(a)(ii), relied on compliance with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document or on a separately submitted (non-certified) copy of the earlier application concerned. That information would be published on the front page of the published pamphlet (see proposed new Rule 48.2(b)(v), below).]

20.7 Time Limit

The applicable time limit referred to in Rules 20.3(a), 20.3(b), 20.4, 20.5(a), (b) and (c), and 20.6(a) shall be:

(i) where an invitation under Rule 20.3(a) or 20.5(a), as applicable, was sent to the applicant, [one month] [two months] from the date of the invitation;

(ii) where no such invitation was sent to the applicant, [one month] [two months] from the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office;

provided that any correction under Article 11(2), or any confirmation under Rule 20.6(a) of the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e), that is received by the receiving Office after the expiration of the applicable time limit under this Rule but before that Office sends a notification to the applicant under Rule 20.4(i) shall be taken into account in determining whether the papers purporting to be an international application fulfill the requirements under Article 11(1).

[COMMENT: See PLT Article 5(3) and PLT Rule 2(1) (notification in case of non-compliance with a filing date requirement); PLT Article 5(4) and PLT Rule 2(2) (subsequent compliance with a filing date requirement); PLT Article 5(6) and PLT Rule 2(3)(i) and (ii) (filing date where missing part of description or drawing is filed); and PLT Article 5(7) and PLT Rule 2.5(b)(ii) (filing date where description and drawings are replaced by reference to previous filed application). While the PLT provides for the time limit under item (ii) only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed”, it is proposed to apply that time limit to all cases where no invitation has been sent to the

[Rule 20.7, continued]

applicant. It is proposed that the starting point for the time limit under item (ii) should, in all cases (irrespective of whether no invitation was sent to the applicant in relation to a defect, a missing element or a missing part), remain the date on which one or more elements referred to in Article 11(1) were first received by the receiving Office, and not be changed, in relation to the correction of a defect, to the date on which all of the requirements of Article 11(1) are fulfilled, as was suggested during the fifth session of the Working Group. Alternative time limits have been retained in square brackets for further consideration by the Working Group (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 103 and 104).]

20.8 Incompatibility With National Laws

(a) If, on [date of adoption of these modifications by the PCT Assembly], any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: See the summary of the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 91), and paragraph 39 in the main body of this document. Note that a Contracting State could only take advantage of the reservation provision if its national law contained provisions addressed to its national Office in its capacity as a PCT receiving Office (and not only in its capacity as a designated Office) which were not compatible with the proposed amendments of the PCT Regulations (a reservation provision for designated Offices is contained in proposed new paragraph (c), below). Note further that a receiving Office which makes such reservation and does not apply Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 would have to accord as the international filing date the date on which the missing element referred to in Article 11(1)(iii)(d) or (e) was received by the receiving Office in accordance with Rule 20.3(b)(i), or accord as the international filing date the date on which the missing part of the description, claims or drawings was received by the receiving Office in accordance with or Rule 20.5(b) or (c), as the case may be.]

[Rule 20.8, continued]

(b) If, on [date of adoption of these modifications by the PCT Assembly], any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: See the summary of the Chair of the sixth session of the Working Group, document PCT/R/WG/6/12, paragraph 63) and paragraph 39 in the main body of this document. Note that a designated Office which makes a reservation and does not apply Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 would have to accord as the international filing date the date on which the missing element referred to in Article 11(1)(iii)(d) or (e) was received by the receiving Office in accordance with Rule 20.3(b)(i), or accord as the international filing date the date on which the missing part of the description, claims or drawings was received by the receiving Office in accordance with or Rule 20.5(b) or (c), as the case may be.]

20.9 – Certified Copy for the Applicant

~~Against payment of a fee, the receiving Office shall furnish to the applicant, on request, certified copies of the international application as filed and of any corrections thereto.~~

[COMMENT: It is proposed to move the content of present Rule 20.9 to proposed new Rule 21.2 (see below) so as to leave Rule 20 to deal only with questions of according of the international filing date.]

Rule 21

Preparation of Copies

21.1 [No change]

21.2 *Certified Copy for the Applicant*

Against payment of a fee, the receiving Office shall furnish to the applicant, on request, certified copies of the international application as filed and of any corrections thereto.

[COMMENT: See the Comment on Rule 20.9 as proposed to be deleted, above. It is proposed delete present Rule 20.9 (see above) and to move its contents to proposed new Rule 21.2.]

Rule 22

Transmittal of the Record Copy and Translation

22.1 *Procedure*

(a) [No change]

(b) If the International Bureau has received a copy of the notification under Rule [20.2\(c\)](#) ~~20.5(e)~~ but is not, by the expiration of 13 months from the priority date, in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly.

(c) If the International Bureau has received a copy of the notification under Rule [20.2\(c\)](#) ~~20.5(e)~~ but is not, by the expiration of 14 months from the priority date, in possession of the record copy, it shall notify the applicant and the receiving Office accordingly.

[COMMENT: The proposed renumbering is consequential on the proposed renumbering of present Rule 20.5 above.]

(d) to (h) [No change]

22.2 and 22.3 [No change]

Rule 26

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

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

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

[COMMENT: The title is proposed to be amended so as to correctly cover the subject matter of paragraph (a). See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 69; see also PLT Article 6(7).]

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

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

26.2 *Time Limit for Correction*

The time limit referred to in [Rule 26.1](#) ~~Article 14(1)(b) shall be reasonable under the circumstances and~~ shall be [\[one month\]](#) [\[two months\]](#) ~~fixed in each case by the receiving Office. It shall not be less than one month~~ from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

[COMMENT: See PLT Article 6(7) and PLT Rule 6(1). The time limits have been retained in square brackets for further consideration by the Working Group (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 103 and 104).]

26.2*bis* to 26.3*bis* [No change]

26.3*ter* *Invitation to Correct Defects Under Article 3(4)(i)*

(a) Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office shall, unless

(i) and (ii) [No change]

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

[Rule 26.3ter(a), continued]

[COMMENT: The proposed renumbering is consequential on the proposed renumbering of present Rule 26.1(a), above.]

(b) [No change]

(c) Where the request does not comply with Rule 12.1(c), the receiving Office shall invite the applicant to file a translation so as to comply with that Rule. Rules 3, 26.1(a), 26.2, 26.5 and 29.1 shall apply *mutatis mutandis*.

[COMMENT: The proposed renumbering is consequential on the proposed renumbering of present Rule 26.1(a) above.]

(d) [No change]

26.4 [No change]

26.5 *Decision of the Receiving Office*

The receiving Office shall decide whether the applicant has submitted the correction within the [applicable](#) time limit under Rule 26.2, and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered

[Rule 26.5, continued]

withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 70.]

~~26.6 *Missing Drawings*~~

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

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

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

[COMMENT: The proposed deletion of present paragraph (b) is consequential on the proposed amendment of Rule 20 (see above).]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

(b) Subject to paragraph (c), the front page shall include:

(i) to (iii) [No change]

(iv) an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

(v) where applicable, an indication that the international filing date was accorded by the receiving Office under Rule 20.3(b)(ii) or 20.5(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, together with an indication as to whether the applicant, for the purposes of Rule 20.6(a)(ii), relied on compliance with Rule 17.1(a), (b) or (b-bis) in relation to the priority document or on a separately submitted copy of the earlier application concerned.

[Rule 48.2(b)(v), continued]

[COMMENT: See paragraphs 32 to 37 in the main body of this document and the Comment on proposed new Rule 20.6(b), above.]

(c) to (i) [No change]

48.3 to 48.6 [No change]

[COMMENT: Note that Rule 48 is proposed to be further amended in the context of proposed amendments of the Regulations relating to the restoration of the right of priority (see document PCT/R/WG/7/3, relating to the rectification of obvious mistakes (see document PCT/R/WG/7/6) and relating to international publication and the PCT Gazette in electronic form (see document PCT/R/WG/7/8).]

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 Rule [20.4\(i\)](#) ~~20.7(i)~~, 24.2(c) or 29.1(ii).

[COMMENT: The proposed renumbering is consequential on the proposed renumbering of present Rule 20.7 above.]

51.2 *Copy of the Notice*

Where the applicant, after having received a negative determination under Article 11(1), requests the International Bureau, under Article 25(1), to send copies of the file of the purported international application to any of the named Offices he has attempted to designate, he shall attach to his request a copy of the notice referred to in Rule [20.4\(i\)](#) ~~20.7(i)~~.

[COMMENT: The proposed renumbering is consequential on the proposed renumbering of present Rule 20.7 above.]

51.3 [No change]

Rule 51bis

Certain National Requirements Allowed Under Article 27

51bis.1 Certain National Requirements Allowed

(a) to (d) [No change]

(e) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required:

(i) where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable; or

(ii) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii) or 20.5(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, for the purposes of determining under Rule 82ter.1(b) whether that element or part is completely contained in the priority document concerned.

[COMMENT: It is proposed to amend Rule 51bis.1(e) so as to permit a designated or elected Office to require the applicant to furnish a translation of the priority document for the purposes of making a finding, under proposed Rule 82ter.1(b) (see below) whether an element or part which has been incorporated by reference was completely contained in the priority document. Note that the sanction which would apply if the applicant failed to furnish a translation of the priority document required under the applicable national law would be a matter for that national law.]

[Rule 51bis.1, continued]

(f) If, on [date of adoption of these modifications by the PCT Assembly] ~~March 17, 2000~~, the proviso in paragraph (e)(i) or (ii) is not compatible with the national law applied by the designated Office, ~~the that~~ proviso concerned shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly] ~~November 30, 2000~~. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: The proposed amendment of paragraph (f) is consequential on the proposed amendment of paragraph (e) (see above). A decision by the Assembly may be necessary to ensure that transitional reservations that were made under existing paragraph (f) with regard present paragraph (e) (renumbered paragraph (e)(i)) continue to be effective.]

51bis.2 and 51bis.3 [No change]

Rule 55

Languages (International Preliminary Examination)

55.1 [No change]

55.2 *Translation of International Application*

(a) [No change] Where neither the language in which the international application is filed nor the language in which the international application is published is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant shall, subject to paragraph (b), furnish with the demand a translation of the international application into a language which is both:

- (i) a language accepted by that Authority, and
- (ii) a language of publication.

(a-bis) A translation of the international application into a language referred to in paragraph (a) shall include any element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b) or 20.6(a) and any part of the description, claims or drawings furnished by the applicant under Rule 20.5(b) or 20.6(a).

[COMMENT: It is proposed to add new paragraph (a-bis) so as to ensure that, in the rare case that the applicant has to furnish a translation of the international application to the International Preliminary Examining Authority under Rule 55.2(a), that translation includes any element referred to in Article 11(1)(iii)(d) or (e) and any part of the description, claims or drawings furnished by the applicant under Rule 20. Note that Rule 55.2 would have to be further amended should it be agreed to amend the Regulations by adding provisions concerning international publication in multiple languages, as is proposed in PCT/R/WG/7/4.]

[Rule 55.2, continued]

(b) [No change]

(c) If the requirements of paragraphs (a) and (a-bis) are ~~requirement of paragraph (a) is~~ not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant complies with the invitation within the time limit under paragraph (c), the said requirements ~~requirement~~ shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted and the International Preliminary Examining Authority shall so declare.

[COMMENT: The proposed changes to paragraphs (c) and (d) are consequential on the proposed addition of new paragraph (a-bis).]

55.3 [No change]

Rule 82ter

Rectification of Errors Made

by the Receiving Office or by the International Bureau

82ter.1 Errors Concerning the International Filing Date and the Priority Claim

(a) If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered by the receiving Office or the International Bureau not to have been made and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered not to have been made.

[COMMENT: Note that present Rule82ter.1 (Rule 82ter.1(a) as proposed to be amended) is proposed to be further amended in the context of proposed amendments of the Regulations relating to the restoration of the right of priority (see PCT/R/WG/7/3).]

(b) Where the international filing date was accorded by the receiving Office under Rule 20.3(b)(ii) or 20.5(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part but the applicant has not complied with Rule 17.1(a), (b) or (b-bis) in relation to the priority document or the designated or elected Office finds that the element or part is not completely contained in the priority document concerned, the designated or elected Office may, subject to paragraph (c), treat the international application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under 20.5(c), as applicable, provided that Rule 17.1(c) shall apply *mutatis mutandis*.

[Rule 82ter.1(b), continued]

[COMMENT: See paragraph 37 in the main body of this document. See also the summary of the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 102 and 103), and Note 5.21 of the Explanatory Notes on PLT Article 5(6)(b) which states that, where it is subsequently determined, for example in the course of substantive examination, that the missing part of the description or missing drawing was not completely contained in the earlier application as required under PLT Rule 2(4)(ii), the Office may rescind the filing date accorded under that Rule and re-accord it under PLT Article 5(6)(a).]

(c) The designated or elected Office shall not treat the international as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under 20.5(c), without giving the applicant the opportunity to make observations on the intended treatment, or to make a request under paragraph (d), within a time limit which shall be reasonable under the circumstances.

(d) Where the designated or elected Office, in accordance with paragraph (c), has notified the applicant that it intends to treat the international application as if the international filing date had been corrected under Rule 20.5(c), the applicant may, in a notice submitted to that Office within the time limit referred to in paragraph (c), request that the missing part concerned be disregarded for the purposes of national processing before that Office, in which case that part shall be considered not to have been furnished and that Office shall not treat the international application as if the international filing date had been corrected.

[COMMENT: Where a designated or elected Office, in accordance with paragraph (b), intends to treat the international application as if the international filing date had been corrected under Rule 20.5(c) to the date on which the receiving Office received the missing part, the applicant should have an opportunity, as during the international phase (see

[Rule 82ter.1(d), continued]

Rule 20.5(e) as proposed to be amended) to request that the missing part concerned be disregarded, in which case the missing part would be considered not to have been furnished and the designated or elected Office must treat the international application as if the international filing date had not been corrected.]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

MISSING ELEMENTS AND PARTS OF THE INTERNATIONAL APPLICATION

RULE 20 “CLEAN” COPY⁴

Rule 20 [“clean” copy] International Filing Date	2
20.1 <i>Determination Under Article 11(1)</i>	2
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⁴ Comments on particular provisions appear only in the “marked-up” copy contained in Annex I.

Rule 20 [“clean” copy]

International Filing Date

20.1 *Determination Under Article 11(1)*

(a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers fulfill the requirements of Article 11(1).

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

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

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

20.2 *Positive Determination Under Article 11(1)*

(a) If the receiving Office determines that, at the time of receipt of the papers purporting to be an international application, the requirements of Article 11(1) were fulfilled, the receiving Office shall accord as the international filing date the date of receipt of the international application.

(b) The receiving Office shall stamp the request of the international application which it has accorded an international filing date as prescribed by the Administrative Instructions. The copy whose request has been so stamped shall be the record copy of the international application.

(c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

20.3 *Defects Under Article 11(1)*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that any of the requirements of Article 11(1) are not, or appear not to be, fulfilled, it shall promptly invite the applicant, as applicable and at the applicant's option:

- (i) to furnish the required correction under Article 11(2); or
- (ii) where the requirements concerned are those relating to an element referred to in Article 11(1)(iii)(d) or (e), to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

(b) Where, following an invitation under paragraph (a) or otherwise:

- (i) the applicant furnishes to the receiving Office the required correction under Article 11(2) after the date of receipt of the purported international application but on a later date falling within the applicable time limit under Rule 20.7, the receiving Office shall accord that later date as the international filing date and proceed as provided in Rule 20.2(b) and (c);

[Rule 20.3(b), continued]

(ii) an element referred to in Article 11(1)(iii)(d) or (e) is, under Rule 20.6(b), considered to have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

(c) If the receiving Office later discovers, or on the basis of the applicant's reply realizes, that it has erred in issuing an invitation under paragraph (a) since the requirements of Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in Rule 20.2.

20.4 *Negative Determination Under Article 11(1)*

If the receiving Office does not receive, within the applicable time limit under Rule 20.7, a correction or confirmation referred to in Rule 20.3(b), or if a correction or confirmation has been received but the application still does not fulfill the requirements of Article 11(1), the receiving Office shall:

(i) promptly notify the applicant that the application is not and will not be treated as an international application and shall indicate the reasons therefor;

(ii) notify the International Bureau that the number it has marked on the papers will not be used as an international application number;

(iii) keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1; and

(iv) send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under Article 25(1), the International Bureau needs such a copy and specially asks for it.

20.5 *Missing Parts*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that a part of the description, claims or drawings is or appears to be missing, including the case where all of the drawings are or appear to be missing but not including the case where an entire element referred to in Article 11(1)(iii)(d) or (e) is or appears to be missing, it shall promptly invite the applicant, as applicable and at the applicant's option:

- (i) to complete the purported international application by furnishing the missing part;
- (ii) to confirm, in accordance with Rule 20.6(a), that the part was incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

[Rule 20.5, continued]

(b) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, on or before the date on which all of the requirements of Article 11(1) are fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application and the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

(c) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, after the date on which all of the requirements of Article 11(1) were fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application, and the receiving Office shall correct the international filing date to the date on which the receiving Office received that part and proceed as provided for in the Administrative Instructions.

(d) Where, following an invitation under paragraph (a) or otherwise, a part referred to in paragraph (a) is, under Rule 20.6(b), considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

[Rule 20.5, continued]

(e) Where the international filing date has been corrected under paragraph (c), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (c), request that the missing part concerned be disregarded, in which case the missing part shall be considered not to have been furnished and the correction of the international filing date under that paragraph shall be considered not to have been made, and the receiving Office shall proceed as provided for in the Administrative Instructions.

20.6 *Confirmation of Incorporation by Reference of Elements and Parts*

(a) The applicant may submit to the receiving Office, within the applicable time limit under Rule 20.7, a written notice confirming that an element or part is incorporated by reference in the international application under Rule 4.18, accompanied by:

(i) a sheet or sheets embodying the element or part concerned;

(ii) where the applicant has not already complied with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document, a copy of the earlier application as filed;

(iii) where the earlier application is not in the same language as the international application as filed, a translation of the earlier application into that language or, where a translation of the application is required under Rule 12.3(a) or 12.4(a), a translation of the earlier application into both the language of the application as filed and the language of that translation; and

(iv) in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the earlier application.

[Rule 20.6, continued]

(b) Where the receiving Office finds that the requirements of Rule 4.18 and paragraph (a) have been complied with and that the element or part referred to in paragraph (a) is completely contained in the earlier application concerned, that element or part shall be considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.

20.7 *Time Limit*

The applicable time limit referred to in Rules 20.3(a), 20.3(b), 20.4, 20.5(a), (b) and (c), and 20.6(a) shall be:

- (i) where an invitation under Rule 20.3(a) or 20.5(a), as applicable, was sent to the applicant, [one month] [two months] from the date of the invitation;
- (ii) where no such invitation was sent to the applicant, [one month] [two months] from the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office;

provided that any correction under Article 11(2), or any confirmation under Rule 20.6(a) of the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e), that is received by the receiving Office after the expiration of the applicable time limit under this Rule but before that Office sends a notification to the applicant under Rule 20.4(i) shall be taken into account in determining whether the papers purporting to be an international application fulfill the requirements under Article 11(1).

20.8 *Incompatibility With National Laws*

(a) If, on [date of adoption of these modifications by the PCT Assembly], Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, those Rules shall not apply to an international application filed with that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

(b) If, on [date of adoption of these modifications by the PCT Assembly], Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, those Rules shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[End of Annex II and of document]

WIPO



PCT/R/WG/7/3
ORIGINAL: English
DATE: April 5, 2005

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
Geneva, May 25 to 31, 2005

RESTORATION OF THE RIGHT OF PRIORITY

Document prepared by the International Bureau

SUMMARY

1. This document contains further revised proposals for amendment of the Regulations under the PCT¹ to provide for the restoration of the right of priority where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, consistently with the provisions for such restoration under the Patent Law Treaty (PLT).

2. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and the comments received on preliminary draft documents made available since then. The main differences in comparison with the proposals considered at the sixth session concern the

¹ 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. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

following: (i) the time limits for requesting restoration of the right of priority; (ii) the circumstances in which a decision of a receiving Office can be reviewed by a national authority; and (iii) the addition of a definition of the term “priority period” and clarification that Rule 80.5 applies to this period *mutatis mutandis*.

BACKGROUND

3. The Committee on Reform of the PCT (“the Committee”), at its first and second sessions, and the Working Group, at its first, second, third, fourth, fifth and sixth sessions, considered proposals for amendment of the Regulations under the PCT relating to the restoration of the right of priority. The reports of these sessions of the Committee and the summaries by the Chair of these sessions of the Working Group set out the status of the matters discussed by the Committee and the Working Group, respectively, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken (see documents PCT/R/1/26, paragraphs 72 to 76; PCT/R/2/9, paragraphs 111 to 123 and 125; PCT/R/WG/1/9, paragraphs 22 and 23; PCT/R/WG/2/12, paragraphs 54 to 56; PCT/R/WG/3/5, paragraphs 13 to 27; PCT/R/WG/4/14, paragraphs 35 to 44; PCT/R/WG/5/13, paragraphs 28 to 62; PCT/R/WG/6/12, paragraphs 7 to 42).

4. The Working Group’s discussions at its last (sixth) session (see document PCT/R/WG/6/12, paragraphs 7 to 42) are outlined in the following paragraphs:

“7. Discussions were based on document PCT/R/WG/6/1.

“8. Several delegations referred to the discussions in previous sessions of the Working Group and expressed their concern that, while they were in favor of the principle of allowing for restoration of priority rights in the case of applications under the PCT consistently with the provisions for such restoration under the Patent Law Treaty (PLT), the procedure would represent such a fundamental change to the system that it ought to be addressed in the Articles of the Treaty itself rather than in the Regulations. Some of those delegations indicated that they would not wish to block a consensus should the Assembly decide to adopt amendments of the Regulations providing for restoration of the right of priority but that they would make use of the proposed transitional reservation provisions, at least until such time as the matter could be addressed directly under their national laws. Others felt that the possibility for transitional reservations would not be sufficient to address their concerns and stressed the need for amendment of the Treaty itself.

“9. One delegation expressed the view that Article 58(1) would not provide a sufficient basis for this matter to be dealt with in the Regulations only. It stated that Article 58(1)(iii) provided a basis only for Rules concerning details useful in the implementation of the provisions of the Treaty but not for Rules concerning matters which were not dealt with by provisions of the Treaty in the first place. The delegation also expressed its concern that a restoration of the right of priority would, in effect, extend the term of a granted patent by up to two months and, in general, questioned whether aligning the PCT requirements to those of the PLT should indeed be one of the objectives of PCT reform, noting that the PLT had not yet entered into force and, in light of differing views on the PLT, may not be ratified by many PCT Contracting States in the near future.

“10. Other delegations were of the opinion that, while provisions concerning restoration of the right of priority would not be in conflict with the Paris Convention itself, inclusion of such provisions in the Regulations providing, in effect, for a 14-month priority period in certain cases would be inconsistent with Articles 8(2)(a) and 2(xi) of the PCT, which referred to the Paris Convention with regard to the conditions for, and the effect of, any priority claim contained in an international application, and thus to the 12-month priority period under Article 4C(1) of the Paris Convention.

“11. A number of delegations and representatives of users welcomed the general approach taken in the document, noting the importance of provisions for the restoration of the right of priority as a safeguard for applicants. The proposed provisions would not enable an automatic extension of the priority period to 14 months but would be applicable only in particular circumstances after a check by the Office concerned. Referring to the extensive discussion that took place in the context of the adoption of the PLT, those delegations and representatives of users expressed the view that provisions for the restoration of the right of priority were in compliance with the provisions of the Paris Convention, which only provided for a minimum standard with regard to the length of the priority period and thus left room for member States of the Paris Convention to grant longer periods of priority if they so wished. They were of the opinion that the Working Group should proceed with developing proposed amendments to the Regulations unless it was convinced that those amendments would clearly be inconsistent with provisions of the Treaty, which they felt not to be the case.

“12. Noting the divergence of views as to whether the inclusion in the PCT of provisions relating to the restoration of the right of priority needed to be addressed in the Articles of the Treaty itself rather than in the Regulations, the Secretariat referred to earlier discussions in the Working Group concerning a possible revision of the Treaty and the apparent difficulties noted by the Working Group in that context, namely, the difficulty of defining the scope of any revision and the need to avoid the existence of two parallel systems during a prolonged period where some Contracting States had ratified a new version of the Treaty and others had not. The Secretariat pointed out that there were, however, precedents in WIPO for making changes to the effect of treaties in advance of their formal ratification, or which were not in strict agreement with their literal wording, where there was a consensus to do so. For example, the WIPO Assemblies in 1989, 1991 and 1993 had considered radical changes to the system of contributions by Member States under the WIPO Convention and the six other treaties administered by WIPO that provided for contributions to be paid by Contracting States. In consequence, in 1993, a unitary contributions system with revised contribution classes was introduced by consensus. The formal changes to the relevant treaties were only adopted in 2003, after it was agreed that the system had been shown to work, and the system was continuing even though those changes had not yet entered into force. Similarly, in the International Union for the Protection of New Varieties of Plants (UPOV), after the conclusion of the 1991 Act, it was agreed that the 1978 Act should remain open to accession by developing countries even beyond the dates of closing of the 1978 Act which had been set in the 1991 Act. The Secretariat suggested that Contracting States should consider the possibility of a revision of the PCT having a limited scope and whether a way could be found to voluntarily accelerate the effective entry into force of new provisions.

“13. After some discussion, the Chair concluded that, while differing views had been expressed as to whether the inclusion in the PCT of provisions relating to the restoration of the right of priority ought to be addressed in the Articles of the Treaty itself rather than in the Regulations, a majority of delegations had expressed the view that, as had been decided by the Assembly, it would be desirable for the PCT to be aligned in that regard to the PLT. The question at hand was thus not whether such restorations should be provided for in the context of the PCT but rather how best to address the concerns expressed by those delegations who saw a need for amending the Treaty itself. On the one hand, the possibility for transitional reservations provided one possible way for Contracting States not to apply the provisions concerned until such time as the position might be solved under their national laws. On the other hand, the suggestion by the Secretariat outlined in paragraph 12, above, merited further consideration.

“14. The Working Group agreed that, while there was no agreement as to whether the proposals could be implemented without amending the Articles of the Treaty itself, the approach taken in the proposals should be further developed, and the Working Group invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the matters noted above and the comments and suggestions as to particular provisions noted in the following paragraphs.

Rule 4.10(a)(i)

“15. One delegation suggested, noting particularly the proposed deletion of the words “, being a date falling within the period of 12 months preceding the international filing date”, that the term “priority period”, as used in proposed Rule 26bis.2(a)(i) and elsewhere, should be defined in the Regulations, either in Rule 26bis.2 or in Rule 2. Another delegation noted that the definition should take into account non-working days under Article 4C(3) of the Paris Convention. Another delegation considered that the definitions should also make clear that the provisions of Rule 80.5 (concerning expiration of time limit on a non-working day or official holiday) should apply to the priority period.

Rule 26bis.2(a)

“16. One delegation suggested that a receiving Office which had made a transitional reservation under proposed Rule 26bis.3(h) should not be required to notify the applicant of the possibility of submitting the request for the restoration of the right of priority in accordance with Rule 26bis.3, and that the proposed amendments of the Regulations should be further amended accordingly.

Rule 26bis.2(b)

“17. In response to questions by one delegation and a representative of users, the Secretariat explained that, as defined in proposed Rule 26bis.2(b), a priority claim which was “considered void” was, for the purposes of the Treaty, considered not to have been made *ab initio*. The definition had been introduced as a mere drafting change to simplify the wording of the proposed text and not to change the substance of the present provision. One delegation noted that consequential changes in terminology concerning priority claims “considered not to have been made” should be considered elsewhere, for example, in Rule 82ter.

“18. One delegation suggested that the Regulations should be further amended so as to provide that, as already provided under the Receiving Office Guidelines, a notice received after the expiration of the time limit under Rule 26bis.1(a) should be considered to have been received in time if it was received before the receiving Office had declared that the priority claim was considered not to have been made.

Rule 26bis.2(c)

“19. It was suggested and agreed that the words “the contents of” should be deleted in Rule 26bis.2(c)(ii).

Rule 26bis.2(d)

“20. One delegation suggested that the Administrative Instructions should be modified to ensure that the information to be published under Rule 26bis.2(d) contains a clear indication as to whether a priority claim has been considered void under Rule 26bis.2(b) or whether a priority claim has not been considered void under Rule 26bis.2(c).

Rules 26bis.3(a) and (b)

“21. One delegation pointed to the need for clarification of the relationship between Rules 26bis.3(b) and 26bis.2, noting that the present draft would appear to permit an applicant to request the restoration of the right of priority much later than two months following the expiration of the priority period, for example, in the case where the applicant added a priority claim under Rule 26bis.1 and received a notification by the receiving Office under Rule 26bis.3(b), which would appear to afford a further period of one month in the time limit for requesting restoration of that priority claim.

