

International Patent Cooperation Union (PCT Union)

Assembly

Fifty-Sixth (32nd Extraordinary) Session
Geneva, July 9 to 17, 2024

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

Document prepared by the International Bureau

SUMMARY

1. This document contains proposed amendments to the Regulations under the Patent Cooperation Treaty (PCT) (“the Regulations”) based on the recommendations by the PCT Working Group (“the Working Group”) for submission to this session of the Assembly.

PROPOSED AMENDMENTS

2. Annexes I to IV set out proposed amendments to the Regulations, as recommended by the Working Group at its seventeenth session from February 19 to 21, 2024. The proposed amendments relate to the following matters:

- (a) to allow an Office, other than the International Bureau, to require international applications or subsequently-filed documents to be submitted in electronic form only, or to require that any document submitted on paper is submitted again in electronic form within two months (Rule 89*bis*, as set out in Annex I); for further details, see document PCT/WG/17/15 and paragraphs 15 and 16 of document PCT/WG/17/21;
- (b) to enable the International Bureau to correspond with applicants or Offices in any of the 10 languages of international publication for certain communications to be determined in future Administrative Instructions, instead of in either English or French only (Rule 92, as set out in Annex II); for further details, see document PCT/WG/17/6 and paragraphs 21 and 22 of document PCT/WG/17/21;

(c) to limit the scope of the exceptions from the requirement of the receiving Office to invite the applicant to furnish a translation of the abstract and text matter of the drawings into the language in which the international application is to be published when the abstract or text matter of drawings is filed in a different language, thereby ensuring that the international application is published in a single language (Rule 26, as set out in Annex III); for further details, see document PCT/WG/17/7, and paragraphs 23 and 24 and Annex I of document PCT/WG/17/21;

(d) to broaden the definition of relevant prior art for international search and preliminary examination to include non-written disclosures (Rules 33 and 64, as set out in Annex IV); for further details, see document PCT/WG/17/10, and paragraphs 25 and 26 and Annex II of document PCT/WG/17/21.

3. Annex V sets out a “clean” text of the relevant Rules as they would stand after their amendment.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

4. It is proposed that the Assembly adopt the following decisions in relation to entry into force and transitional arrangements of the proposed amendments set out in Annexes I to IV:

(a) The amendments to Rule 89*bis* set out in Annex I shall enter into force on July 1, 2025.

(b) The amendments to Rule 92 set out in Annex II shall enter into force on July 1, 2025.

(c) The amendments to Rule 26 set out in Annex III shall enter into force on July 1, 2025, and shall apply to any international application with an international filing date that is on or after that date.

(d) The amendments to Rules 33 and 64 set out in Annex IV shall enter into force on January 1, 2026, and shall apply to any international application in relation to which the international search report or declaration under Article 17(2)(a) is established on or after that date.

5. The proposed entry into force of the amendments to Rules 33 and 64 corresponds to the entry into force of the amendments that the Assembly adopted at its fifty-fifth session in July 2023 related to the definition of the minimum documentation that the International Searching Authority should consult during international search (see document PCT/A/55/2 and paragraphs 27 to 32 of document PCT/A/55/4).

6. The Assembly of the PCT Union is invited to adopt the proposed amendments to the Regulations under the PCT set out in Annexes I to IV of document PCT/A/56/2, and the entry into force and transitional arrangements set out in paragraph 4 of the same document.

[Annexes follow]

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

Rule 89bis
Filing, Processing and Communication
of International Applications and Other Documents
in Electronic Form or by Electronic Means

89bis.1 International Applications

(a) International applications may, subject to paragraphs (b) to (e), be filed and processed in electronic form or by electronic means, in accordance with the Administrative Instructions, ~~provided that any receiving Office shall permit the filing of international applications on paper.~~

(b) [No change] These Regulations shall apply *mutatis mutandis* to international applications filed in electronic form or by electronic means, subject to any special provisions of the Administrative Instructions.

(c) [No change] The Administrative Instructions shall set out the provisions and requirements in relation to the filing and processing of international applications filed, in whole or in part, in electronic form or by electronic means, including but not limited to, provisions and requirements in relation to acknowledgment of receipt, procedures relating to the according of an international filing date, physical requirements and the consequences of non-compliance with those requirements, signature of documents, means of authentication of documents and of the identity of parties communicating with Offices and authorities, and the operation of Article 12 in relation to the home copy, the record copy and the search copy, and may contain different provisions and requirements in relation to international applications filed in different languages.

(d) [No change] No national Office or intergovernmental organization shall be obliged to receive or process international applications filed in electronic form or by electronic means unless it has notified the International Bureau that it is prepared to do so in compliance with the applicable provisions of the Administrative Instructions. The International Bureau shall publish the information so notified in the Gazette.

[\(d-bis\) A national Office or intergovernmental organization, other than the International Bureau, that has made a notification under paragraph \(d\) may notify the International Bureau that it will only receive international applications if they are filed in electronic form or by electronic means. The International Bureau shall publish a notification made under this paragraph in the Gazette.](#)

(d-ter) A national Office or intergovernmental organization that has made a notification under paragraph (d) but not paragraph (d-bis) may notify the International Bureau that any application filed on paper must be resubmitted by electronic means within two months from the date of an invitation by such Office or organization. If corresponding documents are not timely received, the international application shall be considered withdrawn and the receiving Office shall so declare. The International Bureau shall publish a notification made under this paragraph in the Gazette.