“22. One delegation suggested that it should be made clear that Rule 80.5 (concerning expiration of time limit on a non-working day or official holiday) applied to the time limit under this Rule.

Rule 26bis.3(c)

“23. One delegation sought clarification as to the evidence which could be required by a receiving Office, and in particular as to whether Offices could require particular forms of evidence (for example sworn statements) and whether they could require further evidence if the evidence originally filed was considered to be insufficient to decide the matter. It was felt that the draft as proposed would permit such flexibility, without having to include express provision to that effect, thus allowing each receiving Office to establish its own requirements, as had been previously agreed by the Working Group (see paragraph 49 of document PCT/R/WG/5/13). Such an understanding could, if desired, be reflected in the report of the Assembly in the event that it adopted amendments of the Regulations along the lines of the proposals.

“24. A number of delegations were concerned that leaving the necessary evidence to be decided by the receiving Office meant that a decision by a receiving Office which had very flexible requirements could result in the restoration of a right of priority on the basis of evidence which might not have been acceptable to a designated Office in a different

Contracting State having regard to the latter's national law, even if restoration of the right of priority were permitted under ostensibly the same criteria (due care or unintentionality).

“25. Other delegations and a representative of users, referring to one of the basic principles of international cooperation under the PCT, namely, trust in the work and decisions taken by other Offices during the international phase, considered that it was essential that the decisions of receiving Offices should be binding on designated Offices in the circumstances provided for in Rules 49ter.1(a) and (b), except in very limited circumstances where there was a particular doubt that a requirement had been complied with. Consistency in the standards to be applied was desirable and might be pursued through the Administrative Instructions, Receiving Office Guidelines and sharing of relevant decisions, with the result that consistency would be encouraged while enabling each receiving Office to deal with matters using procedures familiar to it.

“26. A representative of users was concerned that the term “reasonable in the circumstances” was not sufficiently certain as a time limit for filing a declaration or other supporting evidence. A minimum period of one month would be preferred. It was pointed out that Rule 14(6)(b)(i) of the PCT, on which this Rule was based, did not include a specific minimum time limit.

Rule 26bis.3(e)

“27. One delegation asked whether the requirement that the applicants should have the opportunity to make observations would enable a formal hearing to be conducted and whether it should be possible to appeal decisions to the national courts. Another delegation considered that since the receiving Office's negative decision can always be reviewed by the designated Office, there was no need to provide for an appeal. The Secretariat pointed out that the PCT was in general silent on these matters. The availability of hearings and appeals was neither required nor precluded by the Treaty; rather, the matter was left to national law.

Rule 26bis.3(h)

“28. Two delegations and one representative of users questioned the need for a transitional reservation provision under Rule 26bis.3(h), referring, in particular, to the wording of Article 10. However, other delegations pointed to the need for such a transitional reservation provision so as to afford time for the provisions of the applicable national law, such as those enabling the Office to require the payment of a fee for restoration of the right of priority, to be adapted to the new system.

“29. In response to a comment by one delegation that a three-month period may be insufficient for Contracting States wishing to make use of transitional reservation provisions, the Secretariat noted that this was the period that had usually been provided for in such transitional reservations when included in the Regulations in the past. Another delegation noted that such reservations would need to be made before entry into force of the provisions concerned.

Rule 48.2(a)(ix)

“30. In response to a query by one delegation, the International Bureau explained that, since the list of contents of the pamphlet under Rule 48.2 was comprehensive, information concerning a priority claim which had been considered void was included in Rule 48.2(a)(ix) even though such information was also referred to Rule 26 bis.2(d).

Rule 48.2(b)(v)

“31. The Chair noted that Rule 48.2(b)(v) should refer to Rule 26 bis.2(d) rather than Rule 26 bis.2(c).

Rule 49ter.1(a) and (b)

“32. Following a query by one delegation as to whether it was possible for a national law to provide for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion, as referred to in the Comment on Rule 49ter.1(b), another delegation suggested that, in practice, an Office would necessarily also accept, under such national law, decisions by a receiving Office based on the criterion of “unintentionality” and that the Comment was thus unnecessary. Another delegation suggested that a reference to more favorable requirements should be included in Rule 49ter.1(b) for consistency with Rule 49ter.2(e).

“33. One delegation suggested that, with a view to avoiding the need for transitional reservations under Rule 49ter.1(f) by States which did not wish to introduce provisions relating to the restoration of the right of priority into their national law, and to avoid an inequality between the provisions of Rule 49ter.1(a) and (b), Rule 49ter.1(a) should be restricted to any designated State whose applicable law provided for restoration of the right of priority based on the criterion of “due care”; alternatively, the words “whose applicable law provided for restoration of the right of priority based on that criterion” in Rule 49ter.1(b) should be deleted. That suggestion was opposed by one delegation. The Secretariat noted that, for consistency with the PLT, the proposal had been based on the general rule that Offices should provide for restoration of a right of priority on either the “due care” or the “unintentionality” criterion, any exception to that general rule being provided by way of transitional reservations.

Rule 49ter.1(c)

“34. One delegation, supported by another, expressed the view that the reference in Rule 49ter.1(c) to the requirements applied under Rule 26 bis.3 should be clarified so as to refer expressly to those procedural and substantive requirements for the restoration of the right of priority under Rule 26 bis.3, non-compliance with which would have the consequences provided for in Rule 49ter.1(c). The delegations suggested that the relevant requirements were those set out in Rule 26 bis.2(a)(i) and (ii) and the criterion applied by the receiving Office (“due care” or “unintentionality”).

Rule 49ter.1(f)

“35. Following a query by a delegation as to the nature of the effect of a reservation made by a designated Office under Rule 49ter.1(f), the Secretariat explained that such a

reservation would have both procedural and substantive effects. For example, there would be consequences both in terms of calculating the time limit for national phase entry before the designated Office concerned and in terms of the assessment of novelty and inventive step during the national search and examination. The Secretariat agreed that a Comment to that effect should be added to better clarify the effects of reservations under Rule 49ter.1(f).

“36. Another delegation noted that the reference in Rule 49ter.1(f) to “the national law applied by the designated Office” did not appear to apply to “a court or any other competent organ” as in Rule 49ter.1(c). The Secretariat noted that the same national law would presumably be applied by the designated Office and the courts in the designated State, and that it might therefore be preferable in Rule 49ter.1(f) to refer to the national law applied by the “designated State.” A representative of users noted that, in any event, the reference should be expressed so as to be clearly applicable in the case of a designated Office which was a regional Office.

Rule 49ter.2

“37. The Secretariat noted that comments made in respect of certain provisions of Rules 26bis.3 and 49ter.1 might also be relevant to corresponding provisions of Rule 49ter.2.

“38. In response to a query by a delegation, the Secretariat explained that the purpose of Rule 49ter.2 was to enable an applicant to request restoration of the right of priority during the national phase in any of the following cases: where the applicant had not requested such restoration during the international phase; where the receiving Office had made a reservation under Rule 26bis.3(h) and thus the possibility of requesting restoration was not available during the international phase; where the receiving Office did not provide for restoration on the relevant criterion; or where the receiving Office had refused a request for restoration during the international phase.

“39. In response to a query by another delegation, the Secretariat confirmed that it was intended to provide for the addition of priority claims only during the international phase (under Rule 26bis) and not during the national phase (unless such additions were possible under the national law itself), and the wording of proposed Rule 49ter.2 should be reviewed so as to ensure that it did not imply that such additions were enabled under the latter Rule.

Rule 49ter.2(g)

“40. One delegation suggested that reservations under Rule 49ter.2(g) should apply to at least paragraph (f) in addition to paragraph (a).

“41. The Secretariat explained that, although it was likely that a designated Office which made a reservation under Rule 49ter.1(f) would in practice also make one under Rule 49ter.2(g), there were circumstances in which a designated Office may need to make a reservation under only one of those Rules, for example, where its national law provided for restoration of the right of priority by the Office during the national procedure but did not put in place procedures enabling such restoration by its a PCT receiving Office.

“42. In response to a query by one delegation, the Secretariat agreed that the proposed Rule 49^{ter}.2(g) should be reviewed with a view to clarifying the basis of the calculation of the time limit referred to in that Rule, that is, whether the calculation should be on the basis of the priority date before or after restoration of the right of priority.”

5. While, at the sixth session of the Working Group, there was no agreement as to whether the proposals could be implemented without amending the Articles of the Treaty itself, the Working Group nevertheless agreed that the approach taken in the proposals should be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session (see the summary of the sixth session by the Chair, paragraph 14, reproduced in paragraph 4, above).

6. Revised proposals for amendment of the Regulations relating to the restoration of the right of priority, taking into account the suggestions made at the sixth session (see document PCT/R/WG/6/12, paragraphs 7 to 42, reproduced in paragraph 4, above) and comments received on preliminary draft documents for these seventh session of the Working Group which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 2 and Paper No. 2 Rev., have been prepared by the International Bureau accordingly. The further revised proposals are contained in Annex I to this document. Article 13 and Rule 14 of the PLT are reproduced, for ease of reference, in Annex II.

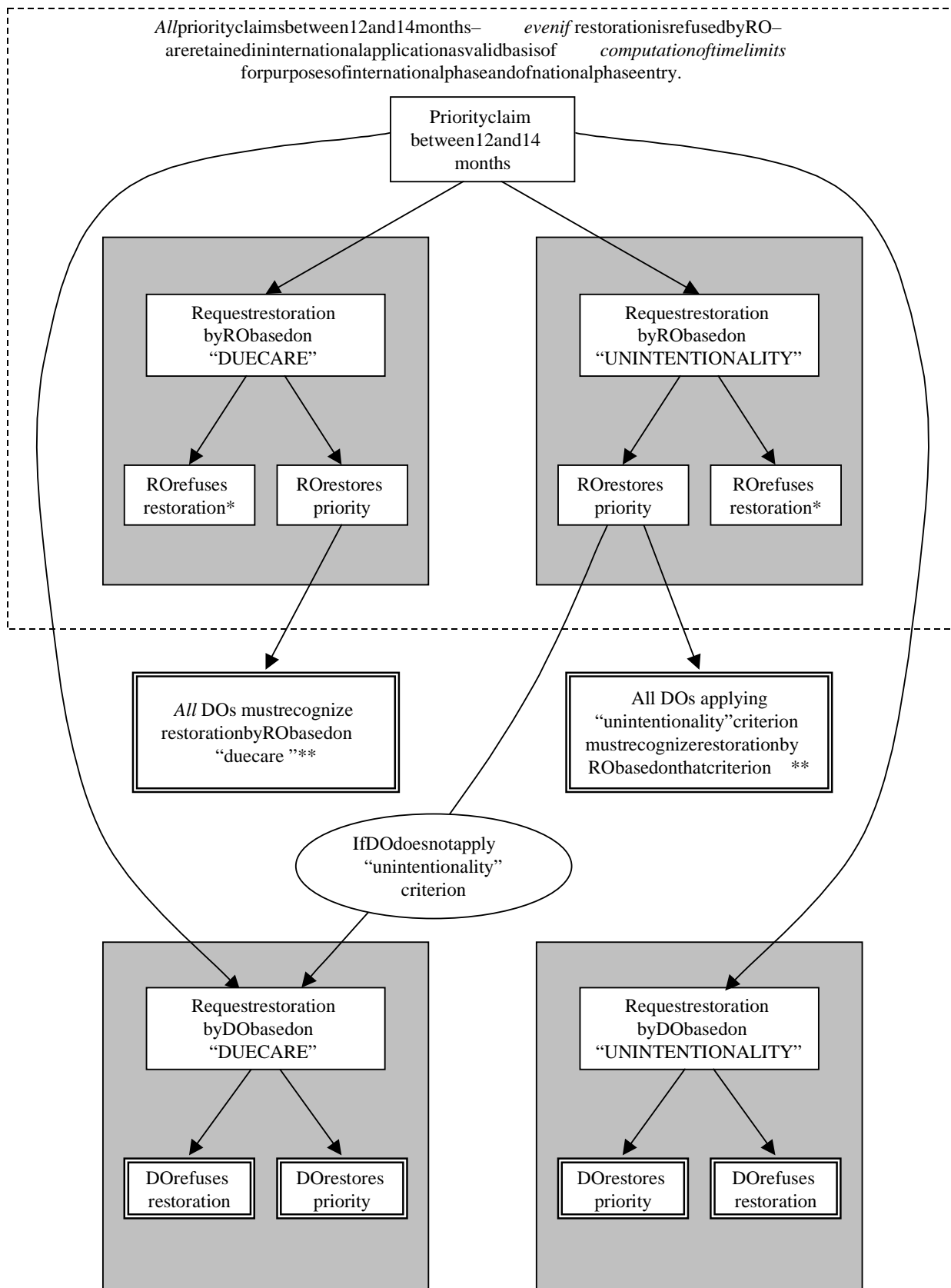
7. The main features of the revised proposals, which remain as outlined in document PCT/R/WG/6/12 and represented in the flow chart appearing on page 10, below, are outlined in the following paragraphs.

RESTORATION OF THE RIGHT OF PRIORITY

Automatic Retention of Priority Claim During International Phase

8. It is proposed to provide for the automatic retention, during the international phase, of a priority claim where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. Such a priority claim would be retained irrespective of whether the applicant requests the receiving Office to restore the right of priority, and even where such a request is made but refused by the receiving Office. Such a priority claim would therefore be taken into account during the international phase for the purposes of international search and international preliminary examination, and for the purpose of the computation of time limits, including that for entry into the national phase. In other words, because of the automatic retention of the priority claim, the filing date of the earlier application whose priority is claimed would be the “priority date” under Article 2(xi) for the purpose of computing time limits, irrespective of whether or not the receiving Office restored the right of priority (provided, of course, that the priority claim in question is the only priority claim contained in the international application or, where several priority claims are contained in the application, provided that the priority claim in question relates to the earliest application whose priority is claimed). The effect of this would be that all limits under the Treaty and Regulations which are calculated on the basis of the priority date, including those for entry into the national phase under Articles 22(1) and 39(1)(b), would expire up to 14 months earlier than if the priority claim was considered not to have been made (“void”) (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 42).

RESTORATION OF RIGHT OF PRIORITY



* Refusal by RO does not preclude a subsequent request to DO based on either criterion.

** Restoration by RO is subject to review by DO where reasonable doubt that requirements were met.

Restoration of the Right of Priority by the Receiving Office during the International Phase

9. As a general rule, and consistent with the PLT, any receiving Office would have to provide for the restoration of the right of priority during the international phase, any exception to that general rule being provided only by way of a transitional reservation by a receiving Office. The receiving Office, when deciding on a request for restoration, would be free to apply either the more strict criterion of “due care” or the less strict criterion of “unintentionality.” A receiving Office could also, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, receiving Offices would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. It is suggested that those understandings be expressed by the Assembly in amending the Regulations.

10. It would be advantageous for the applicant to obtain a positive finding by the receiving Office on the stricter criterion of “due care” since such a finding would be effective in all designated States, unlike a finding on the less strict “unintentionality” criterion (see paragraph 11, below).

Effect of Receiving Office Decision on Designated States

11. A decision by the receiving Office to restore a right of priority based on the criterion of “due care” would, as a general rule, be effective in all designated States. A decision by the receiving Office to restore a right of priority based on the criterion of “unintentionality” would be effective only in those designated States whose applicable national law provided for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, was more favorable than that criterion.

12. However, a decision of a receiving Office to restore a right of priority would not be effective in a designated State in which the relevant provisions did not apply consequent to a notification that the provisions concerned were not compatible with its national law. It would also not be effective in a designated State if the designated Office, a court or any other competent organ found that a substantive requirement for restoration of the right of priority by the receiving Office had not been complied with. However, a decision of the receiving Office to restore a right of priority would not be ineffective in a designated State merely because a procedural requirement for such restoration had not been complied with, for example, because a required fee had not been paid.

Prior Art for the Purposes of International Search, the Establishment of the Written Opinion by the International Searching Authority and International Preliminary Examination

13. As explained in paragraph 8, above, under the proposals, the claimed priority date would be used throughout the international phase for the purpose of calculating time limits (for example, those for international publication and national phase entry), even if restoration of the right of priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office, provided that the international application was filed within two months from the date on which the priority period expired.

14. At its fifth session, the Working Group noted that such retention of a priority claim did not affect the question of relevant prior art for the purposes of the international search under Rule 33, since the relevant date for the purposes of the international search was in any case the international filing date. In particular, it considered that no change to Rule 33.1(c) was needed since that Rule does not deal with the issue of written disclosures published earlier than the international filing date but later than the claimed priority date. Rather, that issue was covered by Section 507(d) of the Administrative Instructions (“Manner of Indicating Certain Special Categories of Documents Cited in the International Search Report”). With regard to international applications claiming the priority of an earlier application filed not within 12 months but within 14 months prior to the international filing date, consideration will be needed as to whether Section 507 should be modified so as to provide for a special code (say, letter “R” for “Restoration” (of the right of priority)) to identify, in the international search report (in addition to the letter “P” used in accordance with Section 507(d)), any document whose publication date occurred earlier than the international filing date of the international application but later than the priority date claimed in that application where that claimed priority date falls within the 2-month period between 12 months and 14 months prior to the international filing date.

15. At its fifth session, the Working Group also agreed to refer the question of relevant prior art for the purposes of the written opinion of the International Searching Authority (Rule 43bis.1) and the international preliminary examination (Rule 64) to the Meeting of International Authorities under the PCT (MIA) for consideration via its electronic forum, with a view to the development of a proposal for submission to the next session of the Working Group (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 35). Following consultation with the International Authorities via the MIA electronic forum, it is proposed to amend Rule 64.1(b) so as to clarify the “relevant date” for the purposes of Rule 64.1(a) where the international application claims the priority of an earlier application but has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. By virtue of Rule 43bis.1(b), this date would also be the “relevant date” for the purposes of establishing the written opinion by the International Searching Authority.

Restoration of the Right of Priority by Designated Office during the National Phase

16. As a general rule, and consistent with the PLT, any designated Office would have to provide for the restoration of the right of priority in the national phase, any exception to that general rule being provided only by way of a notification of incompatibility by a designated Office. As under the PLT and the provisions applicable to the receiving Office mentioned above, the national law applicable by the designated Office would have to provide for the restoration of the right of priority either on the basis of the more restrictive criterion of “due care” or the less restrictive criterion of “unintentionality.” A designated Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a designated Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. It is suggested that those understandings be expressed by the Assembly in amending the Regulations.

17. In practice, of course, restoration of the right of priority by a designated Office during the national phase would only be necessary where the receiving Office had not already restored the right of priority with effect for the designated Office concerned.

18. The Working Group is invited to consider the proposals contained in Annex I to this document.

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

RESTORATION OF THE RIGHT OF PRIORITY

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² 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 2

Interpretation of Certain Words

2.1 to 2.3 [No change]

2.4 “Priority Period”

(a) Whenever the term “priority period” is used in relation to a priority claim, it shall be construed as meaning the period of 12 months from the filing date of the earlier application whose priority is so claimed. The day of filing of the earlier application shall not be included in that period.

(b) Rule 80.5 shall apply *mutatis mutandis* to the priority period.

[COMMENT: As suggested at the sixth session of the Working Group, it is proposed to define the term “priority period” in the Regulations (see Article 4C(2) of the Paris Convention) and to clarify that Rule 80.5 applies *mutatis mutandis* to the priority period (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 15). Note that the proposed definition would apply to all priority claims contained in an international application, that is, international applications claiming the priority of one or more earlier applications filed either in or for any country party to the Paris Convention or for any Member of the World Trade Organization that is not party to the Paris Convention (see present Rule 4.10(a)(ii)).]

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No change]

(iii) declarations as provided in Rule 4.17 .

(iv) a request for restoration of the right of priority .

(d) [No change]

4.2 to 4.9 [No change]

4.10 *Priority Claim*

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

(i) the date on which the earlier application was filed ~~, being a date falling within the period of 12 months preceding the international filing date~~;

[COMMENT: It is proposed to amend item (i) of paragraph (a) so as only to require the applicant to indicate the filing date of the earlier application. The question of whether the international application has been filed within the Paris Convention priority period (only then the priority claim would be valid) would be dealt with in Rule 26bis.2(a) as proposed to be amended (see below). See also the definition of the term “priority period” in proposed new Rule 2.4, above.]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 26 bis

Correction or Addition of Priority Claim

26bis.1 [No change]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds in relation to a priority claim:

- (i) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under Rule 26bis.3 has not been submitted;
or

[COMMENT: It is proposed to amend Rule 4.10(a)(i) (see above) and Rule 26bis.2(a) so as to expressly provide that the applicant should be invited to correct the priority claim where the international application has an international filing date which is later than the date on which the priority period expired and a request for restoration has not (yet) been submitted by the applicant. There appears to be no need for an invitation to correct a priority claim where a request for restoration of that right of priority has been filed by the applicant, showing that the applicant, while being aware of the fact that the filing date of the earlier application as indicated in the request does not fall within the 12 months preceding the international filing date, has no intention to correct that priority date but rather wishes to have the right of priority restored under Rule 26 bis.3, below.]

- (ii) that the priority claim does not comply with the requirements of Rule 4.10~~;~~

or

[Rule 26bis.2(a), continued]

(iii) that any indication in ~~the~~ a priority claim is inconsistent with ~~not the same as~~ —
the corresponding indication appearing in the priority document ;

[COMMENT: As agreed by the Working Group at its sixth session, item (iii) has been further amended by deleting the reference to “the contents of” the corresponding indication (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 19).]

the receiving Office or the International Bureau, as the case may be, shall invite the applicant

to correct the priority claim. In the case referred to in item (i), where the international filing

date is within two months from the date on which the priority period expired, the receiving

Office or the International Bureau, as the case may be, shall also notify the applicant of the

possibility of submitting a request for the restoration of the right of priority in accordance

with Rule 26bis.3, unless the receiving Office has notified the International Bureau under

Rule 26bis.3(i) of the incompatibility of Rule 26bis.3(a) to (h) with the national law applied

by that Office.

[COMMENT: A notification of the possibility of submitting a request for the restoration of the right of priority would, of course, only be sent to the applicant where such a request had not already been made (“in the case referred to in item (i)” of paragraph (a)). Where the receiving Office has made a reservation under proposed Rule 26bis.3(i), the receiving Office or the International Bureau, as the case may be, would not be required to notify the applicant of the possibility of submitting the request for the restoration of the right of priority.]

[Rule 26bis .2, continued]

(b) If, ~~in response to an invitation under paragraph (a),~~ the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim ~~so as to comply with the requirements of Rule 4.10,~~ that priority claim shall, subject to paragraph (c), for the purposes of the procedure under the Treaty, be considered not to have been made (“considered void”) and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly . Any notice correcting the priority claim which is received before the receiving Office or the International Bureau, as the case may be, so declares and not later than one month after the expiration of that time limit shall be considered to have been received before the expiration of that time limit. ~~provided that a~~

[COMMENT: The proposed deletion of the reference to “an invitation under paragraph (a)” is to provide for the situation in which no invitation has been sent under paragraph (a) because no address for service has been provided. The proposed deletion of the reference to Rule 4.10 is consequential on the amendment of that Rule proposed above. It is also proposed to define the phrase “considered not to have been made” so as to avoid, in paragraph (c) (see below) the use of a double negative (“shall *not* be considered *not* to have been made”). See also paragraphs 17 and 18 of the summary of the sixth session by the Chair, document PCT/R/WG/6/12). Furthermore, as had been suggested at the sixth session of the Working Group (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 18), it is proposed to further amend Rule 26bis.2(a) so as to provide that a notice received after the expiration of the time limit under Rule 26bis.1(a) should be considered to have been received in time if it was received before the receiving Office or the International Bureau had declared that the priority claim was considered not to have been made. However, noting that a decision as to the validity of a priority claim must be obtained prior to international publication, it is proposed that any such notice must be received not later than one month from the expiration of the applicable time limit under Rule 26bis.1(a).]

[Rule 26bis.2, continued]

(c) A priority claim shall not be considered ~~void notto have been made~~ only because :

[COMMENT: See the Comment on paragraph (b) as proposed to be amended, above.]

(i) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing ; ~~or because~~

(ii) an indication in the priority claim is ~~inconsistent with not the same as~~ the corresponding indication appearing in the priority document ; ~~or~~

[COMMENT: As agreed by the Working Group at its sixth session, item (ii) has been further amended by deleting the reference to “the contents of” the corresponding indication (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 19).]

(iii) the international application has an international filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date.

[COMMENT: Pursuant to item (iii), a priority claim contained in an international application whose international filing date is later than the date on which the priority period expired but within the period of two months from that date would automatically be retained, even if restoration of the right to priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office. Such a priority claim would therefore be used throughout the international phase for the purpose of calculating time limits (for example, those for international publication and national phase entry) as well as for the determination of prior art in the context of establishing the written opinion by the International Searching Authority and the international preliminary examination report by the International Preliminary Examining Authority under Chapter II (see Rule 64.1(b) as proposed to be amended, below).]

[Rule 26bis.2, continued]

~~(d)~~ (e) Where the receiving Office or the International Bureau has made a declaration under paragraph (b) or where the priority claim has not been considered void only because paragraph (c) applies, the International Bureau shall ~~upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions,~~ publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions which was considered not to have been made, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information ~~A copy of that request~~ shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 44. Under paragraph (d) as proposed to be amended, information concerning a priority claim which, in accordance with paragraph (b), is considered void would be published in all cases and not only upon request made by the applicant. Furthermore, information concerning a priority claim would also be published in all cases where the priority claim, in accordance with paragraph (c), was retained. The Administrative Instructions would have to be modified accordingly, taking into account a suggestion made at the sixth session of the Working Group that the information published under this paragraph should contain a clear indication as to whether a priority claim has been considered void under paragraph (b) or whether a priority claim has been retained under paragraph (c) (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 20). See also Rule 48.2 as proposed to be amended, below.]

26bis.3 Restoration of Right of Priority by Receiving Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it (“criterion for restoration”) is satisfied, namely, that the failure to file the international application within the priority period:

(i) occurred in spite of due care required by the circumstances having been taken;

or

(ii) was unintentional.

Each receiving Office shall apply at least one of those criteria and may apply both of them.

[COMMENT: See PLT Article 13(2) and PLTR Rule 14(4). See paragraph 9 in the main body of this document. Since it would not appear feasible to define or explain the terms “due care” and “unintentional” in the Regulations, it is proposed that, following adoption of the proposed amendments by the Assembly, the International Bureau should consider defining or explaining those terms in the Receiving Office Guidelines, taking into account any standards that are recurrently applied under the national laws applicable in Contracting States.]

[Rule 26bis.3, continued]

(b) A request under paragraph (a) shall:

(i) be filed with the receiving Office within the time limit applicable under paragraph (c);

(ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under paragraph (d);

[COMMENT: See PLT Article 13(2)(i) and (iii). See also proposed new paragraph (d), below.]

(iii) where a priority claim in respect of the earlier application is not contained in the international application, be accompanied by a notice under Rule 26bis.1(a) adding the priority claim; and

[COMMENT: See PLT Article 13(2)(i) and PLTR Rule 14(5)(ii).]

(iv) be accompanied by any fee for requesting restoration required under paragraph (e).

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

[Rule 26bis.3, continued]

(c) The time limit referred to in paragraph (b)(i) shall be two months from the date on which the priority period expired, provided that, where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a) or any notice referred to in paragraph (b)(iii) submitted, or any fee referred to in paragraph (b)(iv) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

[COMMENT: See PLT Article 13(2)(ii) and PLTR Rule 14(4)(b). Upon further consideration, it is no longer proposed, as in previous drafts, that the time limit for furnishing a request for the restoration of the right of priority should be two months from the date on which the priority period expired or one month from the date of the notification under the last sentence of Rule 26bis.2(a), whichever expires later. As was noted at the sixth session of the Working Group (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 21), such a time limit would have allowed an applicant to request restoration of the right of priority much later than two months following the expiration of the priority period (example: the applicant, say, four months after the international filing date (the minimum time limit within which a priority may be added under Rule 26bis.1), adds a priority claim under Rule 26bis.1 with regard to an earlier application filed 14 months prior to the international filing date; the applicant is then notified under Rule 26bis.2(a) of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3, triggering a time limit of one month from the date of that notification for requesting restoration of the right of priority). Rather, it is proposed to fix that time limit, as under PLTR Rule 14(4)(b), at simply “two months from the date on which the priority period expired” and to even shorten that time limit where the applicant requests early publication under Article 21(1)(b) (also as under PLTR Rule 14(4)(b)). Note that Rules 80.5 and 82 would apply to that time limit (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 22). The Administrative Instructions would have to be modified so as to require the International Bureau to notify the receiving Office of any request by the applicant for early publication and the (envisaged) date of completion of technical preparations for early international publication.]

[Rule 26bis.3, continued]

(d) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b)(ii) be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau a copy of any such declaration or other evidence filed with the receiving Office, in which case the International Bureau shall include such copy in its files.

[COMMENT: See PLT Article 13(5). Note that the Working Group agreed at its fifth session that the question of what information or evidence each receiving Office was entitled to require in support of a request for restoration of the right of priority should be left to national law and practice (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 49). This agreement was affirmed by the Working Group at its sixth session. It was also noted that an understanding to that effect could, if desired, be reflected in a report of the Assembly in adopting the proposed amendment (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 23). In order to promote consistency of standards as regards declarations and evidence which would be acceptable under this paragraph, it is proposed that, following the adoption of the proposed amendments by the Assembly, the International Bureau should consider defining or explaining the term “a declaration or other evidence in support of the statement of reasons” in the Administrative Instructions and/or Receiving Office Guidelines and promoting the sharing of relevant decisions, taking into account any standards that are currently applied under the national laws applicable in Contracting States (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraphs 24 and 25).]

(e) The submission of a request under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration. The amount of that fee, if any, shall be fixed by the receiving Office.

[COMMENT: See PLT Article 13(4). As noted by the Working Group at its fifth session, under Rule 26bis.3(c), an Office which provided for restoration on both the criterion of “unintentionality” and the criterion of “due care” would be free to charge different fees in respect of the two cases (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 48).]

[Rule 26bis.3, continued]

(f) The receiving Offices shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal by the receiving Office may be sent to the applicant together with any invitation to file a declaration or other evidence under paragraph (d).

[COMMENT: See PLT Article 13(6). Note that, since the PCT is generally silent on such matters, the availability of hearings and appeals in respect of decisions by the receiving Office under paragraph (f) is neither required nor precluded by the Treaty but is left to national law and practice (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 27).]

(g) The receiving Offices shall promptly:

(i) notify the International Bureau of the receipt of a request under paragraph (a);

(ii) make a decision upon the request;

(iii) notify the applicant and the International Bureau of its decision and the criterion for restoration upon which the decision was based.

(h) Each receiving Office shall inform the International Bureau of which of the criteria for restoration it applies. The International Bureau shall promptly publish such information in the Gazette.

[Rule 26bis.3, continued]

(i) If, on [*date of adoption of these modifications by the PCT Assembly*], paragraphs (a) to (h) are not compatible with the national law applied by the receiving Office, those paragraphs and the last sentence of Rule *26bis.2(a)* shall not apply to that receiving Office for as long as paragraphs (a) to (h) continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [*three months from the date of adoption of these modifications by the PCT Assembly*]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: At the sixth session of the Working Group, a number of delegations confirmed that the need for a reservation provision applicable to receiving Offices as proposed in paragraph (i) so as to afford time for the provisions of the applicable national law, such as those enabling the Office to require the payment of a fee for restoration of the right of priority, to be adapted to the new system (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 28). Note, however, that a Contracting State could only take advantage of such provision if its national law contained provisions addressed to its national Office in its capacity as a PCT receiving Office (and not only in its capacity as a national Office, or as a designated or elected Office) which were not compatible with the proposed amendments of the PCT Regulations. For a reservation for national Offices in their capacities as designated or elected Offices, see Rule *49ter.1(f)* and *49ter.2(g)*.]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (viii) [No change]

(ix) any information concerning a prior ity claim referred to in Rule 26bis.2(d)
~~considered not to have been made under Rule 26bis.2(b), the publication of which is~~
~~requested under Rule 26bis.2(c),~~

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under
Rule 26ter.1, which was received by the International Bureau before the expiration of the time
limit under Rule 26ter.1,

(xi) any information concerning a request under Rule 26bis.3 for restoration of the
right of priority and the decision of the receiving Office upon such request, including
information as to which of the criteria for restoration the decision was based upon.

[Rule 48.2, continued]

[COMMENT: Since the list of contents of the pamphlet under Rule 48.2 is comprehensive, information concerning a priority claim which had been considered void under Rule 26bis.2(b), or which had not been considered void because Rule 26bis.2(c) applied, is included in item (ix) even though such information was also referred to in Rule 26bis.2(d) (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 30).

(b) Subject to paragraph (c), the front pages shall include:

(i) to (iii) [No change]

(iv) where applicable, an indication that the request contains ~~a~~ **any** declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter.1*,

(v) where applicable, an indication that the pamphlet contains information under Rule 26bis.2(d).

(vi) where applicable, an indication that the pamphlet contains information concerning a request under Rule 26bis.3 for restoration of the right of priority and the decision of the receiving Office upon such request,

(vii) where applicable, an indication that the applicant has, under Rule 26bis.3(d), furnished copies of any declaration or other evidence to the International Bureau.

(c) to (i) [No change]

[Rule 48.2, continued]

(j) If, at the time of completion of the technical preparations for international publication, a request under Rule 26bis.3 for restoration of the right of priority is still pending, the pamphlet shall contain, in place of the decision by the receiving Office upon that request, an indication to the effect that such decision was not available and that the decision, when it becomes available, will be separately published.

48.3 to 48.6 [No change]

Rule 49 ter

Effect of Restoration of Right of Priority by Receiving Office;

Restoration of Right of Priority by Designated Office

49ter.1 Effect of Restoration of Right of Priority by Receiving Office

(a) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken, that restoration shall, subject to paragraph (c), be effective in each designated State.

[COMMENT: See paragraph 11 of the Introduction to this document. Note that, for consistency with the PLT, the proposal is based on the general rule that Offices should provide for restoration of a right of priority on either the “due care” or the “unintentionality” criterion, any exception to that general rule being provided by way of reservations (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 33). As regards a reservation provision, see paragraph (f) and Rule 49ter.2(g), below.]

(b) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to paragraph (c), be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion.

[COMMENT: See paragraph 11 of the Introduction to this document. The reference to a criterion which is more favorable than the “unintentionality” criterion has been included to clarify that restoration by the receiving Office would also be effective in any designated State

[Rule 49ter.1(b), continued]

whose applicable national law provided for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 32). As regards a transitional reservation provision, see paragraph (f) and Rule 49ter.2(g), below.]

(c) A decision by the receiving Office to restore a right of priority under Rule 26bis.3 shall not be effective in a designated State where the designated Office, a court or any other competent organ of that designated State finds that a requirement of any of Rule 26bis.3(a) or (b)(i) or (iii) was not complied with, taking into account the reasons stated in the requests submitted to the receiving Office under Rule 26bis.3(a) and any declaration or other evidence filed with the receiving Office under Rule 26bis.3(b)(ii).

[COMMENT: See the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 34. It is proposed that a competent authority in the designated State should be permitted to consider a decision by a receiving Office to restore a right of priority to be not effective in that designated State only if it finds that there was non-compliance with a requirement of any of Rule 26bis.3(a) or (b)(i) or (iii). Accordingly, a competent authority could not consider a decision by the receiving Office to restore a right of priority to be not effective in that designated State on a finding that, for example, a fee required under Rule 26bis.3(e) was not paid. Note that a finding of non-compliance could not be made merely because the information or evidence required by the receiving Office was not the same kind of information or evidence as that required by the designated Office under its national law; instead, such a finding could only be made on the basis of the information or evidence as furnished to the receiving Office (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 54). The proposed wording “the designated Office, a court or any other competent organ of that designated State” is modeled on Article 27(4).]

[Rule 49ter.1, continued]

(d) A designated Office shall not review the decision of the receiving Office unless it may reasonably doubt that a requirement referred to in paragraph (c) was complied with, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for those doubts and giving the applicant an opportunity to make observations within a reasonable time limit.

[COMMENT: Note that the requirement for reasonable doubt applies only to designated Offices in order not to fetter the courts or any other competent organs of the designated States in the exercise of their discretion under national law.]

(e) No designated State shall be bound by a decision of the receiving Office refusing a request under Rule 26bis.3 for restoration of the right of priority.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 54.]

(f) Where the receiving Office has refused a request for the restoration of the right of priority, any designated Office may consider that request to be a request for restoration submitted to that designated Office under Rule 49ter.2(a) within the time limit under that Rule.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 56. Note, however, that, in order for the request to be considered by the designated Office, it must comply with certain requirements (such as the furnishing of reasons, which the request filed during the international phase may not have complied with) and a fee may have to be paid to the designated Office (see Rule 49ter.2(a)(ii), below).]

[Rule 49ter.1, continued]

(g) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (d) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: A designated Office whose applicable national law did not provide for the restoration of the right of priority at all or did provide for the restoration of the right of priority based on a more stringent criterion than the “due care” criterion would have to make use of the reservation provision under paragraph (g) and also of the reservation provision under Rule 49ter.2(g). In view of the definition of the term “national law” in Article 2(x) (“reference to “national law” shall be construed as reference to the national law of a Contracting State...”), and for consistency with the wording of other reservation provisions throughout the Regulations (all of which refer to the “national law applied by the designated Office”), it is not proposed, as had been suggested at the sixth session (see summary of the sixth session by the Chair in document PCT/R/WG/6/12, paragraph 36), to refer to the “national law of a designated State” instead of the “national law applied by the designated Office.” Note that Article 2(x) also clarifies that, where a regional application or regional patent is involved, the reference to “national law” is construed as a reference to the treaty providing for the filing of regional applications or the granting of regional patents. Note further that a reservation under this paragraph would have both procedural and substantive effects; for example, there would be consequences both in terms of calculating the time limit for national phase entry before the designated Office concerned and in terms of the assessment of novelty and inventive step during the national search and examination (see summary of the sixth session by the Chair in document PCT/R/WG/6/12, paragraph 35).]

49ter.2 Restoration of Right of Priority by Designated Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it (“criterion for restoration”) is satisfied, namely, that the failure to file the international application within the priority period:

(i) occurred in spite of due care required by the circumstances having been taken;

or

(ii) was unintentional.

Each designated Office shall apply at least one of those criteria and may apply both of them.

[COMMENT: See paragraph 16 in the main body of this document.]

(b) A request under paragraph (a) shall:

(i) be filed with the designated Office within a time limit of one month from the applicable time limit under Article 22;

[Rule 49ter.2(b), continued]

(ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under paragraph (c); and

(iii) be accompanied by any fee for requesting restoration required under paragraph (d).

[COMMENT: As had been suggested in the sixth session of the Working Group (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 39), proposed new Rule 49ter.2 has been reviewed with a view to whether its wording implies that it would be possible, based on that Rule, to add a priority claim in the national phase where that priority claim was not contained in the international application as filed and has not been added during the international phase under Rule 26bis. Upon review, however, that does not appear to be the case. As at present, it is a question of the national law applicable by the designated Office whether it is possible, in such a case, to add a priority claim and to request the designated Office to restore the right of priority with regard to that priority claim. As regards the computation of the time limit for entry into the national phase under Article 22(1), see paragraph 8 of the Introduction.]

(c) The designated Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b)(ii) be filed with it within a time limit which shall be reasonable under the circumstances.

(d) The submission of a request under paragraph (a) may be subjected by the designated Office to the payment to it, for its own benefit, of a fee for requesting restoration.

[Rule 49ter.2, continued]

(e) The designated Offices shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal may be sent by the designated Office to the applicant together with any invitation to file a declaration or other evidence under paragraph (d).

(f) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraphs (a) and (b), the designated Office may, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under those paragraphs.

(g) Each designated Office shall inform the International Bureau of which of the criteria for restoration it applies and, where applicable, of the requirements of the national law applicable in accordance with paragraph (f). The International Bureau shall promptly publish such information in the Gazette.

[Rule 49ter.2, continued]

(h) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (g) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply to that designated Office for as long as they continue to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: See the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraphs 40 and 41. Any designated Office whose national law provided for a criterion more stringent than the “due care” criterion or did not provide for restoration of the right of priority at all could make use of the reservation provision under proposed new paragraph (h). Designated Offices whose applicable national law provided for the restoration of the right of priority based on requirements similar but not identical to the requirements under Rule 49ter.2(a) and (b) would not need to make use of the reservation provision, provided the requirements under the applicable national law were, from the viewpoint of applicants, at least as favorable as the requirements under Rule 49ter.2(a) and (b). It is suggested that this understanding be expressed by the Assembly in amending the Regulations.]

Rule 64

Prior Art for International Preliminary Examination

64.1 *Prior Art*

(a) [No change]

(b) For the purposes of paragraph (a), the relevant date will be:

(i) subject to item s(ii) and (iii), the international filing date of the international application under international preliminary examination;

(ii) where the international application under international preliminary examination ~~validly~~ claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application , unless the International Preliminary Examining Authority considers that the priority claim is not valid;

(iii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

[Rule 64.1(b), continued]

[COMMENT: See paragraph 15 of the Introduction to this document.]

64.2 and 64.3 [No change]

Rule 76

Translation of Priority Document;

Application of Certain Rules to Procedures Before Elected Offices

³

76.1, 76.2 and 76.3 [Remain deleted]

76.4 [No change]

76.5 *Application of Certain Rules to Procedures Before Elected Offices*

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

[COMMENT: The proposed amendment of Rule 76.5 is consequential on the proposed addition of new Rule 49 *ter*.]

(i) to (v) [No change]

³ The present text of Rule 76 is as adopted by the Assembly on October 5, 2004, with effect from April 1, 2005.

Rule 82 *ter*

**Rectification of Errors Made by the
Receiving Office or by the International Bureau**

82ter.1 Errors Concerning the International Filing Date and the Priority Claim

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered void by the receiving Office or the International Bureau ~~not to have been made~~, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date as if the priority claim had not been considered void ~~not to have been made~~.

[COMMENT: The proposed amendment of Rule 82 *ter.1* is consequential on the proposed amendment of Rule 26bis.2(b) (see above; see also the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 17). Note that present Rule 82 *ter.1* is proposed to be further amended in the context of proposed amendments of the Regulations relating to the restoration of missing elements and parts of the international application (see PCT/R/WG/7/2).]

[Annex II follows]

ANNEXII

ARTICLE13ANDRULE14OFTHEPATENTLAWTREATY(PLT)

Article13

CorrectionorAdditionofPriorityClaim;RestorationofPriorityRight

(1) [*CorrectionorAdditionofPriorityClaim*] Exceptwhereotherwise prescribedin theRegulations,aContractingPartys shallprovideforthecorrectionoradditionofapriority claimwithrespecttoanapplication(“thesubsequentapplication”),if:

- (i) arequesttothateffectismadetotheOfficeinaccordancewith the requirementsprescribedintheRegulations;
- (ii) therequestisfiledwithinthetimelimitprescribedintheRegulations;and
- (iii) thefilingdateofthesubsequentapplicationisnotlaterthanthedateofthe expirationofthepriorityperiod calculatedfromthefilingdateoftheearliestapplication whosepriorityisclaimed.

(2) [*DelayedFilingoftheSubsequentApplication*] Takingintoconsideration Article15,aContractingPartys shallprovidethat,whereanapplication(“thesubsequent application”)whichclaimsorcouldhaveclaimedthepriorityofanearlierapplicationhasa filingdatewhichislaterthanthedateonwhichthepriorityperiodexpired,butwithinthe timelimitprescribedintheRegulations,theOfficeshallrestore therightofpriority,if:

- (i) arequesttothateffectismadetotheOfficeinaccordancewiththe requirementsprescribedintheRegulations;
- (ii) therequestisfiledwithinthetimelimitprescribedintheRegulations;
- (iii) therequeststatest hereasonsforthefailuretocomplywiththepriority period;and
- (iv) theOfficefindsthatthefailuretofilethesubsequentapplicationwithinthe priorityperiodoccurredinspiteofducarerequiredbythecircumstanceshavingbeentaken or,at theoptionoftheContractingParty,wasunintentional.

(3) [*FailuretoFileaCopyofEarlierApplication*] AContractingPartys shallprovide that,whereacopyofanearlierapplicationrequiredunderArticle6(5)isnotfiledwiththe Officewithinth etimelimitprescribedintheRegulationspursuanttoArticle6,theOffice shallrestorertherightofpriority,if:

- (i) arequesttothateffectismadetotheOfficeinaccordancewiththe requirementsprescribedintheRegulations;
- (ii) therequest isfiledwithinthetimelimitforfilingthecopyoftheearlier applicationprescribedintheRegulationspursuanttoArticle6(5);

(iii) the Office finds that the request for the copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations; and

(iv) a copy of the earlier application is filed within the time limit prescribed in the Regulations.

(4) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).

(5) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(6) [Opportunity to Make Observations in Case of Intended Refusal] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Rule 14

Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13

(1) [Exception Under Article 13(1)] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.

(2) [Requirements Under Article 13(1)(i)] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) [Time Limit Under Article 13(1)(ii)] The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) [Time Limits Under Article 13(2)] (a) The time limit referred to in Article 13(2), introductory part, shall expire not less than two months from the date on which the priority period expired.

(b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) [Requirements Under Article 13(2)(i)] A Contracting Party may require that a request referred to in Article 13(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [*Requirements Under Article 13(3)*] (a) A Contracting Party may require that a request referred to in Article 13(3)(i):

(i) be signed by the applicant; and

(ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request.

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3)(iv) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [*Time Limit Under Article 13(3)(iii)*] The time limit referred to in Article 13(3)(iii) shall expire two months before the expiration of the time limit prescribed in Rule 4(1).

[End of Annex II and of document]

WIPO



PCT/R/WG/7/4
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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
Geneva, May 25 to 31, 2005

PUBLICATION OF INTERNATIONAL APPLICATIONS
IN MULTIPLE LANGUAGES

Document prepared by the International Bureau

SUMMARY

1. This document contains further revised proposals for amendment of the Regulations under the PCT¹ to provide for the publication of international applications in multiple languages. Applicants would have the option of submitting translations, in languages other than the usual language of publication, for publication by the International Bureau. This possibility would be useful for applicants wishing to ensure the “prior art effect” of their applications and/or to establish a basis for “provisional protection” in designated States whose national laws provide that such effect or protection is dependent on publication of a translation.

¹ 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.

2. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and the comments received on preliminary draft documents made available since then. The main differences in comparison with the proposals considered at the sixth session concern the following: (i) the additional languages in which the applicant may request international publication to take place; and (ii) the furnishing of translations of changes (amendments, rectifications of obvious errors) and of indications in relation to deposited biological material.

3. This document also contains other proposed language-related amendments of the Regulations which are not directly related to the proposed amendments concerning international publication in multiple languages but which appear to be necessary even if the latter do not proceed.

BACKGROUND

4. During its third session, the Working Group discussed a proposal for deletion of Article 64(4), based on document PCT/R/WG/3/1, Annex II, item 28. The Working Group agreed that further consideration of this matter should be deferred until progress had been made in discussions of prior art issues by the Standing Committee for the Law of Patents (SCP). As a related matter, the Working Group agreed, however, that the International Bureau should look into the possibility of amending Rule 48 so as to provide for the electronic publication by the International Bureau of translations, furnished by the applicant, of the international application (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 78 to 82).

5. For the fourth session of the Working Group, the International Bureau prepared a proposal to amend Rule 48 so as to require the International Bureau, on request by the applicant, to publish, together with the international application, any translation of the international application furnished by the applicant or, where the international application was filed in a language which was not a language of publication, the international application in the language in which it was filed (see Annex III of document PCT/R/WG/4/4). However, having regard to the time available for discussion during the fourth session, discussion on this proposal was deferred until the fifth session of the Working Group.

6. At the fifth session of the Working Group, discussions on the proposal to amend Rule 48 were again deferred, following an explanation by the International Bureau that further study and consultation was needed.

7. At its sixth session, the Working Group discussed revised proposals for amendment of the Regulations concerning the publication of international applications in multiple languages, taking into account the comments received on previous draft proposals. The discussions are outlined in document PCT/R/WG/6/12, paragraphs 138 to 143, reproduced in the following paragraphs:

“INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

“138. Discussions were based on document PCT/R/WG/6/8.

“139. The Working Group invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the comments and suggestions set out in the following paragraphs.

“140. One delegation confirmed that the proposal as presently drafted would achieve its primary objective of establishing prior art effect of the international application concerned under its national law. In view of this confirmation, the proposal was supported by two other delegations. One of those emphasized, however, the need to discuss a possible revision of Article 64(4) at some stage in the future.

“141. One delegation and one representative of users, while welcoming the proposals in relation to the question of prior art effect, stated that the effects of international publication in an additional language other than those relating to prior art effect ought to be further examined and kept in mind as further proposals were developed. Such other effects included, for example, the affording of “provisional protection” to published applications (see Article 29).

“142. One representative of users suggested that international publication in additional languages should not be restricted to languages of publication under the PCT, that there should be a long time limit for submitting translations for publication, that additional language versions should be published only in electronic form as documents downloadable from the Internet, and that the fee for publications should vary depending on the particular electronic format in which a translation was provided.

“143. One representative of users, while not opposed to the proposals *per se*, expressed concern that publication of international applications in multiple languages was out of line with one of the basic aims of the Treaty, namely, to give effect under multiple national laws to an international application filed in a single language. The representatives suggested that the additional costs involved would deter most applicants from using the proposed system, and that the underlying issue concerning the prior art effect of published international applications should be dealt with in the context of the consideration by WIPO’s Standing Committee on the Law of Patents of a proposed Substantive Patent Law Treaty.”

8. The Annex to the present document contains further revised proposals, taking account of the suggestions made by delegations and representatives of users at the sixth session (see document PCT/R/WG/6/12, paragraphs 138 to 143, reproduced in paragraph 7, above) and also of comments received on preliminary drafts for the seventh session of the Working Group which were made available for comment on the WIPO website as PCT/R/WG/7/Paper No.3 and Paper No.3 Rev. The main features of the revised proposals are outlined in the following paragraphs.

INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

9. International publication and communication to designated Offices of the international application in more than one language would be beneficial for the establishment or protection of certain rights of the applicant under the national law of designated States. This will be the case, first, in designated States where the prior art effect of an international application is, in accordance with Article 64(4), dependent on the international publication of the international application in a language accepted by the Office of the designated State concerned. Second, there are designated States where provisional protection of an international application is, in accordance with Article 29, dependent on the publication or availability of the international application in a language in which publications under the national law of the designated State concerned are effected.

10. It is thus proposed to amend the PCT Regulations so as to allow for the international publication of translations of the international application in one or more languages beyond that in which the international publication takes place under Article 21(4) and Rule 48.3.

11. Under the Regulations as proposed to be amended, the applicant may request, within a time limit of 17 months from the priority date, that the international application be published, in addition to the "usual" language in which the international application is published under Rule 48.3(a) or (b), in one or more additional languages.

12. Where the international application was filed in a language different from the language in which it is published under Rule 48.3(a) or (b) and the applicant requests publication in that language of filing, the international application would be published in both the language of publication referred to in Rule 48.3(a) and in the language in which it was filed. The applicant may also request publication in an additional language which was not the language of filing, in which case the applicant would have to furnish a translation of the international application into the additional language and the international application would then be published in both the language of publication referred to in Rule 48.3(a) and the additional language.

13. For the purposes of international publication in an additional language, the applicant would have to pay a special fee. The translation into an additional language would have to contain the following elements (unless such element had already been furnished in that language):

(i) the international application itself (that is, the description, including the title of the invention, where applicable, as established by the International Searching Authority under Rule 37; the claim or claims; any text matter in the drawings; and the abstract, where applicable, as established by the International Searching Authority under Rule 38);

(ii) any amendment under Article 19 and any statement filed under Article 19(1);

(iii) any rectification of an obvious error referred to in Rule 91.1(e)(ii) (that is, any rectification of an error in any part of the international application other than the request); and

(iv) any indications in relation to deposited biological material referred to in Rule 13*bis*.4 furnished separately from the description.

14. International publication in the additional language would not take place where the applicant did not, within the applicable time limit, pay the special fee for publication or furnish the required translations.

15. As indicated above, in general, the time limit for requesting publication in the additional language, for the payment of the special fee for publication, and for the furnishing of the required translations would be 17 months from the priority date. It is to be noted, however, that the time limit for making amendments under Article 19 (and for filing the statement under Article 19(1)) may, in certain circumstances, under Rule 46.1, expire after the expiration of that 17-month time limit, and even after international publication of the international application concerned. Furthermore, where the International Searching Authority has established the title and/or the abstract under Rules 37 and 38, respectively, the applicant may need further time to translate those elements into the additional language. It is

thus proposed that any translation into the additional language of an amendment under Article 19 or statement under Article 19(1), or of the title and the abstract as established by the International Searching Authority, may be filed within two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority, or 17 months from the priority date, whichever time limit expires later. If such a translation is furnished after completion of technical preparations for international publication of the international application in the additional language but within that time limit, the international application would have to be republished in the additional language.

16. As regards the additional languages in which the applicant may request that international publication take place, it is no longer proposed, as it was in document PCT/R/WG/6/8, to limit those languages to the “languages of publication” referred to in Rule 48.3(a). As suggested at the sixth session (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 142, reproduced in paragraph 7, above), it is now proposed that the applicant be allowed to request publication of the international application in any additional language.

17. The International Bureau would not, however, be able to establish, for the purposes of international publication, a standardized front page of the published international application in a language not being one of the languages of publication referred to in Rule 48.3(a). It is thus proposed that, where the additional language is not one of the languages of publication referred to in Rule 48.3(a), the front page relating to such international application would always be published in both English and French. The data contained on the front page is always available at the International Bureau in both those languages, since the Gazette in electronic form, which contains the same data elements as the front page, is published in both English and French. Where the additional language is one of the languages of publication referred to in Rule 48.3(a), the front page relating to such international application would, of course, be published in that language of publication.

OTHER PROPOSED AMENDMENTS

18. This document also contains certain proposed amendments which are not directly related to the proposed amendments concerning international publication in multiple languages but which would appear necessary even if the latter were not agreed upon. In particular, it is proposed:

(i) to add a new Rule 12.1*bis* to fill a gap in the present Regulations which do not provide for the language in which indications related to deposited biological material furnished under Rule 13*bis*.4 separately from the description are to be filed;

(ii) to amend Rule 12.2(c) to fill a gap by adding a reference to a translation furnished under Rule 12.4;

(iii) to amend Rules 12.2(c) and 55.2 to clarify that the check for, and the correction of, defects under Rule 11 in translations furnished under Rule 55.2(a) for the purposes of international preliminary examination is carried out by the International Preliminary Examining Authority; and

(iv) to amend Rule 48.3(c) to clarify that, where the international application is published in a language other than English, the translation required for such international publications shall be prepared under the responsibility of the International Bureau only if it is not furnished by the applicant under Rule 12.3 (or proposed new Rule 12.5).

19. 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: ²

PUBLICATION OF INTERNATIONAL APPLICATIONS IN MULTIPLE LANGUAGES

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Rule 12

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

12.1 Languages Accepted for the Filing of International Applications

(a) [No change]

(b) Each receiving Office shall, for the filing of international applications, accept at least one language which is both:

(i) [No change] a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office, and

(ii) a language referred to in Rule 48.3(a) ~~of publication~~.

(c) Notwithstanding paragraph (a), the request shall be filed in any language referred to in Rule 48.3(a) ~~of publication~~ which the receiving Office accepts for the purposes of this paragraph.

(d) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

12.1bis Language of Indications Furnished Under Rule 13bis.4

Any indication in relation to deposited biological material furnished under Rule 13bis.4 shall be in the language in which the international application is filed, provided that, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), any such indications shall be filed in both the language in which the application is filed and the language of that translation.

[COMMENT: It is proposed to add new Rule 12.1bis so as to fill an apparent gap in the present Regulations which do not provide for the language in which indications related to deposited biological material furnished under Rule 13 bis.4 separately from the description are to be filed. Note that this proposed amendment is not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon.]

12.2 *Language of Changes in the International Application*

(a) [No change] Any amendment of the international applications shall, subject to Rules 46.3, 55.3 and 66.9, be in the language in which the application is filed.

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

(i) where a translation of the international application is required under Rule 12.3(a), 12.4(a) or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language in which ~~of~~ the application is filed and the language of that translation;

[Rule 12.2(b)(i), continued]

[COMMENT: Not that paragraph (b) would have to be further amended should the proposed amendments to the Regulations concerning the rectification of obvious mistakes (see document PCT/R/WG/7/6) be adopted.]

(ii) [No change]

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or [12.4](#), any [correction under Rule 12.5\(f\)](#) of a defect in a translation furnished under Rule [12.5\(b\)](#), any [correction under Rule 55.2\(c\)](#) of a defect in a translation furnished under Rule [55.2\(a\)](#), or [any correction of a defect](#) in a translation of the request furnished under Rule [26.3ter\(c\)](#), shall be in the language of the translation.

[COMMENT: Rule 12.2(c) as worded at present would appear to incorrectly imply that the check for, and correction of, defects under Rule 11 in a translation furnished under Rule 55.2(a) is made “under Rule 26” and thus by the receiving Officer rather than by the competent International Preliminary Examining Authority to which such a translation is to be furnished. It is therefore proposed to amend paragraph (c) so as to clarify that a correction of a translation furnished under Rule 55.2(a) is done “under Rule 55.2(c)” and thus by the International Preliminary Examining Authority (see also Rule 55.2 as proposed to be amended, below). Furthermore, it is proposed to amend Rule 12.2(c) by adding a reference to a translation furnished under Rule 12.4, noting that it would appear that the addition of such reference was overlooked when Rule 12.4 was added to the Regulations. Not that these proposed amendments are not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon. It is further proposed to amend paragraph (c) to add a reference to a translation furnished under proposed new Rule 12.5, consequential on the proposed addition of that new Rule.]