(e) [No change] No receiving Office which has given the International Bureau a notification under paragraph (d) may refuse to process an international application filed in electronic form or by electronic means which complies with the applicable requirements under the Administrative Instructions.

89bis.2 *Other Documents*

Rule 89bis.1 shall apply *mutatis mutandis* to other documents and correspondence relating to international applications, provided that, where a national Office or intergovernmental organization has made a notification under Rule 89bis.1(d-ter), any such documents or correspondence filed on paper and not resubmitted by electronic means within two months from the date of a corresponding invitation shall be disregarded.

89bis.3 *Communication between Offices*

[No change] Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal ("communication") of an international application, notification, communication, correspondence or other document by one national Office or intergovernmental organization to another, such communication may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

[Annex II follows]

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 92
Correspondence

92.1 *[No change]*

92.2 *Languages*

(a) [No change]

(b) [No change]

(c) [Remains deleted]

(d) [No change] Any letter from the applicant to the International Bureau shall be in English, French or any other language of publication as may be permitted by the Administrative Instructions.

(e) Any letter or notification from the International Bureau to the applicant or to any national Office shall be in English, ~~or~~ French or any other language of publication as may be permitted by the Administrative Instructions.

92.3 and 92.4 *[No change]*

[Annex III follows]

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³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 26

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

26.1 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, subject to Rules 12.1*bis* and 26.3*ter*(e), of the description and the claims, the receiving Office shall, unless

(i) a translation of the international application is required under Rule 12.3(a) [into the language in which the international application is to be published](#), or

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published,

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, 26.2, 26.3, 26.3*bis*, 26.5 and 29.1 shall apply *mutatis mutandis*.

(b) to (e) [No change]

[Annex IV follows]

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⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 33

Relevant Prior Art for the International Search

33.1 *Relevant Prior Art for the International Search*

(a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by any means ~~of written disclosure (including drawings and other illustrations)~~ and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

(b) [No change] When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

(c) [No change] Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

33.2 and 33.3 *[No change]*

Rule 64

Relevant Prior Art for the International Preliminary Examination

64.1 *Prior Art*

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by any means ~~of written disclosure (including drawings and other illustrations)~~ shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) [No change]

64.2 *Non-Written Disclosures*

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means ("non-written disclosure") before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, ~~the non-written disclosure shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless,~~ the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.

64.3 *[No change]*

[Annex V follows]

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Rule 26

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

26.1 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, subject to Rules 12.1*bis* and 26.3*ter*(e), of the description and the claims, the receiving Office shall, unless

(i) a translation of the international application is required under Rule 12.3(a) into the language in which the international application is to be published, or

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published,

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, 26.2, 26.3, 26.3*bis*, 26.5 and 29.1 shall apply *mutatis mutandis*.

(b) to (e) [No change]

Rule 33

Relevant Prior Art for the International Search

33.1 Relevant Prior Art for the International Search

(a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by any means which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

(b) and (c) [No change]

33.2 and 33.3 [No change]

Rule 64

Relevant Prior Art for the International Preliminary Examination

64.1 *Prior Art*

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by any means shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) [No change]

64.2 *Non-Written Disclosures*

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means ("non-written disclosure") before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.

64.3 [No change]

Rule 89bis
Filing, Processing and Communication
of International Applications and Other Documents
in Electronic Form or by Electronic Means

89bis.1 International Applications

(a) International applications may, subject to paragraphs (b) to (e), be filed and processed in electronic form or by electronic means, in accordance with the Administrative Instructions.

(b) to (d) [No change]

(d-*bis*) A national Office or intergovernmental organization, other than the International Bureau, that has made a notification under paragraph (d) may notify the International Bureau that it will only receive international applications if they are filed in electronic form or by electronic means. The International Bureau shall publish a notification made under this paragraph in the Gazette.

(d-*ter*) A national Office or intergovernmental organization that has made a notification under paragraph (d) but not paragraph (d-*bis*) may notify the International Bureau that any application filed on paper must be resubmitted by electronic means within two months from the date of an invitation by such Office or organization. If corresponding documents are not timely received, the international application shall be considered withdrawn and the receiving Office shall so declare. The International Bureau shall publish a notification made under this paragraph in the Gazette.

(e) [No change]

89bis.2 Other Documents

Rule 89bis.1 shall apply *mutatis mutandis* to other documents and correspondence relating to international applications, provided that, where a national Office or intergovernmental organization has made a notification under Rule 89bis.1(d-*ter*), any such documents or correspondence filed on paper and not resubmitted by electronic means within two months from the date of a corresponding invitation shall be disregarded.

89bis.3 [No change]

Rule 92
Correspondence

92.1 *[No change]*

92.2 *Languages*

(a) to (d) *[No change]*

(e) Any letter or notification from the International Bureau to the applicant or to any national Office shall be in English, French or any other language of publication as may be permitted by the Administrative Instructions.

92.3 and 92.4 *[No change]*

[End of Annex V and of document]