12.3 *Translation for the Purposes of International Search*

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

(i) [No change]

(ii) a language [referred to in Rule 48.3\(a\)](#) ~~of publication~~, and

(iii) a language accepted by the receiving Office under Rule 12.1(a), unless the international application is filed in a language [referred to in Rule 48.3\(a\)](#) ~~of publication~~.

(b) to (e) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below).]

12.4 *Translation for the Purposes of International Publication*

(a) Where the language in which the international application is filed is not a language referred to in Rule 48.3(a) ~~of publication~~ and no translation is required under Rule 12.3(a), the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into any language referred to in Rule 48.3(a) ~~of publication~~ which the receiving Office accepts for the purposes of this paragraph.

(b) to (e) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below).]

12.5 Additional Translations for the Purposes of International Publication

(a) The applicant may, within the applicable time limit under paragraph (g), make a request to the International Bureau that the international application be published, in addition to the language in which it is to be published under Rule 48.3(a) or (b), in another language (“additional language”). Such requests may be made in respect of more than one additional language in relation to the same international application.

[COMMENT: See paragraph 16 in the main body of this document.]

(b) A request under paragraph (a) shall be accompanied by a special publication fee whose amount shall be fixed in the Administrative Instructions and by a translation into the additional language of:

(i) the international application, unless it was filed in the additional language or a translation into the additional language has already been furnished under Rule 12.3;

[COMMENT: With regard to the contents of the translation of the international application under paragraph (b)(i), see paragraph (c), below.]

(ii) any amendment under Article 19 and any statement under Article 19(1);

(iii) any rectification of an obvious error referred to in Rule 91.1(e)(ii), unless such rectification has already been filed in the additional language under Rule 12.2(b)(i);

[Rule 12.5(b)(iii), continued]

[COMMENT: Not that item (iii) would have to be further amended should the proposed amendments to the Regulations concerning the rectification of obvious errors (see PCT/R/WG/7/6) be adopted.]

(iv) any indication in relation to deposited biological material referred to in

Rule 13bis.4, unless such indication has already been furnished in the additional language

under Rule 12.1bis.

[COMMENT: With regard to the consequences of non-compliance with the requirements of Rule 12.5(a) and (b) (for example, non-payment of fees, missing translations, etc., see Rule 48.3(b-bis) and (b-ter), below).

(c) For the purposes of paragraph (b)(i), the translation of the international application

shall contain:

(i) the description (other than any sequence listing part of the description),

including, where applicable, the title established by the International Searching Authority

under Rule 37.2;

[COMMENT: Not that the title prepared by the applicant is part of the description (see Rule 5.1(a)) and would thus be included in the translation of the description into the additional language.]

(ii) the claim or claims;

(iii) any text matter in the drawings; and

[Rule 12.5(c), continued]

(iv) the abstract as filed by the applicant or, where applicable, as established by the International Searching Authority under Rule 38.2.

[COMMENT: Not that paragraph (c) would have to be further amended should the proposed amendments of the Regulations concerning the incorporation by reference of certain elements and parts (see document PCT/R/WG/7/2) be adopted.]

(d) The translation of any text matter in the drawings referred to in paragraph (c)(iii) shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

[COMMENT: Proposed new paragraph (d) is modeled on present Rule 49.5(d).]

(e) Where a request under paragraph (a) is not accompanied by the special publication fee or a required translation referred to in paragraph (b), the International Bureau shall invite the applicant to pay that fee or to furnish that required translation, as the case maybe, within the applicable time limit under paragraph (g).

[COMMENT: With regard to the consequences where the applicant does not comply with the invitation within the applicable time limit, see Rule 48.3(b-bis), below].

[Rule 12.5, continued]

(f) The International Bureau shall check any translation referred to in paragraph (b) furnished by the applicant for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication, and shall invite the applicant to correct any defect within the time limit under paragraph (g).

[COMMENT: With regard to the consequences where the applicant does not comply with the invitation within the applicable time limit, see Rule 48.3(b-*bis*), below].

(g) The time limit referred to in paragraphs (a), (e) and (f) shall be 17 months from the priority date, provided that:

[COMMENT: See paragraphs 9 to 16 in the main body of this document. In general, it is proposed that any request for the publication of the international application in an additional language of publication (see proposed new Rule 12.5, above) and any translation into such a language would have to be furnished within 17 months from the priority date, noting that sufficient time is needed by the International Bureau in order to prepare international publication in the additional language. It is not proposed, as had been suggested by a representative of users at the sixth session (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 142), to provide for an even longer time limit than 17 months from the priority date for the furnishing of the translation, noting that, in order to have the intended effects concerning prior art and provisional protection, publication of the international application in the additional language has to be part of the “international publication” under Article 21 and thus has to take place promptly after the expiration of 18 months from the priority date.]

[Rule 12.5(g), continued]

(i) the time limit referred to in paragraph (e) for the furnishing of a translation of the title or the abstract established by the International Searching Authority under Rule 37.2 and 38.2, respectively, as required under paragraphs (b)(i) and (c), and of an amendment under Article 19 and a statement under Article 19(1) as required under paragraph (b)(ii), and the time limit referred to in paragraph (f) for the furnishing of any correction of such translation, shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 17 months from the priority date, whichever time limit expires later;

[COMMENT: See paragraph 15 in the main body of this document.]

(ii) any translation or rectification of an obvious error required under paragraph (b)(iii), and any correction of such translation referred to in paragraph (f), furnished after the expiration of 17 months from the priority date shall be considered to have been received on the last day of that time limit if it reaches the International Bureau before the technical preparations for international publication have been completed;

[COMMENT: As regards the translation of any rectification of an obvious error, it is proposed to, in effect, extend the 17-month time limit up to the point of completion of technical preparations for international publication, noting that, under present Rule 91, the applicant may request rectification of an obvious error in the international application (other than the request) up to that point in time (not further that, in order to be effective, the authorization for rectification given by the International Searching Authority must also reach the International Bureau before the completion of technical preparation for international publication (see present Rule 91.1(g)(i) and (g -bis)). Note that item (i) would have to be further amended should the proposed amendments to the Regulations concerning the rectification of obvious mistakes (see document PCT/R/WG/7/6) be adopted.]

[Rule 12.5(g), continued]

(iii) where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a), any translation under paragraph (b) or any correction under paragraph (f) submitted, or any fee under paragraph (b) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

[COMMENT: Where the applicant has requested early publication of the international application, all acts required for the international publication of the international application in the additional language must have been performed by the applicant before the completion of technical preparations for international publication; otherwise, the international application will not be published in the additional language.]

Rule 26

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

26.1 to 26.2 *bis* [No change]

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

(a) Where the international application is filed in a language [referred to in Rule 48.3\(a\)](#)
~~of publication~~, the receiving Office shall check:

(i) and (ii) [No change]

(b) Where the international application is filed in a language which is not a language
[referred to in Rule 48.3\(a\)](#) ~~of publication~~, the receiving Office shall check:

(i) and (ii) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

26.3 *bis* [No change]

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

(a) Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office shall, unless

(i) [No change]

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#),

invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#). Rules 26.1(a), 26.2, 26.3, 26.3 *bis*, 26.5 and 29.1 shall apply *mutatis mutandis*.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) and (c) [No change]

26.4 to 26.6 [No change]

Rule 37

Missing or Defective Title

37.1 [No change]

37.2 *Establishment of Title*

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with Rule 4.3, it shall itself establish a title. Such titles shall be established in the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#), or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

Rule 38

Missing or Defective Abstract

38.1 [No change]

38.2 *Establishment of Abstract*

(a) If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#), or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) [No change]

Rule 43

The International Search Report

43.1 to 43.3 [No change]

43.4 *Language*

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is to be published [under Rule 48.3\(a\) or \(b\)](#), or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

43.5 to 43.10 [No change]

Rule 46

Amendment of Claims Before the International Bureau

46.1 and 46.2 [No change]

46.3 *Language of Amendments*

~~Any~~ ~~If the international application has been filed in a language other than the language~~
~~in which it is published, any~~ amendment made under Article 19 shall be in the language in
which the international application is published under Rule 48.3(a) or (b) ~~of publication~~.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

46.4 *Statement*

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published under Rule 48.3(a) or (b). ~~The statement~~ ~~and~~ shall not exceed 500 words if in the English language or if translated into that language and. ~~The statement~~ shall be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) [No change]

46.5 [No change]

Rule 47

Communication to Designated Offices

47.1 and 47.2 [No change]

47.3 Languages

(a) The international application communicated under Article 20 shall be in the language in which it is published under Rule 48.3(a) or (b) and, where applicable, in each additional language in which it is published under Rule 48.3(b-bis).

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below). Note that, in accordance with Rule 93bis.1 (“communication on request”), the communication of any document by the International Bureau to a designated Office will only be effected on request by that Office, so that any designated Office would be free to waive the receipt of the published international application under Article 20 altogether, or to request to receive the published international application in all publication languages, or to specify the publication languages in which it wishes to receive the published international application.]

(b) Where the ~~language in which the~~ international application is not published under Rule 48.3(a), (b) or (b-bis) in ~~is different from~~ the language in which it was filed, the International Bureau shall furnish to any designated Office ~~upon the request of that Office,~~ a copy of that application in the language in which it was filed.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below) and, as far as the proposed deletion of the text “upon request of that Office” is concerned, on the entry into force, with effect from January 1, 2004, of Rule 93bis.1 (“communication on request”), pursuant to which the communication of any document by the International Bureau to a designated Office will only be effected on request by that Office.]

47.4 [Nochange]

[COMMENT: Not that it is also proposed in another document to amend Rule 47 in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8).]

Rule 48³

International Publication

48.1 *Form and Means*

(a) ~~[Deleted] The international applications shall be published in the form of a~~
~~pamphlet.~~

(b) The ~~particulars regarding the~~ form in which and the means by which international
applications are published ~~of the pamphlet and the method of reproduction~~ shall be governed
by the Administrative Instructions.

[COMMENT: See document PCT/R/WG/7/8. Modified Section 406 of the Administrative Instructions, which entered into force on April 1, 2005, enable the International Bureau to fulfill its legal obligation under Article 21 to publish international applications by way of electronic means. It is thus proposed to delete the term “pamphlet” throughout the Regulations, noting that that term, connoting paper publication, would appear to be misleading.]

48.2 *Contents*

(a) The publication of the international application ~~The pamphlet~~ shall contain:

[COMMENT: See document PCT/R/WG/7/8. The proposed amendments of the chapeau of paragraph (a) are consequential on the proposed deletion of the term “pamphlet” throughout the Regulations (see Rule 48.1 as proposed to be amended, above).]

³ Changes to Rule 48 are proposed in both this document and in document PCT/R/WG/7/8 relating to international publication and PCT Gazette in electronic form. Where appropriate, changes to particular provisions are repeated in both documents.

[Rule 48.2(a), continued]

(i) to(x) [Nochange]

[COMMENT: Not that amendments of items (i) to (x) of paragraph (a) are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8.)]

(b) [Nochange]

[COMMENT: Not that amendments of paragraph (b) are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8.)]

(c) to (e) [Nochange]

(f) to (h) [Nochange]

[COMMENT: Not that amendments of paragraphs (f), (g) and (h) are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8.)]

(i) Where the international application is published in an additional language under

Rule 48.3(b-bis), the published international applications shall include:

(i) if the additional language is one of the languages referred to in Rule 48.3(a),
the element referred to in paragraph (a)(i) in that additional language;

[Rule 48.2(i)(i), continued]

[COMMENT: The “element referred to in paragraph (a)(i)” is the front page which, where the additional language is one of the languages referred to in Rule 48.3(a), would include the abstract.]

(ii) if the additional language is not one of the languages referred to in

Rule 48.3(a), the element referred to in paragraph (a)(i) in English and in French, and the

abstract, as referred to in Rule 12.5(c)(iv), in the additional language;

[COMMENT: Where the additional language is not one of the languages referred to in Rule 48.3(a), the front page (“the element referred to in paragraph (a)(i)”), including the abstract, would be published in English and French. Furthermore, the publication of the international application would contain the abstract in the additional language.]

(iii) the elements referred to in paragraphs (a)(ii) to (iv), (v) and (viii) of this Rule,

in the additional language;

[COMMENT: The “elements referred to in paragraphs (a)(ii) to (iv), (vi) and (viii)” are the description, the claims, the drawings (if any) (where applicable, as rectified under Rule 91) and any indications in relation to deposited microorganisms furnished separately from the description.]

(iv) if available at the time of the completion of the technical preparations for

international publication, the elements referred to in paragraph (f) of this Rule, in the

additional language.

[COMMENT: The “elements referred to in paragraph (f)” are amended claims under Article 19 and any statement under Article 19(1).]

[Rule 48.2(i), continued]

~~The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g) and (h) shall apply. Such determinations shall depend on the volume and complexity of the amendments and/or the volume of the international application and the cost factors.~~

[COMMENT: The proposed deletion of the text of present paragraph (i) is consequential on the amendments of paragraphs (g) and (h) proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8).]

(j) Where the international application is published in an additional language under Rule 48.3(b-bis) and, at the time of the completion of the technical preparations for international publication, the time limit under Rule 12.5(g) for the furnishing of a translation of the title or the abstract established by the International Searching Authority, of a translation of an amendment under Article 19 and of a statement under Article 19(1), or of any correction of such translation under Rule 12.5(f), has not expired, the front pages shall refer to that fact and indicate that, promptly after receipt by the International Bureau of any such translation within the time limit under Rule 12.5(g), any such translation will be published together with the revised front page.

[COMMENT: See paragraph 15 in the main body of this document.]

48.3 *Languages of Publication*

(a) If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish ~~(“languages of publication”)~~, the application shall be published in the language in which it was filed.

(b) If the international application is not filed in one of the languages referred to in paragraph (a) ~~a language of publication~~ and a translation into such a language ~~of publication~~ has been furnished under Rule 12.3 or 12.4, the application shall be published in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed addition of new Rule 48.3(b-*bis*)(see below).]

(b-*bis*) Where the applicant makes a request complying with Rule 12.5 for publication of the international application in an additional language, the international application shall be published in that language in addition to the language in which the international application is published under paragraph (a) or (b).

[COMMENT: Where the applicant has made a request for the publication of the application in an additional language but has not met all the requirements of Rule 12.5 (for example, the special fee has not been paid in full, or required elements are missing from the translation, or the translation does not comply with the physical requirements referred to in Rule 11 to the extent necessary for the purpose of reasonably uniform publication), the international application would not be published in the additional language.]

[Rule 48.3, continued]

(c) If the international application is published under paragraph (a) or (b) in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations , if not furnished by the applicant under Rule 12.3 or 12.5, shall be prepared under the responsibility of the International Bureau.

[COMMENT: The proposed amendments of the first sentence of paragraph (c) are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above). The proposed addition of a reference to Rule 12.3 in the last sentence of paragraph (c) would fill an apparent gap in the present text of paragraph (c); note that this addition is not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon. Otherwise, the proposed amendment of the last sentence is consequential on the proposed addition of Rule 12.5.]

48.4 to 48.6 [No change]

[COMMENT: Note that Rule 48 is proposed to be further amended in the context of proposed amendments of the Regulations relating to missing elements and parts of the international application (see document PCT/R/WG/7/2), relating to the restoration of the right of priority (see document PCT/R/WG/7/3), relating to the rectification of obvious mistakes (see document PCT/R/WG/7/6), relating to international publication and PCT Gazette in electronic form (see document PCT/R/WG/7/8), and relating to the addition of Arabic as a language of publication (see document PCT/R/WG/7/10).]

Rule 49

Copy, Translation and Fee Under Article 22

49.1 [No change]

49.2 *Languages*

(a) The language into which translation may be required must be an official language of the designated Office provided that no translation may be required:

(i) if the international application is filed in such a language or, if there are several of such languages, no translation may be required if the international application is in one of them ; or

(ii) if the international application is published under Rule 48.3(a), (b) or (b-bis) in such a language or, if there are several of such languages, in one of them;

If there are several official languages and a translation must be furnished, the applicant may choose any of those languages.

[COMMENT: Where the international application is published under Rule 48.3(a), (b) or (b-bis) in an official language of the designated Office, or where the international application is filed in an official language of the designated Office which is different from the language in which the application is published, a copy of the international application in that official language is communicated to that designated Office by the International Bureau, upon request of that Office, under Article 20, Rule 47.3(a) or (b) and Rule 93bis. It is proposed to amend Rule 49.2(a) so as to clarify that, in those cases, the Offices should not be entitled to require the applicant to furnish it with a translation.]

[Rule 49.2, continued]

(b) Notwithstanding ~~the foregoing provisions of this~~ paragraph (a);

(i) if there are several official languages but the national law prescribes the use of one such language for foreigners, a translation into that language may be required ;

(ii) if no translation of the international application may be required under paragraph (a), the designated Office may nevertheless require a translation of the request as referred to in Rule 49.5(a)(i), in which case Rule 49.5(b) shall apply *mutatis mutandis*.

[COMMENT: The proposed addition of new item (ii) is consequential on the proposed amendment of paragraph (a) (see above): where no translation of the international application may be required by a designated Office under paragraph (a), that Office should still be entitled to request the furnishing of a translation of the request (see Rule 49.5(a)(i)), noting that a copy of the request would not be included in the copy of the international application communicated to the designated Office (in the official language of the designated Office) under Article 20, Rule 47.3(a) or (b), and Rule 93bis. Rule 49.5(b), which is referred to in proposed new item (ii) of paragraph (b), deals with details concerning the furnishing of a translation of the request.]

49.3 to 49.6 [No change]

Rule 55

Languages (International Preliminary Examination)

55.1 *Language of Demand*

The demand shall be in the language in which the international application is published under Rule 48.3(a) or (b) ~~of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication~~. However, if a translation of the international application is required under Rule 55.2, the demand shall be in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

55.2 *Translation of International Application*

(a) Where ~~neither the language in which~~ the international application is not filed nor ~~the language in which the international application is~~ published under Rule 48.3(a), (b) or (b-bis) in a language is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant shall, subject to paragraph (b), furnish with the demand a translation of the international application into a language which is both:

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see above).]

[Rule 55.2(a), continue d]

(i) [No change] a language accepted by that Authority, and

(ii) a language referred to in Rule 48.3(a) ~~of publication~~.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

(a-bis) The International Preliminary Examining Authority shall check any translation furnished under paragraph (a) for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purposes of the international preliminary examination.

[COMMENT: See Rule 12.2(c) as proposed to be amended, above. It is proposed to add a new paragraph (a-bis) to Rule 55.2 so as to expressly provide for the International Preliminary Examining Authority to carry out the Rule 11 check but only to the extent that compliance with Rule 11 is necessary for the purposes of international preliminary examination. Furthermore, it is proposed to amend paragraph (c) (see below) so as to expressly provide for that Authority to invite the applicant to correct any defect. Note that the proposed addition of new paragraph (a-bis) and the proposed amendments to paragraph (c) are not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon.]

(b) [No change]

[Rule 55.2, continued]

(c) If ~~a~~ the requirement referred to in ~~of~~ paragraph (a) or (a -bis) is not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation or the required correction, as the case maybe, within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

[COMMENT: See comment on proposed new paragraph (a-bis), above.]

55.3 [No change]

Rule 66

Procedure Before the

International Preliminary Examining Authority

66.1 to 66.8 [No change]

66.9 *Language of Amendments*

(a) Subject to paragraphs (b) and (c), ~~if the international application has been filed in a language other than the language in which it is published,~~ any amendment, as well as any letter referred to in Rule 66.8, shall be submitted in the language in which the international application is published under Rule 48.3(a) or (b) of publication.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

(b) to (d) [No change]

Rule 70

**International Preliminary Report on Patentability
by
the International Preliminary Examining Authority
(International Preliminary Examination Report)**

70.1 to 70.16 [No change]

70.17 *Languages of the Report and the Annexes*

The report and any annex shall be in the language in which the international application to which they relate is published [under Rule 48.3\(a\) or \(b\)](#), or, if the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

Rule 74

**Translation of Annexes of the International
Preliminary Examination Report and Transmittal Thereof**

74.1 *Contents of Translation and Time Limit for Transmittal Thereof*

(a) [No change]

(b) Where the furnishing under Article 39(1) of a translation of the international application is not required by the elected Office, that Office may require the applicant to furnish, within the time limit applicable under that Article, a translation into the language in which the international application was published [under Rule 48.3\(a\) or \(b\)](#) of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report and is not in that language.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

[End of Annex and of document]

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORMOF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
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RECORDING OF CHANGES BY THE INTERNATIONAL BUREAU

Document prepared by the International Bureau

SUMMARY

1. This document contains further revised proposals for amendment of the Regulations relating to the recording of changes concerning the person, name and address, etc., of applicants, inventors and agents in respect of international applications under the PCT. Applicants would benefit greatly from having the possibility for the single recording of a change under Rule 92bis to have effect for the purposes of the national procedure before a number of designated and deleted Offices. The proposal thus affords applicants the option of requesting the recording of changes not only, as at present, during the international phase before the expiration of 30 months from the priority date but also after the expiration of 30 months from the priority date in respect of designated and deleted Offices before which the national phase processing of the international application has started and has not yet been completed. The proposals would not apply to granted patents.

¹ 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. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

2. Changes in the name, address, nationality and residence of the applicant or inventor recorded by the International Bureau would have effect under the applicable national law of those Offices (subject to certain exceptions and a reservation provision). However, changes in the person of the applicant or the inventor, or in the person, name and address of the agent and the common representative, or in the address for correspondence, would have effect only if so provided under the applicable national law of designated and elected Offices.

3. The proposals are also intended to achieve consistency, to the extent possible, with provisions of the PLT relating to the recording of changes.

4. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and comments received on preliminary draft documents made available since then.

BACKGROUND

5. At its fifth session, the Working Group agreed that the International Bureau should study the possibility of providing for a request, to be made in a single document submitted to the International Bureau, to record certain changes concerning the applicant, inventor, licensee or security interests in respect of two or more designated or elected Offices in the international application had entered the national phase, similar to the procedure under Article 14(1)(b) and Rules 15, 16 and 17 of the Patent Law Treaty (PLT) (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 105). which

6. During its sixth session, the Working Group discussed proposals by the International Bureau for setting up a system, under the PCT, which would facilitate, for both applicants and Offices, the recording of certain changes in respect of an international application which has entered the national phase before several designated or elected Offices, or of a patent granted on the basis of such an international application. The Working Group's discussions are outlined in document PCT/R/WG/6/12, paragraphs 108 to 121, reproduced in the following paragraphs:

“SINGLE REQUEST FOR THE RECORDING OF CHANGES DURING THE NATIONAL PHASE

“108. Discussions were based on document PCT/R/WG/6/10.

“109. There was considerable support in the Working Group for further consideration of the concept of permitting requests to be made centrally for the recording of certain changes in respect of international applications which have entered the national phase, noting the significant consequential benefits that would accrue if greater communication resulted in common formats and easier access to patent data for information and statistical purposes.

“110. The Working Group invited the Secretariat to prepare revised proposals for consideration at the next session, taking into account the comments and suggestions set out in the following paragraphs.

“111. Some delegations expressed concern as to the legal basis in the Treaty for making Rules for procedures extending well into the national phase of processing of international applications. Some delegations felt that the regulation-making power in Article 58(1)(ii) was not a sufficient basis to establish procedures for which there was no general basis in the substantive Articles of the Treaty. Other delegations, however, felt that there was an adequate basis, noting, in particular, that the proposals were consistent with the aims of the Treaty as expressed in the preamble and were in no way inconsistent with any specific provision of the Treaty.

“112. Some delegations noted that the Treaty in general governed procedures only to the end of the international phase, whereas, after national phase entry, the application became subject solely to national law. Concerns were expressed that in introducing such a system might have consequential effects on the way in which other provisions in the Regulations were interpreted.

“113. Other delegations pointed out that the international and national phases were not distinctly defined by the Treaty or Regulations, and that, in fact, certain features of the Treaty dealt specifically with matters obtaining long after the international phase was over. Those features included the fundamental principle that an international application has, for the purposes of the national law in all designated States, the effect of a regular national application having as its filing date the international filing date accorded under the Treaty (see Article 11). Others such features related to the provision of information (see Article 50), and the prohibition on requirements relating to the form or contents being applied to the application additional to those provided for in the Treaty and Regulations (see Article 27(1)).

“114. Some delegations were of the view that the proposed system should only be applied in respect of changes concerning pending applications but should not apply to changes concerning granted patents.

“115. It was generally agreed, as was proposed, that any such system should be limited, at least at the outset, to changes in the name and address of applicants, agents and inventors, noting that it would be difficult to achieve agreement at this stage on the kind of evidence which should be required for other kinds of matter.

“116. A number of delegations were concerned that the proposed system would not be compatible with national laws which require the applicant to notify changes directly to the designated Office in a particular manner and with prescribed kinds of evidence, particularly in the case of a change of name. Moreover, it was noted that dealing with fees might pose difficulties. Consequently, it was felt that participation in any system would need to be on a voluntary basis for designated Offices or subject to transitional reservation provisions, although it was pointed out that the usefulness of the system would be considerably less if a significant number of Offices were to opt out of it.

“117. One delegation expressed its concern that it would be too difficult to incorporate the proposed new system into established national procedures and that the new system would consequently result in greater, rather than less, work in designated Offices. It was noted, however, that certain checks would be carried out centrally by the International Bureau rather than the designated Offices concerned, meaning that there ought rarely to be any action required by designated Offices other than the recording

itself. Other delegations considered that such a system ought to be very beneficial and should be considered further, even if it would imply changes to established national laws and systems.

“118. One representative of users suggested that, since local agents needed to be informed about any changes concerning international applications which had entered the national phase, almost the same amount of work would be involved for the applicant as under the current system. The representative also expressed concern about the reliability of the new system in case of different applicants for different designated States or in case of multiple divisional applications divided from an international application which had entered the national phase, and suggested that a central register of ownership details would be desirable.

“119. Delegations were generally content with the proposal that the applicant's request to the International Bureau could be made in either English or French, but some expressed the view that the communication from the International Bureau to the designated Office would need to be in a language accepted by the Office. It was noted that this difficulty would be largely overcome by use of forms using standard language which could be translated into several languages. Delegations of two Contracting States whose official languages used alphabets other than the Latin alphabet stressed the need for translations.

“120. One delegation expressed the view that, even if the applicant could make a request for recording of a change centrally to the International Bureau, each designated Office ought to notify the applicant when the change had actually been made.

“121. Some delegations stated that, in order for such a system to work reliably, appropriate information technology systems would be needed both at the International Bureau and at the designated Offices. One delegation suggested that the proposal might be premature in that the International Bureau had not yet completed its systems for processing PCT applications in electronic form in the international phase. A delegation from a developing country considered that technical assistance would be required in some cases to ensure that Offices had the necessary capacity to handle electronic files.”

7. The Annex to this document contains revised proposals, taking into account the discussions, and the agreement reached, at the sixth session, comments received on a preliminary draft document for the seventh session of the Working Group which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 5. The main features of the revised proposals are outlined in the following paragraphs.

RECORDING OF CERTAIN CHANGES BY THE INTERNATIONAL BUREAU DURING THE INTERNATIONAL PHASE AND THE NATIONAL PHASE OF PROCESSING

8. Noting the considerable support in the Working Group at its sixth session for further consideration of the concept of recording of changes by the International Bureau during the national phase, it is proposed to amend Rule 92bis so as to allow requests for recording of certain changes to be made not only during the international phase (before the expiration of 30 months from the priority date) but also during the national phase (after the expiration of 30 months from the priority date) in respect of designated or elected Offices before which national processing of the international application has started and has not yet been completed. The proposals would not, however, apply to granted patents.

9. Changes recorded under Rule 92bis would have, depending on their nature, either optional or automatic effect under the applicable national law of designated and elected Offices concerned (see paragraphs 21 to 27, below).

10. The possibility for the single recording of a change under Rule 92bis to have effect for the purposes of the national procedure before a number of designated and elected Offices would have clear advantages for applicants. It would allow an applicant to deal with one office, with one set of requirements, to make only one fee payment, and to file one request (or a limited number of requests) for the recording of changes in respect of all affected international applications filed by the same applicant. It would reduce administrative work for applicants, minimize the difficulties of working in various languages and of meeting different legal requirements, and reduce overall fees.

11. It is intended that this possibility would be an alternative to the existing possibility (which would be maintained) of filing separate requests directly with each designated and elected Office.

12. Concern was expressed by some delegations during the sixth session of the Working Group as to the legal basis in the Treaty for making Rules for procedures extending into the national phase of processing of international applications. Moreover, concerns have been expressed as to the basis in Article 58 for providing Rules concerning procedures for which there was no general basis in the substantive Articles of the Treaty (see paragraphs 111 and 112 of the Chair's summary, reproduced in paragraph 6, above).

13. It is to be noted that, while PCT procedures are principally concerned with the international phase, the Treaty and Regulations are not limited in their operation to that phase. Certain features of the Treaty and the Regulations deal specifically with matters obtaining long after the international phase is over. Those features include, for example, the fundamental principle that an international application has, for the purposes of the national law in all designated and elected States, the effect of a regular national application having as its filing date the international filing date accorded under the Treaty (see Article 11). Other such features relate to the opportunity to amend the application during the national phase (see Articles 28 and 41), to the prohibition against national requirements relating to the former contents different from or additional to those provided for in the Treaty and Regulations (see Article 27(1)), the provision of patent information services (see Article 50), and the furnishing by designated and elected Offices to the International Bureau, after the start of national processing, of copies of translations of the international application furnished by the applicant (see Rule 95).

14. Moreover, the proposals for recording of certain changes by the International Bureau after the expiration of 30 months from the priority date appear consistent with the objectives of the Treaty, as expressed in the preamble, in particular, the objective "to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries." To that extent, Article 58(1)(iii) would appear to provide a sufficient basis for providing Rules concerning procedures which would further those objectives.

REQUIREMENTS UNDER RULE 92 *BIS* AS PROPOSED TO BE AMENDED*Filing of Requests*

15. As at present, Rule 92 *bis* as proposed to be amended would allow applicant to submit a request for the recording of a change either directly to the International Bureau or to the receiving Office. In the latter case, the request would be considered to have been received by the receiving Office on behalf of the International Bureau, and the receiving Office would promptly transmit it to the International Bureau.

Indications Which May Be Changed

16. As at present, Rule 92 *bis* as proposed to be amended would provide for the recording of changes by the International Bureau in the following indications appearing in the request or the demand: the person, name, residence, nationality or address of the applicant; the person, name or address of the inventor; and the person, name or address of the agent or the common representative. In addition, Rule 92 *bis.1* as proposed to be amended would also provide for the recording of a change in the address for correspondence (as provided in PLTR Rule 15(8)).

Transliteration or Translation of Indications

17. Noting the concern expressed at the sixth session with regard to the need for translations or transliterations for designated or elected States whose official languages used alphabets other than the Latin alphabet, the revised proposals provide as follows:

(a) where the indications to be changed are written in characters other than those of the Latin alphabet, the applicant would be required to furnish the same in characters of the Latin alphabet, either as a mere transliteration or through translation into English;

(b) where, on the other hand, the indications to be changed are written in characters of the Latin alphabet and the applicant desires the change to be effective in a designated or elected State whose official language or languages use characters other than those of the Latin alphabet and which has notified the International Bureau of the need for a transliteration or translation, the applicant would be required to furnish the same indications also in those other characters, either as a mere transliteration or through translation into the language concerned;

(c) where the applicant does not furnish a required transliteration or translation, the International Bureau would nevertheless record the changes but, as far as designated or elected Offices which had notified the International Bureau of the need for a transliteration or translation are concerned, such changes would have effect only if so provided for under the applicable national law of the designated or elected Offices concerned; in other words, it would be a matter for the national law applicable by the designated or elected Office to provide whether, and under which circumstances, any such change would have effect under the national law applied by that Office.

Persons Entitled to Make Requests

18. As at present, under Rule 92 *bis* as proposed to be amended, a request for the recording of a change could be made: (i) in any case, by the applicant; (ii) in the case of a change in the person of the applicant, by the person seeking to be recorded as applicant ("the new applicant"); (iii) in the case of a change in the person of the agent or the common

representative pursuant to the renunciation of an appointment as agent or common representative, by the agent or the common representative concerned; and (iv) by the receiving Office acting pursuant to the applicable national law.

19. Where the request for the recording of a change in the person of the applicant was made by the new applicant, the International Bureau would continue to require, as at present, the furnishing of documentary evidence supporting the change before recording any such change. Furthermore, as at present, in such a case, where the previous applicant objects to the change in writing, any such change would be considered not to have been recorded. However, rather than leaving these important matters to the Administrative Instructions and the PCT Applicant's Guide, as is presently the case, it is proposed to clarify the practice in Rule 92bis itself.

Timing of Requests

20. Under Rule 92 bis as proposed to be amended, requests for recording of a change could be made before or after the expiration of 30 months.

Effect of Recorded Changes for the Purposes of National Procedure Before Designated and Elected Offices

21. At the sixth session of the Working Group, it was generally agreed that a system for the recording of certain changes with effect for the national procedure before designated and elected Offices should be introduced, but that it should be limited, at least at the outset, to changes in respect of which, in general, in line with PLTR Rule 15, no further documentary evidence supporting the change may be required, noting that it would be difficult to achieve agreement at this stage on the kind of evidence which should be required for other kinds of matter (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraph 115).

— *change in the name, address, nationality or residence of the applicant, or in the name or address of the inventor*

22. It is thus proposed that any change in the name, address, nationality or residence of the applicant, or in the name or address of the inventor (that is, any change concerning the applicant and the inventor, other than a change in the person of the applicant or in the person of the inventor) that is recorded by the International Bureau and notified to a designated or elected Office before the processing of the international application has started in that Office, or after such processing has started but before it has been completed, should in general have automatic effect under the applicable national law of the designated or elected Office concerned.

23. A change recorded by the International Bureau would not have effect in a designated or elected State if the designated or elected Office, a court or any other competent organ found that a requirement for the recording of the change by the International Bureau had not been complied with. However, no designated or elected Office would be permitted to review the decision by the International Bureau to record a change unless that Office may reasonably doubt the veracity of an indication contained in the request for recording of the change or of a supporting document or a translation thereof, in which case it would be required to invite the applicant to furnish evidence to it within a time limit which shall be reasonable under the circumstances.

24. A change recorded by the International Bureau would also not have effect in a designated or elected State in which the relevant provisions did not apply consequent to a notification that the provisions concerned were not compatible with its national law. It is to be understood that such reservation could be made in respect of changes recorded by the International Bureau based on requests by the applicant received before and/or after the expiration of 30 months from the priority date. It is suggested that this understanding be expressed by the Assembly in amending the Regulations. For example, where a designated or elected Office made use of the reservation provision in respect of changes recorded by the International Bureau based on request by the applicant received after the expiration of 30 months from the priority date, any such change recorded by the International Bureau concerning the name, address, nationality and residence of the applicant, or the name and address of the inventor would have no effect in respect of that Office, and the applicant would have to request the recording of the change, upon or after national phase entry, under the applicable national law of that Office. The Administrative Instructions would have to be modified so as to provide that, where the applicant nevertheless included any such Office in his request received by the International Bureau after the expiration of 30 months from the priority date, the International Bureau would be required to notify the applicant accordingly.

— *change in the person of the applicant or in the person of the inventor*

25. It is proposed that any change in the person of the applicant or in the person of the inventor (that is, changes in respect of which, in general, in compliance with PLTR Rule 16, further documentary evidence supporting the change may be required) which is recorded by the International Bureau and notified to a designated or elected Office before the processing of the international application has started in that Office, or after such processing has started but before it has been completed, would have effect only if so provided by the applicable national law of the designated or elected Office concerned. In other words, as at present with regard to changes in the person of the applicant or the inventor recorded during the international phase, it would be a matter for the national law applicable by the designated or elected Office to provide whether, and under which circumstances, any such change would have effect under the national law applied by that Office.

26. Alternatively, the Working Group may wish to consider whether the Regulations under the PCT should be further aligned with the PLT by providing that a change in the person of the applicant or in the person of the inventor recorded by the International Bureau under Rule 92bis would, in general, have to be recorded by any designated or elected Office concerned, and would have effect under the applicable national law of that Office, provided that any such Office would be free to require, if it so wishes, (further) documentary evidence supporting the change, consistently with the corresponding provisions of PLTR Rule 16(2), (3) and (4), which would have to be incorporated into Rule 92bis accordingly (further amended so as to also apply to changes in the person of the inventor; as noted above, the PLT does not apply to changes in the person of the inventor).

— *change in the person, name and address of an agent or common representative, or of a change in the address for correspondence*

27. As regards changes in the person, name and address of an agent or common representative, or of a change in the address for correspondence recorded by the International Bureau under Rule 92bis, it is to be noted that agents and common representatives appointed to represent the applicant during the international phase usually are not, and cannot be, appointed to represent the applicant during the national phase before more than one of the

designated and deleted Offices. Similarly, an address for correspondence used for the purposes of international phase processing usually is not, and generally cannot be, used as an address for correspondence for the purposes of national phase processing before more than one of the designated and deleted Offices. While it is proposed to notify the designated or deleted Offices of any such change recorded by the International Bureau, noting that up-to-date information concerning agents, common representatives and address for correspondence may be of importance to designated or deleted Offices in order to be able to contact the applicant in the context of national phase entry, it is not proposed to require the designated or deleted Offices to record any such change. Any such change notified to a designated or deleted Office would have effect only if so provided under the applicable national law of the Office concerned.

Further Requirements

28. The requirements under Rule 92bis as proposed to be amended have been aligned to the corresponding requirements under PLTRules 15 and 16, respectively, in particular with regard to the contents of any request for the recording of a change, the requirements where a single request relates to more than one international application, the evidence which the International Bureau may require in support of a request of a change, and the invitation procedure where a request does not comply with the formal requirements. (Note, however, that the PLT does not apply to changes in the person, name or address of the inventor, or to changes in the person of the agent and common representative; see PLTRules 15 and 16).

Fees

29. It is proposed that the submission *before* the expiration of 30 months from the priority date of a request for the recording of a change under Rule 92bis would, as at present, not be subject to the payment of a fee, whereas the submission *after* the expiration of 30 months from the priority date would be subject to the payment of a fee, for the benefit of the designated or deleted Offices concerned by the change, and of the International Bureau.

30. Where the request for the recording of a change is made *before* the expiration of 30 months from the priority date, any designated or deleted Office would usually be notified of the recordal of such change at the same time as other documents required for the processing of the international application are communicated by the International Bureau to that Office under the International Bureau's "communication on request" system. Processing of the international application would thus start before that Office on the basis of the changes recorded by the International Bureau, so that it would not appear to be justified to subject the submission of such a request to the payment of a fee for the benefit of the designated or deleted Office concerned.

31. However, where the request for the recording of a change is made *after* the expiration of 30 months from the priority date, designated and deleted Offices would usually be notified of the recordal of such change only after the processing of the international application has started before designated or deleted Offices concerned, in which case it would appear justified to subject the submission of such a request to the payment of a fee for the benefit of the designated and deleted Offices concerned by the change. Moreover, since a request made after the expiration of 30 months would be after the expiration of the period within which the International Bureau usually processes the international application, it would appear justified to subject the submission of such a request also to the payment of a fee for the benefit of the International Bureau. It is thus proposed to fix, in the Administrative Instructions, a fee

which would consist of two components: a basic component for the benefit of the International Bureau, and an additional component for the benefit of the designated or elected Offices concerned by the change (not that any request for the recordal of a change submitted after the expiration of 30 months from the priority date would have to indicate the designated or elected Offices in respect of which the change is desired to be effective). Proposed modifications of the Administrative Instructions to fix the fee would, of course, be subject to consultations with all interested Offices and Authorities in accordance with Rule 89.2(b).

32. 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: ²

RECORDING OF CHANGES BY THE INTERNATIONAL BUREAU

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² 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 76

Translation of Priority Document;

Application of Certain Rules to Procedures Before Elected Offices

76.1, 76.2 and 76.3 [Remain deleted]

76.4 [No change]

76.5 *Application of Certain Rules to Procedures Before Elected Offices*

Rules 13 *ter.* 3, 22.1(g), 47.1, 49, 49 *bis*, ~~and~~ 51 *bis* and 92 *bis* shall apply, provided that:

[COMMENT: It is proposed to amend Rule 76.5 so as to ensure the application of Rule 92 *bis* to the procedures before elected Offices.]

(i) [No change] any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) to (v) [No change]

Rule 92 bis

**~~Recording of Changes in Certain Indications Concerning the Applicant, Inventor,
Agent, Common Representative and Address for Correspondence in the Request or the
Demand~~**

92 bis.1 ~~Recording of Changes in Indications in the Request or Demand by the International
Bureau~~

(a) The International Bureau shall, on ~~a the~~ request (“request for recording of a
change”) made in accordance with Rules 92 bis.2 and 92 bis.3, ~~of the applicant or the receiving
Office~~, record a change ~~changes~~ in any of the following indications appearing in the request
or demand:

(i) the person, name, residence, nationality or address of the applicant;

(ii) the person, name or address of the inventor;

(iii) the person, name or address of the agent ~~;~~ or the common representative ~~or the
inventor;~~

(iv) the address for correspondence .

(b) ~~[Deleted] 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.~~

92bis.2 Request for Recording of a Change

(a) A request for recording of a change may be made:

(i) in any case, by the applicant;

(ii) in the case of a change in the person of the applicant, by the person seeking to be recorded as applicant ("new applicant");

(iii) in the case of a change in the person of the agent or common representative pursuant to the renunciation of an appointment as agent or common representative, by the agent or common representative concerned;

(iv) by the receiving Office acting pursuant to the applicable national law.

[COMMENT: As under present Rule 92bis.1, it is proposed to continue to provide that a request for recording of a change may be made by the receiving Office so that effect can be given to decisions under the national law, for example, in disputes between parties as to ownership.]

(b) A request for recording of a change may be submitted to the International Bureau or to the receiving Office and may be submitted at any time, whether before or after the expiration of 30 months from the priority date. Where a request is submitted to the receiving Office, it shall be considered to have been received by that Office on behalf of the International Bureau.

[Rule 92bis.2(b), continued]

[COMMENT: The Administrative Instructions would have to be modified to provide that, where the request is received by the receiving Office on behalf of the International Bureau, that Office should mark the date of receipt on the request and promptly transmit it to the International Bureau.]

(c) A request for recording of a change shall indicate:

(i) the number of the international application concerned;

[COMMENT: See PLTR Rules 15(1)(ii) and 16(1)(ii).]

(ii) the relevant indication referred to in Rule 92bis.1 and details of the change;

and

[COMMENT: See PLTR Rules 15(1)(iii) and (iv).]

(iii) where the request is submitted after the expiration of 30 months from the priority date, the designated State or States in respect of which the change is desired to be effective;

and, where the request for recording of a change concerns the person of the applicant or the inventor, shall further indicate:

[Rule 92bis.2(c), continued]

(iv) the name and address of the person recorded as applicant or inventor, as applicable, prior to the change;

[COMMENT: See PLTRule 16(1)(iii).]

(v) the name, residence, nationality and address of the new applicant or the name and address of the person to be recorded as applicant;

[COMMENT: See PLTRule 16(1)(iv) and (vi).]

(vi) the date of the change;

[COMMENT: See PLTRule 16(1)(v).]

(vii) the basis for the change.

[COMMENT: See PLTRule 16(1)(vii).]

[Rule 92 bis. 2, continued]

(d) Where any indication referred to in Rule 92 bis. 1 is written in characters other than those of the Latin alphabet, the same shall also be indicated in characters of the Latin alphabet, either as a mere transliteration or through translation into English. Where any indication referred to in Rule 92 bis. 1 is written in characters of the Latin alphabet and the change is desired to be effective in respect of a designated Office which has informed the International Bureau under paragraph (e) that it requires that such indications be written in other characters, the same shall also be indicated in those other characters, either as a mere transliteration or through translation into the language concerned. The applicants shall decide which words will be merely transliterated and which words will be translated.

[COMMENT: See paragraph 17 in the main body of this document.]

(e) A designated Office which requires any indication referred to in Rule 92 bis. 1 to be written in characters other than those of the Latin alphabet, either as a mere transliteration or through translation into the official language, or one of the official languages, of the designated State concerned, shall inform the International Bureau accordingly. Any information received by the International Bureau shall be promptly published by the International Bureau in the Gazette.

[COMMENT: See paragraph 17 in the main body of this document.]

[Rule 92bis.2, continued]

(f) Where an indication is required under paragraph (c)(iii) as to the designated State or States in respect of which a change is desired to be effective but no such indication is contained in the request for recording of the change, that request shall be considered to indicate that it is in respect of all designations and elections in force in respect of the international application at the time when that request is submitted.

(g) The submission in accordance with Rule 90 of a document appointing an agent or a common representative, or revoking or renouncing such an appointment, shall be considered to be a request for recording of a change in the person of the agent or the common representative concerned.

[COMMENT: See present Section 425 of the Administrative Instructions. In the context of the proposed amendment of Rule 92bis, it is proposed to move the contents of present Section 425 of the Administrative Instructions to the Regulations so as to deal with all issues relating to the recording of changes in just one place. The Administrative Instructions would have to be modified accordingly.]

(h) A single request for recording of a change may be submitted in respect of:

(i) changes in more than one kind of indication;

(ii) a change relating to more than one international application, provided that, in respect of all of the applications concerned, the application numbers are separately indicated, the same person is applicant, and the same change is requested.

[Rule 92bis.2(h), continued]

[COMMENT: See PLTR Rules 15(3) and 16(5). Where a single request for recording of a change is filed relating to two or more international applications, the International Bureau would, of course, issue separate notifications under Rule 92bis.4(c) in respect of each international application concerned.]

92bis.3 Evidence; Translation; Fee

(a) Where a request for recording of a change in the person of the applicant is made by the new applicant, it shall be accompanied by documentary evidence of the change.

[COMMENT: See PLTR Rule 16(2).]

(b) The International Bureau may require the furnishing of documentary evidence, or of further documentary evidence where evidence has been furnished under paragraph (a), in support of a request for recording of a change where that Bureau may reasonably doubt the veracity of an indication contained in the request or of the evidence furnished under paragraph (a), or the accuracy of a translation thereof.

[COMMENT: See PLTR Rules 15(4) and 16(6).]

(c) The International Bureau may require the furnishing of a translation of any documentary evidence furnished under paragraph (a) or (b) that is not in the same language as the international application to which it relates or, where a translation of the international application has been furnished under Rule 12.3 or 12.4, in the language of that translation.

[Rule 92bis.3, continued]

(d) The submission after the expiration of 30 months from the priority date of a request for recording of a change may be subjected by the International Bureau to the payment of a special fee whose amount shall be fixed in the Administrative Instructions.

[COMMENT: See paragraphs 29 to 31 in the Introduction to this document.]

92bis.4 Processing of Requests for Recording of a Change

(a) Where a requirement under Rule 92bis.2 or 92bis.3 is not complied with, the International Bureau shall invite the person making the request for recording of a change to comply with that requirement, and to make observations, within two months from the date of the invitation, failing which the International Bureau shall refuse the request and shall notify that person accordingly, provided that a request shall not be refused merely because of non-compliance with Rule 92bis.2(d)(ii).

[COMMENT: See PLTR Rules 15(6) and 15(7), and PLTR Rule 16(8). With regard to the proviso at the end of paragraph (a), see paragraph 17 in the main body of this document.]

(b) Where the International Bureau, after considering evidence furnished under Rule 92bis.3(b), still reasonably doubts the veracity of an indication contained in the request for recording of a change, it shall refuse the request and shall notify the person making the request accordingly.

[Rule 92bis.4, continued]

(c) Where the International Bureau is satisfied that the requirements of Rules 92bis.2 and 92bis.3 are complied with, it shall promptly record the change concerned under Rule 92bis.1 and notify the receiving Office, the International Searching Authority, the International Preliminary Examining Authority, the designated Offices concerned, the applicant and, in the case referred to in Rule 92bis.2(a)(ii), the agent or common representative concerned, in accordance with the Administrative Instructions. Where the change concerns the person of the applicant, the International Bureau shall notify both the new applicant and the previously recorded applicant.

[COMMENT: The Administrative Instructions (see present Sections 422 and 425) would have to be modified to prescribe the details as to who (receiving Office, International Searching Authority, International Preliminary Examining Authority, designated/elected Offices, applicant and/or new applicant) should be notified of a change recorded by the International Bureau, depending on when (before or after the expiration of 30 months from the priority date) and in respect of which indication referred to in Rule 92bis.1 the request for recording of a change was made. Moreover, the Administrative Instructions would have to be modified to clarify that, where a single request for the recording of a change was filed in respect of multiple applications, the International Bureau would issue, if so desired by a designated or elected Office which was not yet bound by the Patent Law Treaty, separate notifications for each international application concerned by the change.]

(d) The International Bureau shall, upon the request of a designated Office receiving a notification under paragraph (c), transmit to it a copy of the request for recording of a change and of any documentary evidence or translation furnished under Rule 92bis.3.

[COMMENT: It is proposed to add paragraph (d) so as to make available to designated or elected Offices the necessary documentation for a review (in limited circumstances) under proposed new Rule 92bis.6 (see below).]

92bis.5 Objection to Change

Where the International Bureau has recorded a change under Rule 92bis.1 in the person of the applicant on the request of the new applicant but the person previously recorded as applicant, within two months from the date of the notification under Rule 92bis.4(c), submits a notice to the International Bureau objecting to the change, the change shall be considered as if it had not been recorded and the International Bureau shall further notify all of the addressees of that notification accordingly.

[COMMENT: See present Section 422bis of the Administrative Instructions. In the context of the proposed amendment of Rule 92bis, it is proposed to move the contents of present Section 422bis of the Administrative Instructions to the Regulations so as to deal with all issues relating to the recording of changes in just one place. It would appear that there is no need to extend the scope of proposed new Rule 92bis.5 beyond the case where an old applicant is, upon request of a new applicant, removed and replaced by the new applicant, noting that the present requirements as to representation and signatures would appear to ensure that that one (old) applicant cannot remove (all or any) other (old) applicants without their consent: where there is more than one applicant, any request for the recording of a change in the person of one of the applicants must be signed by, on behalf of, all applicants, including any applicant who is to be removed.]

92bis.6 Changes with Automatic Effect Under National Law

(a) A change in an indication referred to in Rule 92bis.1(i) or (ii) concerning the applicant or the inventor, other than a change in person, that is notified to a designated Office under Rule 92bis.4(c) shall, subject to paragraph (d), have effect in the designated State or States concerned, unless that Office or a court or any other competent organ of a contracting State finds that a requirement of Rule 92bis.2 or 92bis.3 was not complied with.

[COMMENT: See paragraphs 22 and 23 in the main body of this document.]

(b) A designated Office shall not review a decision of the International Bureau to record a change in an indication referred to in Rule 92bis.1(i) or (ii) concerning the applicant or the inventor, other than a change in person, that is notified to that Office under Rule 92bis.4(c) unless it may reasonably doubt the veracity of an indication contained in the request for recording of the change or of a supporting document or a translation thereof, in which case it shall invite the applicant to furnish evidence to it within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

[COMMENT: See paragraph 23 in the main body of this document. Note that the requirement for reasonable doubt applies only to designated or elected Offices and not to the courts or any other competent organs of a contracting State for the designated or elected States in order not to fetter the latter in the exercise of their discretion under national law.]

[Rule 92bis.6, continued]

(c) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) and (b) are not compatible with the national law applied by a designated Office, those paragraphs shall not apply to that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: See paragraphs 24 in the main body of this document.]

(d) Where a change referred to in paragraph (a) is notified to a designated Office which has informed the International Bureau under Rule 92bis.2(e) of the need for a transliteration or translation but the request for the recording of a change did not comply with Rule 92bis.2(d), that change need not be taken into account by that Office.

[COMMENT: See paragraph 17 in the main body of this document.]

92bis.7 Changes with Effect only if Provided by National Law

A change in an indication referred to in Rule 92bis.1(i) or (ii) concerning the person of the applicant or the inventor, or a change in an indication referred to in Rule 92bis.1(iii) or (iv) concerning the agent, the common representative or the address for correspondence, that is notified to a designated Office under Rule 92bis.4(b) shall have such effect, if any, as may be provided for under the applicable national law.

[Rule 92 bis.7, continued]

[COMMENT: See paragraphs 25 and 26 in the main body of this document. It would not appear necessary to add a reservation provision with regard to the possible incompatibility of proposed new Rule 92 bis.7 with the national law applicable by designated or elected Offices, since the effect of a change in an indication referred to in that Rule would only have such effect as may be provided for under the applicable national law.]

[End of Annex and of document]

WIPO



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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT
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RECTIFICATION OF OBVIOUS MISTAKES

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for amendment of the Regulations under the PCT relating to the rectification of obvious mistakes in international applications. The main aim of the proposals is to rationalize the operation of Rule 91 (presently entitled "Obvious Errors in documents") whose provisions are open to different interpretations and have at times led to strange and inconsistent decisions. The proposals would introduce more consistent practices in PCT Offices and Authorities and would bring PCT practice in line, to the extent possible, with the provisions of the PLT relating to rectification of mistakes.

2. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and the comments received on preliminary draft documents made available since then. The main differences in comparison with the proposals considered at the sixth session concern, in

¹ 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. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

particular: (i) the definition as to which mistakes are to be considered as being “obvious” and thus rectifiable; (ii) the question as to the emotional person who should understand what was intended by the applicant and who should make the finding whether the alleged mistake is obvious; and (iii) whether, and if so, to which extent, the competent authority should be able to rely on extrinsic documents when deciding whether to authorize the rectification of a mistake.

BACKGROUND

3. The Working Group, at its fifth and sixth sessions, considered proposals for amendment of the Regulations under the PCT relating to the rectification of obvious mistakes. The Working Group’s discussions at its previous (sixth) session (see document PCT/R/WG/6/12, paragraphs 43 to 57) are outlined in the following paragraphs:

“43. Discussions were based on document PCT/R/WG/6/3.

“44. There was a clear divergence of views among delegations as to the cases and circumstances in which mistakes in international applications and related documents should be rectifiable under Rule 91.

“45. After some discussion, the Working Group agreed that the Secretariat should further consider how to take this matter forward, taking into account the comments and suggestions noted in the following paragraphs, preferably by making use of the PCT Reform and PCT/MIA electronic forums.

“46. While there was some support for a liberal approach to the correction of obvious mistakes, several delegations considered that proposed amended Rule 91.1(c)(i) was too broad, feeling that mistakes which only became apparent as a result of a lengthy investigation were not appropriate for rectification under Rule 91.

“47. One delegation suggested that only mistakes in the request and other documents related to the procedure, but not in the description, claims and drawings, should be rectifiable under Rule 91, noting that mistakes in the description, claims and drawings could be corrected by way of amendments under Articles 19 and 34. It suggested that, since only *obvious* mistakes were rectifiable under Rule 91, it was not necessary that rectifications be physically entered in the application documents in order for their meaning to be known. The delegations suggested that providing for rectifications in the description, claims and drawings added complexity and placed an unnecessary burden on examining staff. It considered that, if rectifications of obvious mistakes in the description, claims and drawings were to be permitted, they should be limited to typographical and clerical mistakes which could be disposed of by clerical staff.

“48. A number of delegations and representatives of users pointed out that existing Rule 91 already permitted the rectification of obvious errors in the description, claims and drawings, and considered that it was in the interests of applicants, designated Offices (in particular smaller Offices) and third parties for any mistake, where rectifiable and noted at a sufficiently early stage, to be rectified by only one action in the international phase, thus having effect for the purposes of the procedure before all designated Offices. While some difficulties were seen with the current proposals, they represented an improvement on the current provisions, which were not clear enough to allow uniform interpretation.

“49. One delegation questioned the relationship between Rule 91 and other Rules offering correction procedures in the case of particular kinds of mistakes (such as Rule 26bis with regard to the correction of priority claims), and suggested that the more general Rule (Rule 91) should not apply where a more specialized Rule providing for correction was available.

“50. One delegation noted that the term “obvious” had a special connotation in connection with patent law, that is, in determining whether the invention involved an inventive step (see, for example, Article 33(1)), and suggested that it might be preferable to avoid use of that term in connection with the rectification of mistakes.

“51. Opinions differed on the extent to which extrinsic documents (that is, documents other than the one in which the mistake occurred) should be able to be relied upon in support of a request for rectification. It was noted that the application of two tests was involved: (i) the recognition that there was indeed a mistake, and (ii) an assessment as to whether the proposed rectification was the only meaning which could have been intended. Most delegations which spoke on the matter considered that the fact that there was a mistake needed to be apparent on the face of the document containing the mistake, without referring to extrinsic documents, but a few delegations felt that extrinsic documents should be able to be considered at least in the case of mistakes in the request form. Some delegations considered that the question whether nothing else could have been intended than what is offered as a rectification should also have to be answered without reference to extrinsic documents, but others considered that extrinsic documents should be able to be relied upon, at least in certain cases.

“52. Among those delegations which favored reliance on extrinsic documents, there was a divergence of views as to whether the list of such documents appearing in Rule 91.1(c)(ii) was appropriate for all situations and whether it should be seen as exhaustive. There was a widespread feeling that it would usually not be acceptable to refer to extrinsic documents in relation to mistakes in the description, claims and drawings. Some delegations considered that the kind of documents which should be accepted as evidence relating to a mistake should be determined by the competent authority, depending on the facts of the particular case. Others felt that documents already on the file of the international application should always be able to be considered, although one delegation expressed concern that such an approach might lead to a large amount of background art being filed with the international application in the hope that it might later be useful for attempting to introduce changes in the application.

“53. A number of delegations considered that it should be explicit in the Rule itself, rather than left to Guidelines, that a rectification was not permitted to go beyond the disclosure in the international application as filed. One delegation considered that this should be expressed as a limitation of the legal consequences of a rectification rather than as a component of the test for whether a mistake was obvious and thus rectifiable. It was noted that it may be necessary for a designated Office to have before it, when considering this issue, the application papers both as filed and as rectified.

“54. One representative of users expressed the view that the priority document, being a clearly established document of record referred to in the request, should be able to be taken into account in deciding whether there was a rectifiable mistake in the international application. While there was some support for this view, particularly in

relation to mistakes which had been introduced by errors in translation, most delegations which spoke on the matter considered that the description, claims and drawings should be viewed on their face in deciding whether there was a clear mistake. It was noted that a remedy in some cases might be available by way of provisions relating to “missing parts” (see documents PCT/R/WG/6/4 and 4 Add.1).

“55. There was wide agreement that the current wording providing that “anyone” would need to “immediately” recognize that nothing else could have been intended was incapable of literal application and should be reviewed. A number of delegations considered that references should be made to “the competent authority” rather than to “anyone.” One delegation suggested that the notional reader in all cases should be an average person with no special skills, and specifically that the application of Rule 91 should not require the involvement of patent examiners. Other delegations felt that rectification of mistakes in the description, claims and drawings should be dealt with by reference to a “person skilled in the art” and that the involvement of patent examiners was essential in relation to such rectifications.

“56. There were no objections to the notion of a single time limit for the requesting of rectifications (see proposed Rule 91.2(a)), but several delegations felt that 28 months from the priority date was too late to enable completion of all the necessary actions before the end of the international phase, noting, in particular, that the proposals envisaged the republication of the international application if the rectification of an obvious mistake was authorized after international publication.

“57. There was doubt expressed as to whether there was any benefit in allowing rectification of obvious mistakes in the description, claims and drawings during Chapter II proceedings, since such rectifications could in such cases be achieved by way of amendments under Article 34. In this connection, one delegation suggested that the time limit for requesting rectifications might appropriately be aligned with that for filing a demand for international preliminary examination.”

4. The Annex to this document contains revised proposals for amendment of the Regulations relating to the rectification of obvious mistakes, taking account of the suggestions made by delegations and representatives of users at the sixth session (see document PCT/R/WG/6/12, paragraphs 43 to 57, reproduced in paragraph 3, above) and comments received on a preliminary draft document for the seventh session of the Working Group which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 6. For information and clarity, the proposals for amendment of Rule 91 are presented both in the form of a marked-up text of Rule 91 as proposed to be amended (contained in Annex I) and in the form of a “clean” text of the Rule 91 as it would stand after amendment (contained in Annex II). The main features of the revised proposals are outlined in the following paragraphs.

RECTIFICATION OF OBVIOUS MISTAKES

Types of Rectifiable Mistakes

5. Existing Rule 91 permits the rectification of “obvious errors” in the description, claims and drawings, as well as in the more “formal” request part of the international application. It would appear to be in the interest of applicants, designated Offices (in particular smaller Offices) and third parties that any mistake, where rectifiable and noted as sufficiently early

stage, is rectified by only one action in the international phase, thus having effect for the purposes of the procedure before all designated Offices. It is thus not proposed, as had been suggested by one delegation during the sixth session of the Working Group (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraph 47), that only mistakes in the request and other documents related to the procedure, but not in the description, claims and drawings, should be rectifiable under Rule 91, or to limit rectifications of mistakes in the description, claims or drawings to typographical and clerical mistakes which could be disposed of by clerical staff.

Terminology

6. “*Rectification*.” Although the draft SPLT uses the term “correction” instead of “rectification” (see draft SPLT Article 7(3) and draft SPLT Rule 7(2)), it is proposed, as was proposed in document PCT/R/WG/6/3, to continue to use the term “rectification” so as to maintain the distinction, in the context of the PCT, between “rectifications” of obvious mistakes (under Rule 91), “amendments” of the description, claims or drawings (under Articles 19 and 34) and “corrections” of formal defects (under Article 14 and Rule 26).

Responsibility for Authorization of Rectification

7. *Competent authorities*. It is proposed, as in document PCT/R/WG/6/3, to make it clear which are the “competent authorities” responsible for authorizing the rectification of obvious mistakes appearing in the different elements of the international application and in related documents, bearing in mind the responsibilities of the different authorities in the different stages of the international phase. Under the proposals, the finding whether an alleged mistake is obvious and thus rectifiable would be made:

- (a) in the case of a mistake in the request part of the international application or in a correction thereof — by the receiving Office;
- (b) in the case of a mistake in the description, claims, drawings or abstract or in a correction thereof, or in an amendment under Article 19, unless the International Preliminary Examining Authority is competent under paragraph (c), below — by the International Searching Authority;
- (c) in the case of a mistake in the description, claims, drawings or abstract or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examinations shall start in accordance with Rule 69.1 has passed — by the International Preliminary Examining Authority;
- (d) in the case of a mistake in a document not referred to in paragraphs (a) to (c), above, submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau — by that Office, Authority or Bureau, as the case may be.

Rectification of "Obvious Mistakes"

8. *"Obvious" to the competent authority.* Upon consideration of the concern expressed by some delegations during the sixth session of the Working Group that mistakes which only became apparent as a result of a lengthy investigation were not appropriate for rectification under Rule 91 (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraph 46), it is proposed:

(a) to continue to use, as at present, the term "obvious" mistake, noting that the term "obvious" appears to best define and most clearly describe the kind of mistake that should be rectifiable under Rule 91, despite the fact that it also has a special connotation in connection with the determination of inventive step (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraph 50);

(b) not to ascribe any special attributes to the person in the competent authority making the finding whether an alleged mistake is "obvious" and thus rectifiable, and to simply refer to "the competent authority."

9. *Extrinsic documents.* Opinions differed in the sixth session of the Working Group as to whether, and if so, to which extent, extrinsic documents (that is, documents other than the one in which the mistake occurred) should be able to be relied upon (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraphs 51, 52 and 54). Most delegations which spoke on the matter considered that the mistake and the rectification needed to be apparent on the face of the document containing the mistake, without referring to extrinsic documents (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraphs 51). Among those delegations which favored reliance on extrinsic documents in some circumstances, there was a widespread feeling that it would usually not be acceptable to refer to extrinsic documents in relation to mistakes in the description, claims, drawings and abstract (see the summary by the Chair of the sixth session, document PCT/R/WG/6/12, paragraphs 52).

10. It is therefore no longer proposed, as in document PCT/R/WG/6/3, that the competent authority should always be obliged to take into account, when making the finding whether an alleged mistake is "obvious", documents other than the document containing the mistake, irrespective of the question in which part of the international application the mistake occurred in. Under the revised proposal for an amendment of Rule 91 contained in the Annex, the question whether the competent authority could rely on extrinsic documents would depend on which part of the international application is involved:

(a) Where the mistake is in the description, claims, drawings or abstract or in a correction thereof, or in an amendment under Article 19 or 34, the finding by the competent authority whether an alleged mistake is obvious would have to be made only on the basis of all the international application itself and, where applicable, the correction or amendment concerned, without any possible reliance on extrinsic documents.

(b) Where the mistake is in the request part of the international application or in a correction thereof, or in a document referred to in paragraph 7(d), above, the finding by the competent authority would have to be made only on the basis of the international application itself and, where applicable, the correction concerned, or the document referred to in

paragraph 7(d), above, together with any other documents submitted with the request, correction or document, as the case may be, and any other document contained in the authority's international application file as at the applicable date referred to in paragraph 11, below. It is not proposed that extrinsic evidence should be able to be used in a more liberal way, as had been suggested in a comment received on the preliminary draft document for the seventh session of the Working Group which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 6, noting that that view did not find any support in other comments received.

11. *Applicable date*. As was already proposed in document PCT/R/WG/6/3, it is proposed that the applicable date to be used in determining the allowability of a rectification of a mistake should be:

(a) where the alleged mistake is in a part of the international application as filed — the international filing date; or

(b) where the alleged mistake is in a document other than the international application as filed, and including a correction or an amendment of the international application — the date on which the document containing the alleged mistake was received.

12. *Added matter*. At the sixth session of the Working Group, a number of delegations expressed the view that it should be explicit in Rule 91 itself, rather than left to PCT International Search and Preliminary Examination Guidelines, that a rectification was not permitted to go beyond the disclosure in the international application as filed. One delegation considered that this should be expressed as a limitation of the legal consequences of a rectification rather than as a component of the test for whether a mistake was obvious and thus rectifiable (see the summary of the session by the Chair, document PCT/R/WG/6/12, paragraph 53). A related question concerns the way in which the International Searching Authority would handle requests for rectification of obvious mistakes in Article 19 amendments, noting that the question of whether the amendments themselves add new matter may arise in the course of deciding whether a rectification should be authorized.

13. The rectification of obvious errors in the description, claims and drawings, and also (although rarely in practice) in Article 19 amendments, is of course provided for under the present provisions of Rule 91. It is proposed that procedures for handling such cases be addressed in the International Search and Preliminary Examination Guidelines, which need to be set up straight forward guidance to Authorities, taking into account the fact that Authorities' practices may vary somewhat. To attempt to deal with the matter expressly in the Rule itself would overburden what is intended to be a simple procedure for dealing with obvious mistakes.

Mistakes not Rectifiable Under Rule 91

14. *Omission of entire sheets, etc.* As in document PCT/R/WG/6/3, it is proposed to maintain the existing provision that the omission of an entire element or sheet shall not be rectifiable under Rule 91. In view of the proposal to provide expressly for the furnishing of missing parts of the description, claims or drawings (see PCT/R/WG/7 Paper No. 1 Rev.), it would not seem appropriate to change the existing provisions of Rule 91 in this respect. Furthermore, it is proposed to clarify what is meant by an "entire element" by referring expressly to the elements of the international application listed in Article 3(2) (request, description, claims, drawings and abstract).

15. *Mistakes in priority claims and corrections and additions thereof.* Upon consideration, it would not appear imperative to generally exclude particular kinds of mistakes from being rectifiable under Rule 91 where other, more specialized Rules offering correction procedures existed (for example, for the correction of priority claims under Rule 26*bis* or the correction of declarations under Rule 26*ter*), as had been suggested by one delegation at the sixth session of the Working Group (see the summary of the session by the Chair, document PCT/R/WG/6/12, paragraph 49). Noting that Rule 91, being the more general Rule, applies in particular circumstances only and to different kinds of mistakes than the more specialized Rules, it would appear justified, as at present, to apply Rule 91 (with one exception, see paragraph 16, below) in addition to other correction procedures, such as the correction procedures offered under Rule 26*bis* or 26*ter*.

16. However, so as not to add further complexity to the system with regard to the computation of time limits calculated on the basis of the priority date, it is proposed, as was already proposed in document PCT/R/WG/6/3, that a mistake in a priority claim or in a notice correcting or adding a priority claim (submitted under Rule 26*bis*) should not be rectifiable under Rule 91 where the rectification of such a mistake would cause a change in the priority date of the international application. Such a mistake should only be correctable by way of submitting a (further) notice of correction or addition under Rule 26*bis* of the priority claim in question, within the applicable time limit under that Rule.

17. There would appear, however, to be the need to fill a gap in the present Regulations with regard to the correction of a priority claim in the particular case where the Office of filing of the priority application corrects certain indications relating to the priority application, such as the date of filing of the priority application, only after the expiration of the time limit under Rule 26*bis*.1(a), that is, too late for the applicant to file a request for the correction of the priority claim, where the applicant had relied on the correctness of those indications and used them as the basis for the priority claim in the international application. Rule 91 would also appear not to be available in such a case, noting the requirements for the rectification of "obvious mistakes" under Rule 91.1(c) to (e) as proposed to be amended and the fact that Rule 91.1(f) as proposed to be amended expressly excludes mistakes in a priority claim from being rectifiable under Rule 91 where a rectification would cause a change in the priority date.

18. While it would not be desirable to allow the applicant to correct such a priority claim after the expiration of the time limit under Rule 26*bis*.1(a), noting the possible impact of a change in the priority date on the international procedure, and in particular on the result of the international search and the written opinion by the International Searching Authority, it is proposed to allow the applicant to request the International Bureau to publish information concerning the corrections made by the Office of filing of the priority application with a view to pursuing the matter further in the national phase before the designated or elected Offices. While the main reason for dealing with this matter relates to the occurrence of a defect attributable to an official error on the part of the authority responsible for issuing the priority document, there does not seem to be any reason to restrict the proposal to such a circumstance. A proposal to amend Rule 26*bis*.2 to enable the publication of information where the applicant wishes to add or correct a priority claim for any reason, but the time limit under Rule 26*bis*.1 has expired, is contained in Annex I.

Request for Rectification

19. *Timelimit; effect of authorization on written opinions and reports*. While there were no objections to the notion of a single timelimit for the requesting of rectifications (see proposed Rule 91.2(a)), several delegations at the sixth session of the Working Group felt that the proposed timelimit of 28 months from the priority date was too late to enable completion of all the necessary actions before the end of the international phase, in particular, republication of the international application where the rectification of an obvious mistake had been authorized (see the summary of the session by the Chair, document PCT/R/WG/6/12, paragraph 56). It is therefore proposed to set the timelimit for the requesting of rectifications at 26 months from the priority date, which should leave sufficient time for the International Bureau, following the competent authority's decision to authorize the rectification, to prepare for the "republication" of the international application (see paragraph 21, below).

20. In general, as outlined in document PCT/R/WG/6/3, it would appear not to be necessary to require a request for rectification of an obvious mistake be submitted before the International Searching Authority has begun to draw up the international search report or the written opinion or (under Chapter II) before the International Preliminary Examination Authority has begun to draw up the written opinion or the international preliminary examination report. Since a mistake may only be rectified if both the mistake and the rectification are obvious, a rectification should not affect the substance of any written opinion or report.

21. On the other hand, it is proposed to expressly provide that any rectification authorized after the International Searching Authority or the International Preliminary Examining Authority has begun to draw up a written opinion or a report would not need to be taken into account by that Authority for the purposes of establishing the opinion or the report in question. The International Searching Authority or the International Preliminary Examining Authority, as the case may be, would be required in such a case to indicate whether or not the rectification has been taken into account for the purposes of preparing the written opinion or report. Such information would then be published together with the rectification (either as part of the pamphlet or together with the statement reflecting all rectifications).

22. *Rectifications under Rule 91 and amendments under Article 34*. See the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 57. Upon further consideration, it is not proposed to require that, after the start of the international preliminary examination procedure, obvious mistakes be remedied not by way of rectification under Rule 91 but rather under Article 34, as was suggested at the sixth session of the Working Group. Rather, it is proposed to maintain, as under many national and regional laws, a clear legal distinction between amendments and rectifications, noting particularly that the rectification of an obvious mistake in the international application would be effective from the international filing date.

Authorization of Rectification

23. *Effect on written opinions and reports*. See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(i). With regard to the question of what, if any, further action would be necessary where a mistake in the international application, other

than therequest, is rectified after the International Searching Authority or the International Preliminary Examining Authority has begun to draw up the written opinion or any report, see paragraph 19, above.

24. *Effect on designated/elected Offices where national processing has started*. See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(g). It is proposed to expressly provide that the rectification of an obvious mistaken need not be taken into account by any designated or elected Office in which processing or examination of the international application has already started prior to the date on which the designated or elected Office is notified of the authorization of the rectification by the competent authority.

RECTIFICATION BY DESIGNATED OR ELECTED OFFICES OF ERRORS MADE BY THE RECEIVING OFFICE OR BY THE INTERNATIONAL BUREAU

25. At its fifth session, the Working Group invited the International Bureau to study suggestions that Rule 82ter be amended to require designated and elected Offices to rectify certain decisions taken by the receiving Office or the International Bureau during the international phase if that Office or the International Bureau accepted that the decision taken was in error (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraphs 110(a)). The Working Group also invited the International Bureau to study suggestions that Rule 82ter be amended to avoid designated and elected Offices having to decide disputes between the applicant and the receiving Office or the International Bureau as to whether certain decisions taken by the receiving Office or the International Bureau during the international phase were erroneous (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraphs 110(b)).

26. Upon further consideration, it seems that Rule 82ter does not need to be burdened with express provisions for review of decisions taken during the international phase under Rule 91.1. Rather, it appears preferable to leave the matter to designated and elected Offices to deal with under their general power to decide whether and on what basis to grant a patent, in the course of which it would be open to an Office to decide upon whether a given rectification (like an amendment) had been made in accordance with the Treaty, noting particularly the provisions of Article 26.

27. *The Working Group is invited to consider the proposals contained in the Annexes.*

[Annex follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

RECTIFICATION OF OBVIOUS MISTAKES

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² 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 11

Physical Requirements of the International Application

11.1 to 11.13 [No change]

11.14 *Later Documents*

Rules 10, and 11.1 to 11.13, a) also apply to any document — for example, [replacement sheets](#) ~~corrected pages~~, amended claims, translations — submitted after the filing of the international application.

[COMMENT: It is proposed to amend Rule 11.14 so as to align the terminology (“replacement sheets” instead of “corrected pages”) with that used in Rule 26.4, which applies *mutatis mutandis* under Rule 91.2(b) as proposed to be amended (see below).]

Rule 12

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

12.1 [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

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

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed amendment of Rule 91 (see below).]

(i) and (ii) [No change]

(c) [No change]

12.3 and 12.4 [No change]

Rule 26 bis

Correction or Addition of Priority Claim

26 bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct [a priority claim](#) or add a priority claim [to the request](#) by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

[COMMENT: It is proposed to amend Rule 26 bis.1(a) so as to clarify that any addition of a priority claim would be made “to the request”, as is the case also for any addition of declarations under present Rule 26 ter.1(a). In the context of “obvious mistakes,” the proposed amendment would also clarify that the receiving Office would be the competent authority to authorize the rectification of an obvious mistake made in a notice correcting or adding a priority claim (provided that such correction or addition would not cause a change in the priority date, in which case a rectification under Rule 91.1 would not be possible (see Rule 91.1(f)(ii) as proposed to be amended, below).]

(b) and (c) [No change]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

[COMMENT: The proposed amendment of the title of Rule 26bis.2 is consequential on changes proposed in document PCT/R/WG/7/3 (restoration of the right of priority) and on the proposed addition of paragraph (e) (see below).]

(a) to (c) [No change]

[COMMENT: No change is proposed to paragraphs (a) to (c) in the context of this document. See, however, amendments to paragraphs (a) to (c) proposed in document PCT/R/WG/7/3 (restoration of the right of priority).]

(d) [see document PCT/R/WG/7/3]

[COMMENT: The addition of a new paragraph (d) is proposed in document PCT/R/WG/7/3 (restoration of the right of priority).]

(e) Where the applicant wishes to correct or add a priority claim but the time limit under Rule 26 bis.1 has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, request the International Bureau to publish information concerning the matter, and the International Bureau shall promptly publish such information.

[COMMENT: See paragraphs 17 and 18 in the main body of this document. The Administrative Instructions might provide for a variable amount of the fee, depending on the volume of the information to be published, and for a waiver of the fee in cases where the applicant relied on information contained in the priority document, or information otherwise provided by the authority responsible for issuing the priority document, that later turned out to be erroneous.]

[26bis.3](#) [seedocumentPCT/R/WG/7/3]

[COMMENT: The addition of new Rule 26bis.3 is proposed in document PCT/R/WG/7/3 (restoration of the right of priority).]

Rule 48

International Publication

48.1 [No change]

[COMMENT: Not that amendments of Rule 48.1 are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8).]

48.2 *Contents*

(a) The publication of the international application ~~The pamphlet~~ shall contain:

[COMMENT: The proposed amendments of the chapeau of paragraph (a) are consequential on the proposed deletion of the term “pamphlet” throughout the Regulations (see Rule 48.1 as proposed to be amended in document PCT/R/WG/7/8 “international publication and PCT Gazette in electronic form”).]

(i) to (vi) [No change]

[COMMENT: Not that amendments of items (i) to (vi) are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8).]

(vii) where the request for publication under Rule 91.3(e) was received by the International Bureau before the completion of the technical preparations for international publication, any request for rectification of an obvious mistake, any reasons and any comments referred to in Rule 91.3(e) referred to in the third sentence of Rule 91.1(f) —;

[Rule 48.2(a), continued]

(viii) and (ix) [No change]

[COMMENT: Note that amendments of items (viii) and (ix) are proposed in the context of “international publication and PCT Gazette in electronic form” (seed document PCT/R/WG/7/8.)]

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26 *ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter*.1;

[COMMENT: Note that further amendments of item (x) are proposed in the context of “international publication and PCT Gazette in electronic form” (seed document PCT/R/WG/7/8.)]

(xi) any information concerning the authorization of a rectification of an obvious mistake referred to in the second sentence of Rule 91.3(b).

(b) to (h) [No change]

[COMMENT: Note that amendments of paragraphs (b), (f), (g) and (h) are proposed in the context of “international publication and PCT Gazette in electronic form” (seed document PCT/R/WG/7/8.)]

[Rule 48.2, continued]

(h-bis) If the authorization of a rectification of an obvious mistake in the international application referred to in Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications (containing any information referred to in paragraph (a)(xi)) shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2(b), as the case may be, and the front pages shall be republished.

(i) [No change]

[COMMENT: Note that the deletion of paragraph (i) is proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8).]

(j) If a request for publication under Rule 91.3(e) was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in that Rule shall be promptly published after the receipt of such request for publication, and the front pages shall be republished.

[COMMENT: The proposed amendments of Rule 48.2 are consequential on the proposed change of approach with regard to the time limit within which a request for rectification of a mistake may be made; see proposed new Rule 91.2(a), below.]

48.3 to 48.6 [No change]

[COMMENT: Note that Rule 48 is proposed to be further amended in the context of proposed amendments of the Regulations relating to missing elements and parts of the international application (seedocument PCT/R/WG/7/2), relating to the restoration of the right of priority (seedocument PCT/R/WG/7/3), relating to the publication in multiple languages (seedocument PCT/R/WG/7/4), relating to the international publication and PCT Gazette in electronic form (seedocument PCT/R/WG/7/8), and relating to the addition of Arabic as a language of publication (seedocument PCT/R/WG/7/10).]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 to 66.4*bis* [No change]

66.5 *Amendment*

Any change, other than the rectification of an obvious mistake ~~errors~~, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

[COMMENT: The proposed amendment of Rule 66.5 is consequential on the proposed amendment of Rule 91 (see below).]

66.6 to 66.9 [No change]

Rule 70

International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and subject to Rule 91.3(b), each replacement sheet containing the rectification ~~rectifications~~ of an obvious ~~mistake~~ ~~errors~~ authorized under Rule 91.1(b)(iii) ~~91.1(e)(iii)~~ shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Replacement sheets containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

(b) [No change]

70.17 [No change]

Rule 91 [marked -up copy]³

Rectification of Obvious Mistakes Errors in the
International Application and Other Documents

91.1 *Rectification of Obvious Mistakes*

(a) An obvious mistake ~~Subject to paragraphs (b) to (g) — *quater*~~, obvious errors in the international application or another document ~~other papers~~ submitted by the applicant may be rectified in accordance with this Rule if the applicant so requests.

(b) ~~(e)~~ The rectification of a mistake shall be subject to authorization by the “competent authority”, that is to say ~~No rectification shall be made except with the express authorization~~:

(i) in the case of a mistake ~~the receiving Office if the error is~~ in the request part of the international application or in a correction thereof ~~—~~ by the receiving Office;

(ii) in the case of a mistake in the description, claims, drawings or abstract ~~the International Searching Authority if the error is in any part of the international application~~ ~~other than the request~~ or in a correction thereof, or in an amendment under Article 19, unless the International Preliminary Examining Authority is competent under item (iii) ~~—~~ by the International Searching Authority; ~~or in any document papers submitted to that Authority,~~

³ A “clean” copy of the text of Rule 91 as it would stand after an amendment is contained in Annex II.

[Rule 91.1(b), continued]

[COMMENT: It is proposed to modify the Administrative Instructions to provide that, where the International Searching Authority receives a request for rectification of an obvious mistake, it should check with the International Bureau as to whether it is (still) the competent authority under item (ii) or whether the International Preliminary Examining Authority has become the competent authority under item (iii).]

(iii) in the case of a mistake in the description, claims, drawings or abstract ~~the International Preliminary Examining Authority if the error is in any part of the international application other than the request~~ or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examinations shall start in accordance with Rule 69.1 has passed ~~— by the International Preliminary Examining Authority; or in any document papers submitted to that Authority, —~~

(iv) in the case of a mistake in a document not referred to in items (i) to (iii) submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or of the International Bureau — by that Office, Authority or Bureau, as the case may be ~~if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau —~~.

[COMMENT: See paragraph 7 in the main body of this document. It is envisaged that the Administrative Instructions be modified to provide that, where the applicant has the choice of submitting a document either to the International Bureau or to the receiving Office or the International Preliminary Examining Authority, which would then forward it to the International Bureau, the “competent authority” for the purposes of Rule 91 would be the “final addressee” of the document, that is, the International Bureau.]

[Rule 91.1, continued]

(c) ~~(b)~~ The competent authority shall authorize the rectification under this Rule of a
mistake if, and only if, it is obvious to the competent authority that, as at the applicable date
under paragraph (e), something else was intended than what appears in the document
concerned and that nothing else could have been intended than the proposed rectification.
~~Errors which are due to the fact that something other than what was obviously intended was~~
~~written in the international application or other papers shall be regarded as obvious errors. The~~
~~rectification itself shall be obvious in the sense that anyone would immediately realize that~~
~~nothing else could have been intended than what is offered as rectification.~~

[COMMENT: See paragraphs 8 to 13 in the main body of this document.]

(d) In the case of a mistake in the description, claims, drawings or abstract or in a
correction or amendment thereof, the competent authority shall, for the purposes of
paragraph (c), only take into account the contents of the international application itself and,
where applicable, the correction or amendment concerned.

[COMMENT: See paragraphs 9 and 10(a) in the main body of this document.]

[Rule 91.1, continued]

(e) In the case of a mistake in the request part of the international application or a correction thereof, or in a document referred to in paragraph (b)(iv), the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the international application itself and, where applicable, the correction concerned, or the document referred to in paragraph (b)(iv), together with any other documents submitted with the request, correction or document, as the case may be, and any other document contained in the authority's international application file at the applicable date under paragraph (f).

[COMMENT: See paragraphs 9 and 10(b) in the main body of this document.]

(f) The applicable date for the purposes of paragraphs (c) and (e) shall be:

(i) in the case of a mistake in a part of the international application as filed — the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application — the date on which the document was submitted.

[COMMENT: See paragraph 11 in the main body of this document.]

[Rule 91.1, continued]

(g) (e) A mistake shall not be rectified under this Rule if:

(i) the mistake lies in the omission of one or more entire elements of the international application referred to in Article 3(2) or one or more entire sheets of the international application; or, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

(ii) the mistake lies in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that this paragraph shall not affect the operation of Rules 20.4, 20.5 and 26 bis.

[COMMENT: See paragraphs 14 and 15 in the main body of this document. See also proposed new Rule 26bis.2(e), above. Note that the reference to Rules 20.4 and 20.5 in the text of those Rules as proposed to be amended in document PCT/R/WG/7/2. Note further that the proposed deletion of the words “ even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable” is not intended to modify the principle but is merely a drafting change.]

[Rule 91.1, continued]

(h) ~~(d)~~ Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discover s ~~Rectification may be made on the request of the applicant. The authority having discovered~~ what appear to be a rectifiable obvious mistake in the international application or another document, it ~~an obvious error~~ may invite the applicant to ~~present a~~ request ~~for~~ rectification ~~as provided in paragraphs (e) to (g-*quater*)~~ under this Rule. ~~Rule 26.4 shall apply~~ *mutatis mutandis* ~~to the manner in which rectifications shall be requested.~~

[COMMENT: Clarification only. It is proposed to move the last sentence of present paragraph (d) to proposed new Rule 91.2(b) (see below).]

91.2 Requests for Rectification

A request for rectification under Rule 91.1 shall be submitted to the competent authority within 26 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation. Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the proposed rectification shall be indicated.

[COMMENT: See paragraphs 19 to 21 in the main body of this document. See also PLT Rule 18(1)(a)(i), (iii) and (iv). The indication under PLT Rule 18.1(a)(ii) (the number of the application or patent concerned) is not included here since the request for rectification must be in the form of, or accompanied by, a letter identifying the international application to which it relates (see PCT Rule 92.1(a)). The indication under PLT Rule 18.1(a)(v) (the name and address of the requesting party) is not included since rectification may be made only on

[Rule 91.2, continued]

the request of the applicant (see Rule 91.1(a) as proposed to be amended, above). Not that the furnishing of a "brief explanation" is at the option of the applicant, consistent with PLT Rule 18(5), which expressly prohibits PLT Contracting States to require compliance with formal requirements other than those referred to in PLT Rule 18(1) to (4).]

~~{91.1(g)} The authorization for rectification referred to in paragraph (c) shall, subject to paragraphs (g-bis), (g-ter) and (g-quater), be effective:~~

~~(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;~~

~~(ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;~~

~~(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.~~

91.3 Authorization and Effect of Rectifications

(a) ~~{91.1}(f)~~ The competent authority shall promptly decide whether to authorize or
refuse to authorize a rectification under Rule 91.1 and ~~Any authority which authorizes or~~
~~refuses any rectification~~ shall promptly notify the applicant and the International Bureau of
the authorization or refusal and, in the case of refusal, of the reasons therefor. The
International Bureau shall proceed as provided for in the Administrative Instructions. ~~The~~
~~authority which authorizes a rectification shall promptly notify the International Bureau~~
~~accordingly.~~

[COMMENT: The proposed amendments would align the wording with that used elsewhere in the amended Rule. The Administrative Instructions would have to be modified to require the International Bureau to notify the receiving Office, the International Searching Authority and/or the International Preliminary Examining Authority, and the designated and elected Offices accordingly, as required by the circumstances.]

(b) The rectification under Rule 91.1 of an obvious mistake need not be taken into
account by the International Searching Authority for the purposes of the international search
report or the written opinion by that Authority, or by the International Preliminary Examining
Authority for the purposes of a written opinion by that Authority or the international
preliminary examination report, if the Authority concerned gives, or is notified of, the
authorization of the rectification after it has begun to draw up the written opinion or report
concerned. The notification under paragraph (a) shall include information as to whether the
rectification has been or will be taken into account.

[COMMENT: See paragraph 21 of the main body of this document.]

[Rule 91.3, continued]

(c) Where the rectification of an obvious mistake has been authorized under Rule 91.1, the document concerned shall be rectified in accordance with the Administrative Instructions.

[COMMENT: Sections 325, 413, 511 and 607 of the Administrative Instructions would have to be modified.]

(d) Where the rectification of a obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application as filed, from the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which that document was submitted.

[COMMENT: Proposed new paragraph (d) would clearly spell out the effective date of a rectification once authorized. It is proposed to modify the Administrative Instructions to provide that, where an international application has been transmitted to the International Bureau as receiving Office under Rule 19.4 because the Office with which the application was originally filed found that it was not competent to receive it, but as subsequent rectification under Rule 91.1 would retrospectively make the Office competent, the international applications should continue to be processed by the International Bureau.]

[Rule 91.3, continued]

(e) ~~[91.1](f)~~ Where the competent authority refuses to authorize rectification under Rule 91.1 authorization of the rectification was refused, the International Bureau shall, upon request submitted to it ~~made~~ by the applicant within two months from the date of the refusal, ~~prior to the time relevant under paragraph (g — bis), (g — ter) or (g — quater)~~ and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of the request , reasons and comments (if any) ~~for rectification~~ shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: Under paragraph (e) as proposed to be amended, upon request of the applicant, the International Bureau would publish information with regard to a request for rectification which was refused by the International Preliminary Examining Authority, even if the request for publication is received after international publication. This would fill a gap which exists under the present Regulations: under present Rule 91.1(f), any request for publication of information with regard to a refused request for rectification has to be received by the International Bureau prior to completion of technical preparations for international publication. In practice, this means that information concerning a request for rectification which has been refused by the International Preliminary Examining Authority after international publication is neither published nor mentioned in the international preliminary examination report: only authorized rectifications are annexed to that report (see present Rule 70.16; see also Rule 70.16 as proposed to be amended, above). One comment received on the preliminary draft made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 6 suggested that it would be better to make the reasons and comments available by way of file inspection rather than publication (if possible with the application). Such an approach would certainly be appropriate when suitable on-line file inspection and publication systems have been introduced, but pending the development of such systems, it seems preferable to publish the information as at present in order to ensure that the information concerned is made available to designated and elected Offices in the most convenient way.

[Rule 91.3, continued]

(f) The rectification of an obvious mistake need not be taken into account by any designated Office in which the processing or examination of the international application has already started prior to the date on which that Office is notified under Rule 91.3(a) of the authorization of the rectification by the competent authority.

[COMMENT: See paragraph h 24 in the main body of this document.]

~~{91.1}(g-bis) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.~~

~~{91.1}(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.~~

[Rule 91.3, continued]

~~[91.1](g-*quater*) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.~~

[Annex II follows]

ANNEXII

PROPOSEDAMENDMENTSOFTHEPCTREGULATIONS:

RECTIFICATIONOFO BVIOUSMISTAKES

RULE91“CLEANCOPY”⁴

Rule91[“clean”copy]RectificationofObviousMistakesintheInternational ApplicationandOtherDocuments	2
91.1 <i>RectificationofObviousMistakes</i>	2
91.2 <i>RequestsforRectification</i>	5
91.3 <i>AuthorizationandEffectofRectifications</i>	5

⁴ Comments on particular provisions appear only in the “marked -up” copy contained in Annex I.

Rule 91 [clean copy]

**Rectification of Obvious Mistakes in
the International Application and Other Documents**

91.1 *Rectification of Obvious Mistakes*

(a) An obvious mistake in the international application or another document submitted by the applicant may be rectified in accordance with this Rule if the applicant so requests.

(b) The rectification of a mistake shall be subject to authorization by the “competent authority”, that is to say:

(i) in the case of a mistake in the request part of the international application or in a correction thereof — by the receiving Office;

(ii) in the case of a mistake in the description, claims, drawings or abstract or in a correction thereof, or in an amendment under Article 19, unless the International Preliminary Examining Authority is competent under item (iii) — by the International Searching Authority;

(iii) in the case of a mistake in the description, claims, drawings or abstract or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examinations shall start in accordance with Rule 69.1 has passed — by the International Preliminary Examining Authority;

[Rule 91.1(b), continued]

(iv) in the case of a mistake in a document not referred to in items (i) to (iii) submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau — by that Office, Authority or Bureau, as the case may be.

(c) The competent authority shall authorize the rectification under this Rule of a mistake if, and only if, it is obvious to the competent authority that, as at the applicable date under paragraph (e), something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification.

(d) In the case of a mistake in the description, claims, drawings or abstract or in a correction or amendment thereof, the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the international application itself and, where applicable, the correction or amendment concerned.

(e) In the case of a mistake in the request part of the international application or in a correction thereof, or in a document referred to in paragraph (b)(iv), the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the international application itself and, where applicable, the correction concerned, or the document referred to in paragraph (b)(iv), together with any other documents submitted with the request, correction or document, as the case may be, and any other document contained in the authority's international application file at the applicable date under paragraph (f).

[Rule 91.1, continued]

(f) The applicable date for the purposes of paragraphs (c) and (e) shall be:

(i) in the case of a mistake in a part of the international application as filed — the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application — the date on which the document was submitted.

(g) A mistake shall not be rectified under this Rule if:

(i) the mistake lies in the omission of one or more entire elements of the international application referred to in Article 3(2) or one or more entire sheets of the international application; or

(ii) the mistake lies in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that this paragraph shall not affect the operation of Rules 20.4, 20.5 and 26bis.

[Rule 91.1, continued]

(h) Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or another document, it may invite the applicant to request rectification under this Rule.

91.2 *Requests for Rectification*

A request for rectification under Rule 91.1 shall be submitted to the competent authority within 26 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation. Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the proposed rectification shall be indicated.

91.3 *Authorization and Effect of Rectifications*

(a) The competent authority shall promptly decide whether to authorize or refuse to authorize a rectification under Rule 91.1 and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. The International Bureau shall proceed as provided for in the Administrative Instructions.

[Rule 91.3, continued]

(b) The rectification under Rule 91.1 of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search report or the written opinion by that Authority, or by the International Preliminary Examining Authority for the purpose of a written opinion by that Authority or the international preliminary examination report, if the Authority concerned gives, or is notified of, the authorization of the rectification after it has begun to draw up the written opinion or report concerned. The notification under paragraph (a) shall include information as to whether the rectification has been or will be so taken into account.

(c) Where the rectification of an obvious mistake has been authorized under Rule 91.1, the document concerned shall be rectified in accordance with the Administrative Instructions.

(d) Where the rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application as filed, from the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which that document was submitted.

[Rule 91.3, continued]

(e) Where the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall, upon requests submitted to it by the applicant within two months from the date of the refusal, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of the request, reasons and comments (if any) shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

(f) The rectification of an obvious mistake need not be taken into account by any designated Office in which the processing or examination of the international application has already started prior to the date on which that Office is notified under Rule 91.3(a) of the authorization of the rectification by the competent authority.

[End of Annex II and of document]

WIPO



PCT/R/WG/7/8
ORIGINAL:English
DATE:April5,2005

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
Geneva, Ma y 25 to 31, 2005

INTERNATIONAL PUBLICATION AND PCT GAZETTE IN ELECTRONIC FORM

Document prepared by the International Bureau

SUMMARY

1. The proposals contained in this document are designed to implement publication in electronic form of international applications and of the PCT Gazette. The proposals, which involve amendment of the PCT Regulations¹, are complementary to modifications of the Administrative Instructions that were promulgated with effect from April 1, 2005. The main change would be that the legally determinative means of publication of international applications and the Gazette would be publication in electronic form rather than on paper as at present. Amendments of the Regulations are proposed and practical aspects of the new approach are explained.

¹ 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.

PUBLICATION OF THE PCT GAZETTE IN ELECTRONIC FORM

Background

2. Pursuant to Article 55(4) and Rule 86.1(a), the International Bureau is required to publish a Gazette which shall contain:

(i) for each published international application, the bibliographic data, the drawing (if any) appearing on the front page of the pamphlet and the abstract;

(ii) the schedule of fees payable to Offices and Authorities;

(iii) notices the publication of which is required under the Treaty or the Regulations;

(iv) information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned;

(v) any other useful information prescribed by the Administrative Instructions, provided access to such information is not prohibited under the Treaty or the Regulations.

3. At present, the International Bureau fulfills its legal obligation under Article 55(4) to publish a Gazette by way of publication in two different forms: as a Gazette in *paper form* and as a Gazette in *electronic form* (see Rule 86.1(b)).

Gazette in Paper Form

4. The *Gazette in paper form* (hereinafter referred to as “the paper Gazette”) is published by the International Bureau on a weekly basis. Each issue contains the content prescribed by Rule 86.1(b)(i)—that is, the bibliographic data in respect of each international application published that week as referred to in paragraph 2(i), above, but without the drawing or abstract, as well as the matters referred to in paragraph 2(ii) to (v), above. The paper Gazette is presented in four Sections as follows:

(i) Section I contains the bibliographic data in respect of each international application published in the week covered by the Gazette;

(ii) Section II contains notices and information relating to published international applications (such as announcements of the later publication of amended claims under Article 19; and announcements of later publication of international search reports);

(iii) Section III contains weekly indexes of international application numbers and corresponding international publication numbers, of names of applicants and corresponding international publication numbers, and of international publication numbers grouped according to International Patent Classification symbols;

(iv) Section IV contains notices and information of a general character (such as notices the publication of which is required under the Treaty or the Regulations, information on Contracting States and intergovernmental organizations, and fees payable).

5. At present, the paper Gazette is mailed, on a weekly basis, to about 180 subscribers. These include International Searching and Preliminary Examining Authorities and national and regional Offices who, under Rule 87, are entitled to receive one or more copies of the Gazette free of charge, as well as about 150 paying subscribers, including a variety of public and private sector entities and individuals, with a broad geographical distribution.

6. Over the last four years, the number of paid subscriptions to the paper Gazette has significantly declined, as illustrated in Figure 1 appearing in Annex II to this document. The income generated by subscriptions to the paper Gazette has, since at least 2001, failed to cover the cost to WIPO of producing it, as illustrated in Table 1 appearing in Annex II to this document.

Gazette in Electronic Form

7. The *Gazette in electronic form* (hereinafter referred to as “the electronic Gazette”) is made available through the Internet via WIPO’s website.² The electronic Gazette contains not only the content prescribed by Rule 86.1(b)(ii) (that is, bibliographic data, drawing and abstract in respect of each international application published in the week covered by the Gazette) but, in effect, functions as a searchable Intellectual Property Digital Library (IPDL), containing data relating to international applications published, in the form of pamphlets, since January 1997. Bibliographic data, abstracts, drawings and images of pamphlets are provided in the IPDL for all published international applications. In addition, for international applications published since April 1998, the description and claims are also provided as searchable text.

8. Concurrent with the decrease in subscriptions to the paper Gazette, interest in the electronic Gazette has greatly increased, as illustrated in Figure 2 appearing in Annex II to this document.

Other Gazette -Related Electronic Products

9. An electronic version (in PDF format) of the paper Gazette is available, free of charge, via WIPO’s website for browsing, downloading and selective printing.

10. In addition, a private sector publisher produces, in close cooperation with WIPO, a CD-ROM version of the Gazette in PDF format which contains the same data as published in the electronic Gazette as well as elements from the paper Gazette (Sections II, III and IV, as referred to in paragraph 4, above). The CD-ROM version, which is published weekly with cumulative contents (including all previous issues during the same calendar year), is available by way of annual subscription. Although the CD-ROM is not an official WIPO product, the International Bureau purchases subscriptions to the CD-ROMs from the publisher and distributes them to over 40 national and regional Offices of PCT Contracting States free of charge.

² See <http://www.wipo.int/pct/en/gazette/index.jsp>

Proposed Amendment of Rule 86

11. Noting that:

(i) today, electronic means of publication (Internet and physical media such as CD and DVD) are increasingly being used by patent Offices to fulfill their legal obligation to publish applications and official notifications; -R

(ii) there has been a significant decrease in subscriptions to the paper Gazette in the last years and a concurrent increase in hits to the electronic Gazette;

(iii) as the paper Gazette is not text searchable, its usefulness for users (Offices and others) is therefore limited; and

(iv) the income generated by subscriptions to the paper Gazette has not covered WIPO's cost of production in recent years;

it is proposed to amend the Regulation to enable the International Bureau to fulfill its legal obligation to publish a Gazette by way of publication in electronic form. A proposal to amend Rule 86 accordingly, and to move to the Administrative Instructions matters of detail concerning the form in which and the means by which the Gazette is published, is contained in Annex I to this document. The format and content of the proposed new version of the electronic Gazette are outlined in paragraphs 13 to 15, below.

12. If an Office or Authority preferred to receive the electronic Gazette on a physical medium rather than online via WIPO's website, the International Bureau would, aside from its legal obligation under Article 55(4) to publish a Gazette, continue to provide, under Rule 87 as proposed to be amended, a copy of the electronic Gazette on CD-ROM, free of charge, to that Office or Authority.

Format and Content of the Proposed Electronic Gazette

13. The electronic Gazette, in its current version, does not have an identical content to the paper Gazette. As explained in paragraph 7, above, the electronic Gazette contains the bibliographic data, drawing and abstract for each application (the elements required according to Rule 86.1(b)(ii)) but it does not contain the information published in Sections II to IV of the paper Gazette (the elements referred to in Rule 86.1(a)(ii) to (v)); those elements are provided only "unofficially" in the PDF version of the *Gazette in paper form*, see paragraph 9, above). It is therefore proposed to revise the electronic Gazette so as to include all of the data and information referred to in Rule 86.1(a)(ii) to (v). The proposed approach on how that data and information will be made available to users is described in the following paragraphs.

14. Apart from notices and information of general character published in Section IV, the Gazette is essentially a series of indexes that are intended to facilitate the retrieval of PCT data. Because of the different nature of data and information contained in the Gazette, it is felt advisable to publish application data (e.g., data referred to in Sections I, II and III) differently from notices and information of general character (as contained in Section IV).

15. Sections I, II and III would be made available through a searchable database that will be a revamped version of the current electronic Gazette. The indexes contained in Sections I and III are already available in the electronic Gazette and would only be subject to minor changes intended to make them more usable, such as the ability to generate lists ordered in the same way as Sections I and III of the current paper Gazette. The notices contained in Section II are partially available in the electronic Gazette, and this information would be completed and made searchable. Further technical details will be provided as further developments are made on this issue.

16. Notices and information of general character published in Section IV would also be made available in electronic form. Weekly updates would be published (as at present in the paper Gazette) and the collection of information published in Section IV would become searchable from within the electronic Gazette. Further technical details on the technical format of Section IV information and on the availability of historical information will be provided as further developments are made.

17. As at present, versions of the electronic Gazette in both English and French would be published at the same time (see present Rule 86.2(c) which, except for drafting changes, is not proposed to be amended).

18. Further details concerning the electronic Gazette will be provided to Offices and users of the system in the context of the consultations under Rule 89.2(b) of proposed modifications of the Administrative Instructions implementing Rule 86.1 as proposed to be amended.

PUBLICATION OF INTERNATIONAL APPLICATIONS IN ELECTRONIC FORM

19. Following consultations pursuant to Rule 89.2(b) with Offices, Authorities and users of the PCT system, Section 406 of the Administrative Instructions has been modified, with effect from April 1, 2005, so as to enable the International Bureau to fulfill its legal obligation under Article 21 to publish international applications by way of publication in electronic form. The wording of a number of provisions in the Regulations that were drafted in the context of paper publications systems need to be adapted to the new electronic environment.

20. Proposals to amend Rules 13 *bis*.4, 26 *bis*.2, 47.1, 48.1, 48.2, 86.1(a), 87 and 91.1 accordingly are contained in Annex I to this document. Explanations are set out in Annex II in comments relating to the provisions concerned. In particular, it is proposed to delete the term "pamphlet" throughout the Regulations, noting that the term "pamphlet", connoting paper publication, would appear to be misleading.

21. The Working Group is invited to consider the proposal contained in Annex I to this document.

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ³

INTERNATIONAL PUBLICATION AND PCT GAZETTE – ELECTRONIC FORM

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³ 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 13 bis

Inventions Relating to Biological Material

13 bis.1 to 13 bis.3 [No change]

13 bis.4 *References: Time Limit for Furnishing Indications*

(a) to (c) [No change]

(d) The International Bureau shall notify the applicant of the date on which it received any indication furnished under paragraph (a), and :

(i) if the indication was received before the technical preparations for international publication have been completed, publish the indication furnished under paragraph (a), and an indication of the date of receipt, together with the international application ~~indicate that date, and include the relevant data from the indication, in the pamphlet published under Rule 48~~ ;

[COMMENT: It is proposed to amend item (i) so as to further streamline the publication process by requiring the International Bureau to publish the indications furnished by the applicant under paragraph (a) rather than, as at present, “the relevant data from the indication”. Otherwise, the proposed amendments are consequential on the proposed deletion of the term “pamphlet” throughout the Regulations (see Rule 48 as proposed to be amended, below).]

(ii) [No change]

13 bis.5 to 13 bis.7 [No change]

Rule 26 bis

Correction or Addition of Priority Claim

26bis.1 [No change]

26bis.2 *Invitation to Correct Defects in Priority Claims*

(a) and (b) [No change]

(c) Where the receiving Office or the International Bureau has made a declaration under paragraph (b), the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning the priority claim which was considered not to have been made. A copy of that request shall be included in the communication under Article 20 ~~where a copy of the pamphlet is not used for that communication or~~ where the international application is not published by virtue of Article 64(3).

[COMMENT: The proposed amendments of Rule 26bis.2(c) are consequential on the proposed deletion of the term “pamphlet” throughout the Regulations and the deletion of (former) Rule 47.2(c) with effect from January 1, 2004. Rule 47.2(c) as in force until December 31, 2003, read: “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.” Not that it is also proposed in another document to amend Rule 26 bis in the context of “rectification of obvious mistakes” (see document PCT/R/WG/7/6).]

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) and (a-bis) [No change]

~~(a-ter) [Deleted] The notification under paragraph (a-bis) shall include any declaration referred to in Rule 4.17(i) to (iv), and any correction thereof under Rule 26ter.1, which was received by the International Bureau before the expiration of the time limit under Rule 26ter.1, provided that the designated Office has informed the International Bureau that the applicable national law requires the furnishing of documents or evidence relating to the matter to which the declaration relates.~~

[COMMENT: It is proposed to delete paragraph (a-ter) so as to no longer provide for a separate transmittal to particular designated Offices of declarations referred to in Rule 4.17(i) to (iv) but instead to publish any such declaration together with the international application, as is already the case in respect of a declaration referred to in Rule 4.17(v) (see Rule 48.2(a)(x) as proposed to be amended, below), thereby further streamlining the publication and communication procedures at the International Bureau.]

(b) to (e) [No change]

47.2 to 47.4 [No change]

[COMMENT: Note that it is also proposed in another document to amend Rule 47 in the context of “international publication in multiple languages” (see document PCT/R/WG/7/4).]

Rule 48

International Publication

48.1 *Form and Means*

(a) ~~[Deleted] The international applications shall be published in the form of a~~
~~pamphlet.~~


(b) The ~~particulars regarding the~~ form in which and the means by which international
applications are published ~~of the pamphlet and the method of reproduction~~ shall be governed
by the Administrative Instructions.

[COMMENT: See paragraph 19 in the Introduction to this document. Modified Section 406 of the Administrative Instructions, which entered into force on April 1, 2005, enable the International Bureau to fulfill its legal obligation under Article 21 to publish international applications by way of electronic means. It is thus proposed to delete the term "pamphlet" throughout the Regulations, noting that that term, connoting paper publication, would appear to be misleading.]

48.2 *Contents*

(a) The publication of the international application ~~The pamphlet~~ shall contain:

[COMMENT: The proposed amendments of the chapeau of paragraph (a) are consequential on the proposed deletion of the term "pamphlet" throughout the Regulations.]

(i) a standardized front page 

[Rule 48.2(a), continued]

(ii) the description ⁵;

(iii) the claims ⁵;

(iv) the drawings, if any ⁵;

(v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a); ~~the publication of the international search report in the pamphlet shall~~ all, ~~however, not be required to include the part of the international search report which contains~~ ~~only matter referred to in Rule 43 already appearing on the front page of the pamphlet,~~

[COMMENT: At present, the International Bureau always publishes the international search report without the front page of that report, noting that that part of the report contains only matter which already appears on the front page of the pamphlet. In order to further streamline the publication process at the International Bureau, it is proposed to always publish the international search report as established by the International Searching Authority, including the front page, and to amend item (v) accordingly.]

(vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4⁵;

(vii) any request for rectification referred to in the third sentence of Rule 91.1(f)⁵;

[Rule 48.2(a), continued]

(viii) the ~~relevant data from any~~ indications in relation to deposited biological material furnished under Rule 13bis separately from the description, together with an indication of the date on which the International Bureau received such indications ~~;~~

(ix) any information concerning a priority claim considered not to have been made under Rule 26 bis.2(b), the publication of which is requested under Rule 26 bis.2(c);~~;~~

(x) any declaration referred to in [Rule 4.17](#) ~~Rule 4.17(v)~~, and any correction thereof under Rule 26ter.1, which was received by the International Bureau before the expiration of the time limit under Rule 26 ter.1.

[COMMENT: The proposed amendments of item (viii) are consequential on the proposed amendments of Rule 13bis.4 (see the comment on that Rule, above). With regard to item (x), it is proposed to amend that item so as to no longer publish, together with the international application, only a declaration referred to in Rule 4.17(v) but any declaration referred to in Rule 4.17; in this context, see also Rule 47.1(a-ter), above, which is proposed to be deleted. The other proposed amendments of Rule 48.2 are consequential on the proposed deletion, throughout the Regulations, of the term “pamphlet”.]

(b) Subject to paragraph (c), the front pages shall include:

(i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions ~~;~~

[Rule 48.2(b), continued]

(ii) a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies ;

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first ;

(iv) an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter*.1.

(c) to (e) [No change]

(f) If the claims have been amended under Article 19, the publication of the international application shall contain ~~either~~ the full text of the claims both as filed and as amended ~~or the full text of the — claims as filed and specify the amendments —~~. Any statement referred to in Article 19(1) shall be included as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4. The date of receipt of the amended claims by the International Bureau shall be indicated.

[COMMENT: It is proposed to amend paragraph (f) so as further streamline the publication process and to align it with the existing practice of the International Bureau to always publish, if the claims have been amended under Article 19, the full text of the claims both as filed and as amended, rather than just the claims as filed and a “specification” of the amendments established by the International Bureau.]

[Rule 48.2(g), continued]

(g) If, at the time of the completion of the technical preparations for international publication, the international search report is not yet available ~~(for example, because of publication on the request of the applicant as provided in Articles 21(2)(b) and 64(3)(e)(i))~~, the front page pamphlet shall contain ~~in place of the international search report,~~ an indication to the effect that that report was not available and that ~~either the pamphlet (then also including the international search report) will be republished or~~ the international search report (when it becomes available) will be separately published together with a revised front page.

[COMMENT: It is proposed to amend paragraph (g) so as to further streamline the publication process and to align it with the existing practice of the International Bureau to always separately publish the international search report together with a revised front page rather than the entire pamphlet including the international search report where the search report was not available at the time of completion of technical preparations for international publication.]

(h) If, at the time of the completion of the technical preparations for international publication, the time limit for amending the claims under Article 19 has not expired, the front page pamphlet shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after receipt by the International Bureau of such amendments within the time limit under Rule 46.1, the full text of the claim as amended ~~either the pamphlet (containing the claims as amended) will be republished or a statement reflecting all the amendments~~ will be published together with a revised front page. ~~If in the latter case, at least the front page and the claims shall be republished and, if~~ a statement under Article 19(1) has been filed, that statement shall be published as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4.

[Rule 48.2(h), continued]

[COMMENT: It is proposed to amend paragraph (h) so as to further streamline the publication process and to enable the International Bureau to publish, if the claims have been amended under Article 19 after completion of technical preparations for international publication but within the time limit under Rule 46.1, the full text of the claims as amended, together with a revised front page, rather than the entire pamphlet containing the claims as amended.]

(i) ~~[Deleted] The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g) and (h) shall apply. Such determinations shall depend on the volume and complexity of the amendments and/or the volume of the international application and the cost factors.~~

[COMMENT: The proposed deletion of paragraph (i) is consequential on the proposed amendment of paragraphs (g) and (h).]

48.3 to 48.6 [No change]

[COMMENT: Note that Rule 48 is proposed to be further amended in the context of proposed amendments of the Regulations relating to missing elements and parts of the international application (see document PCT/R/WG/7/2), relating to the restoration of the right of priority (see document PCT/R/WG/7/3), relating to the publication in multiple languages (see document PCT/R/WG/7/4), relating to the rectification of obvious mistakes (see document PCT/R/WG/7/6), and relating to the addition of Arabic as a language of publication (see document PCT/R/WG/7/10).]

Rule 86

The Gazette

86.1 *Contents ~~and Form~~*

~~(a)~~ The Gazette referred to in Article 55(4) shall contain:

(i) for each published international application, the data specified by the Administrative Instruction taken from the front page of the [publication of the international application pamphlet published under Rule 48](#), the drawing (if any) appearing on the said front page, and the abstract ;

(ii) the schedule of all fees payable to the receiving Offices, the International Bureau, and the International Searching and Preliminary Examining Authorities ;

(iii) notice of the publication of which is required under the Treaty or these Regulations ;

(iv) information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned ;

[Rule 86.1, continued]

(v) any other useful information prescribed by the Administrative Instructions, provided access to such information is not prohibited under the Treaty or these Regulations.

[COMMENT: The proposed amendments of paragraph (a) are consequential on the proposed deletion of paragraph (b) (see below) and the proposed deletion, throughout the Regulations, of the term “pamphlet” (see the comment on Rule 48.1 as proposed to be amended, above).]

(b) ~~[Deleted] The information referred to in paragraph (a) shall be made available in two forms:-~~

~~(i) as a Gazette in paper form, which shall contain the data specified by the Administrative Instruction taken from the front page of the pamphlet published under Rule 48 (“bibliographic data”) and the matters referred to in paragraph (a) (ii) to (v);~~

~~(ii) as a Gazette in electronic form, which shall contain the bibliographic data, the drawing (if any) appearing on the said front page, and the abstract.~~

[COMMENT: See paragraphs 11 to 17 in the main body of this document.]

86.2 Languages; Form and Means of Publication ~~Access to the Gazette~~

(a) The Gazette shall be published in English and French at the same time. The translations shall be ensured by the International Bureau in English and French. The International Bureau shall ensure that the publication of the Gazette shall be effected on, or as soon as possible after, the date of publication of the international application. ~~The Gazette in paper form shall be published in a bilingual (English and French) edition. It shall also be published in editions in any other language, provided the cost of publication is assured through sales or subventions.~~

[COMMENT: See paragraphs 11 to 17 in the main body of this document. It is proposed to amend the text of present paragraph (c) (see below) and to move that text to paragraph (a); the present text of paragraph (a) is proposed to be deleted, consequential on the proposed discontinuation of the paper Gazette.]

(b) [No change] The Assembly may order the publication of the Gazette in languages other than those referred to in paragraph (a).

(c) The form in which and the means by which the Gazette is published shall be governed by the Administrative Instructions. ~~The Gazette in electronic form referred to in Rule 86.1(b)(ii) shall be made accessible in English and French at the same time, by any electronic ways and means specified in the Administrative Instructions. The translations shall be ensured by the International Bureau in English and French. The International Bureau shall ensure that the making accessible of the Gazette in electronic form shall be effected on, or as soon as possible after, the date of publication of the pamphlet containing the international application.~~

[Rule 86.2(c), continued]

[COMMENT: The Administrative Instructions would have to be modified to provide details concerning the publication of the Gazette in electronic form. The text of present paragraph (c) is proposed to be amended and moved to paragraph (a) (see above).]

86.3 [No change] *Frequency*

The frequency of publication of the Gazette shall be determined by the Director General.

86.4 [No change] *Sale*

The subscription and other sale prices of the Gazette shall be determined by the Director General.

[COMMENT: While the legal publication of the Gazette for the purposes of Article 55(4) will be effected by making the Gazette in electronic form available online, free of charge, via WIPO's website, it would appear that Rule 86.4 is still needed in respect of the envisaged sale to the general public of related products, such as the Gazette on CD-ROM.]

86.5 [No change] *Title*

The title of the Gazette shall be determined by the Director General.

86.6 [Nochange] *FurtherDetails*

FurtherdetailsconcerningtheGazettemaybeprovide dforintheAdministrative
Instructions.

Rule 87

Communication ~~Copies~~ of Publications

87.1 Communication of Publications on Request ~~International Searching and Preliminary Examining Authorities~~

The International Bureau shall communicate ~~Any International Searching or Preliminary Examining Authority shall have the right to receive~~ ~~—~~, free of charge, ~~two copies of~~ every published international application, ~~of the Gazette~~ ; and ~~of any other publication of~~ general interest published by the International Bureau in connection with the Treaty or these Regulations, to International Searching Authorities, International Preliminary Examining Authorities and national Offices upon request by the Authority or Office concerned ~~—~~. Further details concerning the form in which and the means by which publications are communicated shall be governed by the Administrative Instructions.

[COMMENT: It is proposed to amend Rule 87.1, whose present wording would appear to connote paper publication. The Administrative Instructions would have to be modified to provide for the details concerning the form in which and the means by which the International Bureau would communicate publications to Authorities and national Offices. Aside from its legal obligation, under Rules 48.1 and 86.1 as proposed to be amended, to publish international applications and the Gazette (publication would be effected by making international applications and the Gazette in electronic form available online, free of charge, via WIPO's website), it is envisaged that the International Bureau would, on request, continue to provide a copy in electronic form of any published international application and of the Gazette on a physical data carrier (such as CD-R or DVD), and a copy of any published international application on paper.]

87.2 ~~[Deleted]~~ *National Offices*

~~(a) Any national Office shall have the right to receive, free of charge, one copy of every published international application, of the Gazette, and of any other publication of general interest published by the International Bureau in connection with the Treaty or these Regulations.~~

~~(b) The publications referred to in paragraph (a) shall be sent on special request. If any publication is available in more than one language, the request shall specify the language or languages in which it is desired.~~

[COMMENT: The communication of publications to national Offices is dealt within Rule 87.1 as proposed to be amended (see above).]

Rule 91

Obvious Errors in Documents

91.1 Rectification

(a) to (e) [No change]

(f) Any authority which authorizes or refuses any rectifications shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor.

The authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (g-bis), (g-ter) or (g-quater) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification together with the international application. A copy of the request for rectification shall be included in the communication under Article 20 ~~where a copy of the pamphlet is not used for~~ ~~that communication or~~ where the international application is not published by virtue of Article 64(3).

[COMMENT: The proposed amendments of paragraph (f) are consequential on the proposed deletion of the term "pamphlet" throughout the Regulations and the deletion of (former) Rule 47.2(c) with effect from January 1, 2004. Rule 47.2(c) as in force until December 31, 2003, read: "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." Note that it is also proposed in another document to amend Rule 91 in the context of "rectification of obvious mistakes" (see document PCT/R/WG/7/6).]

[Rule 91.1, continued]

(g) to (g -quater) [No change]

[Annex II follows]

ANNEXII

STATISTICSRELATEDTOTHEPCTGAZETTE

Figure 1: Evolution of the number of paid subscriptions to Gazette in paper form

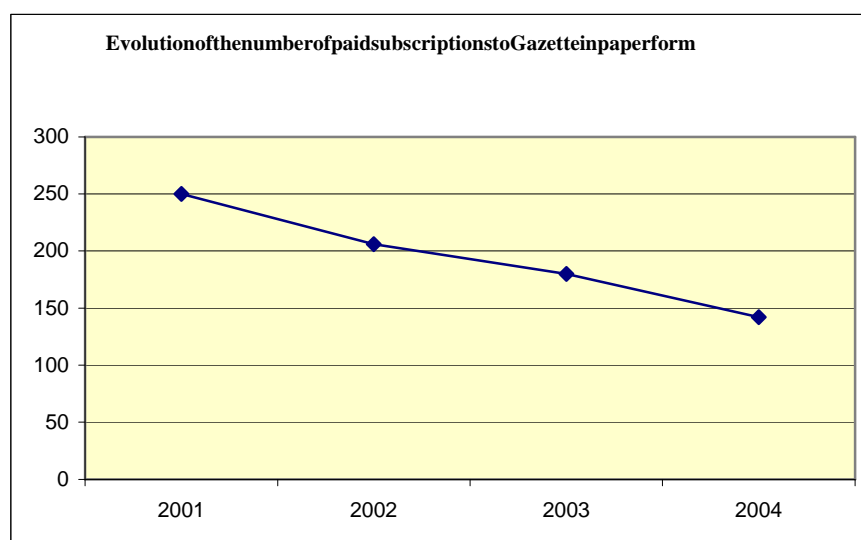
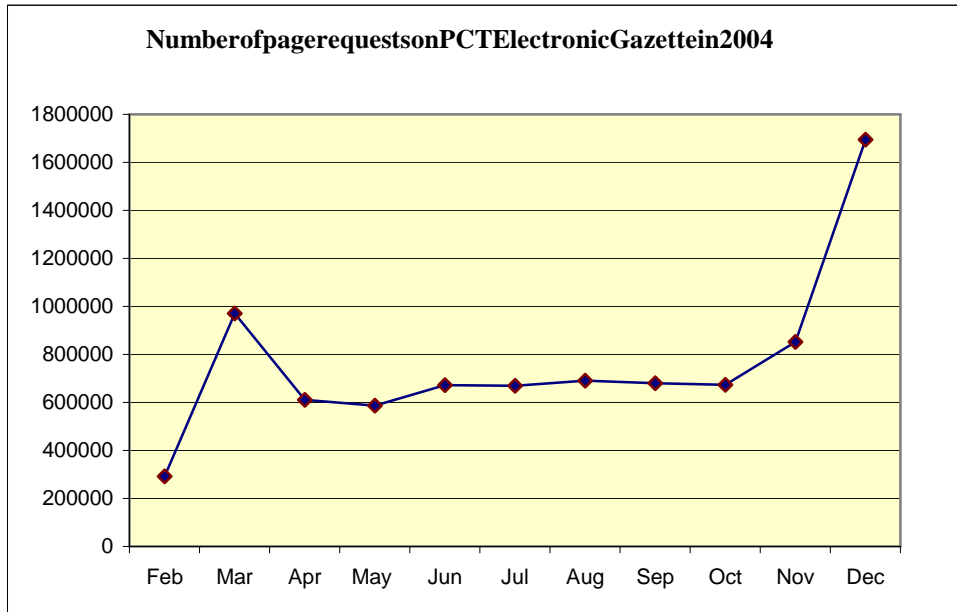


Table 1: Income/loss generated by subscription to the Gazette in paper form

	2001	2002	2003	2004
Income				
Subscriptions	150,000	124,000	108,000	94,000
Costs				
Mailing	163,000	175,000	159,000	101,000
Paper	85,000	64,000	56,000	73,000
Printing & Binding	119,000	89,000	78,000	26,000
Total costs	367,000	328,000	293,000	200,000
Loss	-217,000	-204,000	-185,000	-106,000

Figure 2: Number of page requests on PCT Electronic Gazette in 2004



[End of Annex II and of document]

WIPO



PCT/R/WG/7/9
ORIGINAL:English
DATE:April5,2005

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
Geneva, Ma y 25 to 31, 2005

FURTHER OBSERVATIONS BY SWITZERLAND ON ITS PROPOSALS
REGARDING THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES
AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

Document prepared by the International Bureau

BACKGROUND

1. The further observations by Switzerland on its proposals regarding the declaration of the source of genetic resources and traditional knowledge in patent applications appearing on the following pages were made by Switzerland in a submission to the International Bureau received on October 26, 2004.

2. *The Working Group is invited to consider the further observations contained in the Annex to this document.*

[Annex follows]

ANNEX

FURTHER OBSERVATIONS BY SWITZERLAND ON ITS PROPOSALS
REGARDING THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES
AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

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APPENDIX: PROPOSED AMENDMENTS OF THE PCT REGULATIONS

I. OVERVIEW

3. At the fourth session of the Working Group on Reform of the Patent Cooperation Treaty (PCT) of the World Intellectual Property Organization (WIPO) held in May 2003, Switzerland submitted proposals regarding transparency measures under patent law in the area of genetic resources and traditional knowledge.¹ More specifically, Switzerland proposed to explicitly enable the national patent legislation to require the declaration of the source of genetic resources and traditional knowledge in patent applications, if an invention is directly based on such resources or knowledge.

4. In order to further advance the discussions of the Working Group on PCT -Reform, Switzerland submitted additional comments on its proposal to the sixth session of this Working Group held in May 2004.² These comments concern the use of terms, the concept of the “source” of genetic resources and traditional knowledge, the scope of the obligation to declare this source in patent applications, and the possible legal sanctions for failure to disclose or the wrongful disclosure of the source.

5. In the discussions on the Swiss proposal held at the sixth session of the Working Group on PCT -Reform³, a number of issues were raised requiring further clarification. The present submission, which complements the two previous submissions by Switzerland to this Working Group, addresses (1) the formal vs. substantive nature of the disclosure requirement, (2) the optional vs. the mandatory introduction of the disclosure requirement, and (3) the concept of the source.

¹ These proposals are contained in PCT/R/WG/5/11 Rev.

² These additional comments are contained in PCT/R/WG/6/11.

³ See PCT/R/WG/6/12, paras. 82 -107, in particular paras. 105 -107.

II. FORMAL VS. SUBSTANTIVE DISCLOSURE REQUIREMENT

6. When considering the introduction of the disclosure requirement in patent law, its legal nature (formal vs. substantive) needs to be determined. This is decisive not only for the identification of the competent international forum to address and implement the requirement, but also with regard to the sanctions imposed for failure to disclose or wrongful disclosure of the source.

7. Generally, the requirements with regard to patent applications can be categorized as follows:⁴

- *formal requirements* which are examined for the purposes of determining if a complete application has been filed;
- *formal requirements strongly linked to substance* concerning the various parts of the patent application for the purposes of search, examination and grant, that is, requirements which could affect the scope of a search or result in the rejection of the claims during the substantive examination of the patent application; and
- *substantive requirements*, under which the claims are evaluated for patentability, namely, definition of prior art, disclosure of the claimed invention, patentable subject matter, novelty, inventive step and industrial utility.

8. The policy objective of the disclosure requirement proposed by Switzerland is to increase transparency in the context of access to genetic resources and traditional knowledge and the sharing of the benefits arising out of their utilization, in particular with regard to the obligations of the users of genetic resources and traditional knowledge.⁵ Increased transparency will allow the providers of genetic resources and traditional knowledge to verify whether the inventor and/or patent applicant complied with the applicable rules and procedures on access to these resources or this knowledge, and whether provision for benefit sharing has been made. This transparency measure will enhance the mutual supportiveness of the relevant international agreements, namely the treaties administered by WIPO, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), the Convention on Biological Diversity (CBD) and the Bonn Guidelines on Access to Genetic Resources and Fair and Equitable Sharing of the Benefits Arising Out of Their Utilization (Bonn Guidelines), and the International Treaty on Plant Genetic Resources for Food and Agriculture (International Treaty) of the Food and Agriculture Organization (FAO).

9. Due to its policy objective outlined above, the disclosure requirement is examined for the purposes of determining if a complete patent application has been filed. The disclosure requirement is in the view of Switzerland linked neither to the search, examination or grant of patents, nor to the evaluation of the claims for patentability. Accordingly, it has to be considered as a formal requirement, not a formal requirement strongly linked to substance or even as a substantive requirement.

⁴ See generally SCP/5/6, para. 51.

⁵ See PCT/R/WG/5/11 Rev., para. 7.

10. To clarify the legal situation and to provide for legal certainty, Switzerland proposes to amend the Regulations under the PCT to explicitly enable the national legislator to require patent applicants to disclose the source of genetic resources and traditional knowledge in patent applications. At the sixth session of the Working Group on the Reform of the PCT, the question was raised whether this Working Group is the competent forum to discuss these proposals. The Working Group can discuss only matters related to the PCT, that is, matters related to former contents of patent applications. Accordingly, since the disclosure requirement is in the nature of a formal requirement, the Working Group on the Reform of the PCT is the competent forum to address the proposals by Switzerland.

III. OPTIONAL VS. MANDATORY INTRODUCTION OF DISCLOSURE REQUIREMENT

11. Switzerland proposes to amend the PCT -Regulations to explicitly enable the national patent legislation to require the declaration of the source of genetic resources and traditional knowledge in patent applications. The proposal thus leaves it up to the national legislator to decide whether such a requirement is to be introduced in the national patent legislation. This optional nature of the disclosure requirement was chosen because of the great divergence in the views on transparency measures, and because at the international level the discussion on disclosure requirements has not brought any final results. An optional introduction of the disclosure requirement would enable those States interested in introducing such a requirement to do so, but would not oblige States to take action. Additionally, it would allow the national governments and the international community to gain experience with the disclosure requirement, without prejudice to further international efforts.

12. In this context, the amendment proposed by Switzerland with regard to the international publication is of relevance: The proposed Rule 48.2(a)(xi) provides that the pamphlet of the international publications shall contain any declaration as referred to in the proposed Rule 4.17(vi). Accordingly, if one or several Contracting Parties of the PCT require in their national legislation patent applicants to declare the source of genetic resources and traditional knowledge as provided for in the proposed Rule 51 *bis*.1(g), this declaration, if already included in the international patent application, would form part of the international publication of this application. As a result, any declaration of the source of genetic resources or traditional knowledge contained in an international patent application would generally become accessible to the public after the expiration of 18 months from the priority date of these applications by being included in the international publication. Thus, even though it is optional for the Contracting Parties of the PCT to implement the proposals by Switzerland at the national level, the proposed Rule 48.2(a)(xi) would in practice bring effects which are very similar to those of a mandatory approach: By being included in the international publication, the declaration of the source would be publicly accessible, and would thus increase transparency in the context of access and benefit sharing at the global level, without it being necessary that it is mandatory for the Contracting Parties of the PCT to require patent applicants to declare the source. At the same time, the proposed Rule 48.2(a)(xi) combined with the optional approach as proposed by Switzerland would have the advantages described in the preceding paragraph.

IV. THE CONCEPT OF THE SOURCE

13. According to the CBD, the Bonn Guidelines and the International Treaty of FAO, a multitude of entities may be involved in access and benefit sharing. To take into account this multitude of entities, Switzerland proposes to require patent applicants to declare the source of genetic resources and traditional knowledge in patent applications, the term “source” being understood in its broadest sense possible.

14. Based on the mentioned international instruments, the entity competent (1) to grant access to genetic resources and traditional knowledge, and/or (2) to participate in the sharing of the benefits arising out of their utilization, is in the foreground to be declared as the source. Depending on the genetic resource or traditional knowledge in question, one can distinguish “primary” and “secondary” such sources: Primary sources are the Contracting Party providing genetic resources (see Arts. 15, 16 and 19 of the CBD), indigenous and local communities (see Art. 8(j) of the CBD), and the Multilateral System established by the International Treaty (see Arts. 10 -13), and secondary sources are *ex situ* collections such as gene banks and botanical gardens as well as databases on genetic resources and traditional knowledge, and scientific literature.

15. As a result, according to the proposals by Switzerland, there is a “cascade” of primary and secondary sources the patent applicant may be required to disclose in order to fulfill the disclosure requirement. If the patent applicant (or the inventor) has information at hand about:

- the primary source, this primary source must be disclosed; thus, for example, if the patent applicant knows that the source of a genetic resource is the Contracting Party providing this resource, this Contracting Party must be disclosed as the source;
- the primary and one or several secondary sources, the primary source must be disclosed, whereas the disclosure of these secondary sources is optional; thus, for example, if the patent applicant received the genetic resource from a botanical garden, but also knows the Contracting Party providing the genetic resource, this Contracting Party must be disclosed, whereas the disclosure of the botanical garden is optional.
- a secondary source, but not about a primary source, this secondary source must be disclosed; thus, for example, if the patent applicant received the genetic resource from a botanical garden, but does not know the Contracting Party providing the genetic resource, the botanical garden must be disclosed as the source.
- several secondary sources, but not about the primary source, these secondary sources with the closest relationship to the primary source must be disclosed; the disclosure of the other secondary sources is optional; thus, for example, if the genetic resource was provided from one botanical garden to several others, the first botanical garden in this chain must be disclosed, whereas the disclosure of the other botanical gardens is optional.

16. Only if the patent applicant (or the inventor) has no information at hand about the primary or the secondary source, may he disclose that such source is unknown. Considering the broad understanding of the term “source,” cases where neither a primary nor a secondary source is known are likely to be rare.

V. CONCLUSIONS

17. *Formal vs. substantive disclosure requirement*: The policy objective of the disclosure requirement is to increase transparency in the context of access to genetic resources and traditional knowledge and the sharing of the benefits arising out of their utilization. To achieve this policy objective, the disclosure requirement has to be examined for the purposes of determining if a complete patent application has been filed. However, this policy objective neither requires nor justifies that the disclosure requirement is linked to the research, examination or grant of patents, or to the evaluation of the claims for patentability. Accordingly, it has to be considered as a formal requirement. In the context of amendments to the Regulations under the PCT only formal requirements can be taken into consideration.

18. *Optional vs. mandatory introduction of disclosure requirement in the PCT*: In view of the clear divergence of opinions among the Contracting Parties of the PCT with regard to the introduction of a formal disclosure requirement, Switzerland has proposed to make it optional for the national legislator to introduce such a requirement.

The concept of “source”: The relevant international instruments foresee a multitude of entities to be involved in access and benefit sharing. In the foreground to be declared as the source is the entity competent (1) to grant access to genetic resources and traditional knowledge, and/or (2) to participate in the sharing of the benefits arising out of their utilization. Depending on the genetic resource or traditional knowledge in question, one can distinguish primary sources, including in particular Contracting Parties providing genetic resources, the Multilateral System of FAO’s International Treaty, indigenous and local communities, and secondary sources, including in particular ex situ collections and scientific literature. Accordingly, there is a “cascade” of possible primary and secondary sources: Patent applicants must disclose the primary source to fulfill the disclosure requirement, if they have information about this primary source at hand. A secondary source may only be disclosed if patent applicants have no information at hand about the primary source.

[Appendix follows]

APPENDIX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

DECLARATION OF THE SOURCE OF GENETIC RESOURCES AND TRADITIONAL
KNOWLEDGE IN PATENT APPLICATIONS

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INTRODUCTION

This Annex contains the wording of the amendments of the PCT Regulations proposed by Switzerland regarding the declaration of the source of genetic resources and traditional knowledge in patent applications. Proposed additions and deletions are indicated, respectively, by underlining and striking through of the text concerned. Amendments are proposed to Rule 4.17 (addition to chapeau and new subpara. vi), Rule 48.2(a) (new subpara. xi), Rule 51 *bis*.1 (new subpara. g), Rule 51 *bis*.2 (new subpara. d), and Rule 51 *bis*.3 (amendment of subpara. a). Rule 26 *ter* is not proposed to be amended, but is included in this Annex for ease of reference.

To take into account the discussions of the Working Group on the Reform of the PCT on the proposals by Switzerland, the wording of the amendments of the PCT Regulations originally proposed by Switzerland⁶ has been slightly adapted, without, however, modifying the substance of the proposals. This concerns, in particular, the use of the term “traditional knowledge related to genetic resources” instead of the term “knowledge, innovations and practices of indigenous and local communities relevant for the conservation and sustainable use of biological diversity.”

⁶ See PCT/R/WG/5/11 Rev., paras. 24 and 29.

Rule 4

The Request (Contents)

4.1 to 4.16 [No change]

4.17 *Declarations Relating to National Requirements Referred to in Rule 51 bis. 1(a)(i) to (v) and Rule 51 bis. 1(g)*

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

(i) to (iv) [No change]

(v) a declaration as to non-prejudicial disclosures or exception to lack of novelty, as referred to in Rule 51 bis. 1(a)(v);

(vi) a declaration as to the source of a specific genetic resource and/or traditional knowledge related to genetic resources, as referred to in Rule 51 bis. 1(g).

[COMMENT: Rule 4.17 sets forth those matters relating to which applicants may include a declaration in the request pursuant to Rule 4.1(c)(iii). Such matters include those as to which designated Offices are entitled to require documents or evidence during the national phase of processing and which are expressly listed in Rule 51 bis. 1(a). The proposed new subparagraph (vi) would give patent applicants the possibility of satisfying the declaration requirement under national patent law in accordance with the proposed new Rule 51 bis. 1(g) at the time of filing an international patent application or later during the international phase.

[Rule 4.17, continued]

This would further simplify procedures related to the declaration of the source of genetic resources and/or traditional knowledge related to genetic resources, with regard to international patent applications. The Administrative Instructions will have to prescribe the standardized wording of such declarations which may be included in the request pursuant to the proposed Rule 4.17(vi).]

4.11 to 4.18 [No change]

Rule 26 *ter*

Correction or Addition of Declarations Under Rule 4.17

26ter.1 Correction or Addition of Declarations

The applicant may correct or add to the request any declaration referred to in Rule 4.17 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.

26ter.2 Processing of Declarations

(a) Where the receiving Office or the International Bureau finds that any declaration referred to in Rule 4.17 is not worded as required or, in the case of the declaration of inventorship referred to in Rule 4.17(iv), is not signed as required, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.

(b) Where the International Bureau receives any correction or addition of a declaration under Rule 26 *ter.1* after the expiration of the time limit under Rule 26 *ter.1*, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

[Rule 26ter, continued]

[COMMENT: Rule 26 *ter* is unchanged. It is included in this Annex for ease of reference only. Rule 26 *ter* provides procedures for the addition or correction of declarations in the request which are referred to in Rule 4.17. It also applies in the context of the proposed new Rules 4.17(vi) and 51 *bis*.1(g). Rule 26 *ter* provides the applicant with a mechanism for providing or correcting a declaration of the source of genetic resources and/or traditional knowledge related to genetic resources pursuant to the proposed Rule 4.17(vi) during the international phase.]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (ix) [No change]

(x) any declaration referred to in Rule 4.17(v), and any correction under Rule 26*ter.1*, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter.1*.

(xi) any declaration referred to in Rule 4.17(vi), and any correction under Rule 26*ter.1*, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter.1*.

[COMMENT: The proposed Rule 48.2(a)(xi) provides that the pamphlet shall contain any declaration contained in the request that is referred to in the proposed Rule 4.17(vi), that is, a declaration regarding the source of a specific genetic resource and/or traditional knowledge related to genetic resources, as referred to in the proposed Rule 51 *bis.1*(g). With the proposed subpara. (xi), the declaration of the source of such a resource or such knowledge in a patent application would generally become accessible to the public after the expiration of 18 months from the priority date of that application. Accordingly, the proposed Rule 48.2(a)(xi) would further support the policy objective of the declaration of the source, that is, increasing transparency in the context of access to genetic resources and traditional knowledge and the sharing of the benefits arising out of their utilization.]

[Rule 48.2, continued]

(b)to(i) [Nochange]

48.3to48.6 [Nochange]

Rule 51 bis

Certain National Requirements Allowed Under Article 27

51bis.1 *Certain National Requirements Allowed*

(a) to (f) [No change]

(g) Subject to Rule 51 bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish:

(i) a declaration as to the source of a specific genetic resource to which the inventor has had access, if the invention is directly based on such a resource;

(ii) a declaration as to the source of traditional knowledge related to genetic resources, if the inventor knows that the invention is directly based on such knowledge;

(iii) a declaration that the source referred to in (i) or (ii) is unknown to the inventor or applicant, if this is the case.

[COMMENT: The proposed Rule 51 bis.1(g) provides that the national law applicable by the designated Office may require patent applicants to furnish either a declaration as to the source of a specific genetic resource and/or traditional knowledge related to genetic resources, or a declaration that this source is unknown to the inventor or applicant. The proposed Rule 51bis.1(g) takes into account the discussions held in the Working Group on PCT on the proposals by Switzerland. Accordingly, the wording of the proposed Rule 51 contains minor adaptations compared with the wording of the proposals originally submitted -Reform bis.1(g) submitted

[Rule 51 bis.1(g), continued]

by Switzerland to the Working Group on Reform of the PCT in May 2003.⁷ These adaptations concern the structure and the use of terms, but do not alter the substance of the proposed Rule 51 bis.1(g). These adaptations are: First, the proposed Rule 51 bis.1(g) uses the term “traditional knowledge related to genetic resources” instead of the term “knowledge, innovations and practices of indigenous and local communities relevant for the conservation and sustainable use of biological diversity.” In the view of Switzerland, both terms are fully synonymous,⁸ the term “traditional knowledge related to genetic resources” being used for reasons of simplicity and brevity. Second, a subpara. (iii) is added to the proposed Rule 51 bis.1(g), containing the provision of the last part of the originally proposed subparas. (i) and (ii), respectively, with regard to the case where the source is unknown to the inventor or applicant. And third, the proposed subpara. (iii) clarifies that the source must be unknown to the inventor or patent applicant.]

51 bis.2 Circumstances in Which Documents or Evidence May Not Be Required

(a) to (c) [No change]

(d) Where the applicable national law requires the applicant to furnish a declaration as to the source (Rule 51 bis.1(g)), the designated Office shall not, unless it may reasonably doubt the veracity of the declaration concerned, require any document or evidence:

(i) relating to the source of a specific genetic resource (Rule 51 bis.1(g)(i) and (iii)) if, in accordance with Rule 4.17(vi), such declaration is contained in the request or is submitted directly to the designated Office;

⁷ See PCT/R/WG/5/11 Rev., paras. 24 and 29.

⁸ See PCT/R/WG/6/11, para. 11.

[Rule 51 bis.2(d), continued]

(ii) relating to the source of traditional knowledge related to genetic resources,
(Rule 51 bis.1(g)(ii) and (iii)) if, in accordance with Rule 4.17(vi), such declaration is
contained in the request or is submitted directly to the designated Office.

[COMMENT: The proposed Rule 51 bis.2(d) is intended to limit the circumstances in which designated Offices are entitled to require documents or evidence from applicants in the national phase in relation to certain matters referred to in the proposed Rule 51 bis.1(g). The limitation is consistent with draft PLT Article 6(6). Accordingly, if the request, in accordance with Rule 4.17(vi), contains a declaration as to the source of a genetic resource or traditional knowledge, or a declaration that this source is unknown to the inventor or applicant (Rule 51 bis.1(g)), or if such a declaration is submitted directly to the designated Office, the Office would not be entitled to require documents or evidence relating to this declaration, unless the Office has reasonable doubts as to the veracity of the declaration.]

51 bis.3 Opportunity to Comply with National Requirements

(a) Where any of the requirements referred to in Rule 51 bis.1(a)(i) to (iv) ~~and~~ (c) to (e) ~~and~~ (g), or any other requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27(1) or (2), is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the designated Office, in the circumstances, shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

[Rule 51 bis.3(a), continued]

[COMMENT: Rule 51 *bis*.3(a) provides that designated Offices shall invite the applicant to comply with those requirements of national law which designated Offices may apply under Rule 51 *bis*.1(a) and (c) to (e) and Article 27(1) and (2), respectively, which have not already been fulfilled by the time of entry of the application into the national phase. It is proposed to apply this Rule also with regard to requirements of national law which designated Offices may apply under Rule 51 *bis* .1(g).]

(b) and (c) [No change]

[End of Appendix, Annex and document]